



[2011] EWPC 31

Case No: 0CL 70144

IN THE PATENTS COUNTY COURT

The Rolls Building,
7 Rolls Buildings
London EC4A 1NL

Date: 23/11/2011

Before :

HIS HONOUR JUDGE BIRSS QC

Between :

VICTOR IFEJIKA

Claimant

- and -

(1) CHARLES IFEJIKA
(2) LENS CARE LIMITED

Defendant

The **Claimant** represented himself
Isabel Jamal (instructed by **Comptons**) for the **Defendants**

Hearing dates: 19th, 20th October 2011

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

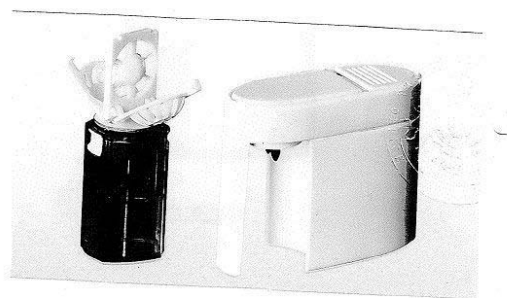
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HIS HONOUR JUDGE BIRSS QC

His Honour Judge Birss QC :

1. This case is a fraternal dispute ranging over many years. The claimant, Victor Ifejika, contends that his brother, the first defendant Charles Ifejika, has taken his intellectual property. Much of the case turns on events which took place in 1988, more than 20 years ago and memories have inevitably faded. The dispute is clearly a bitter one. Strikingly, when Victor Ifejika rose to cross-examine his brother during the trial, he commented that this was the first time he had spoken directly to his brother for a very long time.
2. The claimant represented himself at the trial. The defendants were represented by Ms Isabel Jamal instructed by Comptons.
3. There was an element of acrimony during the trial process itself and each brother had a tendency to interrupt the other when they were speaking. I wish to pay tribute to Ms Jamal's conduct in this difficult case. She conducted her clients' case in an exemplary fashion in the difficult circumstances of this trial and treated Victor Ifejika with courtesy at all times.

The case

4. The claim is brought as an action for infringement of UK registered design right and UK unregistered design right. Victor Ifejika claims to be the proprietor of Registered Design No. 2 003 357 in respect of a design for a contact lens cleaning device. The registration consists of photographs of a product called the CLC 60 device which was a prototype produced by a company called Murdoch. Murdoch produced the prototype pursuant to a commission (says Victor Ifejika) from Victor Ifejika himself.
5. Large versions of the photographs are appended as Annex 1. A small version of one of them is below:



PERSPECTIVE VIEW WITH PARTS SHOWN
IN SEPARATED CONDITION

6. The picture above shows the device separated out. The housing is on the right. On the left is a lens case in the form of a barrel. The holder for the lenses has been taken out of the barrel and inverted with its basket like parts pointing upwards and opened out. In use lenses are placed into the baskets, the holder is placed inside the barrel and the barrel then inserted into the housing. It is a snug fit between the main body of the housing and the vertical member or nose on the left of the housing. A switch on the housing actuates a motor which drives arms just visible in the housing. The arms

engage the holder to turn it. When the device is assembled, the lines of the holder match with the lines of the barrel case. The outer surface of the barrel case is not circular in cross-section. Rather it is shaped to match the contours of the housing and this overall form was referred to in the proceedings as a “contoured” design.

7. Victor Ifejika claims that two products have been put on the market by the second defendant company which infringe the registered design. The products are called the Lenscare product and the AMO product. Victor Ifejika contends that the second defendant is controlled by Charles Ifejika and that Charles Ifejika is personally liable for its infringements.
8. Victor Ifejika also claims to be the owner of UK unregistered design right which subsists in a prototype lens cleaning device made by an organisation called Hot House (“the Hot House prototype”). Both the Lenscare device and the AMO device are alleged to have been made by copying, directly or indirectly, parts of the Hot House prototype and to thereby infringe the unregistered design right.
9. As regards the registered design, the defendants accept that the Lenscare device would (subject to a defence below) infringe. It is worth noting that in terms of damages, the parties are agreed that the most the damages will be for Lenscare is £35. As regards the AMO device, the defendants deny infringement. They contend that the registered design and the AMO device create a different overall impression on the informed user. If AMO infringes then there will need to be an inquiry. The estimates of the damages which might be payable on that inquiry range from £25,000 (defendants) to £½ Million (claimant).
10. On unregistered design right the defendants contend that most of the features of the Hot House prototype are not original. To the extent that any features are original such that unregistered design right subsists, they submit that only those specific features can be relied on. There is then a point on the term of any unregistered design right because of a contact lens case referred to as the “standalone” case. It is not in dispute that Victor Ifejika sold some examples of the standalone lens case and it is plain that the case includes some features of the design of the Hot House prototype. The defendants contend this limits the term of the unregistered design right. In any case the defendants deny that either the Lenscare device or the AMO device infringes the unregistered design right in any event because neither is an article produced exactly or substantially to the design.
11. The defendants’ case is that the registered design is invalid because of the application of the rules on proprietorship of registered designs. This is the major factual dispute between the parties. The registered design was applied for by a company called CCL (Vision) Ltd. When it was granted, CCL (Vision) Ltd were named as proprietor. CCL (Vision) Ltd was a company owned by the two brothers (one share each). The defendants’ case is that CCL (Vision) Ltd were not and never could be the proprietor of the design either in law or equity and thus the defendants contend the registration is invalid. The defendants’ case is that Charles Ifejika should have been the proprietor because he commissioned Murdoch to make the Murdoch prototype and, since CCL (Vision) Ltd do not derive title from him, the registration falls. The defendants say alternatively that Charles and Victor were joint proprietors, with the same consequence for the registered design. The defendants contend that it was never intended that CCL (Vision) Ltd should be the proprietor of the rights. The

defendants' also contend that Victor Ifejika's case (at least as it was at one time) means the registration is invalid, because the defendants say that Victor Ifejika's case is that he (Victor) commissioned Murdoch and was therefore the true proprietor and did not pass title on to CCL (Vision) Ltd either.

12. The action began in the High Court. The issue of proprietorship was dealt with by HHJ Fysh QC sitting as a judge of the High Court on 23rd July 2009 on an application for summary judgment by the defendants. He decided that the defendants were right. The matter went to the Court of Appeal and on 25th May 2010 the appeal was allowed ([2010] EWCA 563). The appeal was allowed on two bases. First the Court of Appeal held that it was seriously arguable that there was an equitable assignment of the design rights from Victor Ifejika to CCL (Vision) Ltd and if that were established, assuming he was the person originally entitled to be the proprietor, then the company were entitled to apply to register the design under s1(2) of the Registered Designs Act 1949 (in its relevant form at the time). Second the Court of Appeal held that even if there was no equitable assignment, if Victor Ifejika was the person originally entitled to be the proprietor then the fact that the design was registered to the wrong company should not matter now since today Victor Ifejika is registered as proprietor as a result of an assignment from CCL (Vision) Ltd. It would be a triumph of form over substance to order cancellation of the registration in these circumstances rather than simply to order a variation of the register to reflect the correct basis for the registration.
13. The case was remitted to the High Court and was then transferred to the Patents County Court. Both parties amended their statements of case to address the consequences of the Court of Appeal's judgment.
14. In summary the case on invalidity turns on whether Victor Ifejika was the original proprietor of the design which was registered. Victor Ifejika contends he was original proprietor and if he is right then the registration is valid. Charles Ifejika contends that the design was his or alternatively it was jointly held by Charles and Victor Ifejika together. In their Amended Defence and Counterclaim (see paragraph 60), the defendants contend that on this basis the registered design is invalid and seek cancellation of its entry on the register of designs.
15. At the trial Ms Jamal contended that an alternative remedy might be rectification of the register to record Charles Ifejika alone or both brothers together as proprietor(s). She argued that this would be within the court's powers under s20 of the Registered Designs Act 1949. Victor Ifejika did not address this point in his submissions. If the registered design was in fact jointly owned and is to remain on the register on that basis then questions would arise about whether the defendants have a proprietorship defence to the infringement claim which again Victor Ifejika did not address. As regards the proprietorship defence the question would be whether, if Charles and Victor Ifejika were in fact joint proprietors, that permitted one of them to exploit the design without the consent of the other. Ms Jamal submitted that the appropriate analogy was with patents, in which that is the case, rather than with copyright, in which it is not. She was not able to cite an authority on the point however. If the submission is correct then Charles Ifejika would have a defence. The defendants' position was that if I decided the brothers were joint proprietors of the registered design but if I also decided the proprietorship defence point against Charles Ifejika

then Charles Ifejika did not want the register to be rectified to reflect joint ownership, he wanted the registration cancelled.

16. It seems to me that I should not entertain the alternative remedy of rectification leaving the registration in place even if I accept the defendants' defence on the facts. This case has been fought and brought to trial on the basis that the issue of proprietorship decides whether the registration is valid or invalid. The most recent version of the defendants' Defence and Counterclaim simply seeks a declaration that the registration is invalid and deletion of the design from the register. That statement of case was dated 14th April 2011 and was in response to Victor Ifejika's amended Particulars of Claim, consequential on the Court of Appeal's judgment. The proper time to have raised an alternative rectification case was in April 2011 at the very latest.

Further defences in relation to the registered design

17. Apart from the issue of original proprietorship, the defendants have other defences to the registered design claim. They accept that the Lenscare device falls within the scope of the registered design but contend that the differences which undoubtedly exist between the AMO device and the registered design mean that it does not infringe. Charles Ifejika also contends that he has a defence under section 24B of the relevant version of the RDA. He says that until 7th February 2003 he was not aware and had no reasonable grounds for supposing that the design was registered. This defence is put forward only in relation to the Lenscare device because Charles Ifejika found out about the registered design in February 2003 as part of the due diligence process before entering into an agreement to sell the AMO device. However as to the period after that, Charles Ifejika contends that he has the benefit of an estoppel arising from the fact that the registered design was in the name of CCL (Vision) Ltd but that company did not then exist because it had been struck off the register in 1995. Once he found out about the registered design, Charles Ifejika wrote in February 2003 to the agents identified as the address for service on the design, enquiring about the status of the registered design. He did not receive a reply. CCL (Vision) Ltd was restored to the register by the order of Registrar Derrett on 17th November 2003. Charles Ifejika says the only response to his February 2003 letter was in patent entitlement proceedings in 2005.

The previous proceedings

18. This action is not the first time Victor and Charles Ifejika have litigated the question of entitlement to intellectual property relating to these contact lens cleaning devices. In 1995 Charles Ifejika was granted a patent (EP 0394254) based on an application filed on 18th July 1988 and claiming priority from a filing on 17th July 1987. This patent relates to contact lens cleaning devices. In April 2004 Victor Ifejika commenced entitlement proceedings in the Patent Office on the basis that the contribution he made in developing the invention set out in the patent deserves to be both recognised and rewarded. The matter was heard on 30th January 2006 before the Comptroller's Divisional Director, Peter Back. In Decision BL O/260/06 dated 15th September 2006 Mr Back decided the case in Charles Ifejika's favour.
19. However although the Decision was in Charles Ifejika's favour that does not mean that Mr Back rejected Victor Ifejika's contention that he was the originator of certain

aspects of the contact lens cleaning devices. One of the key features Victor Ifejika claimed to have invented was called “the within feature” in the Decision. Victor Ifejika’s then counsel Mr Richard Davis described this as possibly the most important feature of the inventive concept in the patent. It related to the idea of allowing the holder of the contact lens to agitate rotationally “within” a tank and to the idea of a direct coupling between a support arm and the lens holder in order to agitate it. Victor Ifejika claimed to have invented this and Charles Ifejika did not agree. However Mr Back decided that the feature was added matter. It was not present in the application as filed and so could not form part of the inventive concept. He did not have to resolve the factual dispute (see Decision paragraphs 29 to 34 and 43 to 44).

20. I will return to the Patent Office proceedings in context below because Victor Ifejika contends that Charles Ifejika made an admission in those proceedings which is relevant to the issue I have to decide now.

