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Protection of the press title within the Polish unfair competition law

Ochrona tytułu prasowego w polskim prawie zwalczania nieuczciwej konkurencji

I. INTRODUCTION

In the Polish legal literature little attention has been devoted to the issues concerning legal protection of a work (press title among others) even though both pre-war jurisdical doctrine and court opinions dealt with the topic extensively. In the past, as well as nowadays, legal protection of a title has been raising many questions and doubts. Authors dealing with the issue emphasise its complexity and conclude that it warrants a profound and thorough analysis.

The analysis of binding legal regulations leads to the conclusion that there is a lack of a uniform model as far as legal protection of a title is concerned. The protection depends not only on the circumstances in which the infringement of a title occurred but also on the kind of the title infringed and its structure. In some instances, a title might be subject to protection of the copyright law, industrial ownership law, law on unfair copmetition or the civil code regulations on personal interests. Still, in others, there might be no legal protection provided.

There is no legal definition of a work within Polish law. However, the term "title" appears in legal provisions, in article 11 of the law on copyright and neighbouring rights (hereafter referred to as "l.o.c.n.r.") and in article 20 par.2 of the press law.

In the Polish language the word "title" commands many meanings. It might mean: 1. a name, 2. a heading, 3. a whole work - a book (metaphorically), 4. a scientific or professional degree, 5. a family or a clan name, 6. a legal basis[1]. The present paper will not focus on the meanings in points 4, 5 and 6.

Marks and features indentifying individual works are of paramount importance in commercial trade of the latter. For exmple, a magazine is made distinct by its title. It is commonly known that a proper and intriguing title, stirring public interest or the one that has already become known and popular as a book or a theatre play, will considerably contribute a success and popularity of other works -among others, films, theatre plays etc

[1] A. Kubisa- Ślipko, *Słownik wyrazów bliskoznacznych*, Wałbrzych 2002, s.156.

derived from the famous original work. For those reasons, producers of works and distribution specialists have been attaching more and more importance to titles[2].

Legal protection of a title might be based on regulations of the law on copyright, industrial ownership law or personal interests anchored in the civil code. However, it seems that the provisions of the unfair competition law offer the most comprehensible protection against illegal usage of other's work's title. (hereafter referred to as "u.c.l.")[3]

II. LEGAL REGULATIONS OF THE PRESS LAW CONCERNING A TITLE.

Before conducting an analysis of provisions of unfair competetition law dealing with protection of a title, it is worth mentioning that the term "title" used in the press law[4] (hereafter referred to as "p.l") means the title of a daily newspaper or a magazine. What is more, the press law stipulates that an application for registration of a magazine should contain a title.

Article 21 of the press law provides that an application for registration shall be rejected if granting thereof would constitute an infringement of rights to an already existing press title. Putting aside intricacies of the press registration procedure, it needs to be stressed that its aim lies in providing protection for existing press titles; apparently then – protection against unfair competition[5].

Non-compliance with the obligation to register press shall be subject to penal liability within article 45 of the press law. The said article provides that "whoever publishes a daily or a magazine without prior registration or when registration has been suspended, shall be subject to a fine." There arises a question whether a successful registration creates a personal right or a legally meaningful situation and if so, who shall be the entitled party: editors, publishers or journalists involved.

In the literature of the subject it has been claimed that the registration procedure does not create a right to a press title and its function consists merely in presenting its publisher[6]. However, a closer reading of article 21 of the press law, which provides that within the registration procedure court shall be obliged to determine whether a future title infringes rights to existing ones, leads to a different conclusion.

It seems therefore, that on the basis of the cited provision a court's positive ruling on registration of a title constitutes a guarantee that the registered title does not infringe anyone's rights. However, in practice, it is assumed that a registration of a title may be used merely as evidence in a potential dispute over rights to a title and does not determine the right to use it.

In a number of court opinions, it has been emphasised that registration of a title does not create an effective and comprehensive pro-

2 J. Brown, *Advertising and Public Interest, Legal Protection of Trade Symbols*, 57 Yale L. J. 1165, 1948r.; C. Callmann, *Unfair Competition in Ideas and Titles*, 42 California Law Review 77, 1954 r.

