

Oxford International Intellectual Property Moot 2016

Instructions

The 2016 moot concerns the case *Erewhon Community Games Association v Erewhonian Animal Sanctuary & Slaven* [2015] HCE 50, [as amended on 9 November 2015 \(see para. 27\)](#). A copy of this case is included in the pages that follow, along with relevant provisions from the Erewhonian Copyright Act 1997 and the Erewhon Community Games Indicia Act 2011 (as amended).

At first instance in the High Court of Erewhon, Madam Justice Davies found that:

- i. the Sanctuary and Mr Slaven each acted in contravention of s. 4 of the Indicia Act, as read in conjunction with ss. 3 and 5 (using for a prohibited purpose); and
- ii. Mr Slaven did not infringe copyright because he had a defence under s. 56 of the Copyright Act (making of subsequent works by same artist). In deciding the copyright claim, Madam Justice Davies rejected Mr Slaven's alternative defence pleaded under s. 44(1) (fair dealing).

The defendants were granted leave to appeal from this judgment. The grounds of appeal were that the trial judge erred in: (1) finding that each of the defendants performed acts in contravention of the Indicia Act; and (2) rejecting Mr Slaven's fair dealing defence. The claimant brought a cross-appeal that Madam Justice Davies was wrong to conclude that the s. 56 defence was applicable.

By order, without issuing an opinion, a unanimous bench of the Court of Appeal overturned the trial decision in relation to the claims under the Indicia Act; upheld the trial judge in relation to fair dealing; and overturned her conclusion in relation to s. 56. This resulted in neither defendant being liable under the Indicia Act, but Mr Slaven being liable for copyright infringement.

The claimant has been granted leave to bring a further appeal to the Supreme Court of Erewhon on its actions under the Indicia Act, and the defendants a further cross-appeal on the claimant's copyright cause of action. The appeal before the Supreme Court will therefore cover:

1. in relation to the **Indicia Act**, whether the Sanctuary and Mr Slaven each performed acts in contravention of s. 4;
2. in relation to the **Copyright Act**, whether Mr Slaven has a defence under s. 44(1) and/or s. 56.

It is your task to prepare written and (for teams that are invited to the Oral Proceedings) oral submissions for this appeal.

Some points to consider:

- a. Each written submission must cover all issues on appeal, i.e., make submissions on both the appeal and cross-appeal.
- b. Whilst you are encouraged, within the grounds of appeal, to present arguments and authorities not mentioned by Madam Justice Davies, you should not seek to introduce entirely new causes of action, or press arguments that have been conceded or were abandoned in the original proceedings. To illustrate, you should not seek to argue that copyright in the mascots was not properly assigned to the Association, nor should you make any arguments under moral rights, passing off or some other non-statutory prohibition on unfair competition.
- c. Appeals to the Supreme Court are on points of law only, although it is permissible to challenge the legal conclusions that arise from findings of fact.
- d. The opinion of Madam Justice Davies includes reference to a number of cases. For the purposes of both the written and oral submissions, it is expected that you will deal with, and be familiar with, these items. However, these references are **not** intended to constitute your sole authorities for the moot, and indeed you are expected to rely on other primary and secondary materials. The emphasis you give to any particular authority is up to you, although the Panel/Bench will not look favourably upon strong reliance on an unduly narrow spectrum of authorities.
- e. Although the moot is held in Europe, this is an international competition and you are not limited in the jurisdictions from which you use authority. You can therefore use authorities from around the world. Obviously, however, it needs to be clear why any given authority is relevant to the legal issues in dispute.
- f. Erewhon is **not** a member of the European Union. It is a signatory to the Berne Convention, the Paris Convention, and the TRIPS Agreement.
- g. Requirements for your written submissions are contained in §14 of the Rules. The following is some additional guidance:
 - i. You do not need to include such things as a table of contents, statement of jurisdiction, statement of facts, index of authorities, etc. Submissions should focus on the substantive matters raised in the appeal.
 - ii. When marking your submissions, the Panel will be instructed not to give extra credit for court headings and other flourishes that merely give the submissions the superficial “look” of an official court document. Credit may be awarded for a presentation style that facilitates the arguments being made (for instance, in the content and number of headings, the use of a logical paragraph numbering system, and so forth). You should not,

therefore, be worried about purely stylistic matters when constructing your submissions.

