

The newsletter for the publishing sector



Welcome to the Summer issue of FairCopy. We hope you find it relevant and interesting, and welcome any feedback or suggestions for other topics you would like to see addressed in future issues.

WHAT'S IN A NAME?

Generally speaking, book and other literary titles will not, in their own right, qualify as literary works capable of copyright protection under English law. This is largely due to the fact that they are not deemed to possess the requisite degree of originality required for copyright protection, irrespective of the (often significant) amount of skill, labour and judgement exercised in their creation. Although the legal justification for this status quo may on occasion be questionable, the underpinning policy is clear – allowing an automatic and unrestricted copyright monopoly for a specific word or phrase is not practical or in the public interest.

All is not lost for those looking to safeguard their titles, however, as alternative methods for protecting and enforcing rights in titles are available in certain circumstances, principally under trade mark law (in respect of registered trade marks) and the common law tort of passing off (in respect of unregistered rights). This article focuses on registered trade mark protection.

Literary Titles as Registered Trade Marks

Registering a trade mark affords the trade mark owner the exclusive right to exploit the mark in respect of the goods (and/or services) for which it is registered. The trade mark owner can prevent others from using identical or similar marks in respect of identical, similar (or even under certain circumstances, dissimilar) goods or services. When used, managed and maintained correctly, registered trade mark protection can potentially last indefinitely: unlike other forms of intellectual property, there is no limitation on the number of times

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a registered trade mark can be renewed and no fixed statutory term. Consequently, where a book or other literary title qualifies for registered trade mark protection, such protection will have the potential to outlast the finite copyright protection enjoyed by the title's content. The possibility, through trade mark registration, of preventing others from publishing out-of-copyright works under their original title (or even a similar title), is clearly a potentially attractive proposition for publishers and other rights owners.

Generally speaking, a trade mark is a badge of origin. Securing registered trade mark protection for book and other literary titles is, therefore, not straightforward. Titles are often referential or allusive to content, and as such are rarely (at least from the outset) perceived by the purchasing public as identifying or alluding to commercial source. This holds particularly true of non-fiction publications. The function of determining commercial origin for a publication is instead traditionally achieved through alternative means, such as branding with the publisher's name and/or imprint.

Non-distinctive and/or descriptive titles will therefore not *prima facie* qualify for registered trade mark protection, as they are deemed to be inherently devoid of a trade mark function. However, where one can show that a title (post-launch) has acquired a distinctive character and a secondary brand meaning by virtue of its use and promotion in the marketplace, it may then qualify for registration (and also potentially protection as an unregistered trade mark under the common law right to prevent others passing off their goods as yours).

Proving a title's notoriety and elevation to a brand status can be achieved through a variety of means, including evidence of sales revenue, marketing activities, ancillary product offerings, commercial spin-offs (such as films or television programmes), related merchandising activities and consumer surveys. Evidently, larger publishers with significant marketing budgets and extensive distribution channels will find it easier to gather and produce such evidence than their smaller and less well resourced counterparts.

Whilst it is arguably easier to demonstrate the attainment of a secondary brand meaning where the aim of the title is itself to establish a branded series originating from a single source (e.g. THE ROUGH GUIDE® series of books or any well-known magazine, journal or other periodical title), successful one-off titles, such as GONE WITH THE WIND®, are also capable of becoming so widely recognised that they become acknowledged as a brand capable of registration as a trade mark.

Where a book or literary title has been successfully registered as a trade mark, it is important that its exploitation is carefully monitored and controlled. Any unauthorised third party use

should be promptly and appropriately dealt with so as to ensure that the title does not develop into a common expression, thereby become misleading or generic: in such cases registered trade mark protection could be lost. According to the UK Intellectual Property Office ("UKIPO"), one such example may be SHERLOCK HOLMES (a registered Community trade mark for a range of goods and services, including books and other printed matter), which in the UKIPO's view "is a name that has been used by many traders over the years in order to describe a story and a character who appears therein. No one these days would expect all material bearing this name to originate from Conan Doyle or his estate". By contrast, in the UKIPO's opinion SPIDERMAN is a name that "appears to have been used by one party as a trade mark for magazines, [meaning that] the name may be capable of identifying the goods of one trader notwithstanding that it is also the name of a well known fictional character". The latter instance shows that maintaining exclusive ownership of the copyright or some other exclusive right to publish the printed material commonly associated with the title may be determinative.

Whilst it is not compulsory, those seeking to notify others of their exclusive rights in a book or other literary title should consider using the ™ symbol where the title is unregistered and the ® symbol where the title is registered.

The upside of all this is that in order fully to secure the rights in your titles and effectively prevent others from encroaching on such rights, you should (wherever possible) seek registered trade mark protection.

We offer a complete brand protection service that helps you identify and establish a tailored branding strategy to meet your business needs. For further information please contact Gavin Stenton on 01865 722106 or by email to gavin.stenton@manches.com



THE DISAPPOINTING DEFAMATION BILL

On 26 May 2010 the Defamation Bill received its first reading in the House of Lords. Those hoping for a radical change to the law will, however, have been left somewhat disappointed.

If passed, the Bill would give journalists greater leeway in making defamatory comments providing they can show that the matter is of public interest and they have acted responsibly: this in effect codifies the common law “Reynolds Defence”.

The wording of other defences have changed to make them more accessible: i.e. the defence of “fair comment” is to be called the “honest opinion” defence, while the justification defence is renamed the “truth” defence. Although each of these codifications reflects the current common law position, initially this would almost certainly make litigation more uncertain as the Court ascertains the precise parameters for these new terms.