3 Ustawa z dnia 16 kwietnia 1993r. o zwalczaniu nieuczciwej konkurencji (Dz. U. z 1993r. Nr 47 poz. 211 ze zm.).

4 Ustawa z dnia 26 stycznia 1984r. prawo prasowe (Dz. U. z 1984 r., Nr 5 poz. 24 ze zm.).

5 In Western Europe countries, among others in France and Germany, where there is no obligation of printed press registration, new press with similar or identical titles is prevented from enetring the market by unfair competition regulations.

6 J. Sobczak, *Prawo prasowe. Komentarz*, Warszawa 1999, s. 279.

tection of a press title, which might be sought invoking provisons of other laws. Noteworthy appears the fact that the judiciary consistently treats the publisher as the beneficiary of the rights to a title and the party entitled to seek protection thereof.

However, since, as mentioned before, registration of a press title does not create any personal rights, it is obviously not legitimate to designate any parties entitled to exercise such rights.

III. THE TITLE AS AN IDENTIFICATION MARK OF GOODS. (COMMODITIES).

While considering a possibility of applying the provisions of the unfair competition law to protect titles of works, it seems proper to devote some attention to the issue raised by the doctrine of law concerning the legitimacy of treating a title of a work as a title of a commodity. The law on unfair competition, article 10 in particular, which envisions protection of titles, concerns protection against introduction of misleading indentification of goods and services. Law theoreticians raise doubts whether a title of a work might be understood as as "indentification mark of a commodity." As a prerequisite to approaching this issue, the term "goods", as used in article 10 of the law, shall be clarified.

The word "goods" means in Polish: a commodity, a product, a creation, a handiwork[7]. The terms "goods" and "commodities" are freely interchanged within the law. (article 13 par. 1 and art 10) The word "product" means a result of a process of production, a work, a creation, a result of artistic, social or human brain activity[8]. In day-to day language fruit of human intellect is not referred to as "goods" or "products", and those terms are applied to results of industrial production or subjects of commercial trade. However, it cannot be questioned that works carry economic value and are subject to commercial trade. A division of intellectual goods markets into: books, music or antiques markets is hence valid. Through this perspective works of human intellect play the role of goods. It is therefore legitimate to claim that the term "goods" used in article 10 of the l.o.u.c encompasses intellectual creations (works among others) which might be subject of commercial trade.

Summing up the above considerations it may be put forward that titles cannot be denied the function of "indentification marks of goods" within the scope of article 10 of the l.o.u.c.

IV. THE TITLE AS A DISTINCTIVE FEATURE.

Using another's title may be aimed at taking over their clientele. The thought was formulated already in pre-war Polish law doctrine by S. Ritterman[9].

So, an illegal use of another's work title in commercial trade may constiute an unfair competition tort provided for in article 10 of the l.o.u.c. The scope of the provision encompasses identifications (marks) and descriptive information whose purpose is to make goods and services distinct. The provision

7 A. Kubisa – Ślipko, *Słownik ...,* s.154.

8 E. Sobol (red.), *Słownik wyrazów obcych PWN*, Warszawa 2002, s. 900.

9 S. Ritterman, *Komentarz do ustawy o prawie autorskim*, Kraków 1937, s. 325-327; M. Marotte, *Del'application des droits d'auteur et d'artiste aux oeuvres cinematographiques*, Paryż 1930, s.116 and n.

protects subjects of trade against confusion as to goods' (services') origin and their significant characteristics. This legal institution protects titles of individual and collective works as well publishing editions titles.

The prerequisite of title protection within the l.o.u.c, just like in the case of every other distinctive mark, is that a mark- a title must have distinctive capacity. (distinctive power) It is agreed that rights to an identification – mark, as well as to a title arise from using a definite mark-title in commercial trade, rather than from merely creating one.

An identification mark of goods (works) that enjoys protection of article 10 needs to have a capacity to make goods distinctive from one another. Even though the formulated prerequisite does not stem directly from the wording of the article 10, it is clear that an identification mark lacking such capacity will be misleading and will result in a confusion as to identity of goods and their origin[10]. Having determined distinctive capacity of an identification mark – a title, the procedure whose purpose is to ensure that the mark or the title is not misleading in signifying goods of similar nature becomes legitimate.