- iii. The word count includes all the text in the footnotes. It is recommended that footnotes are used primarily for citation purposes, and that you minimise the amount of substantive text that appears in the footnotes.
- iv. There is no prescribed style guide for the submissions. Teams should, however: (i) maintain consistency of style throughout each submission; (ii) include full citations for sources on which they rely (at least the first time any given source is cited); and (iii) ensure that whenever they *quote* from a source, a pinpoint reference is included to the relevant page number and/or paragraph.

Any requests for clarifications of or corrections to the moot problem should be directed to the Moot Secretary at [moot@oiprc.ox.ac.uk] by **midday on Wednesday 4 November 2015 (Oxford time)**. Requests should note the paragraph number to which they relate, and explain why the requested clarification or correction is expected to have legal significance for the problem. Requests will be treated as confidential. If any clarifications or corrections are deemed necessary by the Organising Committee (OC), these will be released on the moot website by **Wednesday 11 November 2015**. The OC will not respond individually to any requests for clarifications or corrections, nor will it respond to requests that are seeking assistance with substantive aspects of the moot.

Your submissions must be received by the Moot Secretary (at the email address above) by **8.00pm on Friday 11 December 2015, Oxford time**; see further §15-§16 of the Rules. As noted there, within their written submissions, teams must identify themselves **only** by use of the anonymous identifier given to them in advance by the Moot Secretary. To apply for this identifier, you should email the Moot Secretary at [moot@oiprc.ox.ac.uk] **well before** the submission deadline.

The registration process will not open until *after* invitations have been issued to compete at the oral rounds. These invitations will be issued in mid-late January 2016. **Only those teams who are invited to the oral rounds will need to register and pay the registration fee.**

To keep apprised of announcements and news in relation to the moot (**#OxIPMoot**), please follow us on Twitter: **@OxIPMoot**.

Before:

THE HONOURABLE MADAM JUSTICE DAVIES

Between:

Erewhon Community Games Association

- and -

Erewhonian Animal Sanctuary & Brad Slaven

Madam Justice Davies:

Introduction

[1] In April 2016, Erewhon will host the Community Games (“**Games**”), a major multi-sport event that takes place every four years. It is expected that approximately 5,000 athletes, representing over 100 nations, will compete at the Games in 2016, in sports including athletics, swimming, gymnastics, rowing, boxing, wrestling, rugby, tennis, cycling, and so forth. The coordination of the Games is being undertaken by the Erewhon Community Games Association (“**Association**”), an entity that was created by statute in 2009. There are many activities that must be overseen by the Association, however, the aspects that are most relevant to this case are marketing and sponsorship arrangements.

[2] The Association makes claims against two defendants, the Erewhonian Animal Sanctuary (“**Sanctuary**”) and Mr Brad Slaven, in relation to acts that the Association calls ambush marketing. At its broadest level, the term “ambush marketing” describes a suite of practices in which a third party seeks to connect itself to an event, thus capturing some of the goodwill or positive associations created by the event. This does not necessarily require any misrepresentation or wrongful claim of sponsorship; on the contrary, this broad definition captures many legitimate and accepted marketing practices. I have therefore been careful to focus my attention on the specific legal claims being ventilated, which in this case pertain to infringement of copyright and to contravention of provisions of the Erewhon Community Games Indicia Act 2011 (“**Indicia Act**”). Before I turn to the claims against each defendant, it is useful to set out some background to the dispute, and in particular the development of Clarrie and Bettina, the mascots for the Games.

