



[2011] EWPC 15

Case No: 0 CL 70026

IN THE PATENTS COUNTY COURT

St. Dunstan's House
133-137 Fetter Lane
London EC4A 1HD

Date: 02/06/2011

Before :

HIS HONOUR JUDGE BIRSS QC

Between :

(1) ALBERT PACKAGING LIMITED
(2) ADRIAN WEINTROUB
(3) JEREMY WEINTROUB

Claimants

- and -

NAMPAK CARTONS & HEALTHCARE
LIMITED

Defendant

The Claimants appeared in person and for Albert Packaging Ltd
Joe Delaney (instructed by Shulmans LLP) for the Defendant

Hearing dates: 6th, 7th April 2011

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

.....

His Honour Judge Birss QC :

1. This is an action for infringement of unregistered design right relating to cartons. The cartons are used as packaging for tortilla type wraps. The claimants' case is that they designed a new kind of carton for wraps in 2005. They started manufacturing those cartons for Sainsbury in 2006. The cartons were supplied via an intermediary company. In 2008 the intermediary chose to move to the defendant (Nampak) to supply a wrap carton product instead. The claimants' case is that this new wrap carton product of Nampak's is a infringing copy of the claimants' design. Nampak deny infringement. They also challenge the subsistence of unregistered design right.
2. The claim form was issued in the High Court on 3rd July 2009. The Particulars of Claim were served at that time. Although the Particulars of Claim were settled by counsel, to a large extent the case has been conducted by the claimants representing themselves. On 5th January 2010 the case was transferred to the Patents County Court and on 30th March 2010 HH Judge Fysh QC made an order for directions to bring the matter to a trial in the next available window after 30th July 2010. Problems arose with security for costs and no trial date was arranged by the parties. On 23rd November 2010 the case came before me. Further directions to bring the case to a trial on 6th April 2011 were made.
3. The directions on that occasion also dealt with an important aspect of the dispute. A key part of the defendant's defence involved a carton design created at Nampak in 2005 and before anyone at Nampak could conceivably have been aware of the claimants' design. The authenticity of the 2005 Nampak design documents was a fundamental point. In a witness statement purporting to be of both Adrian Weintroub and Jeremy Weintroub of 16th November 2009 they had stated that they had challenged the validity of those documents and then said "*If these drawings are proven to have existed on the date claimed then there is no case to answer. Discussion on whether design right subsists in our design would be irrelevant.*" The defendant understood that that meant that the claimants recognised that their case must fail if the Nampak 2005 drawings were genuine and sought essentially to confirm that by a Part 18 Request dated 19th March 2010. No substantive reply to that Part 18 Request had been provided by the time the case came before me in November 2010. At the hearing the claimants were represented by Mr Robert Onslow of counsel. On their behalf he made clear that the claimants accepted, with the benefit of legal advice, that forgery should only be alleged where it is proper to do so on the material available. If an allegation of forgery was to be proceeded with it had to be properly made. The means by which such an allegation would be made, if it was to be made, would be in a Reply pleading from the claimant.
4. Accordingly the directions order of 23rd November 2010 provided that the claimants had permission to serve a Reply by 5th January 2011 and that if no Reply was served then the claimants would be precluded from advancing or relying on a case based on fraud and/or forgery on the part of the defendant. At the same time the claimants should respond to the Part 18 Request.
5. No Reply was served and the claimant stated by email on 4th January 2011 that "*We shall not be pursuing 'forgery' of your client's documents as there is sufficient evidence to prove copying.*" That was the response to the Part 18 Request.

6. The case proceeded to trial on that basis and came on before me on 6th April 2011. Adrian and Jeremy Weintroub represented themselves. With my permission (and the defendant's consent) they also represented the first claimant. Mr Joe Delaney instructed by Shulmans represented the defendant.
7. At the outset a problem arose in relation to the issue of forgery. It appeared that the claimants were seeking to re-open the very point which had clearly been dropped on 4th January. However during the course of the submissions it became clear that the claimants' point was not a general attack on the authenticity of the documents but a specific focussed point on one document (drawing 05G0168v1 from 2005) which had arisen recently. The claimants contended that the defendant's solicitors had provided them with two different versions of what was supposed to be the same document on two separate occasions. I permitted the claimants to explore the two versions point but made it clear that that did not entitle them, without further permission, to mount a wider challenge to the authenticity of the defendant's documents in the circumstances. In addition to their email of 4th January 2011, by CPR Part 32 rule 32.19 they had been deemed to admit the authenticity of the defendant's documents included in disclosure. No relevant notice having been served. The two versions point was addressed by Mr Wood of Shulmans who was called to give evidence to address the issue.

The witnesses

8. For the claimants I heard from Adrian Weintroub and Jeremy Weintroub. For the defendants I heard from David Wood, Martin Laker and Marc Kavanagh.
9. The Weintroub brothers are the sole shareholders in Albert Packaging. That company makes and sells packaging products and they explained that it exploits their intellectual property rights. Jeremy Weintroub is the person who draws a design for a new item of packaging but both brothers review the designs and make suggestions in order to finalise the design. Mr Delaney made no criticism of the two brothers as witnesses. They were good witnesses and gave their evidence entirely fairly. Indeed I should pay tribute to the manner in which they conducted the trial as a whole, which was exemplary.
10. Marc Kavanagh has worked as a carton designer since 1989. In 2003 he joined Nampak and has worked there ever since. He designed the 2005 Nampak designs. Mr Kavanagh made it clear that he was working off the documents available and had no independent recollection of the specific design exercise. He was able to look at the drawings and the various annotations and explain what they meant. The claimants made no criticism of Mr Kavanagh. He was a good witness.
11. Martin Laker is a design services manager at Nampak. Apart from an interlude between 1997 and 2000, Mr Laker has worked at Nampak since 1990. During his time at Nampak he estimates he designed in the region of 20,000 cartons. Mr Laker designed the Nampak design which is said to infringe. To some extent Mr Laker had an independent recollection of the events but, in a similar way to Mr Kavanagh, his evidence was largely based on the documents available. The claimants criticised Mr Laker for the evidence in his witness statement about the state of carton design for wraps at the relevant time. His position was significantly qualified in the course of cross-examination and I will deal with the evidence itself below. In the witness box

Mr Laker was a good witness and it was to his credit that he clarified his evidence about the state of carton design without equivocation.

12. David Wood is a solicitor at Shulmans. His evidence related to the new point about two versions of the drawing. He was a good witness. A point was raised that he was not an expert in relation to document scanning. Indeed he was not and he did not purport to be.

Law

13. The right itself is defined in section 213 of the Copyright Designs and Patents Act 1988:

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 any aspect of the shape or configuration (whether internal or external) of the whole or part of an article.

(3) Design right does not subsist in—

(a) a method or principle of construction,

(b) features of shape or configuration of an article which—

(i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or

(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part, or

(c) surface decoration.

(4) A design is not “original” for the purposes of this Part if it is commonplace in the design field in question at the time of its creation.

14. The definition of “design” in s213 is wide, and allows a claimant to assert design rights in only certain aspects of a larger article. It is however important to identify precisely which aspects of shape or configuration are relied on. The issue of originality/subsistence needs to be considered separately for each aspect relied on and the question of infringement is crucially dependent on what aspect is alleged to have been copied.