The witnesses

21. At the trial I heard from three witnesses, Victor Ifejika, Charles Ifejika and Ian Dryburgh.
22. As I have mentioned already both Victor and Charles Ifejika had a tendency to interrupt the other when they were speaking. While in itself that is not a criticism of either person as a witness, it did create confusion while the evidence was being given.
23. Given that the issues revolve around what happened many years ago I would be surprised if any witness retained a clear memory for what happened. In my judgment neither Charles Ifejika nor Victor Ifejika retains a completely reliable memory for the relevant events in this case. Today when they are giving evidence each of them seeks to reconstruct what happened based on the documents available coupled with a firm conviction that they are right and their brother is wrong. Victor Ifejika did refer to Charles Ifejika as a “greedy callous and deviously immoral individual” (skeleton paragraph 11.5) and suggested that Charles Ifejika was lying in his evidence. I reject that. I am sure that neither witness was seeking to mislead the court but that does not mean I can place much weight on what was said by either witness over and above what I can glean from the documents.
24. Ian Dryburgh was a director of Murdoch Industrial Design Limited at the material times. He was called by Charles Ifejika. Charles Ifejika had applied to adjourn the trial because of Ian Dryburgh’s non-availability. I refused the adjournment (*Ifejika v Ifejika* [2011] EWPC 028) but in the result Mr Dryburgh was able to attend the trial in any event. He gave his oral evidence entirely fairly. He was able to recognise his colleagues’ drawing style on various drawings and to interpret letters sent by Murdoch at the time however Mr Dryburgh explained in the witness box that he had little recollection of the events over and above what one could take from the documents available (see also paragraph 6 of my judgment dealing with the adjournment).
25. Charles Ifejika’s purpose in calling Ian Dryburgh was to seek to rely on a statement by Mr Dryburgh in a letter sent to Charles in 2007 which included the following:

“I cannot believe that Victor is still trying to lay claim to your invention just because he provided financial support.

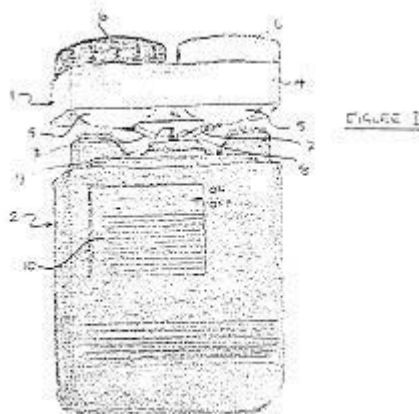
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At no point did Victor originate IP (intellectual property) so it would be totally wrong for him to claim authorship for such like.”

26. I do not intend to place reliance on these comments from Mr Dryburgh. For a start 2007 is still nearly 18 years after the relevant events. More importantly it was clear to me that Mr Dryburgh was not in a position to know whether in fact Victor Ifejika originated anything relevant or not. One of the major issues to be addressed is which brother produced a design sometimes called the Coopers & Lybrand prototype which was given to Murdoch at the outset. Mr Dryburgh’s evidence does not touch on this and yet it is a key issue. An important set of sketches in the case include a sketch which Victor Ifejika contends he drew. It is on a page with other sketches. Ian Dryburgh clearly thought all the sketches on the page (including the one claimed by Victor Ifejika) were probably drawn his colleagues but when Victor Ifejika pressed him in cross-examination Mr Dryburgh was not prepared to go as far as to deny Victor Ifejika’s evidence on the point.

The facts

27. It seems to me that this case will be best resolved by setting out what happened in chronological order and resolving conflicts of fact and evidence as they arise in their proper historical context.
28. It is not, I think, in dispute that Charles Ifejika started thinking about contact lens cleaning devices before his brother. Charles Ifejika had been thinking about them since 1985. In March 1987 Victor Ifejika was working on an invention relating to using a Psion hand held computer to download stock market share prices.
29. On 17th July 1987 Charles Ifejika filed priority application GB8716886. Figure 1 of that application is shown below:



30. Essentially the device consists of an electrical vibrator (item 2 in figure 1) on top of which is mounted a casing (1) carrying two tanks, one for each contact lens. The

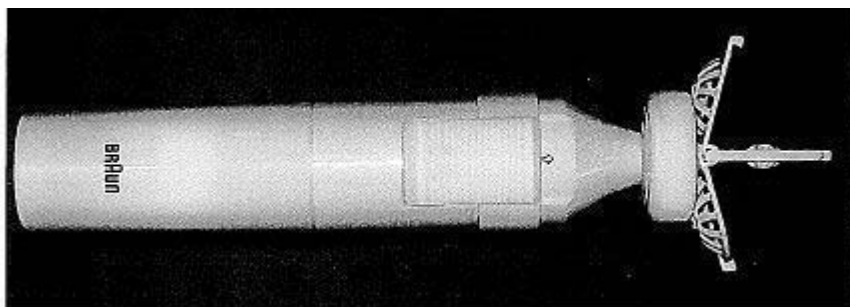
tanks each have a lid (6). In appearance the device could be described as a bit like a hand held electric shaver with a contact lens case mounted on top instead of rotary shaver blades.

31. Victor Ifejika does not dispute that this invention was his brother's. Victor Ifejika places emphasis on the fact that it operates by vibration and does not involve a barrel lens case. Victor Ifejika describes devices like the one shown in Fig 1 of the priority document as flat designs. Who came up with the idea of a barrel lens case is disputed.
32. In any event it is clear that from sometime in 1987 and on into 1988 they were both working on contact lens cleaning devices at least to some extent. In the Patent Office proceedings Victor Ifejika described this period as one in which the brothers were working as a team. Charles Ifejika relies on that statement by his brother and it seems to me to ring true.

The "Coopers & Lybrand" prototype

33. In about March 1988 a prototype lens cleaner which has been referred to as the "Coopers & Lybrand" prototype was produced. The reason for that name is that at some point around this time there was a decision to seek to use a Government sponsored scheme for helping inventors develop the designs of their products. It was called the DTI Design Initiative (DTI being the Department of Trade and Industry). The DTI would fund suitable product design projects. As I understand it the accountants Coopers & Lybrand acted as gate keepers for this project and so the Ifejikas needed to show a prototype to Coopers & Lybrand in order to attract DTI funding. Coopers & Lybrand were shown the Coopers & Lybrand prototype.
34. The project was approved. Murdoch would be the designers. It is common ground that whatever it was, the Coopers & Lybrand prototype was taken to Murdoch and shown to them at the start of the project. The nature of the Coopers & Lybrand prototype is important since it pre-dates the Murdoch project.
35. There is a letter dated 21 March 1988 from Coopers & Lybrand to Victor Ifejika referring to the DTI Design Initiative which dates the meeting as 24th March 1988.
36. There are two candidates for the Coopers & Lybrand prototype. Both are shown below. I have called them the "Braun" device and the "Second Vision" device. They are:

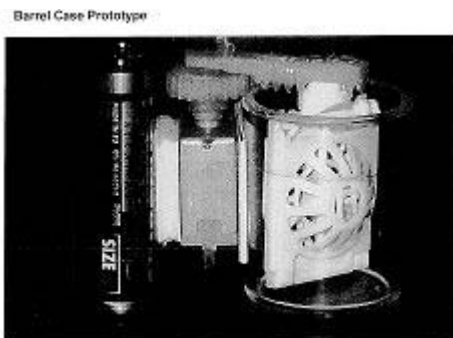
The Braun device:

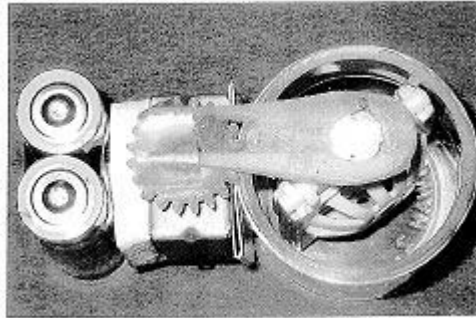


The Second Vision device:

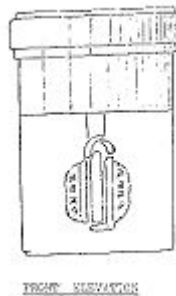


37. The Braun device is essentially a Braun electric toothbrush on the end of which has been fitted the lid of a contact lens barrel case and a lens holder. When the baskets are closed the barrel case is fitted over them and onto the lid. This image of the Braun device comes from Victor Ifejika's exhibits used in the Patent Office proceedings. In evidence there are also images of a product related to the Braun device based on a cylindrical rotary shaver. It looks broadly similar to the Braun device and it is not necessary to distinguish between the two.
38. Although the reproduction of the image of the Second Vision device is poor, it is clear that the product is much closer to the Registered Design than the Braun device. However an important difference is that the Second Vision device is not contoured. In other words the barrel case itself is circular and, although not visible in the image above, in fact the case is proud of the housing. The image above is taken from a copy of a leaflet produced in evidence by Charles Ifejika. He says he marketed the design under that brand name towards the end of 1988 and start of 1989 but there are no details given at all.
39. A further relevant device is the "Barrel Case" prototype. Victor Ifejika contends that he constructed this device to show how his barrel case idea would work. The images below come from Victor Ifejika's exhibits used in the Patent Office proceedings. The Barrel Case prototype consists essentially of a pair of batteries fixed beside a motor which is then fixed to a contact lens barrel case. The motor can impart rotation on a contact lens holder in the barrel case through the plastic gear train.





40. Charles Ifejika's version of events is that the Coopers & Lybrand prototype was the Braun device or something like it. He says that was what was shown to Coopers & Lybrand and led to the Murdoch project. The Murdoch project started in August 1988 and Charles Ifejika says that the Second Vision device was created by him after the project began. Charles Ifejika calls the Second Vision device the "Proof of Principle" prototype. As regards the Barrel Case prototype, he agrees that it was made by Victor Ifejika but contends it is irrelevant. He says it is not a working prototype and points to the lack of wires connecting the battery to the motor.
41. Charles Ifejika contends that he thought of using barrel cases and relies on another registered design number 1 052 304 which he filed for on 14th July 1988. He contends that this shows that the barrel case was his idea. The front elevation from that registered design is shown below. It can be seen that it is indeed a barrel case albeit not one with a separate housing to one side.



42. Charles Ifejika also refers to a US patent No 4,776,360 which he says inspired him in terms of a cleaner design based on a gear train and barrel case. His witness statement states that this was sent to him by the Patent Office after July 1987 during the process of the patent being granted. In the context of his witness statement it appears that Charles is suggesting this was given to him before he approached Cooper & Lybrand in March 1988. This cannot be right because the US patent was published in October 1988. Charles Ifejika has clearly become confused in relation to this US patent and I will not rely on that aspect of his evidence.
43. Victor Ifejika's version of events is very different from Charles' version. He says that the Braun Device (and the cylindrical rotary shaver version) were developed by him in 1987. He says that he came up with the idea of agitating the lens holder inside a barrel case by turning it alternately clockwise and anticlockwise and that these devices were developed to test his theory. Victor Ifejika contends that the Barrel Case prototype was developed by him after that because although the Braun device worked he did not like the design. He says he thought the Barrel Case prototype was the most

compact and optimum design for an electrical cleaner to produce rotational agitation of a contact lens holder.

