

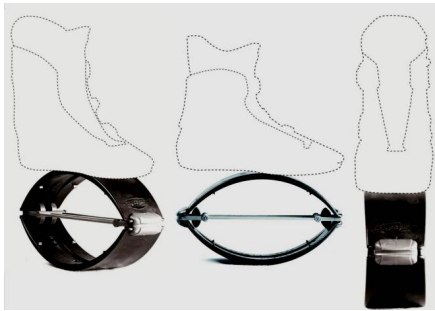



TRADE MARKS

Decisions of the CJ and GC


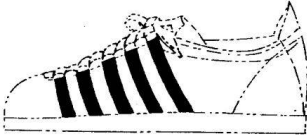

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC T-248/14 <i>Masafi Co. LLC v OHIM; Hdı Ltd</i> (25.11.15)</p>	 <p>- beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages (32)</p> <p>MASAFI</p> <p>- various alcoholic and non-alcoholic drinks including soft drink colas and vegetable drinks and vegetable juices (32)</p> <p>(UK mark)</p>	<p>The GC upheld the BoA's decision to refuse registration of the mark under Art 8(1)(b).</p> <p>The BoA had been correct to find that the goods at issue were identical or similar. Whilst soft drink colas were not identical to mineral and aerated waters they were of average similarity. The same applied to fruit drinks and fruit juices as compared to vegetable drinks and vegetable juices.</p> <p>The BoA was also correct to find a high degree of visual and phonetic similarity between the marks. The mark applied for was dominated by the term 'masafi' which had only limited stylisation. The term 'juice' was descriptive and merged into the background due to its size and colour. The other elements of the mark would not specifically draw the public's attention or they would be perceived as secondary figurative elements. This conclusion was not altered by Masafi's submission that 5% of the UK public was Arabic-speaking and would understand the term 'masafi' to be descriptive.</p> <p>Given the identical or similar nature of the goods and the high degree of visual and phonetic similarity between the marks, the BoA had been correct to find a likelihood of confusion.</p>
<p>GC T-249/14 <i>Masafi Co. LLC v OHIM; Hdı Ltd</i> (25.11.15)</p>	 <p>- various goods in Class 29 including preserved and cooked fruits, jams and compotes (29)</p> <p>- various goods in Class 32</p>	<p>The GC upheld the BoA's decisions to refuse registration of the mark under Art 8(1)(b).</p> <p>Following the reasoning adopted in case T-248/14 (reported above) the BoA had been correct to find that mineral waters were similar to soft drink colas and fruit drinks and fruit juices were similar to vegetable drinks and vegetable juices. The BoA had</p>



	<p>including mineral waters and fruit drinks and fruit juices (32)</p> <p>MASAFI</p> <p>- various goods in Classes 29 and 30 including sauces (condiments)</p> <p>- various alcoholic and non-alcoholic drinks including soft drink colas and vegetable drinks and vegetable juices (32)</p> <p>(UK mark)</p>	<p>also been correct to find that the other goods at issue were identical or similar. Whilst certain specific preserved and cooked fruits and jams and compotes differed in their purpose and use from 'sauces (condiments)', the general description covered identical or similar goods.</p> <p>Following the reasoning adopted in case T-248/14 the BoA had been correct to find a high degree of visual and phonetic similarity between the marks and therefore a likelihood of confusion.</p>
<p>GC</p> <p>T-390/14</p> <p><i>Établissement Amra v OHIM (KJ KANGOO JUMPS XR)</i></p> <p>(26.11.2015)</p>	 <p>The description of the mark is as follows:</p> <p>'Position mark, consisting of the lower spring portion of a sporting and exercising device. The claimed lower spring portion is placed under an upper foot-receiving portion (not claimed by the applicant) and comprises an upper spring layer arched upwardly, a lower spring layer arched downwardly and an intermediate component consisting in elastic plastic straps. The figurative mark "KANGOO JUMPS" is placed in both the upper spring layer and the lower spring layer. The letters "KJ" and "XR" are placed at the ends of the intermediate elastic plastic straps. No colours are claimed as a feature of the mark. The dotted outline is intended to show the position of the mark and is not a part of the mark.'</p> <p>- gymnastic and sporting articles not included in other classes (28)</p>	<p>The GC, agreed with the BoA's decision that the mark was devoid of distinctive character under Art 7(1)(b).</p> <p>The BoA was correct to reject the submission that consumers of gymnastic and sporting articles were accustomed to distinguishing the origin of different articles by a number of 'non-conventional trademarks', such as the shape of the upper part of a treadmill and the air-cushioning unit in the heel of a sports shoe. OHIM rightly stated that whilst this might be true for consumers who practiced sports particularly intensively, in this instance the relevant public was the average European consumer and not a consumer who practiced sport very intensively.</p> <p>The GC also held that the mark did not depart significantly from the basic shape of the goods concerned. Even if the lower part of the model of the rebound boots could be regarded as unusual, that was not sufficient to influence the overall impression made by the mark to such a degree that it could be said to depart significantly from the norm or customs of the sector and thereby to be capable of fulfilling its essential function.</p> <p>Finally the GC found that the word and figurative elements of the mark were extremely minor, and, therefore, of such a superficial nature that they did not bring any distinctive character to the mark applied for as a whole.</p>


