

**IN THE HIGH COURT OF JUSTICE**  
**CHANCERY DIVISION**  
**PATENTS COURT**

Royal Courts of Justice, Rolls Building  
Fetter Lane, London, EC4A 1NL

Date: 11 July 2013

Before :

**THE HON MR JUSTICE ARNOLD**

Between :

**MAGMATIC LIMITED** **Claimant**  
**- and -**  
**PMS INTERNATIONAL LIMITED** **Defendant**

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**Michael Hicks and Jonathan Moss** (instructed by **Briffa**) for the **Claimant**  
**Richard Hacon and Chris Aikens** (instructed by **Gordons Partnership LLP**) for the  
**Defendant**

Hearing dates: 6-7, 10-11 June 2013  
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**Judgment**

**MR JUSTICE ARNOLD :**

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## Introduction

1. The Claimant (“Magmatic”) manufactures and sells a child’s ride-on suitcase under the trade mark Trunki. The Defendant (“PMS”) imports and sells a similar product under the name Kiddee Case whose design was admittedly inspired by that of the Trunki. Magmatic contends that PMS has thereby infringed the following intellectual property rights of Magmatic: (i) Community Registered Design No. 43427-0001 (“the CRD”); (ii) design rights in a number of designs relating to the Trunki; (iii) the copyright in the artwork for the packaging of the Trunki; and (iv) the copyright in a safety notice which appears on the packaging. At trial, PMS conceded claim (iv), but disputed claims (i)-(iii). In relation to claim (i), PMS contends that, if the scope of protection of the CRD is broad enough to encompass the Kiddee Case, the CRD is invalid over an earlier design called the Rodeo.
2. The only witness called by Magmatic was Robert Law, the founder and a director of Magmatic. PMS called two witnesses: Paul Beverley, PMS’s managing director and major shareholder, and Brian Turner of PMS’s solicitors, who oversaw some prior art

searches carried out on behalf of PMS. I am satisfied that all three witnesses were reliable witnesses.

### The development of the Trunki

3. In 1997 Mr Law was studying product design at the University of Northumbria. He entered the competition for the BASF/Institute of Materials Design Award 1998 (“the Award”). This is an annual student plastic design competition (now called the Design Innovation in Plastics Award) organised by the Institute of Materials (now the Institute of Materials, Minerals and Mining) and the Worshipful Company of Horners (which includes those who work in plastics). The competition was established in 1985, and by 1998 it attracted around 120 entries each year. These included students from nearly every product design college in the UK. The six finalists were mentored by designers from BASF, who at that time sponsored the Award. The theme for the 1998 competition was “a design for luggage”.
4. Mr Law had the idea of taking established technology for adult suitcases and designing a product for children that would maximise space, yet be fun and ergonomic to use. He visited a department store in Newcastle, but found little inspiration in the adult luggage on display. Finding himself in the toy section, however, he noticed that ride-on toys often featured a lift-up seat and around a litre of storage space. The storage space was limited because the toys were made by rotational moulding. Mr Law had the idea of using injection moulding to make a product that would be comfortable for children to ride on, yet would have a much larger internal space.
5. Mr Law developed this idea into a design which he called “Rodeo”. He made a mock-up of his design in polystyrene and a prototype in vacuum-formed plastic. He also produced a concept board with visualisations showing the product in use (reproduced in Annex 1 to this judgment). It is the concept board which shows most clearly what the product was intended to look like and how it was intended to be used.
6. Mr Law duly won the Award, receiving a cash prize of £200 (although not a work placement which had been promised). For reasons that will appear, there is an important issue about what became public and when as a result of this. There is no dispute that the presentation of the Award was a public ceremony, albeit that it was probably mainly attended by teachers, students and students’ relatives and friends in addition to the judges and representatives of BASF. Accordingly, there is no dispute that the persons who attended the ceremony will have seen the design of the Rodeo as shown in particular on the concept board, and could have taken that information away in their heads. To that extent, there is no dispute that the design of the Rodeo was made available to the public.
7. The dispute is as to whether it would have been possible for anyone who was not present at the ceremony either to find out about the existence of the Rodeo or, more importantly, to ascertain the design of the Rodeo in the period from 1998 to 20 June 2003. PMS relied on three items of documentary evidence as showing that this would have been possible. The first is a list of Award winners that is currently available on the Design Innovation in Plastics website, which refers to Mr Law as having won the Award in 1998 with the Trunki. This wording must post-date 20 June 2003, however, since the product was not called Trunki prior to then. There is no evidence that any

comparable list which was available prior to 20 June 2003 referred to the Rodeo, although it seems likely that Mr Law's name would have been recorded as the winner of the Award. In any event, even now the list of Award winners does not show the design of the Rodeo.

8. Secondly, PMS relied on a photograph of Mr Law at the ceremony with the concept board in the background, which is currently available on Magmatic's website located at [www.trunki.co.uk](http://www.trunki.co.uk). It is clear that this could only have been posted on the website after 20 June 2003, however, since the website did not exist prior to that date. Mr Law's evidence was that, prior to posting the photograph on his website, he had kept it in a file.
9. Thirdly, PMS relied upon a portfolio posted by Mr Law on a website located at [www.coroflot.com](http://www.coroflot.com) which includes images of a design referred to by the name Rodeo. Although the portfolio appears on the face of the website to have been posted on 16 July 2006, the relevant part of it refers to the Rodeo "hitting shops in summer 2003" and Mr Law accepted that he had probably posted that in 2003. There is no evidence that it was posted prior to 20 June 2003, however. More importantly, as Mr Law pointed out, the design depicted is not the Rodeo design which won the Award, but a design which dates from late 2002/early 2003 (see further below).
10. Accordingly, I find that it would not have been possible for someone who was not present at the ceremony to find out about the existence of the Rodeo, and certainly not its actual design, prior to 20 June 2003.
11. Between 1997 and 2002 Mr Law continued to develop the design. The bulk of the work took place in 2001 while Mr Law was learning to use a computer-aided design (CAD) package called Rhino. By June 2002 Mr Law had arrived at a design which he considered was sufficiently finished to show to a manufacturer. Accordingly, on 26 June 2002 he applied for UK Registered Design No. 3004793, which was registered on 23 July 2002 and lapsed due to non-renewal on 26 June 2012. Mr Law showed this design to a manufacturer in confidence, but the manufacturer was not interested. At this point Mr Law was still using the name Rodeo for the product, although the design had changed since 1998.
12. In January 2003 Mr Law visited the London Toy Fair and met a new toy company called Toyline International UK Ltd ("Toyline"). He subsequently granted Toyline a worldwide licence to manufacture and sell what became the Trunki. During early 2003 Mr Law worked intensively on translating the design of the Trunki into a physical product. This resulted in some further changes to the design, resulting in a design referred to in these proceedings as the Trunki "Mark I". Products made to this design were first sold in about May 2004.
13. Toyline went into liquidation in October 2005. Accordingly, Magmatic started selling the product itself in 2006. Shortly afterwards, Mr Law appeared on the television programme *Dragons' Den*, which led to Magmatic securing an agreement to supply John Lewis. At that time it had the product manufactured in China, although manufacture was transferred to the UK in 2012.
14. Since 2006, Mr Law has continued to develop the design of the Trunki. A "Mark II" design was created between about May and December 2006. Products made to this

design were first sold in June 2007. A “Mark IIA” design was created in 2008 and first sold in early 2009. A “Mark III” design was created between March and December 2009, and first sold in April 2010.

15. Various different versions of the Trunki designs have been sold, including versions with animal and insect prints such as cow and bee designs.
16. There is no dispute that the Trunki was an innovative design. Apart from the Rodeo, it does not appear that anything like it had been produced before. The product has won numerous awards and has been a significant commercial success. Magmatic calculates that in 2011 approximately 20% of all 3-6 year olds in the UK possessed a Trunki. Although the majority of Magmatic’s sales are in the UK, it sells the Trunki in 97 countries. Largely as a result of the success of the Trunki, Magmatic won the SME of the Year Award at the National Business Awards in November 2012.

