






## TRADE MARKS

## Decisions of the GC and CJ

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC <b>T-394/10</b> <i>Elena Grebenshikova v OHIM; Volvo Trademark Holding AB</i> (05.12.13)</p>	 <p>- computer programs for warehouse management systems and computer programs for container terminal systems (9)</p> <p><b>VOLVO</b></p> <p>- computer software (9)</p> <p>- vehicles (12)</p>	<p>The GC annulled the BoA's decision, which found a likelihood of confusion under <b>Art 8(1)(b)</b>.</p> <p>The relevant public (specialists such as managers of warehouse complexes or container terminals) would have a particularly high degree of attention and would scrupulously examine the characteristics and the content of the software product and the identity of its producer before deciding whether to purchase.</p> <p>The GC had previously held (in <b>Case T-434/07</b>) that the marks were not visually or conceptually similar, but that there was a degree of phonetic similarity.</p> <p>Despite the identity of the goods and the high level of distinctiveness of the earlier mark, the GC concluded that the visual dissimilarities outweighed the phonetic similarity and that there was no likelihood of confusion. The GC noted that the staff responsible for purchasing the relevant goods would inevitably be faced with the image of that sign during the selection process and would be very attentive to even slight differences between the marks.</p>
<p>GC <b>T-361/12</b> <i>Premiere Polish Co. Ltd v OHIM; Donau Kanol GmbH &amp; Co. KG</i> (06.12.13)</p>	<p><b>ECOFORCE</b></p> <p>- preparations and substances all for laundry use, cleaning, polishing, scouring, descaling and abrasive preparations; soaps, turpentine substitute, paint or polish stripping preparations and substances, water closet colouring materials, antistatic preparations and substances, and rinse</p>	<p>The GC upheld the BoA's finding that there was a likelihood of confusion between the two marks under <b>Art 8(1)(b)</b>.</p> <p>The GC did not dispute the BoA's finding that the goods covered by the marks were identical.</p> <p>The average consumer would perceive the word elements of the figurative mark as consisting of the words 'eco' and 'forte' read in that order. As the word elements of the figurative mark were likely to dominate the overall</p>

	<p>additives' (3)</p>  <p>- bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices (3)</p>	<p>impression created in the minds of members of the relevant public, the BoA correctly found that there was a low degree of visual similarity between the marks.</p> <p>The marks were highly similar phonetically as the letters and syllables of the word elements of the marks had the same sequence. There was some conceptual similarity as the elements 'forte' (evoking the idea of 'strong point') and 'force' (corresponds to 'physical strength') had similar meanings.</p> <p>Given further the identity of the goods, there was a likelihood of confusion between the marks.</p>
<p>GC <b>T-467/11</b> <i>Colgate Palmolive Company v OHIM; dm-drogerie markt GmbH &amp; Co. KG</i> (10.12.13)</p>	<p><b>360° SONIC ENERGY</b> - toothbrushes (21)</p> <p><b>SONIC POWER</b> - dentifrices, products for oral care (03)</p> <p>- toothbrushes, electric toothbrushes, water apparatus for cleaning teeth and gums, dental floss, toothpicks (21)</p> <p>(International trade mark effective in Czech Republic, Italy, Hungary, Austria, Slovenia and Slovakia)</p>	<p>The GC upheld the BoA's finding that there was a likelihood of confusion between the marks under <b>Art 8(1)(b)</b>.</p> <p>The BoA was correct to find that the term 'sonic' was descriptive of certain electric toothbrushes. The descriptive character was strengthened when associated with 'energy' or 'power'. However, the GC disagreed with the view that 'sonic' could not be considered descriptive here (as the goods included toothbrushes not equipped with sonic technology). The fact that the application did not distinguish between categories of toothbrushes could not alter the descriptive character of the term. In any event, a certain degree of distinctive characteristic of the earlier mark had to be acknowledged given the existence of the earlier intentional trade mark.</p> <p>The marks were visually, conceptually and phonetically similar. Given further the identity of the goods, the BoA was correct to find that there was a likelihood of confusion between the marks.</p>
<p>GC <b>T-487/12</b> <i>Eckes-Granini Group GmbH v OHIM: Panini SpA</i></p>	 <p>- beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks</p>	<p>The GC upheld the BoA's finding that there was no likelihood of confusion between the marks under <b>Art 8(1)(b)</b>.</p> <p>The BoA had erred by concluding that the marks at issue had a low degree of</p>