44. Victor Ifejika says that in 1987 Charles Ifejika was working with a venture capitalist called Paul Baker on a lens cleaning product based on the electric shaver idea as shown in Charles Ifejika's priority document. These have been referred to as a flat design because (I think) the lenses are held in flat, horizontal baths in order to be cleaned. Victor Ifejika says that Paul Baker breached his agreement with Charles Ifejika and started selling a contact lens cleaner device called "Sparkling Eyes" to the Grattan catalogue without Charles Ifejika's knowledge. Charles Ifejika denies that anyone knows who was responsible for the Sparkling Eyes device and I do not propose to embark on resolving that issue.
45. Victor Ifejika says that at this time he and his brother were on good terms and Charles knew about his (Victor's) work on the barrel case designs. Victor Ifejika says that Charles Ifejika approached Victor for help with funding his patent application because Paul Baker had not provided the funding he had promised. A PCT application would be needed in July 1988 to claim priority from the July 1987 priority filing and it is common ground that Victor Ifejika provided the funding for the PCT application. Charles Ifejika does not accept Victor Ifejika's version of events vis a vis Paul Baker but I cannot resolve whose account is right and it is not necessary to do so.
46. Victor Ifejika says that he and Charles collaborated to produce the Coopers and Lybrand prototype, which was to be a device embodying the configuration of the Barrel Case prototype. Victor Ifejika says he told his brother to go out and buy some boxes used for artificial sweeteners (such as the brands Canderel and Hermesetas) and gave him some money to do so. Charles returned with a four boxes and Victor selected one to be used as the housing for the device. In cross-examination Victor said that Charles physically constructed the product and he accepted that appearance of it was the result of the two men collaborating. The device shown in the Second Vision picture above was the result.
47. Some years ago in this long running dispute Victor Ifejika made a model of what he said the Coopers & Lybrand prototype was like. Images of the model and a sweetener box to illustrate Victor Ifejika's point are shown below. Both the model and the sweetener box are recent items produced for this case:

Side view of model with a complete sweetener box in the same orientation:



Bottom view of model:



48. Charles Ifejika does not dispute that the model is a reasonable representation of the Second Vision device although of course he emphasises that the model is just that and is not an original exhibit and emphasises that his evidence is that the Second Vision device was not the Coopers & Lybrand device.
49. One difference between the model above and the Second Vision device is that the model is turned on by rotating the barrel, which flicks a lever inside the housing (just visible in the bottom view), whereas in the Second Vision device itself the device was turned on by a switch near the base of the barrel which actuated a similar lever (the switch is just visible in the Second Vision image).
50. I have mentioned the PCT application of July 1988 above. Its content has a bearing on the issues I have to decide. The application was filed by Charles Ifejika but paid for by Victor. It was published as WO 89/00429. The figures have been redrawn but do not differ materially from the figures in the priority document. At the end of the text of the description there is the following paragraph:

“In certain other embodiments the connection between the motor and the arm of the drive mechanism may comprise a gear train designed to reciprocate the arm. This gear train will allow the contact lens holder to undergo reciprocating rotational motion within the tank means while undergoing vibration as aforesaid.”

51. Victor Ifejika contends this text refers to his Barrel Case prototype invention and derives from him and not Charles. He says it was “bunged into the back” of the patent application in order to refer to the Coopers & Lybrand prototype. He says he paid for the patent agent (Mr Warren Silverman of Haseltine Lake) to make the amendments which incorporated this matter. As I have said, it is not in dispute that Victor Ifejika paid for the patenting at this time. Victor Ifejika also refers to certain letters from Mr Silverman and in particular a letter of 6th April 1992 but none of them, including the 1992 letter, seem to me to advance the issue any further.
52. Victor Ifejika also relies on an exchange which took place in the Patent Office proceedings concerning entitlement to the subject matter of the patent. Charles Ifejika was being cross-examined by Victor’s counsel. He was asked about Victor’s input and in answer to a question “You are happy to say that effectively he [Victor] was working on his barrel design that rotated and that was his input?” Charles replied “Yes but we quickly knew that input was totally worthless in terms of patentability, inventorship or anything...”. Charles was also asked about the Braun device and the Barrel Case prototype and stated clearly that Victor never showed those prototypes to him. He says Victor had talked about it but not shown it to him. He had not seen the Braun device until that day (the day of the Patent Office proceedings). Asked by counsel whether he accepted that Victor had made the Braun prototype he said he could not remember. I should also record that in the extracts from the transcript I have been shown Charles gives evidence which is the same as his case before me – that the Second Vision prototype (albeit it was not called that in the Patent Office) was produced by him once the Murdoch project had started.
53. Bearing all this in mind, my findings on the Coopers & Lybrand prototype are as follows.
54. I reject Charles Ifejika’s case that the Coopers & Lybrand prototype was the Braun device for the following reasons. First, the Patent Office testimony. In the Amended Defence and Counterclaim produced once the case had been transferred to the Patents County Court and signed by Charles Ifejika with a statement of truth dated 14th April 2011, Charles makes a clear assertion that he created what he is there calling the Coopers and Lybrand prototype, shown in Annex 4 to the pleading, which consists of pictures of the Braun device and the other related rotary device, and that he presented this prototype to Murdoch at a meeting in August 1988 (at which he says Victor was present). The statement of case can stand as evidence in the Patents County Court and Charles Ifejika confirmed this statement of case as being true when he gave evidence before me along with his other statements. However it is not consistent with his evidence before the Patent Office. In cross-examination Victor Ifejika put to his brother that his evidence before the Patent Office was not consistent with his case before the Patents County Court. Charles Ifejika’s response was that the Patent Office proceedings had jogged his memory. As I have said before I do not doubt that Charles Ifejika believes that the facts were as he put forward before me but I do not accept his evidence on this issue today. If Charles created the Braun device (which is what he says in his statement of case), he could not have said what he said in the Patent Office proceedings. Charles Ifejika has convinced himself of the position most probably because he has started from the outcome he believes to be the right one and worked backwards to work out what “must have” happened.

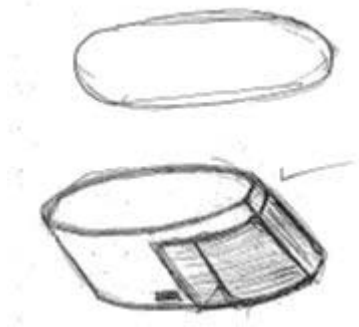
55. Second I rely upon the text in the patent application. The text at the end of the patent application seems to me to provide some support for Victor Ifejika. I believe it refers to the configuration shown in the Second Vision prototype and the Barrel Case prototype. It does not show who thought of it but it does show that this idea – at least as an idea – existed before the meetings with Murdoch began in August 1988. The text in the patent does not go as far as to prove that the Second Vision prototype existed before the meeting with Murdoch but it does support Victor Ifejika’s case.
56. Third, while Charles Ifejika’s own registered design filed in July 1988 supports the view that the idea of using a barrel case may derive at least to some degree from Charles, the design of the device there is quite different. There is no housing and it does not support Charles’ case that he devised the Second Vision prototype independently of his brother after the Murdoch project began.
57. Fourth, there is no evidence in the contemporaneous documents to which I have had my attention drawn which refers to any prototype being made during the Murdoch project by one of the Ifejikas. What is clear from Murdoch’s documents (see below) is that there were prototypes in existence at the outset in August 1988, although the document does not identify what they were like. Moreover there are no sketches in the Murdoch documents which depict the Braun device. If the Braun device was one of the prototypes which Murdoch had access to at the start one might have expected to see it appearing in the sketches. The sketches which do exist show either a flat device like Charles Ifejika’s PCT application or a barrel case type device configured broadly like the Second Vision device.
58. Fifth, I find Victor Ifejika’s explanation of the origin of the Braun device plausible. It has a ring of truth. Charles Ifejika does not advance a rival explanation which has any detail associated with it.
59. On the other hand, looked at in isolation, Charles Ifejika’s testimony that the Second Vision device was created during the Murdoch project is not inherently implausible. Moreover if Victor and Charles Ifejika had really got as far as the Second Vision device before they went to Murdoch, I wonder why they really needed to use Murdoch’s services at all. However since the only candidates for the Coopers & Lybrand prototype are the Braun device and the Second Vision device, it must follow from that fact that I am confident that it was not the Braun device, that it must have been the Second Vision device. Accordingly I will accept Victor Ifejika’s account of how it came to be created and reject the account of Charles Ifejika on this issue.
60. Before leaving the Coopers & Lybrand prototype I should recall that, as Ms Jamal points out, of course Victor Ifejika’s case is not that Charles was not involved in that prototype. The brothers were working together.

The Murdoch design project

61. The next stage in the chronology is the Murdoch project. The work by Murdoch ran from August 1988 until well into 1989. What has been called Phase I of the project lasted from the start until Murdoch produced a report which bears a date of November 1988. In fact there was some confusion about when the report was actually produced. Indeed at one stage Victor Ifejika was anxious to contend that various sketches in the report must have been created after November 1988 and perhaps in January 1989,

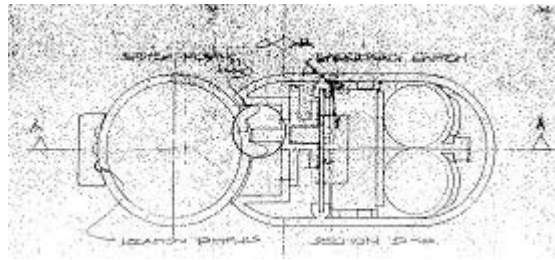
despite their being included in the report. He may or may not be right about that but the reason he was making this contention was revealing. Victor Ifejika was concerned that the sketches might antedate the Registered Design the subject of this case by more than one year and that this might have an impact on the validity of his Registered Design. In fact it would not have that impact in any event and Ms Jamal did not suggest otherwise. However this approach by Victor Ifejika was an illustration of the same problem which arises with Charles' evidence. The confusion arose because on this issue Victor Ifejika has started from the outcome he believes to be the right one (the design is valid) and worked backwards to work out what "must have" happened.

62. The brothers do not agree how the project started. It is clear there was a secrecy agreement originally drafted as between Charles Ifejika and Murdoch and dated 16th August 1988. It enabled Murdoch to use the then unpublished PCT application. Charles Ifejika's case is that on the same day Murdoch entered into a 15 day consultancy agreement with him to undertake 15 working days of work to develop various designs for the product. He says Victor was there but Victor denies this. Victor Ifejika's case is that the design Charles wanted Murdoch to work on was Charles' flat design but he Victor wanted Murdoch to work on the barrel case designs. Victor says he met Murdoch on 18th August without Charles and he was the one who commissioned Murdoch.
63. What is clear is that by 23rd August 1988 Murdoch produced an initial design brief. It is addressed to Victor Ifejika but starts "Dear Charles" and then ends after 6 pages with a signature of Giles Smith of Murdoch and a cc to Charles Ifejika. Victor Ifejika submits the cc shows that "Dear Charles" was an error and that the brief was addressed to him and that that shows he commissioned Murdoch. Charles does not agree with this. Victor Ifejika also points to paragraph 1 (vi) of the brief which refers to Murdoch wanting information about the performance of "the prototypes" and therefore proves that prototypes existed at the start.
64. It is also clear that on 21st September 1988 Peter Tennent of the DTI wrote to Giles Smith of Murdoch to ask him to prepare terms of reference for a project to be undertaken for Victor Ifejika. In the end "Project Terms of Reference" were signed by Ian Dryburgh and Victor Ifejika on 29th September. The "user company" as defined in the terms of reference was "Distributive Software Associates", which was a trading name used by Victor Ifejika for his software business at the time. The user company was required to contribute a third of the costs (£1650 out of £4950), the balance to be covered by the DTI's Design Initiative. Elsewhere it has been said Victor Ifejika was to pay for 50% of Murdoch's costs of development. Whether it was 50% or 33% does not matter.
65. In evidence are 2 A3 size sheets of paper bearing design sketches. Victor Ifejika has the originals. He says they were produced at a meeting he had at Murdoch on the same day he signed the terms of reference. An extract from one of them is below:

