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Bartłomiej Orawiec

What is the design protected by a CAD rendered Registered Community Design?

Jakie wzory są chronione przez zarejestrowane wzory wspólnotowe w postaci obrazów przygotowanych przy wykorzystaniu programu komputerowego Computer Assisted Design (CAD)?

On 9 March 2016, the UK Supreme Court delivered its first ever judgment on a Registered Community Design (RCD) in *PMS International Group Plc v Magmatic Limited*¹. The Supreme Court upheld the decision of the Court of Appeal that the RCD consisting of six grayscale images of ‘Trunki’ prepared by a 3D Computer Assisted Design (CAD) program is not infringed by the respondent’s ‘Kiddee Cases’.² Also, it stated *obiter* that as a matter of principle, the absence of decoration can be a feature of a RCD but it failed to provide an explanation of how a designer can, in practice, claim the positive absence of decoration. In addition, despite the UK Intellectual Property Office (IPO)’s request, the court did not make a reference for a preliminary ruling to CJEU.³

Robert Law, the founder of Magmatic Limited (“Magmatic”) is known for a design of a ride-on suitcase for children (the Rodeo), for which he won a prize in 1998. After updating the design, he applied to register it at the Office for Harmonization in the Internal Market (OHIM), which published it as a RCD (43427-0001) on 28 October 2003. Subsequently, Magmatic commercialized

¹ [2016] UKSC 12, para 1-3 and D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 662.

² *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12.

³ S. Ashby, *Magmatic v PMS: UK Supreme Court says no Community registered design infringement by Kiddee cases*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 7, p. 490-493.

the ride-on suitcases and sold them under the trade mark “Trunki”.⁴ The Trunki suitcase was ‘enormously successful’⁵ – by 2011, 20% of all 3-6 year olds in the UK possessed it.⁶ In 2010, PMS International Group Plc (“PMS”) seeing the success of Trunki decided to produce a similar product, at a lower price, called Kiddee Case (see Figure 2 below).

Figure 1. One of six views from RCD 43427-0001

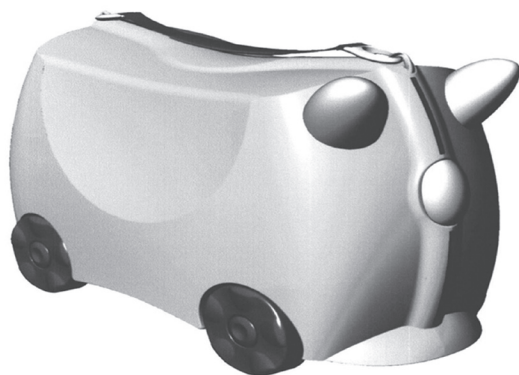


Figure 2. Tiger Kiddee Case



⁴ [2016] UKSC 12, para 2-3.

⁵ [2014] EWCA Civ 181, para 9.

⁶ [2013] EWHC 1925 (Pat), para 16.

In consequence, in 2013 Magmatic commenced proceedings against PMS seeking damages and an injunction alleging that PMS has infringed the RCD by selling in, and importing into the UK and Germany ride-on suitcases under the name “Kiddee Case” with a number of features similar to the RCD.⁷

In the High Court decision, Arnold J held that the Kiddee Case had infringed Trunki RCD, which was a “shape” design with a wide scope of protection. He noted that while some design features of both suitcases were different, the overall impression created by them on the informed user was the same. The permission to appeal was given essentially on just one issue that is whether the surface decoration should be taken into account when assessing “overall impression” and if so whether the Kiddee Cases do not produce on the informed user a different overall impression.⁸

The Court of Appeal overturned the decision of the High Court and continued its unbroken run of not finding infringement of RCDs.⁹ Kitchen LJ found three errors in Arnold J’s judgment i.e. Arnold J (1) ‘failed to give proper weight to the overall impression of the RCD as an animal with horns, which was significantly different from the impression made by the Kiddee Case’, (2) ‘failed to take into account the effect of the lack of ornamentation on the surface of RCD’ and (3) ‘ignored the colour contrast in the RCD between the body and the wheels’.¹⁰ For the purposes of this article, mainly criticisms (2) and (3) will be analysed as they deal with the question ‘what is the design protected by CAD rendered RCD?’

