

Neutral Citation Number: [2022] EWHC 689 (IPEC)

Case No: IP-2019-000130

**IN THE HIGH COURT OF JUSTICE**  
**BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES**  
**INTELLECTUAL PROPERTY LIST (ChD)**  
**INTELLECTUAL PROPERTY ENTERPRISE COURT**

Royal Courts of Justice  
Rolls Building, London, EC4 1NL

Date: 25/03/2022

**Before:**  
**MISS RECORDER AMANDA MICHAELS**

**Between:**

(1) FAIRFAX & FAVOR LIMITED  
(2) MR FELIX FAVOR PARKER  
(3) MR MARCUS FAIRFAX FOUNTAINE

**Claimants**

and

(1) THE HOUSE OF BRUAR LIMITED  
(2) MR PATRICK MARK BIRKBECK  
(3) MR MARK NIGEL THOMAS BIRKBECK

**Defendants**

**Thomas St Quintin** (instructed by **McDaniel & Co**) for the Claimants

**Kathryn Pickard** (instructed by **Marks & Clerk Law LLP**) for the Defendants

**Hearing dates: 2 and 3 December 2021**

-----

**Approved Judgment**

*Covid-19 Protocol: This judgment was handed down remotely by circulation to the parties' representatives by email and released to BAILII. The date and time for hand-down is deemed to be 10.30 a.m. on Friday 25th March 2022.*

.....

### **Miss Recorder Amanda Michaels**

1. This is the judgment following the trial of a claim for infringement of a registered Community design and of unregistered UK design rights in the design for a knee length ladies' boot. The design is based upon a traditional Spanish riding boot. I have to decide, in essence, whether three versions of the design sold (sequentially) by the First Defendant infringe the Claimants' registered and unregistered designs.
2. The Claimants' boot design is called the "Regina boot" or the "Heeled Regina." It is a slim fitting, elegant, knee-length boot with a mid-height heel, a full zip on the outside of the leg, with a tassel pull, and a 'fan' above it. Whilst the boot is in the style of a Spanish riding boot, it was not designed for serious equestrian or country use.
3. The claim was issued before the UK left the EU, and there is now a UK registered design No. 9002954222-00001 cloned from the Community Registered Design. No application was made to amend the claim expressly to assert reliance upon the UK registered design, but no point was taken about this by the Defendants. As it is not necessary to distinguish between the RCD and the equivalent UK right, for convenience in this judgment I shall simply refer, as the parties did, to the "RCD."
4. The unregistered designs relied upon consist of a design showing the whole of the Heeled Regina, and two designs for the same boot with the exclusion of different parts of it.
5. The proceedings were issued in August 2019 against The House of Bruar Ltd ("Bruar") and two of its directors. The claim initially included an allegation of infringement of two RCDs: the RCD for the Heeled Regina, and a design for a boot known as the Amira. However, the Defendants admitted infringement of the Amira design in the Defence and Counterclaim, and I do not need to deal further with that design, as such. The Claimants nevertheless said that the admission that the Amira design had been copied showed that the Defendants were willing or had a propensity to copy their designs. When the proceedings were issued, complaint was made about two versions of the Defendants' boots alleged to infringe the Heeled Regina design. A third boot design came to the Claimants' attention after issue, leading to an amendment to the Particulars of Claim in September 2019 to add that boot.
6. Directions were given in an order dated 3 April 2020. The Order and the list of issues did not limit the number of prior designs to be taken into account, which was a matter of some significance because numerous earlier boot designs were pleaded by the Defendants in order to challenge the validity or scope of the Claimants' rights. At trial, Miss Pickard helpfully identified a narrower range of designs which she said were the most relevant.

#### *The witnesses*

7. For the Claimants, both Mr Parker and Mr Fontaine provided witness statements and were cross-examined. Mr Fontaine was a wholly credible and reliable witness, as the Defendants accepted. However, they contended that Mr Parker was not a reliable

witness, saying that his explanation of the process of designing the Heeled Regina was incomplete or confused, and that he gave various different dates when the design was said to have been made. On the whole, I found Mr Parker to be a credible witness, who was doing his best to explain the design process and I accept that he genuinely believed that the various designs which he had made had different features. However, he was rather unclear about the dates of the various designs, and especially as to the sequence of various design changes in the critical period of October and November 2014. I did not find his difficulty in specifying the relevant dates surprising so long after the event, nor did it lead me to doubt his veracity, but I have concluded that I should not rely upon Mr Parker's recollections as to dates without some corroborative evidence. The third witness for the Claimants was Mr Duff, a business consultant who sits on the board of the First Claimant. His evidence was not challenged in cross-examination.

8. The Defendants' main witnesses were Mrs Lorna Meikle (née Macleod) and the Second Defendant, Mr Patrick Birkbeck. Mrs Meikle is a long-standing employee of Bruar, and has been its ladieswear buyer for around 15 years. Regrettably, I did not find Mrs Meikle to be a reliable witness. For the reasons set out below, I did not believe her evidence on a number of points, and in particular I did not accept her denial that Bruar had copied the Heeled Regina design. I therefore consider it right to treat all of her evidence with caution, save as consistent with any corroborative evidence. I found Mr Birkbeck to be a more credible witness, although there were some gaps in his evidence, for instance as to his explanation of the design process when ordering the Defendants' Version 3 boot, which differed as between his witness statement and his oral evidence and as to the explanation he gave for the use of F&F's boots in Bruar's 2018/19 catalogue, given that the same 'mistake' had been made in the previous year's catalogue, something which he did not seek to explain. In addition, the Defendants relied upon a witness statement of their solicitor, Mr Bevan, who exhibited various documents, and who was not cross-examined. They also served a Civil Evidence notice seeking to rely upon some correspondence between Mr Lazo and Mr Birkbeck.

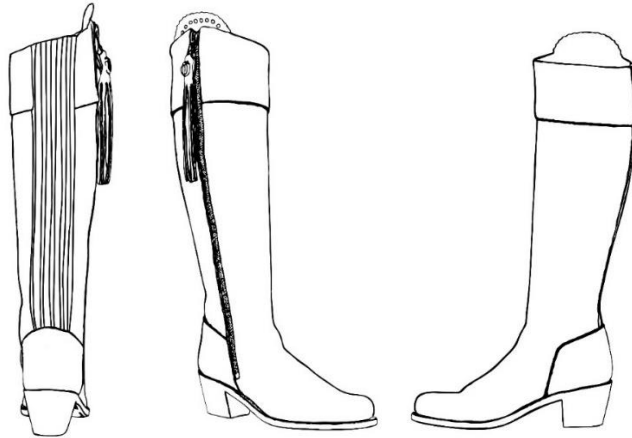
### *Background*

9. Mr Parker and Mr Fountaine were schoolfriends who at the age of 16 came up with the idea of running their own luxury leather business. After going to agricultural college Mr Parker spent some time working with his godfather's business, Abarca, which provided him with an introduction to the leather and footwear industries. By about 2012, aged around 21, Mr Parker and Mr Fountaine started trading under the name "Fairfax & Favor." They imported shoes from Spain and initially sold them through country shows and fairs and it seems that they have had a good measure of success. They decided early on that they wished to sell goods made to their own designs, with Mr Parker having the design and aesthetic input, and Mr Fountaine looking after the business development and administration. The First Claimant company ("F&F") was incorporated on 7 May 2013 and its turnover has increased year on year; in the year to February 2017 its turnover was just over £3 million, rising to £13.5 million pounds for the 10 months to December 2020. F&F has 42 employees and sells directly through its own website and at events and shows such as Badminton and Burley, as well as through a number of retailers.