#### The development of the Kiddee Case

17. PMS is a manufacturer, importer and distributor of a large range of goods, including toys and giftware. It has a strong presence in the discount sector of the retail market. PMS is associated with a Hong Kong company called PMS International Far East Ltd, of which Mr Beverley is also the majority shareholder. The companies share an office in Hong Kong.
18. Towards the end of 2010, Mr Beverley noticed the Trunki when travelling. He considered that it was a good product, and discovered that it had been successful. He also discovered that a discount version did not appear to be available, and concluded that there was a gap in the market which PMS could exploit. PMS purchased a Mark III Trunki and decided to produce a similar product. Mr Beverley asked an artist in PMS’s Hong Kong office, Will Shawcross, to produce some concept drawings of the proposed product. At that stage, however, Mr Beverley was unable to find a factory which could manufacture the product at a low enough price.
19. In October 2011, Nick Davidson, one of PMS’s senior buyers, saw some children’s ride-on suitcases produced by Molto Y Cia SA (“Molto”), a Spanish company, at the Canton Toy Fair. Mr Davidson negotiated with Molto with a view to PMS becoming its distributor, but was unable to reach agreement. During these negotiations, Molto gave PMS a sample case which Magmatic contends is a substantial copy of the Trunki. PMS also looked at some other ride-on cases which were available in China, and in particular one called the Bubule which Mr Beverley described as “ugly”.
20. At around the same time, Mr Beverley identified a suitable manufacturer in China called Taizhou Hensing Home Products Co Ltd (“Taizhou”). Mr Beverley discussed the project with Taizhou’s Sales Manager Ann Shen late in November 2011. She was aware of the Trunki and of several factories making local copies of it. Ms Shen said that she would get hold of a Trunki and some other cases and look at them. Mr Beverley’s evidence was that he explained to Ms Shen that PMS needed to avoid similarities to other cases on the market, otherwise there might be a problem with copyright.

21. In December 2011 PMS had some searches made for intellectual property rights registered in the names of Magmatic and Mr Law. These revealed a number of registered designs, including the CRD.
22. In early January 2012 Mr Beverley asked another artist in the Hong Kong office, Elvin Au Yeung, to look at the Trunki and the Molto and to come up with some more ideas for a ride-on case. Mr Au Yeung duly produced some concept drawings. Mr Beverley liked a drawing of a pig-styled case, but was concerned that Mr Au Yeung had put Trunki-like horns on the pig. He asked Mr Au Yeung to try some ears instead and to think about insects with antennae. Mr Au Yeung duly produced some revised concept drawings.
23. As Mr Beverley explained, PMS's artists are not product designers. Further, he himself is not artistic and cannot draw. Yet further, his involvement in the development of the Kiddee Case was intermittent, since he never stays in one place for very long and is almost always occupied on many different fronts at the same time. Accordingly, although he was in overall charge of the project, most of the detailed design work was done by Taizhou or its contractors.
24. On 16 January 2012 Mr Beverley visited Taizhou. He took with him Mr Au Yeung's revised drawings and the Molto sample. Ms Shen had obtained samples of the Trunki, Bubule and at least one local copy of the Trunki. Mr Beverley exhibited to his second witness statement photographs of these samples. The Trunki sample appears to be a Mark II. The local copy appears to be derived from a Mark IIA.
25. The meeting was attended by Ms Shen, her boss and an external toolmaker who did not speak any English. It was not attended by Taizhou's draftsman. Mr Beverley gave evidence that he spent a good deal of time outlining the parts of the design that were important to PMS and the reasons why. He explained the functional requirements of the product, including a target weight of 1.5 kg. He also explained that PMS wanted its case to be different from any other case on the market. He agreed with Ms Shen that Taizhou would buy in the fabric parts of the shoulder strap, handles, interior straps and pocket and also the clasps.
26. In early February 2012 Mr Au Yeung produced some further concept drawings, which Mr Beverley sent Ms Shen on 16 February 2012. On 23 February 2012 Taizhou sent PMS a preliminary set of tooling drawings. On 25 February 2012 Taizhou sent PMS a revised set of drawings. On 28 February 2012 Taizhou sent PMS a final set of drawings. After this, moulds were made, prototypes shown to PMS and refinements were made to the design. It took PMS longer than Mr Beverley had expected to achieve a product that met all relevant quality standards, as a result of which PMS did not start shipping the Kiddee Case to customers until December 2012. Apart from what is shown by the documents exhibited by Mr Beverley, he was not able to speak to the detail of the design work that was carried out since he neither did it himself nor was present when it was done. Indeed, PMS did not deal directly with the draftsman or toolmaker.
27. As I have made clear, there is no dispute that both PMS and Taizhou had samples of the Trunki. Nor is there any dispute that the design of the Kiddee Case was inspired by the design of the Trunki at least to some extent. There is, however, a minor dispute as to which design of Trunki was copied, to the extent that there was copying.

Magmatic relies upon five similarities between the Kiddee Case and the Trunki Mark III which are not present in the Trunki Mark II as showing that the Mark III design was copied. These are: (i) a soft strip running round most of three sides of the case between the two halves of the clamshell; (ii) a flared part of the ridge in the centre of the top of the case; (iii) a U-shaped slot in two of the fixtures for the cross-straps; (iv) five spoke-like ribs on the interior of the wheel-arch; and (v) a recessed design of eyelet and accompanying channel in the top of the case.

28. PMS relies upon the photographs referred to in paragraph 24 above as showing that Taizhou could not have copied a Mark III, but only a Mark II. Furthermore, I accept that, considered individually, some of the other similarities relied on by Magmatic are both inexact and explicable without derivation. In particular, as counsel for PMS pointed out, there is some documentary evidence of independent design of the eyelet by Taizhou. Nevertheless, I find it improbable that all the similarities should have arisen without derivation. Mr Beverley's evidence does not exclude the possibility that (unbeknownst to him) the draftsman and/or toolmaker had access to a Mark III or a local copy thereof. Accordingly, I find on the balance of probabilities that the Mark III design was copied directly or indirectly.
29. In any event, as I have already said, Taizhou had a sample of a local copy which I consider to have been derived from the Mark IIA. The difference between the Mark IIA and the Mark III in terms of duration of any design right is only one year.
30. It should be noted that the Kiddee Case comes in two basic versions, an animal version with handles formed to look like ears and an insect version with handles formed to look like antenna. Each version comes in a number of varieties which have different graphical designs on its surface: cow, leopard, pig, tiger, bee and ladybird.

#### The claim for infringement of the CRD

##### *The CRD*

31. The CRD was filed on 20 June 2003 and published on 28 October 2003. The "indication of the product(s)" given in the CRD is "suitcases". The CRD comprises six representations showing the exterior of the case from various angles. Reproductions of these representations are contained in Annex 2 to this judgment, together with corresponding photographs of a Trunki Mark I and a Kiddee Case. It will be noted that the representations of the CRD are all monochrome and do not show any surface decoration.

##### *Key provisions of the Regulation*

32. Council Regulation 6/2002/EC of 12 December 2001 on Community designs ("the Regulation") includes the following provisions:

"[Recitals]

...

- (14) The assessment as to whether a design has individual character should be based on whether the overall impression produced on

an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

...

#### *Article 4*

#### **Requirements for protection**

1. A design shall be protected by a Community design to the extent that it is new and has individual character.

...

#### *Article 5*

#### **Novelty**

1. A design shall be considered to be new if no identical design has been made available to the public:

...