<p>(11.12.13)</p>	<p>and fruit juices, syrups and other preparations for making beverages (32)</p> <p><b>GRANINI</b></p> <p>- non-alcoholic beverages, fruit drinks and fruit juices (32)</p> <p>(Community and German national marks)</p>	<p>visual similarity. The figurative elements of the mark applied for helped to create a very different overall visual impression to the earlier marks.</p> <p>There was a low degree of phonetic similarity between the marks. Conceptually, given 'granini' had no meaning, the marks were either dissimilar (for the public for which 'panini' meant 'small bread rolls') or no comparison was possible (for the public for which 'panini' was meaningless).</p> <p>On a global assessment, the phonetic similarity was less important than visual differences owing to the method of distribution of the goods (supermarkets, restaurants and cafes etc) where visual examination would usually occur before purchase. Further, in relation to the non-alcoholic goods at issue, consumers would not usually order by trade mark, but merely give the generic name of those drinks (e.g. orange juice).</p>
<p>CJ</p> <p><b>C-445/12</b></p> <p><i>Rivella International AG v OHIM; Baskaya di Baskaya Alim e C. Sas</i></p> <p>(12.12.13)</p>	 <p>- various goods in Classes 29 and 30</p> <p>- beers and other non-alcoholic drinks (32)</p>  <p>- beer, ale and porter, water and other non-alcoholic drinks (32)</p> <p>(International mark effective in Germany, Spain, France, Italy, Austria and Benelux)</p>	<p>The CJ upheld the GC's decision rejecting the opposition as Rivella had failed to provide proof of use of the earlier mark under <b>Art 42(2)</b> and <b>(3)</b> (reported in <i>CIPA Journal</i>, August 2012).</p> <p>Rivella had provided proof of use of the mark in Switzerland and relied on an 1892 bilateral convention between Switzerland and Germany under which German law considered the use of the mark in Switzerland to be use in Germany.</p> <p>The CJ held that marks with effect in a Member State by virtue of an international arrangement must be subject to the same use requirements as national marks registered in that Member State or <b>Art 42(2)</b> and <b>(3)</b> would be deprived of their useful effect. Whilst international arrangements could affect national trade mark law, the question of use of an earlier mark for the purposes of the Community trade mark system was governed entirely by EU law.</p>

## Examination of national laws by OHIM

### ***OHIM v National Lottery Commission ('NLC') (AG Bot for the CJ (First Chamber)); C-530/12; 28.11.13)***

Advocate General Bot proposed that the CJ refer the case back to the GC after the GC had annulled a BoA decision to declare a figurative CTM owned by NLC invalid in light of an identical earlier Italian copyright protected mark under **Article 53(2)(c)**.



NLC registration



Work alleged to be protected by Italian copyright

The dispute regarded the legality of evidence of the earlier copyright protected work. The earlier work had appeared in a photocopy of an agreement which had a post office stamp dated 21 September 1986. Under Italian law the presence of a post office stamp constituted proof of a definite date and provenance of the statements contained within the agreement. NLC challenged the reliability of the stamp, primarily based on the fact that the date corresponded to a Sunday; a date on which the post office would have been closed.

The GC, of its own motion, had decided that there had been a misinterpretation of Italian law (**Case T-404/10** reported in *CIPA Journal*, September 2012). NLC should have been able to contest the validity of the agreement before the BoA without having to bring proceedings for a declaration of forgery. The GC held that the BoA incorrectly assessed the scope of its own powers; it did have the ability to take into account the NLC's arguments contrary to its interpretation of Italian law.

OHIM appealed, alleging infringement of (i) **Article 76(1)** because the GC had relied on Italian statute and case law not cited by the parties in its decision; and (ii) OHIM's right to be heard.

#### **Infringement of Article 76(1)**

The AG considered that the GC was right to examine, by obtaining information of its own motive about the content of the relevant Italian law, whether the BoA had interpreted that law correctly.

