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## Literacy Titles - Copyrightable or Trademarkable

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LITERARY TITLES — COPYRIGHTABLE OR  
TRADEMARKABLE\*

Literary titles are neither subject to copyright registration themselves nor included in the copyright of the work<sup>1</sup> obtainable under the Federal Copyright Act.<sup>2</sup> Similarly, titles of single publications are denied registration under the Trademark Act,<sup>3</sup> although series titles have received some degree of protection. Thus, prior to the recent decisions of *Sears, Roebuck & Co. v. Stiffel Co.*<sup>4</sup> and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>5</sup> state laws of unfair competition had generally been regarded as affording the most pervasive protection<sup>6</sup> to holders of literary titles. These cases, however, have created serious doubts as to the permissible extent of this protection.

It is the purpose of this comment to re-evaluate the adequacy of existing protection of single literary titles, particularly those of books, newspaper and magazine columns in light of the *Sears* and *Compco* decisions, and to evaluate the possibility as well as the advisability of extending federal protection to such titles.

## I. COPYRIGHT REGISTRATION

The copyright and patent clause, article I, section 8, of the United States Constitution, grants Congress the power "to promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries." Pursuant to this grant, Congress has passed several Copyright Acts,<sup>7</sup> the most recent of which grants an author the exclusive right to print, reprint, publish, copy and vend<sup>8</sup> all his writings<sup>9</sup> for a limited time.<sup>10</sup> The purpose of this enactment, to encourage the production of literary work in the arts and sciences by affording protection for intellectual endeavor, is to be accomplished without burdensome requirements<sup>11</sup> and, after the statutory period has expired, the work is to be dedicated to public use.

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1. 3 CALLMAN, UNFAIR COMPETITION AND TRADE-MARKS § 83.2(b) (2d ed. 1950).

2. 17 U.S.C. §§ 1-216 (1964).

3. 60 Stat. 427 (1946), 15 U.S.C. §§ 1051-1127 (1964). The discussion of trademark registration in the comment will be with respect to the Principal Register and not the Supplemental Register.

4. 376 U.S. 225, *rehearing denied*, 376 U.S. 973 (1964).

5. 376 U.S. 234, *rehearing denied*, 377 U.S. 913 (1964).

6. See Netterville & Hirsch, *Piracy and Privilege in Literary Titles*, 32 So. CAL. L. REV. 101, 117-36 (1959).

7. The first Copyright Act was enacted into law May 31, 1790. See HOWELL, COPYRIGHT LAW 2, note 21 (3d ed. 1952).

8. 17 U.S.C. § 1(a) (1964).

9. 17 U.S.C. § 4 (1964).

10. The duration of a copyright is twenty-eight years from the date of first publication with an optional extension for another twenty-eight-year period. 17 U.S.C. § 24 (1964).

11. *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), *rehearing denied*, 306 U.S. 668 (1939).

The statute itself does not specifically exclude registration of a literary title; on the contrary, it is susceptible to a literal reading which would indicate the permissible inclusion of a title under section 4, which states: "The works for which copyright may be secured under this title shall include *all the writings* of an author."<sup>12</sup>

Nevertheless, the Supreme Court held in the *Trade-Mark* cases<sup>13</sup> that the word "writing" as used in the copyright clause refers only to such writings as are original and result from intellectual labor, and not to those which merely advertise or designate the subject to which they are attached. The reason for this exclusion has been concisely summarized in regulations of the Copyright Office which categorize titles with names, slogans, ideas and plans in a class of works which consist solely of information which are common property and contain no original authorship.<sup>14</sup> This declaration, which has been regarded as "a fair summary of the law"<sup>15</sup> in conformity with judicial decision since 1850,<sup>16</sup> has been the basis for holding titles to be beyond the possible protection of the Copyright Act.

This result, however, fails to take into account the originality of some individual titles as well as the intellectual labor expended to devise a title with public appeal.<sup>17</sup> Nor do they consider that, through the medium of advertising, titles have acquired notable value and have become a readily marketable item.<sup>18</sup> Such pecuniary interest achieved by an author's efforts would appear to be equally worthy of protection.

Furthermore, while the decisions make it clear that titles are beyond the scope of the Copyright Act, some doubt remains as to whether they are beyond the purview of the copyright clause itself, even considering the pronouncement in the *Trade-Mark* cases. The restrictive standard of originality developed in those cases has apparently been discarded in favor of an objective standard which would require an author merely to demonstrate that the work was his creation, thus obviating the need for

12. 17 U.S.C. § 4 (1964). (Emphasis added.) Applications for registration must specify to which class the work in which a copyright is claimed belongs. Two of the enumerated classes are books and periodicals, including newspapers. 17 U.S.C. § 5(a), (b) (1964). The Register of Copyright's proposed copyright revision bill of 1965 changes "all writings" to "original works of authorship." HOUSE COMM. ON THE JUDICIARY, 89th Cong., 1st Sess., COPYRIGHT LAW REVISION, pt. 6, at 174 (Comm. Print 1965) (hereinafter cited as 1965 COPYRIGHT LAW REVISION).

13. *United States v. Steffens*, 100 U.S. 82 (1879).

14. 37 C.F.R. § 202.1 (Supp. 1965). The Registrar of Copyrights has the authority under 17 U.S.C. § 207 (1964) to promulgate such rules and regulations for the registration of claims to copyright.

15. *Kitchens of Sara Lee, Inc. v. Nifty Food Corp.*, 266 F.2d 541 (2d Cir. 1959).

16. *Jollie v. Jacques*, 13 Fed. Cas. 910 (No. 7437) (C.C. S.D. N.Y. 1850). The Court, in holding that the title of a musical composition was not subject to copyright protection, stated at p. 914: "The right secured is the property in the piece of music, the production of the mind and genius of the author, and not in the mere name given to the work."

17. Some believe that the most original contributions of the author Thomas Wolfe were his titles, e.g., *LOOK HOMEWARD ANGEL*; *YOU CAN'T GO HOME AGAIN*; *OF TIME AND THE RIVER*.