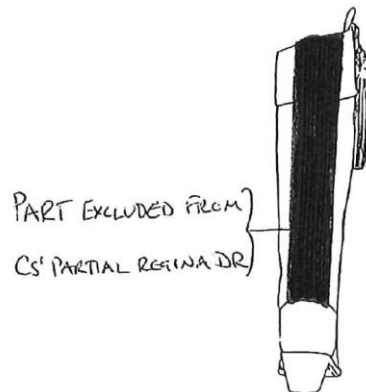
10. The First Defendant, House of Bruar Ltd, (“Bruar”) was described by Mrs Meikle as a major independent country fashion retailer based in Perthshire in Scotland. It sells traditional tweed and cashmere garments and other clothing and footwear with a rural or country theme, as well as sporting accessories, outdoor equipment, home and kitchenware and Scottish food and drink. It deals in well-known fashion brands as well as products sourced directly from "high-quality artisan producers." The business has an annual turnover of around £30 million and sells from retail premises in Perthshire as well as via an online and mail order catalogue. Mrs Meikle explained that footwear accounted for less than 20% of the ladies' clothing and accessories for which she is responsible, but she did not give any turnover figures for footwear. It is clear that by at least early 2016 Ms Meikle and Bruar were aware of F&F and its products.
11. The Claimants' case (as clarified in its Amended Reply) was that the Heeled Regina boot was designed by Mr Parker, who is an employee as well as a director of F&F. He was not a professional designer, but through working at Abarca had experience of the footwear trade including trade in Spanish shoes and boots. This had, in particular, introduced him to manufacturers in the town of Valverde del Camino, which appears to be a centre of footwear production. There was some contradictory evidence before me as to who had designed some Spanish riding boots made in Valverde, which were popularised by Miss Kate Middleton, the future Duchess of Cambridge, but this was not directly relevant to the matters which I have to decide.
12. Mr Parker had met Mr Lazo of Lazo y Duque, which is a Valverde manufacturer, whilst he was working for Abarca, and it was Lazo & Duque which produced the prototypes of the Heeled Regina boot. Mr Parker's evidence was that he wanted to produce a style of boot which was more stylish and elegant, and less rugged, than a boot truly designed for riding. Whilst working for Abarca he had designed a form of riding boot which the Defendants relied upon in these proceedings as relevant prior art (“the Abarca boot”). Then, in around 2013 he designed a boot for F&F which was identified as the “Early Regina.” The Defendants' case was that the Early Regina was the same as the Abarca boot. It had many of the same features as the RCD but had a flat heel and did not have a rear elasticated panel like the Heeled Regina. The Early Regina was made for the Claimants by Lazo & Duque and was given reference number 1752 by Mr Lazo. It appears to have been offered for sale from at least July 2013.
13. Mr Parker said that he subsequently came up with the concept of the Heeled Regina boot, and asked Mr Lazo to make up samples of the design for F&F to consider. The design process appears to have proceeded in two steps, initially by the production of an intervening design, the “1856.” Mr Parker sent a series of emails to Mr Lazo in mid-October 2014 giving him details of the features of the proposed design. He sent Mr Lazo a photograph of the Early Regina, together with a photograph of a shoe which had the kind of mid-height heel he wanted to use for the boot. A single sample was made of that boot, to which Mr Lazo gave his reference number 1856 (this number may be out of sequence, as later designs have lower numbers, but no point was taken about this). It was never sold, although photographs of it were posted on F&F's social media on 26 November 2014, stating “Who is loving our new Regina heeled boot?” The 1856 was one of the prior designs relied upon by the Defendants:



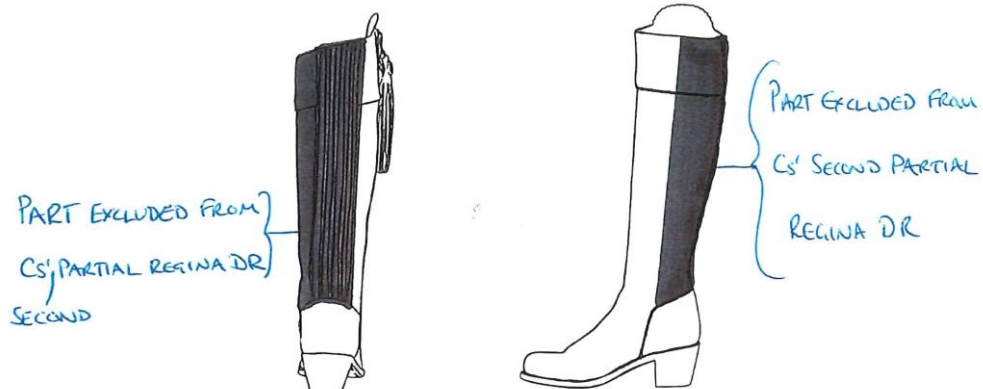
14. The email exchanges show that in about mid-October 2014 Mr Parker asked Mr Lazo to add an elasticated panel or gusset, overlaid with strips of leather/suede, running down the back of the heeled boot, as well as adding the existing type of F&F tassels. By an email dated 15 October 2014, Mr Lazo asked for details of the kind of elastic panel that was wanted, saying that they were making the sample. Mr Parker immediately sent him a photograph showing the kind of panel he wanted, which had 4 parallel leather strips with zigzag edges covering the length of the elastic base. Later the same day Mr Lazo told Mr Parker that the elastic sample was being made and would be ready the following week.
15. Mr Parker's evidence was that in November 2014 he visited Mr Lazo and they finalised the design, which involved making a number of small changes arising from the addition of the higher heel, and varied the design of the suede strips over the panel by removing the zigzag edges. In another set of emails dated 27 November 2014, Mr Lazo and Mr Parker discussed the price of the boots, which by then had been given reference number 1857 (later they seem also to have been given number 1858). Mr Lazo said that they were going to make patterns and batches of the boots, which Mr Parker wanted for early January. Moreover, Mr Lazo confirmed on 27 November 2014 that the various designs were exclusive to F&F. At some point the flat-heeled Early Regina was also produced with the same elastic panel, and this model was given number 1852.
16. Lazo & Duque manufactured the Heeled Regina boots until about April 2017. In 2018, the Claimants became concerned that Lazo & Duque were supplying copies of their boots to unauthorised third parties (not the Defendants), leading them to seek and obtain an undertaking from Lazo & Duque not to do so. Lazo & Duque confirmed that the design of the gusset had been made by Mr Parker and the Heeled Regina was exclusive to F&F.
17. The application for the RCD was filed on 21 January 2016 in the names of Mr Parker and Mr Fountaine (nothing turns on its ownership). It is registered for footwear. There are 7 representations of the design in the RCD, but the main features can be seen in these 3 drawings:



18. The unregistered designs relied upon are:
- a. The whole of the Heeled Regina boot (essentially as shown in the RCD);
  - b. The Heeled Regina boot with the back gusset area excluded:



- c. The Heeled Regina boot with the back panel and part of the inner side of the boot excluded:



19. Seven features of the unregistered design of the Heeled Regina were relied upon by the Claimants in the Amended Particulars of Claim: the mid-height heel, the height of the shaft, the narrowing of the boot just above the ankle, the narrow shape of the toe, the panelling of the gusset at the back of the boot, the sloping cuff at the top of the boot, and the decorative features – the fan and tassel. The Partial designs included all of the same features save for the gusset design, the back of each of those boot designs being excluded.

