

**IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION (PATENTS COURT)
The Hon Mr Justice Arnold
[2013] EWHC 1925 (Pat)**

Royal Courts of Justice
Strand, London, WC2A 2LL
28/02/2014

B e f o r e :

**LORD JUSTICE MOSES
LADY JUSTICE BLACK
and
LORD JUSTICE KITCHIN**

Between:

Magmatic Ltd

**Claimant/
Respondent**

- and -

PMS International Group Plc

Defendant/Appellant

**Michael Hicks and Jonathan Moss (instructed by Briffa)
for the Claimant/Respondent
Mark Vanhegan QC and Chris Aikens (instructed by Gordons Partnership LLP)
for the Defendant/Appellant**

Hearing date: 21 January 2014

HTML VERSION OF JUDGMENT

Crown Copyright ©

Lord Justice Kitchin:

Introduction

1. This appeal concerns a dispute about the scope of Community Registered Design No. 43427-0001 ("the CRD") for ride-on suitcases for young children.
2. The claimant ("Magmatic") makes and sells ride-on suitcases under the trade mark Trunki. The defendant ("PMS") imports and sells similar products under the trade mark Kiddee Case. In this action Magmatic asserted that these dealings by PMS infringed the CRD, its UK unregistered design rights in the design of the Trunki and its copyrights associated with the packaging for the Trunki.

3. The action came on for trial before Arnold J in June 2013. At that point PMS conceded one of the copyright claims but disputed all of the other allegations made against it. It also contended that if the scope of protection of the CRD was broad enough to encompass the Kiddee Case, then the CRD was invalid over an earlier design called the Rodeo.
4. The trial lasted for four days and in his clear and concise judgment dated 11 July 2013, Arnold J found that PMS had infringed the CRD and the design right in four of the six designs the subject of the claim. The claim for infringement of copyright failed, save in so far as it had been conceded by PMS at the outset of the trial.
5. On this appeal, brought with the permission of the judge, PMS contends that the judge fell into error in finding infringement of the CRD. It argues that the judge wrongly interpreted the CRD and improperly excluded from his consideration various aspects of the design of the Kiddee Case.

The background

6. The background facts relevant to this appeal are not in dispute and may be summarised as follows. The Trunki was conceived and designed by a talented young designer called Mr Robert Law. In 1997 Mr Law was studying product design at the University of Northumbria and decided to enter the competition for the BASF/Institute of Materials Design Award for 1998. The theme of the competition that year was "a design for luggage".
7. Mr Law had the idea of designing a ride-on suitcase for children using established technology for the manufacture of adult suitcases. Mr Law's design was called the Rodeo and it won the award, beating around 120 other entries. The presentation of the award was made at a public ceremony in the course of which the design of the Rodeo was disclosed. It had a relatively simple shape with straight sides, a curved top and a curved front and rear. The case was opened by two clasps, one at the front and one at the rear, and it had an elongated dumb-bell shaped handle at the top of the front. This handle was attached to a pull out strap.
8. From 1997 Mr Law continued to develop his design until, in 2003, he arrived at the first design of the Trunki. He called this design the Mark I and on 20 June 2003 Magmatic, a company founded by Mr Law, applied for the CRD. On 28 October 2003 the CRD was published. The indication of the product given in the CRD is "suitcases" and the CRD itself consists of six representations showing the exterior of the case from various angles and perspectives. They are reproduced in the [Annex](#) to this judgment. As the judge recognised, one of the striking features of the CRD is that the handles and the clasps give the suitcase the appearance of a horned animal.
9. Trunki suitcases have been sold since 2004. Initially they were made and sold under licence by a company called Toyline International UK Ltd but since about 2006 they have been made and sold by Magmatic itself. The Trunki has been enormously successful. Its design has progressed through various iterations to the Mark IV and it has won numerous awards. Magmatic estimated that in 2011 approximately 20% of all three to six year olds in the UK possessed a Trunki and the product is now sold in 97 different countries.
10. PMS makes and sells a range of toys in the discount sector of the market. Its managing director, Mr Beverley, frankly explained that he saw the Trunki when travelling, recognised its qualities and formed the view that there was a gap in the market for a discount version which PMS could exploit. Mr Beverley thereupon approached various toy designers and manufacturers in China and in due course they designed and produced the Kiddee Case which PMS began to sell in late 2012. It was sold in two basic versions, an animal version with handles formed to look like ears and an insect version with handles formed to look like antennae. Each version comes in a number of varieties which have different graphical designs on its surfaces: tiger, leopard, cow, pig, ladybird and bee.
11. On 18 February 2013 Magmatic commenced these proceedings alleging, inter alia, that dealings in the Kiddee Case infringed the CRD under Council Regulation (EC) No 6/2002 ("the Regulation"). Photographs of the basic versions of the Kiddee Case corresponding to the six images of the Trunki in the CRD are also contained in the [Annex](#) to this judgment. The argument before us focused on the particular varieties of the Kiddee Case which are there depicted, that is to say the ladybird and tiger, and I shall do the same in this judgment, it being

accepted that this is sufficient to deal with the issues arising on this appeal.