- (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

2. Designs shall be deemed to be identical if their features differ only in immaterial details.

#### *Article 6*

#### **Individual character**

1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:

...

- (b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.



2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

*Article 7*

**Disclosure**

1. For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

...

*Article 10*

**Scope of protection**

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.
2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.”

*Legal principles*

33. *Article 7(1)*. By virtue of Articles 4, 5 and 6 of the Regulation, a Community registered design must be novel and have individual character having regard to any design “which has been made available to the public”. Article 7(1) sets out the ways in which a design may have been made available to the public. In short, any disclosure which makes the design public in any part of the world will suffice. This is subject to two exceptions, however. These may conveniently be labelled “obscure disclosures” and “confidential disclosures”. Only the first of these is relevant for present purposes. This applies where “these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”.
34. Although it was not directly in issue, the obscure disclosures exception was considered by the Court of Appeal in *Green Lane Products Ltd v PMS International*

*Group Plc* [2008] EWCA Civ 358, [2008] FSR 28. Jacob LJ, with whom Ward and Rimer LJJ agreed, said:

“66. ... How then did the exception to absolute novelty come about? The *travaux* are clear about this. It came about by reason of a specific piece of lobbying by the textile industry. It was a concern about counterfeiting and nothing to do with an intention that prior art, obscure in the field of intended use, should be discounted.

67. The Economic and Social Committee opinion of 1994 said this when considering the novelty provision:

‘3.1.2 This provision, as worded, would be difficult to apply in many fields, and particularly in the textiles industry. Sellers of counterfeit products often obtain false certification stating that the disputed design had already been created in a third country.

3.1.3 In these circumstances, the aim should be dissemination to interested parties within the European Community before the date of reference.

3.1.4 In the light of the above considerations, article 5(2) might be worded as follows: “A design shall be deemed to have been made available to the public if it has been published following registration, exhibited, used in trade or otherwise disclosed, unless this could not reasonably be known to specialist circles in the sector in question operating within the Community before the date of reference.”

68. This is clearly the forerunner of the exception in article 7. The Economic and Social Committee's suggestion was taken up, extended also to the individual character test and became the law. It is worthwhile quoting the Commission's explanation for the proposed exception contained in its 1966 amended proposal:

‘... article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the “safeguard clause”. Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that

antecedents can be found in remote places or museums.’

69. As Mr Hacon observes, for the exception to work as intended the sector concerned had to be that of the cited prior art. His example demonstrates this:
- ‘If the registered Community design was in respect of a design for, say, teapots and the alleged prior art was for Columbian textiles, it would be the textiles circles in Europe who would be in a position to know whether the “certification” was genuine. *Ex hypothesi* the teapot circles would never know.’
70. Moreover the exception was clearly conceived as narrow - it was aimed at obscure prior art only: it meant that forging this would not help an infringer.
71. Although there were further *travaux* before the ultimate Regulation, there was no significant relevant further change.”
35. There is a helpful discussion of this exception, which includes references to some more recent case law elsewhere in Europe, in Stone, *European Union Design Law: A Practitioners’ Guide* (OUP) at §§9.22-9.66. As the author comments, the wording of the exception gives rise to a number of questions of interpretation which may require resolution by the Court of Justice of the European Union. In Case C-479/12 *H. Gautzsch Grosshandel GmbH v. Münchener Boulevard Möbel Joseph Duna GmbH* the Bundesgerichtshof has referred a question concerning the interpretation of the exception to the CJEU, but neither side suggested that I should defer judgment in the present case until after the CJEU has given its judgment. Nor was it suggested that I should refer questions myself. Accordingly, I must interpret the exception as best I can in the light of the guidance that is currently available. There are a number of points to consider.
36. First, the exception refers to “these events”. The “events” are the events constituting disclosure referred to earlier in the first sentence of Article 7(1) – publication, exhibition, etc. Counsel for PMS submitted that the exception did not apply if the relevant event could reasonably have become known, even if the design itself could not reasonably have become known as a result of that event. I do not accept that submission. The purpose of the exception is to prevent obscure designs from being relied upon to attack the novelty and individual character of a Community registered design. If a design could not reasonably have become known, it cannot matter that the event could have become known. In most cases, of course, one will follow from the other.
37. Secondly, what is “the sector concerned”? In *Green Lane* the Court of Appeal held that it was the sector from which the prior design came, not the sector from which the registered design came. The Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) came to the opposite conclusion in Case R 84/2007-3 *Ferrari SpA v Dansk Supermarked A/S* (unreported, 25 January 2008) and Case R 9/2008-3 *Crocs Inc v Holey Soles Holdings Ltd* [2010] ECDR 11. An

appeal to the General Court in the latter case was not pursued. In those circumstances, I am bound by the Court of Appeal's decision in *Green Lane*. Furthermore, I agree with it.

38. Thirdly, who are “the circles specialised in” that sector? In *Green Lane* Lewison J (as he then was) held at first instance that this comprised all individuals who conducted trade in relation to products in that sector, including those who designed, made, advertised, marketed, distributed and sold such products in the Community ([2007] EWHC 1712 (Pat), [2008] FSR 1 at [34]-[35]). This point was not addressed by the Court of Appeal. In Case R 552/2008-3 *Harron SA v THD Acoustics Ltd* (25 July 2009, unreported) the Board of Appeal held that the circles included experts and all businesses involved in the trade including importers. Thus it seems clear that the words are to be broadly interpreted.
39. Fourthly, the test is whether the events “could not reasonably have become known in the normal course of business”. It is common ground that this is an objective test. Counsel for PMS emphasised that the question was whether the events *could not* have become known, not whether the events *would not* have become known. I accept that, but subject to the qualification that the test is whether the events could not *reasonably* have become known *in the normal course of business*. The wording must be interpreted as a composite whole.
40. It is common ground that the events in question must have occurred prior to the filing or priority date of the registered design. Counsel for PMS accepted that it was theoretically possible for a design to have become sufficiently obscure as a result of the passage of time that it could not reasonably have become known in the normal course of business at the filing or priority date even if it could have become known at the date of the event, although he submitted that this was unlikely to occur in practice.
41. Fifthly, who bears the burden of proof? Counsel for PMS submitted that the burden of proving that the exception applied rested on the party who relied on it, here Magmatic. He argued that this interpretation was supported by both the wording and purpose of the exception and by the case law of the Board of Appeal, in particular Case R 1516/2007-3 *Normanplast snc v Castrol Ltd* (unreported, 7 July 2008) at [9]. Counsel for Magmatic submitted that the burden of proving that the disclosure was made available to the public rested on the party challenging the validity of the registered design, and that included proof that the design could reasonably have become known as result of the event relied on. In the alternative he submitted that, if the burden of proof lay on the proprietor of the design, nevertheless the evidential onus could shift if on its face the disclosure was an obscure one. In support of these submissions, he relied on the decision of the Board of Appeal in Case R 1482/2009-3 *Termo Organika Sp. z.o.o. v Austrotherm GmbH* (unreported, 22 March 2012) at [38]-[44]. As counsel for PMS submitted, however, there is no indication in that decision that the question of burden of proof was argued or that the Board of Appeal was addressing its mind to the question. In my judgment the burden of proving that the exception applies rests on the party relying on the exception. I accept, however, that the evidential onus may shift to the other party once it is shown that the disclosure relied on appears to be an obscure one.
42. *The informed user*. The law as to the nature of the informed user was summarised by His Honour Judge Birss QC (as he then was) sitting as a High Court Judge in

*Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), [2013] ECDR 1 in a passage which was accepted to be accurate by the Court of Appeal on appeal [2012] EWCA Civ 1339, [2013] FSR 9:

- “33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo Inc v Grupo Promer Mon-Graphic SA* (C-281/10 P) [2012] F.S.R. 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* (T-9/07) [2010] ECDR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM* (T-153/08), judgment of 22 June 2010.
34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:
- i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzhen* paragraph 46).
  - ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
  - iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);
  - iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);
  - v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).
35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).”
43. The CJEU re-iterated what it had said in *PepsiCo* at [53] and [55] in Joined Cases C-101/11 P and C-102/11 P *Neuman v OHIM* [2012] ECR I-0000 at [53]-[54].
44. *The existing design corpus*. Recital 14 of the Regulation makes it clear that the overall impression produced on the informed user depends on “the existing design corpus”, taking into consideration the nature of the product to which the design is applied, and the industrial sector to which it belongs.
45. In *Grupo Promer* the Community design was registered for “promotional items for games”. The General Court held at [62] that the informed user “has *some* awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed” (emphasis added). In *PepsiCo* the CJEU appears to have approved this statement at [54]. The CJEU went on at [59] to say that the informed user “knows the various designs which exist in the sector

concerned, possesses a *certain* degree of knowledge with regard to the features which those designs *normally* include” (emphasis added).