Development of the mascots

[3] It is common for major events, such as the Games, to have a mascot or mascots. The mascot serves a number of purposes, including to embody the values of the event; to help communicate messages and ideas about the event; to serve as a source identifier for official products and services; and to encourage interest in the event. A successful mascot may emerge as a personality or character in its own right. The mascot therefore performs informational and economic functions in the same way as other elements of branding.

[4] The Association held a public competition in Erewhon in 2014 to design the mascot (or mascots) for the Games. The terms and conditions required, inter alia, that the winner execute an assignment of copyright in the mascot to the Association.

[5] The winner of the competition was Mr Brad Slaven, the second defendant. Mr Slaven is a well-known Erewhonian illustrator, and his entry was a pair of cartoon Billibies. The Billiby is a small marsupial that is indigenous to Erewhon. The adult Billiby is grey, measures 50cm in length (body only), weighs 2-3kg, and has a pointed muzzle, long rabbit-like ears, and soft fur. The Billiby has been listed as an endangered species in Erewhon since the early 1980s. In his entry, Mr Slaven explained that he selected the Billiby because it is native to Erewhon, and because the spirit behind the Games – of community, co-operation and harmony – presented an opportunity to draw attention to the plight of endangered animals. Mr Slaven named his mascots Clarrie and Bettina. Clarrie, a male Billiby, wears a blue singlet, red trunks, and a pair of red boxing gloves. Mr Slaven describes Clarrie as a cheerful go-getter who always has a spring in his step. Bettina, a female Billiby, wears a yellow tennis dress and a blue sun visor, and carries a tennis racket. She is described in Mr Slaven's entry as sporty, adventurous and playful. Clarrie and Bettina are named after Mr Slaven's parents, and play sports in which the real Clarrie and Bettina participated.

[6] Mr Slaven assigned copyright in Clarrie and Bettina to the Association in a signed instrument dated 6 October 2014. This instrument did not purport to assign moral rights, which under Erewhonian law are inalienable. There has been no suggestion that there are any irregularities with the assignment (and I can see no basis for making any such assertion), and all the parties have proceeded on the basis that copyright in Clarrie and Bettina is owned by the Association, with moral rights retained by Mr Slaven. The Association has not applied for or obtained any registered trade mark that includes the names or images of Clarrie and Bettina. However, there is some protection of the characters in the Indicia Act, as discussed in further detail below.

[7] Clarrie and Bettina were officially launched to the public on 10 November 2014, and have proven to be hugely popular. Their image appears on official Games merchandise, such as t-shirts, mugs, key rings and fridge magnets. The Association has also developed a range of Clarrie and Bettina plush toys.

The Relevant Acts of the Defendants

[8] In May 2015, the Sanctuary launched an advertising campaign to encourage people to attend its main campus, located just outside the Erewhonian capital. The Sanctuary is Erewhon's second largest zoo, and has a particular focus on native Erewhonian animals, for which it runs conservation and breeding programs. The Sanctuary is open most days for the public to visit. In addition to the animal exhibits and presentations, the facilities include a café, a restaurant, a thirty seat cinema, and a shop selling books, artworks, toys and other merchandise. There is an entry fee.

[9] The Sanctuary purchased space on four billboards in the Erewhonian capital, two of which are located next to Pickhaver Park, Erewhon's biggest athletics stadium and the location of the track and field events at the forthcoming Games; and two of which are within 200 metres of the Doyle Aquatic Centre, at which the swimming and diving will take place. Each billboard is identical, and comprises a photograph of two juvenile Billibies playing with one another, alongside the caption: "For more fun and games, visit the Erewhonian Animal Sanctuary". The only other text to appear in the advertisement is a website address and a Twitter handle. The Sanctuary is not a sponsor of the Games, nor does it have any official connection with the event.

[10] The Association was angered by the campaign, and contacted the Sanctuary by letter dated 15 May 2015 to demand that it be discontinued immediately. The essence of the complaint was that the campaign was likely to cause confusion amongst the public as to the relationship between the Sanctuary and the Games, especially given: (i) the advertisement's use of the word "GAMES" and Billiby imagery; (ii) the proximity of billboards to Games venues; and (iii) the lack of a disclaimer. The Association claimed that this placed the Sanctuary in breach of rights granted to the Association under the Indicia Act. The Sanctuary denied, and continues to deny, that it was engaging in any conduct prohibited by the Act.