15. This has long been recognised, and it is why the pleadings in design right cases take on such importance – see for example Lewison J in *Virgin Atlantic v Premium* [2009] EWHC 26 (Pat) at paragraph 27 (quoting Laddie J in *Ocular Sciences v Aspect Vision Care Ltd (No.2)* [1997] R.P.C. 289):

27. One of the real difficulties of s.213 is that the claimant may select a part of the article and claim design right for that part only. The courts have recognised this possibility since the early days of design right. In *Ocular Sciences Ltd v Aspect Vision Care Ltd (No.2)* [1997] R.P.C. 289 Ch D (Patents Ct) at 422 Laddie J. said:

“ . . . the proprietor can trim his design right claim to most closely match what he believes the defendant to have taken. The defendant will not know in what the alleged monopoly

resides until the letter before action, or, more usually, the service of the statement of claim. This means that a plaintiff's pleading has particular importance. It not only puts forward the claim but is likely to be the only statement of what is asserted to be the design right.”

...

29. ...similarities between the design relied on and the allegedly infringing article are often relied on to raise the inference of copying which the defendant must then rebut. There is a danger that the ability of the claimant to select parts of his design which are small in comparison to the overall article will give rise to a distorted impression of what the defendant has done which comes close to reversing the burden of proof. This concentration on relatively minor aspects of the overall design also had a tendency to make some of the witnesses more defensive than they might otherwise have been.

16. In the present case the claimants defined the design on which they rely in three different ways. Two ways of putting their case were pleaded in the Particulars of Claim and a third was added in the claimants' skeleton argument. Mr Delaney did not object to the third approach. The exclusion provisions in s213(3) were not relevant to the first way the claimant put its case but Mr Delaney submitted that they were relevant to the second and third approaches.
17. Two points were taken – one under s213(3)(a) (method or principle of construction) and one under s213(3)(b) (the so called interface provisions).

s213(3)(a) method or principle of construction

18. Mr Delaney submitted that although designs that serve purely functional purposes are not denied protection, it is important when identifying the aspect that is relied upon to have in mind that design right does not protect ideas *per se* (in the way a patent might) even though these ideas might have been important in arriving at the design in question. I accept that submission. Design right only protects aspects of the actual physical manifestation of an idea.
19. In *Rolawn Ltd v Turfmech Machinery* [2008] EWHC 989 (Pat), the Claimant sought to protect not only the actual designs of its mower as it appeared in real life, but also aspects of that overall shape by reference to a more generalised level of abstraction. In rejecting this argument, Mann J explained the following at paras 79 et seq:

79. It is important to isolate the design in respect of which protection can be properly claimed, and it is vital to ensure that it falls within the definition of design. The Act defines design as “any aspect of the shape or configuration . . . of the whole or any part of an article”, and the right cannot exist until there is an embodiment of the design in an article or in a design document. This combination of features means that design right is confined to what one can actually see in an article—either the physical article or a

drawing. This is what one would naturally expect from the concept of “design” (which is what is protected) which is a physical manifestation of an idea, not some underlying abstraction, and it is reinforced by the definition of the “designer” in s.214 as, “the person who *creates* [the design]”. You cannot create a design until you have actually reduced it to a particular form. It is not a design while it is a conception in the designer’s head, and it becomes a design when it takes physical shape on paper or in the flesh.

80. This means that Mr Alexander’s more abstraction-based proposals for design right are not correct. His client is not entitled to claim design right in the abstraction of ideas involving folding over, folding again, and leaning on a stand and so on. Nor is it entitled to claim design right in the concept of a tank between two vertical support stands at the back of a wide-area mower. What it is entitled to claim design right in (subject, of course, to matters such as commonplace) is aspects or configuration of the physical manifestation, not some underlying design concept. ...

81. ...what is protected from copying in design right cases is the design, meaning the physical manifestation. It is not some underlying abstraction. The test for infringement is set out in s.226 ...if there is to be protection for the underlying ideas it must come through that, not because the underlying ideas are themselves the design. That, among other things, is probably one of the rationales behind the “method or principle of construction” exception.

...

84. ... Rolawn are not, on any footing, entitled to claim design right in the concept of a mower which has arms folding back on themselves at the mid-way point. What they may be entitled to claim design right in is in their *particular* mower, or an aspect of the shape or configuration of it, one of which shapes can be verbally described in the manner just set out, but in which it is the actual manifestation of it which is the design.”

20. As Mann J explained, this is one of the policies behind the specific exclusion that says design right cannot subsist in a ‘method or principle of construction’. This exclusion, and the ‘interface exclusion’, in s213 play an important part in the scheme of the 1988 Act by ensuring that design right provides a suitable amount of protection without unfairly restricting fair competition.
21. In *Landor & Hawa International Ltd v Azure Designs Ltd* [2007] F.S.R. 9 in the Court of Appeal, Neuberger LJ (with whom Wilson LJ agreed) approved the following formulation of this exclusion in *Russell-Clarke on Copyright in Industrial Designs*, 7th edn at para.3–80 at paragraph 13 of the judgment:

A method or principle of construction is a process or operation by which a shape is produced, as opposed to the shape itself. To say that a shape is to be denied registration because it amounts to a

method or principle of construction is meaningless. The real meaning is this: that no design shall be construed so widely as to give its proprietor a monopoly in a method or principle of construction. What he gets is a monopoly for one particular individual and specific appearance. If it is possible to get several different appearances, which all embody the general features which he claims, then those features are too general and amount to a method or principle [of construction]. In other words, any conception which is so general as to allow several different appearances as being made within it, is too broad and will be invalid.

22. This exclusion operates to limit the level of generality at which a definition of the design to be relied on can be stated: the more abstract the definition relied on, the more likely it is to fall foul of the exclusion – see Mann J in *Rolawn* at [91]-[96]:

91. [*The method or principle of construction*] point does not arise in relation to the particular designs of the overall machine in its unfolded, semi-folded and finally folded states. If one is looking at that overall design then it is simply not, in any sense, a method or principle of construction. ...

92. However, the exclusion of methods and principles of construction does provide another bar to the more generalised way in which Mr Alexander put his case on the subsistence of design right. The abstract idea of an arm holding cutters which folds over on to itself by means of a hinge in the middle seems to me to describe a method of construction of an arm. ...

...

96.... When he articulates the matter in the way he does, it becomes plain that he is describing a way of constructing a wide-area mower. It does not generate any single particular appearance of the mower; mowers produced in accordance with that general description could have very different appearances, albeit recognisable as coming from the same root. Frankly, I consider that the Turfmech machines achieve that. When one looks at those mowers, one can tick off a lot of the features, but the overall design impression is different. They are built to the same principles or methods of construction. There is no design right in those principles or methods.

23. I will apply this approach.

s213(3)(b) interface

24. As to the ‘interface’ exclusion under s213(3)(b)(i) Mr Delaney relied on the judgment of Laddie J in *Ocular Sciences* at p.424 as follows:

“This is sometimes referred to as the interface provision. It's original purpose was to prevent the designer of a piece of equipment from using design right to prevent others from making parts which fitted his equipment. As I read it, any features of shape or configuration of an article which meet the interface criteria must be excluded from being considered as part of the design right. Furthermore a feature which meets the interface criteria must be excluded even if it performs some other purpose, for example it is attractive. There is also nothing in the provision which requires the feature to be the only one which would achieve the proper interface. If a number of designs are possible each of which enables the two articles to be fitted together in a way which allowed one or other or both to perform its function, each falls within the statutory exclusion.”

