



Neutral Citation Number: [2011] EWCA Civ 1206

Case No: A3/2010/2498

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE (CHANCERY DIVISION)
MR. JUSTICE ARNOLD
HC10C00126

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 27/10/2011

Before :

LORD JUSTICE JACKSON
LADY JUSTICE BLACK
and
SIR ROBIN JACOB

Between :

DYSON LIMITED
- and -
VAX LIMITED

Appellant

Respondent

Mr. Henry Carr QC and Mr. Hugo Cuddigan (instructed by **Wragge & Co LLP**) for the
Appellant
Mr. Iain Purvis QC and Ms. Anna Edwards-Stuart (instructed by **EMW Law LLP**) for the
Respondent

Hearing dates : 26 July 2011

Approved Judgment

Sir Robin Jacob (giving the first judgment at the invitation of Jackson LJ):

1. Dyson appeals, with the Judge's permission, from a judgment of Arnold J of 28th July 2010, [2010] EWHC 1923 (Pat). He held that Dyson's UK registered design No. 2,043,779 (whose validity was not impugned) was not infringed by Vax's Mach Zen C-91 MZ vacuum cleaner.
2. Dyson's case was argued by Mr Henry Carr QC and Mr Hugo Cuddigan, Vax's by Mr Iain Purvis QC and Ms Anna Edwards-Stuart.

The Statutory Provisions

3. It is common ground that the scope of protection of a UK registered design is now governed by the Registered Designs Act 1949 as very substantially amended to implement the Designs Directive 98/71. As usual neither side saw any point in referring to the amended Act. What matters is the text of the Directive. So far as is material Arnold J set it out and I do not propose to do it all over again.

The Registered Design

4. The subject-matter of the registered design is strictly that shown in the representations on the certificate of registration. These consist of various views of what is essentially the actual Dyson DC02, subject to this: that the real thing has a small departure from the design as registered in that its back is provided with slatted air holes whereas the back of the design as registered is smooth and unperforated. For practical purposes, bearing this in mind, it was useful to compare the actual DC02 with the Mach Zen. Both sides did so in the course of argument.
5. Annex 1 to this Judgment consists of the photographs of the certificate of registration. Although these are in colour it is common ground that the colour (of both the registration and the alleged infringement) should be ignored for the purposes of considering the scope of registration. This is because the statement of novelty says:

“The features of the design for which novelty is claimed reside in the shape and configuration applied to the article as shown in the representations.”

In order to obviate any risk that colour might enter into the comparison, the physical articles we compared were spray painted grey all over (including those parts visible through the clear dust collecting bins).

The Mach Zen

6. Annex 2 to this Judgment consists of a series of photographs of the Mach Zen, each one corresponding to a photograph of the registered design. I should point out that unless one has very good copies the photographs do not convey the full visual flavour of the two articles. It is essential in cases involving registered designs (and trade marks for that matter) for the court to have proper reproductions – otherwise the court wastes time. Those responsible for conducting such cases should take personal responsibility for this – it is not a matter to be left to secretaries or trainees.

The Key Legal Question

7. This is apparently straightforward. It is simply whether the Mach Zen “does not produce on the informed user a different overall impression”, Art. 9(1).

The Evidence

8. Not only is that question apparently straightforward, but, I think, it actually is. It is possible to produce much elaborate argument and evidence – some of which seems to touch upon metaphysics – but generally none of that matters. What really matters is what the court can see with its own eyes. I said (with the other members of the court concurring) as much in *Procter & Gamble v Reckitt Benckiser* [2007] EWCA Civ 936, [2008] Bus LR 801:

[3] The most important things in a case about registered designs are:

- (i) The registered design;
- (ii) The accused object;
- (ii) The prior art.

And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has “individual character” or what the “overall impression produced on an informed user” is. But “it takes longer to say than to see” as I observed in *Philips v Remington* [1998] RPC 283 at 318. And words themselves are often insufficiently precise on their own.

9. I added this:

[4] It follows that a place for evidence is very limited indeed. By and large it should be possible to decide a registered design case in a few hours.

10. It is highly desirable in a registered (or indeed unregistered) design action that, if permission to give expert evidence is to be given at all, the precise ambit of that evidence should be defined. This was the procedure adopted in the present case by order of Arnold J who heard the Case Management Conference. The expert should be told what question or questions he is addressing and confine himself to these. The same is often true in other cases: left to their own devices experts all too often address questions of their own choosing.
11. It is, of course, necessary to consider the registered design in relation to what went before (the “existing design corpus”, see Recital 13). An expert can assist in relation to this, but seldom if ever will this be controversial. In the present case there was no matter calling for extensive expert evidence. There was a sterile controversy as to whether one considered the corpus to consist of cylinder vacuum cleaners, as Dyson contended or nothing (as Vax contended) but that was hardly a matter for expert

evidence at all. Arnold J concluded (and there is no challenge) that the corpus was cylinder cleaners and that these by and large consisted of sledge or tank types.