[11] In late May, the dispute between the Association and the Sanctuary was reported in the Erewhonian media. When Mr Slaven became aware of the dispute, he became, in his words, "incensed by the hyper-commercialisation of the Community Games by the Association"; see para. 12 of the witness statement of Brad Slaven dated 27 July 2015. His statement continued:

13. I see the Community Games as an international sporting event grounded in camaraderie, friendship and cooperation. To me, the actions of the Association in suing a zoo were nothing but a reprehensible money-grab, and were all the more outrageous given that my choice of Billibies as Games mascots was intended to draw attention to endangered species in Erewhon and around the world. The conservation projects of the Sanctuary are precisely the sorts of activities we should be supporting. I therefore wanted to express my disquiet at Clarrie and Bettina, the characters I developed, being misused in this way.

[12] In order to publicly express this disquiet, Mr Slaven decided to produce some rival merchandise that would “call out the Association on its values”: Slaven witness statement, para. 14. The particular product developed by Mr Slaven is a “stubby cooler”: an insulated foam holder for chilled cans and bottles, and used in particular for beer and other alcoholic beverages. Mr Slaven’s stubby cooler comes in white and black, and has printed onto it the image of two cartoon Billibies that bear a striking resemblance to Clarrie and Bettina. The male Billiby is wearing a blue singlet and red shorts, but instead of boxing gloves holds a full glass of beer in one hand and makes an obscene gesture (sometimes called “giving the middle finger” or “flipping the bird”) with the other. He is intoxicated. The female Billiby is wearing a yellow dress and is adorned with jewellery, including a tiara. She carries in each hand a large sack with a dollar sign on the front. A number of green notes spill out of the sacks and onto the ground around her feet. She looks very happy.

[13] Mr Slaven commenced sale of the stubby coolers in early June, and within weeks had sold several thousand units. Sales were spurred by social media, where hundreds of photos and comments have been posted with the hashtag #SillyBillibies. Surprised at the level of interest, Mr Slaven has been donating profits to animal and environmental charities, including a donation to the Sanctuary.

[14] The Association contacted Mr Slaven by letter dated 29 June 2015 to demand that he immediately discontinue the manufacture and sale of the stubby coolers, and that he deliver up or destroy any stock-on-hand. The Association grounded its demands in copyright law and in the tarnishment provisions of the Indicia Act. Mr Slaven did not respond to this letter, and has continued to sell the stubby coolers. At the time of making his witness statement on 27 July 2015, he had sold approximately 8,000 units.

[15] With both the Sanctuary and Mr Slaven refusing to comply with its letters of demand, the Association instituted these proceedings. It requests declarations and injunctions against both defendants, but not monetary compensation. I will deal first with the claim against the Sanctuary and then with the claims against Mr Slaven.

Claim against the Sanctuary

[16] The claim against the Sanctuary is brought pursuant to s. 4(1) of the Indicia Act. This piece of legislation was enacted in order to “protect the integrity of words, images and sponsorship arrangements associated with the Community Games”: Indicia Act, Recital A. The Act achieves this aim by designating certain words and images as “protected words” and “protected images”, and then regulating the use of those words and images, including by prohibiting third party uses that cause confusion or reputational harm. The protected words include “COMMUNITY GAMES”, “GAMES” and (following amendment in 2014) “CLARRIE”, “BETTINA” and “BILLIBIES”. The Association is given the authority to grant licences in relation to the protected words and images, and – relevantly for this case – to bring enforcement actions in relation to alleged contraventions of the Act.