25. The law on the interface point was not developed in detail at the hearing. Since (see below) I have found that the case based on the two approaches to the definition of the design to which this point might be relevant fails for other reasons, I will not consider it further.

s213(4) - common place

26. Nampak also contend that if the relevant designs are not excluded from protection under s213(3) they are nevertheless not protectable because they are “commonplace in the design field in question” under s213(4).
27. In *Farmers Build v Carrier Bulk Materials* [2000] E.C.D.R. 42 at p65 Mummery LJ said this:

(3) If the court is satisfied that the design has not been copied from an earlier design, then it is ‘original’ in the ‘copyright sense’. The court then has to decide whether it is ‘commonplace’. For that purpose it is necessary to ascertain how similar that design is to the design of similar articles in the same field of design made by persons other than the parties or persons unconnected with the parties.

(4) This comparative exercise must be conducted objectively and in the light of the evidence, including evidence from experts in the relevant field pointing out the similarities and the differences, and explaining the significance of them. In the end, however, it is for the court and not for the witnesses, expert or otherwise, to decide whether the design is commonplace. That judgment is one of fact and degree according to the evidence in each particular case. No amount of guidance given in this or in any other judgment can provide the court with the answer to the particular case. The closer the similarity of the various designs to each other, the more likely it is that the designs are commonplace, especially if there is no causal link, such as copying, which accounts for the resemblance of the compared designs. If a number of designers working independently of one another in the same field produce very similar designs by

coincidence the most likely explanation of the similarities is that there is only one way of designing that article. In those circumstances the design in question can fairly and reasonably be described as 'commonplace'. It would be a good reason for withholding the exclusive right to prevent the copying in the case of a design that, whether it has been copied or not, is bound to be substantially similar to other designs in the same field.

(5) If, however, there are aspects of the plaintiff's design of the article which are not to be found in any other design in the field in question, and those aspects are found in the defendant's design, the court would be entitled to conclude that the design in question was not 'commonplace' and that there was good reason for treating it as protected from misappropriation during the limited period laid down in the 1988 Act. That would be so, even though the design in question would not begin to satisfy any requirement of novelty in the registered designs legislation.

28. In *Ocular Sciences* Laddie J said (at p429 line 48)

the flavour of the word is . . . a ny design which is 'trite, trivial, common-or-garden, hackneyed or the type which would excite no peculiar attention in those in the relevant art'.

29. As to the "design field in question", it is a question of fact for each case: see Mummery LJ in *Scholes v Magnet* [2001] EWCA 561 Civ, [2002] E.C.D.R. 20 at para 32:

32. The expression "design field in question" is not legally defined in the 1988 Act. It must accordingly be understood in its ordinary and natural meaning, bearing in mind that the purpose of the provision in subsection (4) is to withhold legal protection from commonplace designs. The expression is obviously intended to set sensible limits to the inquiry whether a design is "commonplace". The making of comparisons with other designs is the essence of that inquiry. The outer bounds of the limits on comparisons with pre-existing designs are matters of fact and degree to be assessed by the tribunal of fact in taking account of all the relevant circumstances of the particular case.

30. Moreover in *Lambretta v Teddy Smith* [2004] EWCA (Civ) 886 Jacob LJ (with whom Mance and Wedley LJ agreed (on this issue)) said at paragraph 45:

I think that when the Act speaks of "design field in question" a reasonably broad approach is called for. What matters are the sort of designs with which a notional designer of the article concerned would be familiar.

31. When comparing how similar a particular design is to others in the field for the purposes of determining whether it was commonplace, the court needs to do this through the eyes of the person to whom the designs were ultimately intended to

appeal, not through the eyes of an expert in the particular design field – see Mummery LJ in *Scholes* at paragraph 49:

49. The deputy judge made the comparisons by considering the similarities and differences in the designs from the point of view of a person to whom it was ultimately intended that the design should appeal, rather than from the point of view of the expert in the design of window horns. He considered the appeal of the design to “the market to which the window was aimed, whether that is viewed as a market of individual home buyers or replacement window purchasers or the arguably more sophisticated market of developers and architects”.

50. In my judgment this was the correct approach. I would reject the submission made on behalf of Scholes that the comparisons should be made from the point of view of the designer who is expert in the design field in question. Expert evidence is admissible to assist the court in the perception and appreciation of the differences and similarities in the designs compared. But it is not necessary to be an expert in the design field in question either to appreciate the similarities and differences between the designs compared or to form an opinion whether the design in which design right is claimed is “commonplace”. At the end of the day it is for the court and not for the experts, whether they be parties or witnesses called by the parties, to determine objectively on all the evidence whether the design is commonplace.

32. I will follow these cases below on the question of whether the designs are commonplace in the design field in question.

Ownership of design right

33. There is an issue in the case about whether Albert Packaging has an exclusive licence. The relevant provision of the 1988 Act is section 225 as follows:

225.— Exclusive licences.

(1) In this Part an “exclusive licence” means a licence in writing signed by or on behalf of the design right owner authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the design right owner.

34. Note that the 1988 Act requires a licence in writing and requires a signature of the design right owner. In order to seek to contend that no such document in writing was needed, the claimants drew my attention to *Ifejika v Ifejika* [2010] EWCA Civ 563 in which the Court of Appeal referred to “design rights” as being assignable like any other form of chose in action and held that s2(2) of the Registered Designs Act 1949 imposes no requirements as to the form of any assignment or transmission of the right (paragraph 25). However that case is not relevant because it is not concerned with the formalities laid down in the 1988 Act for creating an exclusive licence of unregistered design right. The rights given by the 1988 Act to an exclusive licensee (to bring

proceedings) are statutory and the statute only gives those rights to the holder of an “exclusive license” as defined. In my judgment the formalities on s225 have to be complied with to acquire the right to sue. I suppose in some cases a claimant in a similar position might contend that they had an equitable right to call for a written agreement or licence, try to start proceedings and then produce a formal document during the proceedings perfecting their title; but no such submission was made in this case and I do not need to address that question.

Infringement of design right

35. Section 226 defines acts of primary infringement as follows:

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.

36. As was explained by Lewison J in *Virgin*, the test requires comparison of the alleged infringing article against the article that is said to embody the design relied on, the question being (1) whether copying has occurred and (2) if so whether the alleged infringement has been produced “exactly or substantially” to the copied design:

31. What must be established is that the design in which design right subsists has been copied so as to produce “articles exactly or substantially to that design”. Two points arise. First, although the Act allows design right to subsist in (and be claimed for) part of an article, the definition of reproduction speaks only of making “articles”. There is, therefore, a linguistic mismatch between subsistence of design right and the right that it confers. But it must obviously have been Parliament’s intention that if design right subsisted in part of an article (e.g. the teapot spout) the right would be infringed by incorporating a copy of that spout in another teapot, even if the infringing spout is not itself a whole article. Secondly, even if the design has been copied, the infringing article must be produced “exactly or substantially” to the copied design. Mere similarity is not enough.

32. In *C&H Engineering v F Klucznik & Sons Ltd (No.1)* [1992] F.S.R. 421 Ch D Aldous J. said:

‘Under section 226 there will only be infringement if the design is copied so as to produce articles exactly or substantially to the design. Thus the test for infringement requires the alleged infringing article or articles be compared with the document or article embodying the design. Thereafter the court must decide whether copying took place and, if so, whether the alleged infringing article is made exactly to the design or substantially to that design. Whether or not the alleged infringing article is made substantially to the plaintiff’s design must be an objective test to be decided through the eyes of the person to whom the design is directed.

37. In this case the claimants’ seek to draw an inference based on what are said to be certain close similarities between the Albert Packaging design and the Nampak design. In these types of case Park J’s observation in *A Fulton Co Ltd v Grant Barnett & Co Ltd* [2001] R.P.C. 16 at [95] is applicable:

The courts proceed on the basis that a close similarity between the claimant’s design and the alleged infringing article, coupled with the opportunity for the alleged copier to have access to the claimant’s design or work, raises an inference of copying. It is then up to the defendant to rebut the inference by evidence which shows that the apparent similarity arose in some other way.