12. Whatever the corpus, the registered design was a great departure from that which went before. That was obviously so, as was rightly admitted in the Defence and was not disputed in the expert evidence. There was no dispute between the parties about the prior art as shown for example in the various Argos catalogues we were shown.
13. Expert evidence can of course be relevant to “the degree of freedom of the designer in developing his design” which, by Art. 9(2) must form part of the assessment of the scope of protection. The evidence can take two forms – technical (typically why a thing or part of a thing must be shaped at least broadly in a particular way so as to perform its function) or from the market to demonstrate that there is design freedom in practice. Again it should normally be practical to agree these matters.

The Informed User

14. There was no dispute as to the characteristics of this notional character. Borrowing from the Judgment:

[19] In Case T-9/07 *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal Market* [2010] ECR II-0000 the General Court of the European Union held at [62]:

“It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed”

[20] In Case T-153/08 *Shenzhen Taiden v Office for Harmonisation in the Internal Market* [2010] ECR II-0000 the General Court held:

“46. With regard to the interpretation of the concept of informed user, the status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended.

47. The qualifier ‘informed’ suggests in addition that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include,

and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

48. However, contrary to what the applicant claims, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product's technical function from those which are arbitrary."

15. The important point to note is that the informed user is reasonably discriminatory ("a relatively high degree of attention"): not the same person as the average consumer of trade mark law (see also *P&G* at [24-26]).

Principles to be applied by the Court of Appeal

16. I set these out in *P&G*:

[36] There was no dispute as to these. It must be shown that the Judge has gone wrong in principle, see, e.g. *Designers Guild v Russell Williams* [2001] FSR 113 where Lord Hoffmann said, speaking of the closely analogous question of substantiality in relation to copyright infringement:

"because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle."

See also *Assicurazioni v Arab Insurance* [2003] 1 WLR 577.

17. Mr Carr accepted he had to show an error of principle.

The degree of design freedom

18. Art. 9(2) speaks of the "degree of freedom of the designer in developing his design". That to my mind plainly refers to the degree of freedom of the designer of the registered design, not the degree of freedom of the designer of the alleged infringement. In practice there will seldom be any difference: only if there is some sort of significant advance in technology will the freedom change between the date of creation of the registered design and the date of creation of the alleged infringement. Mr Carr complains that in several places the Judge referred to the degree of freedom of the designer of the Mach Zen (e.g. [65] and [73]). Technically I think the Judge should have focussed only on the degree of freedom surrounding the design of the DC02. But I cannot see that it matters. For there was no evidence of any change in degrees of freedom between the date of design of that and the date of design of the Mach Zen.
19. What the Judge did observe was that the degree of freedom may vary according to the technical specification of the product being designed. That seems true – for instance a

more powerful machine will require a larger (and therefore more bulky) motor. And a heavier machine will be more difficult to move and may require bigger wheels to overcome obstacles.

20. It follows that I do not think the Judge made any relevant error of principle when considering the degree of design freedom when he referred to the freedom of the designer of the Mach Zen.
21. Mr Carr put his suggestion of error of principle another way. It came out in a particularly striking interchange between him and Black LJ:

LADY JUSTICE BLACK: But a lot of what the judge was saying was a better or cheaper way of doing it as opposed to this was the only way of doing it? Is that your complaint?

MR. CARR: That is a part of our complaint. What the judge ends up by saying is that all designs are compromises and because this is a particularly good compromise that, I think, given a high specification, amounts to some kind of restriction on design freedom. If you go down that approach, you are going to penalise ingenious and innovative designs, which is what he has done.

LADY JUSTICE BLACK: The better your design the more people will say, "It is only going to be worse if I do it a different way".

MR. CARR: Precisely; the better your design, according to the judge, the less design freedom, and the narrower your protection, which also cannot be right.