20. Mr Fountaine explained that in the early years of its operation F&F used sales agents to try to sell their products to retailers with established client bases. One such agent, a Mr Pound, began discussions with Bruar in about 2015, offering to supply them with boots. That, and similar exchanges in 2016, did not lead to sales, as Bruar objected to the price of the boots. In early January 2016, Mr Pound sent Mrs Meikle an F&F brochure which (she accepted) would by then have included the Heeled Regina boot, as F&F's most popular product.
21. In early 2017, according to Mrs Meikle, she met another company based in Valverde, Dakota Boots ("Dakota"), which was run by a Mr Arroyo. She said that Bruar had previously bought other goods from Dakota. Her evidence was that she ordered samples and stock of Dakota's existing "Model 94" boot at the MICAM trade show. She said that Model 94 was the earliest of the Defendants' boots in issue in these proceedings (the "Version 1" boot). It was said by the Claimants to include all of the identified elements of the Heeled Regina design, including the long 4 strips of leather over the elasticated rear panel. However, there was no evidence that the model existed in that form prior to Mrs Meikle meeting with Mr Arroyo, whilst he referred to the boots as "NEW model reference 94" in an email dated 19 July 2017.
22. Mrs Meikle asked for the samples by April, so that they could be included in the main photoshoot for Bruar's catalogue. It seems that samples were received, after some delay, and Dakota invoiced for them in June 2017, but Mrs Meikle said that Bruar was let down by Dakota and did not receive stocks of the Version 1 boots in 2017. Emails passing between her and Mr Arroyo show her chasing for the boots in August 2017. However, despite his unreliability, more Version 1 boots were ordered in 2018. Again, Bruar chased Dakota for samples and stock, and Dakota failed to deliver.
23. On 31 March 2017, Mr Fountaine emailed Mr Patrick Birkbeck to offer to supply Bruar with boots, but again the offer was refused. However, shortly afterwards, on 25 April 2017, Mrs Meikle wrote to F&F, suggesting some terms on which Bruar would stock the Claimants' boots. She said:

"I look after the Ladieswear buying at Bruar and as such know all about your products. You are absolutely right in saying that it would be a good fit for our customers – and we are asked for it. You have done an amazing job building the brand and that is a great credit to you."

Mrs Meikle did not mention that one reason why she was well aware of F&F's boots was because she had bought a pair of Heeled Regina boots for (she said) her own use, on 4 April 2017.
24. Mrs Meikle went on to explain the Defendants' reluctance to order goods through an agent and have to pay his commission, and went on:

"I am well aware of the strength of your brand and it would be silly of me not to try and look at how we may be able to work together."

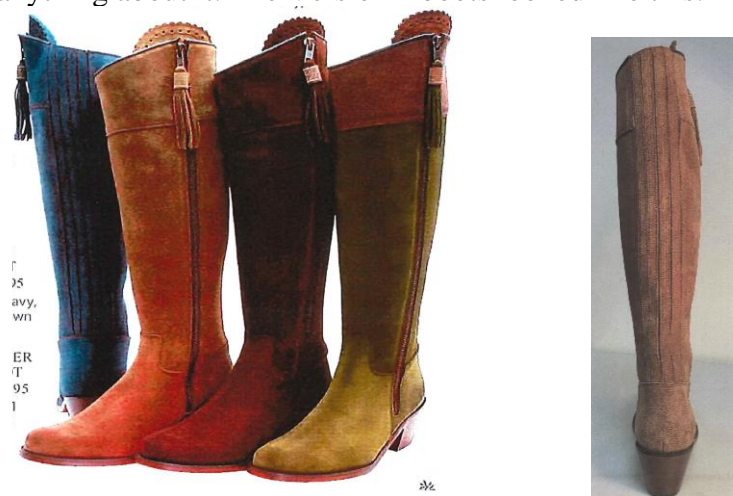
She suggested dealing direct, so as to achieve a saving equivalent to the agent's 10% commission and a minimum margin of 2.5. She added:

"I know it sounds like we are asking for it all but there will be there will also be benefits for you being stock [*sic*] at the House of Bruar. First and foremost is the brand exposure that we will give you is second to none and secondly the quantities that we will be able to achieve over time will be substantial –

especially if we decide to include your brand in our mail order catalogue (of which we send out over 3,000,000 copies every year).”

Mr Fountaine replied on 3 May 2017, offering the same 5% discount the Claimants gave to Harrods, but no agreement was reached.

25. On 29 May 2017, another Bruar employee, a Mr Whitfield, ordered another pair of F&F’s Heeled Regina boots. It was paid for by a company credit card. Mr Whitfield is no longer employed by Bruar, but no-one at Bruar could explain why he bought the boots. The boots were ordered for next day delivery to a Mr Cavallero who was a designer involved in the production of Bruar’s 2017/18 catalogue.
26. At some point in about May 2017 a photoshoot took place for Bruar’s 2017/18 catalogue, which was due for release in August. I was provided with a copy of the catalogue, which includes a photograph showing one tan and one brown boot, and another photograph of a highly similar but not identical brown boot. It was the Claimants’ case that the tan coloured boot and one of the brown boots were F&F boots, whilst the second brown boot was a copy of the Heeled Regina, one of the Defendants’ Version 1 boots. The Defendants did not dispute that some of the photographs showed F&F boots rather than samples received from Dakota. The Claimants suggested that the tan F&F boot shown in the catalogue was the one bought by Mrs Meikle. She denied this, but I was given no other explanation of how the tan boot came to feature in the catalogue. It seems highly likely to me that it was indeed a photograph of the boot she had bought, and that the brown F&F boot ordered on 29 May by Mr Whitfield was also included in the catalogue, although Mrs Meikle and Mr Birkbeck said that they did not know anything about it. The Version 1 boots looked like this:



27. In late August 2017, F&F was alerted to the contents of Bruar’s 2017-18 catalogue by a retailer who considered that it was advertising copies of the Heeled Regina.
28. The Claimants decided to send a solicitors’ letter of complaint to the Defendants, but before they did so they were contacted by Mrs Meikle by email dated 25 September 2017. Shortly afterwards she agreed to place some quite modest orders for a variety of F&F’s designs, which included the Regina and Amira boots, at what Mr Fountaine described as a special price. She accepted that at that stage Bruar knew that the boots in its catalogue were not available from Dakota. I am satisfied that Bruar ordered the boots from F&F because it was in need of goods to supply to its customers which looked like those in its catalogue, although this too was denied by Mrs Meikle.



29. Mr Fountaine explained that the Claimants hoped that supplying Bruar with its goods would stop it selling the Version 1 boots, which they saw as infringing their rights, and so they did not write a letter of claim to them at that stage.
30. In the event, unfortunately, the commercial relationship between the parties was short-lived. Mrs Meikle said that Bruar was keen to sell the F&F boots because they were being asked for them, she thought the range would fit well in Bruar's catalogue and it would be a good brand to have in the shop, but the problem was the price. However, that is hard to square with the documentary evidence. In January 2018, Mrs Meikle wrote to Mr Arroyo to see whether he would be able to supply Bruar. She speculated that the reason for the previous lack of supply was that "the people who do a very similar boot to the one we asked you for" (which must have been a reference to F&F) might have contacted him and asked him not to supply them. Then Bruar re-ordered some Version 1 boots from Dakota in March 2018, after the MICAM trade show, and asked Dakota to provide samples. In April 2018 Mrs Meikle wrote to Mr Fountaine expressing some embarrassment, but saying that the price of F&F's boots was not acceptable to the Defendants. She asked whether it was possible to move to a 10% discount and reiterated that unless the 10% discount was possible there was no point wasting his time with a conversation. Mr Fountaine said again that he would be happy to discuss the matter with her. However, she did not revert to him, no further negotiations took place, and no further orders were placed with F&F. Mrs Meikle denied that Bruar's decision to stop selling F&F's boots was connected with ordering the Version 1 boots from Dakota but, in the circumstances, it seems to me that the reason for ceasing to take supplies from F&F was not related to pricing but was, as the Claimants suggested, linked to Bruar's belief that equivalent boots would be supplied by Dakota.
31. Bruar naturally wanted to include the Version 1 boot in its 2018/19 catalogue, and on 12 March 2018 Mrs Meikle emailed Mr Arroyo asking for samples for use in the catalogue of both the Model 94 boots and some boots described as a "new development" of an "over the knee" boot. She said she would send a sample of the latter boot, which Bruar needed Mr Arroyo to "copy exactly." She sent him a link to a page on F&F's website showing the Amira boot. Not surprisingly, she accepted in evidence that Bruar's objective in so doing was for Dakota to make exact copies of the Amira boot, which it appears to have done. That infringement was admitted.
32. Once again Dakota failed to deliver samples when needed for Bruar's 2018/19 catalogue photoshoot. In an email dated 4 May 2018, Mrs Meikle asked Dakota for the samples urgently needed for the Bruar photoshoot. She wrote:  
"New riding boot (as Fairfax) in navy (dark blue) and tan (you were supposed to send me a swatch to choose the colour).  
We also want a sample of this boot in olive suede with dark brown oily leather.  
New over the knee boot (as Fairfax) in testa di moro."  
It seems clear that the reference to the new riding boot was to the Version 1 boots, and the over the knee boot was a reference to the copy of the Amira boot. It is equally clear that both were identified by reference to F&F's designs: "as Fairfax."
33. The 2018/19 Bruar catalogue included several photographs of suede Spanish riding boots, again including genuine F&F boots alongside the Version 1 boots. Mr Birkbeck's evidence was that using the F&F boots in the catalogue when those boots were no longer

in stock was a mistake. However, I formed the view that those photographs were included deliberately, as a matter of expediency, as they had been in 2017, because of Dakota's shortcomings in supplying samples of the Version 1 boots.

