

Oxford International Intellectual Property Moot 2022

Instructions

The 2022 moot concerns *Floyd's Kitchins & Erewhonian Burrellshire Brandy Association v Greenland Supermarket* [2021] HCE 107. A copy of this case is included in the pages that follow, along with relevant statutory provisions. [This document was amended on 22 November 2021 to incorporate some changes made in response to Requests for Corrections and Clarifications.](#)

At first instance in the High Court of Erewhon, the Honourable Justice Chen Wishart found as follows:

1. The Birss Butterfly Cake does not fall within the category of 'artistic works' in the Copyright Act 1997. As such, the copyright infringement action by the first claimant, Floyd's Kitchins, fails.
2. The second claimant, the Erewhonian Burrellshire Brandy Association, succeeds in its action for passing off. Such an action can be maintained in relation to a product (in this case, Burrellshire Brandy Butter Icing) that contains the claimant's product (in this case, Burrellshire Brandy).
3. The second claimant does not succeed in its action under the Protected Geographical Indications Act 2007 in relation to the defendant's use of the protected geographical indicator, 'Burrellshire Brandy'.

The claimants were granted leave to appeal from this judgment in relation to Items 1 and 3; and the defendant, Greenland Supermarket, granted leave to appeal in relation to Item 2. A unanimous bench of the Court of Appeal upheld (without releasing a substantive opinion) the decision of Justice Chen Wishart and dismissed the appeal and cross-appeal. The parties have been granted leave to bring a further appeal to the Supreme Court of Erewhon. It is your task to prepare written and (for teams that are invited to the Oral Proceedings) oral submissions for this appeal.

Covid statement: The 2020 moot was cancelled due to the Covid-19 pandemic, and the problem for that moot used for an online competition in March 2021. At the time of release of this problem, **it is planned that the 2022 oral rounds will take place as a purely in-person event in Oxford in March 2022.** The schedule will be finalised once we have a sense of team numbers, meaning that the following is subject to change: but we anticipate welcoming teams on the evening of **Wednesday 16 March**, and then mooting from **Thursday 17 to Saturday 19 March 2022.** We appreciate that circumstances can change, sometimes rapidly, and that teams will not know, for sure, whether they will be able to travel to Oxford in March. **Interested teams are nevertheless encouraged to make written submissions**, as making a submission does not require that teams pay any money or commit to their availability to travel. If a team wins a memorial prize but finds itself unable to come to Oxford, it will still receive its prize. We will also notify teams immediately if, due to changed

regulations in the UK or worsening Covid conditions, we need to change plans for the oral rounds.

Some points to consider:

- a. Each written submission must cover all issues on appeal, i.e. make submissions on Items 1, 2 and 3 in the list above. Please present these arguments in the order that you consider to be most logical. That is, you are not bound to present your arguments in any particular order due to there being an appeal and cross-appeal. The key thing is that each written submission covers all three issues.
- b. Whilst you are encouraged, within the grounds of appeal, to present arguments and authorities not mentioned by Justice Chen Wishart, you should not seek to introduce entirely new causes of action, or to press arguments that have been conceded or that were never ventilated in the original proceedings, or press matters outside the appeal. For instance, you may not seek to argue that the Cake is a 'sculpture', or present a passing off argument on behalf of Floyd's Kitchens (the passing off claim having been brought by the Association), or argue that the Association does not have standing to bring a claim in passing off.
- c. Erewhon is a common law jurisdiction, and the opinion of Justice Chen Wishart includes reference to a number of cases. For the purposes of the written submissions, it is expected that you will deal with all of these cases, and you risk missing out on credit if you omit analysis of them. 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 (including those cited by Justice Chen Wishart) is up to you, although the Panel will not look favourably upon strong reliance on an unduly narrow spectrum of authorities.
- d. 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. Please assume that all rules in relation to evidence and procedure have been complied with.
- e. Although the moot is held in the UK, this is an international competition and you are not limited in the jurisdictions from which you use authority. You may therefore use cases from around the world. Obviously, however, it needs to be clear why any given case is relevant to the legal issues in dispute. It is permissible to cite academic commentary in support of your legal arguments.
- f. Erewhon is not a member of the European Union. It is a party to the Berne Convention and is a member of the World Trade Organization and signatory to the TRIPS Agreement. Treaties are not self-executing in Erewhon.
- 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.
- v. Justice Chen Wishart is a woman. You may refer to her as 'Chen Wishart J' and 'Her Honour' in your written submissions.