In reaching that opinion, the AG noted the following:

- (i) Although as a general rule the GC regarded national law as an element of fact which it is for the opponent or cancellation applicant to prove, that principle was tampered significantly by requiring OHIM to obtain, of its own motive, information about the national law where that law was a well-known fact. Furthermore, OHIM considered itself obliged to determine whether the BoA construed the relevant national law correctly.
- (ii) The justification for that duty of examination, however, should not lie in the concept of 'well-known fact', as it would give rise to considerable legal uncertainty and yield arbitrary results. Instead the duty should be based on the need to protect the effect of **Regulation No. 207/2009** and on the requirements of effective judicial protection.

- (iii) **Rule 37** of the **Implementing Regulation (2868/95/EC)** did not specify all the legal rules applicable to national law. It demonstrated that the EU legislative did not intend to leave the reins fully in the hands of the parties and leave the courts as mere arbiters.
- (iv) **Article 53(2)** afforded national law some degree of legal status in the EU legal system, which prohibited it from being regarded exclusively as a mere question of fact. That finding was supported by *Edwin v OHIM (Case C-263/09)* reported in *CIPA Journal*, August 2011).
- (v) The duty of examination must remain restricted and should only apply when OHIM already has information relating to national law and should not alter the subject matter of the dispute by the introduction of new facts.

#### Right to be heard

The right to a fair trial is a fundamental principle of EU law and the principle that the parties should be heard is the basic requirement of any fair trial. The GC had not given OHIM, or indeed NLC, the opportunity to submit their observations on the Italian law considered in its judgment. Therefore, the AG considered that the case should be referred back to the GC.

#### **IDEAL HOME mark found valid and not infringed by Ideal Home Show's online offering**

##### ***IPC Media Ltd v Media 10 Ltd\** (John Baldwin QC; [2013] EWHC 3796 (IPEC); 06.12.13)**

**John Baldwin QC** (sitting as a Deputy Judge) dismissed IPC's claim against Media 10 for trade mark infringement, finding that Media 10's use of the sign 'Ideal Home Show' did not infringe IPC's trade mark for IDEAL HOME under **Sections 10(1), 10(2) or 10(3)**.

IPC was the publisher of the market-leading Ideal Home magazine which was launched in around 1920. It had sold mail order goods by reference to the 'Ideal Home' sign since the 1960s. Following the launch of its website in 2005, its IDEAL HOME mark was registered in 2006 in Class 35 for '*the bringing together for the benefit of others of a variety of house wares, domestic electrical goods and appliances, garden equipment, plants and furniture, home furnishings, lighting apparatus, enabling customers to conveniently view and purchase those goods from catalogues by mail order or by means of telecommunications including via the Internet and television shopping*'. In January 2009, IPC launched an online shop called the 'Ideal Home Shop', selling a range of home interest products via the internet.

Media 10 had operated the Ideal Home Show (a popular home wares exhibition held at Earls Court in London and various other locations around the UK) since 2009. IPC brought the present proceedings in response to Media 10's launch of an online shop selling home interest goods. Media 10 counterclaimed for invalidity of IPC's mark on absolute grounds under **Sections 3(1)(b)** (devoid of distinctive character) and/or **3(1)(c)** (consisting exclusively of signs or indications which served to designate the kind and/or quality and/or intended purpose of the services in question). It also relied on **Section 5(4)**, asserting that it could, in 2006, have restrained IPC's use of the IDEAL HOME mark by bringing an action in passing off on the basis that IPC's application for registration of the mark was a claim that it owned the entirety of the goodwill associated with 'Ideal Home' when used in connection with the services in the registration.

The Deputy Judge found that 'Ideal Home' conveyed a different meaning depending on whether the context was a magazine or an exhibition/show. However, he found that the parties had for some time chosen to conduct their respective businesses without taking any steps to educate consumers that those businesses were owned and controlled by separate

entities; indeed, the magazine often presented a positive indication that it was connected with the show in a material way by, for example, the inclusion of free tickets to the Ideal Home Show in the magazine. Likewise, visitors to the Ideal Home Show were given a free copy of the Ideal Home magazine. The consequence of this was that there was some confusion between the two businesses but, due to the different nature of the two, that confusion was of little consequence other than an administrative inconvenience.

The Deputy Judge rejected Media 10's attack on the validity of the IDEAL HOME mark under **Section 3**, finding that the sign had, when used in connection with a business in home interest goods, acquired a secondary meaning by reason of its use by both parties. He also rejected the counterclaim under **Section 5(4)** because IPC had not yet done anything with its IDEAL HOME mark to increase the likelihood of it representing itself as the sole owner of the goodwill associated with the business under which it has been used, and any *potential* use of the mark by IPC in a way which caused misrepresentation was not sufficient. The Deputy Judge concluded that the sale of home interest goods by either party under the Ideal Home name was sufficiently in the middle of the spectrum between the respective core businesses for neither party to be able to succeed against the other in a passing off claim.