34. Seeing the 2018/19 brochure led the Claimants to send a letter of claim to Bruar about the Version 1 boots on 28 August 2018. This apparently led directly to the development of Bruar's Version 2 boots, which Bruar hoped would put an end to the Claimants' complaints. I was told that the redesign was discussed at a meeting between Mr Birkbeck and Mr Arroyo in September 2018. Mr Birkbeck accepted that the Version 2 design was a modification of the Version 1 boots. It is unclear to me whether that timing is correct, or whether, as Mr Parker speculated, the Version 2 boots had been designed earlier in 2018, but it matters not. Mr Birkbeck said that a number of changes to the Version 1 design were discussed, but not implemented, and the end result was that Version 2 was the same as Version 1 save that it has only 2 suede strips over the elasticated panel at the back of the boot. In fact, the Version 2 boot shown to me had two small additional changes: it did not include the piping around the top of the boot present in Version 1, and the colour of the lining had been changed from an ochre colour to orange (whilst the colour forms no part of the claim, I understand that F&F's boots are lined in orange).
35. In October 2018, in response to the letter of claim, Bruar said that it had only sold the samples of the Version 1 boots, but was going to produce a replacement product, and "take further steps to differentiate" it from the Heeled Regina. Mr Birkbeck and Mrs Meikle gave evidence that in March 2019 they visited a number of manufacturers in Valverde to source a substitute for the Version 2 boot. Whether or not by coincidence, they visited Lazo & Duque. Mr Birkbeck said that it was only when they met Mr Lazo that they realised that Lazo & Duque had made the Heeled Regina boot for F&F, and Bruar chose them to make the Version 3 boot.
36. Mr Birkbeck said that they based the Version 3 boot on existing Lazo & Duque designs, rather than on the Heeled Regina. Certainly, in an email of 24 April 2019 to Mr Lazo discussing the new design Mr Birkbeck referred to two design numbers: number 1727 which is one of the earlier designs relied upon by the Defendants, and number 1969, which was not in evidence. However, Mr Birkbeck accepted in cross-examination that the Heeled Regina was "absolutely" in his "thought patterns" when ordering the Version 3 boots from Lazo & Duque. No doubt that explains why the Version 3 boots have a gusset with full length suede panels over it, identical in concept though not in placement to the Heeled Regina. The gusset is located on the inside of the boot, and the vertical leather strips are adjacent to the centre side seam, and separated by a wider roughly triangular panel from the back seam. The front of the boots is made in a single piece, like the Heeled Regina, rather than like the split front of the Version 1 and 2 boots. The tassel is rather longer than on the Defendants' earlier boots:



37. These proceedings were issued in August 2019, complaining that the Version 1 and 2 boots infringed rights in the Heeled Regina, as well as that the rights in the Amira boot were infringed. When Bruar began to sell the Version 3 boots, the Claimants amended the claim to allege that it too infringed their rights.

### **The Law**

38. There was little dispute between the parties as to the law.
39. As to the unregistered design right claim, sections 213 and 226 of the Copyright Designs and Patents Act 1988 (CDPA) provide:
- “213.- Design right.
- (1) Design right is a property right which subsists in accordance with this Part in an original design.
- (2) In this Part ‘design’ means the design of the shape or configuration (whether internal or external) of the whole or part of an article.
- ...
- (4) A design is not ‘original’ for the purposes of this Part if it is commonplace in a qualifying country in the design field in question at the time of its creation; and ‘qualifying country’ has the meaning given in section 217(3) .
- ...
- 226.- Primary infringement of design right
- (1) The owner of design right in a design has the exclusive right to reproduce the design for commercial purposes—
- (a) by making articles to that design, or
- (b) by making a design document recording the design for the purpose of enabling such articles to be made.
- (2) Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design, and references in this Part to making articles to a design shall be construed accordingly.
- (3) Design right is infringed by a person who without the licence of the design right owner does, or authorises another to do, anything which by virtue of this section is the exclusive right of the design right owner.
- (4) For the purposes of this section reproduction may be direct or indirect, and it is immaterial whether any intervening acts themselves infringe the design right.”

40. In *Original Beauty Technology Co Ltd v G4K Fashion Ltd* [2021] F.S.R. 20, Mr David Stone helpfully summarised the law on subsistence of UKUDR and commonplace designs:

“87. Subsistence of UKUDR therefore requires:

- (i) that the design be “original”;
- (ii) that the designer or his/her employer is a “qualifying person”, or that articles made to the design were first marketed in a way which qualifies them for protection;
- (iii) that the design not be excluded from protection (“must fit, “must match” etc);
- (iv) that the design has been recorded in a design document or an article has been made to the design; and
- (v) that the term of the design has not expired.

...

91. In addition to being original, to qualify for UKUDR, a design must also not be “commonplace in a qualifying country in the design field in question at the time of its creation”. In *Neptune* [2018] F.S.R. 3 , Henry Carr J said (at [59] and [60]):

“59. In *Ocular Sciences Ltd v Aspect Vision Care Ltd (No.2)* [1997] R.P.C. 289 Laddie J explained that the commonplace exclusion applies to ‘any design which is trite, trivial, common-or-garden, hackneyed or of the type which would excite no peculiar attention in those in the relevant art’. The analysis must be conducted by reference to material ‘shown to be current in the thinking of designers in the field at the time of creation of the designs’, per Jacob LJ in *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886; [2005] R.P.C. 6 at [56].

60. Following the amendment to s.213(2) , it is more difficult for the claimant to define the shape of a design at a higher level of abstraction than its physical manifestation in the relevant article. As explained by Arnold J in the *Whitby* case at [45], this makes it harder for the claimant to prove infringement, and also makes it harder for the defendant to prove that the design is commonplace. Nonetheless, the commonplace exclusion remains a useful crosscheck on the breadth of a claim to infringement—the more generalised the definition of the design relied upon, the more likely it is to encompass designs which would ‘excite no peculiar attention in those in the relevant art’.”

92. I was also referred to the useful summary of the task facing a defendant set out by HHJ Hacon in *Action Storage Systems Ltd v G-Force Europe.Com Ltd* [2016] EWHC 3151 (IPEC); [2017] F.S.R. 18 at [37]:

“(1) A defendant alleging that a design is commonplace should plead the significant features of the design as he contends them to be, the prior art relied on in which those features are said to be found and the date from which each cited item of prior art was available to designers in the relevant design field.

(2) Prior art which renders a design commonplace will not be obscure. The evidential burden rests on the defendant to show that it is not.

(3) A design will be commonplace if it is shown to have been current in the thinking of designers in the field in question at the time of creation of the design, see *Lambretta* [2005] R.P.C. 6 at [56]. Another way of looking at this is that a commonplace design will be one which is trite, trivial, common-or-garden, hackneyed or of the type which would excite no particular attention in those in

the relevant design field, see *Ocular Sciences Ltd v Aspect Vision Care Ltd (No.2)* [1997] R.P.C. 289, at p.429, approved in *Farmers Build Ltd (In Liquidation) v Carrier Bulk Materials Handling Ltd* [2000] E.C.D.R. 42; [1999] R.P.C. 461, at pp.477 and 479. A third way of characterising a commonplace design is that it will be ready to hand, not matter that has to be hunted for and found at the last minute, see *Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd* [2005] EWCA Civ 761; [2005] R.P.C. 36, at [60].