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 Friday 12 November 2021** (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 the end of **Monday 22 November 2021**. 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 **5.00pm on Monday 13 December 2021**, 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 **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 2022. **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**. The website for the Oxford IP Moot is: <https://www.law.ox.ac.uk/centres-institutes/oxford-intellectual-property-research-centre/19th-annual-oxford-international>.

Before:

THE HONOURABLE JUSTICE CHEN WISHART

Between:

Floyd's Kitchins & Erewhonian Burrellshire Brandy Association

- and -

Greenland Supermarket

Justice Chen Wishart:***Background***

[1] This case raises novel questions, in Erewhon, about the intellectual property protection of food. The first claimant is Floyd's Kitchins, an artisan patisserie and bakery. Floyd's Kitchins operates out of five locations and runs an online store via its website. One of its highest-selling cakes – and the focus of this action – is the Birss Butterfly Cake. Floyd's Kitchins began selling this Cake in 2011. It was created by Ms Mummery, then head chef at Floyd's Kitchins. Ms Mummery made and decorated by hand the first Birss Butterfly Cake. She did not work from any design drawings. She took photos of the Cake and wrote instructions about how to create it, so that it could be replicated by other chefs. There is no dispute that, if there is any copyright in the Cake, that copyright is owned by Floyd's Kitchins by virtue of Ms Mummery's employment contract.

[2] The Birss Butterfly Cake is a sticky ginger cake decorated by hand with Burrellshire Brandy Butter Icing and coloured frosting. Burrellshire Brandy Butter Icing is usually made with twenty percent Burrellshire Brandy, a point that is central to the claims of the Erewhonian Burrellshire Brandy Association (**'Association'**). The frosting is six colours: pink, yellow, orange, green, blue and purple. The frosting is carefully piped onto the cake, using a colour blocking technique, to form the body of the butterfly and its two wings. The colours on the wings are symmetrical. The frosting is also piped as florettes around the base of the cake. The cake is completed by the addition of two metallic pipe cleaners that form the butterfly's antennae.¹ I am

¹ The Birss Butterfly Cake resembles closely the cake in this photograph: (<https://www.pinterest.com.au/pin/263390278179937452/>). This link is included to help teams and judges visualise the cake. It does not form part of Chen Wishart J's judgment.

informed that the cake was named after Ms Mummery's favourite great-uncle, described as a colourful man who loved nature and had a passion for beekeeping.

[3] In November 2019, Greenland Supermarket (**'Greenland'**) launched its own butterfly-shaped cake. Greenland is Erewhon's third largest supermarket chain. Its self-described mission is to give consumers the best value groceries in Erewhon. It produces its own Greenland-branded range of products as well as stocking products from other brands. It has never sold any products from Floyd's Kitchens, who as noted above only sells products from its own stores and online shop.

[4] The evidence discloses that when developing its own butterfly cake, Greenland was not only aware of the Birss Butterfly Cake but sought to create its own version of that Cake. The written evidence included minutes of meetings of Greenland's product development team. That evidence shows that in early 2019, Greenland decided to 'extend our range of birthday and celebration cakes'. This included the creation of a cake 'with the look of a Floyd's Kitchens cake, at a lower price-point'. At a subsequent meeting, a team member discussed a number of options for the Floyd's Kitchens-style cake, and it was decided to use the Birss Butterfly Cake as 'inspiration'. The Greenland Butterfly Cake was created by Mr Keene, a development chef at Greenland. Mr Keene examined photographs on Floyd's Kitchens' website and purchased a Birss Butterfly Cake so he could inspect and take measurements of the Cake. In terms of appearance, the Greenland Butterfly Cake is the same shape as the Birss Butterfly Cake; features the same colour-blocked pattern on the wings and body of the butterfly; and uses the same six colours, albeit in slightly different shades. There are no florettes at the base of the cake, and the antennae are piped on in black frosting, along with eyes and a mouth. In terms of ingredients, the Greenland Butterfly cake is a sponge cake with jam filling. The brandy butter icing contains four percent Burrellshire Brandy rather than twenty percent. Mr Keene explained that the cake was changed to a sponge, and the quantities of the icing ingredients modified, to help expand the potential market for the Greenland Butterfly Cake, including by making it 'suitable for children'.