As regards infringement, the Deputy Judge was satisfied that the average consumer would perceive the sign used in connection with Media 10's online offering as 'Ideal Home Show', rather than 'Ideal Home'. IPC's claim under **Section 10(1)** therefore failed for lack of double identity. The claim under **Section 10(2)** also failed because, although there might be some confusion caused by the use of Ideal Home Show as a trade mark for online retail shopping, such confusion was no more than was to be expected by reason of the concurrent trading by the parties in their core businesses using 'Ideal Home', and was not such as to affect the function of IPC's mark more adversely than it was already affected by virtue of the long standing uses of the separate businesses. The claim under **Section 10(3)** also failed due to the *'massive overlap between the reputation belonging to IPC Media and that belonging to Media 10'*.

The Judge acknowledged that his conclusions as regards infringement opened up the possibility of some confusion between the online retail businesses of the parties, but noted that it was therefore in both parties' interests to take appropriate measures, such as choice of get up, to keep such confusion to a minimum.

### **Extensions of time for serving a claim form**

#### ***Jonathan Malcolm-Green v And So To Bed Ltd ('ASTB')\** (Judge Hacon; [2013] EWHC 4016 (IPEC); 16.12.13)**

**Judge Hacon** set aside a previous Order granting Mr Malcolm-Green an extension of time to serve his claim form, and struck out his claim for copyright infringement.

Mr Malcolm-Green was a professional photographer who alleged that ASTB, a former client, had infringed his copyright in certain photographs by exceeding the non-exclusive licence he had granted to ASTB for their use.

Following correspondence between solicitors on each side, solicitors acting for Mr Malcolm-Green issued a claim form. The time for service of the claim form expired on 29 August 2013. On 6 August 2013, Mr Malcolm-Green successfully applied for an extension of time for service, citing the following reasons: (i) ASTB had been informed in correspondence that the claim form had been issued; (ii) no substantive reply to letters of complaint sent to ASTB in February 2009 and May 2011 had been received until 17 July 2013; (iii) Counsel for Mr Malcolm-Green was abroad for the whole of August 2013 and would not be in a position (or would be very rushed) to draft pleadings by 12 September 2013; and (iv) Mr Malcolm-Green wished to have a further conference with counsel in light of the letter sent on behalf of ASTB on 17 July 2013. ASTB sought to set aside the Order of **District Judge Lambert** by which

Mr Malcolm-Green was granted an extension of time to 30 September 2013 in which to serve his claim form. ASTB also applied for the claim to be struck out.

Applying *Hoddinott v Persimmon Homes (Wessex) Ltd* [2008] 1 WLR 806, **Judge Hacon** concluded that at no stage had Mr Malcolm-Green advanced good reasons for his failure to serve the claim form within the 4 month period; the slowness of ASTB in responding to the claim and his counsel being away on holiday did not qualify. Following *Hoddinott*, in the absence of any good reason, the court could still grant an extension of time provided there were exceptional circumstances. However, the fact that a limitation defence open to ASTB was lost because Mr Malcolm-Green was allowed to extend the period of service was by itself sufficient to exclude him from being entitled, exceptionally, to an extension of time. **Judge Hacon** rejected Mr Malcolm-Green's argument that there would be no loss to ASTB because of time-barred claims if he was excluded from claiming damages in relation to alleged infringements which occurred more than six years before the date on which he would re-issue the claim. Allegations in correspondence may or may not coincide in nature or scope with what was set out in a claim form, and a defendant was entitled to take the view that a claimant was unlikely to pursue the claim and '*let sleeping dogs lie*'.

The Judge stated that Mr Malcolm-Green could and should have served the claim form within the four months and applied for an extension of time to serve the Particulars of Claim, the requirements for which were less stringent.

#### **Award of interim damages and costs**

#### ***Redcrier Publications Ltd & Anr v Redrup Publications Ltd & Anr ('RPL')\** (Mr Recorder Alastair Wilson QC; [2013] EWHC 3481 (IPEC); 08.10.13)**

Redcrier was awarded an interim payment of damages and its costs in relation to RPL's infringement of Redcrier's copyright in a photograph and care home staff training manuals.