[17] It is clear to me that the Indicia Act strengthens and expands the rights that would otherwise be available to the Association under common law and statutory intellectual property regimes. From my reading of the Recitals and the substantive provisions of the Act, I understand the legislation to be aimed at preserving the exclusivity associated with the Games. This gives the Association greater control in the way the event is presented to members of the public, and facilitates the ability of the Association to raise money through sponsorship arrangements. Although some may baulk at this legislation, it is now common for hosts of major events to be required by the relevant world governing body to enact legislation to protect words and images associated with the event. To the extent that it permits Erewhon to host the Community Games and to fund the Games with as much private money as possible, this legislation therefore benefits all Erewhonians.

[18] The protected words and images are set out in s. 3. The Association argues that the Sanctuary's billboard: (i) uses the protected word "GAMES" in the slogan per s. 4(1)(a); and (ii) through the photograph, uses a sign that is deceptively similar to the protected word "BILLIBIES" per s. 4(1)(b). The first proposition is in my opinion unassailable. Whether a claim is also available in relation to BILLIBIES depends on the role of ideational or conceptual similarity in establishing deceptive similarity. I am of the view that the photograph falls within s. 4(1)(b), just as the use of an image of the character Betty Boop was held to infringe the word mark BETTY BOOP in *Hearst Holdings Inc v A.V.E.L.A. Inc* [2014] EWHC 439 (Ch).

[19] Having established there is use of a protected word and a deceptively similar sign, it is then necessary for the Association to show that this use is for a "prohibited purpose". The Association argues that the Sanctuary's advertisement falls within the situation described in s. 5(2), which deals with confusing uses. Argument before me focused on whether the use was "likely to cause confusion", it being clear that the billboard was for advertising purposes. I accept that this phrase includes confusion as to the commercial association between the Association and Sanctuary, for instance that the Sanctuary provides sponsorship-like support for the Games and in return may associate itself with the Games. I also accept that, in the light of the conceptual basis and purpose of ambush marketing statutes, the standard to be applied in assessing confusion ought not to be exacting. With no guidance in the Indicia Act as to the meaning of "likely to cause confusion", and no case law to have considered the Act, I have sought to apply a standard that reflects these goals. In this regard I have found helpful the "cause to wonder" standard that has been applied by some courts in trade mark law: e.g., *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* [1954] HCA 82; (1954) 91 CLR 592. I conclude that this standard is met in this case as a reasonable person, viewing the billboards, would wonder whether the Sanctuary was an official partner or sponsor of the Games, especially given the location of the billboards next to Games venues.

[20] I therefore conclude that the Sanctuary has acted in contravention of s. 4 of the Indicia Act. At one point the Sanctuary attempted half-heartedly to argue that it had

a defence under s. 8(b)(iv) of the Act, on the basis that it used the word “GAMES” and the Billiby images to indicate the intended purpose of its goods and services. However, the Sanctuary was unable to provide a compelling explanation of why its use was necessary, and this defence was abandoned.

First claim against Mr Slaven: tarnishment

[21] I will deal first with the claim alleging tarnishment under the Indicia Act before turning to the claim grounded in copyright. In dealing with the tarnishment claim, it is worth emphasising that the Clarrie and Bettina designs are not protected images under the Indicia Act, although their names are on the list of protected words.

[22] The Association argues that the Billibies appearing on Mr Slaven’s stubby coolers bear close resemblance to Clarrie and Bettina, and therefore constitute signs that are deceptively similar to the protected words “CLARRIE”, “BETTINA” and “BILLIBIES”. It is safe to say that the resemblance between the two sets of characters is striking, and that this is entirely consistent with Mr Slaven’s goal of creating a subversive version of the official mascots in order to comment on the actions of the Association. For the same logic as that set out in para. 18, I accept that the Billiby images are deceptively similar to the words “CLARRIE”, “BETTINA” and “BILLIBIES”.