38. But as Lewison J pointed out in *Virgin* (quoting Mummery LJ in *Farmers Build*), it is important to have in mind that similarity (even substantial similarity) between designs can often be explained not by the fact they were copied, but by some shared functional requirement between the designs:

35. ... it is also important to bear in mind Mummery L.J.’s warnings in *Farmers Build* (at 481 and 482):

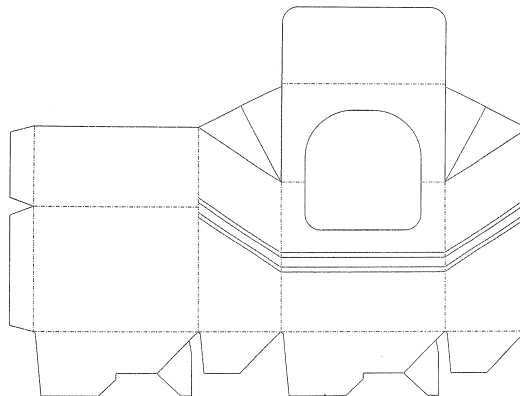
“Substantial similarity of design might well give rise to a suspicion and an allegation of copying in cases where substantial similarity was often not the result of copying but an inevitable consequence of the functional nature of the design. . . Copying may be inferred from proof of access to the protected work, coupled with substantial similarity. This may lead to unfounded infringement claims in the case of functional works, which are usually bound to be substantially similar to one another. . . . [The court] must not forget that, in the field of designs of functional articles, one design may be very similar to, or even identical with, another design and yet not be a copy: it may be an original and independent shape and configuration coincidentally the same or similar.”

36. However, as in any case where there are factual presumptions and shifting evidential burdens, the question of copying is in the end a question of fact; and one which must be proved by the claimant on the balance of probabilities.

39. On the basis of these authorities, the approach I will take to infringement is as follows. First I will consider whether the similarities between the Nampak product complained of and the Albert Packaging design (as well as the possibility of access) call for an explanation. In other words - do they raise an inference of copying? In considering that matter I will bear in mind that functional features may be similar because they are performing a function not because of copying. If an inference is raised then I will consider what explanation Nampak put forward. In the end I will compare the Nampak product and the design objectively, reminding myself that for infringement, the relevant article must be produced exactly or substantially to the design.

Subsistence and title to unregistered design right

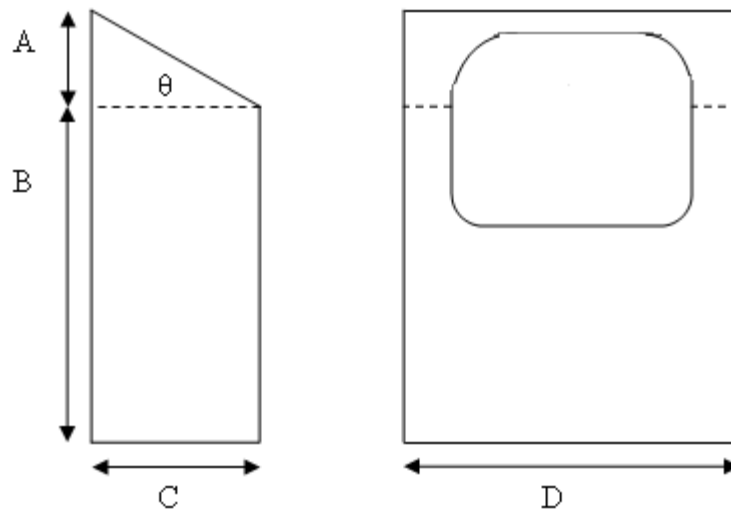
40. The claimants' case is that they designed a new kind of carton for wraps in 2005/2006. There are various different ways of representing the claimants' design. Packaging designers create the designs by drawing a plan of the cardboard which will be used to make the finished carton. The plan shows elements such as cuts and creases in colour. The design can also be described to some extent by a list of features and also by elevation diagrams of the carton in its filled state. I will use all three in this judgment.
41. As a cardboard plan (without dimensions marked and in black and white) the claimants' design is shown below:



42. This drawing shows the flat card with lines depicting folds and such like. The carton is made by first folding and gluing the card into a form of flattened tube. To fill the carton, the flattened tube is opened up. The parts making up the base point inwards in the flattened state and are pushed down to lock in place when the carton is opened up. The base is called a “crash lock” base to describe that process of locking the base in place. At the back there is a tuck flap to close the carton. There is a score line running along what will be the top of the carton – shown as a dashed horizontal line above the window.
43. When folded up into a carton, the carton has a rectangular base and vertical flat sides. The front consists of a vertical panel and then an angled panel sloping backwards to meet the rear panel at an angle. In the middle of the front, straddling the vertical panel and the sloping panel, is a transparent window. The wrap starts as a single cylinder with the filling inside. An operator cuts the wrap at an angle (the angle is set

by a frame) to produce two cylindrical pieces with sloping ends. The two pieces are put side by side in the carton. The cut faces of the two parts of the wrap can be seen through the window and so the customer can see the contents of the wrap.

44. The carton has a pull tab so that the user can open it (that is shown in the drawing above as two pairs of parallel lines running across the front and sides). It is barely visible in the finished product.
45. Below are representations of a side and front elevation of the claimants carton in its assembled state which I have prepared for this judgment. They are not to scale and the dimensions and proportions are only rough:



46. Dimensions $A + B$ determine the height of the carton, dimension C determines its depth and dimension B on its own determines the height of the front vertical panel. Dimension D is the width of the carton. The angle of the front sloping panel to the horizontal is θ . To the nearest mm (or degree), the claimants' dimensions are $A = 35\text{mm}$, $B = 95\text{mm}$, $C = 52\text{mm}$, $D = 104\text{mm}$ and $\theta = 34^\circ$.
47. The salient features possessed by the claimants' carton can be conveniently listed as follows:-
- a rectangular based box, the dimensions A , B , C and D being as set out above;
 - a sloping front face, sloping at an angle determined by A and C ;
 - a broadly rectangular window partly on the flat front face and partly on the sloping face with a large diameter rounded top and small diameter rounded lower corners;
 - a crash lock base;
 - a straight tucked flap;
 - a score on the top ridge;

(g) a pull tab.