The judgment

12. The judge began by considering the Rodeo. He held that this had been disclosed to the public at the award ceremony and that it was possible that people connected with the luggage trade attended the ceremony and saw it. It followed that the design of the Rodeo had been made available to the public.
13. The judge then explained that it was common ground that since the Rodeo, the CRD and the Kiddee case were all ride-on suitcases for a child from 3 to 6 years old, the informed user was such a child and also a parent, carer or relative. The judge had considerable doubt whether the child was indeed an informed user and, for my part, I agree with him. These products are likely to be selected and bought by an adult, though perhaps at the request of a child, and then used by a child under the supervision of an adult. Be that as it may, the parties were agreed that the appeal before this court should proceed on the basis that that the informed user is a parent, carer or relative.
14. This brought the judge to the design corpus and the scope of the CRD. The informed user would, he held, be aware of a range of clamshell suitcases, though not the Rodeo, given its relative obscurity. This user would therefore know of clamshell cases with:
 - i) substantially rectangular bases;
 - ii) clasps on the front and rear;
 - iii) four wheels, one on each corner;
 - iv) a ridge where the clamshell portions meet, such ridge running along the front, top and rear side of the case;
 - v) a strip located between the two clamshell portions which protrudes from the case so that it is approximately level with the top of the ridge; and
 - vi) eyelets at the top front and top back of the case.
15. The judge thought the CRD represented a significant departure from this design corpus because it created a significantly different overall impression, partly due to the overall combination of features but also because the horns and shape and positioning of the clasps of the CRD were strikingly different from anything in the design corpus. Having regard to these differences and the considerable degree of freedom available to the designer, the judge held that the CRD was entitled to a relatively broad scope of protection.
16. The judge next considered the overall impressions of first, the CRD and the Rodeo and second, the CRD and the Kiddee Case. The former was relevant in light of the contention advanced by PMS that the overall impression of the Rodeo was no more different from the overall impression of the CRD than was the overall impression of the Kiddee Case. Accordingly, so PMS continued, if the Kiddee Case was an infringement of the CRD then the CRD must itself be invalid for lack of novelty. This argument, although advanced as a squeeze, nevertheless required the judge to carry out a comparison of the CRD and the Rodeo, which he duly did. After summarising the similarities and differences, he expressed his conclusion in these terms, once more attaching importance to the appearance of the CRD and the impression of a horned animal that it creates:

"64. In my judgment the informed user would notice both similarities and differences between the CRD and the Rodeo when comparing them in detail. What matters is how those similarities and differences would affect the informed user's overall impression. The Rodeo is rather squat and chunky, and the handle forms an important part of its appearance. Despite the novelty of the concept, the appearance of the Rodeo is somewhat crude and old-fashioned. By comparison, the CRD is slimmer and more sculpted, and the ridge and the horns form important parts of its appearance. The CRD appears to be considerably more sophisticated and modern than the Rodeo. Furthermore, the clasps have a rather different visual impact, looking much more like the nose and

tail of an animal than the winder and the rear clasp on the Rodeo. Thus the overall impression created by the CRD is different to that created by the Rodeo. Accordingly, I consider that PMS was right not to challenge the validity of the CRD except as part of its squeeze argument. "

