Against the Grain

Volume 6 | Issue 4 Article 32

September 1994

Legally Speaking / Trademark Part Deux

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Legally Speaking

Trademark Part Deux

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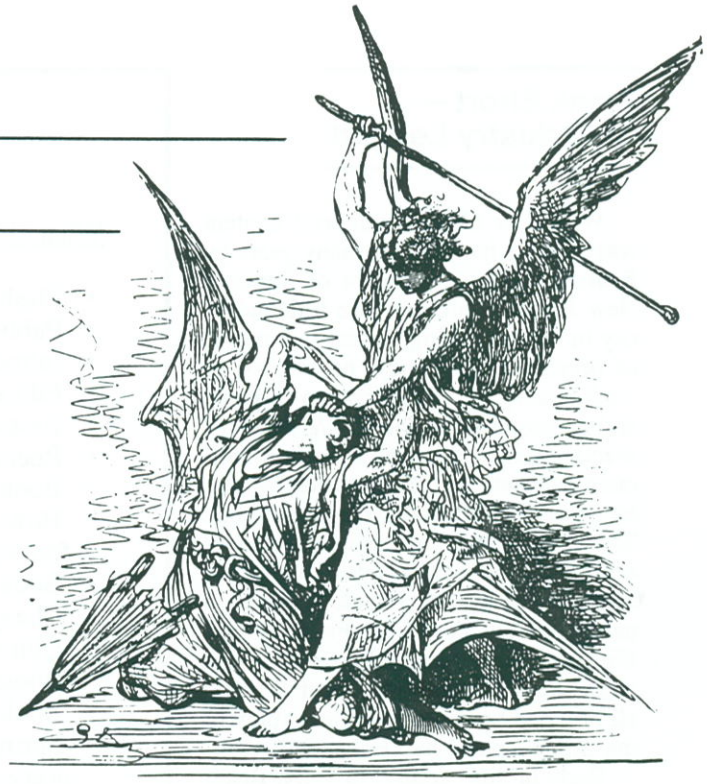

In this space in the last issue of ***ATG***, we introduced the topic of trademark and discussed the distinctions between it and its more familiar cousin, copyright. Now we will take up some of the publishing-related aspects of trademark, as well as trademark infringement.

Trademark law can provide protection to some elements of creative works which copyright law does not readily cover, such as titles and characters. Individual book titles generally cannot be trademarked, while series and periodical titles can be. This makes sense in light of the core purpose of a trademark: to identify the source of goods. The title of a series or periodical indicates the source of the work, whether it be the author or publisher. When we buy this year's edition of *Literary Marketplace*, we expect it to come from the same source as last year's. It could be confusing to consumers if another publisher was able to market a reference work entitled *Literary Marketplace*. In some sense, it would also be unfair to Bowker, which has built a reputation and a subscriber base for *LMP*. Not surprisingly, Bowker claims a trademark in *Literary Marketplace* by following it with the TM symbol. (The other trademark symbol, a circled R, indicates that the mark has been registered federally.)

Protection of literary characters is one of the most interesting applications of trademark and copyright law, although such protection is not as easily obtained as some might imagine. Consistent with the notion that we copyright expression of ideas, and not ideas themselves, the copyright of a novel does not generally provide for the exclusive use of the characters within that novel. Probably the most famous exposition of that doctrine is found in the case of Warner Bros. v. CBS, 216 F. 2d 945 (9th Cir. 1954), generally known as the Sam Spade case. Dashiell Hammett and Alfred A. Knopf, Inc. had sold the film, radio, and TV rights to *The Maltese Falcon* to Warner Brothers. Warner subsequently claimed exclusive rights not only in the story of The Maltese Falcon, but also in the characters contained therein, including Sam Spade. Hammett, of course, wanted to use the Spade character in future stories.

One of the documents in the sale of rights to Warner was entitled Assignment of Copyright, which the court found not to be a complete assignment of copyright, but rather a grant of limited rights. Those rights, the court concluded, did not mention and therefore did not include the characters of the story. The court did not stop its analysis here, though, but went on to consider whether characters and their names were even covered by the copyright statute. The court concluded that a character could be copyrighted with a story, but only if the character constitutes the story being told and is not just a vehicle for telling the story. In this case, Sam Spade was found not to be the story, but merely a vehicle for telling the story. Suffice to say, most literary characters are story-telling vehicles and not the story itself. Copyright protection is thus not easily obtained for literary characters, although somewhat more easily so for animated and comic book characters.