48. The claimants define the design in which they claim unregistered design right in three ways. They are:
- (1) The shape of the carton in assembled form;
 - (2) A generally rectangular box save in that the top face slopes downwardly from the rear face to the front face, there being a window extending from the sloped top face onto the front face;
 - (3) The distance from the shoulder of the pack to the top of the back panel, along the back panel, is 35mm regardless of the length or width or depth of the pack.
49. Approach (3) is the one which was only raised at trial. It relates to dimension A above. Nampak did not object because they were ready to deal with it. They had anticipated that a point of this kind was being developed by the claimants although they had seen it as a focus on the angle θ being 34° rather than dimension A being 35 mm.
50. The designers were the Weintroub brothers. They worked closely together on the design, although Jeremy Weintroub actually drew the drawings. As far as I am aware, whether the designer was just Jeremy Weintroub or Jeremy and Adrian Weintroub together is not a vital point but in any case I find that the design was a collaboration between both of them (under s259 of the 1988 Act). They are joint designers.
51. The claimants make no claim that Albert Packaging owns the designs and it is notable that the claimants' carton when on sale was marked "All rights reserved A & J Weintroub". However they do contend that Albert Packaging has an exclusive licence under any unregistered design right. During the proceedings the claimants were pressed for a written document to this effect and none was produced. By an email the claimants explained that their case was that "the relationship between Albert Packaging and A & J Weintroub is such that a non-written agreement suffices." The relationship is that Adrian Weintroub and Jeremy Weintroub are shareholders in Albert Packaging and the company only manufactures intellectual property of the two brothers.
52. In the absence of a signed written document, s225 of the 1988 Act is not satisfied. I find that Albert Packaging does not have an exclusive licence under the 1988 Act.
53. As regards the exclusions, Mr Delaney submitted that approaches (2) and (3) are excluded from unregistered design right protection by s213(a) as a method or principle of construction.
54. I will consider s213(a) in relation to approach (3) first because it seems to me to be a plain case. To give the claimants a monopoly in a single dimension (A =35mm) regardless of the length depth or width of the pack and regardless of the presence or shape of a window is too general. Although one could quibble that the definition does not say so, I will take it that this design is intended to apply only to sloping fronted rectangular based packs. Even with the limitation, approach (3) is a concept which

allows for all kinds of appearances to be made within it. It would include a box with no window, a box with a window of any shape in any position and a box with numerous windows. It would include a stubby short box (dimension B very small) consisting of little more than the sloping front and it would also include a pack with a very steep front angled face (dimension C very small). These examples produce very different appearances from each other and from the existing Albert Packaging product. Thus approach (3) is excluded by s213(a).

55. Approach (2) is less general than approach (3). A key aspect of the appearance of the product is the window and approach (2) captures that to some extent by requiring the window to be present and to extend from the sloped top face onto the front face. However it seems to me that this way of defining the design still falls foul of s213(a). It is narrower in scope than approach (3) but in the end it is ultimately nothing more than a definition of a concept rather than a definition of a design with a specific, individual appearance. To accept this definition in effect would be to give the claimants a monopoly akin to a patent monopoly (albeit limited to cases of copying) in any pack which satisfied that definition. But packs which still satisfy that definition will have very different appearances – there is no restriction on the relative dimensions. Thus as with approach (3), stubby short boxes and steeply angled boxes will be included although they look entirely different. Also there is no restriction on the shape of the window – so although the design involves a sort of rounded rectangular window, this definition will include (say) a product with a triangular window, again looking very different.
56. Thus both approaches (2) and (3) are excluded by s213(a) of the 1988 Act.
57. As regards originality, the defendant did not deny originality of the design in the “copyright sense” (whichever approach is taken) but they did contend the designs were commonplace in the design field in question.
58. For the question of “commonplace” it was common ground that 2006 was the convenient and appropriate year to consider. The claimants contended that their design was a new departure for wrap cartons. They said that at the time wraps were packaged either using a carton known as a chip scoop or a watch strap. They explained that their design allows the two halves of the wrap to be presented side by side with their cut faces presented to a purchaser in an attractive manner. The sloping face with the window was the product of careful design work to rise at a steeper angle than the cut face of the wraps themselves and therefore avoid unattractive smearing. In practice when the wrap has been filled and rolled up by hand by a worker, the wrap is cut on a standard tool such that the angle of the cut is predetermined and is essentially the same all the time.
59. Mr Laker’s first witness statement dealt with design concepts for wrap cartons. This included discussion of “top loading” – i.e. placing the cut wrap pieces inside the box from the top to avoid smearing the window; and positioning the window in order to allow the customer to see the cut face of the wrap. Mr Laker went on to state that in his opinion these concepts were as true and well known today as they were in 2006. Thus as stated in his witness statement, wrap packs of the same general configuration as the claimants’ were said to be well known in 2006.

60. Mr Laker was cross-examined by Jeremy Weintraub. Mr Laker accepted that two well known wrap pack designs in 2006 were the watch strap and chip scoop. The watch strap consists essentially of a flat piece of card on which the wrap rests. The card is longer than it is wide and the wrap lies along its length. There may also be a fold running along the length of the base card. A thin strip of card comes over the top of the wrap like the strap of a watch and the whole thing is wrapped in clear plastic. The chip scoop is so called because it is like the small trough shaped container used in fast food outlets to provide a portion of chips. It is open at the top. When the wraps are in place the whole pack is wrapped in plastic.
61. The case Mr Weintraub put to Mr Laker was that despite what was said in the witness statement, wrap packs with a window in the front (like the Albert Packaging product) were not in use in 2006. To reinforce his case Mr Weintraub put a Nampak patent application to Mr Laker. It was GB2 443 063A naming Mr Laker as the inventor and with a priority date of October 2006. The title is “Carton with curved wall for bakery products” and the first sentence of the abstract states “The carton, suitable for products such as baguettes, sandwiches or wraps, comprises ...”. It is clear therefore that wraps are included within the contemplation of the document although it is of course not limited to them. On the first page of the specification the background is discussed. The paragraph discusses the conventional triangular prisms used to pack sandwiches, making the point that sandwiches are usually triangular in shape and then states:
- However it is becoming increasingly common for sandwiches to use different varieties of bread and/or the like. These types of sandwiches cannot fit into conventional triangular prism type cartons and are currently located in a cellophane covering or supported on a board platform and surrounded by cellophane or plastic type wrapping.
62. This is clearly a reference to the watch strap and Mr Laker accepted it as such.
63. The upshot of the cross-examination was clear. In the context of packaging for wraps, the only designs which were commonplace in that field in 2006 were the wrist strap and chip scoop.
64. Martin Laker accepted without equivocation that in the marketplace for wrap products in 2006, packs with a window in the front like the claimants’ design were not in use and were not on the market. The reason Mr Laker had referred to packs with windows in the front related to the 2005 Nampak design which I shall return to below. That product did not reach the open market.
65. However is the relevant design field limited to boxes for wraps? In my judgment it is not. The Court of Appeal in *Lambretta* (above) made it clear that what matters are the sort of designs with which a notional designer of the article concerned would be familiar. The evidence was clear that there is no such thing as a wrap box designer. The relevant designers, including each of Martin Laker, Marc Kavanagh as well as Jeremy and Adrian Weintraub, design cartons generally. The Weintraubs design packaging used by McDonalds and Kellogg and there was also evidence of the range of goods designed by Marc Kavanagh. The design field in question in this case is not

limited to wraps or sandwiches. Mr Delaney submitted the field was simply carton design. I accept that submission.