(4) The design field in question is that with which a notional designer of the article in issue is familiar, see *Lambretta* [2005] R.P.C. 6 at [45].

(5) A design made up of features which individually are commonplace is not necessarily itself commonplace. A new combination of run-of-the-mill features may not be commonplace. See *Ocular Sciences* [1997] R.P.C. 289 at p.429, approved by the Court of Appeal in *Farmers Build* [1999] R.P.C. 461 at p.476 and in *Ultraframe* [2005] EWCA Civ 761 at [64].

(6) If the designer of the accused article has expended sufficient skill and labour to make his design original (in the copyright sense) over a single piece of commonplace prior art, he is liable also to have succeeded in creating a design that is not rendered commonplace by that prior art.””

41. In *Farmers Build* Mummery LJ had also said at p. 481:

“The shorter life of the design right, the narrower scope of protection against copying and the *prima facie* protection given by it to designs of functional articles are indications that the reference to “commonplace” designs in section 213(4) should be interpreted narrowly rather than broadly. The fact is that very many designs of functional articles which fall within the definition of a “design” are likely to be “commonplace” if that term is construed broadly in the sense of “well known”.”

42. Applying that point in *A. Fulton Co Ltd v Grant Barnett & Co* [2001] RPC 16, Park J said:

“51. ... the denial of design right protection to commonplace designs does not mean that a design must be new to qualify for protection. A design which is new is fairly unlikely to be commonplace, but it is a mistake to conclude that, if a particular design has been used before and so is not new, therefore it is commonplace. It might be, but the conclusion does not necessarily follow. ...

52. A consequence of the point made in the previous paragraph is that a design should not be denied design right protection merely because the defendant, in researching what is often referred to as the “prior art”, discovers an obscure article which is fairly similar to the design in which design right is claimed. That would not be enough to make the claimant's design commonplace.”

43. Section 226(2) is clear: infringement requires copying and the allegedly infringing design must be made “exactly or substantially” to the design. In *Neptune (Europe) Ltd v Devol Kitchens Ltd* [2017] EWHC 2172 [2018] F.S.R. 3, Henry Carr J said at [49] that this is an objective test to be decided through the eyes of the person to whom the design is directed. He went on:

“53. In contrast to copyright, it is not an infringement of a UK unregistered design to reproduce ‘a substantial part’ of a design. The importance of this distinction may be illustrated by the facts of the present case. Apart from the

features which Neptune has excluded, it relies upon the entirety of each of the articles of furniture which is said to embody the designs in issue, and does not rely upon parts or combinations of parts of such articles. Therefore, it is necessary to consider the differences as well as the similarities between Chichester and Shaker products. It will not be enough to show that a particular feature or combination of features (which in a copyright claim might constitute a substantial part) has been copied. Nor will it be enough to show that Neptune's key features have been copied, since those features, whether alone or in combination, have not been pleaded as a design right."

44. So far as the registered design claim is concerned, it was common ground that the main issues related to validity, as to which the Defendants raised allegations of lack of novelty and lack of individual character, and infringement.

45. For a registered design to be protected, Article 4(1) of the Regulation and s 1B of the 1949 Act require it both to be new and to have individual character. Section 1B provides:

"(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date."

46. As to infringement, section 7 of the 1949 Act provides:

*"Right given by registration.*

(1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.

...

(3) In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration."

47. In *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat) at [169] to [182] HHJ Hacon (sitting as a Judge of the Patents Court) summarised the law and provided a helpful six stage summary of how to compare an RCD with an allegedly infringing design. He said:

"169. A registered Community design ("RCD") which is markedly different from any member of the design corpus will confer protection of a scope greater than would be conferred by a RCD only incrementally different from a member of the design corpus, see *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936; [2008] FSR 8, at [35(ii)].

170. Designs which are strikingly new in every way will be unusual. More often some features will be commonly found in the design corpus, others not. In such a case the correct approach is to give little or no weight to common features.”

HHJ Hacon went on to refer to the decision of the General Court in *H&M Hennes & Mauritz BV & Co. KG v OHIM* (Case T-525/13) EU:T:2015:617; [2015] E.C.D.R. 20, mandating a four stage examination of the individual character of a Community design. He said:

‘173. As explained, similarities between the designs of corresponding parts of two products which are attributable to design constraints will be given little significance in the comparison of the overall impressions they produce. Though where the entirety of each design is subject to design constraints, minor differences between them can be sufficient to produce different overall impressions.

174. However, where there are at least some elements in respect of which the designer had a high level of design freedom, attention is likely to be focussed on those parts with their greater potential for variability. Similarities cannot be explained away by design restraints and will tend towards the view that the overall impressions do not differ, whereas differences will lead towards the opposite conclusion.

...

179. Some design elements are ... more equal than others. An informed user may discriminate between elements of an RCD when comparing each with the corresponding element of an accused design. Greater or lesser significance may be attached to similarities or differences, as the case may be, depending on the practical significance of the relevant part of the product or on other reasons affecting the degree to which their appearance would matter to the informed user.

..

181. I here adapt the four-stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community Design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

- (1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;
- (2) Identify the informed user and having done so decide (a) the degree of the informed user's awareness of the prior art and (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;
- (3) Decide the designer's degree of freedom in developing his design;
- (4) Assess the outcome of the comparison between the RCD and the contested designs, taking into account (a) the sector in question, (b) the designer's degree of freedom, and (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

- (5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters."

48. HHJ Birss QC (sitting as a Judge of the Patents Court as he then was) described the informed user in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat); [2013] E.C.D.R. 1, which was approved by the Court of Appeal at [2012] EWCA Civ 1339; [2013] F.S.R. 9 at [10]:

“(i) 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 EU:T:2010:96* paragraph 62; *Shenzhen EU:T:2010:248* paragraph 46);

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

(iii) 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 EU:T:2010:96* paragraph 62);

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

(v) 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).

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).”

### The merits

#### *Validity and subsistence of rights*

49. The first issue is whether UKUDR subsists in the full Heeled Regina design and/or in the two Partial designs.
50. The Defendants pleaded a ‘must-fit’ exclusion in relation to the elasticated panel. This point was, very sensibly, not pursued at trial.
51. The Claimants said that the Partial designs were created (in the form of the 1856 boot) in October 2014 and the Heeled Regina was also created that month. It is clear from Mr Parker’s evidence, from the emails exchanged with Mr Lazo, and from F&F’s Instagram account that the 1856 design was made earlier than the Heeled Regina design, at some time between mid-October and 26 November 2014. I do not think that the timing of the creation of the Partial designs was contentious.
52. The Defendants disputed the claim that the Heeled Regina design also dated back to October 2014. It seems to me that the history of the creation of the Heeled Regina set out above shows that whilst Mr Parker may have had a fairly detailed idea in mind about that design in October, some of the design work, including the important detailing of the gusset, was not finalised until he met Mr Lazo in November 2014. The exchanges on 27 November 2014 show that prior to that date Mr Lazo had identified the design, attributed a design number to it, and accepted that it had been made exclusively for F&F. There was no suggestion that the design was recorded in a design document, and



the evidence did not clearly establish when the first sample of the Heeled Regina was made. However, by 27 November Mr Lazo was ready to make patterns and batches of the Heeled Regina, and so, on the balance of probabilities, it seems to me that a sample would have been made before that date, most likely when Mr Parker visited the factory earlier in November 2014. I reject the Claimants' submission that the design was complete in October 2014, whether or not recorded in a document or sample. I conclude that the subsistence of UKUDR in the Partial designs needs to be tested as at October 2014, and in the Heeled Regina design as at November 2014 (and prior to 27 November).