17. As for the comparison between the CRD and the Kiddee Case, the judge dealt at the outset with three preliminary points. Two of these were agreed. The judge explained that since the CRD includes a detachable strap, the appropriate comparison was with the Kiddee Case with such a strap. So also, since the CRD does not include a representation of the bottom of the suitcase, it was not appropriate to take the bottom into account in carrying out the comparison.
18. The third preliminary point was, however, controversial and forms the basis of the appeal. Magmatic contended that since the CRD does not show any graphical designs on the surface of the suitcase, the designs on the surface of the Kiddee Case had to be ignored. PMS disagreed and contended that they should be taken into account. On this point the judge preferred the submission advanced by Magmatic. He held that since the CRD was for the shape of the suitcase, the proper comparison was with the shape of the Kiddee Case and all other aspects of the design of the Kiddee Case must be ignored.
19. The judge then identified the following similarities between the CRD and the Kiddee Case upon which Magmatic relied:
 - i) A substantially rectangular portable luggage case with the sides being slightly curved.
 - ii) A saddle shaped top.
 - iii) Four wheels on a substantially rectangular base located close to the end of the long side of this base.
 - iv) Two horns/protrusions located at the top of the front of the case.
 - v) A ridge running up the front and back of the case wherein the middle of the ridge contains a thin strip running generally along the length of the ridge.
 - vi) The thin strip located in the ridge stopping for the clasps on the front and back and stopping for the eyelets.
 - vii) A ridge running along the top of the case wherein the ridge flares out to form an oval in the middle of the top of the case.
 - viii) A curved clasp on the front and back of the case located in the middle of the ridge and slightly above the visual centre of the front and back of the case.
 - ix) The clasp on the front being located below the horns so as to give the impression of animal characteristics.
 - x) Two eyelets located in the ridge at the top of the front and back parts of the case.
 - xi) A strap being attached to the two eyelets and running between them.
20. The judge accepted that the CRD and the Kiddee Case were similar in these respects but noted that the clasps on the Kiddee Case were slightly lower down than the clasps on the CRD.
21. By contrast, PMS focused more on the features of the CRD which were novel as compared to the design corpus and identified ten such features, of which, so it argued, no more than three were present in the Kiddee Case:

	Feature in [CRD] which is novel over design corpus	Present, absent or different in Kiddee Cases
1	Two handles at the front shaped like horns.	Two handles present, but different shapes in the form of insect antennae or erect but folding animal ears.

2	Sides have a sculpted ridge and indent below of semi-circular shape.	Absent
3	Front [clasp] is (a) oval in outline shape, not circular and (b) has a plain outer surface.	Absent. Cover is circular and not plain.
4	Rear [clasp] is (a) oval in outline shape, not approximately square and (b) has a plain outer surface.	Absent. Cover is circular and not plain.
5	Strap along the top surface.	Present, but different shape
6	Ridge present along centre of front, top and rear, expanding to form an oval shape along the top and around clasp covers at front and rear.	Present, but different shape
7	[Lip] at bottom of front and rear.	Absent
8	Circular tab attached to strap, hanging down rear side.	Absent
9	Wheels have central circular feature from which extend five "spoke" ridges.	Absent. Wheel sides smooth.
10	Overall shape is symmetrical front to rear.	Absent. Asymmetrical shape. Seat to rear of centre.

22. The judge accepted that the differences identified by PMS were present but explained that in his view some of them were not as different as the table suggested. He put it this way at [73]:

"I agree that these differences are present, but in my view a number of them are not as visually significant as this table suggests. Thus the handles (item 1) are different in detail (more so in the case of their antennae than in the case of the ears), but the overall effect of their shape and positioning is similar; the clasp covers (items 3 and 4) are broadly similar despite the detailed differences; the strap is very similar (as is the method and positioning of its attachment); the ridge is very similar apart from the flared sections around the clasps; the absence of the tab (luggage label) would not strike the informed user as significant for the reason given above; and the asymmetry of the Kiddee Case is not particularly noticeable. In the case of the wheels, the real difference is that the wheels on the Kiddee Case have covers over them. Furthermore, the central feature and spokes are barely visible on the CRD. "

23. PMS also argued that the following six important features of the Kiddee Case were absent from the CRD:

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

24. The judge held that items 1 and 2 had to be ignored because the CRD was just for the shape of the suitcase. He accepted items 3 and 4 although he considered that since the handles were made of fabric, their visual impact was not great. He thought item 5 was more significant and as for item 6, he reiterated that the clasps were broadly similar.
25. That brought the judge to the overall impression produced by each of the designs and he summarised his views

in these terms at [76]:

"In my judgment the informed user would notice both similarities and differences between the CRD and the Kiddee Case when comparing them in detail. What matters is how those similarities and differences would affect the informed user's overall impression. In my view the most noticeable differences between the Kiddee Case and the CRD are (i) the more rounded contours of the Kiddee Case around the seating area compared to the more angular contours and semi-circular indentation of the CRD in that area and (ii) the covered wheels of the Kiddee Case. Also noticeable are (iii) the more flared areas of the ridge around the clasps and (iv) the absence of the lip. Nevertheless, there is an overall resemblance between the designs."

26. Finally, the judge came to his conclusion at [77]:

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

27. Here it can be seen the judge was doubtful whether it could be said the overall impression produced by the Kiddee Case was the same as that produced by the CRD and yet the overall impression produced by the Rodeo was different. In the end, however, he decided that it could and so a finding of infringement followed.