22. I do not read the Judgment in that way at all. Nowhere does the Judge say anything of the sort. All he did was to go through the list of nine similarities relied upon by Dyson to consider to what extent they had technical significance and thus affected the degree of design freedom. That he was enjoined to do by Art. 9(2).
23. Thus, for instance, he found on the evidence that:
 - (i) there is a technical reason for a 45° inclined bin [65];
 - (ii) there is a technical reason for a transparent bin [68-70];
 - (ii) there is a technical reason why large wheels are used at the rear of the machine [72-75];
 - (iii) there is technical reason for having the wheels spaced apart as far as possible [[75-76];
 - (iv) there is a technical reason for wheel arches which are prominent and for the incorporation of buttons into these [76-79]

24. It is not necessary to go further. The other five similarities are dealt with in the same way.
25. Mr Carr submitted that the Judge made too much of these technical reasons, leading him to downplay the overall effect. He showed us other machines where different technical solutions had been used, as for instance by using a “full” beeper instead of a transparent bin or casters instead of rear wheels. He emphasised that these showed there was really a lot of design freedom and that accordingly the Judge had downplayed the nine features relied upon too much.
26. The upshot of Mr Carr’s submission was this: that in reality there was a lot of design freedom and, because the DC02 was a major departure from anything that went before, its degree of protection should be correspondingly wide. The Judge had lost the wood (the general overall impression of this strikingly new design) for the trees (the detail of implementation, such things as the actual shape and proportions of the transparent bin, the detail of the arcuate handle, the detail of the wheel arches and so on).
27. He submitted that the Judge, even though he explicitly held that the registered design is “strikingly different” from the existing design corpus [58] had failed to apply the established principle that:

...if a new design is markedly different from anything that has gone before, it is likely to have a greater overall visual impact than if it is “surrounded by kindred prior art.” (HHJ Fysh's pithy phrase in *Woodhouse* at [58]). It follows that the “overall impression” created by such a design will be more significant and the room for differences which do not create a substantially different overall impression is greater. So protection for a striking novel product will be correspondingly greater than for a product which is incrementally different from the prior art, though different enough to have its own individual character and thus be validly registered (*P&G*, [35(iii)], see also Recital 13 and *Grupo Promer* at [67] and [72]).

28. Mr Purvis submitted that the Judge did not ignore this principle – he indeed allowed for it in his concluding paragraph:

[94] Even on the basis that the Registered Design is entitled to a fairly broad scope of protection because of the differences between the Registered Design and the existing design corpus and because of the degree of freedom of the designer, in my judgment the overall impressions produced by the two designs are different.

29. Mr Purvis also took us through a comparison, picture by picture, of the DC02 and the Mach Zen. The reader can do the same from the Annexes to this judgment though we had the advantage also of the actual articles. One sees substantial differences. I pick a few of the more significant:

- a) Apart from having an arcuate portion, the wands are quite different, not least because the Mach Zen includes accessories whereas the DC02 does not.
 - b) The pictures of the DC02 shows a flowing outer portion starting as part of the wheel arch behind the wheel, running over the wheel, sloping down to the front where it forms a “bumper” before flowing back on the other side. The Mach Zen has a wheel arch, but it is just over the wheel. It does not extend behind it. And far from flowing all round the machine, it terminates by the wheel and is replaced by a “running board.” Moreover the place for fixing the hose is different (on top of the DC02 and on the front low down on the Mach Zen).
 - c) The bins, although transparent, are quite different. Not only are the proportions different (the Mach Zen is taller) but they are differently shaped because the Mach Zen is stepped. And the cyclones you can see inside are shaped quite differently, one from the other. The handles of the bins are also very different, that on the DC02 being short and transparent so as to be unobtrusive, almost invisible, whereas the bin handle of the Mach Zen is a prominent feature, much longer and “gutter” shaped (a feature carried over into the arcuate rear handle.)
 - d) The Mach Zen has the hose portion on one side of the “running board” – there is nothing like it on the DC02.
 - e) The rear view of the two articles is very different, that of the DC02 being plain and smooth whilst that of the Mach Zen is complicated with a ribs and a much more prominent (and differently positioned) cavity for the plug.
 - f) Views from the front are different – the different bin handle, the place for fixing the hose, the relative proportions of width and height and so on.
 - g) The top views are very different, the top portion of the “shell” of the Mach Zen is keyhole shaped and very different from that of the DC02 which is much broader.
30. On the basis of these differences Mr Purvis submitted that the Judge was entitled to conclude that the Mach Zen did produce on the informed user a different overall impression. Moreover the list of nine features relied upon by Dyson is far too general. Thus it is no good saying “both have transparent bins through which the cyclone shroud is visible” when the reality is that both the bins and shrouds are very different in shape. You cannot take features of a design, turn them into general words and then treat those words like a patent claim.
31. I accept Mr Purvis’s submissions. What the Judge said was:

[93] In my view the informed user would notice that there were certain similarities between the two designs, in particular the inclined transparent bin, the large rear wheels and the

curved longitudinal central handle. For the reasons given above, the informed user would not consider these similarities to be particularly significant. The informed user would also notice many differences between the respective designs, including features present in the Registered Design which are not present in the Mach Zen and vice versa. For the reasons explained above, the informed user would consider a number of these differences to be significant, particularly the rear view, the hose connector position, the bin handle, the wand handle, the cut-away feature and bumper of the Registered Design and the asymmetry of the Mach Zen. The overall impression produced by the Registered Design is smooth, curving and elegant. The overall impression produced by the Mach Zen is rugged, angular and industrial, even somewhat brutal.

