

**EIP**

# Betty Boop as a badge of origin

In Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors [2014] EWHC 439 (Ch) Mr Justice Birss held that A.V.E.L.A. Inc. and its co-defendants (together “AVELA”) have infringed Hearst Holdings Inc.’s (“Hearst”) UK and European Community registered trade marks and committed acts of passing off in relation to “Betty Boop” merchandise.

## **Background**

Hearst claimed that it represented the originator of the 1930s American cartoon character Betty Boop and, therefore, was the only authentic source of Betty Boop merchandise in the UK. Hearst had UK and Community registered trade marks for the words “BETTY BOOP” and an image of Betty Boop. AVELA argued that it was a legitimate source of Betty Boop “imagery” in the UK. Both parties sold Betty Boop merchandise in the UK and the wider European Community. Hearst alleged that AVELA committed trade mark infringement and passing off by doing so. AVELA denied this and argued that Hearst’s marks were invalid.

(In the proceedings as a whole, Hearst also alleged copyright infringement by AVELA. However this claim was separated from the current trial and is due to be heard in January 2015.)

Hearst contended that any unauthorised product which: (i) bore an image of Betty Boop would infringe its figurative marks regardless of the pose of Betty Boop; or (ii) was recognisable as Betty Boop would infringe its word marks regardless of the words actually used. As to its passing off claim, Hearst contended that AVELA deceived the average consumer into thinking that its Betty Boop merchandise was either official Betty Boop merchandise or was authorised by Hearst as the official source of Betty Boop merchandise.

It was AVELA's case that it had reconditioned old movie posters of Betty Boop and only used the imagery derived from those posters on its Betty Boop merchandise (i.e. not Hearst's words or images). AVELA further contended that it did not use Betty Boop as a trade mark and that the Betty Boop imagery on the goods was purely decorative making no representation about trade origin (and therefore no misrepresentation for the passing off claim). AVELA also attacked the validity of Hearst's marks for: (i) being devoid of distinctive character because the marks constituted the name and/or image of a well-known character; and (ii) consisting exclusively of indications of the goods for which they were registered.

### **Decision**

Birss J held in favour of Hearst, finding that the marks were valid, that AVELA had infringed the UK and Community marks under sections 10(1), (2) and (3) of the Trade Marks Act 1994 (and their equivalents under the Community Trade Mark Regulation) and that AVELA had committed acts of passing off.

He rejected AVELA's defence under s11(2) of the Trade Marks Act (and Art 12(b) of the Community Trade Mark Regulation) that it was using the pictures of Betty Boop purely for decoration because the merchandise examined had swing tags which used the words "officially licensed" or similar indicating to the average consumer that the goods were official Betty Boop merchandise. He also held that no defence of honest commercial practices had been made out because AVELA knew of the existence of Hearst's marks, knew that it would be likely to object to its actions and knew of its reputation but still intended to take advantage of that reputation in direct competition and in the face of expressed objections. Finally he did not accept AVELA's contention that the Betty Boop merchandise was film memorabilia as the Betty Boop character had largely been built up by Hearst.

### **Comments**

Birss J concluded that the work carried out by Hearst through 20 years of trading Betty Boop merchandise in the UK meant that the average consumer saw the Betty Boop cartoon character not only as decorative but also as a sign related to origin. This made the cartoon character a valid trade mark, meaning that no other party was able to use images of Betty Boop without the permission of Hearst. This case demonstrates that it is possible to turn a cartoon character into a valid trade mark, if the average consumer can be educated to see the cartoon character as a badge of origin and not merely as being descriptive.

By Matthew Jones and Emma Muncey