

THE CASE

– Richard Dearlove (trading and professionally known as “Diddy”) v Sean Combs (trading and professional known as “Sean ‘Puffy’ Combs”, “Puffy” and “P. Diddy”)

– Chancery Division
28 February 2007

DIDDY DO IT?

Diddy v Puffy and P. Diddy



AUTHOR

Michele Boote specialises in Intellectual Property litigation, focusing on the media and entertainment sector, including television, film, music and sport. Her practice covers disputes involving trademarks, copyright, passing off and breach of confidential information. In 2006, Michele acted for adidas AG in connection with the protection and use of its iconic 3-Stripes on its successful application for injunctive relief against the International Tennis Federation and the Grand Slam tournaments and the subsequent preparation for trial before the matter settled. She also provided IP advice on the sale of Celador International Limited and the rights in various formats which it owned including "Who Wants to be a Millionaire?".



By **Michele Boote** of Addleshaw Goddard LLP

If you had never thought to see two grown men arguing over the privilege of being known by the sobriquet “Diddy”, think again. The issue which was first brought before the Court in November 2005 has raised its head again following a claim that the Settlement Agreement which had apparently resolved the dispute had been breached.

In the red corner stands Richard Dearlove, a record producer, re-mixer and recording artist. He claims to have been known as “Diddy” in a professional context since the early 1990s. In the blue corner stands the undoubtedly better known and more commercially successful Sean Combs, also a record producer, re-mixer and recording artist, who has been known variously as “Puffy”, “Puff Daddy” and “P. Diddy”. In August 2005, Mr Combs decided that, henceforward, he wanted to be known as “Diddy”. Following Mr Combs’ announcement and subsequent refusal to cease using this name in the UK, proceedings were commenced against him by Mr Dearlove for passing off.

In August 2006, Mr Combs proposed settlement and terms were agreed which result in a Settlement Agreement being signed. Under the Agreement, Mr Combs undertook not to do various acts in the UK including advertising, offering or providing (or causing or procuring others to do so) any goods and services under or with reference to the word “Diddy”. Further, Mr Combs would not otherwise pass off or attempt to pass off any goods and services which were

not Mr Dearlove’s as the same as or for goods and services connected or associated with Mr Dearlove.

Following the settlement, Mr Dearlove claimed that he had tried to ensure that Mr Combs complied with the terms of the Settlement Agreement but that this had been done in a piecemeal and ineffective way. Mr Dearlove therefore launched the present application for summary judgment complaining that Mr Combs had breached the terms of the Agreement. A number of complaints were made in the application but, by the time that it came to be heard by Mr Justice Kitchin, these had been significantly reduced. Mr Dearlove accepted, for example, that he could not pursue his application in respect of recordings released in the UK before the date of the Settlement Agreement which remained on sale thereafter and which credited Mr Combs and referred to him as “Diddy”. These recordings and this issue were therefore left over to trial.

Two strands of the summary judgment application survived: first, the use of the name “Diddy” in connection with web-pages on domains MySpace and YouTube and at www.badboyonline.com; secondly, references to Mr Combs as “Diddy” on six tracks of the album “Press Play” released in the UK in October 2006, after the Settlement Agreement was signed.

Summary Judgment

Under CPR Part 24, the Court may award summary judgment on the whole of a claim or a particular issue if it considers that the

defendant has no real prospect of successfully defending the claim or issue and there is no other compelling reason why the case/issue should proceed to trial. It is this test which Mr Dearlove sought to satisfy.

Web-Presence

As Kitchin J noted, the use of trademarks on websites has been reviewed in a number of cases. He referred, among others, to the 800-FLOWERS case¹ in which Jacob J (as he then was) considered whether or not Internet use of the mark 1-800 FLOWERS constituted a use of that mark in the UK. He concluded that the mere fact that websites can be accessed anywhere in the world does not mean that the law should regard them as being used everywhere in the world. That depends on the circumstances and, in particular, the intention of the website owner and what the visitor to the site will understand.