The categories of statutory exemptions to responsibility for publication are extended by the Bill. There is now a formal exemption for merely facilitating publication (i.e. a person concerned only with transmission or storage but with no control over content) where the publication is removed within a certain period of time following notice to the facilitators. This would apply to ISPs, who already enjoy some such immunity under the provisions of the E-Commerce Directive, but who would now benefit from a grace period of 14 days from notification of the defamatory content before incurring liability. This is very different to the current position set out in the case law concerning ISPs, which in effect required immediate action by the ISP to avoid liability.

One area which the Bill would, if passed, clarify matters is in respect of the “single publication rule”. This effectively overturns the nineteenth-century case *Duke of Brunswick -v- Harmer*, which established that each fresh instance of material being accessed constituted a new publication – thereby giving rise to a new cause of action and restarting the limitation period. While this may have been practicable in the Duke’s time (the case concerned the accessing of defamatory material through the British Library by the Duke’s manservant), in the modern information society it is not; the Bill sensibly proposes that the first date of publication of material made available to the public or section of the public be the date from which the cause of action accrues.

The Bill would introduce the requirement that any body corporate seeking to pursue an action for defamation must show that the publication of the words or matters complained of has caused, or is likely to cause, substantial financial loss. This could prove

problematic for non-governmental and charitable organisations as it effectively treats reputation as a purely financial matter.

In a bid to prevent defamation laws being abused, the Bill would introduce an automatic early strike out of cases where a claimant cannot demonstrate that the relevant publication has caused or is likely to cause substantial harm to their reputation. While possibly freeing up Court time by reducing the number of unmeritorious claims that would otherwise make it to a full trial, this measure may well mean that litigation (for the claimant at least) becomes more costly and time consuming as substantial harm will need to be established before any other issues in a defamation claim are put forward, making it in effect a two-stage process.

Finally, an important change would be the removal of the presumption of a jury trial for defamation claims. A jury trial would still be available, but there would need to be a reason for it.

If introduced, the Defamation Bill would tidy up the current law by codifying numerous principles. It is reasonable to state, however, that it does not go far enough in some areas while creating potentially problematic issues in others.

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FOOTBALL FIXTURES TEST DATABASE COPYRIGHT

The High Court has ruled that fixture lists for the English and Scottish football leagues are protected by domestic database copyright law but not analogous European database provisions.

Background

In 1996 the European Database Directive created a new intellectual property right protecting databases where the creator had used substantial investment in obtaining, verifying or presenting the contents (the EDD Right). This right was totally separate to protection under existing national copyright law, under section 5.3A of the Copyright Designs and Patents Act 1988 (as amended) where a database is covered by copyright if the selection or arrangement of the contents is original and constitutes the author’s own intellectual creation (the CDPA Right).

The EDD Right had been considered by the European Court of Justice in 2004, when four cases were joined concerning sport scheduling. Three of the four cases were brought by Fixtures Marketing Limited (FML) – a sub-licensee of the English Football League at the time – and the fourth by the British Horseracing

Board (BHB) relating to racehorses and jockey lists. None of these cases referred to the CDPA Right. In the FML case it was held that the contents of a football fixtures list did not require any investment independent of that required for the creation of the data contained in that list and hence was not protected by the EDD Right. In the BHB case the judge determined that the list of riders and runners was not protected by the database right as this was a by-product simply devised once the principal task of organising the races had been conducted and that no independent investment was required.

The Dataco Case

The English and Scottish football leagues sued Brittens Pools, Yahoo! and Stan James (the gambling operator) for the use of its fixtures lists without a licence. The defendants argued that the fixtures lists deserved neither protection under the CDPA Right nor the EDD Right.

Mr Justice Floyd agreed with the reasoning in the FML and BHB cases and expressed that – despite the significant effort involved in deciding who will play when, where and against whom – there was no independent investment involved in the actual creation of the database and therefore the football fixtures were not covered by the EDD Right.

Justice Floyd did conclude, however that, the fixtures lists were covered by the CDPA Right and stated that the EDD Right case law could not automatically be applied to the CDPA Right. He found that they protected different things: the CDPA Right protecting creativity, the EDD Right protecting investment.

With regard to CDPA Right, Mr Justice Floyd set down a four-step test:

1. Identify the data collected and arranged in the database (here it was who, when and where English and Scottish football teams would be playing);
2. Analyse the work which goes into the collecting and arranging the data in the database (in this case, deciding which dates were used, which matches to be played on such dates, where such matches should be played, etc);
3. Ask whether the work on selection or arrangement was the author's own intellectual creation and, in particular, whether it involved the author's judgment, taste and discretion (it was held that that "at each stage there was scope for the application of judgement and skill" and that different individuals would come up with different date/team combinations); and
4. Ask whether the work is quantitatively sufficient to attract copyright protection (in the present instance, Justice Floyd held that the work involved to create the fixtures lists was not mere "sweat of the brow").

Implications

Reproducers of fixtures lists will now have to stop doing so without authorisation from their owners. If fixtures lists are reproduced, the reproducer will be charged a fee or need to convince the Court that one of the defences to copyright infringement applies. It should be noted, however, that this only applies to fixtures lists which are created using individual judgement and that the CDPA Right will not protect fixtures lists which are generated at random.

Case Reference: Football Dataco Ltd and others v Stan James (Abingdon) Ltd and others [2010] EWHC 841 (Ch)

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Manches is a leading law firm in Oxford, Reading and London. We advise clients on all areas of business law, including banking and asset finance, property, corporate, commercial litigation and dispute resolution, employment, intellectual property and technology law.

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