32. I can see nothing wrong with that conclusion. Indeed even if the Judge had wrongly discounted the sloping transparent bin, the large rear wheels and the curved handle too much (assuming a greater degree of freedom than he allowed for) so I was free to form my own opinion, I would have come to the same conclusion. An informed user looking at the two designs would indeed notice the difference between them because the overall impressions are different: “smooth curving and elegant” versus “rugged angular and industrial.” These are different designs.
33. Accordingly I would dismiss the appeal.
34. I would only add one matter, irrelevant in this case. In *P&G* I drew attention to the difference between Recital 14 and Art. 6 of the Design Regulation (EC 6/2002). The former uses the expression “the design clearly differs” whereas the latter merely says “differs.” “Clearly” does not reappear. I thought the difference was deliberate and so had some significance. I was wrong, though that does not affect the main reasoning in *P&G*. The difference in wording is merely the result of sloppy drafting as has been pointed out by Dr Alexander von Mühlendahl in *Design Protection in Europe, 3rd Edn.* (2009 at pp.232-3). The same of course applies to the identical wording in the Directive (Recital 13 and Art. 9).

Lord Justice Jackson :

35. I agree that this appeal should be dismissed, for the reasons given by Sir Robin Jacob.
36. I only wish to add one comment in relation to expert evidence. In *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] Bus LR 801 Jacob LJ gave valuable guidance as to the limited role of evidence in registered design cases. At paragraphs 3-4 he said this:

“3. The most important things in a case about registered designs are: (i) the registered design; (ii) the accused object; (iii) the prior art. And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has ‘individual character’ or what the ‘overall impression produced on an informed user’ is. But ‘it takes longer to say than to see’ as I

observed in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [1998] RPC 283, 318. And words themselves are often insufficiently precise on their own.

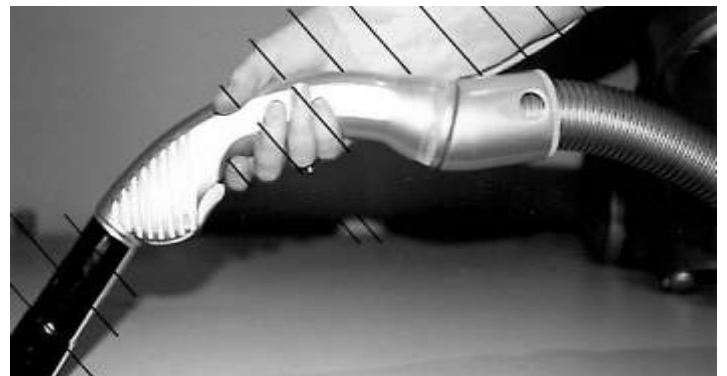
4. It follows that a place for evidence is very limited indeed. By and large it should be possible to decide a registered design case in a few hours. The evidence of the designer, e.g. as to whether he/she was trying to make, or thought he/she had made, a breakthrough, is irrelevant. The evidence of experts, particularly about consumer products, is unlikely to be of much assistance: anyone can point out similarities and differences, though an educated eye can sometimes help a bit. Sometimes there may be a piece of technical evidence which is relevant – e.g. that design freedom is limited by certain constraints. But even so, that is usually more or less self-evident and certainly unlikely to be controversial to the point of a need for cross-examination still less substantial cross-examination.”

37. The only matter upon which expert evidence was required, or indeed was admissible, in this case was the extent of the technical constraints upon design freedom.
38. It is anticipated that next year CPR Part 35 will be amended in a number of respects. One amendment will require a party, on a permission application for expert evidence, to specify the issues which the expert will address. Another amendment will encourage, but not compel, any court giving permission for expert evidence to specify the issues which the experts should address.
39. Courts already have the power to limit and focus expert evidence. If they do so more often (which I hope will be the effect of the forthcoming rule amendments) substantial costs will be saved.

Lady Justice Black:

40. I agree with both judgments.

Annex 1
The representations of the Registered Design in monochrome



Annex 2
Photographs of the Mach Zen