18. See Klein, *Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy?*, 28 BROOKLYN L. REV. 59, 67 (1961).

meeting the more subjective standard of aesthetic and educational value.<sup>19</sup> Under such an interpretation, Congress could constitutionally protect titles as "writings" within the copyright clause.<sup>20</sup>

This is not to suggest, however, that such protection should be extended as a matter of course. Admittedly, not all titles are distinctive and original; but the exclusion of some merely descriptive titles from copyright registration should not necessitate the exclusion of all. For this reason, a number of foreign jurisdictions have adopted an intermediary approach and distinguish non-original titles from those which are original and distinctive, affording protection to the latter.<sup>21</sup> The desirability of adopting legislation to accomplish this end will be discussed more fully in following pages.

Finally, the common law copyright also fails to afford an author adequate protection of his title.<sup>22</sup> Publication of an uncopyrightable title, even though it might still qualify as a writing under the Constitution in light of the *Bleistein* case, would nonetheless be a forfeiture of the common law right.<sup>23</sup>

Consequently, authors have been forced to look to other areas of the law to secure protection of their titles. One possibility, where some titles have been held to be registrable, is the Federal Trademark Act, the Lanham Act.<sup>24</sup>

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19. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). In the majority opinion of Mr. Justice Holmes, copyright protection was granted to chromolithographs for advertising a circus. The opinion indicated that the article only need be the original work of the designer. Mr. Justice Holmes stated at pp. 251-52:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. . . . [y]et if they command the interest of any public, they have a commercial value, — it would be bold to say that they have not an aesthetic and educational value. . . .

20. Kalodner & Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1115 (1959).

21. Belgium, Egypt and France grant copyright protection if the title is original and is a personal intellectual creation. Guatemala protects a title if it is distinctive, while Mexico protects titles of a newspaper, magazine or any other serial publications. Dubin, *Motion Pictures — Rights United States and International*, 28 SO. CAL. L. REV. 205, 214 (1955).

22. In *Edgar H. Wood Assoc. v. Skene*, 347 Mass. 351, 197 N.E.2d 886 (1964), the court held that *Sears* and *Compco* do not require abandonment of state protection afforded to unpublished material.

23. *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 89 (2d Cir. 1940), *cert. denied*, 311 U.S. 712 (1940). Judge L. Hand stated:

[W]e see no reason why the same acts that unconditionally dedicate the common-law copyright in works copyrightable under the act, should not do the same in the case of works not copyrightable. . . . Any relief which justice demands must be found in extending statutory copyright to such works, not in recognizing perpetual monopolies, however limited their scope.

Although state competence to define publication has not been doubted, it has been suggested that the *Sears* and *Compco* cases indicate that this area is also preempted. Treece, *Patent Policy and Preemption: The Stiffel and Compco Cases*, 32 U. CHI. L. REV. 80, 89 (1964).

24. 60 Stat. 427 (1946), 15 U.S.C. §§ 1051-1127 (1964).

## II. TRADEMARK REGISTRATION

The first Trademark Act, enacted by Congress in 1870,<sup>25</sup> provided for registration by a person who had acquired the exclusive right to a trademark through usage, and created a cause of action for infringement thereof.<sup>26</sup> However, that act was declared unconstitutional in the *Trademark* cases,<sup>27</sup> where it was held that trademarks did not qualify under the copyright clause since the basis for trademarkability was usage rather than "originality, invention, discovery, or intellectual labor." Nor did the commerce clause<sup>28</sup> validate this *particular* statute, as it was not limited to interstate commerce, but envisaged a universal system. Subsequent federal trademark regulations, including the present-day statute, have been passed under the authority of the commerce clause, their scope being limited to articles in interstate commerce.

## A. Book Titles

For registration under the Lanham Act, a term or phrase must first distinguish applicants' goods in commerce from all others, rather than be "merely descriptive of the goods or deceptively misdescriptive"<sup>29</sup> of it. With these standards as a guideline, titles to individual literary works have been denied registration as trademarks.<sup>30</sup>

The case of *In re Cooper*<sup>31</sup> illustrates the position of the courts. In that case applicant sought to register the arbitrary title "Teeny-Big" as a trademark for his juvenile book. Analogizing the title of a book to "oranges" and "canned beans," common names of products, rather than "Sunkist" oranges or "Heinz" canned beans, the products' trademark, the court held that a title is merely descriptive of the goods and does not perform a trademark function.

The court's argument was founded on the proposition that even though a title is arbitrary and fanciful in that it is not descriptive of the *contents* of a book, it is the only name for the book, and is therefore descriptive of it. And names which either denote the article or describe its contents are "descriptive" of that article within the statutory meaning of the word.

In his dissenting opinion, Judge Worley took the position that a mark cannot be both arbitrary and, at the same time, descriptive of the goods. Thus, the basic disagreement revolved about the definition to be attached to the term "descriptive." The dissenting opinion would permit registration whenever the title is arbitrary and fanciful, rather than being

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25. 16 Stat. 198 (1870).

26. 19 Stat. 141 (1876), provided for a fine and imprisonment for unlawful use.

27. 100 U.S. 82 (1879).

28. U.S. CONST. art. I, § 8.

29. 60 Stat. 427 (1946), 15 U.S.C. § 1052(e) (1964).

30. *In re National Council Books, Inc.*, 121 U.S.P.Q. 198 (P.O. TM. T. App. Bd. 1959); *In re Commonwealth Engineering Co. of Ohio*, 120 U.S.P.Q. 415 (P.O. TM. T. App. Bd. 1959).

31. 254 F.2d 611 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840 (1958).

descriptive of the contents of the book, while the majority would deny registration to all titles on the theory that they are necessarily descriptive of the book as an object.

The validity of the majority's position must be examined in light of the general policy behind the exclusion of descriptive or generic terms from trademark protection. The rationale appears to be that to confer the exclusive right to the use of such a term would preclude others from exercising their right to use the proper word to describe a similar product.<sup>32</sup> This necessarily presupposes a class of similar products susceptible to designation by the same descriptive term. However, it is at least arguable that an arbitrary book title is specific to that book, and is not a term to be properly used in describing similar books. Indeed, it would seem to be more palatable to hold that terms such as "western," "historical novel," or "juvenile" constitute the class of generic terms properly excluded from trademark protection.<sup>33</sup> Nevertheless, this analysis does not obviate the persuasive policy objection that it would preclude another from using the only name the work has.

A mark which does not perform a technical trademark function, that is, one which indicates the origin or source of the product rather than the product itself, might nevertheless be afforded trademark protection where it acquires secondary meaning. Literary titles, however, are more commonly associated with the qualities and characteristics of a product rather than its source. Even if the public were to make a source association, it would more likely be with the author than the publisher. Since the courts have generally concluded that under the Lanham Act the identified source must be the publisher<sup>34</sup> trademark registration has been denied.