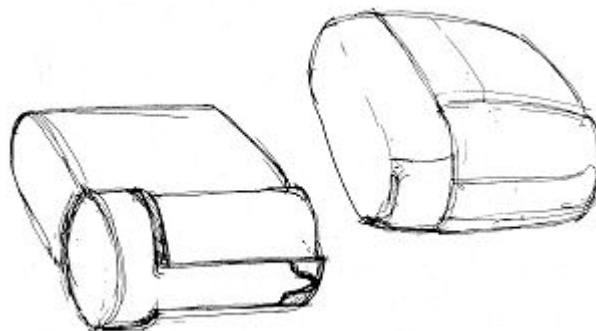


66. Victor Ifejika contends that he drew the sketch above marked with a tick himself while he was in a meeting with one of Murdoch's designers (I think Richard Billson). That sketch appears in a page with a range of other rough sketches which Victor Ifejika contends were drawn by the Murdoch designer. Victor Ifejika also states that his daughter drew one of the sketches which in the original appears in purple. These documents were put to Ian Dryburgh. He recognised the hand of the Murdoch designer in the sketches and doubted that Victor Ifejika had drawn the marked one, however he was prepared to agree to disagree with Victor Ifejika in cross-examination and did not press the point.
67. Charles Ifejika agrees these sketches were drawn in August/September 1988 but contends that they were produced by Murdoch following his meeting on 16th August. It seems to me that Victor Ifejika's general account (leaving aside the ticked sketch) is more likely, first because he rather than Charles has retained the originals. Moreover Charles' account was part of his evidence that he produced the Second Vision prototype, which I have rejected.
68. The significance of the sketch with the tick is that it shows a contoured design for lens cleaner. Victor Ifejika swore he drew it but I must say I doubt it was actually drawn by him. My sense of Ian Dryburgh's evidence was that he did not think so either but was too polite to say so firmly. I will not decide the point however since there is no need to do so.
69. On 28th October 1988 Giles Smith of Murdoch wrote to Victor Ifejika (CC Charles Ifejika) indicating that a meeting had taken place and confirming the decisions made. Victor Ifejika says this reflects his intervention in the project because up to that point Charles had been making the running and encouraging Murdoch to work on Charles' flat design rather than Victor's barrel case. Victor contends that this letter marks the point at which Victor steered the project back to Victor's barrel case type product and away from Charles' design. The letter may reflect Victor Ifejika intervening but it is impossible to discern from the letter whether it marked a change of the kind Victor Ifejika contends for. Apart from anything else the letter talks about carrying on with "the flat pack version" but Victor Ifejika contends that on this occasion this is not a reference to Charles' flat design, it is a reference to the flat housing of the barrel design.
70. In November 1988 as well as producing the report, Murdoch produced "concept drawings" dated 17th November 1988. The draftsman of the concept drawings was Richard Billson of Murdoch. One of the concept drawings is an assembly drawing

showing a design for a contact lens cleaner very like the model Victor Ifejika made of the Coopers & Lybrand prototype. An extract from the drawing is below:



71. Notably, just like the model and unlike the Second Vision prototype, this device appears to be actuated by rotating the lens case. This is explicable because as I understand it Victor Ifejika made the model using the Murdoch concept drawings to some extent.
72. Victor Ifejika's evidence did not include a clear copy of the whole of the Murdoch report but he had it with him at trial and I arranged for copies to be made. The report includes some text written by Murdoch and also copies of various documents. Included is a version of the 16th August secrecy agreement to which Victor's name has been added beside Charles. The report includes sketches showing a device like the one in Charles Ifejika's patent application and various other similar "flat" designs. Although on the front page the report states it is prepared for Victor Ifejika, inside there is a reference to "a meeting with Client" in which it is common ground the client referred to is Charles because in context it is referring to Charles' flat designs like those in his patent application. The report refers to problems (foaming) caused by the action of the lens tray in the bath and I take it to be referring to problems with Charles' flat design. Then the report states that Murdoch proceeded to general arrangement drawings which I take to be the so called concept drawings which show a device of the barrel design. The general arrangement drawings were done "without due respect to the outer case styling" and the report then continues with sketches to show the development of the styling. Different avenues were explored and 14 pages of the report show various sketches of outer cases, more careful drawings and a photograph of what must be the Second Vision device. Of course the presence here of the Second Vision device is consistent with either side's case. Ms Jamal submitted that the sketches include at least one (actually a few) which shows a contoured design. The best example from Ms Jamal's point of view is shown below:



73. The allegedly contoured design is on the right. I am not satisfied that this is a fully contoured design. The sketch is just that, a sketch and it has not been drawn carefully enough to be able to tell.
74. A point worth noting from the overall structure of the Murdoch report is that it does provide support for Victor Ifejika's testimony that the project started by looking at Charles Ifejika's flat design (i.e. a design like the one in the PCT application) but moved onto working on a barrel case plus housing design.
75. Finally the Murdoch report also includes documents, some dating from December 1988, which relate to pricing. Nothing turns on them save the point that the November date must be treated with a little caution.
76. On 1st December 1988 Charles Ifejika wrote a letter to his brother. In the letter he states that he apologises for causing Victor any headaches or sleepless nights. He is now totally uninterested in pursuing a policy of own manufacture or sub-contract manufacture for the lens cleaning device. Charles wishes to pursue a policy of licensing instead. He then says:
- “I therefore find it impossible to continue and in fact I am totally ‘sickened’ by the whole project. I would advise you to stop all further investment in this project as soon as Murdoch’s have been paid for their design work. I will try to repay you as soon as I possibly can for all the money you have invested. I would also ask that you allow me to have access to the designs as I can only repay you for goods or services that are useful and help towards raising the finances to repay you.”
77. A small point is that the 1st December letter suggests that at that stage Murdoch had not been paid and this is corroborated by a letter of 21st December from Murdoch to Victor. The 21st December letter also puts to Victor quotations for Murdoch to make prototypes of various sorts including a fully detailed visual working model.
78. Victor Ifejika's contends that the 1st December letter reflects the fact that although Charles had been running the project initially, he had sent Murdoch down a blind alley with the flat design and Victor Ifejika had had to step in to insist on Murdoch working on the barrel design. The sleepless nights had been caused by Charles' obsession (Victor's word) with licensing. Victor says that this letter was Charles's way of resigning from the project when he could not get his way. Victor contends that this letter marks the break between him and his brother. He says that the work carried out by Murdoch after this point did not involve Charles at all. The significance of this is that the Murdoch prototype which is depicted in the Registered Design was produced by Murdoch in April 1989.
79. It is worth recording that there is no evidence of a reply from Victor to the 1st December letter.
80. Charles' position on the letter is that while it did reflect a difference of opinion between the brothers, and while he did wish to license the designs, it did not mark a break between the brothers. Charles contends he was involved in the Murdoch work in 1989. He says that if Victor intended to exclude him from Murdoch after the end

of Phase I, he did not tell either Charles or Murdoch and so they kept working together.

81. The work by Murdoch continued. Victor Ifejika's case is that in January 1989 he told Murdoch to alter the drawings they had in order to give the lens cleaner a contoured outer shape. I accept that evidence because it fits in with the general sequence of events. On 10th February 1989 Murdoch wrote to Victor Ifejika confirming that the design had now been drawn to the overall shape and dimensions that he required. Murdoch point out this involved extra work by them. The letter refers to the cleaner as now being so compact that the mouldings have become far more complicated. The letter ends by reminding Victor Ifejika that final payment is due on completion of the general arrangement and component drawings.
82. On 15th February 1989 Murdoch wrote to Victor Ifejika following a meeting. The letter refers to magic marker sketches of the current model and these are in evidence. They show a clearly contoured design. By April 1989 Murdoch had made the Murdoch prototype, photographs of which were used for the Registered Design the subject of this action. An example of the Murdoch prototype survives and images of it are below:



83. The generally contoured lines can be seen in the images. Although it is not clearly visible in the image looking from the bottom, while the inside of the barrel case is circular in cross-section the outside it not. The outside of the barrel case has been shaped to match the lines of the product.
84. Clearly Murdoch produced drawings which corresponded to the Murdoch prototype in this period, although they have not survived. It is also obvious that the design of the Murdoch prototype of April 1989 was derived at least to some degree from the Murdoch concept drawings of November 1988. After all Victor Ifejika's own evidence is that he told Murdoch to alter their general arrangement drawings so that the outer case was contoured (paragraph 30 of one of Victor Ifejika's witness statements [Bundle 2/28 p404]). The configuration of both designs, with a barrel case and housing, are the same. I asked Victor Ifejika whether he agreed that the design of the Murdoch prototype was based to some extent on the 1988 concept drawings. On the first day of trial he agreed that they were but on the second day he informed me that his answer had given him a sleepless night and he did not accept the point. In the cross-examination of Ian Dryburgh, Victor Ifejika put to the witness that the Murdoch drawings in 1989 which must have been used for the prototype would have been redrawn and not simply copied from the 1988 drawings. Mr Dryburgh accepted that they were in all likelihood redrawn and he pointed out that at that time his company did not have an electronic CAD system for this sort of work and the drawings were hand drawn. He also explained that changes could be made by scratching lines off the paper and re-drawing them. Ian Dryburgh also described the

design process as a constantly evolving one with the product going through multiple iterations.

85. I can readily accept Mr Dryburgh's evidence. It does not assist Victor Ifejika nor does it undermine the obvious point that in terms of the design of the product, the 1989 Murdoch prototype derives a significant part of its design from the 1988 Murdoch concept drawings. Victor Ifejika placed emphasis on the differences between the designs and there is no doubt there are many of them from the point of view of the internal design of the device itself. The product in the Murdoch concept drawings appears to have no cap on the beaker at all and the lens holder was apparently not detachable. However the basic configuration of the cleaners is the same in both. True it is that one is contoured and the other is not but the general appearance of both articles is governed by the fact that they consists of a barrel case at one end of a housing.
86. Was Charles Ifejika involved in the Murdoch work in 1989? A part from his own testimony, there is no evidence that he was. There is no doubt Victor Ifejika paid for Murdoch's work. It is notable that the correspondence between Murdoch and Victor Ifejika in 1989 does not include a "cc" to Charles Ifejika whereas similar documents in 1988 did so.
87. So does that mean there was a complete break after the 1st December 1988 letter as Victor Ifejika contends? I do not see how that can be right because in February 1989, right at the same time much of the Murdoch work is going on, CCL (Vision) Ltd was incorporated with one share each for Victor and Charles Ifejika. The date of incorporation was 7th Feb 1989. Ms Jamal put to Victor Ifejika that this was inconsistent with his case that there had been a complete break and Victor's answer was that Charles was still his brother. While undeniable, it does seem to me that the incorporation of CCL (Vision) Ltd as a company owned by both men, which was clearly going to work in the area of contact lens cleaners, means that there plainly was not a complete break between Victor and Charles at this time. It does not however prove that Charles Ifejika had any input into the design of the Murdoch prototype in 1989.
88. As I understand it Victor Ifejika suggests that the work done by Murdoch after CCL (Vision) Ltd was incorporated was actually commissioned by CCL (Vision) Ltd. I do not accept that. None of the letters from Murdoch in that period refer to CCL (Vision) Ltd, they all refer simply to Victor Ifejika (10th Feb, 15th Feb, 18th April, 20th April, and 17th July 1989). Also the Murdoch invoices, statements and credit notes are the same (28th Feb, 31st March, 29th April, 31st May, 9th June, 18th Aug, and 31st Aug 1989). One document which does refer to CCL (Vision) Ltd is a promotional leaflet which Victor Ifejika commissioned Murdoch to produce and which includes photographs of the Murdoch prototype (now called the CLC 60). In the text this leaflet includes the phrase "All rights reserved by CCL Vision". It seems to me that this leaflet supports Victor Ifejika's point that he intended the rights in the design to be held by CCL (Vision) Ltd, after all the registered design was ultimately applied for by CCL (Vision), but it does not indicate that that company was commissioning Murdoch at any relevant time. I reject the contention that CCL (Vision) Ltd commissioned Murdoch.

89. In December 1989 two important things happened. 14th December is the date of a business plan for CCL (Vision) Ltd that Victor Ifejika produced in evidence. On 15th December the Registered Design application was filed at the Patent Office in the name of the company. An important element of Charles Ifejika's case is that he knew nothing about the registration of the design at that time (or for many years afterwards). I will deal with that separately.

90. In cross-examination Victor Ifejika put certain parts of the business plan to Charles as being supportive of Victor's case and contrary to his brother's. Charles's response was that the business plan had not been written with his input but had had significant input from Victor. Victor did not demur and I can take it that the business plan reflects at least Victor Ifejika's view of the state of affairs in December 1989. The plan includes the following:

“Introduction and Background

... The company has not yet commenced trading since the purpose of the company was to exploit the product which had been developed by the directors of the company – a small portable device for cleaning contact lenses.

The promoters and directors of the company, Victor and Charles Ifejika, have spent some years in the conception of the product. There is nothing comparable with it in the market place and the development of the product has not yet been publicised in order to avoid attracting the attention of potential competitors in the early stages.