Based on his review of the authorities, Kitchin J concluded that placing a mark on the Internet from a location outside the UK can constitute use of that mark in the UK. The fundamental question was of course whether the UK consumer would regard the site as being directed at him. To assess this, the Court needed to consider all of the material circumstances including:

- the nature of the goods and services;
- the appearance of the website;
- whether it is possible to buy goods or services from the website;
- whether or not the advertiser has in fact sold goods or services in the UK through the website or otherwise;
- any other evidence of the advertiser's intention.

Applying these considerations to the facts here, Kitchin J believed that the web-pages at MySpace and YouTube and the badboyonline site were directed at UK users and did constitute the advertisement of goods and services in the UK by reference to the word "Diddy". For example, the MySpace pages contained numerous references to "Diddy" and allowed visitors to download songs from the "Press Play" album. Upcoming concerts were also listed including those taking place in the UK. Each of the web-pages and site promoted Mr Comb's activities as a recording artist and performer by reference to the name "Diddy".

In reaching his conclusion, Kitchen was also influenced by the fact that Mr Combs was an international celebrity whose new

album was sold here, that he was shortly to visit the UK as part of his current tour, that he accepted that MySpace and YouTube were a valuable promotional and marketing tool and that the web was the "primary means" by which "Press Play" was promoted – the websites were marketing tools used "internationally", and each site referred to UK visitors. Against this background, Kitchin J could hardly reach any other conclusion.

However, while Mr Combs had no real prospect of arguing that the web-pages and website constituted the advertisement of goods and services by reference to "Diddy" in the UK, Kitchin J was less certain that Mr

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Combs had control over this use. While he was sceptical of Mr Combs' evidence that he did not (because of the terms of the agreement with his record company), the Judge did not feel able to decide that there was no prospect of this case succeeding at trial. Mr Dearlove's application on this issue therefore failed.

Lyrics

In assessing whether or not the provision of "Press Play" containing the offending lyrics constituted the provision or advertisement of goods or services by Mr Combs in the UK under the name "Diddy", the Court was treated to a line by line analysis of six of the tracks on the album. Not since Lewison J was exposed to having his shizzle nizzled² has the High Court been delighted by such poetry:

*"I'm from the city where nothing pretty
And everybody know
i spit a flow to get up with diddy
and now we finna blow..."*

Kitchin stated that he could see no reason in principle why a lyric could not be so used but were they here?


The Judge thought that the songs fell into two categories. The first contained the majority of the tracks, where Mr Combs referred to himself as "Diddy" but the average consumer would not understand that the song was an advertisement which would breach the Settlement Agreement. The Judge was sympathetic to Mr Dearlove's argument that references by Mr Combs to

himself as "Diddy" might serve to dilute Mr Dearlove's goodwill but the only issue before the Court was whether there was a breach of the Settlement Agreement; there was not. The second category, comprising one song of the six, did constitute an advertisement. This song invited the listener to "mainline this new Diddy heroin", encouraged him to download the track and referred to Mr Combs' CD and his shows.

However, as was the case for the websites, the Judge thought that there was insufficient evidence to determine whether Mr Combs had control over the album and the songs it contained.

Comment

So something of a hollow, and probably expensive, half-victory for Mr Dearlove. Having dropped many of his arguments before the application was even heard, he then succeeded only partially on those which he pursued. The case illustrates the dangers of a summary judgment application. While it might appear to be a strong tactical weapon which, when wielded successfully can have a devastating effect on the defendant's case, it can also have the reverse effect and weaken, both legally and tactically, a claimant's position.

Mr Dearlove seems determined to prevent Mr Combs from using the name "Diddy" in the UK but at what cost? When Mr Combs is reported to have shelled out approximately £200,000 on the drinks bill for his latest party, a costs order may, indeed, be small beer to him. Can Mr Dearlove be so sanguine? And can he really hope to stop the rise of Mr Combs as "Diddy"? Mr Dearlove recognises that he can do nothing outside the UK but when Mr Combs is promoted elsewhere as "Diddy" it seems unlikely that Mr Dearlove can hope to ring-fence the UK. And, even if he can ultimately control Mr Combs, he cannot hope to rein in the press, television and other third parties and how they refer to Mr Combs. 

Notes

- 1 800-FLOWERS Trade Mark [2000] FSR 697
- 2 Confetti Records & Others v Warner Music UK Ltd and Another [2003] EWCH 1274