[23] The Association then argues that this use is for a “prohibited purpose” because it is commercial and causes reputational harm within the meaning of s. 5(3). I agree that the use is commercial, given that the stubby coolers have been sold to the public; this conclusion is not altered by Mr Slaven’s critical intention or his decision to donate profits to charity. The more pressing question is what is meant by the phrase “reputational harm” in s. 5(3). The Association argued that Mr Slaven’s product has harmed the reputation of the mascots, the Association and the Games through:

1. the official mascots being shown engaging in crass and offensive behaviour (e.g., making obscene gestures) and having unsavoury characteristics (e.g., greed);
2. the design commenting adversely on how the Association is running the Games; and
3. the design (i) including an image of one of the mascots drinking; and (ii) being applied to a product that is typically used for holding alcoholic beverages. The Community Games is a dry event, i.e., there are no sponsors from the alcohol industry nor any alcohol served at Games venues. The production of a stubby cooler is antithetical to this policy. The Association would never licence the production of such a product, nor for that matter *any* product depicting the mascots drinking.

[24] The Association conceded that Mr Slaven's use is not confusing, although as seen from the express words of s. 5(3), this is not necessary for a tarnishment claim to arise under the Indicia Act.

[25] I am persuaded that the third complaint, above, is made out and constitutes "reputational harm" for the purposes of the Act. I accept that the depiction of the male Billiby drinking beer, and the application of the design on a product typically used by those drinking alcoholic beverages, is likely to cause reputational harm because the design and product are antagonistic to the healthy image of the Games and its status as a dry event: see *Inlima SL's Application* [2000] ETMR 325; appeal dismissed [2000] RPC 661.

[26] The first and second complaints raise different considerations, due to Mr Slaven's parodic intent. The Association argued that the mascots evoke many positive associations: they are energetic, fearless, live a healthy lifestyle, and have a cheerful demeanor. It argued that reputational harm is likely to arise through the inherently negative association of the mascots getting drunk, making obscene gestures and being greedy. Mr Slaven responded that the design was intended to convey criticisms about the Association, and that the interpretation of "reputational harm" must take into account the need to protect free speech. In support of these arguments, he directed me to United States case law in which free speech has been emphasised when dismissing tarnishment claims brought under trade mark dilution law against the producers of parodic merchandise: see e.g., *Smith v Wal-Mart Stores, Inc*, 537 F Supp 2d 1302 (N.D. Ga., 2008). However, I have two difficulties with these submissions. First, the conclusion in those cases was tied to the First Amendment of the United States Constitution and to generous statutory exclusions in the relevant statutes. For instance, the current dilution provisions of the U.S. Lanham Act expressly exempt fair use, all forms of news reporting and commentary, and noncommercial use: 15 U.S.C. §1125(c)(3). In the absence of equivalent exemptions in the Indicia Act, it would be necessary for me to determine whether, and how, free speech protections are in-built into the definition of "reputational harm" as used in the Indicia Act.

[27] Secondly, even if I embarked on this project and read the statute as intended (or having) to leave room for parody, I doubt that I would reach a conclusion favourable to Mr Slaven. For reasons elaborated upon below, I have rejected Mr Slaven's submission (in response to the copyright infringement claim) that his use was a fair dealing for the purpose of parody or satire. Given the goals of the Indicia Act, I find it impossible to immunise an allegedly parodic use from liability under that Act when the use in question would not be a fair dealing in copyright law. ~~accept that "reputational harm" should be understood to apply to a use that would not also be a fair dealing in copyright law.~~

[28] I therefore conclude that Mr Slaven has acted in contravention of s. 4 of the Indicia Act, and will award the remedies sought by the Association.

Second claim against Mr Slaven: copyright infringement

[29] Given my conclusion on the first claim, it is not strictly necessary for me to decide the second one in order to grant the remedies sought by the Association. However, for completeness I will set out my reasons.

[30] The Association argues that the design for the mascots is protected as an original artistic work; that copyright was assigned by Mr Slaven (as author) to the Association, such that the Association is now the owner of copyright; and that Mr Slaven's reproduction of the artistic work on the stubby coolers constitutes an infringement of copyright under s. 10(1) of the Copyright Act 1997. Mr Slaven does not seek to challenge any of these assertions. Instead, his answer is that he has a defence under s. 44(1) (as a fair dealing for the purposes of parody or satire) and/or s. 56 (as a subsequent work made by the same artist). Argument before me therefore focused on these matters.