The success of the development stage is almost entirely attributable, therefore, to the skill and persistence of the two promoters, especially to the drive of Victor Ifejika who has organised the design of the prototype and has personally supervised its performance testing, modification and acceptance by Boots Opticians Limited.

Victor Ifejika gained the support of the Department of Trade and Industry through its Design Initiative, towards the cost of the product design. But with this exception the development of the product has been financed solely by him.

...”

91. The business plan goes on to discuss the CLC 60 product, the patent licence under the PCT application of Charles Ifejika and refers to the “pleasing and attractive appearance”. Market and selling plans are set out and then the document deals with pre-production costs and operational plans. This includes an itemised list of services the company has already benefited from as a result of the promoters work. This includes an item “Patent fees and acquisition of rights in the product” of £3,195. Victor Ifejika contends this includes a reference to the preparation for filing the Registered Design the next day and shows that Charles did know about the registration. I will deal with that issue separately. At the end of the business plan is a

discussion of management and organisation. This describes Victor Ifejika as the leading promoter and states he will be managing director. The document continues:

“The managing director will be assisted by his brother, Charles Ifejika, who has a very close understanding of the optical pharmaceutical market. He was instrumental in the concept of the company’s CCL60 product and has also developed a contact lens cleaning fluid which he is promoting outside the company.”

92. This completes the sequence of events up to the filing of the Registered Design on 15th December. I am now in a position to deal with the question of proprietorship.
93. The question in the end is simply this: who was the true original proprietor of the design? If it was Victor Ifejika alone then, since he is now registered as sole proprietor, the second limb of the Court of Appeal’s judgment applies. The registration is valid. If not then I will cancel the registration.
94. There is a question mark as to which of the various versions of the Registered Designs Act 1949 is applicable in this case. The designs were created before 1st August 1989 when the Act was heavily amended by the Copyright Designs and Patents Act 1988 but registered afterwards. Ms Jamal submitted the version of the Act after amendment by the 1988 Act applies because that was the law in force when the design was registered. When this case went to the Court of Appeal, Patten LJ considered the question of which version of the Act was applicable on the question of commissioning although he noted that there was no difference in substance between the two on this point. Patten LJ stated (paragraph 20) that HHJ Fysh would have been wrong to apply the pre-1989 version of the RDA 1949 if the design drawings on which the design was based were those created by Murdoch in 1989. Since I have found that the Registered Design was indeed based inter alia on design drawings created by Murdoch in 1989 I will apply the 1989 amended version of the RDA 1949 and not the pre-1989 version.
95. From the point of view of validity, the relevant form of the Registered Designs Act 1949 applicable to this case is therefore the 1989 amended version which applies to pre-2001 registrations. In that Act (s1(1)) “design” means “features of shape, configuration, pattern or ornament applied to an article by any industrial process being features which in the finished article appeal to and are judged by the eye”. The definition then excludes methods or principles of construction, functional features and features which must match.
96. It is idle to attempt to produce a verbal formula which captures the design the subject of this registration entirely in words and I will not do so. One point worth making though is that it seems to me the “design” here is not just the contoured aspect of the product, although that is important, but plainly includes the overall appearance and configuration of the item, with a barrel at one end of a housing.
97. Section 2(1) of the RDA in its relevant form provides that the author of a design shall be treated for the purposes of the Act as the original proprietor subject to s2(1A) which provides that where a design is created pursuant to a commission for money or

money's worth, the person commissioning the design shall be treated as the original proprietor of the design.

98. Ms Jamal submitted that work can be commissioned by two persons jointly and if those are the facts, then those two people are joint proprietors of the design. She was not able to cite an authority for that proposition but it seems to me to be correct in any event.
99. A registration can be applied for by a person claiming to be the proprietor (s1(2)) but as the Court of Appeal pointed out in this case (Patten LJ paragraph 14) the Court is required to determine the issue of title and cannot uphold the registration merely on the basis that it was made in good faith (*Al Bassam Trade Mark* [1995] RPC 511).
100. First I will decide from where or whom the design derives. It seems to me that the design owes its origin to two sources. The first source is the Second Vision prototype which I have found to be the Coopers & Lybrand prototype and which therefore I have found was given to Murdoch from the outset. Victor was responsible for the Barrel Case prototype which fixes the basic functional configuration of the device but in terms of the appearance of the finished articles, the housing first appears in the Second Vision device. The basic configuration of the Registered Design with a housing and barrel case accounts for a significant element of its appearance and derives from that prototype. The Second Vision device was developed by Victor and Charles Ifejika working together. Victor Ifejika's evidence was that he gave his brother some money to select and buy some sweetener boxes so that a box could be used to make a housing for the device. The product arose from their working together. It seems to me that this makes both brothers responsible for the appearance of the device. There is no basis on which one could disentangle their individual contributions.
101. The second source is the work done at Murdoch. This includes the design work leading up to the report in about November 1988 as well as the final contouring work in 1989. I will assume in Victor Ifejika's favour that he drew the contoured sketch with the tick when it was at Murdoch in September 1988. It is clear that the rest of the design work was carried out by Murdoch's designers. To some extent it might be said that, in terms of the outward appearance of the article, by the end of phase I the product looked much like it did at the start (the Second Vision device) however one can see that the design is developing throughout that period. Moreover although I have not accepted the submission that the sketches in the Murdoch report show a contoured design, they are undoubtedly more contoured in appearance than the Second Vision device. The final work on the appearance clearly took place at Murdoch in 1989.
102. Since Murdoch were responsible for creating the design at least in part, the question then is: who commissioned Murdoch? Victor Ifejika contends that since he supplied the money (apart from the DTI), he is the commissioner. In his pleadings Charles Ifejika has pressed a case that he was the sole commissioner but it seems to me that that is unrealistic on the facts. In this case the choice is between Victor Ifejika alone or Charles and Victor jointly. There is also a question about the two phases of the Murdoch project. Even if Charles and Victor jointly commissioned the first phase, Victor maintains that he solely commissioned the second phase.

103. Victor Ifejika also relied on the terms of the Terms of Reference themselves. They provide (clause 4) that on payment of the project costs, any industrial property rights including copyright, patent and registered design arising directly from the work under contract shall belong to the user company. Of course the user company defined in those terms is Distributive Software Associates (i.e. Victor Ifejika). As between Murdoch and Victor Ifejika, I am quite sure this agreement makes it clear that the rights do not belong to Murdoch or the DTI. However it seems to me that as between Victor and Charles these terms of reference may not be determinative.
104. Charles relies on the fact that clause 4 starts with a qualification that it is subject to the rights of third parties. I do not think that qualification helps the defendants on the commissioning issue. It does mean that the terms of reference cannot undermine Charles Ifejika's prior rights arising as co-proprietor of the design of the Second Vision prototype but it does not shed light on the commissioning issue.
105. In my judgment and despite the terms of reference, the first phase of Murdoch's work was in substance commissioned by Charles and Victor Ifejika jointly. This is for a number of reasons. First, to exclude Charles from the commission altogether does not fit with his name appearing on the secrecy agreement dated 16th August 1988 and with Murdoch's access to Charles Ifejika's unpublished patent specification. Second, it is common ground that in the Murdoch report, in at least one place the term "client" is referring to Charles. Third, the project began (inter alia) with the Second Vision device which was the product of the brothers working together. Fourth, if Charles was not a joint commissioner of the project, what was his status? He was not working for his brother and he was not working for Murdoch. Charles being a joint commissioner fits the evidence available.
106. The major points against this are (i) the point that money only flowed from Victor and not Charles, and (ii) the clear provisions of the Terms of Reference. However the reason Victor signed the Terms of Reference was because he was the one with the financial resources to pay Murdoch and therefore from Murdoch's point of view he was the one who was to be liable to pay. But in doing so in my judgment Victor was acting on behalf of the brothers' joint enterprise. Victor himself has said that at least at the start of the Murdoch project the brothers were working as a team. In a case in which both men were working together as a team, which I find that they were, the fact that one of them contributed the money does not mean that that person should be seen as the sole commissioner. After all Charles did not contribute nothing, at its lowest he contributed his unpublished patent application and his time to the project.
107. Victor Ifejika contends that the 1st December 1988 letter shows that Charles acknowledged Victor owned the design at that stage. I do not agree. The letter shows that Charles recognised an obligation to pay back his brother for the sums Victor had paid but that does not mean Charles was acknowledging he (Charles) had no rights.
108. Did the position change after the end of 1988 and into 1989? Victor Ifejika contends that by then all the Murdoch work was done at his behest alone and to some extent the evidence supports him. However it seems to me that the reality of the position is this. If, as I have found, the commissioning of Murdoch from the outset was a joint one between both brothers, nothing was ever done to alter that state of affairs. Although the evidence in favour of Victor Ifejika's account here is substantial, in the end it seems to me that the lack of anything actually showing a change in the state of affairs

means that they did not change. The design work done by Murdoch in 1989 which led to the April 1989 prototype was still jointly commissioned by Charles and Victor Ifejika.

109. Taking a step back and looking at the position overall, it seems to me that I can place considerable weight on the December 1989 business plan. It is a more or less contemporary narrative discussing the developments as a whole. Although it does emphasise Victor Ifejika's contribution to the product it also makes clear that Charles Ifejika made a contribution too which relates specifically to the CLC 60 product. According to that document Charles Ifejika was "instrumental in the concept of the company's CCL60 product" (sic). It seems to me that this provides a firm foundation for a finding Charles Ifejika was a joint proprietor of the design with his brother and that Victor Ifejika was not the sole original proprietor of the design.
110. Thus the design did not belong to CCL (Vision) Ltd when it was applied for, should not have been registered to that company when it was registered and does not today belong solely to Victor Ifejika. I will cancel the registration.

Hot House

111. On 21st November 1989 Victor Ifejika commissioned Hot House Development Partners to produce manufacturing drawings based on the devices he had (the CLC 60 product). Drawings were produced and the details of the design of the product changed at least to some extent. (Here "design" is now being used not in its particular sense under the RDA 1949 but in its more general sense.)
112. On 16th March 1990 Charles Ifejika and CCL Vision entered into a patent licence whereby CCL Vision was licensed under Charles Ifejika's patent application. I gather that the company paid Charles £1000 although later payments were not made.
113. In May 1990 CCL Vision entered into a confidentiality agreement with Sauflon Pharmaceuticals Ltd [2/28/131]. As I understand it Sauflon had a cleaner fluid and was looking to co-market the fluid with CCL Vision's cleaning device. There are documents reflecting trials to support an application to vary Sauflon's product licence for their cleaning fluid to include its use with the cleaning device.
114. In November 1990 Hot House were commissioned to produce a manufacturing prototype by Victor Ifejika. It was actually produced in 1992. This is the Hot House prototype in which Victor Ifejika claims unregistered design right.
115. On 31st December 1991 Charles Ifejika resigned from CCL (Vision) Ltd. Victor Ifejika contends that his was because the bank had demanded repayment of £144,224.77 and that Charles wished to avoid being liable to the bank. Whether that is right or wrong I cannot say. What is clear is that by now CCL (Vision) were in serious financial difficulties.
116. One thing is tolerably clear. Whenever exactly the split between Charles and Victor Ifejika took place, from now on they were not working together.

Unregistered design right in the Hot House prototype

117. Section 213 of the 1988 Act provides:

213.— Design right.

(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 in question at the time of its creation.

118. Thus unregistered design right will subsist in those aspects of the shape and configuration (whether internal or external) of the whole or part of an article which are original (s213(1) and (2) of the 1988 Act). The relevant originality is that as compared to the Murdoch prototype. The reason for this is that any unregistered design right in the Murdoch prototype will have expired whereas, for reasons I will address below, the term of any unregistered design right relating to the Hot House prototype may be sufficient to catch the Lenscare and AMO products complained of.

119. The question of features being commonplace is always important although in this case there was no attempt to deal with this in any detail in the evidence.