<p>GC</p> <p>T-718/14</p> <p><i>Hong Kong Group Oy v OHIM; WE Brand Sarl</i></p> <p>(30.11.15)</p>	 <p>- clothing, footwear, headgear (25)</p> <p>- retail and wholesale services featuring fishing tackle, clothing, footwear and headgear (35)</p> <p>WE</p> <p>- clothing, footwear, headgear (25)</p> <p>- business mediation in purchase and sale of clothing, footwear and headgear (35)</p>	<p>The GC annulled the BoA's decision that found a likelihood of confusion between the marks under Art 8(1)(b).</p> <p>The BoA was incorrect to find that the marks in question were similar. In terms of the visual comparison, the BoA erred in finding that that the letters "w" and "e" were the dominant elements of the mark applied for. The GC found that in fact the figurative elements dominated the mark applied for. As the structure of the marks at issue were very different, the GC found them to be visually dissimilar overall.</p> <p>Phonetically, the GC found that the 'w' and 'e' elements of the mark applied for would be pronounced either as two individual letters or as "West" and "East" whereas the earlier mark applied for would be pronounced as "we". Therefore the marks were also phonetically dissimilar. The marks also differed conceptually; the mark applied for would be understood as a reference to a weather vane whereas the earlier mark would have no meaning (for the Spanish-speaking public) or it would be understood to refer to the pronoun we (for those with an understanding of English).</p> <p>As the marks were dissimilar overall, it followed that there was no likelihood of confusion between them.</p>
<p>GC</p> <p>T-414/13 T-522/13</p> <p><i>Kenzo Tsujimoto v OHIM; Kenzo</i></p> <p>(02.12.15)</p>	<p>KENZO</p> <ul style="list-style-type: none"> - soaps, perfumery, essential oils, cosmetics, hair lotions (3) - leather goods, bags, hand bags, trunks and suitcases (18) - clothing, footwear (except orthopedic footwear), headgear (25) <p>KENZO ESTATE</p> <ul style="list-style-type: none"> - wine; alcoholic beverages of fruit; western liquors (in general) (33) <p>(international registration designating the European Union - Case T-414/13)</p>	<p>The GC upheld the BoA's to allow the oppositions on the basis that the mark applied for would take unfair advantage of the reputation of the earlier mark pursuant to Art 8(5) and no due cause for its use had been demonstrated.</p> <p>The GC held that the BoA was correct to exercise its discretion under Art 76(2) in both cases to consider evidence submitted by Kenzo as proof of genuine use of the earlier mark when assessing whether that mark also enjoyed a reputation.</p> <p>The GC found that, for the purposes of Art 8(5), 'ESTATE' had too little effect to attenuate the high degree of</p>