The appeal

28. Upon this appeal Mr Mark Vanhegan QC, who has appeared with Mr Chris Aikens on behalf of PMS, contends that the judge has erred in principle in approaching the matter as he did and that he was wrong to disregard all of the decoration on the Kiddee Case. The judge having made this error, it is, he says, open to this court to re-evaluate the matter for itself. Mr Michael Hicks, who has appeared with Mr Jonathan Moss on behalf of Magmatic, responds that the judge approached the matter entirely correctly and that there is no reason for this court to interfere with the conclusion to which he came.

29. In assessing Mr Vanhegan's submissions the starting point must involve the interpretation of the CRD and what it protects. As is well understood and subject to the provisions of the Regulation, a person may register as a Community design any aspect of the appearance of the whole or a part of a product resulting from its lines, contours, colour, shape, colour or texture or the materials of which it is made.

30. An application for a Community design must contain a representation of the design suitable for reproduction and an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. It may also include a description explaining the representation. But all this additional information does not affect the scope of the design (see: Article 36(6) of the Regulation). At the end of the day, the scope of the design must be determined from the representation itself.

31. How then is this exercise of interpretation to be carried out? Some assistance may be derived from drafting conventions. A number are referred to in the OHIM Guidelines for Examination. Thus, for example, broken lines may be used to indicate elements for which no protection is sought or to indicate portions of the design which are not visible in that view. So also, boundaries may be used to surround features for which protection is sought; and colour shading and blurring may be used to indicate that certain features are excluded from protection. These are, however, simply illustrations of a broader principle which is that the scope of the protection must be discerned from the graphical representation and the information it conveys.

32. Colour presents further challenges. An application for a Community registered design may be filed in black and white (monochrome) or in colour. If colour forms no part of the design then it is conventional to file the design in black and white. Similarly, if a particular colour does form part of an aspect of a design then it may be filed wholly or partly in that colour. So also, if monochrome colours are a feature of the design, this can be shown by placing the design against a background of a uniform but different colour. Of course it becomes more difficult if particular colours are not a feature of the design but colour contrasts are. This is said to be such a case, as I shall explain.
33. These general principles are reflected in the decisions of the High Court and Court of Appeal in this jurisdiction. Thus in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2006] EWHC 3145 (Ch), [2007] FSR 13, it was alleged that a Community registered design comprising a series of monochrome line drawings of a spray canister was infringed by a product called "Air Wick". The claimant argued that, in light of the registration, only the product shapes should be compared. The defendant responded that the correct comparator was the defendant's product as a whole, including its colour. Underpinning these rival contentions were two related issues, namely the scope of protection of the design and how the comparison should be carried out. As for the first, Lewison J (as he then was) explained that protection only extended to those aspects of the design which were depicted:

"27. If a design passes these two tests, it is registered as a Community design. The form of the registration derives from the representation included in the application under Article 36. The definition of "design" is that it is the appearance of the whole or part of a product. Whether it is the whole of the product or only part of the product depends, in my judgment, on what is depicted in the application for registration. In the case of a monochrome line drawing, what is protected is likely to be the shape or contours of the product. Although the definition extends to colours and materials, if they are not depicted, they will not be protected. By the same token, if the registered design depicts only part of a product, it is only that part that will be protected. It must be noted that although the applicant is required to identify the products to which his design will be applied, the scope of the protection in that respect is not limited by that: Article 36.6. This means, as both Mr Carr QC and Mr Wyand QC agreed, that if a design is registered for, say, an aerosol, it could be infringed by, say, a vase."

34. Turning to the second issue, Lewison J rejected the submission that he should take into account the colours and graphics on the Air Wick when comparing it with the registered design:

"48. The registration must, in my judgment, be the yardstick by which infringement is to be judged. The registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by prior art. If he chooses too specific a level he may not be protected against similar designs. But in my judgment to allow features that are not the subject-matter of the registration to play a part in the assessment of the overall impression would unduly restrict the scope of protection. This conclusion is, to some extent, supported by Russell-Clarke & Howe on *Industrial Designs* (7th ed) para 2-20 in which the editor/author says:

"Under the new EC harmonised law, there seems no reason why the design of the chair back cannot be registered by itself. In practice, this would be achieved by filing a representation which portrays only the chair back and does not portray the rest of the chair. This would mean that when it came to infringement, only the back of the defendant's chair would be compared with the registration and it would be irrelevant how different or similar, for example, the legs of the defendant's chair are to the design of the proprietor's own products on the market."

49. There is nothing in the registered Community design in the present case that limits the colours. It seems to me therefore, that if one does not eliminate colour from the alleged infringement, the practical effect of not claiming a colour would be to limit the scope of protection to the colour

white. But that would defeat the purpose of not claiming a colour (or it might lead applications for registration of a particularly distinctive shape to claim all conceivable colours)."