46. PMS contends that the design corpus includes all designs which qualify as prior art under Article 7(1) of the Regulation and are not excluded by either the obscure designs exception or the confidential disclosures exception. Magmatic disputes this, and contends that the design corpus consists of the designs with which the informed user is likely to be familiar. Thus there may be designs which are not quite obscure enough to be excluded by the obscure designs exception, and thus can be relied upon as prior art for the purposes of Articles 5 and 6, but nevertheless do not form part of the design corpus when assessing the overall impression created by other designs for the purposes of Article 10. In support of this contention counsel for Magmatic relied upon the passages from *Grupo Promer* and *PepsiCo* that I have just cited. He also relied on passages in the judgment of His Honour Judge Birss QC in *Gimex International Groupe Important Export v Chill Bag Co Ltd* [2012] EWPCC 31, [2012] ECDR 25 at [44]-[47] and [65], but those were addressed to a slightly different issue to the one presently under consideration. Nevertheless, I agree that *Grupo Promer* and *PepsiCo* support Magmatic’s contention. For reasons that will appear, however, I consider that it makes no difference who is right about this in the present case.
47. *The designer’s degree of freedom.* I considered the designer’s degree of freedom in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), [2010] FSR 39 at [32]-[37], where I concluded that design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations. I also concluded that both a departure from the existing design corpus and the production of a wide variety of subsequent designs were evidence of design freedom. Apart from emphasising that the degree of freedom to be considered was that of the designer of the registered design, the Court of Appeal appears to have agreed with this: [2011] EWCA Civ 1206, [2012] FSR 4 at [18]-[20].
48. *Effect of design freedom on the scope of protection.* Article 10(2) of the Regulation indicates that, other things being equal, a registered design should receive a broader scope of protection where the designer had a greater degree of freedom and a narrower scope of protection where the designer had a lesser degree of freedom. Thus in *Grupo Promer* the General Court held:
- “72. In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer’s degree of freedom in developing the contested design must be taken into account. ... the more the designer’s freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.
- ...
82. In the absence of any specific constraint imposed on the designer, the similarities noted in [79]-[81] above relate to

elements in respect of which the designer was free to develop the contested design. It follows that those similarities will attract the informed user's attention..."

49. *Effect of differences between the registered design and the design corpus on the scope of protection.* Recital (14) of the Regulation indicates that, other things being equal, a registered design should receive a broader scope of protection where the registered design is markedly different to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. Thus in *Grupo Promer* the General Court held at [72]:

"... as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. ..."

50. Conversely, in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8 Jacob LJ held at [35(ii)]:

"... if a new design is markedly different from anything that has gone before, it is likely to have a greater overall visual impact than if it is 'surrounded by kindred prior art' (H.H. Judge Fysh's pithy phrase in *Woodhouse* at [58]). It follows that the 'overall impression' created by such a design will be more significant and the room for differences which do not create a substantially different overall impression is greater. So protection for a striking novel product will be correspondingly greater than for a product which is incrementally different from the prior art, though different enough to have its own individual character and thus be validly registered."

51. In *Dyson v Vax* I held at [41] that this did not apply where the striking elements of the design were ones where there was little design freedom, in particular because of technical requirements. This proposition does not appear to have been challenged on the appeal.

52. *Overall impression.* Although it is proper to consider both similarities and differences between the respective designs, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. As Jacob LJ has emphasised repeatedly, the most important thing about each of (i) the registered design, (ii) the accused design and (iii) the prior art is what they look like: see *Procter & Gamble* at [3], *Dyson v Vax* at [8] and *Samsung v Apple* at [28].

#### *Assessment*

53. *The Rodeo.* As I have said, there is no dispute that the design of the Rodeo was disclosed to the public at the Award ceremony in 1998. Magmatic contends that that disclosure falls within the exception for obscure disclosures, however. It is common

ground that the relevant sector is the suitcase sector. Accordingly, the question is whether the design of the Rodeo could not reasonably have become known in the normal course of business to circles specialising in suitcases within the Community as a result of the Award ceremony.

54. Magmatic relies on two main points as showing that it could not have become known: first, the Award was for plastics design; and secondly, as discussed above, there is no evidence that the design of the Rodeo was publicised more widely following the Award and prior to the filing date of the CRD. In my judgment neither of these points suffices to establish that the design of the Rodeo could not reasonably have become known in the normal course of business to those specialising in suitcases. So far as the first point is concerned, while the Award was for plastics design, it seems clear that it was a well-known award in the field of product design in the UK at that time. Furthermore, the theme of the competition in 1998 was luggage. In those circumstances it is possible that people connected with the luggage trade will have attended the Award ceremony and thus seen the design of the Rodeo. Accordingly, I conclude that the obscure designs exception does not apply.
55. *The informed user.* The Rodeo, the CRD and the Kiddee Case are all ride-on suitcases for a child aged 3-6. Accordingly, it is common ground between the parties that the informed users in the present case are (i) a 3-6 year old child and (ii) a parent, carer or relative of such a child. I have to say that I am dubious about (i), since the child will not be a purchaser (unlike *Grupo Promer/PepsiCo*, this is not a case about toys which might be purchased by a child with his or her pocket money), but since this is agreed I shall proceed on that basis. I doubt that it makes any difference either way.
56. *The design corpus.* It is common ground that the Trunki was the first child's ride-on suitcase. The only prior design for such a product that has been identified is the Rodeo. Given the relative obscurity of the Rodeo, I do not consider that it formed part of the design corpus of which the informed user would be aware. Since the Rodeo is the only specific item of prior art relied on by PMS, however, this makes no practical difference.
57. Apart from the Rodeo, it is common ground that the design corpus of which the informed user would be aware consists of a range of adult clamshell suitcases. Mr Turner produced illustrations of a number of these, including in particular the Samsonite Oyster, the Carlton Airtec and the Delsey Club. No challenge was made to Mr Turner's conclusion that the following would be known to the informed user:
  - i) Clamshell cases with substantially rectangular bases.
  - ii) Clamshell cases with clasps on the front and rear.
  - iii) Clamshell cases with four wheels, one on each corner.
  - iv) Clamshell cases with a ridge where the clamshell portions meet, such ridge running along the front, top and rear side of the case.
  - v) Clamshell cases with a strip located between the two clamshell portions which protrudes from the case so that it is approximately level with the top of the ridge.