	<ul style="list-style-type: none"> - olive oil; edible oils and fats; raisins; processed vegetable and fruit; frozen vegetables; frozen fruits; processed meat products; processed seafood (29) - confectionery, bread and buns; spices; sandwiches; pizzas; hot dogs (30) - grapes (fresh); olives (fresh); fruits (fresh); vegetables (fresh); seeds and bulbs (31) - marketing research on wine; providing information on wine sales; retail services or wholesales services for liquor (35) - educational and instruction services relating to general knowledge of wine; testing and certifying of sommelier certification; publication of books on wine (41) - providing foods and beverages; providing temporary accommodation (43) <p>(international registration designating the European Union - Case T-522/13)</p>	<p>similarity between the marks and lacked any distinctive character for a significant number of the relevant English – speaking consumers. The GC agreed that consumers were more likely to take into account the beginning of a mark, rather than its ending and endorsed the BoA's finding on similarity, on the basis that the mark applied for consisted exclusively of the earlier mark.</p> <p>The BoA was correct to find that the earlier mark enjoyed a reputation for clothing, perfume and cosmetics aimed at consumers in the luxury goods market and that there was a link between those goods and the applicant's goods in Class 33 and services in Classes 35, 41 and 43. It was highly likely that the mark would ride on the coat tails of the earlier trade mark in order to benefit from the power of attraction, reputation and the prestige of the earlier mark and that Tsujimoto would exploit the marketing effort of KENZO expended to create and maintain that image, without providing due financial compensation.</p>
<p>GC T-528/13 <i>Kenzo v OHIM;</i> <i>Kenzo Tsujimoto</i> (02.12.15)</p>	<p>KENZO</p> <ul style="list-style-type: none"> - soaps, perfumery, essential oils, cosmetics, hair lotions (3) - leather goods, bags, hand bags, trunks and suitcases (18) - clothing, footwear (except orthopedic footwear), headgear (25) <p>KENZO ESTATE</p> <p>Those goods forming part of the application considered under Case T-522/13</p>	<p>The GC annulled the BoA's decision in so far as it rejected the opposition in respect of goods under Classes 29 to 31 and found that the mark applied for would take unfair advantage of and be detrimental to the distinctive character and reputation of the earlier mark, pursuant to Art 8(5).</p> <p>The GC agreed with Kenzo that there was a certain closeness between some of the goods covered by Classes 29 to 31 (such as olive oil and wine vinegar) and the luxury goods for which the earlier mark enjoyed a reputation. As these goods may be sold alongside each other and given the degree of similarity between the marks, there was a risk that the mark applied for would take unfair advantage of the earlier mark's reputation in respect of these goods.</p> <p>With regards to the goods in Class 29</p>

		to 31 deemed by the BoA to be 'common mass-consumed foodstuffs that are bought in any corner shop' including pizza, hot dogs and meat pies, the GC held that the registration applied for in respect of those goods would be detrimental to the distinctive character and reputation of the earlier mark and that association to those goods could damage the image of exclusivity, luxury and high quality associated with the earlier mark.
<p>GC T-528/14 <i>Information Resources, Inc., v OHIM</i> (02.12.15)</p>	<p>GROWTH DELIVERED</p> <ul style="list-style-type: none"> - advertising, business management, administration and consultancy services (35) - education services, publication of text and training services (41) - scientific and technological services and research, design and industrial analysis services (42) 	<p>The GC upheld the BoA's decision that the mark should not be registered because it was devoid of distinctive character under Art 7(1)(b).</p> <p>The BoA was correct to find that the mark meant that 'growth is provided' in the sense that use of the services offered by Information Resources represented a source of growth for the recipients and users of those services. As such, the mark conveyed a laudatory message as it highlighted the qualities and usefulness of the services concerned and suggested to the relevant public that services bearing that trade mark had those qualities and were useful in terms of growth. The mark would therefore be immediately and necessarily understood by the relevant public as informing it of the quality of the services and their usefulness as to the desired growth process. The BoA was therefore correct in concluding that the mark was devoid of distinctive character.</p>
<p>GC T-628/14 <i>Hewlett Packard Development Company LP v OHIM</i> (03.12.15)</p>	<p>FORTIFY</p> <ul style="list-style-type: none"> - software for analysing source code; software for detecting and describing vulnerabilities and associated mitigation techniques based on an analysis of source code; software for preventing hacking of or attacks on computer programs and software systems based on runtime analysis of software behaviour and use; computer software (9) 	<p>The GC dismissed the appeal from the BoA's decision that the mark was descriptive pursuant to Art 7(1)(c).</p> <p>The BoA was correct in finding that the term 'fortify' designated an intended purpose of the goods concerned, namely to strengthen or reinforce a computer system. The relevant public would immediately and without further reflection perceive the intended purpose of the goods. Therefore the BoA was entitled to find that the mark was descriptive of the goods.</p>