35. A little later, Lewison J considered the position on the basis contended for by the defendant:

"71. Mr Carr asked me to record what my conclusion would have been if I had been of the view that the colours and graphics of the Air Wick canister had to be taken into account in making the comparison.

72. The predominant colour of the Air Wick canister is white. If I compare the Air Wick product with the Febreze product, the differences are not enlarged by the use of colour. Both have a predominantly white container, and both have a bluish pastel top. But that is not the comparison that Mr Carr says I should make. He wants to compare the coloured Air Wick product with the colourless registered design.

73. The contrast (some might say clash) between the blue pastel top and the green band immediately below the junction between the top and the canister in the Air Wick product does accentuate the difference between the two parts of the aerosol. It leads to Mr Treeby's conclusion that the Air Wick design is a standard canister with a new top stuck on top. However, it still seems to me that the overall impression is formed by the distinctive shape of the registered design and the Air Wick product. I would not have come to a different conclusion if I had made the artificial comparison that Mr Carr urges."

36. On appeal to this court (*Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8), the defendant abandoned the point, as recorded by Jacob LJ:

"40. Before going on to consider this argument in detail, I should record that Mr Carr, under a little pressure from the Court, abandoned his point about decoration, rejected by the Judge at [71-73]. He was right to do so. The registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant."

37. If I might respectfully say so, this observation of Jacob LJ seems to me to be entirely right in the context in which it was made. Before carrying out any comparison of the registered design with an earlier design or with the design of an alleged infringement, it is necessary to ascertain which features are actually protected by the design and so are relevant to the comparison. If a registered design comprises line drawings in monochrome and colour is not a feature of it, then it cannot avail a defendant to say that he is using the same design but in a colour or in a number of colours. As Lewison J observed, were it otherwise, the practical effect of not claiming a colour would be to limit the scope of protection to the colour white, and that would defeat the purpose of not claiming a colour in the first place.

38. The second case to which I must refer, *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWCA Civ 1339, [2013] FSR 9, concerned an allegation by Apple that Samsung's "Galaxy" tablets infringed its Community registered design comprising a series of very simple line drawings in monochrome. At trial the judge dismissed the claim, finding that one of the points of difference was the presence on the Galaxy tablet of the Samsung trade mark. On appeal it was contended that he had fallen into error in so doing. In dismissing the appeal, Sir Robin Jacob explained that Apple itself had contended that a feature of the registered design was that it had *no* ornamentation:

"15. The second criticism was based on the fact that the Judge took account of the fact that the Samsung products had the trade mark Samsung on both their fronts and backs. It was submitted that the informed user would disregard the trade mark altogether as being a mere conventional addition to the design of the accused product.

16. Actually what the Judge said about the trade mark being on the front of the Samsung tablets was

said in the context that Apple was contending that a feature of the registered design was "A flat transparent surface without any ornamentation covering the front face of the device up to the rim." He said:

[113] All three tablets are the same as far as feature (ii) is concerned. The front of each Samsung tablet has a tiny speaker grille and a tiny camera hole near the top edge and the name Samsung along the bottom edge.

[114] The very low degree of ornamentation is notable. However a difference is the clearly visible camera hole, speaker grille and the name Samsung on the front face. Apple submitted that the presence of branding was irrelevant However in the case before me, the unornamented nature of the front face is a significant aspect of the Apple design. The Samsung design is not unornamented. It is like the LG Flatron. I find that the presence of writing on the front of the tablet is a feature which the informed user will notice (as well as the grille and camera hole). The fact that the writing happens to be a trade mark is irrelevant. It is ornamentation of some sort. The extent to which the writing gives the tablet an orientation is addressed below.

[115] The Samsung tablets look very close to the Apple design as far as this feature is concerned but they are not absolutely identical as a result of a small degree of ornamentation.

17. So what the Judge was considering was the fact that unlike the design, the front face had some sort of ornamentation which happened to be a trade mark (plus speaker grill and camera hole). Little turned on it in his view, he called it "a small degree of ornamentation." But it was a difference.

18. I think the Judge was correct here. If an important feature of a design is no ornamentation, as Apple contended and was undisputed, the Judge was right to say that a departure from no ornamentation would be taken into account by the informed user. Where you put a trade mark can influence the aesthetics of a design, particularly one whose virtue in part rests on simplicity and lack of ornamentation. The Judge was right to say that an informed user would give it appropriate weight - which in the overall assessment was slight. If the only difference between the registered design and the Samsung products was the presence of the trade mark, then things would have been different.

19. Much the same goes for the Samsung trade mark on the back of the products. Apple had contended that a key feature was "a design of extreme simplicity without features which specify orientation." Given that contention the Judge can hardly have held that an informed user would completely disregard the trade marks both front and back which reduce simplicity a bit and do indicate orientation."

