



Copyright V. Trademark in a Name: Case Comment On Exxon Corporation V. Exxon Insurance Consultants International Ltd.

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**COPYRIGHT V. TRADEMARK
IN A NAME: CASE COMMENT
ON EXXON CORPORATION V.
EXXON INSURANCE
CONSULTANTS
INTERNATIONAL LTD.**

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*The case of “Exxon Corporation v Exxon
Insurance Consultants International Ltd”¹
discusses the copyright ability of names and
the various principles used to reach a
decision on the contended topic.*

To fully understand this case, we first need to understand the meaning of subject matter of copyright under the Copyright Act. Under section 2(1) of the “*Copyright Act of 1956*”² in the UK, Copyright is said to subsist in “*every original literary, dramatic or musical work.*”³ Registration is not mandatory and all that the author need establish is that his work fulfils the standard

of ‘originality’ required for copyright protection. The meaning and extent of this however is quite complex and this case can be used as an example to highlight this. The difficulty arises when attempting to define ‘originality’. Does the umbrella of originality cover all works that are the result of time and effort, or does it recognize only those that rise above the ordinary through a display of some creativity or any other aspect on the part of the author?

In this case, the name “Exxon” was the point of contention. Exxon Corporation was a highly regarded fuel company which claimed that the name was one they had created with an immense amount of labour and hard work which required a considerable amount of time and strategy. The word was then introduced into the English language and therefore does qualify as a literary work under the Copyright Act of 1956. So, when Exxon Insurance used the same word as their name, Exxon Corporation filed a claim of copyright infringement.

This argument forwarded by Exxon Corporation stems from the Locke’s Labour

¹ Exxon Corp. v. Exxon Insurance Consultants Ltd [1982] Ch. 119 (U.K.: High Court and Court of Appeal)

² Copyright Act 1956

³ Id

Theory which essentially states that if you have put effort into making something then the ownership of that and the decisions on latter use of it should lie with you. Further expanded in copyright as the ‘Sweat of the brow’ standard of originality, as laid down in *“University of London Press Limited v. University Tutorial Press Limited”*⁴, it contended that if a man expended time and effort in first putting on paper something that was already out in the public domain, the copyright would vest in him.

While there are certain advantages to this theory such as providing a simple barometer of labour and effort to unmask originality, the needs of marketing and the unending availability of media and technology that has sprung up in the past 50 years or so has led to the ever-increasing *“production of commercial messages, coined phrases, invented words, and brief opinions expressed instantly.”*⁵ To measure the originality of these a much broader and more complex scale is required and thus this theory has been since rejected. The Supreme Court of India recognized this and in *“Eastern Book Company v. D.B. Modak”*⁶, rejected the ‘sweat of the brow

doctrine’, and held that the work must be original *“in the sense that by virtue of selection, co-ordination or arrangement of pre-existing data contained in the work, a work somewhat different in character is produced by the author”*.⁷

Expanding on that, in the current case, while the courts did accept that the word was an original one that was created by Exxon Corporation, it was not copyrightable. To justify this the courts referred to the decision made in the case of *“Hollinrake v Truswell.”*⁸ In this case the courts held that originality is not all that is required. The literary work must further offer *“information, instruction or pleasure in the form of the literary enjoyment.”*⁹ The name “Exxon” however does not fulfil these requirements and therefore does not qualify for protection under the Copyright Act. *“A word alone does not convey any information beyond its dictionary meaning and thus cannot be a literary work.”*¹⁰

Commercial neologisms, such as ‘Exxon’ may meet the criterion of having been made with effort and might attract the “sweat of the brow” Doctrine. However, when looked at in an isolated manner, the word holds no

⁴ University of London Press v University Tutorial [1916] 2 Ch 601

⁵ Jonathan Barrett, Copyright and the Sound Bite Society, 2010

⁶ Eastern Book Company and Ors. v. D.B. Modak and Anr. (2008) 1 SCC 1

⁷ Id

⁸ Hollinrake v Truswell: CA 1894 (1894) 3 Ch D 420

⁹ Id

¹⁰ Supra note 1

real meaning because of which they fail to express anything. This failure leads to a situation where they do not attract copyright protection.

The courts also state that the fear in giving copyright to these invented original words is that they will no longer be put in the dictionary and that might lead to a situation where words already in existence will be *“rendered unusable through inclusion in newly protected literary phrases.”*¹¹

*“Although Locke’s applied labour proposition principally relates to the justification of individual property rights, his proviso that enough of the same should be left for others, subjects such rights to distributive justice imperatives, and may be seen as anticipating the public policy considerations that loom large when the potential for monopolizing words and phrases is raised.”*¹²

In India, Section 13 of the Copyright Act, 1957 speaks of the subject matter of copyright and it is very similar to that of the UK’s in so far as it mentions copyrightable work to be, *“original literary, dramatic, musical and artistic works.”*¹³

Following suit, a similar case can be found in India by the name of *“Krishika Lulla & Ors vs Shyam Vithalrao Devkatta & Anr.”*¹⁴In this case the plaintiff claimed that he had written a story with the title "Desi Boys" and got the synopsis of the story registered with the Film Writers Association in on 2008. When in 2011 a film called “Desi Boyz” was released, the plaintiff claimed infringement of copyright in the title which according to him is the soul of his story and copying it takes away everything from his story.

Delivering a judgment similar to Exxon, the courts held that a title by itself is in the nature of a name of a work and is not complete by itself, without the work. The combination of the two words "Desi" and "Boys" cannot be said to have anything original in it. They are extremely common place words in India. Furthermore, the courts stated that *“a literary work should be literary in nature i.e. “concerning the writing, study, or content of literature, especially of the kind valued for quality of form”.*¹⁵

In both cases the courts further went on to state that names often are not afforded copyright but they can be being they to be

¹¹ Supra note 1

¹² Supra note 5

¹³ Copyright Act of 1957

¹⁴ Krishika Lulla and Ors. v. Shyam Vithalrao Devkatta and Ors. [Criminal Appeal No. 258 and 259 of 2013]

¹⁵ Id

part of something bigger say like a book. The copyright would then apply to the whole book in itself.

*“Arguably the proper route to protect names would be under trademark or the tort of passing off, through which Exxon was afforded relief in the aforementioned case.”*¹⁶The essential use and requisite qualities of a trade mark are generally unsuitable with that of an original literary work. A word such as ‘Exxon’ made with labour by a corporate while very well suited for trade mark registration, does not meet the requirements for copyright protection. *“Unlike an original literary work, a trade mark is not protected for its own intrinsic worth, but for the intangible values surrounding the product and attaching to the mark”.*¹⁷The job of a trademark is not to get an idea across or communicate any of the prerequisites laid down, its simple purpose is to allow consumers to identify and act as an advertising tool. The only situations where neologisms could perhaps qualify for copyright protection is if they were not a trade mark substitute which is not the case here. That is why “Exxon” is largely more qualified to be protected under trademark than under Copyright.

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¹⁶ Jani Ihalainen, Retrospective- Copyright in Names, IP Iustitia, 08 November, 2013

¹⁷ J McGrath, ‘The New Breed of Trade Marks: Sounds, Smells and Tastes’ (2001) 32 Victoria University at Wellington Law Review 277, 281



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