66. Mr Delaney produced a number of examples of cardboard packages (often for Easter eggs) and put them to Adrian Weintroub to establish the proposition that at least as defined in approach (2), the claimants' design was commonplace in the field of carton design. The examples put by Mr Delaney included a number of rectangular based boxes with a sloping fronts and windows on the slope, with dates ranging from 1986 to 2000. They included various Black Magic Easter Egg boxes, a Dairy Box Easter egg, Terry's chocolate log and a pack from Waddingtons Cartons Ltd. Mr Weintroub's response in cross-examination was to stress two aspects of the claimants' design – that the sloping wall was attached to the back wall (in other words the sloping face could be regarded as the top of the box, angled downwards) and that the window on the sloping panel joined the window in the bottom front panel.
67. It is fair to say that the only examples put by Mr Delaney in which the window extends from a sloped face onto the front face were packs in which the sloped face was not the top face of the box. In those cases, the slope took the form of a chamfer off the front top edge and so, looked at side on, the box had 5 faces rather than 4 as in the claimants' pack. However does this mean that approach (2) avoids being a commonplace design in the carton design field? I find that in the field of carton design as a whole, sloping front faces and windows are commonplace features of rectangular based packs. Stated at the same level of generality as approach (2), designers working independently have used the same basic elements and have mixed and matched them as they see fit. The people to whom these cartons are aimed are the general public, buying whatever product is inside the box. From their point of view cartons with the features described at the level of generality of approach (2) are commonplace designs of carton. In my judgment the key is the generality of the definition. There is nothing in it sufficiently specific to attract the notice of a customer. I should say that approach (3) must also fall on the same basis.
68. However approach (1) is a different matter. To say that the particular combination of all the specific features of the Albert Packaging carton in its assembled form is commonplace would deny packaging designers any design right at all. That would fail to recognise the skill they employ in their work. Their skill involves work at a more detailed level than the definition in approach (2). The skill involves the selection of particular sloping faces at particular angles, particular windows with particular shapes, a particular kind of flap and so on. The details are adjusted in order to produce a package which will play its part in attracting a customer. In my judgment the particular combination of elements making up the design as defined in approach (1) is not commonplace.
69. I should record that there were a number of wrap packs in evidence with sloping top faces with windows across both the sloping and front face. Mr Delaney submitted that although they post-dated the relevant time they could be regarded as evidence of what was commonplace in 2006. I do not accept that on the facts of this case. I can see that in some cases such an approach might be legitimate but in this case I am not satisfied that the later designs were not derived at least to some extent from the claimants' design. The claimants' concept was clearly a new departure for wrap products, having regard to what had been on the market before, and I would not be

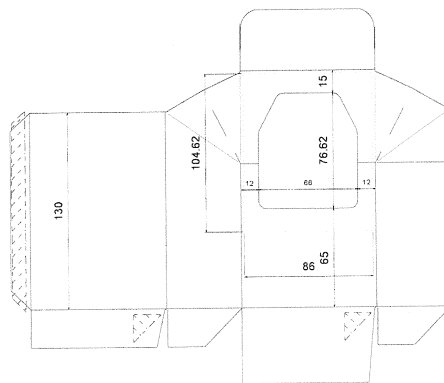
surprised if the idea had been picked up by others once Albert Packaging's product was available.

70. Thus, in conclusion, the second and third claimants are entitled to unregistered design right in their package design as defined in approach (1). Unregistered design right does not subsist in a design defined by approaches (2) and (3).

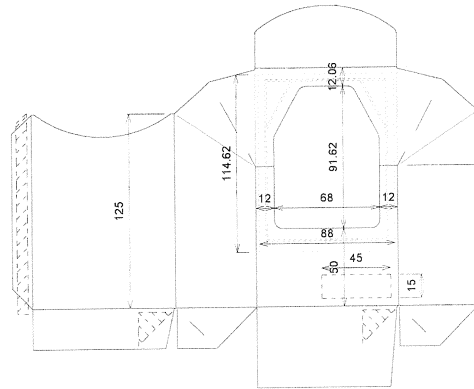
Inference of copying?

71. The claimants' design was successful and Albert Packaging started manufacturing cartons made this way for Sainsbury in 2006. The cartons were supplied via an intermediary company called Buckingham Foods. Buckingham Foods bought the cartons from Albert Packaging, erected them and put the wraps inside and sold the filled cartons to Sainsbury.
72. In 2008 a so called "re-tendering" process was carried out. The result of this process was that Buckingham (and another intermediary called Greencore) stopped buying Albert Packaging's carton. They bought a carton from Nampak instead. The claimants' case is that this Nampak carton was copied from their carton and that represents unregistered design right infringement.
73. Nampak produced two variants of the carton design for Buckingham and two for Greencore. All the designs were produced by Martin Laker. The design ultimately produced for Buckingham was drawing 09G0024v2 dated 16th January 2009. The design produced for Greencore was 09G0079v2 dated 3rd February 2009. Representations of these two designs are shown below:

09G0024v2:



09G0079v2:



74. From the point of view of the side and front elevations of the cartons in their erected state, the only major visual differences between the Nampak cartons and the Albert Packaging design are the shape of the window and the width (D). In the Nampak designs the windows have chamfered top corners unlike the Albert Packaging windows and the Nampak cartons are somewhat narrower (in the Nampak cartons D is about 90mm).
75. From the claimants' point of view, it is clear why a complaint was raised in these circumstances. The opportunity to copy the Albert Packaging carton clearly existed since the Nampak carton replaced the Albert Packaging carton at Buckingham. Equally, looked at in broad terms the cartons are clearly very similar, although not identical.
76. This is a plain case which calls for an answer. Without an explanation from Nampak, the only inference to draw would be that the products were copied from the Albert Packaging design. In my judgment a mere coincidence of functional features is no answer. The fact that both arrangements employ a single window extending from the sloping face down to the front vertical face is striking and cannot in my judgment be explained simply as the product of a function.

Nampak's explanation

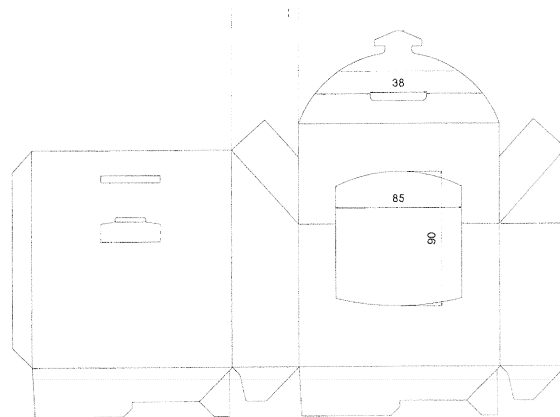
77. Once the complaint was raised Nampak investigated the matter and the design history of the product accused of infringement was established. The history goes in three steps. First in 2005 Marc Kavanagh produced two designs for Food Service Solutions (05G0164v1 and 05G1068v1). Next in 2007 Martin Laker produced a design for a "Pizzatilla box" for Buckingham Foods (07G2168v2). Finally the design actually pleaded as the infringing product was produced in 2009. It was based ultimately on the Pizzatilla box and one of the 2005 designs.
78. From their disclosure documents, Nampak drew attention to the records relating to the design of a different carton. The carton itself was not relevant to the case. The point was that the design documents for that example expressly record that the design was produced by copying an existing product. I should note in passing that there is of course nothing wrong with copying an existing product per se. It might be your own product, you might have permission to copy and so on. Nampak submitted that this showed that when they made a design, the records would show if it had been copied from another product. Since, Nampak contended, there was no record of copying

Albert Packaging's carton in this case, it did not happen. However I do not accept that things are as simple as that. The evidence did not establish that the record keeping was so perfect that an absence of such a note meant it did not happen. Moreover, the relevant records in this case do contain some important information, which I will address below. Finally I should record that the claimants submitted this example showed that Nampak had a propensity to copy other people's designs. Such arguments are sometimes made in design and copyright cases. In this case I reject the submission. First, as I have said, merely copying a product is not necessarily wrongful. Second, given the volume of work Nampak's designers undertake, this episode is not evidence of a propensity of any kind.