- vi) Cases with eyelets at the top front and top back of the case.
58. Magmatic contends that the CRD represented a substantial departure from the design corpus, whereas PMS contends that it represented a modest departure. I agree with Magmatic. While PMS is correct that suitcases with features fitting the descriptions given in the preceding paragraph were commercially available prior to 20 June 2003, the overall impression given by the CRD is quite different to the earlier designs. This is partly due to the overall combination of features, but the horns and the shape and positioning of the clasps are particularly striking differences.
59. *The designer's degree of freedom.* Counsel for PMS submitted that the designer of the CRD had had relatively little freedom. In support of this submission, he relied upon his cross-examination of Mr Law, in which Mr Law agreed that various features of the design of the CRD were either "sensible" or "conventional" or "a trade-off" between different considerations. I do not agree that this evidence demonstrates that the designer's freedom was particularly constrained. On the contrary, the design of the Rodeo, other designs considered by Mr Law during the process of designing the Trunki, the designs produced by Mr Shawcross and Mr Au Yeung during the development of the Kiddee Case and third party designs such as the Bubule and Molto demonstrate that the designer of a child's ride-on suitcase has considerable freedom.
60. Nevertheless, I will quickly run through the main points relied on by counsel for PMS. First, Mr Law agreed that using four wheels was sensible; but, as he pointed out, it would have been possible to use three wheels. Secondly, Mr Law did not agree that the wheels had to be located in recesses in the corners. As the Bubule case demonstrates, they could have been located on projecting arms. Thirdly, Mr Law explained that he wanted the wheels to be small enough for the wheel base to be stable and not take up too much luggage space, but large enough to ride over obstacles. He therefore chose a wheel size which balanced these considerations. It would have been possible to have smaller or slightly larger wheels, however. Fourthly, Mr Law agreed that a clamshell design was a conventional solution to maximise luggage space. As he pointed out, however, other solutions were possible. More importantly, perhaps, a clamshell design does not dictate the shape of the clamshell. Fifthly, Mr Law explained that the shape of the top of the case was a trade-off between the child sitting securely and comfortably and maximising the space in the case. Other solutions would have been possible, however. Sixthly, Mr Law agreed that it was sensible to have something at the front for the child to grip. It was not suggested that it was essential, however, and in any event a wide variety of different grip features would be possible. Finally, Mr Law agreed that the dimensions of the Trunki were selected to ensure that it complied with airline restrictions on the maximum size for carry-on luggage. The CRD has no dimensions, however. Furthermore, different airlines are not entirely consistent in this respect, and their restrictions sometimes change. Nevertheless, I accept that this factor limits the proportions that can be adopted to some extent.
61. *Scope of protection of the CRD.* Given that the CRD represents a substantial departure from the design corpus and that the designer of the CRD had considerable design freedom, it follows that, subject to the impact of the Rodeo, the CRD is entitled to a broad scope of the protection.

62. *Overall impression: the CRD versus the Rodeo.* As noted above, PMS contends that, if the Kiddee Case is an infringement of the CRD under Article 10(1), then the CRD lacks individual character over the Rodeo under Article 6(1) because the overall impression of the Rodeo is no more different to the overall impression of the CRD than the overall impression of the Kiddee Case is. Although PMS only relies upon its validity attack by way of a squeeze, it is necessary to consider the extent to which the overall impression produced on the informed user by the CRD differs from that produced by the Rodeo before turning to consider the question of infringement.
63. Although the Rodeo has similarities to the CRD, there are quite a number of differences. The basic shapes are different. The Rodeo has a relatively simple shape with straight sides, a curved top surface and curved front and rear. The curved surfaces are curved essentially in one direction, although the corners between the surfaces are rounded. The ridge where the clamshells meet is unobtrusive. The CRD has a rather more complex shape. The case has a prominent ridge round the top and sides which flares out in the middle of the top. The sides have semi-circular indentations. The front and rear surfaces are curved both up-and-down and side-to-side. The CRD has projecting lips at the bottom of the front and rear which have no equivalent in the Rodeo. The proportions are different: the Rodeo appears to be shorter, wider and not quite as long as the CRD. This gives it a squatter appearance than the CRD. The clasps are of different appearance: the clasps on the Rodeo are approximately rectangular, whereas the clasps on the CRD are both ovals with a slice removed. The clasps are also lower down on the CRD than on the Rodeo, particularly in the case of the front clasp which is on the top surface of the Rodeo. The CRD has two horns on the front and a strap attached to two eyelets on the top, whereas the Rodeo has a handle shaped like an elongated dumb-bell attached to a pull-out strap and a circular indented winder for the strap. The CRD also includes a luggage tag attached to the rear eyelet which has no counterpart in the Rodeo, but I think the informed user would regard that as a removable feature of little significance.
64. In my judgment the informed user would notice both similarities and differences between the CRD and the Rodeo when comparing them in detail. What matters is how those similarities and differences would affect the informed user's overall impression. The Rodeo is rather squat and chunky, and the handle forms an important part of its appearance. Despite the novelty of the concept, the appearance of the Rodeo is somewhat crude and old-fashioned. By comparison, the CRD is slimmer and more sculpted, and the ridge and the horns form important parts of its appearance. The CRD appears to be considerably more sophisticated and modern than the Rodeo. Furthermore, the clasps have a rather different visual impact, looking much more like the nose and tail of an animal than the winder and the rear clasp on the Rodeo. Thus the overall impression created by the CRD is different to that created by the Rodeo. Accordingly, I consider that PMS was right not to challenge the validity of the CRD except as part of its squeeze argument.
65. *Overall impression: the CRD versus the Kiddee Case.* Before comparing the CRD with the Kiddee Case, it is first necessary to mention three preliminary points. The first, which I do not understand to be controversial, is that, since the CRD includes a (detachable) strap, the correct comparison is with the Kiddee Case with its (detachable) strap. The second, which again I do not believe to be controversial, is

that, since the CRD does not include a representation of the bottom of the suitcase, the bottom does not form part of the comparison.

66. The third point, which is controversial, concerns the graphical designs on the surface of the Kiddee Case. The CRD does not include any graphical designs on the surface of the suitcase, whereas the Kiddee Case is sold with one of a number of graphical designs on its surface (the photographs in Annex 2 show the tiger design). Magmatic contends that, when comparing the CRD with the Kiddee Case, the graphical designs on the surface of the Kiddee Case are to be ignored. PMS contends that they are to be taken into account.
67. A similar issue arose in *Procter & Gamble*, where Jacob LJ said at [40]:

“... I should record that [counsel for the defendant], under a little pressure from the Court, abandoned his point about decoration, rejected by the judge at [71]–[73]. He was right to do so. The registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant.”
68. Against this, counsel for PMS relied on what Jacob LJ had said in *Samsung v Apple* at [15]–[20]. As counsel for Magmatic pointed out, however, in that case Apple contended, and it was common ground, that an important feature of the registered design was the absence of ornamentation. In those circumstances Judge Birss held, and the Court of Appeal agreed, that the informed user would take the presence of Samsung’s trade mark on the alleged infringement into account, but would only give it slight weight.
69. In my judgment, the position in the present case is the same as in *Procter & Gamble*. The CRD is evidently for the shape of the suitcase, and the proper comparison is with the shape of the Kiddee Case.
70. Magmatic relies upon the following similarities between the CRD and the Kiddee Case:
  - i) A substantially rectangular portable luggage case with the sides being slightly curved.
  - ii) A saddle shaped top.
  - iii) Four wheels on a substantially rectangular base located close to the end of the long side of this base.
  - iv) Two horns/protrusions located at the top of the front of the case.
  - v) A ridge running up the front and back of the case wherein the middle of the ridge contains a thin strip running generally along the length of the ridge.
  - vi) The thin strip located in the ridge stopping for the clasps on the front and back and stopping for the eyelets.

- vii) A ridge running along the top of the case wherein the ridge flares out to form an oval in the middle of the top of the case.
- viii) A curved clasp on the front and back of the case located in the middle of the ridge and slightly above the visual centre of the front and back of the case.
- ix) The clasp on the front being located below the horns so as to give the impression of animal characteristics.
- x) Two eyelets located in the ridge at the top of the front and back parts of the case.
- xi) A strap being attached to the two eyelets and running between them.