<p>GC</p> <p>T-647/14 T-648/14</p> <p><i>Infusion Brands, Inc. v OHIM</i></p> <p>(03.12.15)</p>	 <p>- agricultural implements, machines, power tools, power saws, power drills, power driven screw drivers, power sanders and power grinders other than those that are hand-operated (7)</p> <p>-hand-operated hand tools and implements and their parts (8)</p> <p>- wholesaling and retailing the above goods (35)</p>	<p>The GC upheld the BoA's decisions that the marks applied for were descriptive under Art 7(1)(c).</p> <p>The meaning of the words comprising the marks applied for was clear: 'a [saw/tool] having a twofold or double character or nature'. The relevant public would immediately perceive the marks as references to possible characteristics of the goods and services in question.</p> <p>The GC rejected the submission that the marks applied for had highly figurative components which determined the overall impression of them. The BoA was correct that the marks applied for were descriptive under Art 7(1)(c).</p>
<p>GC</p> <p>T-3/15</p> <p><i>K-Swiss Inc. v OHIM</i></p> <p>(04.12.15)</p>	 <p>- athletic shoes, namely tennis shoes, basketball shoes, cross-country and jogging shoes and casual shoes (25)</p> <p>(International registration designating the EU)</p>	<p>The GC dismissed the appeal from the BoA's decision that the mark was not distinctive pursuant to Art 7(1)(b).</p> <p>The BoA was correct to find that the stripes were nothing more than a rather banal generic embellishment. The placing of the mark on the side of the shoe was not likely to attract the attention of the relevant public and to distinguish it from other designs applied to the side of shoes.</p> <p>Contrary to K-Swiss's submissions, it was not possible to conclude that simple geometric shapes placed on the side of a sports shoe necessarily had a distinctive function. Even if it were accepted that the average consumer paid particularly close attention to the shapes placed on the side of the shoe, K-Swiss had not adduced sufficient evidence to establish that, in view of its banal nature, the average consumer would consider that mark to be an indication of the origin of the goods at issue and not a mere decorative element.</p>
<p>GC</p> <p>T-525/14</p> <p><i>Compagnie générale des établissements Michelin v OHIM;</i></p>	 <p>- tyres; inner tubes for tyres (12)</p>	<p>The GC annulled the BoA's decision and found that there was a likelihood of confusion under Art 8(1)(b).</p> <p>Contrary to the BoA's finding, the word element 'king' of the mark applied for was weakly distinctive. It would be perceived by the French</p>

