



INTELLECTUAL PROPERTY

Case Comment

IPC Media Ltd -v- Highbury SPL Publishing Ltd

By analogy to the pattern made by falling grains of sand, Mr Justice Laddie dismissed a claim for copyright infringement in a magazine's format. In a well-reasoned judgment which reviewed the UK law of copyright in this area, Laddie J cautioned against the excision approach to the assessment of copyright infringement. He said that if two individuals drop similar small quantities of sand on the floor and one removes all the grains of sand which are not in equivalent positions, surprising similarities exist. But, he said, these similarities were an artefact created by the very process of ignoring all the differences and so he found when deciding that any similarities which existed between two competing magazines were only there when excised from the rest of the work.

The case concerned IPC Media's Ideal Home magazine which it alleged had been copied by Highbury SPL Publishing's Home magazine. Both titles were monthly publications directed at the home design and decorating market. IPC's title included features such as "Find your perfect home style", "IH Style File; Five looks for kitchens", "IH Style File; Five looks for bathrooms", "Choose the Best" and "Solve your Home Problems". IPC claimed that the features constituted or comprised original artistic works and as such were entitled to copyright protection. IPC also claimed that each of its magazine covers were artistic copyright works. However, the way in which IPC pleaded its case, claiming copyright protection in the "design, subject matter, theme and presentational style" rather than the content of the covers and articles themselves, led Laddie J to conclude that the claim was "illegitimate"¹.

What is capable of protection as a copyright work?

Under the Copyright, Designs and Patents Act 1988 ("CDPA") copyright subsists in original literary and artistic works (amongst others)². Artistic works include paintings, drawings, diagrams, maps, charts and plans ("graphic works") and photographs³. The CDPA gives the author of a copyright work the exclusive right to exploit it and prevent others reproducing it in any material form without his consent⁴.

It was not in question that the individual articles and photographs contained in the IPC Ideal Home publication attracted copyright protection. Further, there was no allegation that Highbury had reproduced specific articles or photographs. The allegations went to the issue of whether the Design Elements, defined as the "design, subject matter, theme and presentational style" could attract copyright protection and, if so, did Highbury's Home magazine infringe the copyright in these Design Elements.

Under UK copyright law the test as to what amounts to an original work rarely causes the courts too much of a problem. Provided the work is not copied from someone else and crosses the de minimis threshold of being the product of the author's own skill and effort it is likely to be regarded as original. Even when the work is part of a series which adopt elements of the earlier works, each subsequent work usually attracts copyright protection⁵.

Further, UK copyright law is concerned with the expression of the idea not the idea itself. This is often referred to as the expression idea dichotomy. The law does not protect the author's idea – anyone is free to write a love story or paint the Houses of Parliament – only when the idea is recorded in writing or otherwise⁶ does it attract protection. For the purposes of determining the question of infringement this has the practical consequence of forcing a claimant who alleges that his copyright has been infringed, to identify the precise work which has been reproduced without permission⁷.

Format rights

UK copyright law has struggled for many years with the problem of how to protect "formats" whether in the context of magazines and their covers or television programmes⁸. Intellectual property rights may protect all elements of a format such as the name, parts of the design and the literary content individually; names by the registration of a trade mark; the designs by registered and/or unregistered design right and possibly copyright; and literary works by copyright – protection of a nebulous collection of such rights as a whole is harder. Whilst it may be possible to point to elements of a publication and say that is what makes up its "format", because the specifics of these elements change from month to month, their combination is not sufficiently certain for the purposes of copyright



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to be protected.

The leading common law case which reached the English court on format rights is *Green -v- Broadcasting Corporation of New Zealand*⁹. In this case, Hughie Green sued the Broadcasting Corporation of New Zealand for taking and using his television format rights for the talent show called “Opportunity Knocks”. Mr Green had a number of catchphrases such as “It’s make your mind up time” and the show recorded how well the audience judged each contestant had done by means of a “clap-o-meter”.

Despite these key elements the Privy Council decided Mr Green did not have any rights in the show which the common law could protect. He could not make out a case for passing off because he did not have the requisite goodwill in New Zealand. The show was too fluid and dynamic to attract copyright protection because no “work” could be identified with a sufficient degree of certainty. His catchphrases had not been registered as trade marks and were too short for copyright protection in themselves. The whole format was just an idea and, in accordance with long established principles, it was held that there was no copyright in an idea and consequently the television show.

The Opportunity Knocks case was applied and followed in the IPC case in respect of magazine formats.

Evidence of copying

Rarely are copyists caught red handed or is copying so blatant (save in the case of counterfeiting operations) that no qualitative analysis of the respective works in question has to be undertaken. Once a claimant has identified a “work”, he must establish that the defendant has reproduced at least a substantial part of it and from this allow an inference of copying to be found. As a general rule, the greater the similarities between the alleged infringement and the copyright work, the greater the chance of copying being inferred. However, the court must be cautious to guard against, what was described in another context as, “the logical fallacy of the undistributed middle”¹⁰. The fact that similarities are present, does not necessarily mean that there has been copying. The author and the defendant may have worked quite independently from common sources, in similar environments, to achieve similar objectives and made use of similar common design techniques so as to produce works which have a degree of visual similarity. This is especially the case, if those similarities have been identified by the excision of all the bits which have undoubtedly not been copied to leave an illusion of copying in what is left.