71. I agree that the Kiddee Case is similar to the CRD in these respects, although the clasps on the Kiddee Case are slightly lower down than the clasps on the CRD.

72. PMS contends that, of 10 novel features in the CRD compared to the design corpus, no more than three can be said to be present in the Kiddee Case, as set out in Annex 1 to PMS’s skeleton argument:

	<b>Feature in [CRD] which is novel over design corpus</b>	<b>Present, absent or different in Kiddee Cases</b>
1	Two handles at the front shaped like horns.	Two handles present, but different shapes in the form of insect antennae or erect but folding animal ears.
2	Sides have a sculpted ridge and indent below of semi-circular shape.	Absent
3	Front [clasp] is (a) oval in outline shape, not circular and (b) has a plain outer surface.	Absent. Cover is circular and not plain.
4	Rear [clasp] is (a) oval in outline shape, not approximately square and (b) has a plain outer surface.	Absent. Cover is circular and not plain.
5	Strap along the top surface.	Present, but different shape
6	Ridge present along centre of front, top and rear, expanding to form an oval shape along the top and around clasp covers at front and rear.	Present, but different shape
7	[Lip] at bottom of front and rear.	Absent
8	Circular tab attached to strap, hanging down rear side.	Absent
9	Wheels have central circular feature from which extend five “spoke” ridges.	Absent. Wheel sides smooth.

10	Overall shape is symmetrical front to rear.	Absent. Asymmetrical shape. Seat to rear of centre.
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73. I agree that these differences are present, but in my view a number of them are not as visually significant as this table suggests. Thus the handles (item 1) are different in detail (more so in the case of their antennae than in the case of the ears), but the overall effect of their shape and positioning is similar; the clasp covers (items 3 and 4) are broadly similar despite the detailed differences; the strap is very similar (as is the method and positioning of its attachment); the ridge is very similar apart from the flared sections around the clasps; the absence of the tab (luggage label) would not strike the informed user as significant for the reason given above; and the asymmetry of the Kiddee Case is not particularly noticeable. In the case of the wheels, the real difference is that the wheels on the Kiddee Case have covers over them. Furthermore, the central feature and spokes are barely visible on the CRD.
74. PMS also contends that there are six features of the Kiddee Case which are absent from the CRD, as set out in Annex 2 to PMS's skeleton argument:

<b>Principal further features of Kiddee Cases absent from [CRD]</b>	
1	Prominent animal markings.
2	Eyes at front.
3	Wheels substantially obscured by side covers.
4	Two handles present at the top.
5	Overall more rounded contours.
6	[Clasps] at front and back have on the outer face (a) a circular feature (b) within which is a cross and (c) a cut-out portion at the side.

75. Items 1 and 2 in this list must be ignored for the reason given in paragraph 68 above. Item 3 I have already mentioned in paragraph 73 above. I agree that item 4 represents a difference, but since the handles are fabric handles, their visual impact on the overall design is not great. Item 5 is a more significant difference, particularly around the seating area. Item 6 I have already addressed in paragraph 73 above.
76. In my judgment the informed user would notice both similarities and differences between the CRD and the Kiddee Case when comparing them in detail. What matters is how those similarities and differences would affect the informed user's overall impression. In my view the most noticeable differences between the Kiddee Case and the CRD are (i) the more rounded contours of the Kiddee Case around the seating area compared to the more angular contours and semi-circular indentation of the CRD in that area and (ii) the covered wheels of the Kiddee Case. Also noticeable are (iii) the more flared areas of the ridge around the clasps and (iv) the absence of the lip. Nevertheless, there is an overall resemblance between the designs.

77. If it were not for the Rodeo, I would have little hesitation in saying that the Kiddee Case produced the same overall impression on the informed user having regard to the broad scope of protection to which the CRD would otherwise be entitled. I am rather more doubtful as to whether it can be said the overall impression produced by the Kiddee Case is the same as the CRD and yet the overall impression produced by the Rodeo is different. Nevertheless, I have come to the conclusion that that is the correct assessment. Despite the differences between the Kiddee Case and the CRD, the overall impression the Kiddee Case creates shares the slimmer, sculpted, sophisticated, modern appearance, prominent ridge and horn-like handles and clasps looking like the nose and tail of an animal which are present in the CRD, but which are absent from the Rodeo. Moreover, neither the Kiddee Case nor the CRD have anything like the handle which is a prominent feature of the Rodeo.

78. *Conclusion.* PMS has infringed the CRD.

### The claim for infringement of design rights

#### *The legislation*

79. Section 213 of the Copyright, Patents and Designs Act 1988 provides, so far as is relevant, as follows:

- “(1) Design right is a property right which subsists in accordance with this Part in an original design.
- (2) In this Part ‘design’ means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article.
- (3) Design right does not subsist in—
- (a) a method or principle of construction,
  - (b) features of shape or configuration of an article which—
    - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or
    - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part, or
  - (c) surface decoration.
- (4) A design is not ‘original’ for the purposes of this part if it is commonplace in the design field at the time of its creation.
- ...”

80. Section 227 of the 1988 Act provides that design right is infringed by a person who, without the licence of the design right owner, imports into the United Kingdom for

commercial purposes and deals with an article which is, and which the importer knows or has reason to believe is, an “infringing article”. Section 228 provides that an article is an infringing article if it has been imported into the UK and the making of it in the UK would have been an infringement of design right. Section 226 provides that making an article is an infringement of design right if it involves “copying the design so as to produce articles exactly or substantially to that design”.

*Legal principles*

81. *Aspect.* Section 213(2) defines “design” for the purposes of design right as meaning the design of “any aspect” of the “shape or configuration” of an article. “Any aspect” extends to any aspect of the shape or configuration that is discernible or recognisable: see *A. Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] EWCA Civ 1514, [2004] RPC 16 at [31] and *Dyson Ltd v Qualtex (UK) Ltd* [2006] EWCA Civ 166, [2006] RPC 31 at [22].
82. *Configuration.* I considered the meaning of the word “configuration” in section 213(2) at some length in *CliniSupplies Ltd v Park* [2012] EWHC 3452 (Ch) at [36]-[53]. I concluded that the interpretation of “configuration” adopted by Pumfrey J in *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [1999] RPC 717 and *JCM Seating Solutions Ltd v James Leckey Designs Ltd* [2002] EWHC 3218 (Ch), namely that “configuration” bore a wider meaning than “shape”, and included the relative arrangement of parts or elements of an article, should be taken to represent settled law at first instance.
83. *Method or principle of construction.* I considered the interpretation and effect of this exclusion in *CliniSupplies v Park* at [54]-[58]. As can be seen from that discussion, it precludes a claim to what Parker J described in *Pugh v Riley Cycle Company Ltd* (1912) 29 R PC 196 at 220 as “general characteristics of shape or configuration” which cover a variety of different specific appearances.
84. *Original.* In order for design right to subsist, a design must be “original” in the copyright sense of originating with the author, and not being copied by the author from another: see *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* [1999] RPC 461 at 475, 482. Counsel for PMS submitted by reference to *Black v Murray* (1870) 9 Macph 341 that the test for originality in relation to a design which has been improved over an antecedent design for product is the following: the improved design is not original if (a) potential purchasers would not notice the improvement or (b) if they noticed, that would not procure purchases of the product on special account of the improvement. I do not accept that submission. In my judgment the test is whether sufficient skill, effort and aesthetic judgement has been expended on the new design to make it original compared to the old design: see *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565, [2005] 1 WLR 3281.
85. *Commonplace.* The correct approach to deciding whether a design was commonplace at the relevant date has been considered in a number of cases, including *Farmers Build v Carrier*, *Scholes Windows Ltd v Magnet Ltd* [2002] EWCA Civ 561, [2002] FSR 10 and *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886, [2005] RPC 6. For reasons that will appear, it is not necessary for me to consider this case law.