<p><i>Continental Reifen Deutschland GmbH</i> (08.12.15)</p>	 <p>- envelopes; inner tubes for pneumatic tyres (12) (French mark)</p>	<p>public which understood basic English as meaning 'king' or 'the best' and thus conveyed a laudatory message.</p> <p>The BoA erred in its finding that the visual similarity was low. In view of the dominant character of the letter 'x' of the mark applied for, the weak distinctive character of 'king', and the similarity between the letter 'x' of the mark applied for and the letter 'x' of the earlier French mark, the marks were visually similar to an average degree.</p> <p>The BoA was also wrong to consider that the phonetic similarity was lower than average. Since the marks at issue shared the same first syllable, they were phonetically similar to an average degree. A conceptual comparison of the mark applied for and the earlier French mark was not possible.</p> <p>In view of the strong similarity or identity of the goods concerned the GC held that there was a likelihood of confusion pursuant to Art 8(1)(b), even if the relevant public's degree of attentiveness was high.</p>
<p>GC T-690/14 <i>Sony Computer Entertainment Europe Limited v OHIM; Marpefa, SL</i> (10.12.15)</p>	 <p>- recording discs; cleaning devices for recording discs; loudspeakers; loudspeaker systems; sound amplifiers; video tapes; magnetic tapes; cabinets for loudspeakers; video cameras; exposed cinematographic films; compact discs; transparencies; photographic apparatus; computers; video screens; apparatus for the reproduction of sound and images; television sets; record players (9)</p>	<p>The GC upheld the BoA's decision to reject the revocation action in respect of 'loudspeakers, loudspeaker systems, sound amplifiers, computers, video screens, television sets and record players' on the basis that the mark had been put to genuine use during the relevant period for the purposes of Arts 51(2) and 15(1).</p> <p>The GC however disagreed that the registration could be maintained in relation to 'apparatus for the reproduction of sound and images'. That expression could not be considered to be defined sufficiently precisely and narrowly as it could at least be subdivided into two categories: 'apparatus for the reproduction of sound' and 'apparatus for the reproduction of images'. The expression included a wide array of audio-visual and electronic equipment including equipment for which genuine use had not been established.</p>

<p>CJ C-603/14 <i>El Corte Inglés v OHIM</i> (10.12.15)</p>	<p>THE ENGLISH CUT - clothing except suits, trousers and jackets; footwear; headgear (25)</p> <p>EL CORTE INGLÉS - footwear (25)</p>  <p>- clothing; footwear; headgear (25)</p>	<p>The CJ partially set aside the finding of the GC in so far that it found that there was an insufficient degree of similarity between the marks to satisfy the conditions of Art 8(5). The case was remitted to the GC.</p> <p>The GC had found that a degree of conceptual similarity existed between the marks but had concluded that this was insufficient to demonstrate a likelihood of confusion under Art 8(1)(b).</p> <p>However, a low level of similarity which did not lead to a likelihood of confusion under Art 8(1)(b) was not necessarily too low to be capable of leading the relevant public to make a connection between the signs for the purposes of Art 8(5).</p> <p>The GC erred when it concluded that it was apparent from the Art 8(1)(b) comparison that the marks were not similar and therefore that the Art 8(5) conditions were not satisfied. The GC should have examined whether the degree of similarity, albeit low, when taken in combination with the reputation of the earlier mark, was sufficient to for the relevant public to establish the link required for the purposes of Art 8(5).</p>
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Earlier rights in a particular locality

***Caspian Pizza Ltd & Ots v Maskeen Shah & Anr* (Judge Hacon; [2015] EWHC 3567 (IPEC); 09.12.15)**

Judge Hacon dismissed Caspian's claim for infringement of its CASPIAN word mark and CASPIAN PIZZA device mark. Its claim for passing off also failed and the Judge found that the CASPIAN word mark was invalidly registered pursuant to **Section 5(4)(a)**.

Mr Zarandi and Mr Zand (the second and third claimants) were co-proprietors of the word and device marks which were registered in 2005 and 2010 for restaurants and related services, and specified foodstuffs including those suitable for making pizzas, respectively. They owned a chain of Caspian Pizza restaurants located in and around Birmingham, the first having opened in 1991. In 2012 they licensed the trade marks to Caspian Pizza Ltd, following which the business was conducted through that company.