Laddie J made clear that the “law of copyright has never gone as far as to protect general themes, styles or ideas”¹¹ and quoted from the Designers Guild case¹²:

“[C]ertain ideas expressed by a copyright work may not be protected because, although they are ideas of a literary, dramatic or artistic nature, they are not original, or so commonplace as not to form a substantial part of the work ... It is on this ground that the mere notion of combining stripes and flowers would not have amounted to a substantial part of the plaintiff’s work. At that level of abstraction, the idea, though expressed in the design, would not have represented sufficient of the author’s skill and labour as to attract copyright protection.”

Generally speaking, in cases of artistic copyright, the more abstract and simple the copied idea, the less likely it is to constitute a substantial part. Originality, in the sense of the contribution of the author’s skill and labour, tends to lie in the detail with which the basic idea is presented.”

The facts

Ideal Home, published by IPC, is the market leader by way of sales, in the interior design magazine market. Highbury publishes the monthly magazine, Home, and is a direct competitor of Ideal Home.

IPC alleged that the outer covers and certain parts of the internal sections of the May, June, July and August 2002 issues of Home were infringements of the copyright in certain earlier issues of Ideal Home as artistic works. The artistic works of the articles and covers were said to include the artistic template or spine around which they are built.

The arguments

Highbury said that the similarities relied on by IPC were trivial and went nowhere near raising an inference of copying, let alone proving it. The similarities, such as were said to exist, were due to the use of design tricks



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and concepts which were common in the field. Both the defendant and claimant designed their magazines in accordance with common design conventions utilizing common design expedients. The design of each of the covers and articles in issue was the result of a vast number of different design elements. No account of the differences between the publications was made in the claimant's case but to the extent there existed some nexus between the designs on and in the relevant issues of Home and those relied on by the claimant, IPC, it could only amount to the adoption of the most general design concepts, not copying in the copyright sense.

Highbury strongly believed that IPC's action was baseless and being pursued, not to prevent copyright infringement, but to harm a weaker but irritating competitor, although Mr Justice Laddie dismissed this.

IPC concentrated its arguments on the areas of alleged similarity as if those areas were covered by copyright in their own right which had the effect of drawing attention away from the covers and articles as a whole. IPC argued that Highbury's August 2002 edition of Home infringed the separate artistic copyrights in the covers of each and every edition of Ideal Home from January 1999 up to and including that of June 2002, despite substantial difference between them, by way of progressive copying.

Similar accusations were made in respect of the articles contained in the magazine. IPC said that Highbury had undertaken a protracted and deliberate course of copying Ideal Home over a number of years.

Expert evidence

The parties had been invited to call expert witnesses from the field of magazine design to address points on the significance of the design features in issue and the similarities between such design features having regard to the design conventions and practice in the magazine industry and process by which magazines are designed. Mr Justice Laddie acknowledged that the court benefited from tutoring by experts to appreciate better how those in the art field designed magazines and what the common design techniques were in the trade. Indeed, on the evidence, Laddie found that all the individual design features relied on by IPC, with one possible exception, were common or were the sort of thing that a designer could arrive at readily and without copying by applying known techniques to the task of designing a home interest magazine.

However, he did not appreciate the experts expressing opinions as to whether there had or had not been copying and said that he found that part of the evidence of "no value"¹³. Laddie was critical of the experts coming to the court with fixed preconceptions on the question of copying and found that this could undermine the evidence. This is a salutary reminder that where the court directs that it requires evidence on certain matters to allow it to decide a case, the parties should limit their evidence accordingly and not stray in to other areas which could ultimately have a damaging effect on the weight of the expert evidence.

Common features of the magazine covers

It was held that the reason IPC failed in its action against Highbury could be explained by reference to the magazine covers. If there were to have been copying and infringement it would have been most apparent in the covers as these do most of the work in getting customers to purchase the magazine.

Alleged similarities of the covers included the use of similar full bleed photographs on which a shadowed title was printed in a particular type face; the title was underlined by a strap-line written in lettering upon a reversed out box; there was similarity in the strap-lines "Britain's best-selling decorating magazine" and "the UK's best home-interest magazine"; and the use of text in particular type faces and in white lettering in several key places on the magazine covers (variously known as the "hot spot", the "cover-lines", the "stamp" and the "main taster"). IPC's case was that Highbury had taken all, or substantially all, of the features which appeared on IPC's magazine covers since spring 1999 by way of progressive copying. However, because it was a case of artistic copyright, there was no complaint as to the words used by Highbury, save as evidence of copying.

Laddie found the absence of greater specificity in IPC's pleadings was not by accident and agreed with Highbury when it argued that IPC had identified features at a high level of generality which left out features which made a significant visual contribution to the magazine covers. When IPC identified a typeface used by Highbury which was similar to one it had used it was advanced as a significant design element from which a finding of copying should be inferred. However, when it was clear that Highbury's typeface was different, its visual importance was ignored. This approach was also adopted when considering the use of capital, lower case and bold lettering and Laddie agreed that this was an inappropriate way to approach the question of copyright infringement.



