

Suggested Answers to the Questions in Chapter 20

1. **The UK unregistered design right has proved to lack clarity, indeed some argue it is unnecessarily complex. By contrast, the registered designs régime offers far better protection. Would it be best to abolish the former and increase protection of registered designs so that designers can rely on the latter?**

The good answer will:

- Demonstrate knowledge of the unregistered designs system – emphasising, however obvious it may seem, that an advantage of unregistered designs (UK and EU) is that no registration is necessary. Discuss the disadvantages, including the fact that UK unregistered design rights are only of limited utility for products where aesthetic quality is a crucial part of the design, because ‘ornamentation’ and ‘surface decoration’ are specifically excluded from their scope. Instead, they protect any aspect of the shape/configuration of the whole or part of an article, including internal elements. Protection lasts between 10 and 15 years. The Community unregistered design right protects designs involving texture, colour, and materials, i.e. the appearance of a product, including two-dimensional designs which are new and have individual character. The Community unregistered design right provides only three years of protection, however.
- Explain that, by contrast, registration is required in the case of UK and EU registered designs. Although there is no examination as part of registration, there are criteria that must be satisfied (but which are only tested post-grant, via an invalidation challenge by a competitor). Once granted, a registered design lasts for five years but can be renewed on four further occasions, giving a maximum term of protection of 25 years. A registrable design need not have ‘eye appeal’ but must create a ‘different overall impression’ from what was previously available. The positive criteria of novelty and individual character are to be assessed through the eyes of the ‘informed user’—*Green Lane Products Ltd v PMS International Group Ltd*; *The Procter & Gamble Company v Reckitt Benckiser (UK) Ltd*; *Senz*. The design must also satisfy the negative criteria: exclusions from protection, i.e. features ‘solely dictated by the product’s technical function’, and ‘must fit’ features are ineligible (*Dyson v Vax* and the recent CJEU case of *DOCERAM v CeramTec*).
- Conclude by reflecting on the complexity of the unregistered designs system. At the same time, refer to the academic view of Ashby by noting the apparent weakness of the registered design system as evidenced in the UKSC case of *PMS v Magmatic*, where the ‘Trunki’ design was held not to be infringed by a very similar product. Overall there are grounds to suggest that the design system would benefit from reform to simplify it and to clarify what exactly is protected.

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2. Having examined the UKSC ‘Trunki’ case in detail, do you think the case offends against common sense? Many members of the public—parents and children—were surprised that such an iconic product was not protected from a ‘copycat’ product. Should design protection take into account such concerns?

The good answer will:

- Begin by discussing UK and EU registered designs: although there is no examination as part of registration, there are criteria that must be satisfied (but which are only tested post-grant, via an invalidation challenge by a competitor). Once granted, a registered design lasts for five years but can be renewed on four further occasions, giving a maximum term of protection of 25 years. A registrable design need not have ‘eye appeal’ but must create a ‘different overall impression’ from what was previously available. The positive criteria of novelty and individual character are to be assessed through the eyes of the ‘informed user’—*Green Lane Products Ltd v PMS International Group Ltd*; *The Procter & Gamble Company v Reckitt Benckiser (UK) Ltd*; *Senz*. The design must also satisfy the negative criteria: exclusions from protection, i.e. features ‘solely dictated by the product’s technical function’, and ‘must fit’ features are ineligible (*Dyson v Vax* and the recent CJEU case of *DOCERAM v CeramTec*).
- Focus on the key case of *PMS v Magmatic* in the UKSC, which involved the issue of infringement of a Community Registered Design or CRD. Magmatic had registered a CRD for the ‘Trunki’: a suitcase shaped like a horned animal that allowed children to sit on it and be pulled along by their parents. PMS produced a rival (cheaper) suitcase—Kiddee—available in different shapes, including a case shaped and decorated like an insect, and one shaped and decorated like a tiger.
- Note that the Court of Appeal, overruling an earlier infringement decision by the High Court, held that the rival product design by PMS—the Kiddee suitcase—did not infringe the Trunki design. The UKSC agreed with the Court of Appeal.
- Refer to Lord Neuberger in the UKSC, who remarked that there were three key points that determined the infringement claim. The first concerned the ‘overall impression’ of the design—in this case the impression was of a horned animal, and the High Court had erred in not giving this impression its proper weight. The Court of Appeal had rectified this by holding that if a CRD is of a horned animal, any infringing item must make the same impression. The second concerned the ‘absence of decoration’ on the CRD. Here, although the UKSC left open the question of whether this minimalist effect was a deliberate part of the CRD, the court considered that this absence of decoration reinforced the overall impression of a horned animal. The third element the UKSC highlighted concerned the ‘two-tone’ colouring of the CRD—grey for the body and

horns, and black for the wheels and spokes. The High Court had focused solely on the shape, but the Court of Appeal (and the UKSC in approval) stated that the colour contrasts were potentially significant when considering infringement. The main Trunki features, i.e. the wheels and horns (handles), stood out in the design drawing. By contrast, the Kiddee case had wheels that were almost entirely covered; and, unlike the Trunki, the handles of the Kiddee had the same colour as the body of the case. Lord Neuberger further remarked that the drawings/images filed as part of the registration are not purely descriptive, they are determinative as to what is protected (in the same way that a patent's claims are)—in other words, the drawings/images/representations define the monopoly. Following the EUIPO's own guidance, Lord Neuberger further stated that where a design drawing is filed showing specific colours, those colours are deemed to be claimed; whereas a black and white drawing/photo is deemed to cover all colours. In light of this, it was natural to infer that the colour contrasts were a deliberate element of the design—and that the design was limited to contrasting colours. Thus, the CRD was held to claim not merely a shape, but a shape with two contrasting colours (grey/black). The Kiddee suitcase lacked the contrasting colours and this was a factor to take into account when considering infringement. The UKSC agreed with the Court of Appeal approach in finding no infringement.

- Conclude by reflecting on academic commentary by Ashby and the ultimate question of whether such 'copycat' products should be held to infringe – even if they do not infringe on the strict reading of the law – or whether this would be damaging for competition.