39. It is important to note that it was a part of Apple's case that an absence of ornamentation was a feature of its design. Indeed, that was the one part of Apple's case with which Samsung took no issue, perhaps because it recognised this as a potential point of distinction. Nevertheless, I see no reason in principle to doubt the correctness of Apple's contention, and it was accepted by the court both at first instance and on appeal as an appropriate basis upon which to proceed. Nor does it seem to me to be in any way inconsistent with the decision in *Procter & Gamble*. All must depend upon the design in issue.
40. I come then to consider the application of these principles in the present case and, in particular, the scope of the CRD. As I have explained, the judge considered it is only for the shape of the suitcase and so the proper comparison was with the shape of the Kiddee Case. In carrying out an analysis of the overall impression created by each, all other material should, he thought, be disregarded.
41. I believe that in interpreting the CRD as he did the judge fell into error in two respects. The CRD consists of six monochrome representations of a suitcase. These representations are not simple line drawings, however. Rather,

they are computer generated three dimensional images which show the suitcase from different perspectives and angles and show the effect of light upon its surfaces. Further and importantly, the suitcase looks like a horned animal with a nose and a tail, and it does so both because of its shape and because its flanks and front are not adorned with any other imagery which counteracts or interferes with the impression the shape creates. As Mr Vanhegan submits, the CRD is, in that sense, relatively uncluttered and it conveys a distinct visual message. Here then the first of the judge's errors can be seen: he failed to appreciate that this is a design for a suitcase which, considered as a whole, looks like a horned animal.

42. Second, I entirely agree with the judge that it is striking that the various representations are shown in monochrome, and so it must be concluded that this design is not limited to particular colours. Just as in the *Procter & Gamble* case, PMS cannot point to the colour of the Kiddee Case as being a point of distinction. That is not the end of the analysis, however, because each of the representations shows a distinct contrast in colour between the wheels and the strap, on the one hand, and the rest of the suitcase, on the other. I have given anxious consideration to whether this is simply an artefact of the computer generation process or a visual cue to indicate that the wheels and the strap are each separate components. However, I do not find either of these alternative explanations convincing. The clasps are also separately functioning components and they are not shown in a contrasting colour and it seems to me that the wheels could perfectly well have been shown and depicted as separate components in the same colour as the rest of the body. Moreover, depicted as they are and standing as they do at the four corners of the animal, the wheels are, to my eye, a rather striking aspect of the design as a whole.
43. I come then to consider the comparison the judge carried out and begin by observing that no criticism is made of the approach the judge adopted to the informed user and his attributes. In that regard he correctly reminded himself that in the *Samsung* case, this court cited with approval (at [2012] EWCA Civ 1339, [10]) the following summary of the law by HH Judge Birss QC (as he then was) at first instance ([2012] EWHC 1882; [2013] ECDR 1):

"[33] The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 7 (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, judgment of 22 June 2010.

[34] Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzhen* paragraph 46).

However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

[35] I would add that the informed user neither (a) merely perceives the designs as a whole and does

not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59)."

44. The judge then proceeded, again entirely correctly, to consider the design corpus and the degree of design freedom, and so also the effect of both the differences between the design corpus and the CRD and also the degree of design freedom upon the scope of protection. So also he properly directed himself that what matters is the overall impression produced upon the informed user by each design having regard to those matters. As Jacob LJ observed in *Procter & Gamble* at [2007] EWCA 936 at [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."

45. I would add that the two designs must therefore be considered globally and, as one would expect, the informed user will attach less significance to those features which form part of the design corpus and correspondingly greater significance to those features which do not. So also, the informed user will attach particular importance to features in respect of which the designer had a great deal of design freedom. The analysis is not limited to these considerations, however, for a global assessment also requires the designs to be considered having regard to the way in which the products to which the designs are intended to be applied are used, with some features having greater prominence than others, perhaps because they are more visible.
46. I therefore detect no error by the judge in his consideration of the principles relevant to the comparison of the CRD with the designs of the accused products. In my judgment the judge did, however, fall into error in the way he applied those principles in the particular circumstances of the present case for I believe his errors as to the proper characterisation of the CRD have carried through into the comparison he actually carried out.
47. First and most importantly, it seems to me the judge failed to carry out a global comparison having regard to the nature of the CRD and the fact that it is clearly intended to create the impression of a horned animal. This is plainly one of its essential features. Necessarily, therefore, a global assessment of the CRD and the accused designs requires a consideration of the visual impression they each create and in so far as that impression is affected by the features appearing on their front and sides, it seems to me those other features must be taken into account. Thus taking the insect version of the *Kiddee* Case, I believe that the impression its shape creates is clearly influenced by the two tone colouring of the body and the spots on its flanks. As a result it looks like a ladybird and the handles on its forehead look like antennae. Overall the shape conveys a completely different impression from that of the CRD. 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. Precisely the same considerations apply to the other version of the *Kiddee* Case. The stripes on its flanks and the whiskers on either side of its nose immediately convey to the informed user that this is a tiger with ears. It is plainly not a horned animal. Once again the accused design produces a very different impression from that of the CRD.
48. The second error concerns the colour contrast between the wheels and the body of the CRD. This is, as I have said, a fairly striking feature of the CRD and it is simply not present in the accused designs. In my view it was another matter which the judge ought to have taken into account in carrying out the global comparison.
49. The judge having made these various errors in his analysis of the CRD and in the way he carried out the global assessment, this court is free to form its own view and that is what I must now do. I also have well in mind the characteristics of the informed user and in particular that he is particularly observant, has knowledge of the