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IPC tried to claim that the similarities were too numerous and close to be explicable by coincidence but Laddie refused to be persuaded by this argument. He found that the concentration by IPC on areas of similarity divorced from numerous differences and also divorced from the essentially routine nature of the design elements relied on, gave a misleading picture. Laddie said that IPC ignored Highbury's good explanation of independent design for each feature and no matter how trite such features were, asserted that their combination pointed to copying. For example, it was accepted that virtually all magazines obey what is called the "rule of quarters" in accordance with which the cover is notionally divided into quarters and content placed in each one but IPC attempted to place reliance on the bottom quarter of the cover as evidence of copying.

Laddie found that IPC had difficulty putting its finger on the specific issues which it alleged had been copied because its magazine cover was in a state of constant flux. Further, he found that the history of the development of Home was inconsistent with the allegation of prolonged and ever closer copying of Ideal Home and in fact supported a move away from Ideal Home (if anything).

Laddie found that any similarities were minor and at a high level of generality and were not as a result of copying.

Particulars of claim

Mr Justice Laddie gave some useful guidance on the way that particulars of claim should be pleaded in copyright cases by his scathing comments about IPC's statement of case. He said that the use of the words "occasionally", "in nearly all cases", "usually" and "typically" were inappropriate in particulars of copyright infringement. Either the copyright work has a particular feature and the defendant has copied it or it has not, in which case it cannot be relied on. He identified this as an example of the way in which the pleadings blurred the infringement claim. The reference to design features which happened to be common (usually) to a number of issues of Ideal Home, distracted the reader from the essential issue, namely whether a particular issue of Home infringed the discrete artistic copyrights which existed in particular issues of Ideal Home.

Conclusion

Mr Justice Laddie found that looking at IPC's allegations in the context of what was common in the trade, IPC had failed to raise even a prima facie case of copying. It was made clear that it was legitimate for Highbury to compete with IPC in this sector of the market. The use of focus groups by Highbury to assess mock-ups of their Home magazine covers by reference to the market leader, Ideal Home, merely reflected Highbury's aspiration to become the most popular home interiors title. Such close attention to the market leader could have led to copying, at least subconsciously, until it was appreciated how slight, scattered and superficial the alleged similarities were.

Although the analysis set out in the judgment focused on the magazine covers, it was held that the accusations in respect of the articles were of the same type and therefore dismissed on the same basis. Finally, Laddie J noted that even if contrary to his findings, Highbury had been "inspired" in some of its design choices by what it saw in Ideal Home, it was at far too high a level of generality to amount to infringement of copyright.

The final nail in the coffin for IPC was the award of indemnity costs against it. Highbury had been so confident in the originality of the work which went into the production of its Home magazine that it had set out in its defence full particulars of the design provenance of the covers and articles complained of. The evidence of IPC did nothing to displace the veracity of the very detailed design history set out in the defence and Mr Justice Laddie commended Highbury for setting out its case so extensively and so early on.

The case makes clear that the court has no appetite for extending the law of copyright to protect general themes, styles or ideas. Whilst it may be possible for the format and "look and feel" of a publication to be protected by the law of passing off where the classical trinity¹⁴ of misrepresentation, deception and damage are present, passing off was not considered in this case. Nor was a European argument run on the basis of Article 10bis of the Paris Convention¹⁵, of which the United Kingdom is a signatory, which imposes a duty on convention countries to ensure their laws protect against acts of "unfair competition".

The sands of time may run long enough to see a law introduced in the UK to protect format rights, whether for magazines or otherwise, but Mr Justice Laddie could not crystallise one on the facts of this case.



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Notes

- ¹ Para 23 of Mr Justice Laddie's judgment dated 21 December 2004
- ² CDPA s1
- ³ CDPA s 4
- ⁴ CDPA s16
- ⁵ *Cala Homes (South) Limited -v- Alfred McAlpine Homes East Limited* [1995] FSR 818
- ⁶ CDPA s3
- ⁷ *Cala Homes (South) Limited -v- Alfred McAlpine Homes East Limited* [1995] FSR 818 at 872
- ⁸ The television industry has long argued that the law needs to be amended to address the area of format rights and has created a self-regulatory group in the form of FRAPA "The Format Recognition and Protection Association" to assist members protect their rights. It allows members to lodge their formats with the organisation and, if disputes arise between members provides a mediation service.
- ⁹ [1989] 2 All ER 1086
- ¹⁰ *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31
- ¹¹ para 14 of Mr Justice Laddie's judgment dated 21 December 2004
- ¹² *Designers Guild Ltd -v- Russell Williams (Textiles) Ltd* [2000] WLR 241
- ¹³ para 40 of Mr Justice Laddie's judgment dated 21 December 2004
- ¹⁴ *Reckitt & Colman v. Borden* [1990] RPC 341 HL
- ¹⁵ 1883 Paris Convention for the Protection of Industrial Property. Article 10bis

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods."