

The Society of Authors

84 Drayton Gardens, London SW10 9SB

Guide to the Protection of Titles

Passing Off

There is no copyright protection in a title. There are, however, occasions when the use of a title can be restrained if there is likely to be confusion. If B uses A's title so that people are likely to buy B's book when they intended to buy A's, or go to see B's play when they intended to see A's, proceedings for 'passing off' are likely to be successful. Much will depend on the nature of the rival works, the methods by which they are exploited, and the extent to which the title is essentially distinctive.

Titles have been classified as (1) purely descriptive, (2) truly 'fancy' and essentially distinctive, and (3) descriptive with an element of fancy or distinctiveness.

A purely descriptive title, e.g. *The Life of St. Paul* or *Company Law*, may be used with impunity by another writer. Truly fancy titles, such as *Moonraker* or *The Subtle Knife*, may not. Titles within the third class, descriptive with an element of fancy, are the most likely to lead to disagreements (e.g. *Splendid Misery*, *Where There's a Will There's a Way*, *The Younger Generation*, *Irish and Proud of It* and *The New Car*).

A title of this sort may be used by A, and then used again quite innocently by B. Unfortunately for B, ignorance is irrelevant. If, having regard to the character of the two works, the markets in which they circulate, and the reputation of the earlier one, people are likely to be deceived into buying B's work in the belief that it is A's or some adaptation of A's, the Court will grant an injunction and/or award damages. However, it is important to note that A has to produce evidence of actual (or likely) loss or damage – and this may not be easy if, for example, A's book is out of print.

A passing off action might also succeed if two works have a strong similarity of format (with the effect of deceiving the public) e.g. if a book by B is published with a cover closely resembling that regularly used on A's book.

Trademarks

A trademark is described by the Patent Office as 'an identification symbol which is used in the course of trade to enable the purchasing public to distinguish one trader's goods from the similar goods of other traders'. Trademark registration can be used to protect distinctive titles and characters (e.g. Harry Potter) and series, annuals, etc (e.g. *Teach Yourself*, and *Wisden*). Registration involves the payment of fees for seven years' protection initially, renewable indefinitely at 14-year intervals.

Protection is given for specific classes of goods (e.g. 'paper and printed matter') and it is an infringement of the mark to make unlawful use of it within the class for which it was registered, if you are using it as a trademark yourself. There must be some evidence that the mark is actively being used (not merely registered), and that, when it is used, the public associates the goods with the manufacturer.

You can make purely descriptive use of trademarks (e.g. a reference in a novel to Biro or Nescafé – check a dictionary for capitals), and it would be a defence to show that the word had become generic (e.g. if it has a generic definition in the *Oxford English Dictionary*). But exploitation of a trademarked title or character, e.g. an unauthorised prequel or sequel, is very risky and even where it is not a trademark infringement it may well attract a claim of passing off – particularly if the offended party is e.g. a major film studio.

For full details about trade marks, go to www.gov.uk/trademarks.

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