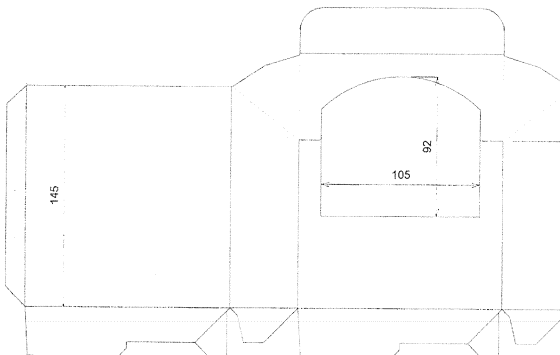
Marc Kavanagh in 2005

79. In February 2005 Marc Kavanagh was asked to prepare two carton designs to be provided as samples to a client of Nampak's called Food Service Solutions. He produced drawings 05G0164v1 and 05G1068v1. They were to be used to package paninis. The designs are:-

05G0164v1:



05G0168v1:



80. If genuine, there is no question of copying in relation to these drawings. They were produced before anyone at Nampak could have been aware of the claimants' design. The only point relating to their authenticity which was live at the trial arose as follows. There were two copies of drawing 05G0168v1 before the court but the two drawings were not identical. They differed in that a diagonal line forming part of the

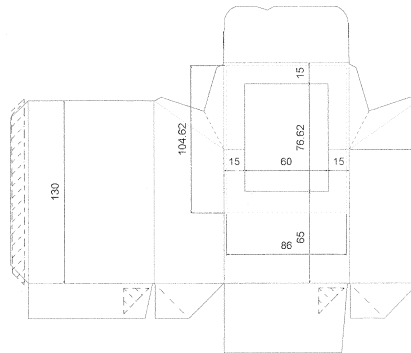
crash lock base showed as a green line in the version in the trial bundles and a half green and half red line on a further copy of the same drawing which had been sent by Shulmans to the claimants. Red would represent a cut whereas green represents a crease in these sorts of drawings. Understandably the claimants were suspicious.

81. Mr Wood investigated the matter and explained what had happened. I accept his explanation. It was as follows. A copy of drawing 05G0168v1 was exhibited to the statement of Mr Kavanagh. It is part of exhibit MK1. The paper copy of the document held by Shulmans had been printed by them on a colour printer following an email from Nampak. It was to be the fourth page of the exhibit and Shulmans marked it with a manuscript 4 at the bottom. Along with the rest of the witness statement, Shulmans scanned the papers copies and sent them electronically to the claimants. The scanned version of 05G0168v1 received electronically by the claimants is the one with a part red part green line. Then Shulmans made photocopies of the printed documents they held in order to prepare the trial bundles. The page numbers in MK1 had to be redone because the photocopying process had lost some of the page numbers off the bottom. The copy of 05G0168v1 in MK1 in the trial bundle (at page 4 of tab 3A of trial bundle IIB) has a 4 scored out and a new 4 written beside it. That was done by Mr Wood. It also has a wholly green line in the relevant place instead of a part red part green line. Thus Mr Wood was able to confirm that the discrepancy must have been caused by the differences in the way the documents had been produced but that the discrepancy had no wider significance. The two versions were both derived from the same document at Shulmans. Mr Wood did not profess any expertise in scanning or printing documents but that did not matter because he was able to give clear evidence that the two sheets derive from the same source at the solicitors' office. I find that the discrepancy is an artefact of the scanning process. The point does not raise any question mark over the authenticity of Mr Kavanagh's 2005 designs.
82. In cross-examination Marc Kavanagh was questioned about the process of giving samples to customers, the manner in which the client (Food Service Solutions) was named on the documents, the way the system recorded dates and other matters. In my judgment none of it undermined Nampak's fundamental position that the 2005 documents are perfectly genuine and Marc Kavanagh drew them at that time. I find that Marc Kavanagh did indeed prepare both 05G0164v1 and 05G1068v1 in February 2005 (05G0168v1 is dated a day later than 05G0164v1 and refers to it). The work was entirely independent of the claimants. The designs are rectangular based cartons in which the top face slopes down from the rear and with a window extending from the sloped top face onto the front face. For what it is worth they satisfy the definition in approach (2) albeit that they were produced independently. That reinforces my view that approach (2) is commonplace.
83. The window has a rectangular base and a curved top. There are webbed flaps between the sloping face and the side walls in 05G0168v1 while in 05G0164v1 there are just flaps. At the back 05G0164v1 has a rounded flap with an arrow to tuck into a slot while 05G0168v1 has a straight edge at the back. The dimensions of 05G0168v1 are A=35 mm, B=110 mm, C=45 mm, D=135mm. Thus although it is somewhat wider than the claimants' design, it is notable that A=35mm and 05G0168v1 satisfies the design as defined in approach (3). The dimensions of 05G0164v1 are A=50 mm, B=95 mm, C=45 mm, D=135 mm.

84. Food Service Solutions did not take the product from Nampak and packages to these designs were not put on the market. However as with all Nampak designs produced in this way, they stayed on the Nampak computer system.

Martin Laker in 2007

85. The Pizzatilla box (07G2168v2) became the focus of the claimants' case at trial. It is:



86. In terms of dimensions A=35 mm, B=95 mm, C=50 mm, D=90 mm.
87. Martin Laker explained that the Pizzatilla box was designed because Buckingham Foods wanted a wrap package for supply to the supermarket ASDA. The relevant documents carry a note that the style was “as per 05G0164 sized around wraps supplied – (in old fridge)”. In my judgment that record on the documents showed that Nampak cannot rule out the possibility that ideas derived from Albert Packaging’s product may have found their way to Martin Laker either directly by his being given a box or indirectly by being given detailed dimensions taken from an Albert Packaging carton. After all at that stage the claimants were selling their carton to Buckingham Foods and it was a success. It would be natural for ASDA to seek a similar style of carton for their wraps if it were available.
88. Mr Laker accepted in cross-examination that he could not rule out having been given the required dimensions by Buckingham and could not rule out having been given a box by Buckingham although he thought he probably was not given a box. He did not remember whether the wraps in the old fridge were in a box.
89. In my judgment it is more likely than not that the claimants’ carton was one of the sources of ideas for the Pizzatilla box. Martin Laker’s lack of memory as to whether wraps in a fridge in 2007 were or were not in a box was entirely credible. Mr Laker produces numerous designs in the course of his work and there is no reason why this one should have stood out at the time. That means the documents become important and in my judgment the records relating to the Pizzatilla box do not rule out the passing of ideas (shape, dimensions and so on) from the claimants to Nampak via Buckingham Foods. If the wraps were indeed in a box then that box must have been one of the claimants’ boxes (no other credible source suggests itself). There is no evidence before me that Nampak were ever given any information which could or should have put them on inquiry that they may have been at risk of copying someone else’s design but that is not the issue. Given that Buckingham were buying the claimants’ wrap carton design from them at the time for Sainsbury and in the absence

of any direct evidence from Buckingham to put forward an alternative version of events, I am not satisfied that the production of a similar wrap carton for ASDA was an independent exercise. On the balance of probabilities ideas derived from the claimants were passed to the defendant at this stage.

90. The Pizzatilla drawing also bears the words “score changed to a crease on tuck flap” as a note of what was done to change the original 07G2168v1 drawing (which does not survive) to make 07G2168v2. Sure enough in 07G2168v2 the line which will become the apex is shown as a crease but the note shows that in the first version it was a score line. The score line did not come from the 2005 drawing referred to (05G0164v1) – that has a crease at the apex. The claimants’ pointed out that their product has a score line in that position and suggested this was direct evidence of copying. It may well be that the score line in version 1 did derive from the claimants but it is really impossible to say. Scores and creases are the day to day choices of designers. In my judgment the point is better seen as simply a reinforcement of the fact that Nampak cannot now rule out some derivation of ideas from the claimants to themselves via Buckingham.