120. Externally the Hot House prototype does not differ much from the Murdoch prototype. This is the Hot House:



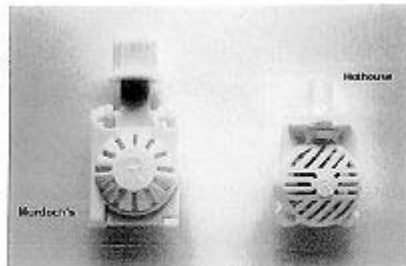
121. However it is clear that the Hot House prototype does differ in some respects from the Murdoch prototype. Victor Ifejika contends that the differences are in the following features:

1. The lens holder body including (i) the hinge detail, (ii) distinctive style of the lens covers, and (iii) separately moulded (blue) rubberised lens support
2. The drive bar
3. The drive peg

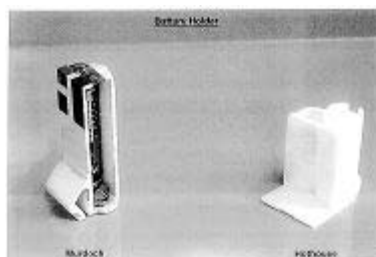
4. The battery door
5. The battery holder
6. Internal aspect of the casing
7. External undercut detail of the casing
8. The drive shaft
9. The combination of internal aspect and external aspect of the casing
10. The combination of drive shaft and beaker cap.

122. Victor Ifejika provided comparative photographs of the relevant parts in order to make out his case on originality. I will not annex all the photographs to this judgment. Of the list above, I find that unregistered design right subsists in relation to some but not all of the items on the list. The items are 1, 4, 5, 6, 7 and 10. These each represent original, not commonplace, designs of aspects of the shape and configuration of the whole, or more realistically, parts of the article. Relevant images for items 1, 5, 6, 7 and 10 are below. There is no picture for item 4 but nevertheless by comparing the actual exhibits it can be seen that the battery door on Hot House is quite different from the corresponding part of Murdoch. The images are:

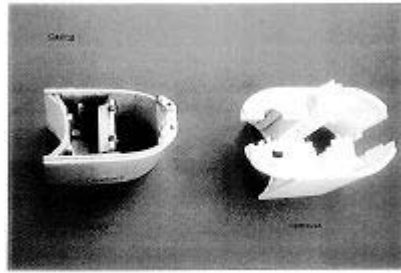
1. Hinge (item 1(iii) not visible in this image):



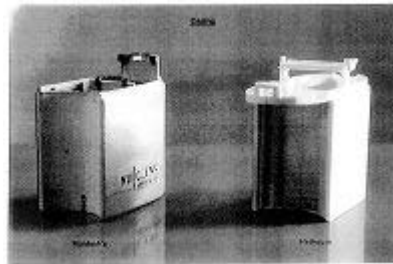
5. Battery holder:



6. Internal aspect of casing:



7. External undercut detail of casing:



10. Combination of drive shaft and beaker cap



123. The external undercut (item 7) consists of a pair of ridges on opposite sides of the face of the casing which would rest against the barrel case. In the Hot House device they allow the face to accommodate the rounded surface of the barrel case. The back wall of that face is flat. This feature is not easily visible in the image above but it can be seen that the corresponding part of the Murdoch casing is smooth and curved to accommodate the rounded surface of the barrel case. Although not clear in the photographs, the battery holder (5) in Hot House holds three batteries whereas Murdoch holds only two.
124. I reject the other items as giving rise to unregistered design right (i.e. I reject items 2, 3, 8, and 9). The drive bars (2) and drive shafts (8) do not appear to me to differ sufficiently to justify a fresh unregistered design right. I could not identify a drive peg (3). Combination 9 does not add anything.
125. Thus in relation to unregistered design right, I find that items 1, 4, 5, 6, 7 and 10 do give rise to unregistered design right. There is no challenge to Victor Ifejika's evidence that he commissioned this work from Hot House and so, pursuant to s215(2) of the 1988 Act Victor Ifejika is the owner of the right.

Term of unregistered design right

126. The defendants contend that Victor Ifejika sold a lens case known as the "standalone" lens case which was exactly in accordance with the lens case in the Hot House

prototype and that this has an impact on the term of the right. It is common ground that Victor Ifejika sold some such products but he contends that the numbers were very low indeed and not such as to be relevant.

127. By s216(1) of the 1988 Act the term of unregistered design right is 15 years from the end of the calendar year in which the design was first recorded or articles made to the design (whichever was first), or if articles made to the design were made available for sale or hire within 5 years from the end of that calendar year, 10 years from the end of the calendar year in which that first occurred.
128. Charles Ifejika says that Victor sold and asked Charles to sell standalone barrel cases of this kind from 1992 onwards. (In fact Charles' evidence about dates has varied in these proceedings but I will take the date as 1992). It is common ground that this took place but the details are sketchy. When this point was discussed in court Victor Ifejika was concerned to point out a paragraph in one of his witness statements which he stated had been prepared by his lawyers (when he was instructing lawyers) to deal with the point. The paragraph uses the expression "supply that would satisfy the reasonable demands of the public" and denies that Victor Ifejika ever supplied enough to do that. Victor Ifejika's position at trial was that while he accepted sales of about 1500 items, that was not sufficient to "satisfy the reasonable demands of the public".
129. Victor Ifejika's case involves a point of law. Section 216(1)(b) refers to articles being made available for sale. The submission is that only sales on a sufficient scale to satisfy the reasonable demands of the public would count and sales on a lower scale would not trigger s216(1)(b). I reject that submission. It seems to me that any making available for sale, on any scale, is relevant for the section to apply. After all the consequences of its application are only that the term of design right may be reduced somewhat in some cases once goods are on sale, with a back stop that the term is still 10 years. I can see no reason why a term requiring sales to be on a certain scale should be read into the provision.
130. Accordingly the admitted sales of the stand alone barrel case are relevant. Victor Ifejika handed up an example of the stand alone barrel case. It has feature 1 (all of 1(i) to 1(iii)). Feature 10 is partly present but since the standalone lens cap does not engage with any drive pins because it stands alone from a lens cleaner device, it seems to me that feature 10 is not caught. The other features are not present in the barrel case. Thus unregistered design right in feature 1 expired at the end of 2002. The unregistered design right relating to the other features runs until the end of 2007.
131. I have asked myself whether it makes any difference that the product sold was a lens case and not a full lens cleaner device. In my view it does not. The features of shape and configuration are the same. Feature 1 is a feature of a lens case which may or may not be part of a lens cleaner device. It seems to me that the lens case was an article made to the design and so the term of unregistered design right in that design is limited by s216(1)(a).

Chronology onwards from 1992

132. As I have mentioned above, after the end of 1991 as far as I can tell the two brothers worked entirely independently. Charles Ifejika and his company Lenscare developed the lens cleaner referred to in this case as the Lenscare device.

133. By late 1992 CCL (Vision) was in severe financial difficulties. Victor Ifejika had remortgaged his house to develop the cleaner but it was repossessed in 1995 and in 1995 CCL (Vision) Ltd was struck off company register. However it still held the registered design.
134. In 1996 Charles Ifejika formally terminated his patent licence to CCL (Vision) Ltd.
135. In 1997 Charles Ifejika, unknown to Victor, worked with ATOM to produce a lens cleaner. This device is the Lenscare device.
136. In evidence is a handwritten letter from Charles Ifejika to Victor dated 21st November 1998. The letter reads:

“Dear Victor,

It is now about 10 years since I first came to you to help me with my project for cleaning contact lenses. Since then you have helped a lot but the best way that you can continue to help me now is by giving me any remaining stocks that you have and all the tools.

I know that this will be very difficult but you must leave things to me, let go and try to get on with other things in your life.

I am older and wiser now and I fell that I can make a success of the project, Alone! You must hope, trust and pray that I can succeed so that I can repay you for your past efforts. I can not repay you now, nor can I make any promises about the future but if you hope, trust and pray, the seemingly impossible may become possible.

So please allow me to have any tools or stock that are still around. Allow me to continue this on my own & hope that fate will work things out for the best.

Charles”

137. As far as I am aware Victor Ifejika did not reply to this letter.
138. On 24th November 1999 the relevant renewal fee for the registered design was paid. The money came from Victor Ifejika. Of course at this stage the proprietor CCL (Vision) had been struck off the register. The renewal ensured that the registration would extent until 15th December 2004.
139. In March 2002 Victor Ifejika was told by Richard Thom of Hot House that Charles Ifejika had won a BBC best inventors competition with a contact lens cleaning device. In evidence there is a page from the Daily Express on 4th April 2002 with an article entitled “Visionary sets sights on market for lens cleaners”. The picture shows Charles Ifejika holding a lens cleaning device and the text discusses the product, its development and the plans for its future. It also mentions tests performed at Moorfields eye hospital on the product. The article ends with a reference to a more

sophisticated model which is being worked on. That later model became the AMO product.

140. In March 2002 Victor Ifejika bought a Lenscare device from Adam Simmonds Eye Care. It is clear that the Lenscare product itself did not sell in any quantity at all.
141. In February 2003 Charles Ifejika was performing “due diligence” as part of making arrangements for AMO to sell the AMO product. His evidence is that this is when he discovered the registered design. On 7th February 2003 he wrote to the address for service (the patent agents firm Graham Jones & Company). The letter refers to the fact that the proprietor CCL (Vision) Ltd has been dissolved and to the termination of the patent licence and ends:

“The reason I bring this to your attention is because of the fact that at the patents and designs registry, CCL Vision is listed as having extended the period of protection for the registered design until 15th Dec 2004. Unfortunately, this registration has no legal foundation due to the dissolution of CCL Vision the company and termination of any rights to the patent and product for CCL Vision when the licence was terminated. The second reason I draw this to your attention is that in the final years of the patent and whilst I see if there is something to be salvaged, I do not wish to get embroiled in any legal disputes, especially if there is no legal foundation for them. Sorry to be the bearer of this bad news but it must be stated. ”

142. He received no reply.
143. In October 2003 Victor Ifejika bought an example of an AMO device (called the AMO Rapid Care Cleaner) from a company called Mid-optic. It was made by the second defendant and distributed by AMO. The sales of this device were much more substantial.
144. In November 2003 Graham & Jones wrote to Victor Ifejika enclosing a copy of the February 2003 letter. Victor Ifejika appears to have contacted them after finding the AMO product. The letter explained that the registered design was in the name of CCL (Vision) Ltd and observed that if the company was no longer in existence then there would be consequences for ownership of it, however the firm were not experts in company law and solicitors should be able to advise.
145. In November 2003 CCL (Vision) Ltd was restored to the register.
146. The patent entitlement proceedings commenced in 2004. I gather that the trigger for them was Victor Ifejika’s discovering a leaflet from the second defendant which referred to the patent. Those proceedings were complete in 2006.
147. The claim form in this case was issued on 21st February 2008 because Victor Ifejika was concerned about the limitation period. Also in February 2008 (on the 19th) the registered design was assigned to Victor Ifejika from CCL (Vision) Ltd.

Infringement of unregistered design right

148. Since I have found unregistered design right subsists I will address infringement of those rights first.

149. Section 226 defines acts of primary infringement as follows:

226.— Primary infringement of design right.

(1) The owner of design right in a design has the exclusive right to reproduce the design for commercial purposes—

(a) by making articles to that design, or

(b) by making a design document recording the design for the purpose of enabling such articles to be made.

(2) Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design, and references in this Part to making articles to a design shall be construed accordingly.

(3) Design right is infringed by a person who without the licence of the design right owner does, or authorises another to do, anything which by virtue of this section is the exclusive right of the design right owner.

(4) For the purposes of this section reproduction may be direct or indirect, and it is immaterial whether any intervening acts themselves infringe the design right.

150. As was explained by Lewison J in *Virgin Atlantic v Premium* [2009] EWHC 26 (Pat), the test requires comparison of the alleged infringing article against the article that is said to embody the design relied on, the question being (1) whether copying has occurred and (2) if so whether the alleged infringement has been produced “exactly or substantially” to the copied design:

31. What must be established is that the design in which design right subsists has been copied so as to produce “articles exactly or substantially to that design”. Two points arise. First, although the Act allows design right to subsist in (and be claimed for) part of an article, the definition of reproduction speaks only of making “articles”. There is, therefore, a linguistic mismatch between subsistence of design right and the right that it confers. But it must obviously have been Parliament’s intention that if design right subsisted in part of an article (e.g. the teapot spout) the right would be infringed by incorporating a copy of that spout in another teapot, even if the infringing spout is not itself a whole article. Secondly, even if the design has been copied, the infringing article must be produced “exactly or substantially” to the copied design. Mere similarity is not enough.