[5] The Greenland Butterfly Cake is sold in rectangular cardboard boxes. The top of the box includes a transparent rectangular section (made with plastic) so that consumers can see the cake inside. Above that plastic section are the words 'Greenland Butterfly Cake', using Greenland's corporate font and purple colour. Immediately below those words it is written, in cursive pink font, 'with Burrellshire Brandy Butter Icing'. Below the plastic section there appears various bits of smaller plain text, including the words 'Icing Made with 4% Burrellshire Brandy'. The quantity of Burrellshire Brandy is also included prominently in the ingredients list on one of the sides of the box.

[6] Floyd's Kitchens became aware of the Greenland Butterfly Cake in January 2020. It formed the view that the Greenland Cake was, in the words of the Director of Marketing, a 'knockoff' of the Birss Butterfly cake. Floyd's Kitchens also noted Greenland's departure from the usual recipe for Burrellshire Brandy Butter Icing and contacted the Association to inform it of the 'misuse of your IP'. Separately, the

Association received complaints from a number of trade members and consumers in relation to the Greenland Cake; for instance, a Mr Fysh wrote to the Association complaining that the icing 'was not as boozy as I'd expected it to be'. Floyd's Kitchens and the Association sought legal advice. Through their lawyer, they contacted Greenland jointly to express their concerns about the Greenland Butterfly Cake. Those concerns were:

- (a) On the part of Floyd's Kitchens: that the Greenland Butterfly Cake copies almost identically the visual appearance of the Birss Butterfly Cake, and thus infringes Floyd's Kitchens' copyright in the cake.
- (b) On the part of the Association: that 'Burrellshire Brandy Butter Icing' is a traditional recipe in Erewhon. That recipe is for icing containing twenty percent Burrellshire Brandy. Describing the icing on the Greenland product as 'Burrellshire Brandy Butter Icing', when that icing contains only four percent Burrellshire Brandy, gives rise to two claims: first, in passing off, on the basis that Greenland is misappropriating the shared goodwill that subsists in Burrellshire Brandy Butter Icing; and second, under the Protected Geographical Indications Act 2007, for having taken undue advantage of the reputation of Burrellshire Brandy.

[7] Floyd's Kitchens did not (and does not in these proceedings) allege copyright infringement in relation to the recipe for its Cake. Nor did it suggest any misuse of confidential information or itself make a claim in passing off.

[8] Greenland, through its lawyer, denied these claims. A flurry of correspondence followed which failed to resolve the dispute. In early February 2020, Floyd's Kitchens and the Association commenced proceedings in the High Court of Erewhon. I shall deal with the claims of each of the two claimants in turn.

Claim of Floyd's Kitchens – Copyright

[9] In order for Floyd's Kitchens to prevail in its copyright infringement action, the Birss Butterfly Cake must fall within one of the protected categories of work in section 2 of the Copyright Act 1997. That section sets out an exhaustive list of protected subject matter. Neither party sought to argue that this provision should be interpreted as an inclusive list. They were right to not plead this argument. Although this approach is taken in other countries, the words of the Erewhonian statute leave no room to recognise other types of work beyond those set out in section 2.

[10] The parties agree that if the Cake is protected, it is as an artistic work. That term is defined non-exhaustively in section 1 to include 'paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works.' As noted earlier, Floyd's Kitchens does not have any design drawings for the Cake. Instead, counsel for Floyd's

Kitchins, Ms Jam SC, made two arguments: (i) the Cake falls within one of the existing categories of artistic work, namely painting and/or work of artistic craftsmanship;² or (ii) the category of artistic works, being inclusive, can include visually-attractive foodstuffs such as a decorated cake. I have concluded that all these arguments fail, meaning that Floyd's Kitchins cannot maintain a claim for copyright infringement.

