

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2137060
IN THE NAME OF SCHOLASTIC INC.,**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47873 IN THE NAME OF
EMILIE BOON**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2137060
in the name of Scholastic Inc.,**

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and

**IN THE MATTER OF opposition thereto under No 47873
in the name of Emilie Boon**

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Background

On 26 June 1997, Scholastic Inc. applied to register a trade mark in Class 16 in respect of the following goods:

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Books; printed publications; magazines; printed matter.

The trade mark applied for is as follows:

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On 3 December 1997, Emilie Boon filed notice of opposition to this application, the grounds of opposition being in summary:

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1. Under Section 5 Because the mark applied for is identical or similar to the opponent's trade mark and is proposed to be registered for goods which are identical or similar to the goods for which the opponent has used their trade mark and have rights.

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2. Under Section 5(4) Because of the extensive use in the United Kingdom by or on behalf of the opponent of the trade mark, the opponent has acquired a substantial goodwill and reputation and is the proprietor of an earlier right.

3. Under Section 3(6) Because the application was made in bad faith.

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The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

Both sides request that costs be awarded in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 12 February 2001, when the applicants were represented by Mr Nicholas Wilson of Withers & Rogers, their trade mark attorneys, the opponents by Mr John Orchard of John Orchard & Co, their trade mark attorneys.

Opponent's evidence

This consists of a two Statutory Declarations, dated 20 October 1998 and 28 October 1998. both from Oliver John Orchard, the Principal of John Orchard & Co, Chartered Patent Agents, the opponent's representatives in these proceedings.

In the first of these Declarations Mr Orchard begins by saying that Emilie Boon, who lives in the United States, is a book illustrator, and by way of example refers to exhibits OJO1 and OJO2 which consist of copies taken from two illustrated children's books published in 1988, and to exhibit OJO3 which consists of a similar book published in 1997. On the cover and inside pages can be seen, inter alia, illustrations of a hippopotamus, and references in the titles and text to "Little Hippo". The books at exhibit OJO1 and OJO2 credit Ms Boon with the rights to the copyright in the illustrations and the text to Harriet Ziefert, both dating from 1988, and exhibit OJO3 to the same but from 1997. All appear to have been published in the United Kingdom.

Mr Orchard goes on to refer to material distributed by the applicants in late 1997 which showed that they were planning to issue a series of publications under the imprint of a device of a hippo and the words Little Hippo, examples of which he shows at exhibit OJO4. The exhibit consists of an exhibition brochure promoting Scholastic Inc. at the 1997 Frankfurt exhibition and lists of book titles which include Little Hippo, Young Hippo, Hippo, Learn with Little Hippo, Play with Little Hippo, etc, mostly in conjunction with a device of a hippopotamus. These titles appear to have been available from June 1998 onwards.

Mr Orchard says that Ms Boon is concerned by what she saw as the "uncanny resemblance of the representation of the little hippo" adopted by Scholastic Inc, to her own illustrations in the books published in 1988 and 1997, and by their use of the words Little Hippo. He says that he was instructed to carry out a search for trade marks owned by Scholastic Inc. the results of which are shown as exhibit OJO5. The exhibit contains details published in the Trade Marks Journal relating to three trade marks belonging to Scholastic Inc, for the word HIPPO on its own and in conjunction with the device of a hippopotamus. Mr Orchard asserts that these do not resemble the hippopotamus used by the applicants at the trade fair in Frankfurt.

Mr Orchard next refers to exhibit OJO6 which consists of extracts from three books published by the applicants, showing copyright dating from 1987, and 1997. All show representation of hippopotamuses, some clearly intended to be "children" and there are references to LITTLE HIPPO throughout. He next refers to exhibit OJO7 which consists of one of the applicant's promotional leaflets for their Little Hippo books, upon which is superimposed one of Ms Boon's illustrations which Mr Orchard says was copied from the centre page of the book shown as exhibit OJO1, and illustrations from one of the applicant's books.

Mr Orchard begins his second Declaration by referring to exhibit OJO8, which consists of a statement from Penguin Putnam Books for Young Readers in which they say that the Little Hippo titles illustrated by Emilie Boon have been in continuous sale in the United Kingdom (and the USA) since 1988, and that to date, some 118,100 books have been sold. Although the statement does not give figures for the United Kingdom alone Mr Orchard says that Ms Boon's US attorney has given the total sales in the United Kingdom amount to 50,000 copies. He refers to exhibits OJO9a, OJO9b and OJO9c which consists of packing lists for books, which he gives as evidence to show that the titles are still on sale.