53. The Defendants concentrated their attack on the subsistence of the UKUDR upon the issue of whether the designs were commonplace in the sense explained above. They pleaded numerous earlier boot designs in support of their contention that the Heeled Regina design and the Partial designs were commonplace, and consisted of a combination of commonplace features. I was provided with pictures of the earlier boots, of varying degrees of clarity, but there was no direct evidence from anyone familiar with those designs, other than from Mr Parker who was familiar with some of the boots. The Defendants restricted their arguments at trial to 5 earlier designs. Those, and many of the other designs pleaded, share a number of features with the F&F designs in issue, such as a tassel hanging from the zip pull and a perforated or decorated fan shape at the top of the boot, which I gather are typical features of a Spanish riding boot. However, the Defendants did not contend that any of the earlier boots had all of the features of the Heeled Regina. I shall consider the five boots in what I believe to be their chronological order.
54. The first of the boots relied upon was style 1620, a knee-length Spanish riding boot shown in the Lazo & Duque 2010 catalogue. Whilst it had the fan detail and a tassel, and an angled if not curved zip, it had a flat heel and a heavy sole, and looked rugged and utilitarian. Mr Parker commented upon the narrower leg of his designs, and I consider that the 1620 looked markedly wider around the ankle than the Heeled Regina and the Partial designs, as well as being much heavier overall. The Defendants relied upon the 1620 in particular for some elastication at the back of the boot which is just visible in the catalogue. However, what one can see is a crinkled or gathered panel on the back half of the outside of the boot; it is not clear whether it extended around the whole of the back of the boot, or just to the centre back, nor is it clear whether the panel was made of or covered in leather. The 1620 may (I cannot be sure) have had the same concept as the Heeled Regina of elastication along the full height of the boot, at the rear of the boot, but this took a very different form and looked very different to the elasticated panel of the Heeled Regina.
55. Next in time was the "Central Hipica" boot. This was again very different to the designs in issue, in being a flat heeled, thick-soled, heavy and utilitarian looking boot. The Defendants relied upon it because it too had an elasticated panel, probably, although not definitely, with thin strips of leather attached to it. However, it seems from the photographs in evidence that the panel was just on the outer side of the boot, rather than at the centre back of the boot. It did not extend to the full height of the boot, but only to around mid-calf level, and had a curved edge.
56. Next, the Defendants relied on another Lazo y Duque boot from 2013 called the "Bota Kate." This had a slightly slimmer profile than the 1620, and a slightly higher heel, but

I would again describe it as a low-heeled boot. Its sole looked thicker than the Regina designs, though much less rugged than the sole of the 1620. It seems to me that the photograph in evidence may show stitching running down the centre of the front of the boot, but this may be a fault in the reproduction of the image. Certainly, the evidence showed no sign of any elastic panel, at the back or otherwise.

57. Some way into the proceedings, the Defendants learned of a boot which was referred to as the Cejudo boot, made by another artisan from Valverde, Manuel Cejudo. He claims (rightly or wrongly, as Mr Lazo also appears to have made this claim) to be the maker of the Spanish riding boots sold to the Duchess of Cambridge. The Defendants produced some pages from the Cejudo website from February 2014, showing thumbnails of a range of boots and other leather goods for sale. As the Claimants pointed out, the website appears to show that Mr Cejudo will make boots to order, combining features shown on the site. The Defendants amended the Defence to rely upon this boot:



58. Mrs Meikle provided an enlarged copy of the website thumbnail, and a video made by Cejudo in around 2011. The video was of poor quality, and I am not convinced that the boot shown in it, which Mrs Meikle said appeared to have an elasticated gusset at the back, was the boot above, as it seems to me to have a lower heel. Nor was the nature of the gusset (if any) at all clear. The photograph above is the only clear picture of this boot.
59. The Claimants pointed to various differences between the Cejudo boot and the Heeled Regina which are clear from the photograph above, such as the straight zip and the buckle across the top of the boot, but perhaps most importantly, the lack of any sign of an elasticated gusset at the back of the boot. It is not possible to see any form of elasticsation at the back of the boot. Mr St Quintin suggested that the Cejudo boot did not have a sloping top like the Claimants' designs, which may be right, it is hard to be sure. There are also double lines of stitching around the heel piece and full length vertical strips of leather on each side of the zip which in my view are quite prominent.
60. The Claimants also deny that the Cejudo boot shows that their designs were commonplace, because it was obscure. The evidential burden rests on the Defendants to show that it is not, whilst finding an obscure example which is fairly similar to the Claimants' design may not be enough to make the design commonplace. Here, the Defendants only discovered the Cejudo boot after a lengthy and thorough research process undertaken by their solicitors. Their solicitor, Mr Bevan, made a witness

statement in March 2021 in support of an application to amend the Defence to plead two earlier designs, the Abarca boot and the Cejudo boot. He explained that when preparing the Defence and Counterclaim in late 2019:

“We commissioned a prior design search from RWS, a well-known patent and design search agency. ... which undertook a comprehensive search of registered designs databases and other relevant literature. In addition, members of my firm (including me) undertook comprehensive Internet searches directed to searching for designs of Spanish riding boots of the appropriate period. In so doing we were aware from discussions with our client that designs of the particular kind of Spanish riding boot in issue originated from a town called Valverde ...”

Despite those extensive, professional and targeted searches, Mr Cejudo and the Cejudo boot did not come to light. It was only just before exchange of witness statements in February 2021, when Mr Bevan was looking for a document to exhibit to Mrs Meikle’s witness statement to give an introduction to Valverde, that he found an article (from Die Welt, in German) which mentioned Mr Cejudo, which led Mr Bevan to find the website page showing the boot relied upon. Mrs Meikle, who said that she was familiar with Valverde and its artisan producers, plainly knew nothing about Cejudo. Mr Parker, who had visited Valverde on a number of occasions, also said that he had never heard of Mr Cejudo.

61. I have considered carefully whether it suffices that the Cejudo design was shown amongst other designs on the Manuel Cejudo website. However, in my judgment the fact that neither the Cejudo website nor the particular boot relied upon came to the Defendants’ notice whilst carrying out their extensive research prior to filing the Defence, supports the conclusion that the Cejudo boot design was obscure. That view is reinforced by the fact that neither Mrs Meikle nor Mr Parker, both of whom were very familiar with Valverde and its manufacturers, knew of Mr Cejudo, let alone that boot. In my judgment, the Defendants have not shown that this boot might have been ‘current in the thinking of designers in the field at the time of creation of the designs.’ In the circumstances, in my judgment it is not to be taken into account as prior art for the unregistered designs. If I am wrong about that point, the fact that it had no elastics means that it would not affect the findings below as to the validity of the Heeled Regina design.
62. Lastly, the Defendants relied upon the 1856 boot. As may be seen from the photographs above, this had many of the same features as the Heeled Regina, save for the gusset at the back. It was developed from the Early Regina and, as I have explained above, was the forebear of the Heeled Regina. The Defendants said that the Early Regina was the same as the Abarca boot, and some of the photographs of *that* boot show that, when worn, it is loose fitting, and creases or wrinkles around the ankle. Mr Parker said that both the 1856 and the Abarca were wider boots than the Early Regina or Heeled Regina. It is not easy to resolve that dispute from the photographs in evidence, but on balance it does seem to me that the Abarca boot looked wider than the Early Regina but the 1856 had the same or much the same profile as the Early Regina (in its non-elasticated form). The emails in which Mr Parker asked Mr Lazo to make the 1856 do not refer to slimming the shaft of the boot, only to the sole and heel. However, the Heeled Regina appears to me to have a slimmer profile than the 1856, facilitated by the elasticated panel. In the circumstances, I accept Mr Parker’s evidence that the 1856 was a wider boot than the Heeled Regina.