Mr Redrup (the second defendant) was a founder of Redcrier, which provided training manuals for care home staff which were delivered in a cabinet labelled 'The Silver Box'. The product was known as the 'Redcrier Silver Box training system'. Mr Redrup subsequently left Redcrier and set up RPL in direct competition. By the time the case came before the IPEC (having been transferred from the High Court), RPL had admitted copyright infringement by copying Redcrier's training manuals and using a photograph of Redcrier's Silver Box. However, Mr Redrup had not admitted liability as a joint tortfeasor and a separate trial was pending in relation to his liability, and separate claims of libel and trade libel. The present issue before the court was Redcrier's application for an interim payment of damages and the question of costs in respect of the copyright claims.

Having regard to the CPR, **Mr Recorder Alastair Wilson QC** determined that Redcrier was entitled to an award of interim damages, and that he was therefore required to assess what amount would be reasonable in the circumstances. Referring to *Nuttal v Fri-Jado* [2010] EWHC 1966 (Pat), he held that court's task was to ascertain what sum it could safely be assumed Redcrier would recover in any event at final judgment.

In assessing the damages which should be awarded for the infringement of the copyright in the photograph, the Recorder assumed that the parties were hypothetically willing to negotiate a licence agreement, and took into consideration the particular circumstances of the case (*32Red v WHG* [2013] EWHC (Ch) 815 applied). In circumstances where the photograph '*represented a significant feature of Redcrier's goodwill*' and given that RPL deliberately used it to benefit from that goodwill, the Recorder was not willing to limit the royalty rate to that which the relatively mundane photograph might otherwise attract. However, despite the actions of RPL, the Recorder did not consider it appropriate at an interim stage to award additional damages pursuant to **Section 97(2)** of the **CDPA** based

on the alleged flagrancy of the infringement. He therefore awarded an interim payment of £750.

Similarly, in assessing the amount of the interim payment for breach of copyright in Redcrier's training manuals (which RPL had used as the basis for its similar training manuals), the Recorder took into account that Redcrier could have extracted a higher royalty rate than normal because RPL had needed the manuals to enter the market as quickly as it did. He awarded Redcrier an interim payment of £36,700 (based on the number of RPL's new customers in the period of infringement, which he divided by the percentage of Redcrier's share of the market, in addition to the notional royalty rate).

The final category of interim damages sought were for loss of income for updates to its customer manuals which Redcrier said it would have achieved, but which it had lost to RPL as a result of RPL's targeted flyers sent to Redcrier's customers. Without fully assessing Redcrier's loss under this heading, and in light of the interim nature of the damages award, the Recorder considered it prudent to base the damages assessment on (i) a '*conservative*' period over which the infringement took place (1 year); (ii) number of lost customers (30); (iii) figure of lost profits per lost customer (£150); and (iv) likely average period of lost business per lost customer (2 years), leading to a total figure of £9,000.

In circumstances where the liability of Mr Redrup was still to be determined, the interim award was made against RPL only.

Finally, the Recorder assessed the interim costs to be awarded to Redcrier and, in doing so, broke each stage of the proceedings into separate periods. In respect of the initial stages (when the case was initially being heard in the High Court), he determined that it was sensible to allocate the costs submitted as one third relating to the copyright infringement claims, one third relating to the libel and trade libel claims, and one third for general costs applicable to both actions. Therefore, at the interim stage, Redcrier was only allowed to recover the one third of the costs which related to the copyright claim exclusively.

There had then been a stage of the proceedings in which the parties were required to focus on the copyright infringement claims, partly due to RPL not admitting liability and partly due to '*untruthful pleadings*' made by RPL regarding the length of the period of infringement. As a result, Redcrier was held to be entitled to 75% of its costs for that period.

Finally, as the copyright infringement claims had been transferred from the High Court to the PCC (as it then was), the stages heard by the PCC were held to be governed by the cost caps set out in the CPR. However, the Recorder refused to award Redcrier its costs relating to the preparation of witness statements the CMC and its summary judgment application, finding that such costs were intended to be included in the cost cap relating to the CMC and other application, and therefore would not be awarded in addition to those cost caps.