[31] I reject the defence based on fair dealing. Even if I apply a low threshold to the interpretation of the purpose of Mr Slaven's dealing (and thus accept it was undertaken for the purpose of parody or satire), the requirement of fairness is not made out. Three considerations were particularly important to me in reaching this conclusion. First, the design was applied to a product sold commercially, thus allowing Mr Slaven to derive a commercial benefit from the dealing. Secondly, any comment directed towards the actions and values of the Association was too vague. To those who are unaware of Mr Slaven's concerns, the design would be perceived as no more than an adult or subversive riff on the official mascots. Finally, I was influenced by the motives of Mr Slaven. As stated by Teitelbaum J in *Cie Generale des Etablissements Michelin-Michelin & Cie v. C.A.W.-Canada* (1996) 71 CPR (3d) 348, 384, "the overall use of the copyright must be 'fair' or treat the copyright in a good faith manner." I do not interpret this as requiring that criticism cannot be negative, but that it must reach a minimum standard of fair play. Mr Slaven did not properly articulate his criticism, and it was not necessary for him to reproduce the image of Clarrie and Bettina to communicate his complaint: see also *Hyde Park Residence Ltd v Yelland* [2001] Ch 143, 159 (per Aldous LJ).

[32] In contrast, I am of the view that Mr Slaven has a defence under s. 56, which permits the author of an artistic work of which he or she is not the copyright owner to copy the work in making another artistic work, "provided he or she does not repeat or imitate the main design of the earlier work". The Explanatory Memorandum to the Copyright Act 1997 explains at para. 121 that s. 56 was intended to be protective of artists, and in particular to limit the circumstances in which an assignee of copyright can prevent the artist from producing subsequent works that adopt similar styles, themes or elements. The Association argues that s. 56 is inapplicable as the "main design" of the earlier work is the Billibies, which have been copied in Mr Slaven's later work. However, the Association cannot have it both ways: it cannot argue that the Mr Slaven's stubby cooler design communicates an entirely different message that tarnishes the official mascots *and* that Mr Slaven

has imitated the “main design” of the earlier work. In a case such as this, the main design must be understood by reference not just to the visual similarity between the Billibies but also to the overall context and the messages conveyed. I understand that this may sit awkwardly with my findings on fair dealing, and I appreciate that it places Mr Slaven in a special position vis-à-vis all other users of the mascots as a copyright work. However, the intention of s. 56 is to provide additional protections to artists in order to protect their livelihood. It is not concerned primarily with free speech as a public goal but artistic endeavor as a private occupation. There is no requirement that any re-use be fair.

[33] I therefore conclude there was no infringement of copyright by Mr Slaven.

Madam Justice Davies made declarations that the Sanctuary and Mr Slaven had each contravened s. 4 of the Indicia Act, and issued injunctions against each defendant.

Oxford International Intellectual Property Moot 2016

Copyright Act 1997 – extracts

Section 2 Subject matter of copyright

Subject to this Act, copyright subsists in the following types of work:

- (a) original literary, dramatic, musical and artistic works;
- (b) sound recordings, films and broadcasts; and
- (c) the typographical arrangement of published editions.

Section 9 Exclusive rights

...

(2) Copyright, in relation to an artistic work, is the exclusive right:

- (a) to reproduce the work in a material form;
- (b) to publish the work; and
- (c) to communicate the work to the public.

...

Section 10 Infringement of copyright

(1) Subject to this Act, the copyright in a copyright work is infringed by a person who, not being the owner of the copyright, and without the licence of the owner of the copyright, does in Erewhon, or authorises the doing in Erewhon of, any act comprised in the copyright.

...

Section 44 Fair dealing

(1) Fair dealing for the purpose of research, private study, education, parody or satire does not infringe copyright.

(2) Fair dealing for the purpose of criticism or review, whether of that or another work, does not infringe copyright if a sufficient acknowledgement is made.