Mr Shah opened a pizza restaurant called Caspian Pizza in Worcester in 2004. Caspian claimed that Mr Shah signed up to a franchise agreement which was terminated in December 2013 and that Mr Shah's continued use of the CASPIAN marks since that date amounted to trade mark infringement and passing off. However, on the evidence, the Judge found that there had been no franchise agreement and that Mr Shah's Worcester restaurant had either generated its own goodwill associated with CASPIAN, or had shared and added to the

goodwill of his first Caspian Pizza business which had operated from 2002 until 2005 and which was a few minutes' walk away.

Infringement

Mr Shah conceded that his Worcester restaurant used signs similar to the CASPIAN trade marks in relation to similar goods and services, and he relied mainly on **Section 11(3)** in his defence, i.e. use of the signs alleged to infringe the marks constituted use of an earlier right which only applied in a particular locality (the Worcester area). **Judge Hacon** identified an inconsistency between the wording of **Section 11(3)** and that of **Article 6(2)** of the Directive. However, interpreting the national legislation in a manner consistent with the Directive, he held that since 2002 Mr Shah's businesses in Worcester would have generated sufficient local goodwill to enable him to restrain the use by others of the CASPIAN name for a pizza business in Worcester. Therefore, Caspian was prevented from enforcing its marks in Worcester despite the local goodwill generated by Mr Zarandi since 1991 in Birmingham.

In any event, the Judge found that Mr Shah and the second defendant company were not liable for trade mark infringement because neither had material involvement in the Worcester pizza restaurant after the termination of the alleged franchise agreement. Nor was Mr Shah jointly liable, as merely leasing the premises used for the restaurant to a third party who ran the business did not amount to active co-operation in the relevant acts by that party.

Invalidity

Judge Hacon held that the CASPIAN word mark was invalid under **Section 5(4)(a)**. Mr Shah or his successors owned goodwill in the Worcester restaurant business prior to the registration of the mark and were therefore entitled to prevent another party trading in the sale of pizza in Worcester under the CASPIAN name. In so finding, the Judge preferred the approach taken by the hearing officer in *SWORDERS Trade Mark* (O-212-06) to that of **Judge Birss** in *Redd Solicitors LLP v Red Legal Ltd* [2012] EWPC 54. As Mr Shah did not know that the mark had been registered until the dispute had begun in 2013, the relevant five year period for establishing statutory acquiescence under **Section 48** had not yet expired. The device mark was not found to be invalid because it had only appeared on pizza boxes provided to Mr Shah by a catering wholesaler which had also provided identical boxes to third parties. There was therefore no earlier right on which Mr Shah could rely.

Passing off

The Judge found that by December 2013 there was sufficient local goodwill owned by Caspian associated with CASPIAN to give the business a cause of action in passing off. However, that goodwill was found not to have extended as far as Worcester. Therefore the claim for passing off failed.

Oppositions based on bad faith require material consequences of that bad faith

***Envirotecnic v Gutterclear UK Ltd* (John Baldwin QC; [2015] EWHC 3450 (Ch); 08.12.15)**

Mr John Baldwin QC (sitting as a Deputy Judge), dismissed Envirotecnic's appeal from a decision of the hearing officer by which she rejected its application for invalidity of Gutterclear's device mark, as shown below:



Envirotecnic owned an earlier CTM for the word GUTTER-CLEAR which was registered in Class 19 in respect of 'Non-metal rain gutter filters in the nature of foam inserts for maintaining gutters and downspouts.' Gutterclear's trade mark for the above device was

registered in Class 37 for '*Commercial, industrial & residential cleaning services. Cleaning equipment rental services.*' The hearing officer had rejected both grounds on which Envirotecnic's application for invalidity was based. Firstly, she found that there was no likelihood of confusion between the marks under **Section 5(2)(b)**. Secondly, she found that, for the purposes of **Section 3(6)**, Gutterclear had not applied for its mark in bad faith by having failed to inform Envirotecnic of its application.