2009

91. In 2009 Martin Laker designed another pack for Buckingham Foods. This was 09G0024v1 produced on 9th January 2009. It was based on the Pizzatilla box design from 2007, the 2005 drawing 05G0168v1 and also on wraps side by side in the old fridge, supplied by Buckingham Foods. From 09G0024v1 Martin Laker produced 09G0024v2 on 16th January 2009 and that was the design offered to Buckingham Foods. When Greencore asked for a wrap box Martin Laker started from 09G0024v2 and produced 09G0079v1 on 20th January and then 09G0079v2 on 3rd February.
92. Whether the wrap product supplied by Buckingham this time came in a box is impossible to tell. Given my findings in relation to the Pizzatilla box it is a point of lesser significance but in my judgment I cannot rule out the possibility that again at this stage, ideas derived from the claimants’ design were injected into the Nampak design process on that occasion. Again I should say there is no evidence that Nampak were ever told anything which might have put them on inquiry but that is a different matter.
93. The upshot of my findings in relation to Nampak’s explanation of the design history is that they did indeed design a slope fronted carton in 2005 which provided one source of the designs in issue in their case. However the claimants’ design was also another source of ideas which fed into the later carton designs and in particular into the 2009 carton design alleged to infringe. One of Nampak’s defences in these proceedings was a contention that their products had been designed independently of the claimants. I reject that contention.
94. However it does not follow that Nampak’s product necessarily infringes. Design right is a right to restrain reproduction of the design by making articles to the design. That means copying the design so as to produce articles exactly or substantially to that design. When it comes to comparing the article alleged to infringe with the claimants’ design in a case like this one, in which it can be seen that the article was in fact derived from multiple identifiable sources, it must be necessary to identify how much of the design of the article in question can be said to derive from the claimants’

design. At the stage of objective comparison to decide whether the article is exactly or substantially to the design, the fact that an element may be identical may be irrelevant if it was in fact derived independently.

Comparing the Nampak products and the Albert Packaging design

- 95. In this case it is necessary to compare three Nampak cartons to the claimants’ design defined by approach (1). They are Pizzatilla (07G2168v2), 09G0024v2 (Buckingham) and 09G0079v2 (Grencore).
- 96. In my judgment the overall shape of the Pizzatilla box as a rectangular based box with a sloping front face and a window on both the slope and the vertical front face did not derive from the claimants, it came from Marc Kavanagh’s work in 2005. The crash lock base also derives from the 2005 design. The shape of the window in the Pizzatilla box is a plain rectangle. That is as much like the 2005 design as the claimants’ and there is no reason to say it came from the claimants. The box has a straight tucked flap like the 2005 design too, no score on top ridge and no pull tab – unlike the claimants.
- 97. What about dimensions? For Pizzatilla the three relevant designs to consider are the claimants’, Nampak’s 05G0164 (that is the design referred to on the 2007 Pizzatilla document) and Pizzatilla itself 07G2168. The dimensions (in mm) are:-

	Claimants	05G0164v1	07G2168v2
A	35	50	35
B	95	95	95
C	52	45	50
D	104	135	90

- 98. In my judgment the dimensions of the Pizzatilla box which give the shape to the side of the carton (made by A, B and C together) owe something to the claimant’s design. The A=35mm dimension which the claimants emphasise may well have been derived this way and I should note that although one of the 2005 Nampak designs had A=35mm, it was the other 2005 design (05G0168v1), not the one referred to in the Pizzatilla drawing. Although B =95 mm in all three cartons, the side shape is determined by the combination of all three dimensions A, B and C.
- 99. There was a suggestion that the dimensions may derive instead from measuring wraps themselves, however Mr Laker explained that taking measurements from a wrap was an uncertain business given that the size of a given product will vary quite dramatically in 10 minutes sitting on a desk as moisture evaporates from it. He described it as a soft bread product which changes size dramatically. In my judgment the explanation for the dimensions is not to be found in measuring wraps.
- 100. As with the Pizzatilla carton, leaving the dimensions aside which I will address separately, the overall shape of Buckingham design 09G0024v2 and Grencore design 09G0079v2 derive ultimately from the 2005 Nampak work, and is therefore independent of the claimants on any view. The shapes of the Buckingham and Grencore windows are different from the claimant’s window. In the Grencore case the back panel has a U shape and the tuck flap has been modified accordingly. None of the features (apart from dimensions) derive from the claimants.

101. In order to address dimensions, I remind myself that Buckingham design 09G0024v2 was derived from Pizzatilla and the other 2005 design (05G0168v1). There may also have been a further injection of the claimants’ ideas at this stage. The various dimensions are:

	Claimants	07G2168v2 (Pizzatilla)	05G0168v1	09G0024v2
A	35	35	35	35
B	95	95	110	95
C	52	50	45	50
D	104	90	135	90

102. Looking at the table, although it might be said that A=35mm in the 2009 design could have come from the 2005 design 05G0168v1, it seems to me to be much more likely that the overall shape of the side (A, B and C together) derived from Pizzatilla and therefore, in my judgment, from the claimants.
103. Grencore design 09G0079v2 was derived from Buckingham, design 09G0024v2. The various dimensions are:

	Claimants	09G0024v2	09G0079v2
A	35	35	35
B	95	95	90
C	52	50	52
D	104	90	92

104. Again it seems to me that the dimension of the side panel (A, B and C together) derived ultimately from the claimants’ design.
105. Looking at the matter as a whole, I do not doubt that originally Buckingham Foods wanted a wrap carton which looked like the claimants’ carton to sell to ASDA. They asked Nampak for a carton. We cannot say today what was said in that conversation but one can imagine the request was for a carton in which the two cut pieces of wrap could be presented side by side in a box with a sloping window, the window continuing down the vertical face to see the product clearly. At that stage Martin Laker obviously looked into Nampak’s computer system and found an existing Nampak design which fitted the bill. It had the essential qualities the customer wanted. There was no need to copy any other design. The dimensions needed to be adjusted and in my judgment the trio of dimensions A, B and C derived from the claimants. That is the only aspect of any of the articles which was derived from the claimants’ design. Does that amount to infringement?

Is there infringement?

106. None of the Nampak cartons are made “exactly” to the claimants’ design but are any or all of them produced “substantially” to the relevant design? In my judgment they are not. The design in question is the shape of the claimant’s carton in assembled form, in other words the whole thing. It is not simply a single dimension (approach (3)) or an abstracted generalisation of the overall design (approach (2)), nor is it the particular shape of the side panel (A, B and C together). The claimants’ design by approach (1) is the combination of all the various aspects and features. What stands

out and characterises the claimants' design is the sloping top face with the window partly on the slope and extending onto the front. Although the defendant's articles look like that, the reason is because they were based on the 2005 design. All of those similarities derive from a source independent of the claimants.

107. Looked at as a whole, what the Nampak products owe to the claimants' design (the three dimensions) is not a substantial part of that design. The articles are not made substantially to the claimants' design and do not infringe.
108. I should record that the same conclusion would follow for the design defined by approach (2) (indeed the defendant's case is a stronger one). The conclusion on approach (3) would be different however. If, which I reject, it were possible in this case to claim unregistered design right in a single dimension (A=35mm) then the Nampak products would infringe since in my judgment that dimension came from the claimants.
109. In this case, to have found infringement of the overall carton shape, given that all that has been derived are the dimensions of the side panel, would have the effect of undermining s213(3)(a) since in truth it would give unregistered design right to something which is no more than a method or principle of construction applicable to articles with many different appearances.

Conclusion

110. The claimants' have unregistered design right in the shape of their carton in assembled form, but the Nampak products do not infringe that right. The action must be dismissed.