86. *Exactly or substantially to the design.* The correct approach to considering whether an allegedly infringing product is exactly or substantially to the design right owner's design was stated by Aldous J in *C & H Engineering v F. Klucznik & Sons Ltd* [1992] FSR 421 at 428 as follows:

“Under section 226 there will only be infringement if the design is copied so as to produce articles exactly or substantially to the design. Thus the test for infringement requires the alleged infringing article or articles be compared with the document or article embodying the design. Thereafter the court must decide whether copying took place and, if so, whether the alleged infringing article is made exactly to the design or substantially to that design. Whether or not the alleged infringing article is made substantially to the plaintiff's design must be an objective test to be decided through the eyes of the person to whom the design is directed.”

*The designs relied on*

87. As has been pointed out in a number of judgments, in claims for infringement of design rights it is very important that the claimant particularise the designs relied on with clarity and precision. In the present case, it took Magmatic a number of attempts to achieve this. Magmatic's particulars of the designs relied on only arrived at their final form on the second day of trial, necessitating a short adjournment. I reproduce the particulars in their final form in Annex 3 to this judgment (omitting paragraphs which set out the relevant dates). I shall refer to the designs by the identifying letter given in Annex 3.

*Assessment*

88. *Did Mr Law create design A?* PMS contends that Magmatic does not own any design right in design A (the metal parts of the clasps), because Magmatic's factory created the design rather than Mr Law. Mr Law accepted that the factory had suggested the use of circlips, but said that otherwise he had created the design. I accept his evidence on this point.
89. *Are designs C-F designs?* PMS accepts that designs A and B are “designs” within the meaning of section 213(2), but disputes that designs C-F are. This depends on whether the designs consist of the design of “any aspect” of the “configuration” of the Trunki. (“Shape” can be ignored for present purposes, since counsel for Magmatic did not contend that designs C-F consisted of aspects of shape.)
90. Counsel for PMS submitted first that a “design” could only consist of a single “aspect” of configuration, not multiple aspects. I do not accept that submission. Construing section 213(2) purposively, I see no reason to exclude designs that consist of multiple aspects of configuration.
91. Counsel for PMS submitted secondly that the aspects selected by Magmatic did not consist of aspects of “configuration” at all. The argument can be illustrated by reference to design C(1) (the external appearance of the Trunki Mark I). As counsel for Magmatic accepted, design C(1) consists of a verbalised description of certain



features of the external appearance of the Trunki which are also to be found in the Kiddee Case. Not only that, but as counsel for Magmatic also accepted, the features are not described at the level of specificity to be found in the Trunki, but at a more generalised, abstract level.

92. The consequence is that, as counsel for PMS pointed out:
- i) The clamshell case may be of any shape provided it has a saddle-shaped top and a substantially rectangular base.
  - ii) The general appearance can be of any animal. The horns can be of any size and shape. The nose and tail can be of any size and any shape which be described as “generally rounded ... with a cut out to one side.
  - iii) [omitted]
  - iv) The ridge can be of any size and shape provided it expands to oval shape in two stated places.
  - v) The eyelets can be of any size and shape.
  - vi) The strip may be of any size and shape provided it is approximately level with the top of the ridge.
  - vii) The hinge can be of any size and shape provided it has the interleaved portions.
  - viii) The wheels can be of any shape, provided they have the stated proportion of diameter to the length of the case.
93. Counsel for PMS argued that, even on the basis that “configuration” extended to the relative arrangement of elements of the article, it did not extend to abstracted generalisations of this kind. I see considerable force in this argument. Nevertheless, I do not feel able to accept it, because much the same could be said about a circuit diagram of the kind in issue in *Mackie*, which is essentially an abstract description using conventional symbols of the selection of components and their interconnections.
94. *Are designs C-F methods or principles of construction?* PMS contends that, even if designs C-F are “designs” at all, no design right subsists in them because they are methods or principles of construction. In my judgment, this is the real objection to design C(1). As can be seen from paragraph 92 above, design C(1) covers a multitude of different specific appearances. It is more like a patent claim than an identification of particular aspects of configuration of the Trunki. The same goes for designs C(2) and C(3). It follows that the same objection applies to designs E(1) and E(2) since these are combinations which include C(2) and C(3).
95. This leaves designs D and F. Even though these also consist of verbalised descriptions of features of the Trunki, namely the interior straps, pocket and strap, the features are much more specifically described. They are not nearly as general and abstract as the C designs. In substance, they amount to descriptions of those parts of the Trunki, particularly so in the case of design F, and that is how I shall treat them.

96. *Are designs C(2) and C(3) original?* PMS contends that, even if designs C(2) and C(3) are not excluded from protection as being methods or principles of construction, they are not original over designs C(1) and C(2) respectively. Given my conclusion that these designs are excluded from protection because they consist of methods or principles of construction, this issue does not arise. Accordingly, I shall deal with it very briefly. In my judgment the combinations of features in C(2) and C(3) are both original compared to the combinations in C(1) and C(2) respectively. While the differences are relatively small, they are discernible and they were the product of Mr Law's skill, effort and aesthetic judgement.
97. *Is design D commonplace?* PMS contends that, if design D is interpreted as consisting of the idea of using cross-straps and a pocket, it was commonplace. PMS does not advance that contention if design D is interpreted as consisting of the specific shape and configuration of the cross-straps and pocket of the Trunki. Since that is how I have interpreted design D, this issue does not arise.
98. *Have the designs been infringed?* PMS does not dispute that, to the extent that the Kiddee Case was an infringing article, it had the requisite knowledge or reason for belief for secondary infringement under section 228. Nor does PMS dispute that the design of Kiddee Case was to some extent derived from that of the Trunki (although, as discussed above, PMS contends that the derivation was from Mark II rather than Mark III). Accordingly, the key issue on infringement is whether the Kiddee Case is exactly or substantially to designs A, B, D and F.
99. In the case of designs A (the metal parts of the clasps), B (the clasps as a whole less the must-fit features) and F (the strap), counsel for PMS did not seriously argue to the contrary. In the case of design D (the internal cross-straps and pocket), counsel for PMS relied upon a number of detailed differences between the design of the Trunki and that of the Kiddee Case as showing that there was no relevant copying alternatively that the Kiddee Case was not substantially to design D. I do not accept that there was no relevant copying for the reasons given above. Furthermore, while I acknowledge that there are a number of detailed differences, I have concluded after some hesitation that the cross-straps and pocket are substantially to design D.
100. *Conclusion.* I conclude that PMS has infringed Magmatic's design right in designs A, B, D and F.

#### The claim for infringement of copyright

101. Like counsel in their submissions, I shall deal with this claim briefly. There is no dispute that Magmatic owns the copyright which subsists in the artistic work which consists of the artwork for its packaging. Nor is there any dispute that the artwork for PMS's packaging was inspired by the Trunki artwork. The only issue is whether the Kiddee Case artwork reproduces a substantial part of the Trunki artwork. Magmatic accepts that there are obvious differences between the two, but contends that various features have been reproduced, albeit inexactly. PMS accepts that there is a stylistic resemblance between the two, but contends that there is no substantial reproduction of the Trunki artwork. The test for substantial reproduction of an artistic work is conveniently summarised in *Copinger & Skone James on Copyright* (16<sup>th</sup> ed) at §§7-66 to 7-69. In my judgment, the correspondences between the two artworks, such as

they are, are insufficient to amount to a reproduction of a substantial part of the Trunki artwork.