As regards criticism (3), before the judgment of the Court of Appeal, practitioners generally understood that CAD drawings protected solely the shape of the product.¹¹ The Court of Appeal and later the Supreme Court held that the contrasting tone on CAD drawings means something and this cannot be ignored. Justice Arnold (the High Court) knew however that Trunki RCD showed wheels and the strap in black colour and the rest of the suitcase in grey whereas Kiddee Cases had also black, but covered, wheels when making his assessment of overall impression. Even if the design was not shape-only but was shape plus tonal contrasts, it seems unlikely that the High Court would consider it as the

⁷ [2016] UKSC 12, para 3-5.

⁸ [2013] EWHC 1925 (Pat) and S. Ashby, *Magmatic v PMS: UK Supreme Court says no Community registered design infringement by Kiddee cases*, *Journal of Intellectual Property Law & Practice*, 2016, Vol. 11, No. 7, p. 490-493.

⁹ S. Ashby, *The UK Supreme Court and the Trunki case: missed opportunities, mysteries and misunderstood*, *European Intellectual Property Review*, 2016, 38(9), p.527-530.

¹⁰ [2016] UKSC 12, para 21.

¹¹ D. Stone, *Trunki – How did things go so wrong?*, *Journal of Intellectual Property Law & Practice*, 2016, Vol. 11, No. 9, p. 665.

“tipping point” and find that there was no infringement.¹² However, David Stone in his article presented a view that since there are no verbal disclaimers or any usable guidance on what such tonal contrasts mean, there may be cases where some objective meaning is to be given to them in CAD renderings. He went on to say that unless people filing designs intend to claim contrast of tones, they should make sure that CAD renderings have only one colour, even though this may mean a change in practice for them.¹³

As regards criticism (2), when comparing ‘like with like’ an RCD with Kiddee Cases, the Court of Appeal stated that:

“...the impression the [insect version of the Kiddee Case]’s shape creates is clearly influenced by (...) the spots on its flanks. As a result it looks like a ladybird (...). It was, in my judgment, wrong for the judge to eliminate the decoration on the accused design from his consideration entirely because it significantly affects how the shape itself strikes the eye, and the overall impression it gives. At least in the case of this particular registered design, the global comparison necessarily requires account to be taken of the context in which the accused shape appears.”¹⁴

Therefore, the Court of Appeal actually found that RCD included a claim for the absence of surface decoration by pointing to the relevance of, for instance, the spots on the flanks of the ladybird version. By acknowledging the relevance of surface decoration on the Kiddee Case the court has, in fact, acknowledged that the absence of the surface decoration in the RCD was relevant to the comparison and thus it was part of the RCD.¹⁵ In addition the Supreme Court noted that:

“... I accept that the point has some force, in the sense that, unless it included items such as eyes and a mouth, any decoration could well detract from the animal impression, and, even if it consisted of such items, it could be said to distract the observer’s attention from the horns.”¹⁶

¹² S. Ashby, *The UK Supreme Court and the Trunki case: missed opportunities, mysteries and misunderstood*, European Intellectual Property Review, 2016, 38(9), p.527-530.

¹³ D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 673.

¹⁴ [2014] EWCA Civ 181, para 47.

¹⁵ D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 667.

¹⁶ [2016] UKSC 12, para 41.

However, it later tried to deny that in ‘like with like’ comparison the absence of surface decoration in RCD should be taken into account by saying that:

“... *Kitchin LJ* was not raising a free-standing contention that a feature of the [RCD] was that it contained no decoration.”¹⁷

Although the Court of Appeal did not say exactly that “a feature of RCD is that it contains no surface decoration”, it had said that the RCD was “*not adorned with any (...) imagery*.” It should be noted the High Court held that the shape of the Kiddee Case and the RCD created the same overall impression and this was not appealed. Thus, the absence of surface decoration must have been considered as part of RCD or otherwise the comparison would have made no sense. The Supreme Court needed to determine whether the RCD included a claim for the absence of surface decoration because that was the basis on which the permission to appeal was granted. It was not open for to the court to state that the part of its judgment referring to the surface decoration was *obiter*.¹⁸ Lord Neuberger (*obiter*) held that since minimalism or simplicity may be an aspect of a design, the absence of decoration could as a matter of principle be a feature of RCD.