[11] The cake is not a painting. In reaching this conclusion, I was influenced by comments of Judge Sykes in the US case, *Kelley v Chicago Park District*, 635 F. 3d 290 (7th circuit, 2011). This was a moral rights case. In order to make out his claims – which related to ‘two enormous elliptical flower beds, each nearly as big as a football field, featuring a variety of native wildflowers, and edged with borders of gravel and steel’ – Mr Kelley needed to demonstrate that the garden was a work of visual art. It was accepted by the District Court that the garden was a protected painting and sculpture. This was not challenged on appeal, which Judge Sykes described as ‘an astonishing omission’. He stated at p. 301:

The district judge worried about taking ‘too literalist an approach to determining whether a given object qualifies as a sculpture or painting.’ ... His concern was the ‘tension between the law and the evolution of ideas in modern or avant garde art; the former requires legislatures to taxonomize artistic creations, whereas the latter is occupied with expanding the definition of what we accept to be art.’ ... We agree with this important insight. But there’s a big difference between avoiding a literalistic approach and embracing one that is infinitely malleable. The judge appears to have come down too close to the latter extreme.

[12] My concerns are similar. The category ‘artistic works’ in the Erewhonian Copyright Act must be sufficiently flexible to admit new artistic forms. But there are limits to how far we can extend the statutory language. I do not think that ‘painting’, as a copyright concept, can or should apply to *any* coloured matter applied to *any* surface. The ordinary meaning of the term is a relevant starting point. The Oxford English Dictionary (online edition) contains a number of definitions of painting as a noun, most relevantly including:

1.

a. Painted matter; that which is painted. In later use esp. as a count noun: a representation on a surface executed in paint or colours; a painted picture or likeness.

b. The representing of a subject on a surface by the application of paint or colours; the art of making such representations; (in extended use) the practice of applying paint to a canvas, etc., for any artistic purpose.

² For avoidance of any doubt, Floyd's Kitchins did not argue that the cake is a sculpture.

[13] The second definition, in particular, refers to the *art* of making representations of a subject on a surface, and the practice of applying *paint or colours* to a *canvas*, etc, *for any artistic purpose*. These are important limiting ideas in ordinary usage; and indeed the term ‘painting’ needs to be seen in its statutory context, that is, as a sub-category of artistic works. I accept that a painting does not need to be fine art or be able to be framed and hung over one’s mantelpiece. But I cannot imagine anyone would, otherwise than in submissions to the High Court of Erewhon, describe a decorated cake as a ‘painting’. Indeed, as explained by Lord Simon in *George Hensher Ltd v Restawile Upholstery (Lanc) Ltd* [1976] AC 64, one reason for the addition of the category of ‘work of artistic craftsmanship’ in the British Copyright Act 1911 was that existing protections for works of art, for instance under the Fine Arts Copyright Act 1862 (which protected ‘paintings’, amongst other things), did not cover the emerging arts and crafts movement, ‘with its emphasis on the applied or decorative arts’ (p. 90).

[14] This brings me to the question of whether the Birss Butterfly Cake is a work of artistic craftsmanship. Given the cake is a three-dimensional object, created using a variety of techniques such as piping, this was a more promising argument than the submissions on painting. However, I am of the view that it also fails. I agree with Floyd’s Kitchins’ suggestion that cake decoration involves ‘special training, skill and knowledge’ and a ‘manifestation of pride in sound workmanship’, to use the language of Lord Simon in *Hensher v Restawhile*, p. 91. But Lord Simon immediately went on to observe that ‘the craftsmanship – not the work itself – must, in addition, be artistic’: p. 91. Lord Simon observed that a cobbler and a pattern-maker were both craftsmen, but their craftsmanship would not be described as artistic; and that other practitioners might sometimes create artistic craftsmanship, such as the blacksmith when he [sic] created wrought-iron gates but not when he was shoeing a horse. In Lord Simon’s view, it was necessary to ask whether a work was ‘of one who was in this respect an artist-craftsman’: p. 94.