Titles subject to protection (titles with distinctive capacity or power), are those original and easy to remember[11]. According to G. Hoepffner for a title to be protected it must be defined and specific so that it differentiates one work from another[12]. Interestingly, R. Bork claims that a title does not need to possess a high grade of distinctiveness but it neeeds to be distinctive at all. Undoubtedly, titles with distinctive power are those which fulfil the requirement of identification uniformity, which means that they are easily noticeable, are likely to be remembered, captured with a "single perceptive snapshot" and those that are self-contained.

German jurisdiction have afforded protection and the feature of distinciveness, among others, to the following titles of magazines: "Arztliches Journal" (Doctor's Journal), "Arzte-Kalendar" (Doctor's Calendar), "Apotheken Kalendar" (Pharmacy Calendar)[13]. The following titles of programmes have been approached in the same way: "Point", "Wie hammas denn", Jetzt red i", "A weni kurz, a weni lang", "Derrick", "Bim Bam Bino"[14].

In German legal literature the following titles have been deemed devoid of distinctive power due to their descriptive character with regard to the work specified by them: "Wohenzeitung" (Weekly), "Molkereizeitung" (Milkman's weekly), "Illustrierte" (Illustrated magazine)[15]. The following titles of programmes have been denied protection: "Nachrichten" (News), "Magazyn" (Magazine), "Sportstudio" (Sport programme). German jurisdiction have considered the following titles as "free", not subject to protection: "Der Nahe Osten" (Near East), "Der 20 Juli" (20th of July), "Friedrich II" (Frederick IInd)[16].

[10] The view is generally accepted in law doctrine; it is agreed that within article 10 of l.o.u.c. the same rules applie as in art. 5 of the law, as far as determination of distinctive quality of an enterprise is concerned. See M. Kempiński, I. Wiszniewska, *Ustawa o zwalczaniu nieuczciwej konkurencji. Komentarz*, Warszawa 2000, s. 302 and 208.

[11] R. Bork, *Titelschutz fur Rundfunksendungen*, UFITA 1989, Bd. 110, s.42.

[12] G Hoepffner, *Der Schutz von Zeitschriftentiteln aus wettbewerbsrechtlicher Sicht*, GRUR Int. 1983, H. 6-7, s. 514.

[13] G Hoepffner, *Der Schutz ...,* s. 514.

[14] R. Bork, *Titelschutz...,* s. 42.

[15] H. Hubmann, *Urheber und Verlagsrecht, Munchen*, Berlin 1966, s.237.

[16] R. Bork, *Titelschutz...,* p. 43.

Some titles despite consisting of commonly used words have a metaphorical or ambiguous meaning. The very quality of being metaphorical or ambiguous transforms "free" titles into distinctive ones that are easily remembered. The following titles might serve as examples of the above-described phenomenon: "Szpilki" – (Pins) refers to satirical conent of the magazine, "Pompon" – (Tassel) symbolises the kind of nonsensical humour typical of the paper, or the equivocal magazine title "Przekrój" – (Profile)

In German legal literature, metaphorically used titles "Stahlnetz" – (Steelnet), "Traumschiff" (Ghost ship), have been put into that category.

Common titles (free titles) consisting of singular words or popular expressions might gain distinctive power thanks to certain additions regardless of whether those additions alone command distinctive power. Therefore, the common titles "Głos" – (Voice), "Życie" – (Life), "Gazeta"- (Newspaper) possessing no distinctive quality, have gained one after being modified into "Pomeranian Voice", "Olsztyn Voice" or "Warsaw Life"

German doctrine assumed that the title "Der Nahe Osten" (The Near East) – does not enjoy protection, unlike "Der Nahe Osten ruck naher" (The Near East Comes Closer). The same applies to "Das Sportstudio" (Sport- programme) and "Das aktuelle Sportstudio". (Up-to-date sport programme)[17]. Falling into this line of argument is a German court opinion concerning the titles of magazines" "Deutsche Zeitung" – (German Newspaper) and "Deutsche Allgemeine Zeitung" - (Comprehensive German Newspaper). The court ruled that even though the words "Zeitung" and "Deutsche" are generic and have no distinctive power when standing alone, the phrase "Deutsche Zeitung" deserves legal protection[18].