Applicant's evidence

This consists of three Statutory Declarations. The first is dated 23 April 1999, and comes from David Kewley, Managing Director of Scholastic U.K. Group Limited (a wholly owned subsidiary of Scholastic Inc.) and who are responsible for the marketing of Scholastic books in the United Kingdom.

Mr Kewley says that Scholastic is one of the largest publishers of children's books in the United Kingdom, and adopted the trade mark HIPPO and device of a hippopotamus as an imprint in or around 1979, at which time they applied to register the same as a trade mark. He continues saying that in 1993 his company introduced a second imprint of hippo range of books called YOUNG HIPPO, and in 1996 made plans to introduce another called LITTLE HIPPO which was the natural development of the HIPPO range of books. He refers to exhibit DK1 which consists of copies of his company's catalogues, the earliest of which dates from 1993 and shows the word HIPPO and device of a hippopotamuses head on the cover, and inside the words HIPPO and YOUNG HIPPO. Later catalogues use the same composite mark and contain references to HIPPO and YOUNG HIPPO with and without the head device. The catalogue for July to December 1997 makes reference to LITTLE HIPPO range of books which Mr Kewley confirms were published from August 1997 saying that LITTLE HIPPO was initially used as a reference to the target readership rather than the content of the books.

Mr Kewley says that although his company has now introduced two books; "Good Night Little Hippo!" and "Good Morning Little Hippo!", both of which are exhibited by Mr Orchard (OJO6), saying that the titles are supplemental to the imprint name. Mr Kewley says that there is a distinct difference between the opponent's and his company's use of the words LITTLE HIPPO, namely, that to the opponents they are the name of the subject character, whereas his company's LITTLE HIPPO books initially had nothing to do with hippos. He refers to exhibit DK2 which consists of four books published in 1997, all with the mark applied for on the cover, the contents being unrelated to hippopotamuses.

Mr Kewley denies that his company adopted LITTLE HIPPO as a trade mark as a result of the opponent's books, stating that others have produced hippo characters in books and that the character LITTLE HIPPO was not necessarily first used by Ms Boone. He refers to his company's registration for the words LITTLE HIPPO, under number 2135781, which, he notes had not been opposed by Ms Boon but had been by a French company, the Grounds of Opposition being shown as exhibit DK3. Mr Kewley refers to the claim to have used LITTLE HIPPO as a character in books as far back as 1970. The exhibit also includes a copy of the cover of a book entitled "Hippo & Duck Bedtime Stories"

Mr Kewley says that the marks HIPPO, YOUNG HIPPO and LITTLE HIPPO have been used on a substantial basis with no instances of confusion. He gives details of the turnover figures for the years 1993 through to 1998, which for the YOUNG HIPPO books ranges from £56,000 in 1993-94, rising year on year to £149,000 in year ending 1996-97, the last full year prior to the relevant date. In relation to the LITTLE HIPPO mark he gives the figure for 1997-98 which amounts to £144,000. Mr Kewley confirms that sales have been throughout the United Kingdom via major bookstores.

Mr Kewley refers to, and describes the mark that his company has applied to register, commenting that the evidence filed by Emilie Boon uses LITTLE HIPPO as the name of a character in a book which did not include the name in the title until after his company had launched their LITTLE HIPPO imprint. He further comments on the images used in the comparison of the marks by Mr Orchard at exhibit OJO7, noting that the mark shown to belong to his company is not the mark applied for, but a character that appears in promotional literature. He denies that there is any similarity between the mark applied for and Ms Boon's illustration, commenting that illustrations in a book are not the same use as an imprint, because an imprint is the trade mark under which books are sold to the public, character illustrations within a book are not.

The next Statutory Declaration is dated 22 April 1999 and comes from Bettina Patterson, who says that she is the designer of the LITTLE HIPPO device depicted in the trade mark application filed by Scholastic Inc.