## COPYRIGHT

### Copyright in papercuttings

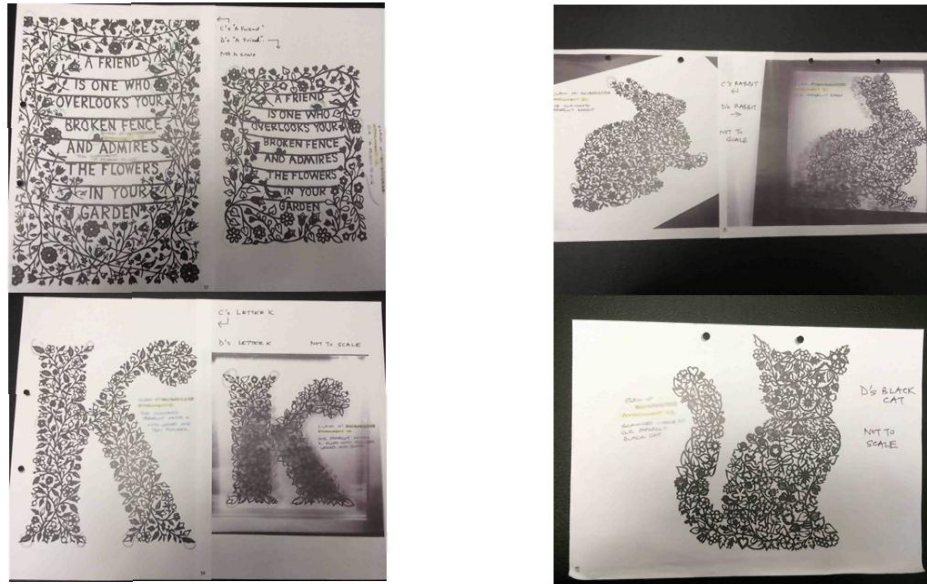
***Suzy Taylor v Alison Maguire***\* (District Judge Clarke; [2013] EWHC 3804 (IPEC); 03.12.13)

**District Judge Clark** held that Maguire had infringed Taylor's copyright in original artistic works comprising a papercut Letter S, Letter K, a Rabbit, a piece entitled 'A Friend and two Cats' (together 'Taylor's Works').

Taylor was a relatively well known artist in the medium of papercutting and sold her work from a Facebook page in the name of Folk Paper Arts. Maguire produced papercutting works which she exhibited and sold from a Facebook page in the name of PAPERtastic.



Taylor claimed that Maguire had infringed the copyright in Taylor's Works by creating, replicating, possessing and dealing in papercut works, namely a papercut Letter S, Letter K, Letter D and pieces entitled 'A Friend ...', a Rabbit and two Cats ('Maguire's Works') which replicated Taylor's Works or the distinct style of Taylor's Works. Certain of Taylor's Works are shown alongside certain of Maguire's Works below:



Maguire denied copyright infringement on the basis that the Maguire Works were independently created, that Taylor's Works were not original, and that any similarity between them was not substantial. In relation to 'A Friend ...', a Rabbit and the two Cats, Taylor sought to rely on the educational defence under **Section 32(1) CDPA**, on the basis that the copies were made for the purposes of her daughter's GCSE Art course and were never intended for sale.

The Judge held that a papercut work was protected by copyright as an artistic work under **Section 4(1)** as a drawing, and if not as a drawing, as a graphic work. He went on to hold that Taylor's Works were original and protected by copyright owned by Taylor. He took into account that in creating each of the works, Taylor made detailed choices including the overall shape of the design, the structure of stems and branches to give them a plant-like appearance and the infill of designs with flowers, birds and insects.

The Judge went onto compare each of Taylor's and Maguire's Works side by side, concluding that there was sufficient similarities between each:

### Letter S

In finding that there was sufficient similarity between Taylor's Letter S and Maguire's Letter S, the Judge identified similarities which included: i) that the main branch arched through the letter in an almost identical way; ii) the use of tear shaped leaves; iii) the use of a flower with five heart shaped petals; vi) the use of serrated leaves; and v) the use of a fan-shaped flower (albeit with a different number of leaves). The Judge also held that the use of these specific elements in an even and unsymmetrical arrangement with a balanced amount of pattern and empty space (the 'Topiary Style') was original. However, the Judge did not consider that the use of the same font, the lack of solid line around the letter and the unsymmetrical arrangement of elements over the shape of the letter were of any relevance since these elements were not part of Taylor's original artistic work protected by copyright in relation to any of Taylor's Works.