[15] In this case, I do not believe that the Birss Birthday Cake is a work of *artistic* craftsmanship. While it is aesthetically pleasing, it is not intended to be enjoyed or admired as a piece of art. Rather, the Birss Butterfly Cake is intended to be eaten, and its shape and decorations serve the (ultimately utilitarian) purpose of attracting customers who wish to buy a cake that resembles a butterfly. My conclusion is similar to that of Mann J in *Lucasfilm Ltd v Ainsworth* [2008] EWHC 1878 (Ch), where his Honour described the purpose of the Stormtrooper helmet and armour in the *Star Wars* films as ‘to give a particular impression in a film’: para. 134. In reaching that conclusion, his Honour observed in the same paragraph that if ‘one takes products of the Arts and Crafts movement as an exemplar, the helmet and armour share nothing of the conceptual purpose of such products.’ That observation is also pertinent here.

[16] Floyd’s Kitchins advanced another argument: that even if the Birss Birthday Cake was neither a painting nor a work of artistic craftsmanship, it could nevertheless be an artistic work because that term is defined inclusively in section 1. Ms Jam pointed me to the CJEU case, *Cofemel v G-Star Raw CV* (C-683/17) [2020] ECDR 9. That case

concerned the status of clothing designs as ‘works’ in EU copyright law. Ms Jam took from this case that in EU law, there are two cumulative conditions for a ‘work’: (1) it must be original subject matter, i.e. matter that is its author’s own intellectual creation; and (2) there must be expression that is sufficiently clear and precise, i.e. protection will be reserved ‘to the elements that are the expression of such creation’: para. 29. Importantly, according to Ms Jam, if a work satisfies these two requirements, it must be protected: para. 35.

[17] *Cofemel* considered the interplay between designs law and copyright, and asked whether EU copyright law precludes national law that adds another criterion for the protection of designs by copyright, such as some aesthetic or artistic value. Floyd’s Kitchens argues that the broader lesson from *Cofemel* is the centrality of originality to the definition of ‘work’. It did not, as noted above, suggest that I read the section 2 of the Copyright Act 1997 as an inclusive list. It did, however, say that the category ‘artistic works’ must be given a broad definition, with originality as the touchstone. Ms Jam submitted that Ms Mummery was able to exercise free and creative choices when she created the Birss Butterfly Cake, the design not being restrained by technical or functional considerations: *SI and Brompton Bicycle Ltd v Chedech / Get2Get* (C-833/18) [2020] ECDR 10. Ms Jam also submitted that the expression is sufficiently clear and objective, as the protection relates to the appearance of the cake and not its taste.

[18] The central tenet of Greenland’s submissions was that I must not read away the need for a *literary* or *artistic* creation, to draw from the language in Art. 2(1) of the Berne Convention. After much thought, I agree. I have no doubt that if it were to fall within a protected category of subject matter under the Copyright Act 1997, the Birss Butterfly Cake would be an original work. I agree with Ms Jam that creative choices were made and, to use the language of the CJEU, that Ms Mummery was able to stamp her personal touch on the Cake. But we need to take great care before concluding that just because the visual appearance of food involved creative choices, it is therefore an artistic work. Food is often presented or plated in a way that is pleasing to the eye because this enhances consumer enjoyment. It would be highly problematic to say that visually-attractive food is an artistic work in copyright law, with all the potential anti-competitive effects that this would bring. There may be some exceptional cases where food is truly used as an artistic medium. But that is not the case here. I am reminded of the words of Jacob J in *Bongrain’s Application* [2005] RPC (14) 306 that an average consumer would ‘be astonished to be told that one of the shapes [of cheese] was a trade mark’ as ‘[c]onsumers do not expect to eat trade marks or part of them’. Similarly, I believe that consumers would be astonished to learn that when they are enjoying a Birss Butterfly Cake, they are eating an original artistic work under Erehwonian copyright law.

[19] Given my conclusion on subsistence, the copyright infringement action fails. Had copyright subsisted in the cake, I would have held that there was infringement, given the evidence regarding development of the Greenland Butterfly Cake and the

extremely high degree of similarity between it and the Birss Butterfly Cake. Indeed, by his closing arguments, Mr Tiny, counsel for Greenland, had largely abandoned any suggestion it had not copied a substantial part of the first claimant's work.