(3) Fair dealing for the purpose of news reporting does not infringe copyright if a sufficient acknowledgement is made.

(4) “**Sufficient acknowledgement**” means an acknowledgement identifying the work in question by its title or other description, and identifying the author unless:

- (a) in the case of a published work, it is published anonymously; or
- (b) in the case of an unpublished work, it is not possible for a person to ascertain the identity of the author by reasonable inquiry.

Section 56 Making of subsequent works by same artist

Where the author of an artistic work is not the copyright owner, he or she does not infringe the copyright by copying the work in making another artistic work, provided he or she does not repeat or imitate the main design of the earlier work.

Erewhon Community Games Indicia Act 2011 (as amended) - extracts

Recitals

A. The purpose of this Act is to protect the integrity of words, images and sponsorship arrangements associated with the Community Games by prohibiting the use of protected words and images, where such use is likely to:

- i. cause confusion as to a person’s association with the Community Games;
or
- ii. tarnish the Community Games or its associated words and images, irrespective of whether such use is confusing.

B. This Act grants to the Erewhon Community Games Association the ability to grant licences in relation to protected words and images, and to bring enforcement actions in relation to the contravention of the prohibitions described in subparagraphs (i) and (ii).

...

Section 3 Protected words and images

(1) The following words and expressions are protected words for the purposes of this Act:

- (a) “Erewhon Community Games”;
- (b) “Community Games”;
- (c) “2016 Games”;
- (d) “Games”;

...

- (j) “Clarrie”;
- (k) “Bettina”; and
- (l) “Billiby” or “Billibies”.

(2) The following images are protected images for the purposes of this Act:

[The Act sets out two images: the Community Games logo, and the logo of the Erewhon Community Games Association.]

Section 4 Prohibition on uses for a prohibited purpose

(1) A person, other than the Erewhon Community Games Association, must not use any of the following for a prohibited purpose:

- (a) a protected word or protected image; or
- (b) any sign that is deceptively similar to a protected word or protected image.

(2) Subsection (1) does not apply to a person who is using a word, image or sign within the terms of a licence or written authorisation given by the Erewhon Community Games Association.

(3) Subsection (1) does not apply to an act that falls within an exemption in section 8.

Section 5 Meaning of prohibited purpose

(1) In this Act, a person uses a word, image or sign for a “**prohibited purpose**” where they perform an act that falls within subsection (2) and/or (3).

Confusion

(2) A word, image or sign is used for a “prohibited purpose” where it is used:

- (a) for a commercial purpose; or
- (b) an advertising, marketing or promotional purpose, whether or not undertaken for profit or commercial gain,

and that use is likely to cause confusion.

Tarnishment

(3) A word, image or sign is used for a “prohibited purpose” where it is used:

- (a) for a commercial purpose; or
- (b) an advertising, marketing or promotional purpose, whether or not undertaken for profit or commercial gain,

and that use is likely to cause reputational harm, irrespective of whether there is confusion.

Section 8 Exemptions

The following are exempt from the prohibition in section 4(1) of this Act:

- (a) genuine reporting of news or current affairs in relation to the Community Games, where the use made is reasonable; and
- (b) use, in accordance with honest practices in industrial or commercial matters, of:
 - (i) a person's own name or address;
 - (ii) the proper name of any town, road or other place in Erewhon;
 - (iii) an existing registered trade mark; or
 - (iv) indications concerning the intended purpose of goods or services.

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Cases cited by Madam Justice Davies

Hearst Holdings Inc v A.V.E.L.A. Inc [2014] EWHC 439 (Ch)

Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd [1954] HCA 82; (1954) 91 CLR 592

Smith v Wal-Mart Stores, Inc, 537 F Supp 2d 1302 (N.D. Ga., 2008)

Inlima SL's Application [2000] ETMR 325; appeal dismissed [2000] RPC 661

Cie Generale des Etablissements Michelin-Michelin & Cie v. C.A.W.-Canada (1996) 71 CPR (3d) 348

Hyde Park Residence Ltd v Yelland [2001] Ch 143