32. In *C&H Engineering v F Klucznik & Sons Ltd (No.1)* [1992] F.S.R. 421 Ch D Aldous J. said:

‘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.

151. In these types of case Park J's observation in *A Fulton Co Ltd v Grant Barnett & Co Ltd* [2001] R.P.C. 16 at [95] is applicable:

The courts proceed on the basis that a close similarity between the claimant's design and the alleged infringing article, coupled with the opportunity for the alleged copier to have access to the claimant's design or work, raises an inference of copying. It is then up to the defendant to rebut the inference by evidence which shows that the apparent similarity arose in some other way.

152. But as Lewison J pointed out in *Virgin* (quoting Mummery LJ in *Farmers Build*), it is important to have in mind that similarity (even substantial similarity) between designs can often be explained not by the fact they were copied, but by some shared functional requirement between the designs:

35. ... it is also important to bear in mind Mummery L.J.'s warnings in *Farmers Build* (at 481 and 482):

“Substantial similarity of design might well give rise to a suspicion and an allegation of copying in cases where substantial similarity was often not the result of copying but an inevitable consequence of the functional nature of the design. . . Copying may be inferred from proof of access to the protected work, coupled with substantial similarity. This may lead to unfounded infringement claims in the case of functional works, which are usually bound to be substantially similar to one another. . . . [The court] must not forget that, in the field of designs of functional articles, one design may be very similar to, or even identical with, another design and yet not be a copy: it may be an original and independent shape and configuration coincidentally the same or similar.”

36. However, as in any case where there are factual presumptions and shifting evidential burdens, the question of copying is in the end a question of fact; and one which must be proved by the claimant on the balance of probabilities.

153. On the basis of these authorities, the approach I will take to infringement is as follows. First I will consider whether the similarities between the Lenscare or AMO products complained of and the elements of the Hot House prototype relied on (as well as the possibility of access) call for an explanation. In other words - do they raise an inference of copying? In considering that matter I will bear in mind that functional features may be similar because they are performing a function not because of copying. If an inference is raised then I will consider what explanation the defendants put forward. In the end I will compare the products and the design

objectively, reminding myself that for infringement, the relevant article must be produced exactly or substantially to the design.

Unregistered design right infringement – the facts

154. Charles Ifejika position vis a vis the Lenscare device has changed significantly since the case management conference in this case. From the start (until after the CMC) Charles Ifejika contended that the Lenscare device was created from the Murdoch prototype and so could not infringe unregistered design right relating to the Hot House prototype. If he had been right then it could not infringe. The changes in that position are addressed below.
155. Charles Ifejika also contended that the AMO device was produced as a result of his trying to take the Murdoch design (now in the form of the Lenscare device) through to manufacture. Ms Jamal points out that just as Victor Ifejika found changes needed to be made to turn the Murdoch prototype into a workable product which could be made on a substantial scale, so too Charles and those working for him encountered the same issues. Thus Charles Ifejika contends that insofar as there are similarities between the AMO device and the Hot House prototype they are explicable as a result of parallel development solving the same problems in similar ways.
156. Apart from his acceptance that AMO was developed on from Lenscare, Victor Ifejika does not accept Charles's case here. Victor contends that Lenscare is a copy of the Hot House prototype. Thus AMO, being based on (at least) Lenscare, is a second generation copy of the Hot House prototype.
157. First I will consider objective similarities or differences between Lenscare and Hot House. Externally the Lenscare device looks like this:

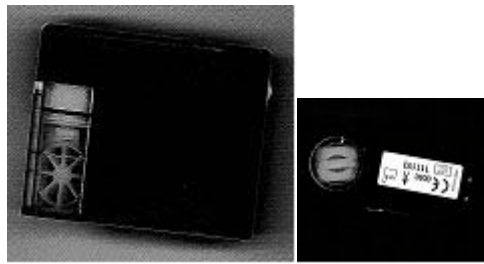


158. From this external point of view it looks much like the Murdoch prototype. However the Lenscare device has an undercut detail which is virtually identical to the Hot House prototype (feature 7). Also it has a lens holder body with a hinge detail which is closely similar to Hot House (item 1(i)). The internal casing of the Lenscare is also strikingly similar to the Hot House design and very different from Murdoch (item 6). The battery doors are very similar (item 4). Victor Ifejika alleges the battery holder (5) has also been copied. Curiously the battery holder in the Lenscare device has three channels arranged like the three battery tubes in the Hot House device but one of them is not in fact a battery tube as far as I can tell, it has a square cross-section and appears to be shorter. Nonetheless, to my eye this part of Lenscare looks like a design which bears a causal relationship to the Hot House design albeit which has then been modified.
159. It seems to me that the similarities between Lenscare and Hot House are more than sufficient to raise an inference of copying.

160. In their original defence in these proceedings dated July 2008, the defendants' case was that the Lenscare device had been produced from mouldings prepared by a company called CT Plastics and based on drawings by a French company called Pole de Plasturgy. Victor Ifejika did not accept this. He relied on a fax letter from a company called ATOM.
161. The fax letter from ATOM was to Richard Thom at Hot House on 6th March 2002. It states that ATOM were approached by Charles Ifejika in June 1997 to make some models and they did so based at least in part on some injection moulded components supplied by Charles. Victor says they were Hot House parts. Victor contends that Charles stole a Hot House prototype from Victor's daughter.
162. In these proceedings Charles Ifejika had always denied having had access to the Hot House prototype and maintained his denial of infringement.
163. Once this case was transferred into the Patents County Court a full review of the issues took place at a case management conference in June 2011. One of the points made by Victor Ifejika at that hearing was to point to a document he had produced which he contended was a Lens Care leaflet from Charles but which contained a photograph of what could be identified as a Hot House prototype. I recall this issue being discussed at the review.
164. In his witness statement prepared for this trial after the CMC, Charles Ifejika explains that the case management conference was the first time he had seen what Victor called the Murdoch prototype and the first time he had understood the differences Victor relied on between Hot House and Murdoch. He states that:
- “At the CMC on 1st June 2011 I realised that I must have come into contact with the Hothouse prototype or articles thereof before. At some point prior to 2001, the claimant's daughter gave me what I thought was the Murdoch prototype. The claimant kept the Feb 1989 drawings a secret from me and a further complication is that he states these drawings are now lost. As I had thought the claimant's daughter had given me the Murdoch prototype and with the UDR claim being so trivial in terms of quantum, I did not want to drag her into the affair regarding the HH design.”
165. Accordingly it is now clear what happened. Victor Ifejika is right. The Lenscare device was obviously made by copying parts of the Hot House prototype and Charles Ifejika had access to the prototype in order to do so. I have no reason to doubt that Charles Ifejika did so unwittingly in the sense that he did not appreciate that the prototype he was using was not Murdoch but a later product (actually Hot House) but that is irrelevant. In my judgment the relevant parts of the Lenscare device infringe Victor Ifejika's unregistered design right. That is items 1(i), 4, 5, 6, and 7. They are not all exactly to the relevant design but in my judgment they are all substantially to the corresponding design. As directed at the case management conference I will assess the damages for that infringement here and now.

The AMO device and unregistered design right

166. Externally the AMO device is further from the Hot House prototype than the Lenscare is from Hot House. The AMO device is dark blue and does not reproduce easily. General images of AMO are:



167. In terms of the specific features, of the ones in which unregistered design right subsists, Victor Ifejika contends that the AMO reproduces feature 1(i) (hinge detail on lens holder), feature 7 (the undercut) and feature 10 (combination of drive shaft and beaker cap).
168. I am not persuaded that feature 10 has been infringed even assuming copying. As can be seen in the image of this combination above, in the Hot House prototype the drive shaft part has a central rectangular slot with a pair of holes on either side into which the arms engage to rotate the lens holder. Each hole is a relatively short fat arc. The corresponding part of the AMO device has a pair of holes but they are longer and thinner, and no central rectangular slot, only a square hole. In my judgment this part of the AMO device is not substantially to the Hot House design.
169. The hinge arrangement (feature 1(i)) in the lens holder of the AMO device is centrally located just like Hot House and Lenscare and unlike Murdoch. Victor Ifejika also produced some evidence of other lens holders on the market to make the point that this central feature was not “prior art” as he put it. It is plain that this aspect of AMO derives from Hot House, most likely indirectly via Lenscare. There is no other credible explanation. The feature is not exactly to the design of the Hot House hinge detail but in my judgment it is substantially to that design. The fact that the term of unregistered design right in relation to this feature expired at the end of 2002 will have a bearing on an enquiry but it is not relevant at this stage.
170. There is clearly an undercut in the AMO device (feature 7) but Ms Jamal emphasised the defendants’ case that the undercut had not been copied. The undercut in AMO is said to perform a different function from the undercut in the Hot House (and Lenscare) devices and so it is argued that this is an example of convergent evolution not copying. As Mummery LJ emphasised in the passage from *Farmers Build* I have cited, substantial similarity may be the inevitable consequence of a functional design and not the result of copying.
171. The difference in function is this. Unlike all the other devices derived ultimately from the Second Vision prototype, the AMO device has no nose or leg holding the barrel case against the main body of the housing. Accordingly in order to hold the barrel case in place, the barrel case body has a pair of ribs which engage with the outer undercuts. A pair of notches are present in the bottom face of the housing, in order to allow the ribs to engage with the undercuts as the barrel case slides into position.

172. Plainly the engagement between ribs and the undercut is a genuine function that these parts of the AMO device perform. However that does not mean there is no case of unregistered design right infringement. In my judgment it is plain that what has happened here is that starting from the Lenscare device, the designer(s) of the AMO device have turned the existing undercuts to their advantage. The under cuts in the Lenscare device, as in the Hot House prototype, provide support for the barrel case in the housing. In the AMO device the undercuts perform the very same function. The AMO designer(s) clearly realised that they could cut away two small notches to allow access to the outer one of the two undercuts on each side and that would let them dispense with the nose of the housing if they created ribs on the barrel to engage with the undercuts. This engagement function has put to a good further use a feature which was already present. It is simply not credible in my judgment to suggest that the undercuts in the AMO device were produced independently and not derived from the Lenscare product. If they were derived from Lenscare then that means they were derived (indirectly) from the Hot House prototype. The feature in the AMO device is not identical to the Hot House prototype here but the AMO device is in this regard substantially to the design of the Hot House prototype. Using the undercuts for engagement with ribs on the case is an ingenious thing to have done but it is an example of ingenuity added on top of copying. That does not avoid infringement when the end result, as here, is substantially to the original design.

Unregistered design right - summary

173. I find that Victor Ifejika is entitled to unregistered design right in the Hot House prototype and it has been infringed by both the Lenscare device and the AMO device.

Registered Design - infringement

174. Since I have found that I should cancel the registered design, the question of infringement does not arise. Since I have heard argument and evidence on the issue I will state my views briefly. The issue is really about the AMO device. It is admitted that the Lenscare device is within the scope of the registered design.
175. For infringement of this registered design as regards acts which took place after 9th December 2001 the relevant law to apply is that of EC Directive 98/71/EC of 13 October 1998 on the legal protection of designs. That was implemented by amendments to the Registered Designs Act 1949. This is the case even though for validity of the registration, the pre-2001 version is relevant (see the Registered Design Regulations 2001 SI 2001/3949 paragraph 12).
176. The scope of protection conferred by a design under Article 9(1) of the directive includes “any design which does not produce on the informed user a different overall impression”, taking into account the “degree of freedom of the designer in developing his design” (Art 9(2)). The informed user is deemed to be aware of the existing design corpus (*Procter & Gamble v Reckitt Benckiser* [2008] FSR 8 at para 17).