63. The panelled gusset has a significant impact on the overall design of the Heeled Regina, not simply because it slims the boot, but because the panels run all the way from the heel piece up to the top of the boot. In contrast, the narrow strip of leather over the centre seam on the back of the 1865 boot runs only from the heel piece to the cuff which encircles the whole of the top of the boot. Mr Parker suggested that the new feature tended to elongate the appearance of the boot, and I accept that it does so.
64. The Defendants said that the Heeled Regina design was commonplace and, as the 1856 had all of the features of the RCD save for the back panel, it was in effect the Partial design shown at paragraph 16 above. The latter point was accepted by the Claimants in their Amended Reply and Defence to Counterclaim. The 1856 was never sold, probably because it was overtaken by the full Heeled Regina design, but, as I have said, photographs of it were posted on F&F's social media on 26 November 2014.
65. None of the prior art comprises a boot with an elasticated panel covered by thin strips of leather running the full height of the boot. Indeed, none of the boots I saw in the evidence appear to have had a panel/gusset even vaguely similar to that included in the Heeled Regina. The Defendants relied upon the elastication at the rear of the 1620 and (rear) side of the Central Hipica boots, but I am satisfied that such elastication looked completely different to the panel used in the Heeled Regina.
66. I conclude that the elasticated panel with its leather strips designed by Mr Parker was an original feature. Further, in my view, the panelled feature is of some visual significance to the overall design of the Heeled Regina, because it tends to elongate the look of the boot from the rear, and the elastication facilitates the narrower leg of the boot. In the circumstances, so far as the Heeled Regina is concerned, it seems to me that it is not, as the Defendants contended, a design consisting simply of a combination of run-of-the-mill features. Nothing resembling the panel feature has been shown to have existed in any other design in the field in question, and I am satisfied that the Heeled Regina was not commonplace as at November 2014.
67. Whilst the 1856 boot formed part of the design corpus from 26 November 2014, I have found that by then the design of the Heeled Regina had been completed. If I am wrong on that, and the Heeled Regina design was made a little later (as the Defendants suggest), in my view, the differences between the 1856 and the Heeled Regina designs are marked. Relying on the 1856 does not help the Defendants as it did not include the panel feature or anything like it, and I am satisfied that taking it into account would not render the Heeled Regina commonplace.
68. The position is different for the Partial designs. First, the Defendants pleaded that the Partial designs did not have sufficient originality in the copyright sense, allegedly as slavish copies of the Early Regina and an existing heel design. I do not accept that submission. In my view, the Partial designs are not simply a copies of any previous design(s). Whilst they may have been closely based upon the Early Regina, in my view, producing the design did require some design input in terms of the choice of the heel and sole. Applying the legal guidance which I have set out above, I reject the suggestion that they lacked the necessary copyright originality.
69. As for the allegation that the Partial designs are commonplace, it is of course necessary to consider them as a whole, not simply take a pick and mix approach to their features

and compare them to individual features of earlier designs. Not all combinations of known features produce a commonplace design. As pointed out in *Copinger & Skone James on Copyright* (at 13-120) where the goods are fashion items “often it is the particular arrangement of features that creates an aesthetic effect which, if new, takes the design above the commonplace.” Certainly, the Partial designs share a number of features with several of the earlier designs in evidence, but it is notable that the Spanish riding boots in evidence tend to have a flat or low heel, and in many cases a rugged, utilitarian sole. Apart from the Early Regina, the Bota Kate was perhaps the closest overall, with a heel that was low rather than flat, and a medium sole. If the Cejudo boot should (contrary to my finding above) also have been taken into account, I do not consider that it advances the Defendants’ arguments. It has a heel of much the same height as the Partial designs, but the zips are noticeably different, the sole looks thicker, the boot looks ‘clompier’ and the Partial designs lack the prominent buckle on the Cejudo.

70. The 1856 was described by F&F as “the new Regina” and the instructions given to Mr Lazo asked him to amend the Early Regina design, which had a flat heel. Raising the heel height and changing the sole of the boot to create the 1856 boot required, it seems, relatively simple changes, substituting well-known and commonplace components for the heel and sole of F&F’s existing boot, in contrast to the work done to produce the Heeled Regina design. There was no evidence that the profile of the boot was also changed at that point. I have considered carefully whether the new combination of features shown in the 1856 boot did produce a new aesthetic effect, and I have concluded that it did not do so. I do not consider that the 1856 would have excited any particular attention amongst those in the design field. I find that the Partial designs consisted of a relatively simple combination of well-known features, and the combination was commonplace. Design right does not subsist in the Partial designs.

#### *Ownership*

71. As to ownership of the designs, the Defendants alleged that Mr Parker was not, in reality, the designer of the Heeled Regina, but it was designed by Mr Lazo as the artisan producer; this was put on the basis that Mr Lazo had designed the 1727 boots, and then simply modified them. In my judgment, Mr Parker’s input to the creation of the Heeled Regina design was not that of a customer asking for some bespoke alterations to an existing design, but was sufficient that he was the designer. Mr Lazo was the skilled craftsman who followed Mr Parker’s instructions to create samples to the design. Not only do I consider that Mr Parker was the designer, but Mr Lazo acknowledged that to be the case, for instance in a letter which he wrote to F&F’s solicitors in July 2018. It is therefore unnecessary for me to deal with the alternative scenario put forward by the Claimants, that Lazo & Duque had granted F&F an exclusive licence to use the design.

#### *Copying*

72. I do not accept Mrs Meikle’s denial that the Version 1 boots were copied from the Heeled Regina boots. She maintained that Bruar had bought an existing Dakota design, its Model 94, but there was no evidence to support that claim, and a good deal of evidence which contradicted it.
73. Mrs Meikle accepted that when Bruar attended the 2017 MICAM show they were looking for boots competitive to the Heeled Regina, yet she denied that she had thought

that the Model 94 boot was a copy of the Heeled Regina. I found that response incredible, given the close similarity of the two designs. The very fact that for two consecutive years Bruar used photographs of the Heeled Regina boots in its catalogues to advertise its own boots speaks to the similarity between them – Bruar appears to have thought they were interchangeable or indistinguishable at least to its customers.

74. Moreover, no documents were disclosed by the Defendants to support the claim that the Model 94 boots were shown by Dakota at the trade show and bought there. Later documents suggest that they were not. For instance, in an email from Mr Arroyo to Mrs Meikle of 13 April 2018 he assured her that Dakota would deliver “the 2 models of Fairfax middle next week”, and there were references in various further emails passing between Mrs Meikle and Dakota to phrases such as “the two Fairfax boots” or “the other Fairfax boot.” It seems that Dakota’s price for the Amira copies was too high for Bruar, and in an email to Mr Arroyo in June 2018, Mrs Meikle complained “I need a price for the new Fairfax over the knee ... this is very, very expensive. The *other Fairfax boot* is only [ ] euro so [ ] euro cannot be right.” (emphasis added). In cross-examination, accepting that this was a reference to the Version 1 boot, she said that she would have referred to it in this way because Bruar had been wanting a competitive boot to the Heeled Regina. Again, I found that response incredible. The correspondence appears to me undoubtedly to refer to the Model 94 boot as a “Fairfax boot” in just the same way as the over the knee boots were (copy) Fairfax boots, that is to say, Version 1 was a copy of the Heeled Regina.
75. In all the circumstances, I conclude that Bruar wished to sell boots which looked like F&F’s boots, and asked Dakota to copy the Heeled Regina design when making the Version 1 and Version 2 boots. In my judgment, the denial of copying is incompatible with the documentary evidence.
76. Mr Birkbeck accepted that the 2018/19 catalogue had included F&F boots, and said that he was annoyed that the F&F boots, which were by then old stock so far as Bruar was concerned, had been included in the catalogue by mistake. He gave no real explanation of why the same thing had occurred in the previous year’s catalogue. In the light of Mrs Meikle’s email exchanges with Dakota, it seems to me that at least until June 2018 Bruar intended to sell the Version 1 boots, as well as the copies of the Amira boots. In the circumstances, the inclusion of the genuine Heeled Regina boots as well as its Version 1 boots in that year’s catalogue was probably done because of the continuing delay in receiving samples from Dakota, rather than just by mistake, either with the intention of supplying genuine F&F boots or (much more probably) because Bruar thought that it could advertise its boots by showing the F&F boots, and then supply its own boots.
77. It is less clear that the Version 3 boot was deliberately copied from the Heeled Regina. Mr Birkbeck’s email to Mr Lazo of 24 April 2019 did refer to two earlier design numbers, 1727 and 1969, which he said were combined to produce Version 3. 1727 was a flat boot with no elastication, a thick sole and a wider profile, which lacks many of the pleaded features of the Heeled Regina, and there is no explanation of how the heel/sole and shape of Version 3 were changed from the 1727 to look like that of the Heeled Regina. I was not shown the 1969 design, so assume that it is not relevant. When asked about this, all Mr Birkbeck said was that he had not ‘presented’ the Heeled Regina or the Version 1 or 2 boots to Mr Lazo. That does not strike me as a very complete

answer. He would hardly have needed to present the Heeled Regina design to Mr Lazo. On balance, I am satisfied that Bruar and Mr Lazo took the Heeled Regina design as their starting point, rather than any other Lazo & Duque product, and amended it in the hope of avoiding any infringement. As Mr Birkbeck accepted, it was “absolutely” in their “thought patterns,” and this explains the similarity of the heel and sole to those of the Heeled Regina, and the extension of the length of the tassel far beyond that of style 1727, or Versions 1 and 2, to be much closer to the Heeled Regina. I find on balance that this version too was copied from the Heeled Regina, even if it differs from it in the ways discussed below.