### Letter K

In finding that there was sufficient similarity between Taylor's Letter K and Maguire's Letter K, the Judge identified similarities between the two works which included: i) the spines forming the letter K in each case; ii) the use of a hollowed out rosehip/berry motif; iii) the use of flowers shaped like daisies; iv) the unusual motif at the top right of the vertical leg of the K; v) the use of solid flowers with five petals; and vi) the use of the Topiary Style.

### A Friend ...

In finding that there was sufficient similarity between Taylor's 'A Friend ...' and Maguire's 'A Friend ...', the Judge identified similarities which included: i) the words were displayed using the same line breaks; ii) the style of the lettering was extremely similar; iii) the words were suspended from strings attached to the surrounding foliage frame; iv) some of the strings were tied with a very similar bow; and v) the inclusion of similar birds, a snail, a beetle, a spider and a large daisy motif all in the same place.

### Rabbit

In finding that there was sufficient similarity between Taylor's Rabbit and Maguire's Rabbit, the Judge identified similarities between which included: i) the almost identical pose and proportions of the rabbit; ii) the swooping line acting as a central spine of the rabbit; iii) the use of hollowed out spade or tear shaped leaves with the centre retaining piece of visible stem throughout the work; iv) an unusual motif of a pointed leaf split in half throughout the work; and v) use of the Topiary Style.

### Letter D

Taylor had not created a Letter D but claimed that Maguire's letter D was a copy of her work and in particular the Topiary Style. In finding that there was sufficient similarity between Taylor's Works and Maguire's Letter D, the Judge identified similarities which included: i) a central swooping line following the shape of the letter; ii) the use of small infill berries and star shaped thorns; iii) the use of a simple daisy motif; iv) the use of two simple birds; and v) use of the Topiary Style.

### Cats

Maguire had created two works in the shape of a cat, a Black Cat and a Pink Cat. Taylor had not created any work in the shape of a cat but claimed that the Black Cat and Pink Cat were a copy of her work and in particular the Topiary Style. In finding that there was sufficient similarity between Taylor's Works compared to Maguire's Black Cat and Pink Cat, the Judge identified similarities which included: i) the central swooping spine following the shape of the animal; ii) the tail of the Black Cat and Pink Cat being terminated by a flower; iii) flowers being used to denote features such as eyes; iv) use of simple daisy shapes; and v) use of the Topiary Style.

Finally, the Judge held that Maguire had prior access to each of Taylor's Works, that the similarities arose from copying, and that the copying was of a substantial part of Taylor's Works. The Judge rejected the defence under **Section 32(1)** since there was no suggestion that Maguire was the instructor in the context of the GCSE Art course, nor was there sufficient acknowledgment of Taylor's copyright accompanying the work.

## **DATABASES**

### **Database right: infringement by dedicated meta search engine**

#### ***Innoweb B.V ('Innoweb') v Wegener ICT Media B.V., Wegener Mediaventions B.V.; (CJ (Fifth Chamber); Case C-202/12; 19.12.13)***

The CJ has ruled that the use of a dedicated meta search engine can in certain circumstances amount to re-utilisation of the contents of a database under **Article 7(2)(b)** of the **Database Directive (96/9/EC)**.

*Note:* A 'meta search engine' uses search engines from other websites, transferring queries from its users to those other search engines, a feature which differentiates meta search engines from general search engines based on an algorithm, such as Google or Yahoo.

Wegener provided access through its AutoTrack website to an online collection of second-hand car sale advertisements, updated daily. With the help of the AutoTrack website search engine, the user could carry out a targeted search for a vehicle on the basis of various criteria.

Via its 'GasPedaal' website, Innoweb provided a meta search engine dedicated to car sales: through a single query on GasPedaal, the user could simultaneously carry out searches of several collections of car advertisements listed on third party sites, including the AutoTrack website. By means of the GasPedaal dedicated meta search engine, it was possible to search through the AutoTrack collection on the basis of specific criteria and 'in real time', i.e. at the time when a GasPedaal user entered his query. GasPedaal carried out that query in 'translated' form, translating the query into the format required for AutoTrack's search engine.