The Registered Design (No. 2 003 357)

177. The photographs in the registration show a device with a white housing with a blue barrel case whereas the AMO device is a striking, fairly dark, blue coloured housing

with a clear barrel case. This is irrelevant (see *Dyson v Vax* [2011] EWCA Civ 1206) because the statement of novelty provides:

“The novelty of the design reside in the shape and configuration of the article as shown in the representations.”

178. Thus the colour of the article should be ignored.

179. I was not invited to use the actual articles (such as the Murdoch prototype) as representations of the registered design and I have not done so. The Murdoch prototype in evidence has lasted remarkably well for over 20 years but it is not in perfect condition.

The comparison

180. The defendants submit the registered design and the AMO device create a different overall impression. Particular features of the AMO device which are argued to be very different are set out below with my observations about them underneath:

i) The AMO is made of a clamshell design as opposed to a top cover and housing case design.

In the registered design a line runs around the side of the housing near the top. This line marks the edge between the top cover and the lower housing. In AMO device the whole housing is made of two parts which fit side by side. The join can be seen running horizontally along the top.

ii) The peripheral features of the AMO device are completely different from the registered design, for example the switch and battery door.

In the registered design the switch can be seen on the top with a series of ridges. The battery door is not visible (in fact we know it is on the base). The top can be opened to provide a mirror. In the AMO device the switch is on the side away from the barrel case, there is no mirror and the battery door is on the top.

iii) There is no front “guiding leg” on the AMO device.

This is what I have called the “nose” or leg. It is absent from the AMO device.

181. Ms Jamal submitted the informed user in this case would be a designer of lens cleaning devices. Victor Ifejika did not demur and the matter was not argued either in writing or orally. Whether the user is a designer or not does not matter much on the facts of this case. The important characteristics of the informed user are that they are reasonably discriminatory and that they know the various designs which exist in the field (e.g. *Dyson v Vax*, Sir Robin Jacob paragraphs 14-15). In evidence there are images of a few other lens cleaners on sale, including two in the Murdoch report. They look nothing like the registered design at all. It is also clear that there were on the market a number of barrel shaped cases for putting contact lenses into cleaning fluid. These included the basket type holders. On the other hand they were not the only contact lens cases available (see e.g. the flat cases of the kind shown in the patent).

182. In terms of design freedom (Art 9(2)) it seems to me that the design freedom here is very broad. The one aspect in which design freedom is limited is the contact lenses themselves – which are obviously a given.
183. Despite the defendants’ submissions, I would hold that the design of the AMO device would not produce a different overall impression on the informed user bearing in mind how broad the design freedom is and how different the other cleaners on the market that I have been shown appear to be. It is ultimately a matter of impression but it seems to me the key is that the test considers an “overall” impression. The various differences relied on are differences of detail but it seems to me that as a whole, the designs produce the same overall impression. Both designs are more or less oval in cross-section and consist of a housing and a barrel case at one end with a contact lens holder inside. The barrel case has been shaped to match the contours of the housing. The differences in peripheral features do not contribute significantly overall. The most significant difference in appearance is the lack of a guiding leg or nose but it is not enough of a distinction to make a material difference in my judgment.

Innocence and estoppel

184. Again since the registered design is to be cancelled, the innocence and estoppel defences do not arise either. I will say only this about them.
185. As regards innocence it is inherently surprising to think that a director of a company (CCL (Vision) Ltd) did not know the company had filed for a registered design on its only product but Charles Ifejika is adamant he did not know about it. In fact the evidence as to what actually happened in the period when Charles Ifejika was a director of the company (1989 – 1991) is sparse. I do note however that the February 2003 letter written when Charles Ifejika contends he discovered the registration reads more as if the surprise is that the registered design has been extended (by payment of renewal fees) than that the writer was unaware that the registered design existed. However in the end there is really no evidence to show that Charles Ifejika did know about the design until he found it in 2003.
186. As regards the estoppel the facts are clear enough. As a matter of law, when CCL (Vision) Ltd was struck off, the registered design passed to the crown as *bona vacantia*. Although at one stage the defendants suggested (I think) that the registered design could be regarded as not being in existence in this period, that is clearly not correct. In any event in February 2003 Charles Ifejika was clearly aware of it and wrote to the agents at the address for service. He had no reply. In November 2003 the company was restored to the register. Although Ms Jamal submitted that the estoppel meant I should refuse to order an inquiry as to damages at all (if I otherwise found registered design infringement), if I had been in that position I would not have taken that course. The details of the arrangements by which the AMO device came to be sold, and the relevant dates are wholly unclear. They are matters which would be gone into on an inquiry. Even if the estoppel point is a good one to some extent, it may well not run sufficiently far forwards in time to cancel out all the damages which might have flown from the AMO device (if there were any). In my judgment the right occasion to deal with this estoppel point would have been on an inquiry as to damages for registered design infringement. However since the registered design is to be cancelled, there has been no infringement and there will be no inquiry in that respect.

Director's liability

187. The list of issues arising from the CMC did not include the question of Charles Ifejika's personal liability. Ms Jamal pointed out it was in fact an issue on the basis of the current versions of the statement of case (the so called "CCL Vision Particulars of Claim" dated 23rd March 2011 and the Amended Defence and Counterclaim dated 14th April 2011). She submitted that its omission was an error and sought leave to deal with this issue. In Charles Ifejika's witness statement dated 20th July 2011 he had given some evidence about it. Victor Ifejika did not object and I gave the defendants leave to address the issue.
188. Ms Jamal submitted that even if the second defendant company was liable, Charles Ifejika was not personally liable for its infringements. He was a director of the company and Ms Jamal cited *MCA v Charly Records* [2001] EWCA 1441. This case made it clear that a director or other officer of a company may in certain circumstances be personally liable with the company as a joint tortfeasor but that a director will not be liable merely because he is an officer of the company. He must be personally involved in the commission of the tort to an extent sufficient to render him liable as a joint tortfeasor. Whether he is sufficiently involved is a question of fact, requiring an examination of the particular role played by him in the commission of the tort. In a case in which a company is found to be the primary infringer a director will be liable as a joint tortfeasor if he procured or induced those acts to be done by the company or if, in some other way, he and the company joined together in concerted action to secure that those acts were done (see Chadwick LJ paragraph 53).
189. In his evidence Charles Ifejika states that he was not the "controlling mind" of the company. In support of this he points out that the bank account had two signatories on the insistence of shareholders. They were his friends but expressed the view they would feel more assured if he did not have unrestricted access to the funds of the company. All financial decisions had to be verified by a second signature and he could not make decisions without this specific approval. He was majority shareholder and could have overruled the decision but it was agreed, says Charles, that the shareholders would jointly assume responsibility for being the "controlling mind" of the second defendant. Charles Ifejika gives examples of decisions made by the company – such as to market the cleaner through AMO – which were taken by meetings of the shareholders and not by himself personally.
190. Charles Ifejika's evidence in this respect was not challenged by Victor Ifejika. In my judgment however it does not meet the point. It is clear that Charles Ifejika is personally responsible for the fact that the products of the second defendant infringe unregistered design right. He obtained what was in fact the Hot House prototype and personally made it available to be used to make the Lenscare product which led on to the AMO product. He is personally responsible for the copying of the Hot House prototype. For this purpose I will assume (without deciding) that Charles Ifejika thought he was entitled to do this. In my judgment it does not matter. He personally procured or induced the second defendant to make and have made the relevant articles. They infringe unregistered design right because the article on which they were based in fact embodied Victor Ifejika's unregistered design right. Another way of looking at the facts would be to say that there was a common design between Charles Ifejika himself and the second defendant, for the second defendant to make articles based initially on the Hot House prototype Charles Ifejika obtained from

Victor Ifejika's daughter. That is the origin and cause of the infringement. In my judgment Charles Ifejika is personally liable for the unregistered design right infringement by the second defendant.

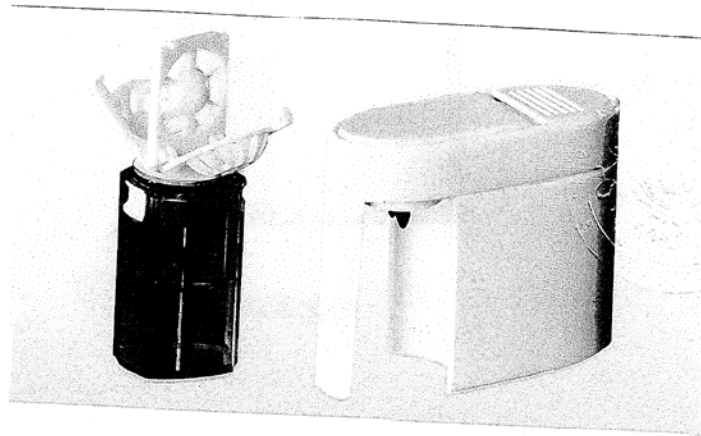
Assessment of damages for Lenscare product

191. I directed at the CMC that if infringement by the Lenscare device was found I would assess the damages at trial. It would be disproportionate to spend any significant time on the matter. The parties are agreed that the most the damages could be if the Lenscare product infringes the registered design and unregistered design right is £35. The registered design is to be cancelled and the only infringement therefore is of unregistered design right. The infringing parts are by no means the whole of the article and in my judgment an apportionment must be made taking into account their significance overall. I will assess them at £10.
192. As regards the AMO device, there will need to be an inquiry. At the CMC the parties position on the likely damages ranged from £25,000 (defendant) to £½ Million (claimant). However these covered registered and unregistered design right infringement. The only infringement I have found relates to unregistered design right by certain aspects of the product. Accordingly an apportionment will need to be undertaken such as I carried out in the previous paragraph. Moreover it may be noted that fewer aspects of the AMO device infringe unregistered design right than in the Lenscare device and that will influence the apportionment to be conducted. Furthermore the five year period for which licences are available for unregistered design right by s237 will be the period 2003 to 2007. Moreover the unregistered design right in the hinge aspect expired in 2002 and that may exclude the AMO product entirely. These factors are likely to have an impact on the level of damages.

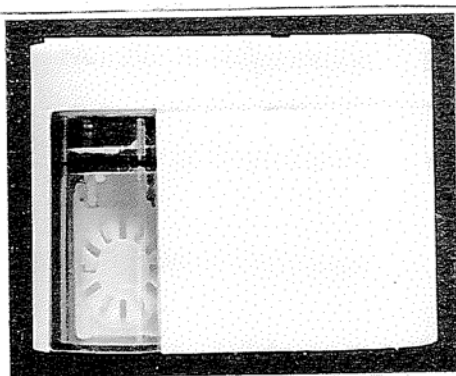
Conclusion

193. Although Charles Ifejika has consistently denied it, in my judgment he *did* take some of his brother's intellectual property. The Lenscare and AMO devices do infringe aspects of Victor Ifejika's unregistered design right. On the other hand, although Victor Ifejika has consistently denied it, in my judgment Charles Ifejika *was* jointly entitled to the design of the original Murdoch prototype lens cleaner which became the registered design. Thus the registered design claim in this case fails while parts of the unregistered design right claim succeed. I cannot end without expressing the hope that the parties now take the time and effort to settle what remains of this bitter dispute once and for all. In the biblical story of Esau and Jacob, Jacob steals his brother's birthright. It leads to a bitter dispute which lasts for many years but even then the brothers are finally reconciled (Genesis 33:1-20). Victor and Charles Ifejika should now strive to do the same.

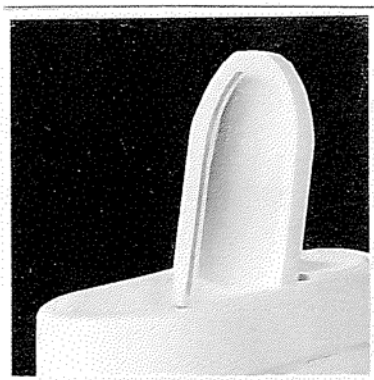
Annex 1 (Registered design)



PERSPECTIVE VIEW WITH PARTS SHOWN
IN SEPARATED CONDITION



SIDE VIEW



VIEW OF TOP IN OPEN CONDITION
TO SHOW MIRROR