Ms Patterson says that she has been producing illustrations of hippopotami since 1984, when, for a commission she produced a selection of cards, two examples of which are shown as exhibit BP1. The exhibit appears to be a form of greetings card and depicts a caricature of a hippopotamus in a bathing costume. The card is marked as having a copyright belonging to CONRAN, her clients, dating from 1985. Ms Patterson refers to books about an elephant family for which she illustrated in 1986/87, and refers to exhibit BP2 which consists of representations of her elephant characters which, she says have similar characteristics to her hippopotamus characters, pointing to the strong, simple outlines and brightly coloured clothing.

Ms Patterson continues saying that in 1987 and 1988 she illustrated two books featuring hippo's, one of which is shown in exhibit OJO6. She says both books depict hippo's in various stances, and show stylised hippo's with three toes on each arm and leg and wearing brightly coloured clothes, often with spots or stripes. Ms Patterson refers to another book shown at exhibit BP3 which depicts a stylised rhino saying that it did not go to print, to exhibit BP4 which consists of some illustrated birthday cards depicting, inter alia, a hippopotamus which she produced as a commission in 1991, and to exhibit BP5 which consists of artwork for an elephant character.

Ms Patterson refers to exhibit BP6 which she says are sketches she prepared in 1996 for Scholastic Inc, and which were a development of the hippopotamus exhibited at BP4. The sketches show a hippopotamus character including a side-on view walking. Ms Patterson says that Scholastic Inc. had already decided on the name LITTLE HIPPO for a new range of pre-school books, and decided to use the sideways view of the young hippo as a colophon/device

for the new imprint, the style having been chosen to be the closest in feel to the look achieved when a character is executed in collage.

Ms Patterson denies that these sketches were developed from Ms Boon's illustrations, stating that they were a development of her many years of drawing hippo's and other large animals and says that any similarity is entirely coincidental, suggesting that this is down to the fact that the drawings of hippo's are made with crayon which is a recognised illustration technique and one that she had used before starting to draw animal characters. Ms Patterson refers to exhibit BP7 which consist of two illustrations of human characters to illustrate The Magic Flute, which Ms Patterson says were done with crayon and watercolour. Ms Patterson refers to exhibit BP8 which consists of various drawings and illustrations done, inter alia, with crayon or computer generated crayon outline.

Ms Paterson says that the mark as applied for is merely a white outline on a black background and is even further removed from the illustration used by Emilie Boon, and that the comparison is being made between the colophon used by Scholastic on their books and publicity material, and Ms Boon's illustrations. She says that in a comparison between the illustrations there are a number of striking and significant differences which she lists.

The final Statutory Declaration is dated 23 July 1999, and is a second Declaration of Bettina Paterson. Ms Paterson refers to exhibit BP9 which she says consists of enlarged drawings from the books "Hippos at Home" and "Goodnight Little Hippo", both of which feature her illustrations, and to exhibit BP10 which she describes as a compilation of her drawings of hippo's between 1984 and 1998. The drawings show hippo's, some intended to be young, in various stances and wearing items of clothing. Ms Paterson compares and describes the development of her hippo characters, detailing the differences and similarities in those by her drawn in 1987 with those produced over the years leading to the version produced in 1998.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Prior to the hearing Mr Orchard sent a letter refining the grounds of opposition to Section 5(4)(a) and Section 5(4)(b). Although not expressly mentioned in Statement of Case, Mr Wilson accepted that the evidence foreshadowed these grounds and raised no objection.

I turn first to the ground founded under Section 5(4)(a). That Section reads as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- 5 (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by
- 10 the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

15 From her own evidence it is clear that Ms Boon's rights exist in the illustrations which appeared in a number of children's books, the rights to the text including the words LITTLE HIPPO clearly resting with Harriet Ziefert with whom Ms Boon had collaborated. Section 5(4)(a) does not require that the earlier right relied upon be solely the property of the

20 opponents, it being possible to maintain an action for passing off where the goodwill is divided amongst different persons with each having an independent right to sue. However, I see nothing in the evidence which shows that Ms Boon has ever had any proprietary right in the text, and it follows, the name LITTLE HIPPO. That said, the words are an intrinsic part of the character in her illustrations and Ms Boon may well have acquired a degree of goodwill and reputation in respect of these words through this association.

25 From the evidence it is apparent that any use made of the words LITTLE HIPPO and/or the image of a hippopotamus has not been in trade, but as the name of a character in children's books sold under the trade mark of another trader. It could be said that her illustrations of hippopotami have established Ms Boon's reputation as an illustrator and act as an "attractive

30 force which brings her custom" in the form of further commissions. However, there is no evidence that the hippopotamus illustrations are regarded as a trade mark of Ms Boon's work or a sign by which her work is recognised.