The results collated by the AutoTrack website, i.e. cars meeting the criteria chosen by the end user, which were also to be found on the results pages of other sites, were merged into one item with links to all the sources where that car was found. A webpage was then created with the list of the results thus obtained and merged, which showed essential information relating to each car. That webpage was stored on the GasPedaal server and sent to the user or shown to him on the GasPedaal website, using the format of that site. For each search performed, the GasPedaal search engine only returned search results representing a small number of the advertisements on the Autotrack website (those which matched the relevant search terms).

Wegener successfully sued GasPedaal for infringement of its *sui generis* database right. GasPedaal appealed, and the Hague Court of Appeal stayed the proceedings pending a reference to the CJ for a preliminary ruling *inter alia* on the following questions:

- (1) Is **Article 7(1)** of the **Database Directive** to be interpreted as meaning that the whole or a qualitatively or quantitatively substantial part of the contents of a database offered on a website (on line) is re-utilised (made available) by a third party if that third party *makes it possible* for the public to search the whole contents of the database or a substantial part thereof in real time with the aid of a dedicated meta search engine provided by that third party, by means of a query entered by a user in 'translated' form into the search engine of the website on which the database is offered?
- (2) If not, is the situation different if, after receiving the results of the query, the third party sends to or displays for each user a very small part of the contents of the database in the format of his own website?
- (3) Is it relevant to the answers to Questions 1 and 2 that the third party undertakes those activities continuously and, with the aid of its search engine, responds daily to a total of 100,000 queries received from users in 'translated' form and makes available the results thereof to various users in a manner such as that described above?

The CJ noted that the dedicated meta search engine did not have its own search engine scanning other websites. Instead it made use of the search engines on the websites covered by its service. By translating its users' queries it enabled all the data on the third party databases to be searched through. As a result the dedicated meta search engine offered advantages similar to those of the database itself in terms of the formulation of the query and the presentation of the results.

The concept of 're-utilisation' for the purpose of **Article 7(2)(b)** requires the 'making available to the public of all or a substantial part of the contents of a database by the distribution of copies, by renting, by online or other forms of transmission.' The 'making available' was held to be to the public as anyone can use a dedicated meta search engine. The

re-utilisation involved a substantial part of the contents of the database since the dedicated meta search engine made it possible to search the entire contents of that database as though the query were entered directly into the database's search engine. The fact that only part of the database was actually consulted and displayed on the basis of the search criteria specified by the end user was irrelevant, and did not detract from the fact the entire database was made available to that end user.

The end user no longer had any need, when researching data, to go to the website of the database concerned, or its homepage, or its search form, in order to consult that database, since he could consult the contents 'in real time' through the website of the dedicated meta search engine. As a result there was a risk that the database maker would lose income, particularly from advertising displayed on his website, thereby depriving the maker of revenue which should have enabled him to recoup investment costs of setting up and operating the database, as it might be more profitable for advertisers to place their advertisements on the website of the dedicated meta search engine, or other databases.

The operator of the dedicated meta search engine provided the end user with a form of access to the database and the information stored in it that was different from the access route intended by the database maker, whilst providing the same advantages in terms of searches. The CJ held that this came close to the manufacture of a parasitical competing product as referred to in **Recital 42**. Since the search carried out by the dedicated meta search engine threw up the same list of results as would have been obtained by separate searches carried out in each of the databases, the end user no longer has to go to the website of the database. Even if he wanted to go to a particular displayed advertisement, because duplicate results are grouped together, it was possible he would consult that advertisement on another database site.

The CJ ruled that it would in the circumstances be an infringement of the *sui generis* database right to use a meta search engine. **Article 7(1)** must be interpreted as meaning that an operator who makes available on the Internet a dedicated meta search engine such as that at issue re-utilises the whole or a substantial part of the contents of a database protected under **Article 7**, where that dedicated meta engine:

- provides the end user with a search form which essentially offers the same range of functionality as the search form on the database site;
- 'translates' queries from end users into the search engine for the database site 'in real time', so that all the information on that database is searched through; and
- presents the results to the end user using the format of its website, grouping duplications together into a single block item but in an order that reflects criteria comparable to those used by the search engine of the database site concerned for presenting results.

### **Katharine Stephens, Zoe Fuller and Hilary Atherton**

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The reported cases marked \* can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at [http://curia.europa.eu/jcms/jcms/j\\_6/home](http://curia.europa.eu/jcms/jcms/j_6/home)