Claims of the Association: passing off and taking unfair advantage

[20] I turn, now, to the claims of the Association, which is the trade association for manufacturers of Burrellshire Brandy in Erewhon. By way of brief background, Burrellshire is a region in southern Erewhon. Producers of Burrellshire Brandy use a particular distillation method, the details of which are not relevant here, as there was no suggestion by Greenland that shared goodwill does not subsist in the words 'Burrellshire Brandy'. The name 'Burrellshire Brandy' has also been registered as a protected Geographical Indicator ('GI') under the Protected Geographical Indications Act 2007 ('PGI Act') since 2008. The Association has standing to sue in passing off and under the PGI Act. The latter is uncontroversial. The former, in contrast, may be surprising to those from jurisdictions where trade associations have been held to not have standing to bring a passing off claim: e.g., *Chocosuisse Union des Fabricants Suisses de Chocolate v Cadbury* [1999] RPC (23) 826. However, the rules in Erewhon are more flexible, in this case meaning that the contract between the Association and its members (under which the Association has ultimate control over the conditions in which Burrellshire Brandy is manufactured and distributed) give it standing in these proceedings.

[21] I shall start with the action in passing off. The essence of that claim is that:

- (a) In an action for extended passing off, shared goodwill can arise not only in the product manufactured by the relevant class of traders, but, in some instances, to products that contain that product. In this case, the shared goodwill extends to the product, 'Burrellshire Brandy Butter Icing'.
- (b) There is a misrepresentation by calling the icing on the Greenland Cake 'Burrellshire Brandy Butter Icing' when only four percent of that icing is Burrellshire Brandy. Burrellshire Brandy forms twenty percent of the contents of the traditional recipe for Burrellshire Brandy **Butter** Icing.
- (c) There is damage to the relevant class of traders, including through lost sales.

[22] The claim for passing off struck me at first as an attempt to expand the action in a new and troubling way. The Association conceded that there is not an identifiable class of producers of Burrellshire Brandy Butter Icing. On the contrary, the Association's evidence included that many members of the public turn their hand to making the Icing, especially during the December festive season. Rather, the position of the Association is that the Icing is a traditional recipe in Erewhon and, relevantly for this case, contains twenty percent Burrellshire Brandy. The Association says that

the Icing has consistent and distinctive qualities and that there is shared goodwill in the Icing amongst producers of Burrellshire Brandy.

[23] In support of this assertion, the Association called as an expert witness Ms Clarke, Director of the Culinary Institute of Erewhon. Ms Clarke gave evidence in relation to the history of the Icing in Erewhon. She explained that the first known publication of its recipe was in *Homemaker's Own* magazine in December 1961. That recipe called for unsalted butter, icing sugar, light muscovado sugar and Burrellshire Brandy. The recipe appeared again numerous times, in unchanged form, in that magazine throughout the 1960s and 1970s, and since the early 1970s has been printed on the side of the bottles of three leading producers of Burrellshire Brandy. Ms Clarke also appended, to her written evidence, twenty recipes for 'Burrellshire Brandy Butter Icing' published in other magazines and cookbooks, and ten online recipes for 'Burrellshire Brandy Butter Icing'. She observed that these recipes made only 'minor' adjustments to the quantities. Ms Clarke accepted, during cross-examination, that home bakers may not be strict with the measurements. She also accepted that she had not examined the approach in restaurants. However, it was her opinion that 'chefs in Erewhon do not deviate from the recipe for Burrellshire Brandy Butter Icing in any significant way. If a chef wants to create a recipe with different ingredients or with less brandy, they will give that recipe a different name.'