Finally, even if secondary meaning were established,<sup>35</sup> trademark protection would still be denied under the current interpretation of section 2(f) of the Lanham Act.<sup>36</sup> While numerous decisions under state laws of unfair competition have prohibited title duplication in such situations,<sup>37</sup> the Court of Customs and Patent Appeals has distinguished between legally significant and *de facto* secondary meaning. Accordingly, a mark which is the common name of an article, such as an individual title, is deemed

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32. *Wise v. Bristol-Myers Co.*, 107 F. Supp. 800 (S.D. N.Y. 1952); *Rainbow Art Co. v. Sears, Roebuck & Co.*, 99 F. Supp. 677 (S.D.W.Va. 1951).

33. *Cf. Nissen Trampoline Co. v. American Trampoline Co.*, 193 F. Supp. 745 (S.D. Iowa 1961).

34. 60 Stat. 427 (1946), 15 U.S.C. § 1127 (1964), defines a trade-mark as a word, etc., used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured by others. The court defines manufacturer or merchant to mean the publisher rather than the author, and for a valid trademark it must be associated with the publisher. However, if the contents of the book are the goods, it is arguable that the author is the manufacturer.

35. *Grove Laboratories, Inc. v. Approved Pharmaceutical Corp.*, 149 F. Supp. 86 (N.D.N.Y. 1957).

36. 60 Stat. 427 (1946), 15 U.S.C. § 1052(f) (1964).

37. *Jackson v. Universal International Pictures, Inc.*, 36 Cal. 2d 116, 222 P.2d 433 (1950); *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474 (Dist. Ct. App. 1947); *Hemingway v. Film Alliance of the United States, Inc.*, 174 Misc. 725, 21 N.Y.S.2d 827 (Sup. Ct. 1940).

to fall within the former category, and is denied registration, even though it has acquired secondary meaning.<sup>38</sup>

The basis for this distinction is the overriding public policy of preventing a monopoly and of insuring the public's right to call a product by the only name it has.<sup>39</sup> This reasoning appears to be sound, for the persuasive scope of the protection conferred by the Lanham Act would effectively remove the title from the public domain for an indefinite period.

These objections disappear, however, when titles to a series of books are an issue. A series title is not the name of any one book and is therefore not in any sense descriptive of it. On the contrary, it performs a legitimate trademark function by indicating that each book in the series originates from the same source, the publisher. Consequently, they have been analogized to titles of periodicals, and have been declared registrable.<sup>40</sup>

Magazine and newspaper column titles, however, like individual book titles, are denied registration; but several different considerations are involved.

#### B. *Newspaper and Magazine Column Titles*

1. *Generally.* — Although titles of newspapers and magazines are registrable under the Lanham Act, titles to columns or sections contained therein are not similarly protected, primarily because they are not "goods" for purposes of the act. For a trademark to function as such, it must be used by the publisher to identify his goods and to distinguish them from those of others.<sup>41</sup> Ordinarily, newspapers and magazines, and not the particular parts thereof, are considered "goods." Consequently, before they can qualify as "goods," the publisher must show that the column or section title was adopted to distinguish it from those of another's magazine, and overcome the inference that it was adopted merely to distinguish sections within his own magazine.

Clearly a particular section or column may be so advertised and promoted that the public will become aware of it as a separate commodity.<sup>42</sup> Once this is established, however, the publisher must further show that the title is not merely descriptive, but has attained such distinctiveness that a reader associates the title and thus the magazine with the publisher.

To establish such distinctiveness would be difficult in light of the *In re Cooper* interpretation of "descriptive," for such a title is also the name of the article, and therefore descriptive of it. Nevertheless, since most promoted columns or sections relate to series, analogy can be made to the series title of a set of books, thus evading the *In re Cooper* problem.

38. *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961); *accord*, *DeWalt Inc. v. Magna Power Tool Corp.*, 289 F.2d 656 (C.C.P.A. 1961).

39. *DeWalt Inc. v. Magna Power Tool Corp.*, 289 F.2d 656 (C.C.P.A. 1961).

40. *In re Cooper*, 254 F.2d 611, 615 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840 (1958).

41. *In re Broadcasting Publications, Inc.*, 135 U.S.P.Q. 374 (P.O. TM. T. App. Bd. 1962); *Ex parte Meredith Publishing Co.*, 109 U.S.P.Q. 426 (Comm'r Pat. 1956).

42. *Hancock, Notes from the Patent Office*, 53 T.M.R. 568 (1959).

2. *Author's Name as a Title.* — A separate problem with respect to the registration of newspaper and magazine column titles occurs when the title is the author's name or pseudonym, which is the case with a number of syndicated columns. A mark consisting of a name is denied registration as a trademark, since it comes within the specific exclusion in section 2(e)(3) of the Lanham Act<sup>43</sup> which denies registration to a mark that "is primarily merely a surname." This represents a change from the previous act, which provided that a mark "merely in the name of an individual" was not registrable,<sup>44</sup> and thus excluded both a full name and a surname. Since the legislature changed the exclusion to "primarily merely a surname" under general construction principles, this legislative change necessarily implies a different intention as to the registrability of names.

The word "primarily" indicates a name clearly recognized as a family name, as distinguished from a word which has a number of other connotations; and the decisions substantiate this interpretation. In one recent case,<sup>45</sup> the word "Rivera" as a trademark for watches was granted registration because the purchasing public would not attach a surname significance to it. Similarly, the name "Douglas" was held not to be "primarily merely a surname" because it has many other possible meanings.<sup>46</sup>

While it would seem that the word "merely" in the statutory phrase should be given its clear dictionary meaning, that is, "only" or "exclusively"<sup>47</sup> the decisions are ambiguous on this point. Applications for trademark registration of a full name rather than merely a surname primarily recognized as such have generally been denied,<sup>48</sup> although the case of *Ex parte Dalliox*<sup>49</sup> did allow registration of "Andre Dalliox" on the grounds that the surname was not a dominant part of the work. However, a later case expressed doubt whether a mark composed of a christian name and a surname, whether a pseudonym or not, was registrable.<sup>50</sup> Thus, the courts are presently interpreting "primarily merely a surname" as excluding from registration not only a surname, but also the name of an individual if the surname contained therein has primary significance to the consumer public as such.