design corpus and is able to carry out a direct comparison of the designs in issue.

50. I also take into account the judge's findings that the CRD represents a significant departure from the design corpus and that the designer had a substantial degree of design freedom with the result that, subject to the design of the Rodeo, the CRD is entitled to a relatively broad scope of protection.
51. Nevertheless, and as may perhaps be anticipated from the views I have expressed above, I think the impression conveyed to the informed user by the designs of the two versions of the Kiddee Case is very different from that of the CRD. There are, it must be acknowledged, some similarities at a general level. The Kiddee Case, in both of its versions, does look like an animal of one kind or another and it has clasps at the front and back. It also has handles at the top of the front where one would expect to see horns or antennae or ears, as the case may be. It has a rounded profile at the front and back, four wheels and a generally saddle shaped top. It also has a ridge running up the front and back of the case and the middle of the ridge contains a thin strip which stops for the clasps. I recognise too that the clasps are generally located in the middle of the ridge and slightly above the centre. There is a strap held by eyelets located in the ridge at the front and back. All of these somewhat generalised features are also to be found in the CRD.
52. However, there are many significant differences between the Kiddee Case and the CRD. The following seem to me to be particularly striking. The profile of the Kiddee Case is asymmetric and much more rounded than the CRD. The sides of the Kiddee Case do not have a ridge and there is no cutaway semi-circular shape below the ridge, whereas the CRD has both of these features. The wheels of the Kiddee Case are covered by wheel arches whereas in the CRD they are not covered and are of a contrasting colour to the rest of the design. The CRD has a circular tab attached to the strap at the rear of the case whereas there is no such tab in the Kiddee Case. The straps, handles and clasps are very different in each of the designs. Finally, the CRD has what has been described as a projecting skirt or lip at the bottom of the front and the rear, a feature which is absent from the Kiddee Case.
53. Further, the overall impression created by the two designs is very different. The impression created by the CRD is that of a horned animal. It is a sleek and stylised design and, from the side, has a generally symmetrical appearance with a significant cut away semicircle below the ridge. By contrast the design of the Kiddee Case is softer and more rounded and evocative of an insect with antennae or an animal with floppy ears. At both a general and a detailed level the Kiddee Case conveys a very different impression.
54. It will be noted that in carrying out this comparison I have not focused on the design of the Rodeo which was deployed by PMS largely as a squeeze in the manner I have explained. The judge evidently felt that squeeze had some force and rightly so, for the Rodeo embodies Mr Law's initial concept of a children's travel case which is shaped like an animal and has four wheels, clasps at the front and back and dumb bell shaped projections at the top of the front which give the impression of ears or horns. Nevertheless the judge held that the CRD was both new and had individual character because it produced on the informed user a different overall impression from that produced by the Rodeo, noting in that regard that the ridge and horns of the CRD formed an important part of its appearance. There has been no appeal by PMS against that finding although Mr Vanhegan at one point indicated he would seek permission to raise this issue out of time should that be necessary. For my part, I do not believe it is necessary because, for all of the reasons I have given, I have come to the conclusion that the design of the Kiddee Case does produce on the informed user a different overall impression from that produced by the CRD.
55. I would therefore allow the appeal. I believe the judge ought to have found that the Kiddee Case does not infringe the CRD.