Descriptive, free titles lacking distinctive capacity may acquire the feature by gaining popularity and recognition among audience. (readers, tv or radio audiences).

The following titles fall into this category: "Rzeczypospolita", "Fakt" – (Fact), "Sukces" – (The Success), "Polityka" – (The Politics), "Fakty" – (The Facts). It is legally irrelevant whether a title becomes popular over a long period of time or almost overnight – thanks to omnipresent and effective advertising, which according to R. Bork happened to the titles: "Dallas", "Schwarzwaldklinik" – (Schwarzwald Clinic), "Tagesschau" (The Daily Review)[19]. Similarly, legal protection of title was granted to "Berliner Illustrierte Zeitung" (The Berlin Illustrated Newspaper), "Revue" (The Review), "Bergwerkszeitung" – (The Mine Paper). On the other hand, it has been denied to the magazine "Deutsche Universitatszeitung"[20].

V. THE TITLE AS A MISLEADING IDENTIFICATION MARK.

While determinig a tort of unfair competition within article 10 of the l.o.u.c., having positively established the existence of distinctive power of a given work title, it needs to be considered whether the title appears

17 R. Bork, *Titelschutz...*, s. 43.
18 G. Hoepffner, *Der Schutz ...*, s. 514.
19 R. Bork, *Titelschutz...*, s. 43.
20 H. Hubmann, *Urheber ...*, s. 237.

misleading as to the origin of the goods it identifies. The author is of the opinion that the above consideration should derive from the body of law doctrine concerning law on trade marks. Similar approach is represented by M. Kępiński and I. Wiszniewska[21] and entails serious consequences. Using the same criteria as in trade marks law to determine if circumstances can be deemed misleading within article 10 leads to the conclusion that the tort from article 10 is committed only when a similar mark-identification refers to similar goods. Consequently, no tort within article 10 shall be comitted when a similar mark is applied to goods which are not similar. The above determination is of much import as an act of using other's identification mark to dissimilar goods can be dealt with only on the basis of the general clause in article 3 of the law.

Thus, the issue of similarity of goods or lack of it shall always precede the determination of potential similarity of identification marks. Only after the similarity of goods have been ascertained, a determination of similarity of marks might be legitimately carried out. It is assumed that using identical marks for identification of dissimilar goods cannot be misleading to the buyers[22].

However, German law on unfair competitin provides an example to the contrary. In the case "Sherlock Holmes" a court claimed that there is a risk of confusing titles of a film and a book[23].

The criterion based on the kinds of goods seems paramount while determining their similarity. A kind of goods is determined by more detailed aspects such as: material, working mechanism, production process, appearance[24]. So, from this point of view, the following might be regarded as similar goods: printed periodicals, books and magazines. Also films and television programmes, music publications and radio programmes. Radio and television programmes but also different kinds of works (music creations, films, computer programmes, multi-media creations, e-books) in a digital version. It is worth noting that different kinds of digital works are recorded on CDs. They might be bought through the Internet, are played by similar devices (the computer) and are on offer in similar shops. For this reason, the author represents the point of view that different categories of works shall be treated as similar goods within the scope of article 11 of the l.o.u.c, as long as they appear in a digitized form.

Having ascertained that goods in question are similar, the determinig body proceeds to consider the aspect of similarity of both identification marks- titles. The evaluation is carried out through the eyes of the average recipient of the goods. It focuses on a general impression that they are likely to make.

Titles, which refer to intellectual works, are verbal identification marks. Their similarity is determined on a visual and phonetic level[25].

21 M. Kępiński, I. Wiszniewska, *Ustawa* ..., s. 272-273.

22 R. Skubisz, *Prawo znaków towarowych. Komentarz*, Warszawa 1997, s. 84.

23 More on this opinion and others – see G. Hoepffner, *Der Schutz*..., s. 513

24 R. Skubisz, *Prawo znaków* ..., s. 84-85.

25 R. Skubisz, *Prawo znaków*..., s. 94.

Identification marks – titles; might me deemed as similar or dissimilar regardless of whether they refer to goods (services) of the same or different enterprises.