35 There can be no dispute regarding the similarity of the respective word elements in which rights are claimed; they are both LITTLE HIPPO. A hippopotamus is not an imaginary animal and I would say would be easily recognisable as such to most people. Although the forms used by the opponents and the applicants are stylised, I do not see why the public should assume that goods sold under the applicant's version are connected with, or licenced by the

40 opponents in the way that they might where the image is of a completely fictional character.

45 Thus, the evidence does not establish in my view that Ms Boon has the goodwill or reputation in the words LITTLE HIPPO or the image of a hippopotamus required to sustain an action under passing off, or that the opponent will suffer any damage should the applicants use their mark in relation to the goods for which they seek registration. Consequently the objection founded under Section 5(4)(a) is dismissed.

The remaining ground is under Section 5(4)(b). That section reads as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- 5 **(b)** by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

10 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

15 Section 153 of the Copyright, Design and Patents Act 1988 sets out certain qualification requirements relating to the author of the work (Section 154), or the country of first publication (Section 155) which must be satisfied before any copyright can subsist. Section 153 reads as follows:

20 **153.—(1)** Copyright does not subsist in a work unless the qualification requirements of this Chapter are satisfied as regards—

25 (a) the author (see section 154), or

30 (b) the country in which the work was first published (see section 155), or

35 (c) in the case of a broadcast or cable programme, the country from which the broadcast was made or the cable programme was sent (see section 156).

40 **(2)** Subsection (1) does not apply in relation to Crown copyright or Parliamentary copyright (see sections 163 to 166) or to copyright subsisting by virtue of section 168 (copyright of certain international organisations).

45 **(3)** If the qualification requirements of this Chapter, or section 163, 165 or 168, are once satisfied in respect of a work, copyright does not cease to subsist by reason of any subsequent event.

Clearly subsections 1(c) and 2 do are not applicable in this case. Sections 154 and 155 read as follows:

50 **154.—(1)** A work qualifies for copyright protection if the author was at the material time a qualifying person, that is—

55 (a) a British citizen, a British Dependent Territories citizen, a British National (Overseas), a British Overseas citizen, a British subject or a British protected person within the meaning of the [1981 c. 61.] British Nationality Act 1981, or

(b) an individual domiciled or resident in the United Kingdom or another country to which the relevant provisions of this Part extend, or

(c) a body incorporated under the law of a part of the United Kingdom or of another country to which the relevant provisions of this Part extend.

(2) Where, or so far as, provision is made by Order under section 159 (application of this Part to countries to which it does not extend), a work also qualifies for copyright protection if at the material time the author was a citizen or subject of, an individual domiciled or resident in, or a body incorporated under the law of, a country to which the Order relates.

(3) A work of joint authorship qualifies for copyright protection if at the material time any of the authors satisfies the requirements of subsection (1) or (2); but where a work qualifies for copyright protection only under this section, only those authors who satisfy those requirements shall be taken into account for the purposes of—

section 11(1) and (2) (first ownership of copyright; entitlement of author or author's employer),

section 12(1) and (2) (duration of copyright; dependent on life of author unless work of unknown authorship), and

section 9(4) (meaning of "unknown authorship") so far as it applies for the purposes of section 12(2), and

section 57 (anonymous or pseudonymous works: acts permitted on assumptions as to expiry of copyright or death of author).

(4) The material time in relation to a literary, dramatic, musical or artistic work is—

(a) in the case of an unpublished work, when the work was made or, if the making of the work extended over a period, a substantial part of that period;

(b) in the case of a published work, when the work was first published or, if the author had died before that time, immediately before his death.

(5) The material time in relation to other descriptions of work is as follows—

(a) in the case of a sound recording or film, when it was made;

(b) in the case of a broadcast, when the broadcast was made;

(c) in the case of a cable programme, when the programme was included in a cable programme service;

(d) in the case of the typographical arrangement of a published edition, when the edition was first published.

155.—(1) A literary, dramatic, musical or artistic work, a sound recording or film, or the typographical arrangement of a published edition, qualifies for copyright protection if it is first published—

(a) in the United Kingdom, or

(b) in another country to which the relevant provisions of this Part extend.