78. I therefore have no hesitation in finding that the Defendants’ boots were all copied – and deliberately copied – from F&F’s designs.

### *Infringement*

79. The Version 1 boots look, at first glance, identical to the Heeled Regina. On close inspection, one can discern some minor differences: there is narrow piping around the top of the boot, and the vamp or front of the boot is made in two pieces, not one. In my judgment, those differences do not affect the result. I find that the design was copied, and the Version 1 boots are made very substantially to the Heeled Regina design.
80. The Version 2 boots again differ slightly from the Heeled Regina. The piping has gone, but the main change was to reduce the number of leather panels over the elastic gusset from four to two. In my view this has a relatively limited impact, and in my judgment the boots are still extremely similar to the Heeled Regina design. I find that the Version 2 boots are made substantially to the Heeled Regina design.
81. It seems that the Defendants hoped to avoid infringement by the changes made to the Version 3 boot. Strangely, given that aim, the boot is more like the Heeled Regina in having a single piece of leather at the front, and no piping, as well as the longer tassel. And the elasticated panel in Version 3 has four vertical strips of leather covering it, instead of the two strips of the Version 2 boot. However, in my judgment the change to the placement of the elasticated panel takes a significant step away from the Heeled Regina. The back of the boot looks very different to the Heeled Regina, as it has a single strip of leather over the centre back seam (more like the 1856 boot). There is also a noticeable difference on the inside of the boot, where four vertical strips of leather run the full height of the boot and abut the centre side seam, with a wider roughly triangular panel between the strips and the centre back seam. The difference to the elasticated panel of the Heeled Regina was evident on inspection of the boots. In those circumstances, I find that the Version 3 boots were not made exactly or substantially to the design of the Heeled Regina.
82. As to infringement of the Partial designs, had I found them to be valid, for the reasons set out above I would have found that both of them were infringed by the Defendants’ Version 1 and 2 boots, and the Second Partial Regina was infringed by the Version 3 boots.

### *Secondary infringement*

83. For what it is worth, the Claimants also complained of secondary infringement under section 227(1), by importation, sale or offering for sale of infringing articles. In my view, the Claimants have satisfied the burden of showing that the Defendants had sufficient knowledge that their boots were infringing articles. Given my findings of deliberate copying, they had reason to believe the goods infringed.

*The RCD*

84. The next issue is whether the RCD is valid. There are, as HHJ Hacon stated in *Cantel* (above) 4 points to consider. First, the design sector. It was common ground that this was to be tested in light of the field of ladies' boots. Second is the identity of the informed user and the degree of their awareness of the prior art. Again, it was common ground that this was a buyer and/or wearer of such boots. Whilst Mr St Quintin suggested that such an informed user might include a retailer, he was happy to accept that the level of attention which would be paid to the goods would be that of a consumer. Thirdly, I must assess the designer's degree of freedom in developing his design, focusing upon elements in respect of which the designer had more design freedom. And lastly, I must compare the RCD with the earlier designs relied upon.
85. In my judgment, Mr Parker had a very wide degree of design freedom when designing the Heeled Regina. There are innumerable possible permutations of ladies' boot designs. It is clear from the evidence before me that there are large numbers of designs for ladies' boots which exhibit a host of different features and combinations of features. Indeed, evidence such as the Lazo y Duque catalogue of 2010 shows many forms of Spanish riding boots, which suggests that even in that sub-category of the appropriate sector here, there is design freedom.
86. The Defendants asserted 5 earlier designs against the RCD. These included the 1620 boot, the Cejudo boot, the Bota Kate and the 1856 boot which I have discussed above.
87. In addition, the Defendants relied upon another style shown in the Lazo & Duque 2010 catalogue, number 1727. Again, this had the fan detail and a tassel, and an angled if not curved zip, but it too had a flat heel. The design overall had a utilitarian look, with a substantial sole, though one which was possibly rather less heavy and rugged than the sole of the 1620. The boot had a relatively wide ankle and no visible elastication.
88. The 1620, 1727 and Bota Kate are all flat or low-heeled boots, and the 1620 and 1727 look heavier and more utilitarian than the RCD. I consider that they give a very different overall impression to the more elegant RCD, even without considering the impact of the back panel.
89. The closer designs to the RCD are the 1856 and the Cejudo boot. As for the Cejudo boot, as I have said, this also differed from the RCD, especially in the lack of any panel at the back of the boot, and in the addition of stitching and the buckle. The onus lies on the Claimants to show that the disclosure of that design could not reasonably have become known in the relevant circles in the normal course of business. Plainly, it could in theory have become known, as the design was on the Manuel Cejudo website and there is no evidence that the site was not freely accessible. However, equally clearly, the Defendants' initial professional searches for prior art did not turn it up, which would suggest that it could not *reasonably* have become known. With some hesitation, especially given my conclusion at paragraph 61 above, I have concluded that given the



general availability of trade websites, the Claimants have not satisfied the onus upon them to show that the Cejudo boot had not been relevantly disclosed for the purpose of considering the validity of the RCD.

90. In my judgment, the informed user knowing the design corpus and interested in the products concerned would understand the vertical lines shown on the back view of the boot in the RCD as indicating strips of the same material as the boot (leather or suede, etc) and many informed users would understand that they indicate the presence of an elasticated panel or gusset. This distinguishes the RCD from both the Cejudo boot (if I am right that it is relevant) and the 1856 boot. None of the 5 earlier designs has any such feature at the back of the boot, and in my judgment, the unusual rear panel is the feature of the RCD which will most strike the informed user. The Defendants submitted that the RCD was essentially a minor modification of the 1856 boot, so that the RCD is not valid. I do not agree. I am satisfied that the rear panel is significantly different to what had gone before, and the impact of the vertical strips or elasticated back panel (if so understood) is such that none of the earlier boots would produce the same overall impression on an informed user as the RCD. I therefore conclude that the RCD is valid.

### *Infringement*

91. My views on the infringement of the RCD reflect my views on infringement of the Heeled Regina design, although of course the tests for infringement are not the same. In my view, the very slight differences between the Defendants' Version 1 boots and the RCD, such as the piping at the top, would not produce a different overall impression from the RCD on the informed user carrying out a direct comparison of the designs. The Version 2 boots are less similar, but in my view the smaller number of vertical lines at the rear of the boots still does not produce a different overall impression to the RCD. Both of these designs infringe.
92. As for the Version 3 boots, in some ways, as I have said, they are closer to the RCD than Versions 1 and 2, especially at the front of the boot. However, the back of the boot and the inside of the leg where the Version 3 boots have the leather strips over the elasticated panel are in my view of more significance, given the significance of the rear part of the RCD design to its validity. I conclude that the Version 3 design produces a different overall impression to the RCD and so does not infringe it.
93. I will hear the parties as to the appropriate form of order, to the extent that this cannot be agreed.