[24] In considering this evidence, there was force in the arguments of Mr Tiny, on behalf of Greenland, that recipes for Burrellshire Brandy Butter Icing vary to some degree, and that individuals are free to adjust the recipe according to their own preferences and tastes. There are no statutory regulations governing the content of the Icing. Nevertheless, I have come to the conclusion that it is no great stretch to apply the action for extended passing off to the facts at hand. In *Erven Warnink v Townend* [1979] AC 731 (the *Advocaat* case), Lord Diplock indicated at p. 742 that the following are required for an action in passing off:

(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

[25] The evidence is clear: Burrellshire Brandy Butter Icing is made with about twenty percent Burrellshire Brandy. The icing on the Greenland Butterfly Cake has four percent. Members of the public will unquestionably be misled as to the nature of the product. Those who do not bake are unlikely to appreciate that the product they are purchasing is not the product they are expecting. Furthermore, even those who do bake may either fail to bring the normal proportion of brandy to mind at the point they purchase the Greenland Cake, or may simply fail to notice the product description. That is, the identification, on the front of the product packaging and on the ingredient list, of the true amount of brandy is not sufficient to qualify the words

'made with Burrellshire Brandy Butter Icing': similar analysis in *Diageo North America Inc v InterContinental Brands (ICB) Ltd* [2010] EWHC 17 (Ch), para 167; affirmed [2010] EWCA Civ 920.

[26] Greenland argued that allowing this action would in effect read away the role of goodwill in passing off. But I am persuaded by Ms Jam, first, that the case law illustrates the central role of misrepresentation to this tort, as seen in the cases on character merchandising: e.g., *Twentieth Century Fox v South Australian Brewery Co* (1996) 66 FCR 451 (Federal Court of Australia). Furthermore, in those cases the definition of trader has extended to those who do not directly produce any goods at all. It is therefore not fatal that the makers of Burrellshire Brandy do not themselves make icing. If Greenland is allowed to continue to market its product as containing Burrellshire Brandy Butter Icing, other traders are likely to follow suit (in order to drive down costs) and producers of Burrellshire Brandy will suffer a reduction in sales.

[27] This leaves me with the Association's other cause of action: that Greenland has unlawfully interfered with Burrellshire Brandy as a Geographical Indicator ('GI') under section 5(1)(a)(ii) of the PGI Act. As noted earlier, 'Burrellshire Brandy' has been registered as a GI in Erewhon since 2008. This registration does not extend to icing. This case therefore raises the question of the application of the PGI Act to products that contain, as an ingredient, a registered name.

[28] The Association's argument is that Greenland, by labelling its cake as containing 'Burrellshire Brandy Butter Icing', has made direct commercial use of the registered GI 'Burrellshire Brandy' in circumstances that 'exploit the reputation' of that GI. I was pointed by Ms Jam to the judgment of the CJEU in the 'Champagne Sorbet case', *Comité Interprofessionnel du Vin de Champagne v Aldi* (C-393/16) (Second Chamber, 20 December 2017). That case pertained to the sale, by Aldi, of a product called 'Champagne Sorbet'. Champagne was a Protected Designation of Origin (PDO). The Aldi product contained twelve percent Champagne. The German court referred various questions to the CJEU in relation to the interpretation of a number of EU instruments dealing with agricultural products. The CJEU emphasised that, to avoid falling afoul of provisions prohibiting the taking of unfair advantage of reputation, the PDO must confer on the foodstuff one of its 'essential characteristics': para. 50. The quantity of that ingredient is relevant but not determinative: para. 51. Instead a 'qualitative assessment' must be made:

51. ... In that regard, as the Advocate General observed in points 76 and 77 of his Opinion, it is not a question of identifying in the foodstuff the essential characteristics of the ingredient protected by a PDO but of establishing that that foodstuff has an essential characteristic connected with that ingredient. That characteristic will often be the aroma or taste imparted by that ingredient.

52. Where the name of the foodstuff indicates, as in the main proceedings, that it contains an ingredient protected by a PDO, which is intended to convey the

taste of the foodstuff, the taste imparted by that ingredient must constitute the essential characteristic of that foodstuff. If the taste of the foodstuff is more attributable to other ingredients it contains, the use of such a name will take unfair advantage of the reputation of the PDO concerned. Thus, in order to determine whether the champagne contained in the product at issue ... confers on it one of its essential characteristics, the national court must ascertain, in the light of the evidence before it, whether the taste of the product is attributable primarily to the presence of champagne in the composition of the product.