As regards criticism (1), many argue that the first criticism i.e. the horned animal point was wrong because although Justice Arnold did not expressly mention that the RCD created the impression of a horned animal, he did actually take this aspect into account when assessing the shape of the design. It must be noted that the permission to appeal was granted solely on the issue of surface decoration and not on the question of shape alone.¹⁹

There are many advantages of CAD rendering over line drawings, for instance, it is easier to represent volume and gradually changing shapes (such as graduated changes on the flanks of Trunki) with CAD rendering than with line drawings, which can be used to represent e.g. simple boxes. Nevertheless, the Supreme Court failed to give any helpful guidance as to what is protected by CAD, it only ‘somewhat mysteriously’ held that a “*line drawing is much more likely*

¹⁷ [2016] UKSC 12, para 43.

¹⁸ D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 666-668.

¹⁹ S. Ashby, *The UK Supreme Court and the Trunki case: missed opportunities, mysteries and misunderstood*, European Intellectual Property Review, 2016, 38(9), p.529 and D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 673-674.

to be interpreted as not excluding ornamentation than a CAD image”²⁰ hence underlining the fact that line drawing will usually provide the broadest scope of protection. As opposed to the UK domestic design law, which allows for a verbal description stating that the design either includes claim for the absence of surface decoration or it is for the shape of the product only, the Design Regulation only allows to provide a description in RCDs to ‘assist the examiner’, which does not affect the scope of protection ‘as such’ and which does not appear on the register.²¹

Despite the fact that some IP lawyers, including Prof David Musker, Chair of CIPA (*The Chartered Institute of Patent Attorneys*)’s Designs Committee, say that the judgment brings clarity to design protection laws²², others highlight that it “plunges design law into an abyss”²³ and disagree with Lord Neuberger who said that it “is not as if a decision whether the absence of ornamentation in this particular RCD would be of much assistance in other cases.”²⁴ It is argued that as a result of the judgment the competitors, who wish to mimic a successful design shape, will be able avoid infringement of design right by decorating their product in a different way than the registered design.²⁵ This, in effect, may reduce the incentive for designers to produce new and innovative products because they may fear that competitors producing a similar product will be able to reap the rewards.²⁶

Many RCDs are registered using CAD images and it is somewhat disappointing for UK IPO, designers and legal practitioners that the Supreme Court having a chance to ask CJEU for guidance on how such images in designs ought

²⁰ [2016] UKSC 12, [2016] Bus. L.R. 371 at 46 and S. Ashby, *The UK Supreme Court and the Trunki case: missed opportunities, mysteries and misunderstood*, *European Intellectual Property Review*, 2016, 38(9), p.530.

²¹ D. Stone, *Trunki – How did things go so wrong?*, *Journal of Intellectual Property Law & Practice*, 2016, Vol. 11, No. 9, p. 671-672.

²² Prof. D. Musker in *Chartered Institute of Patent Attorneys, Trunki Suitcase Ruling clarifies design law, say patent attorneys*, available on: <http://www.cipa.org.uk/policy-and-news/latest-news/trunki-suitcase-ruling-clarifies-design-law-say-patent-attorney/> last accessed on: 20 April 2018.

²³ D. Macdonald, OBE., CEO of ACID *Supreme Court Rules Against Trunki*, - <https://www.acid.uk.com/supreme-court-rules-trunki/> last accessed on: 20 April 2018.

²⁴ [2016] UKSC 12 para 50.

²⁵ E. McClure & A. Shaw, *A hard case: The Supreme Court rules on European design law for first time*, available on [https://www.newLawjournal.co.uk/content/hard-case](https://www.newlawjournal.co.uk/content/hard-case), last accessed on: 20 April 2018.

²⁶ S. McVey, *What’s the difference between an animal with horns and an animal with ears? A cautionary tale of protecting original designs*, available on <https://www.gordonsllp.com/whats-the-difference-between-an-animal-with-horns-and-an-animal-with-ears-a-cautionary-tale-of-protecting-original-designs/> last accessed on : 20 April 2018.

to be interpreted, chose not to do so.²⁷ It is argued that the court was wrong because despite the fact that it identified the main issue on appeal to be “how to interpret particular images on a particular [RCD]”, it held that there was no issue of EU law raised.²⁸ It may seem from the Lord Neuberger’s judgment²⁹, in which he has mentioned that it is for the applicant of RCD to determine what is filed, that he has mistakenly considered the meaning of RCD to be an issue of practice rather than of law. If it was really a reason for not referring the matter to CJEU, the Supreme Court ought to have expressly said that, especially that the Court of Appeal overturned the decision of the trial judge because he had erred in law. Nonetheless, it seems more plausible that the Supreme Court has identified an issue of law but not an issue of EU law.³⁰ If that was the case, then again, it was mistaken because an RCD is an EU-wide right and thus must be an issue of EU law.³¹