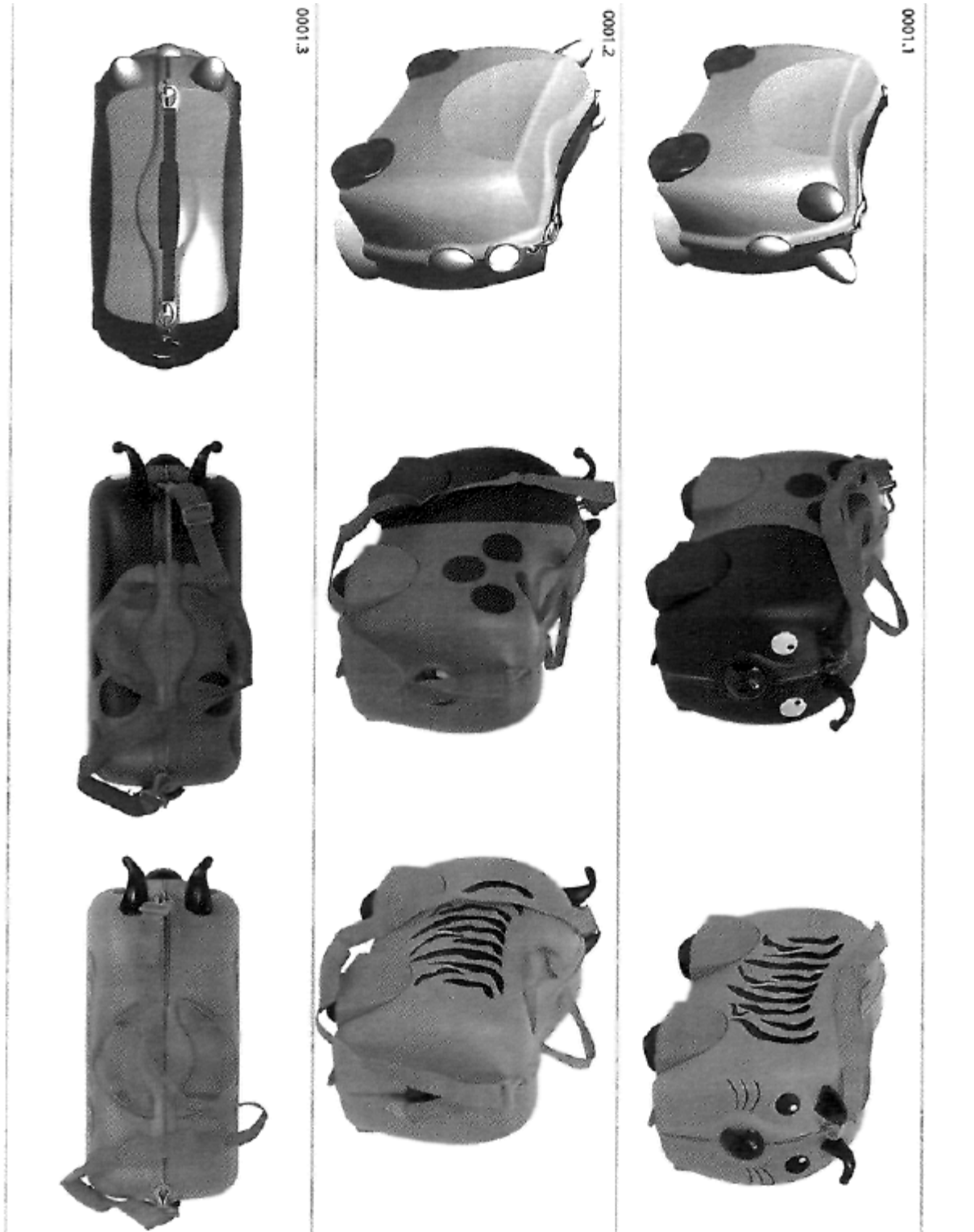
Black LJ:

56. I agree.

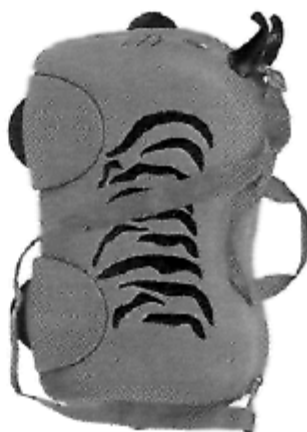
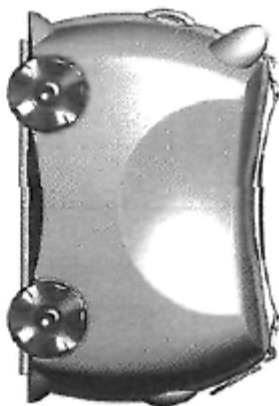
Moses LJ:

57. I also agree.

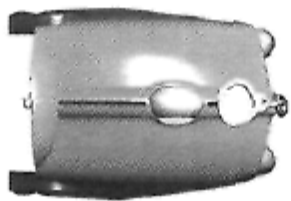
Annex



00014



00015



00016