[29] Mr Tiny, on the other hand, argued that Erewhon should not adopt the 'broad' approach of the CJEU, especially as regards products that: (1) contain ingredients that are registered names under the PGI Act; and (2) identify the name and quantities of those ingredients entirely accurately. In his submission, there are grave dangers in judges turning their hands to construing the 'essential' characteristics of a product and determining some causative relationship with a particular ingredient. For instance, there are ingredients that may not be discernible to the palate but which in fact influence strongly the taste of a product. In his view, unless addition of an ingredient is entirely capricious, it is not caught by section 5(1)(a)(ii). In the alternative, Mr Tiny submitted that even if we adopt the approach of the CJEU, the Greenland icing has the flavour of Burrellshire Brandy, and hence satisfies the CJEU approach.

[30] Although I upheld the claim in extended passing off, I am of the view that the claim under section 5(1)(a)(ii) of the PGI Act fails. The whole point in protecting GIs and other designators of origin is to help guarantee the qualities *of the products specified in the registration*, and in doing so protect traditional recipes and methods, and encourage producers to maintain those recipes and methods and perhaps develop new ones. I agree with Mr Tiny's first submission that I should take great caution in extending the PGI Act to products outside the specifications. I have formed the view that the facts before me are not such an occasion.

Justice Chen Wishart made orders dismissing the copyright claim and the action under section 5(1)(a)(ii) of the PGI Act and upholding the claim in passing off. The claimants were granted leave to appeal to the Court of Appeal in relation to the conclusions on: (1) subsistence of copyright and (2) section 5(1)(a)(ii) of the PGI Act. The defendant was granted leave to cross-appeal in relation to the conclusions on passing off.

Oxford International Intellectual Property Moot 2022

Copyright Act 1997 – extracts

Part I COPYRIGHT

Section 1 Interpretations

“Artistic work” includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works.

“Sculpture” includes a cast or model.

Section 2 Subject matter of copyright

- (1) Subject to this Part, 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.
- (2) Copyright does not subsist in a literary, dramatic, musical or artistic work unless and until it is recorded in writing or some other material form; and references in this Part to the time at which such a work is made are to the time at which it is so recorded.
- (3) It is immaterial for the purposes of subsection (2) whether the work is recorded by or with the permission of the author.

Section 9 Exclusive rights

- (1) Copyright, in relation to a literary, dramatic or musical work, is the exclusive right:
 - (a) to reproduce the work in a material form;
 - (b) to publish the work;
 - (c) to perform the work in public;
 - (d) to communicate the work to the public;
 - (e) to make an adaptation of the work;

- (f) to do, in relation to a work that is an adaptation of the first-mentioned work, any of the acts specified in relation to the first-mentioned work in subparagraphs (a) to (e), inclusive.

(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.
- (2) References in this Part to the doing of an act comprised in the copyright in a work are to the doing of it:
 - (a) in relation to the work as a whole or any substantial part of it; and
 - (b) either directly or indirectly.

Protected Geographical Indications Act 2007 – extracts

Section 5 Protections for registered names

- (1) Registered names shall be protected against:
 - (a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where:
 - (i) those products are comparable to the products registered under that name; or
 - (ii) using the name exploits the reputation of the registered name, including when those products are used as an ingredient;
 - (b) ...

Oxford International Intellectual Property Moot 2020

Cases cited by Justice Chen Wishart

Kelley v Chicago Park District, 635 F. 3d 290 (7th circuit, 2011)

George Hensher Ltd v Restawile Upholstery (Lanc) Ltd [1976] AC 64

Lucasfilm Ltd v Ainsworth [2008] EWHC 1878 (Ch)

Cofemel v G-Star Raw CV (C-683/17) [2020] ECDR 9

SI and Brompton Bicycle Ltd v Chedech / Get2Get (C-833/18) [2020] ECDR 10

Bongrain's Application [2005] RPC (14) 306

Erven Warnink v Townend [1979] AC 731

Chocosuisse Union des Fabricants Suisses de Chocolate v Cadbury [1999] RPC (23) 826

Diageo North America Inc v InterContinental Brands (ICB) Ltd [2010] EWHC 17 (Ch)

Twentieth Century Fox v South Australian Brewery Co (1996) 66 FCR 451

Comité Interprofessionnel du Vin de Champagne v Aldi (C-393/16) (Second Chamber, 20 December 2017)