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43. 60 Stat. 427 (1946), 15 U.S.C. § 1052(e)(3) (1964).

44. TRADE-MARK ACT § 5, 33 Stat. 724 (1905).

45. *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. 145 (Comm'r Pat. 1955); See Note, 24 GEO. WASH. L. REV. 368 (1955).

46. *Ex parte Omaha Cold Storage Co.*, 111 U.S.P.Q. 189 (Comm'r Pat. 1956). The court did not elaborate on the other meanings of "Douglas."

47. This argument is justified since there was no discussion in the hearing on the Lanham Act about the word "merely." Marks, *Personal Names As Trade-Marks*, 35 CHI. B. REC. 417 (1954).

48. *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32 (D.C. Cir. 1953), *cert. denied*, 346 U.S. 829 (1953) (J. C. Higgins); *Kimberly-Clark Corp. v. Marzall*, 94 F. Supp. 254 (D.D.C. 1950), *aff'd*, 196 F.2d 772 (D.C. Cir. 1952) (combination of Kimberly-Clark).

49. 83 U.S.P.Q. 262 (Comm'r Pat. 1949).

50. *Caralfoil-Silverman Co. v. Julette Originals*, 99 U.S.P.Q. 142 (C.C.P.A. 1953) (Paula Dean Originals).



A determination that a mark is "primarily merely a surname" does not preclude registration if it has acquired the requisite distinctiveness<sup>51</sup> or secondary meanings.<sup>52</sup> It must be established, however, that the significance attached to the mark by the consuming public relates to the origin or source of the product,<sup>53</sup> rather than to the product itself.<sup>54</sup> The mark must indicate to the public that the product was produced by a single manufacturer, although his personal identity need not be known.<sup>55</sup> Where the author is considered the source, the prevailing interpretation appears to be that his pseudonym is incapable of acquiring a secondary meaning in connection with literary property.<sup>56</sup> Consequently, the courts have held that the use of an author's pseudonym as a title is not a trademark use.<sup>57</sup>

Establishing the secondary meaning of an author's name as a column title presents a different problem where the publisher, rather than the author, is considered the source of the article. Normally, the reading public would not associate an author's pseudonym with the publisher of the newspaper or magazine in which the column appeared. However, many columns titled with the author's name are syndicated and sold to individual publishers, and it is the syndicate which is seeking registration. In such cases, the relevant consideration is not the reading public's association of the mark with the publisher, but the significance of the name to the purchaser of the column, that is, the individual newspaper publishers.<sup>58</sup> This association may be more readily proved than any between the author's name and the publisher which might be made by the reading public.

A final reason for denying trademark registration to the titles was stated by the court in *Application of Cooper* as follows: "It is well known that rights in book titles are afforded appropriate protection under the law of unfair competition."<sup>59</sup> The scope of that protection must now be explored.

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51. 60 Stat. 427 (1946), 15 U.S.C. § 1052(f) (1964):

[N]othing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicants' goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of filing of the application for its registration.

52. *Grove Laboratories, Inc. v. Approved Pharmaceutical Corp.*, 149 F. Supp. 86 (N.D.N.Y. 1957).

53. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961).

54. This is a question of fact. *Travel Magazine, Inc. v. Travel Digest, Inc.*, 191 F. Supp. 830 (S.D.N.Y. 1961); *Morse-Starrett Products Co. v. Steccone*, 86 F. Supp. 796 (N.D. Cal. 1949), *appeal dismissed*, 191 F.2d 197 (9th Cir. 1951).

55. *Saalfeld Publishing Co. v. G.&C. Merriam Co.*, 238 Fed. 1 (6th Cir. 1917), *cert. denied*, 243 U.S. 651 (1917).

56. *Chamberlain v. Columbia Pictures Corp.*, 186 F.2d 923 (9th Cir. 1951).

57. *Richardson v. Norcross*, 80 F. Supp. 799 (D.D.C. 1948).

58. *Ex parte Checker Cab Mfg. Corp.*, 99 U.S.P.Q. 480 (Comm'r Pat. 1953). The court held that in determining whether the trademark on the cabs indicates origin, the question is not what the mark means to the riding public, but what it means to the purchasers of taxi-cabs. *Accord, Ex parte Gulf States Paper Corp.*, 101 U.S.P.Q. 464 (Comm'r Pat. 1954).

59. 254 F.2d 611, 617 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840 (1958).

## III. UNFAIR COMPETITION IN TITLE CASES

Since titles are neither trademarkable nor copyrightable under the federal acts, an action for infringement is clearly precluded. Thus, the only existing protection afforded titles emanates from state laws of unfair competition. Although not delineable into one clear theory,<sup>60</sup> state statutes can be treated in two categories designed to prevent two distinct unfair practices. Statutes in the first category are designed to prevent<sup>61</sup> the passing off or palming off of one's goods as those of another and to protect the public against confusion as to the source of the product and the manufacturer against loss of good will.<sup>62</sup> The laws of unfair competition also encompass inverse passing off, the tort of misappropriation. It exists in situations where one appropriates another's endeavors for his own benefit, and is designed to prevent a competitor from reaping a harvest he has not sown.<sup>63</sup> Literary titles have been afforded some measure of protection from passing off,<sup>64</sup> but not from misappropriation.<sup>65</sup>

A. *Passing Off*

The common law tort of passing off, as applied to a title case, prevents a competitor from using a duplicate or similar title which would give rise to the likelihood of public confusion as to the source of the work. In order to establish that title simulation will cause confusion as to source, a plaintiff generally must show a secondary meaning or source association of his title.<sup>66</sup> To acquire such an association, a title, initially denied exclusive use because geographically or characteristically descriptive, becomes associated in the consumer's mind with its source.<sup>67</sup> To the consumer, the publication bearing that title originates from a single source, although the particular source need not be identified.<sup>68</sup>

A variant of this approach, the stricter source motivation test, was propounded by Judge Learned Hand in *Crescent Tool Co. v. Kilborn &*

60. In some states, passing off is the rule of law of unfair competition itself. 1 CALLMAN, UNFAIR COMPETITION AND TRADE-MARKS § 4.1 (2d ed. 1950).

61. These terms are used interchangeably to designate the same unfair practice.

62. See *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916); *Shaver v. Heller & Merz Co.*, 108 Fed. 821 (8th Cir. 1901).