(2) Where, or so far as, provision is made by Order under section 159 (application of this Part to countries to which it does not extend), such a work also qualifies for copyright protection if it is first published in a country to which the Order relates.

(3) For the purposes of this section, publication in one country shall not be regarded as other than the first publication by reason of simultaneous publication elsewhere; and for this purpose publication elsewhere within the previous 30 days shall be treated as simultaneous.

These provisions of the Copyright, Designs and Patents Act 1988 were amended by the Copyright (Application to Other Countries) Order 1999 (SI 1999 No. 1751) which extended aspects of the protection granted by the 1988 Act to countries party to specified international conventions and agreements, that are part of the European Community or considered to have adequate legislation. The extension is subject to certain provisions set out in paragraph 2(2) of the Order. The relevant paragraphs read as follows:

2. - (1) In relation to literary, dramatic, musical and artistic works, films and the typographical arrangements of published editions, sections 153, 154 and 155 of the Act (qualification for copyright protection) apply in relation to-

(a) persons who are citizens or subjects of a country specified in Schedule 1 to this Order or are domiciled or resident there as they apply to persons who are British citizens or are domiciled or resident in the United Kingdom;

(b) bodies incorporated under the law of such a country as they apply in relation to bodies incorporated under the law of a part of the United Kingdom; and

(c) works first published in such a country as they apply in relation to works first published in the United Kingdom;

but subject to paragraph (2) and article 5 below.

(2) Copyright does not subsist-

5 (a) in a literary, dramatic, musical or artistic work by virtue of section 154 of the Act as applied by paragraph (1) above (qualification by reference to author) if it was first published-

10 (i) before 1st June 1957 (commencement of Copyright Act 1956[2]); or

(ii) before 1st August 1989 (commencement of Part I of the Act) and at the material time (as defined in section 154(4)(b) of the Act) the author was not a relevant person; or

15 (b) in any work by virtue of paragraph (1) above if-

(i) a date is, or dates are, specified in Schedule 1 to this Order in respect of the only country or countries relevant to the work for the purposes of paragraph (1) above, and

20 (ii) the work was first published before that date or (as the case may be) the earliest of those dates;

25 and for the purposes of sub-paragraph (a)(ii) of this paragraph, a "relevant person" is a Commonwealth citizen, a British protected person, a citizen or subject of any country specified in Schedule 1 to this Order, or a person resident or domiciled in the United Kingdom, another country to which the relevant provisions of Part I of the Act extend or (subject to article 5 below) a country specified in Schedule I to this Order.

30 Turning first to the question of the authors, Emilie Boon and Harriet Ziefert. Self evidently neither is an incorporated body. There is nothing in the evidence which establishes that either qualifies under the Copyright, Designs and Patents Act 1988 by virtue of nationality, citizenship, residence or domicile as required by Section 154 of that Act.

35 With regard to the Copyright (Application to Other Countries) Order 1999. There is nothing to indicate where Ms Ziefert is resident. Ms Boone is shown as being resident in the United States which in Schedule 1 to the Order is listed as being a country to which cover in respect of artistic and literary works extends. . However, paragraph 2 of the order does not extend copyright protection to works published prior to August 1989, the consequence of which is

40 that the opponent cannot claim qualification under Section 154 in respect of the books published in 1988, but can do so in respect of the book "LITTLE HIPPO'S NEW HOUSE" stated as having been published in 1997. However, this is of little assistance because it does not establish a right earlier than the relevant date in these proceedings.

45 This leaves the question of qualification under Section 155 of Copyright, Designs and Patents Act 1988. Both of the books shown at exhibit OJO1 and OJO2 show a date of first publication as 1988. Although it does not say that this was in the United Kingdom, I consider

it reasonable to infer that this was in fact the case, and consequently, that the opponent qualifies under Section 155. But even if this were not the case, the book shown at exhibit OJO1 is endorsed as having been “published simultaneously in Canada” (which I take to mean in 1988) and as Canada is a country covered by the Copyright (Application to Other
5 Countries) Order 1999 this would meet the criteria under Section 155. I also note that the publisher is shown to also have operations in Australia, the United States and New Zealand, also countries covered by the Order, and it seems most unlikely that publication of the books would not have taken place in one or more of these locations. Accordingly I consider that the opponent qualifies under Section 155.