It should be noted that there are some benefits of referring a matter to the CJEU. It is not only an expert for this subject matter but it also supports uniformity of interpretation and sometimes decides on the basis of policy considerations, which national courts have no access to. In addition on any reference to CJEU, European Commission as well as Member States have right to intervene without having to prove an interest. Therefore CJEU not only decides a case between two or more parties but it also has an access to the views and positions of the Member States that should lead to a more harmonized position on what the law should be. Furthermore, there are Advocates-General, who provide CJEU with neutral, expert opinion in EU law as well as analyse legislative texts in various language versions and preparatory papers behind the legislation.³²

A few months after the judgment of the Supreme Court, the UK Intellectual Property Office (IPO) has released guidance on filing registered designs following *Trunki* case. It stated *inter alia* that it is up to the applicants to select a form of representation, which is most suited to their needs. Applicants, who wish to protect shape-only are advised to use simple line drawings, without any colour

²⁷ S. Ashby, *Magmatic v PMS: UK Supreme Court says no Community registered design infringement by Kiddee cases*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 7, p. 493.

²⁸ D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 676-677.

²⁹ [2016] UKSC 12 para 32.

³⁰ [2016] UKSC 12 para 59.

³¹ D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 677.

³² D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 675.

or tonal differences, and without any visible surface features or decoration. As for CAD representations however, they may represent “shape and more” i.e. light reflection or shading.³³ However no detailed explanation is provided in this regard. It seems that IPO, in its guidance, has disregarded the point made *obiter* by Lord Neuberger that “*a line drawing is much more likely to be interpreted as not excluding ornamentation than a CAD image.*”³⁴

To sum up, it remains unclear what is the design protected by a CAD rendered RCD. The Court of Appeal and later the Supreme Court had a chance to clarify the law in this regard and to refer the question to CJEU but they missed it. Some argue that as a result of the decision in *Trunki* case applicants, in order to ensure that their designs are appropriately protected, will need to file several applications, which will need to cover different combinations of colour, shape, ornamentation and other features.³⁵

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³³ UK statutory guidance: DPN 1/16: Guidance on use of representations when filing Registered Design application, Published 1 June 2016, available on: <https://www.gov.uk/government/publications/designs-practice-notice-dpn-116>, last accessed on: 20 April 2018.

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Streszczenie

PMS International Group Plc v Magmatic Limited [2016] UKSC 12 to pierwszy wyrok Sądu Najwyższego Wielkiej Brytanii w sprawie zarejestrowanego wzoru wspólnotowego, w którym Sąd Najwyższy stwierdził, że PMS Kiddee Cases nie naruszyły prawa do zarejestrowanego wzoru wspólnotowego składającego się z 6 obrazów przedstawiających „Trunki” w różnych odcieniach szarości, które zostały przygotowane przy wykorzystaniu programu komputerowego Computer Assisted Design (CAD). Niestety Sąd Najwyższy, który miał możliwość zwrócenia się do Trybunału Sprawiedliwości Unii Europejskiej o wskazówki (ang. guidance) dotyczące tego, jak należy interpretować tego typu obrazy w przypadku zarejestrowanych wzorów wspólnotowych, nie uczynił tego, pomimo iż wiele zarejestrowanych wzorów wspólnotowych rejestrowanych jest obecnie przy wykorzystaniu tego rodzaju obrazów.

SŁOWA KLUCZOWE: Zarejestrowane wzory wspólnotowe – prawo Unii Europejskiej – Trunki – CAD – Sąd Najwyższy Wielkiej Brytanii

Summary

PMS International Group Plc v Magmatic Limited³⁶ was the first judgment of the UK Supreme Court on a Registered Community Design. The court held that PMS Kiddee Cases do not infringe the Trunki CAD rendered Registered Community Design. Unfortunately, the Supreme Court having a chance to ask CJEU for guidance on how such images in designs ought to be interpreted, chose not to do so even though many RCDs are registered using CAD images.

KEY WORDS: Registered Community designs – EU law – Trunki - CAD – Supreme Court

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³⁶ [2016] UKSC 12, para 1-3 and D. Stone, *Trunki – How did things go so wrong?*, Journal of Intellectual Property Law & Practice, 2016, Vol. 11, No. 9, p. 662.