This is a mixed blessing for authors, for while copyright law is not likely to prevent an author, even one who has assigned the copyright to her stories, from using her characters in future stories, neither is it likely to allow that author to prevent others from using those same characters. This is where trademark and other areas of the law, including unfair competition, come into play. Fictional characters, literary service marks if you will, can indicate the source of a writing. If someone lifts Robert Parker's Spenser character for a detective novel or a screenplay, that person is not only likely to create confusion in the marketplace (i.e. as to whether Parker is involved in the project), but in also unfairly reaping the fruits of Parker's labor. If the other author's Spenser novel was written and packaged in a style similar to Parker's books, that second author might even be guilty of trying to pass off his novel as one of Parker's.

From a legal standpoint, a claim of trademark infringement is neither simple to prove nor cheap to defend. Most infringement cases involve similar, but not identical, marks. If I wanted to come out with a product to compete with *LMP*, perhaps even seeking to take advantage of the goodwill which Bowker has earned for *LMP*, I would not call my product *Literary Marketplace*, but would instead use Book Marketplace or some such similar title. How close could I come to *Literary Marketplace* without crossing the line of infringement? Ah, therein lies the complexity. . .

As complicated as the area of copyright infringement can be, trademark infringement is even more difficult to understand. Copyright infringement involves two primary elements, both of which can be viewed fairly objectively: copyrighted material and copying (setting aside controversies over fair use for the moment). Trademarks can be infringed even without exact copying. Instead, the essence of trademark infringement is that the likelihood of confusion caused by the alleged infringing mark. The confusion in question here is confusion in the marketplace as to the source of the goods or services. The likelihood of confusion is a somewhat squishy standard for which the law provides no hard-and-fast formula. Among the

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covered in **Library Technology Reports**' next issue.

As of late June, **Ameritech** announced that **NOTIS Systems** and **Dynix** officially joined forces to form a new company named **Ameritech Library Services**. The new consolidated library services operation will be organized around two groups: a **Library Systems Group** and an **Information Services Group**.

The **Library Services Group** consists of 4 divisions to address the needs of different types of libraries. They are **NOTIS Systems** for academic libraries, **Dynix** for public libraries, **Marquis** for special libraries, and **Scholar** for school libraries.

The **Information Services Group** will consolidate products and services that deliver information content. These include **Vista** for providing information databases access and document delivery, Internet and Z39.50 access products such as **WinGopher** and **WinPAC**, **Retro Link Associates** (RLA) for retrospective conversion services, and **GeneSys** for distribution of genealogical databases.

The NOTIS staff will continue to work from its Evanston headquarters. The planned **LMS Release 5.2** will be delivered on schedule and future development plans include enhancements to OPAC, Serials, Acquisitions, and Cataloging.

Ameritech also announced that a single client/server system is being developed to serve its customers in all 4 divisions. The basis of its software, called **C/SP**, is the currently installed **Marquis client/server product.**

Please note — We were as shocked by developments with NOTIS and Dynix as you were. Please see page 54, this issue, for Dynix answers to some ***ATG*** *questions. — KS*

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factors which are considered in evaluating the likelihood of confusion are: 1) the similarity of the marks (by both sight and sound); 2) the similarity of the goods or services being provided under the two marks; 3) the similarity of trade channels; 4) the conditions under which the goods or services are purchased and the nature of the purchasers; 5) the fame of the mark allegedly being infringed; 6) whether there are other similar marks in use; and 7) the extent of any actual confusion. Re: E. I. DuPont deNemours & Co., 476 F.2d 1357 (CCPA, 1973).

Trademark infringement, then, does not automatically result even from the use of identical marks. Assuming that *Against the Grain* is trademarked as the name of this publication, a bakery named Against the Grain would probably not infringe that mark, since the products are so dissimilar as to create no likelihood of confusion. But what if someone published an information systems newsletter entitled Against the Grain?

What if that newsletter was marketed to library information systems specialists? What if it were not marketed to anyone in the publishing, vendor, or library communities? These examples are a bit trickier.

The seeming subjective nature, or perhaps even vagueness, of the likelihood of confusion test makes trademark infringement cases complex and expensive for all concerned. This circumstance can lead to the tyranny of richer trademark holders, who can generally intimidate more shallow-pocketed companies into abandoning the use of a mark, even if that mark is not likely to cause confusion among either of the companies' markets. Most of us condemn the ripoff or knockoff of one company's trademarks or tradename by another, but the scales of justice in this area can be tipped rather dramatically by the gold of big companies.

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