10 Having established that the opponent is qualified, the next question is whether there is any right in which copyright subsists. Section 1 of Copyright, Design and Patents Act 1988 sets out what is protectable by copyright. That section reads as follows:

15 **1.—(1)** Copyright is a property right which subsists in accordance with this Part in the following descriptions of work—

(a) original literary, dramatic, musical or artistic works,

20 (b) sound recordings, films, broadcasts or cable programmes, and

(c) the typographical arrangement of published editions.

25 **(2)** In this Part "copyright work" means a work of any of those descriptions in which copyright subsists.

30 **(3)** Copyright does not subsist in a work unless the requirements of this Part with respect to qualification for copyright protection are met (see section 153 and the provisions referred to there).

The section asks the questions; is what is being claimed as an earlier right “work” in which copyright can subsist?, and if so, is it original? It is clear from subsection 1(a) that copyright can subsist in literary and artistic works which would clearly encompass the opponent’s illustrated books.

35 From the evidence and Mr Orchard’s submissions it is clear that the opponent is primarily relying on her rights to copyright in the illustration of a juvenile hippopotamus that she had drawn for two books entitled MUMMY WHERE ARE YOU and DADDY CAN YOU PLAY WITH ME published by Puffin Books in 1988, and a third book entitled LITTLE HIPPO’S
40 NEW HOUSE published by Dorling Kindersley Ltd in 1997. Copies of these books are shown as exhibits OJO1 to OJO3 and credit Emilie Boon with the copyright to the illustrations. Mr Wilson conceded that the illustrations are likely to attract copyright although in my view this is not conclusive, and I will go on to look at the facts of this case as established by the evidence.

45 The books refer to the hippo character by the name of LITTLE HIPPO although acknowledge that the copyright in the text is the property of Harriet Ziefert. Mr Wilson submitted that based on the decision in Exxon Corporation v Exxon Insurance Consultants International

Limited (1982 RPC 69) the words LITTLE HIPPO did not qualify for protection as a literary work. In that decision Graham J referred to Lewis Carroll's book, *Through the Looking Glass*, in which is mentioned a creature known as a Jabberwock or Jabberwocky. He concluded that whilst copyright undoubtedly existed in the poem, the word alone could not properly be considered as a literary work the subject of copyright, saying:

"It becomes part of a "literary work" within the Act when it is embodied in the poem, but it is the poem as a composition which is a work within the Act and not the word itself."

The position seems very much the same in this case, LITTLE HIPPO being used as part of the title and text of the books, and I reach the position that there is no copyright available to the opponents in respect of the words LITTLE HIPPO

In order for copyright to subsist in a literary or artistic work, it must be original, but what does original mean? In *Bookmakers Afternoon Greyhound Services v Wilf Gilbert (Staffs) Limited* 1994 FSR 723, Mr Justice Aldous (as he then was) said that:

"It is settled law that the word "original" does not require original or inventive thought but only that the work should not be copied and should originate from the author."

There is no dispute that the illustrations in the three books mentioned above originate from Ms Boon, the first published use being in 1988. Although the applicants have a representation of a hippopotamus registered as a trade mark from an earlier date, by no stretch of the imagination could Ms Boon's illustrations be said to be a copy. In the absence of any evidence to the contrary I reach the conclusion that Ms Boon's illustrations are original work and entitled to copyright protection.

Having determined that there is an earlier right, in this case, copyright, the question is whether the applicant's use of the trade mark would be an infringement of that copyright. The correct approach to the determination of copyright infringement is well established and was set out quite recently in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* 2001 FSR 113 at 124 where Lord Hope of Craighead stated:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied upon are sufficiently close, numerous or extensive to be more likely the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying."

In that case the claim of copyright infringement related to only part of the defendant's overall design, and it is in this context that Lord Hope stated that the purpose of the enquiry is not to see whether there is similarity as a whole but in the features alleged to have been copied.

5 Much of Mr Orchard's argument revolved around a comparison of an illustration from Ms Boon's books and various illustrations drawn by Bettina Patterson for the applicants and which they have used in promotional material. However, as Mr Wilson pointed out, and correctly so, the comparison should be in respect of the mark applied for. Mr Orchard placed particular reliance on one illustration of a striding hippopotamus wearing a form of dungaree's, noting the similarity with the mark in suit, and the differences in appearance and style of the illustrations drawn by Bettina Patterson in 1987. Whilst Mr Orchard did not contend that Ms Patterson had deliberately copied the work of Ms Boon, it is clear from section 16(3)(b) of the CDP that direct or indirect copying of a copyright work is an infringement.