John Baldwin QC considered that the hearing officer had erred by not taking into account the essentially descriptive messages conveyed by the words of the two marks and by concluding that the conceptual differences were sufficiently significant to matter. While he was of the opinion that there would be a very strong conceptual similarity between the two marks if considered as essentially word marks, and scarcely any conceptual difference (which the hearing officer was mistaken not to have recognised when carrying out the requisite global assessment), he found that the marks were visually very different due to the distinctive colour of Gutterclear's mark. When taking all matters into account and making a global comparison, the hearing officer was correct to conclude that there was insufficient similarity, and therefore no likelihood of confusion, between the marks.

John Baldwin QC also rejected Envirotecnic's argument that Gutterclear's mark had been registered in bad faith. Firstly, the value of the lost opportunity to oppose the mark prior to registration was nil. If an opposition based on **Section 5(2)(b)** had failed, the mark would have proceeded to registration in any event, whereas if the opposition had succeeded then the same attack brought under the present invalidity proceedings would also have succeeded. Secondly, there was no duty on trade mark applicants to inform competitors of their plans. The Judge stated that persons interested in trade marks should rely on their own resources rather than relying on competitors or other third parties to keep themselves properly informed.

DESIGNS

Invalidity action against a design for cases for portable computers

Min Liu v OHIM; DSN Marketing Ltd (GC; Case T-813/14; 18.11.2015)

The GC dismissed an appeal from the BoA's decision that the design was invalid because an identical design had been disclosed before the priority date. Min Liu owned the following Community design registration for 'cases for portable computers' (the 'Contested Design'):



DSN Marketing Limited submitted an application for a declaration of invalidity of the design under **Article 25(1)(b)** of the **Community Designs Regulation (No. 6/2002)** on the basis that it was not novel under **Article 5** of the Regulation in light of two iPad cases made available on amazon.co.uk prior to the priority date.

The GC concluded that the Contested Design lacked novelty under **Article 5**. Min Liu appealed to the GC.

The GC dismissed Min Liu's submission that the earlier disclosures could not affect the novelty of the Contested Design because they were disclosures made by a third party on the basis of information provided or action taken by the designer within the meaning of **Article 7(2)**. The BoA was entitled to conclude that Min Liu had not proved he was the creator of the Contested Design. The evidence submitted by Min Liu, including AutoCAD designs which

suggested it took 18 minutes to create the Contested Design, was flawed. As such, Min Liu was not justified in relying on the provisions of **Article 7(2)** or in claiming that the earlier disclosures did not place in question the novelty of the Contested Design.

The GC further held that Min Liu's submission that the BoA had incorrectly assessed and not treated equally certain evidence was unfounded. The submissions made by Min Liu were not capable of proving that the BoA had treated evidence submitted by the parties unequally.

The BoA was therefore correct to find the contested design invalid under **Article 25(1)(b)**.

COPYRIGHT

Court of Appeal rules on ownership of copyrights in Bob Marley works

BSI Enterprises Ltd & Anr ("BSI") v Blue Mountain Music Ltd* (Arden, Kitchin & Lloyd Jones LJJ; [2015] EWCA Civ 1151; 18.11.15)

The CA (**Kitchin LJ** giving the lead judgment) dismissed BSI's appeal from the decision of **Mr Richard Meade QC** (sitting as a Deputy Judge) in which he held that the '1992 Agreement' between CMI (Bob Marley's publisher) and ILL was effective to transfer the copyrights in certain Bob Marley works to ILL, such that BSI had no rights therein (reported in *CIPA Journal*, July 2014).

Between 1973 and 1976 Bob Marley wrote thirteen songs, including one of his most famous, 'No Woman No Cry', which were deliberately misattributed to various other authors ('the Works'). Bob Marley's object in doing this was to gain control of the copyrights in the Works in place of CMI, and to gain remuneration from them.

Blue Mountain was part of a group of companies which included ILL. In March 1992, ILL entered into the 1992 Agreement with CMI to acquire rights in various Bob Marley works. This was pursuant to a general desire by a group of companies, including ILL, and Bob Marley's estate to acquire the rights in Bob Marley's works.