**Summary of conclusions**

102. For the reasons given above, I conclude that:

- i) PMS has infringed the CRD;
- ii) PMS has infringed the design right in designs A, B, D and F, but not designs C and E;
- iii) PMS has not infringed the copyright in the Trunki artwork;
- iv) PMS has infringed the copyright in the Trunki safety notice.

Annex 1: the Rodeo concept board



# rodeo

the rideable  
childrens  
luggage  
system



1998 **BASF** / Institute of Materials Design Awards

Annex 2: the CRD, Trunki Mark I and Kiddee Case







Annex 3: Magmatic's Particulars of Designs

**“(A) The metal parts of the clasps**

Aspect of clasps relied upon

1. The design comprising (that is to say consisting of) the aspects of shape and configuration (as a whole) of the metal clasps on the front and rear of the Mark I Trunki case that is to say the C shaped bar and the U shaped base to which the C shaped bar is attached.

...

**(B) The clasp as a whole**

Aspect of clasp relied upon

3. The following aspects of the design of the locking clasps first incorporated in the Mark II Trunki:
  - (1) The design comprising (that is to say consisting of) the combination of the aspects of shape and configuration of the metal clasps identified in paragraph 1 above, and the aspect of shape and configuration consisting of generally rounded locking covers with a cut out to one side and a central rotating portion.
  - (2) The aspects of the locking covers relied upon are ... the following aspects of shape and configuration (the letters refer to the marked up photographs attached at Annex 1 to the [claimant's Part 18] response ...):-

An outer portion being shaped like an inverted bowl (A) which has (on the side located away from the hinge) two protruding ribs (B). The inverted bowl has a cut away portion (C) located close to the hinge. The inverted bowl has a circular central locking mechanism.

- (3) The claimant does not rely upon the aspects of shape and configuration of the slot in the central locking mechanism to take a key. The claimant does, however, rely upon (a) the existence of a slot in the end of the central locking mechanism and (b) the aspects of shape and configuration of the inside of the circular central locking mechanism facing the case.

...

**(C) The outside of the case**

Aspects of outside of case relied upon

5. The claimant relies upon three designs as follows:
  - (1) The aspects of the external appearance of the Mark I Trunki case identified in paragraph 6 below.
  - (2) Further, if the defendant contends that the design of the external appearance of the Mark III Trunki case (as set out in paragraph 8 below) is not original over the design referred to as the Mark IIA Trunki ..., the claimant will rely upon the aspects of the external appearance of the Mark IIA Trunki case identified in paragraph 7 below.
  - (3) The aspects of the external appearance of the Mark III Trunki case identified in paragraph 8 below.

External appearance design 1 – Mark I Trunki

6. The design comprising (that is to say consisting of) the aspect of the external appearance of the Mark I Trunki case consisting of the combination of the following aspects of shape and configuration of that case:
  - (i) a clamshell case, with a saddle shaped top, and a substantially rectangular base with 4 wheels in the corner;
  - (ii) the case having the general appearance of an animal, with two horns on the upper front portion of the case, and a nose and a tail each comprising a generally rounded plastic locking cover with a cut out to one side;
  - (iii) [not used]
  - (iv) a ridge where the two clamshell portions meet, running up the front, along the top and down the back of the case; the ridge expanding to form an oval shape in the portion of the ridge in the centre of the saddle of the case and around the clasp at the front and rear;
  - (v) two eyelets in the top front and top back of the case;
  - (vi) a strip located between the two clamshell portions, which protrudes from the case so that it is approximately level with the top of the ridge;
  - (vii) a hinge comprising multiple interleaved protrusions from each side of the clamshell case;
  - (viii) the wheels having a diameter which is of a particular proportion to the size of the rest of the case; the proportion being a ratio of 1:5 of wheel diameter to total length of case.

External appearance design 2 – Mark IIA Trunki

7. The design consisting of the aspect of the external appearance of the Mark IIA Trunki case (also referred to as the Mark IB Trunki case) consisting of the combination of the following aspects of the case:
- (1) the aspects of shape and configuration of that case listed in paragraphs 6(i), 6(ii) and 6(iv) to 6(viii) above, and
  - (2) the following aspects of the cloth handles on the top of the case, namely
    - (a) the particular length (about 15 cm);
    - (b) the handles being folded in half and sewn in their middle third to form a narrower centre portion;
    - (c) the handles being spaced around the expanded portion of the central ridge in the top of the case;
    - (d) the handles being mounted in slots cut between the inner and outer portion of the clamshell halves, and terminated with a (metal) C shaped grip folded over the ends;
- (The fact that the handles are made of cloth and the grip is made of metal is not relied upon as an aspect of shape or configuration).

External appearance design 3 – Mark III Trunki

8. The design consisting of the aspect of the external appearance of the Mark III Trunki case consisting of the combination of the following aspects of the case:
- (1) the aspects of shape and configuration of that case listed in paragraphs 6(i), 6(ii) and 6(iv) to 6(viii) above;
  - (2) the aspects of shape and configuration of the cloth handles identified in paragraph 7(2) above; and
  - (3) the eyelets being flush with the external perimeter of the case, and there being U shaped channels cut into either side of the central ridge about the eyelets.

...

**(D) The inside of the case – straps and pouch**

Aspect of inside of case relied upon

12. The design consisting of the aspect of the internal part of one of the shells of the Mark II Trunki case (also included in the Mark III Trunki cases) consisting of the combination of the following aspects:
- (i) the following aspects of the shape and configuration of X shaped retaining straps and their associated fixings and mountings:



- (1) they are X shaped retaining straps affixed to the 4 internal corners of the case;
  - (2) they are sewn at their inner ends around the loop of a clasp (the clasp forming the centre of the X shaped straps);
  - (3) they are fixed by (inverted) L shaped grips clamping the straps at the top of the case, which are held in place by a screw fastened to the inside top of the case (excluding any aspect of the L shaped grip extending beyond the outer part of the inner wall of the shell);
  - (4) they are fixed by generally L shaped grips clamping the straps at the bottom of the case which cover the top and run down the side of a wedge shaped portion of the case which fills the lower corners of the case and which are held by a screw into that wedge shaped portion.
- (ii) the shape and configuration and position of the pocket made of cloth; the pocket being approximately 38 cm in length and 8cm in depth and attached to where the X-shaped cross-straps are secured to the case; and further including a folded hem, containing a flat elastic cord; elastic cord being flat and running the length of the pocket.

...

**(E) Combinations of designs**

Aspects of the Trunki cases relied upon

14. The following designs:

- (1) the design consisting of the combination of the aspects of the clasp referred to under section (B)/paragraph 3 above (the locking clasp) and the aspects of the external appearance of the Mark IIB case as defined in paragraph 7 above;
- (2) the design consisting of the combination of the aspects of the clasp referred to under section (B)/paragraph 3 above (the locking clasp) and the aspects of the external appearance of the Mark III case as defined in paragraph 8 above.

...

**(F) The tow strap**

Aspect of the tow strap relied upon

17. The design of the aspect of the tow strap introduced in the Mark II Trunki case (and also used on the Mark III Trunki case) consisting of the combination of the following aspects of shape and configuration of the strap:-

- (i) A strap with a hook at one end and a key at the other end.
- (ii) The hook at one end being attached to the strap by a loop formed in the strap, which is attached to the body of the strap by a buckle; the centre portion of the

buckle being attached to the tail of the loop by a loop sewn in the end of the tail.

- (iii) The key at the other end being attached to the strap by a loop about 11 cm long formed by the strap being folded back on itself, and attached to the strap so as to leave a tail.
- (iv) The tail being formed with a further loop to attach a further hook to the strap.
- (v) The overall shape and configuration of the two hooks identified in (i) and (iv) above.
- (vi) The overall shape and configuration of the body of the key (but not including the configuration of the end of the key).
- (vii) The overall shape and configuration of the buckle.”