15 The respective illustrations are as follows:

Application

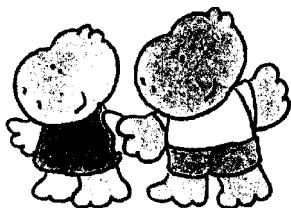


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Bettina Patterson (1987)



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Emilie Boon (1988)



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Bettina Patterson (1997)



The applicants sought to show that the mark applied for is similar to, or a development of Bettina Patterson's work, and consequently, that it was not a copy of Ms Boon's illustrations. In my view the mark applied for is closer in appearance to Ms Boon's illustration than Ms Patterson's earlier illustrations, which is all the more noticeable because both depict a side-on view of a striding hippopotamus, whereas there is no example of Ms Patterson's work showing a hippopotamus in such a way. It is interesting to note that Ms Patterson's illustrations in her book dating from 1997 show a number of changes from her earlier work and bear a much closer resemblance to the mark applied for. Ms Patterson in her evidence put this down to a change of technique rather than style, and I have no reason to doubt this explanation. However, given the differences I do not consider that the evidence establishes Ms Patterson's earlier work as the basis for her later work, and by inference, the mark applied for.

Ms Patterson does not say whether she had seen Ms Boon's work in the years that the books had been available prior to the applicants seeking to register their representation, and whilst nine years is a reasonably long period of time, I do not consider that this establishes with any degree of certainty that she is likely to have come into contact with the books. Mr Orchard has supplied figures from Penguin Books of New York, confirming that since 1988, total sales of the books amounted to 118,100, of which some 50,000 are said to have been effected in the United Kingdom. This equates to around 5,500 sales each year which given the size of the potential market is very modest and not sufficient to say that they are likely to have become widely known.

That these illustrations are based on an existing animal and not solely a product of the illustrator's imagination, it is not surprising that there are similarities. Where aspects of a work are commonplace or true to life (or close to such) I do not consider that another work containing these features will necessarily be an infringement of the earlier work. However, where the features have been subjected to some degree of interpretation by the illustrator so that they can be said to have originated from the illustrator, similarity in a later work is likely to be regarded as copying. That being the case, I would say that the answer to the question of whether the application is an infringement of Ms Boon's work will hinge upon whether the applicant's representation contains a substantial proportion of the work Ms Boon put into the characterisation.

In a comparison of the mark applied for and the "striding hippo" relied upon by Mr Orchard, I note the following:

Differences:

- Colour: the mark applied for is a white line drawing on a black background, whereas Ms Boon's illustration is in colour,
- Tail: the applicant's representation has a tail; Ms Boon's illustration does not,
- Head: in the mark applied for the head is composed of two similar size circles with a defined jaw line whereas the head in Ms Boon's illustration has a snout with a chin but no jaw line,
- Mouth: in the applicant's illustration the mouth starts lower down and curves to

the vertical, in Ms Boon's illustration the mouth runs from the front of the face just off the horizontal, defining a small chin below,

5 Limbs: the "legs and arms" in the applicant's representation have shaped "toes and fingers", as opposed to Ms Boon's illustration which shows these as drawn in detail in the limbs,

10 the applicant's representation is walking with the right leg leading, Ms Boon's hippo is leading with the left leg.

Similarities:

15 Stance: although leading with different legs, the stance is all but identical,

 Arms: both have the right arm leading,

 Features: ears, eyes and nose are similar in position, shape and size,

20 Attire: both are wearing a form of all-in-one suit; in the applicant's representation as an outline drawing, in Ms Boon's the clothing is in blue stripes.

25 In my experience it is not particularly unusual for animal characters in children's books, cartoons, etc, to be attributed with various anthropomorphic traits such as standing upright, walking or wearing clothes. The "facial" features are not that far from the norm, be it in size shape or positioning, nor is the posture any more than would be expected from an illustration depicting an animal walking. Accordingly I come to the view that the mark applied for cannot be said to have been copied from that which could clearly be said to be the work of Ms Boon, and consequently, the ground under Section 5(4)(b) fails accordingly.

30 The opposition having failed on all grounds, I order that the opponents pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

35 **Dated this 3 day of July 2001**

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**Mike Foley
for the Registrar
The Comptroller General**