In 2008, BSI entered a contract with CMI to purchase the copyrights in the Works on the basis that the copyrights were not included in the 1992 Agreement and were therefore still owned by CMI. BSI now sought a declaration that the copyrights in the Works were owned by BSI. The outcome turned on the proper interpretation of the 1992 Agreement.

The CA rejected an alternative interpretation of the 1992 Agreement put forward by BSI to that it had advanced at trial. It also rejected BSI's submission that the Judge had erred by insisting that the language of the 1992 Agreement must accommodate ILL's stated commercial objective to obtain as many rights in Bob Marley's creative output as possible. The CA found that the Judge had directed himself properly as to the relevant principles governing the interpretation of contracts as a matter of English law and had reminded himself that the task was to ascertain the meaning which the agreement would convey to a reasonable person having all the background knowledge which would have been reasonably available to the parties in 1992. The CA agreed with the Judge's finding that the rights in the Works were transferred to ILL under the 1992 Agreement.

IPEC rules on ownership of copyright in West End musical songs

Henry Hadaway Organisation Ltd ("HHO") v Pickwick Group Ltd & Ots* (Melissa Clarke; [2015] EWHC 3407 (IPEC); 25.11.15)

Melissa Clarke (sitting as a Deputy Judge) held that HHO was the exclusive licensee of some, and the owner of other, sound recordings of music from West End musicals. As Pickwick had no right to exploit any of the recordings and no consent from the owner of the

recordings which were licensed to HHO, albums it had released which contained the recordings infringed the copyright in all of them.

Recordings were made between 1991 and 1997 pursuant to an arrangement between the well-known late record producer Gordon Lorenz and music publisher and distributor Pickwick Group ("Pickwick 1") which was unrelated to the defendant ("Pickwick 2") despite the similar name.

HHO claimed that copyright in the Recordings vested in the second defendant, GLPL (a management company owned by Gordon Lorenz) as the author and first owner. HHO claimed it was an exclusive licensee of some of the Recordings pursuant to an agreement with GLPL of February 2008, and the owner of the copyright in the other Recordings pursuant to an assignment from GLPL of December 2008. HHO claimed infringement of copyright in the recordings by Pickwick 2 through the production and sale of various albums on which the Recordings were included. Pickwick 2 denied that HHO was the owner or exclusive licensee of the relevant copyrights, which it claimed were owned by Pickwick 1 from the date of creation of the Recordings and never assigned to GLPL. Accordingly it asserted that GLPL had no rights capable of exclusive license or assignment to HHO in 2008.

Referring to *Robin Ray v Classic FM* [1998] FSR 622 and *Slater v Wimmer* [2012] EWPC 7, the Judge found that Pickwick 1 commissioned and financed the production of the Recordings but that GLPL, by creating the idea of a collection of low-cost high quality recordings of West End musicals and pitching it to Pickwick 1, was the person making the arrangements necessary for the making of the Recordings. As such, it was the author of the Recordings as the evidence did not support joint authorship. The Judge accepted HHO's case that an agreement in 1992 (which could not be found) between GLPL and Pickwick 1 did not displace the copyright from GLPL but merely provided Pickwick 1 with an exclusive licence to exploit the Recordings in return for a royalty.

Interpreting the December 2008 agreement to give effect to the commercial intention of GLPL and HHO, the Judge found that, in light of the February 2008 agreement which provided HHO with an exclusive licence in perpetuity to many of the Recordings, the "only place to go" for the parties in entering into the subsequent agreement was an assignment. The Judge went on to find that the wording of the December 2008 agreement was sufficiently clear to convey to the reasonable person with the relevant knowledge that it was intended to be an assignment to HHO.

As Pickwick 2 knew that it was neither the owner nor the licensee of the copyright in the Recordings at the time its albums were released, the Judge found that Pickwick 2 knew that those albums infringed the relevant copyrights and had no defence of consent in relation to the Recordings in which the copyright remained owned by GLPL.

Katharine Stephens, Zoe Fuller, Hilary Atherton and Emma Green

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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