Similarity of verbal signs should also be evaluated using antonyms and synonyms. Translations of an identification mark from one language to another might also be of importance.

German unfair competition law doctrine assumes that cases of misleading titles giving rise to protection, are connected with "distinctive power". The "stronger", the more characteristic, or easier to remember a title is, the more unlikely it is to get confused with other titles.

Undoubtedly, using identical titles constitutes an act of unfair competition. However, the matter becomes more complicated when titles that already exist are modified by means of all kinds of additions. According to G. Hoepffner, numerous cases that have been subject of court opinions, do not allow to draw a clear conclusion[26].

As far as the issue is concerned, E. Ulmer and H. Hubmann claim that with titles of little "distinctive power" even slight modifications exclude confusion. On the other hand, titles possessing prominent distinctive quality – even if modified in a considerable way – pose a huge risk of confusion. [27].

Summing up the above considerations it might be stated that the risk of confusion as to the origin of works stems both from their similarity and from titles themselves. Those two elements appear inseparable and the average purchaser does not distinguish between them in the process of buying. However, the judicial body is obliged to analyse similarity of goods and titles separately. Thus, its task consists in reconstructing the rapid and mostly subconscious process of perception of both notions by the average purchaser.

Article 10 may serve as a source of protection of goods and services in two ways. It may supplement protection of identifiaction marks resulting from industrial ownership law or it may provide a self-contained basis of claims – when a given identification mark has not been registered as a trademark. The law on unfair competition ensures protection of identification marks (titles) which are used in reality and which, even though potentially eligible for registration, have not been registered. Moreover, it provides protection for distinctive titles used in trade which cannot be registered as trademarks for the lack of registration capacity. The protection of titles within the law on unfair competition may also apply to identification marks of goods which used to be registered as trademarks and whose protection has expired.

Because of the limits of the present paper, considerations of title protection within the law on unfair competition have been focused on article 10 only. The author represents the opinion, however, that in cases where the protection of titles cannot be based on article 10, it might be construed from the general clause in article 3 as well as art 16 point 1 of the law. Those issues require further consideration.

[26] G. Hoepffner, *Der Schutz...*, s. 515.

[27] E. Ulmer, *Urheber und Verlagsrecht*, wyd 2, Gottingen-Heidelberg 1960, s. 176; H. Hubmann, *Urheber ...*, s.238.

KEYWORDS

title, press, copyright, unfair competition law, press law.

SUMMARY

The article focuses on the legal protection of the press title within the Polish unfair competition law. Marks and features indentifying individual works are of paramount importance in commercial trade of the latter. For example, a magazine is made distinct by its title. It is commonly known that a proper and intriguing title, stirring public interest will considerably contribute economic success and popularity works. The analysis of binding legal regulations leads to the conclusion that there is a lack of a uniform model as far as legal protection of a title is concerned. Legal protection of a title might be based on regulations of the law on copyright, industrial ownership law or personal interests anchored in the civil code. However, it seems that the provisions of the unfair competition law offer the most comprehensible protection against illegal usage of other's work's title.

SŁOWA KLUCZOWE

tytuł, prasa, prawo autorskie, nieuczciwa konkurencja, prawo prasowe.

STRESZCZENIE

Artykuł dotyczy problematyki ochrony prawnej tytułu urworu z punktu widzenia polskiego prawa zwalczania nieuczciwej konkurencji. Nazwy utworów a w tym m. in. ich tytuły pełnią w obrocie handlowym wiele ważnych funkcji. Tytuły prasowe służą przede wszyskim do odróżniania utworów. Jednak powszechnie wiadomo, że znany i popularny tytuł ma siłę przyciagania kienteli, posiada więc określoną wartość rynkową zasługującą na ochronę prawną. Analiza regulacji pranych prowadzi do wniosku, iż ochrona tytułu może być realizowana w różnych okolicznosciach przez różnego rodzaju regulacje prawne m. in. prawo autorskie, prawo cywilne, czy też prawo własności przemyslowej. Pośród tych regulacji szczególne znaczenie praktyczne dla ochrony dobra jakim jest tytuł posiada jednak ustawa o zwalczaniu nieuczciwej konkurencji.

NOTA O AUTORZE

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