



Image taken from <http://www.gregscott.com/rwscott/rwscott.htm>. Copyright 1997, 1998, 2002 Gregory J. Scott and/or Ralph W. Scott. Photos by R. W. Scott and digital editing by Gregory J. Scott

## Hummingbird sets suppliers aflutter

By Janine Hollesen, director

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Social media platforms were aflutter recently following allegations by a Cape Town artist that Woolworths reproduced her design of a hummingbird without her consent. Euodia Roets turned to social media to vent her frustrations by posting a blog entry in which she claimed cushion covers printed with a replica of her illustration, are now being sold by the retail chain.

### Introduction

In her blog, she claims she was approached by the home division's head buyer at the beginning of 2013 to discuss the possible inclusion of some of her Touchee Feelee range into the retailer's new artisanal range.

A few months after this meeting, having retained her samples, Woolworths advised Roets that it would not be using the samples. Soon after that, Roets was in a Woolworths store – where she came across a cushion cover depicting her design of the hummingbird.

### Provisions of the Copyright Act

The Copyright Act ("The Act") provides protection for a number of specified works. This includes an artistic work, into which category Roets' artwork would fall. The Act provides that the owner of the copyright work has the exclusive right to do or authorise the doing of the acts specified in the Act – including the reproduction of the work in any manner or form, which in this case is the reproduction of the artwork on the cushion.

In order to prove that Woolworths' conduct constitutes copyright infringement, it is imperative for Roets to prove that the artwork used by Woolworths was indeed copied from her "original" design.

According to radio interviews with the CEO of Woolworths and press articles quoting other Woolworths representatives, Woolworths signed off on the hummingbird design in November 2012 – months before meeting with Roets. If this is indeed the case, there can be no talk of copyright infringement. They further state that the use of birds and hummingbirds is a global trend and inspired the design.

### The question of original copyright

What makes this copyright ownership debacle even more complex, is the fact that Roets admits that she was inspired to paint her hummingbird artwork from a photograph taken by an American photographer Greg Scott.

The question then begs, can Roets indeed claim to be the owner of copyright in respect



Euodia Roets' hummingbird painting taken from her blog post <http://toucheefeelee.net/2013/10/18/how-woolworths-really-operates/>

of her artwork if she admits that it is a substantial copy of the Scott image?

In terms of the Act, a copyright work will be infringed if it not only reproduces the entire work but also if it reproduces a substantial part of another work. Whether or not a substantial part of any work has been used in another work concerns quality and not quantity. Regard is to be had to the degree of similarity between the works.

One of the requirements for the subsistence of copyright is that it must be original, the threshold for which is not exceptionally high in South Africa. In this case, if one compares the Scott image to the Roets artwork, it can be said that the Roets artwork is a substantial copy of the Scott image. It can thus be said that it is not original and therefore does not qualify as a new copyrighted work.

Could it be a case of pure coincidence that there is a degree of similarity between the Woolworths design and Roets' artwork, or could it be that both designers created the artwork using Scott's image?

If this is the case, there could be a case of indirect infringement by Woolworths in respect of Scott's image as there is no requirement that the infringing party is to knowingly infringe the copyright of a third party. An application for an interdict and delivery of the infringing goods and of the plates used or intended to be used for infringing copies could be launched.

### Preventive measures: a necessity, not an option

All things considered, it is imperative when appointing designers to create artwork – or indeed any form of copyright – that an exhaustive paper trail is kept on the design of the work. The appropriate

agreements also have to be signed in terms of which the designer assigns all copyright in the work to the commissioning party and warrants that the work will be original and not copied from any other source, and that the intellectual property of a third party has not been infringed.

Although the enforceability of the warranties may at times be difficult to pursue, such agreements could at least be of assistance to parties who commission the creation of artworks in the merciless court of public opinion.

### Earlier infringements

The hummingbird claims evoke memories of similar allegations brought against Woolworths a few years ago after the retailer launched a range of vintage sodas. In February 2012, the Advertising Standards Authority of South Africa ("ASA"), ordered the retailer to withdraw soft drink packaging carrying the phrase, "good old fashioned" which was also used by Frankies Olde Soft Drink Company.

Although not concerned with copyright, this matter placed the spotlight on intellectual property in relation to a product which was pitched by a supplier to a retailer, and the steps that can be taken in lodging a complaint with the ASA.

Although much of the talk in the media concerned the similarity of the packaging of



The hummingbird cushion designed for Woolworths, taken from Woolworths' website.

the products, Frankies only pursued the matter with the ASA with regard to the use of the term "Good Old Fashioned". The ASA was therefore not called upon to decide whether Woolworths copied the idea to sell sodas with "vintage flavours", whether they copied Frankies' labels nor that the specific flavours were copied. The ASA ruled that Woolworths provided no explanation as to how it had come up with the idea to use the phrase and consequently held that the only reasonable conclusion to be drawn from the evidence was that Woolworths deliberately and intentionally copied the phrase "Good Old Fashioned" from

Frankies' advertising.

If Woolworths could have been in a position to furnish evidence relating to the process which they followed in the adoption of the phrase, the ruling may have been different.

It is therefore imperative to ensure that during any decision process or adoption of any artwork or trade mark that the process is properly documented to indicate that such property had been independently created to prove that no infringement has taken place.

### Conclusion

In addition to the above, sight must not be lost of the importance of trade marks to any business, big or small. Trade marks are an essential part of any business as they identify and distinguish a business and its products from that of the competitor.

It is vital to ensure that trade marks are appropriately protected. Prior to adopting and using a mark, a search of the trade mark registries should be conducted to ascertain whether the mark is available. This will also indicate whether the use of the mark will constitute trade mark infringement. Due to the fact that the manufacture, branding and advertising of a new product or service can run into millions, it is advisable to first conduct the relevant searches.

This will avoid time, effort and money being spent on the launch of a new product or service, only to be faced with a demand to remove the goods or cease rendering the service under that mark. Once trade marks are registered, they provide protection for the identical or similar mark, goods or services and can be relied on to prevent third parties from infringing on your rights. The hummingbird debacle illustrates the importance of proper consideration regarding the use and registration of intellectual property rights.

With a well-established track record, the Werksmans Intellectual Property team can tell you just how secure your IP assets are.

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Janine Hollesen is a member of the firm's Intellectual Property Practice and became a director of Werksmans Attorneys following its merger with Jan S. de Villiers in 2009. Prior to this, she had been a partner at Jan S. de Villiers for nine years.

Janine specialises in all aspects of Intellectual Property (IP) law, including trade mark clearance searches and registration; the protection and enforcement of IP rights; IP litigation; unlawful competition; counterfeit goods; and domain name disputes. She also advises on commercial matters, including securitisation and due diligence investigations, and the protection of plant breeders' rights, including the commercialisation of new varieties and related litigation.

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She is a fellow of the South African Institute of Intellectual Property Law (SAIIPL) and a member of the International Trade Mark Association (INTA) and the Plant Breeders' Rights Committee.

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