63. *International News Serv. v. Associated Press*, 248 U.S. 215 (1918).

64. *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934) (protected movie title *Gold Diggers*); *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939) (passing off book title *Stella Dallas*); *Hemingway v. Film Alliance of the United States, Inc.*, 174 Misc. 725, 21 N.Y.S.2d 827 (Sup. Ct. 1940) (protected play title *The Fifth Column*).

65. *Gotham Music Service, Inc. v. Denton & Haskins Music Publishing Co., Inc.*, 259 N.Y. 86, 181 N.E. 57 (1932) (The court refused to protect the song title *Saint James' Infirmary* from misappropriation).

66. Some courts do not require the establishment of secondary meaning in order to prove likelihood of confusion. *Perfectform Corp. v. Perfect Brassiere Co.*, 256 F.2d 736 (3d Cir. 1958), *cert. denied*, 358 U.S. 919 (1958); *Avon Periodicals, Inc. v. Ziff-Davis Publishing Co.*, 282 App. Div. 200, 122 N.Y.S.2d 92 (1953).

67. *G.&C. Merriam Co. v. Saalfeld*, 198 Fed. 369, 373 (6th Cir. 1912).

68. *Saalfeld Publishing Co. v. G.&C. Merriam Co.*, 238 Fed. 1 (6th Cir. 1917), *cert. denied*, 243 U.S. 651 (1917).

*Bishop Co.*<sup>69</sup> This test was enunciated in a product simulation case and requires a showing not only that the public believes the product to derive from one source, but also that they are motivated to purchase it primarily because of that source.<sup>70</sup> Although source association implies source motivation, the effect of Judge Hand's test is to increase the burden on the plaintiff to establish that the public desires to purchase his product primarily because he makes it.<sup>71</sup> However, the *Crescent* formulation has received only limited approbation in the courts, and does not appear to operate in the title area outside the Second Circuit.

The courts do not vary greatly on the definition of secondary meaning, except insofar as the source association and the source motivation tests differ. Divergence does occur, however, when these tests are applied to the facts of a particular case.

The length of time necessary to acquire secondary meaning does not conform to a set standard, although in practice a certain period of time may become standardized for a factually similar class of cases. For example, titles of plays have received notable success in acquiring the requisite secondary meaning in a limited time,<sup>72</sup> even though the additional elements of advertisement, promotion, and popularity perhaps play a significant part. Book titles, on the other hand, have enjoyed somewhat lesser success, presumably due to the length of time necessary to popularize a book.<sup>73</sup> Extensive advertising and title exploitation prior to the release of a literary product are not, however, necessarily determinative of secondary meaning,<sup>74</sup> just as prior usage does not prevent a subsequent user from acquiring the requisite source association for the same title, since secondary meaning is based solely upon the public's association.<sup>75</sup>

Secondary meaning is designed to illustrate a source significance in order to establish likelihood of public confusion.<sup>76</sup> The ultimate requirement for relief, likelihood of confusion, depends upon a number of factors.

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69. 247 Fed. 299 (2d Cir. 1917).

70. *Id.* at 300.

71. For a more extensive discussion of the *Crescent* formulation, see *Developments in the Law — Competitive Torts*, 77 HARV. L. REV. 888, 912-15 (1964).

72. *Hemingway v. Film Alliance of the United States, Inc.*, 174 Misc. 725, 21 N.Y.S.2d 827 (Sup. Ct. 1940) (secondary meaning of the play *The Fifth Column* was established in two and one-half months). In *Jackson v. Universal International Pictures, Inc.*, 36 Cal. 2d 116, 222 P.2d 433 (1950), secondary meaning was attached to the play *Slightly Scandalous* in three weeks. Curiously, the court declared that neither the size of the public making the required association nor the popularity of the play determines the acquisition of secondary meaning.

73. *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474 (1947) (secondary meaning acquired in two years). However, in *Collins v. Metro-Goldwyn Pictures Corp.*, 255 F. Supp. 781 (S.D.N.Y. 1938), *rev'd on other grounds*, 106 F.2d 83 (2d Cir. 1939), the use of the book title *Test Pilot* for three years did not establish secondary meaning. Likewise, in *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 295 P.2d 62 (1956), seven years was insufficient.

74. *Walt Disney Productions, Inc. v. Souvaine Selective Pictures, Inc.*, 98 F. Supp. 774 (S.D.N.Y. 1951), *aff'd*, 192 F.2d 856 (2d Cir. 1951).

75. The test enunciated in *G.&C. Merriam Co. v. Saalfeld*, 198 Fed. 369 (6th Cir. 1912), indicated the necessity of exclusiveness of use. This element is inconsistent with the conceptual basis of secondary meaning, and is not a defense to an infringement action. *Golenpaul v. Rosett*, 174 Misc. 114, 18 N.Y.S.2d 889 (Sup. Ct. 1940).

76. It is only necessary to show likelihood of confusion rather than actual confusion.

Obviously, the competing title must be confusingly similar in appearance, pronunciation, and color. Differences in appearances, such as spelling, may be overcome by similar pronunciation, and vice versa. A striking difference in color can also prevent confusion. The weight to be given these indicators depends in part upon how discerning the purchasing public is with respect to the particular product.<sup>77</sup> Most book purchasers, for instance, are more particular than people buying candy, and, therefore, a book title must conform to a higher standard of similarity.

Likelihood of confusion by title duplication can be avoided by employing reasonable precautions. In one case,<sup>78</sup> advertising made it abundantly clear that the defendants' movie was not based upon plaintiff's book, a factor which the court weighted heavily to support its conclusion that there was an absence of customer confusion.

Applying the standards of secondary meaning and likelihood of confusion, titles have received protection from passing off in the courts.<sup>79</sup>

### B. *Misappropriation*

The laws of unfair competition, once limited to the tort of passing off with its attendant objective of preventing consumer confusion, have been extended to include the tort of misappropriation, or inverse passing off. This doctrine, which is applicable to cases where a competitor "passes off" another's work as his own, received its first definitive statement in *International News Serv. v. Associated Press*.<sup>80</sup> INS, in order to curtail its news-gathering expenses, copied news bulletins both from AP's bulletin board and from the early editions of its member papers. Relying on the equitable foundations of the laws of unfair competition, the Court upheld an injunction preventing INS from appropriating AP's news until its commercial value had ceased. Mr. Justice Pitney, speaking for the majority, reasoned that AP had acquired a quasi-property right in the news it gathered for release, and INS's appropriation constituted a clear fraud upon AP's rights.<sup>81</sup> The Court thus included misappropriation, along with the existing unfair practice of misrepresentation or passing off, within the ambit of unfair competition.

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77. For an analysis, see 3 CALLMAN, UNFAIR COMPETITION AND TRADE-MARKS § 81.2 (2d ed. 1950).

78. *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 295 P.2d 62 (1956).

79. *Supra*, note 64.

80. 248 U.S. 215 (1918). *The Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916), normally cited to illustrate the misappropriation doctrine, was grounded on the likelihood of confusion which was not an element of the misappropriation doctrine set forth in the *INS* case, *supra*.

81. It is suggested that the core of the Courts' argument was pragmatic. Inevitably, if INS continued to appropriate AP news, it could undercut AP's price and cause a withdrawal of AP services leaving INS and the public without a source of news. *Developments in the Law — Competitive Torts*, 77 HARV. L. REV. 888, 934 (1964).

The misappropriation concept has received limited success in all but a few jurisdictions.<sup>82</sup> After *Erie v. Tompkins*,<sup>83</sup> federal courts were free to disregard the concept since the *INS* case was decided as a matter of federal common law, and they generally did so. Even in New York, where the misappropriation concept has received approbation in a wide variety of cases,<sup>84</sup> the courts have failed to apply that doctrine in the few decided title cases.<sup>85</sup> In *Gotham Music Serv., Inc. v. Denton Haskins Music Publishing Co.*,<sup>86</sup> the plaintiff up-dated the song *Gambler's Blues* and re-titled it *St. James Infirmary*. After extensive advertisement, the latter version became popular. Defendant released the same song under both titles, obviously taking advantage of plaintiff's advertising campaign. The court refused to grant an injunction because of plaintiff's failure to establish a secondary meaning for the title, a requirement it deemed essential for relief under its unfair competition laws. The dissenting opinion, which contended that relief should be granted under the misappropriation doctrine in the *INS* case, left no doubt that the court deliberately failed to discuss that concept.<sup>87</sup> The federal courts in the Second Circuit have likewise failed to prevent title appropriation under the *INS* doctrine.<sup>88</sup>

The above survey indicates that titles have received at least some degree of protection under unfair competition doctrines. The continuing extent of that protection must be evaluated, however, in light of the *Sears* and *Compo* cases.

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82. A number of jurisdictions have rejected the doctrine all together, e.g., *Addressograph-Multigraph Corp. v. American Expansion Bolt & Mfg. Co.*, 124 F.2d 706 (7th Cir. 1941); *Triangle Publications, Inc. v. New England Newspaper Publishing Co.*, 46 F. Supp. 198 (D. Mass. 1942).

83. 304 U.S. 64 (1938).

84. *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133 (1921) (use of cartoon characters); *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 279 App. Div. 632, 107 N.Y.S.2d 795 (1951) (record duplication); *Dior v. Milton*, 9 Misc. 425, 155 N.Y.S.2d 443 (Sup. Ct. 1956), *aff'd*, 2 App. Div. 2d 878, 156 N.Y.S.2d 996 (1956) (pirating of dress designs).

85. It appears from a cursory glance that the court in *Avon Periodicals, Inc. v. Ziff-Davis Publishing Co.*, 282 App. Div. 200, 122 N.Y.S.2d 92 (1953), granted relief on the basis of misappropriation. Although the title of the plaintiff's magazine had not acquired secondary meaning, the court held that defendant's magazine was similar, and public confusion was likely to result. This holding is an adjunct of the passing off doctrine which relies on public confusion rather than the misappropriation doctrine which relies solely on appropriating another's commercial advantage, regardless of fraud on the public. See *Speedy Prods., Inc. v. Dri Mark Prods., Inc.*, 271 F.2d 646, 650 n.1 (2d Cir. 1959). The case of *McGraw-Hill Book Co. v. Random House, Inc.*, 32 Misc. 2d 704, 225 N.Y.S.2d 646 (Sup. Ct. 1962), however recognized the application of misappropriated doctrine in a title area, but in that case there was no evidence of appropriation.

86. 259 N.Y. 86, 181 N.E. 57 (1932).

87. The rationale behind the majority's decision in *Gotham* balances the public's interest with that of the defrauded manufacturers. Since the song *Gambler's Blues* was in the public domain, the name of the song, the title, was also in the public domain. However, the plaintiff was seeking to regain the exclusive use of *St. James' Infirmary*, not *Gambler's Blues*.

88. *Shapiro, Bernstein & Co. v. Goody*, 248 F.2d 260, 268 (1957), *cert. denied*, 355 U.S. 952 (1958). "Titles are protected only to the extent necessary to prevent confusion on the part of the public as to the identity of the composition covered by the title." *Walt Disney Prods., Inc. v. Souvaine Selective Pictures, Inc.*, 98 F. Supp. 774 (S.D.N.Y. 1951), *aff'd*, 192 F.2d 856 (2d Cir. 1951).

IV. IMPACT OF *Sears* AND *Compco* ON TITLE PROTECTIONA. *The Decision of the Court*

The Supreme Court, in *Sears, Roebuck & Co. v. Stiffel Co.*<sup>89</sup> and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>90</sup> concluded that certain aspects of the state laws on unfair competition are preempted since they conflict with federal policy. It is necessary to consider the impact of these decisions upon the laws of unfair competition.

In *Sears*, plaintiff alleged that defendant had marketed a pole lamp which copied the non-functional features of plaintiff's lamp, thereby infringing upon the latter's patent and causing confusion in the trade as to source. The district court invalidated the patents for want of invention, but nonetheless found defendant guilty of violating Illinois unfair competition laws on the ground that confusion was likely to result, even though no secondary meaning had been established. The Supreme Court reversed, holding that a state may neither prohibit the copying of an article, unpatented and uncopyrighted, nor award damages for such copying.

In the *Compco* case, plaintiff alleged that defendant copied his patented lighting fixture. The district court likewise invalidated the patents for lack of invention, but again found the defendant guilty of engaging in unfair competition. However, unlike the *Sears* case, secondary meaning was held to have been established. The Supreme Court again reversed, holding that a state cannot hold a copier of an unpatented article accountable in damages for failure to prevent consumer confusion, except to the extent that such failure violated state statutory or decisional law requiring labeling or some other precautionary measure.

B. *Applicability to Copyright*

In essence, the court determined from the persuasive nature of the patent clause that it necessarily preempts state law in the area,<sup>91</sup> since Congress exhausted its full constitutional authority to protect inventiveness when it passed the Patent Act, the standards of patentability necessarily correspond to the standards of inventiveness under the patent clause.<sup>92</sup> Consequently, articles such as those in *Sears* and *Compco* which fail to qualify for federal protection are beyond the realm of permissible state regulation.<sup>93</sup>

Mr. Justice Black's opinion proceeded on the theory that the patent clause struck a tenuous balance between the competitive policies expressed

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89. 376 U.S. 225 (1964).

90. 376 U.S. 234 (1964).

91. The Court ascribes to Congress the intention to have a uniform federal system of patents and copyrights from the exclusive jurisdiction to hear copyright and patent cases granted to the federal court. 376 U.S. 225, 231 n.7 (1964).

92. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

93. This theory of constitutional preemption is not new, but it is only occasionally used. An example of its use is in the maritime law dealing with workmen's compensation. *Southern Pac. Co. v. Jensen*, 244 U.S. 205 (1917).

in the anti-monopoly laws and the public's interest in securing continuous progress in the arts and sciences. As any variations engendered by state laws would necessarily disturb this equilibrium in contravention to the constitutional mandate, the states must be barred from affecting the scope of this federally-sanctioned monopoly.

Although the *Sears* and *Compco* decisions specifically involved unpatented articles, the rationale of those cases clearly requires that a similar result obtain in the copyright area,<sup>94</sup> at least with respect to published works.<sup>95</sup> Any extension of the scope of protection afforded authors under federal law would represent an independent determination by the states of the circumstances sufficient to justify withholding a work from the public domain.

### C. *The Permissible Scope of Continued State Regulation*

Mr. Justice Black, speaking for the Court in the *Sears* case, carved out an exception to the otherwise pervasive preemption of *Sears* and *Compco*:

Doubtless a State may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source, just as it may protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods.<sup>96</sup>

In effect, then, while the states are powerless to prevent simulation of an article or literary work, they remain free to impose labeling requirements in order "to prevent customer confusion." Nor do these decisions in any way impugn the states' continued competence to prohibit a manufacturer from passing off his goods by duplicating another's mark or label and thereby cause customer confusion.<sup>97</sup>

94. In *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348, 350 n.1 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1964), the court stated: "The principles announced in *Sears* and *Compco* . . . are equally applicable to patent and copyright law." However, unlike the relationship between the Patent Act and the patent clause, there is a gap between a work which is copyrightable as a writing under the Copyright Act and one which is a copyrightable as a writing within the copyright clause. Some articles, such as phonograph records, have been declared a writing within the copyright clause, but too lacking in originality to be afforded protection under the Copyright Act. 1965 COPYRIGHT LAW REVISION 3.

95. *Supra*, note 23.

96. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964).

97. Mr. Justice Black elaborated upon the states' retention of power in the trademark and labeling area in the *Compco* case:

A State of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer's reputation for quality and integrity, deceive the public by palming off their copies as the original. . . . And of course a State cannot hold a copier accountable in damages for failure to label or otherwise to identify his goods unless his failure is in violation of valid state statutory or decisional law requiring the copier to label or take other precautions to prevent confusion of customers as to the source of the goods.

376 U.S. 234, 238-39 (1964). In a footnote to this language (376 U.S. at 239 n.5), Mr. Justice Black pointed out that no such law requiring labeling exists at the present time in Illinois.

It has been pointed out that sanctioning state-imposed labeling requirements in the copyright area does not significantly undermine the Court's competitive objectives; for a copier's otherwise unqualified right to use an uncopyrighted work is only limited in situations where there is a likelihood of consumer confusion with regard to the simulated article.<sup>98</sup> Indeed, it might well have the effect of encouraging a copier to improve upon the copy in order to enhance his own reputation.

#### D. *Subsequent State Court Decisions*

Since states may thus "prevent customers from being misled as to source," it becomes necessary to determine what factors must be established to demonstrate the existence of such confusion. One possibility is to regard secondary meaning — the source association previously regarded as essential to proof of customer confusion where non-technical marks were concerned — as a necessary prerequisite. Such an approach would afford some limited protection to consumers without seriously infringing upon federally-created uniformity, and appears to have found the greatest acceptance with the courts.

This position is illustrated by the recent decision of *Spangler Candy Co. v. Crystal Pure Candy Co.*,<sup>99</sup> where the manufacturer of "Dum-Dums" lollipops sued to enjoin usage of similar packaging under the name of "Pop-Pops." The same court which had granted relief in the *Sears* case in the absence of secondary meaning<sup>100</sup> denied the injunction against defendant's alleged passing off on the grounds that secondary meaning had not been established. In thus interpreting *Sears* as indicating that the only interest against which a manufacturer can claim protection is customer confusion, the court impliedly abolished the tort of misappropriation.

Similarly, the Seventh Circuit,<sup>101</sup> although not specifically requiring secondary meaning, determined that no unfair competition existed after *Sears* and *Compco* unless there was passing off or an attempt to deceive or mislead the public as to origin.

Other federal courts, however, continue to grant relief for the tort of misappropriation. This position was adopted by the Second Circuit in *Flexitized, Inc. v. National Flexitized Corp.*,<sup>102</sup> where it was held that *Sears* and *Compco* did not preclude a state from granting protection to a mark misappropriated by another. The court declared that existing state law was still controlling, and that the New York courts could continue to apply the misappropriation doctrine of the *INS* case by distinguishing between copying an idea and producing a product, and appropriating that

98. Note, 40 N.Y.U.L. Rev. 101, 123 (1965), contains an excellent discussion of the impact of *Sears* and *Compco*.

99. 235 F. Supp. 18 (N.D. Ill. 1964), *aff'd*, 147 U.S.P.Q. 434 (1965).

100. The District Court's opinion is summarized in *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115, 116-17 (7th Cir. 1963), *rev'd*, 376 U.S. 225 (1964).

101. *Aerosol Research Co. v. Scovill Mfg. Co.*, 334 F.2d 751, 757 (7th Cir. 1964).

102. 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965).



product initially. As no fraud or deception upon the public need be established according to those cases, secondary meaning was irrelevant.

Two recent decisions typify this approach; in one,<sup>103</sup> defendant record company reproduced a Beatle tune from plaintiff's recording, while in another,<sup>104</sup> a substantial segment of a motion picture exclusively licensed to plaintiff's television station was exhibited on defendant's station. Characterizing these acts as appropriation rather than copying, the courts granted the requested relief on the basis of the *INS* doctrine. While the courts were no doubt appalled by actions amounting almost to thievery, their granting of relief under the misappropriation doctrine virtually granted copyrights to the defendants and directly contravened the mandate of *Sears and Compco*.<sup>105</sup>

#### E. *Continuing State Competence to Regulate Titles*

Applying the majority position to the area of literary works, and more particularly individual titles, it appears that the states may not prohibit the copying of an uncopyrighted or uncopyrightable work, as was previously accomplished by both the misappropriation and passing off doctrines. It would seem, however, that they do retain the power to prevent an author from passing off his work by utilizing another's title where that title has acquired secondary meaning, although the type of relief is now limited. Since a title is the only name for the work, the states should be limited to setting labeling requirements in order to prevent the likelihood of customer confusion. As titles are not copyrightable, to allow the states to prohibit a copier from using another's title would be to sanction a monopoly not condoned by the Copyright Act. Preventing a copier from using a title which constitutes the only name of a work would effectively preclude him from marketing his copy.

### V. ADVISABILITY OF AMENDING THE COPYRIGHT ACT

The restrictive effect of *Sears and Compco* upon title protection by the states makes it clear that the only possible source of more effective safeguards lies with federal trademark or copyright legislation. The former appears extremely unlikely, however, in light of the several objections to allowing both to operate with respect to titles.

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103. *Capitol Records, Inc. v. Greatest Records, Inc.*, 43 Misc. 2d 878, 252 N.Y.S.2d 553 (Sup. Ct. 1964).

104. *Flamingo Telefilm Sales, Inc. v. United Artists Corp.*, 22 App. Div. 778, 254 N.Y.S.2d 36 (1964).

105. *Accord*, Treece, *Patent Policy and Preemption: The Stiffel and Compco Cases*, 32 U. CHI. L. REV. 80, 94 (1964); Chafee, *Unfair Competition*, 53 HARV. L. REV. 1289, 1318 (1940); 1965 COPYRIGHT LAW REVISION 85: "In some States it [unfair competition] was greatly broadened to become, under the name misappropriation, the virtual equivalent of a copyright; and it has been cut back, by the Supreme Court's decision in *Sears, Roebuck & Co. v. Stiffel Co.*, to the traditional concept of passing off."

Since a copyright is of limited duration,<sup>106</sup> while the only limit on trademarks is use, trademark protection would deprive the public of the right to call the copy by the only name it has, even after the copyright had expired.<sup>107</sup> Thus, the originator would in effect be granted a monopoly, a result specifically foreclosed by the policy considerations of *Sears and Compco*.

Copyright protection of original titles, on the other hand, along with the work itself, would give an author the opportunity to exploit his title during the copyright period while preserving the public's right to thereafter call the copy by its name. Allowing an author to profit from his endeavors to the exclusion of others should meet with no objection so long as it does not prejudice the public interest. Indeed, such an approach has been adopted in a number of foreign jurisdictions to circumvent possible conflict between the two statutes.<sup>108</sup>

Extension of copyright protection to original titles, however, raises a number of problems, the most significant of which is the constitutionality of such legislation. It is submitted that the modification of the *Trade-Mark* cases affected by *Bleistein* has placed original titles within the copyright clause, while leaving them beyond the scope of the present Copyright Act. Under this analysis, Congress could constitutionally amend the existing act to encompass titles.

A further objection is that registration of titles would substantially increase the administrative burden on the Copyright Office.<sup>109</sup> But against this position must be balanced the fact that if titles were to become registrable, it is probable that application for a title copyright would be required to coincide with the application for copyright of the work itself; thus, the added burden on the Copyright Office would be minimal.

Finally, it has been argued that copyright of titles would secure monopolies in words and phrases and remove them from the English language.<sup>110</sup> This position fails to consider the fact that a copyright protects only the form and manner of stating particular words, not the words and phrases themselves.<sup>111</sup> Another author would remain free to utilize such words, although not in the precise order as the originator.

Unfortunately, the proposed copyright law revision will exclude titles as copyrightable subject matter.<sup>112</sup> This bill, initially proposed by the

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106. The duration of a copyright is twenty-eight years with a twenty-eight year renewal option. 17 U.S.C. § 24 (1964). The copyright revision bill proposes to change the duration to the life of the author and 50 years after his death. 1965 COPYRIGHT LAW REVISION § 234.

107. Application of Cooper, 254 F.2d 611, 616 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840 (1958).

108. See Klein, *Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy?*, 28 BROOKLYN L. REV. 59, 91-93 (1961).

109. WARNER, RADIO AND TELEVISION RIGHTS, § 243, 1055 (1953).

110. *Ibid.*

111. Netterville & Hirsch, *Piracy and Privilege in Literary Titles*, 32 So. CAL. L. REV. 101, 110 (1959).

112. 1965 COPYRIGHT LAW REVISION §§ 102-03.

Register of Copyrights, is designed to make it clear that while the pre-emption established by *Sears* and *Compco* does not preclude state remedies that are different in nature from copyright, such as the unauthorized use of the title of a work in such a way as to constitute passing off or fraud,<sup>113</sup> it does exclude protection from misappropriation, the virtual equivalent of a copyright.<sup>114</sup>

## VI. CONCLUSION

The effect of the *Sears* and *Compco* decisions under the preceding analysis, is to preclude the states from enjoining misappropriation while leaving them free to prevent passing off where customer confusion is likely. The permissible remedy, however, is not to enjoin the copier's usage of the originator's title, but rather to require him to label his copy so as to obviate confusion as to source. Thus, the already limited protection afforded titles has been further diminished.

Nor is there any immediate likelihood of an amendment to the present Copyright Act which would bring titles under the mantle of federal protection. Indeed, the proposed bill now under consideration makes no mention of the title area.

Nonetheless, it appears that authors are presently being denied protection of an extremely valuable product, and one which in many instances is highly original.

*Peter C. John*

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113. 1965 COPYRIGHT LAW REVISION 84-85.

114. *Ibid.*