



[2013] EWPC 23

Case No: CC11P01987

IN THE PATENTS COUNTY COURT
COMMUNITY DESIGN COURT

Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 30/05/2013

Before :

MR JUSTICE BIRSS
Sitting as a judge of the Patents County Court

Between :

SEALED AIR LIMITED	<u>Claimant</u>
- and -	
(1) SHARP INTERPACK LIMITED	
(2) SHARPAK AYLESHAM LIMITED	<u>Defendants</u>

Martin Howe QC and Henry Ward (instructed by **Charles Russell**) for the **Claimant**
Anna Edwards-Stuart (instructed by **Marks & Clerk Solicitors LLP**) for the **Defendants**

Hearing dates: 10th April 2013

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.

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MR JUSTICE BIRSS

Mr Justice Birss:

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Introduction

1. This is an action for infringement of UK and Community Registered Design and for infringement of UK unregistered design right. The claimant, Sealed Air, is the owner of the rights and claims that the defendants, Sharpak, have infringed them. The rights all relate to the designs for Sealed Air’s SF-500 range of plastic soft fruit punnets. The Sharpak range of products alleged to infringe are designated as PP30, PP40, PP50, PP60 and PP83. The number refers to the height of the punnet in millimetres.
2. Mr Howe QC and Mr Ward appear for Sealed Air instructed by Charles Russell. Ms Edwards-Stuart appears for Sharpak instructed by Marks & Clerk Solicitors LLP.
3. The directions given at the case management conference permitted each side to call expert evidence on certain issues but did not give permission to cross-examine the experts. There was permission to cross-examine factual evidence but in the end no factual evidence was called. The trial therefore consisted of oral submissions from counsel. No witnesses were called to give oral testimony.
4. Sealed Air relied on the expert evidence of Morris John Field. He was the designer of the punnets the subject of this action. He had many years experience designing packaging products including punnets for soft fruit, mushrooms and other things, Easter Egg packs, chocolate box inserts and other products. Mr Field retired from full time work at Sealed Air in 2012 and retired completely in March 2013.
5. Sharpak relied on the expert evidence of Brian Stanley Hill. He also had many years experience in the design of packaging. Between 1995 and 2003 he worked at Rexam.

In 2003 he retired and after that the part of the business in which Mr Hill had worked was acquired by Sharpak.

The Registered Design case (UK and Community)

6. Sealed Air rely on six design registrations: three UK and three Community. Within these six registrations however there are only three designs: a deep punnet, a middle sized punnet and a shallow punnet. Each Community design is the same as one of the UK Registered Designs. All six registrations claim the same priority date, 31st May 2003. The six designs in their corresponding pairs are:

The deep punnet

- i) UK Registered Design No. 3,012,955;
- ii) Community Registered Design No. 000104591-0003;

The middle sized punnet

- iii) UK Registered Design No. 3,012,956;
- iv) Community Registered Design No. 000104591-0002;

The shallow punnet

- v) UK Registered Design No. 3,012,957;
- vi) Community Registered Design No. 000104591-0001;

- 7. Representations of the designs are in Annex A. I have used the images from the UK Registered Designs.
- 8. Representative images of the various Sharpak punnets alleged to infringe are in Annex B.
- 9. Images of two prior punnet designs relied on in Sharpak's attack on the validity of the registered designs are in Annex C.
- 10. I will not annex the further images relied on by Sharpak in relation to the design corpus/design field.

Registered Design law

- 11. The law relating to Community Registered Designs derives from Council Regulation (EC) No 6/2002 (the Community Design Regulation). The law relating to UK Registered Designs derives from the relevant provisions of the Registered Designs Act 1949 as amended by the Registered Designs Regulations 2001 to implement Directive 98/71/EC. Although the legislative bases are distinct, the Community and UK law relating to these Registered Designs is meant to be the same. It is not necessary to draw any legal distinction between the UK Registered Designs and the Community Registered Designs in this case. I will refer only to the Community Design Regulation.

12. The essential framework of the Community Design Regulation was not in dispute. Art 3(a) defines “design”. Art 4 provides that a design will be protected by Community design right if it is new and has individual character. Novelty is defined in Art 5 and individual character in Art 6. To be new the design must not be identical to a prior design or different only in immaterial details (Art 5). A design has individual character if it produces a different overall impression on the informed user (Art 6 and Recital 14). This includes considering the design corpus, the nature of the product, the industrial sector to which it belongs and the degree of design freedom (Recital 14 and Art 6(2)). Art 8 provides that the right does not subsist in features dictated solely by function. Art 10 provides that the scope of protection conferred by a Community design includes any design which does not produce a different overall impression on the informed user.
13. On the characteristics of the informed user, Ms Edwards-Stuart referred to the summary I set out in paragraphs 33-35 of my judgment in Samsung v Apple [2012] EWHC 1882 (Pat) (sitting in the High Court) which was approved by the Court of Appeal ([2012] EWCA 1339). It was meant to be a distillation of the learning from three cases: PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5 at paragraphs 53 to 59; Grupo Promer v OHIM [2010] ECDR 7, (in the General Court from which PepsiCo was an appeal) and Shenzhen Taiden v OHIM, case T-153/08, 22 June 2010.
14. On the issue of designs dictated solely by function, both sides submitted that the correct approach to Art 8(1) was that explained by Arnold J in Dyson v Vax [2012] FSR 4, following the approach summarised by the OHIM Third Board of Appeal in Lindner Recycling (R 690/2007-3) [2010] ECRD 1. In other words the multiplicity of forms approach was not correct and the right approach is to consider whether every feature of a design is determined by purely technical considerations. If so then the design is excluded.
15. On design freedom, the parties agreed that it can be constrained by the technical function of a product (see Arnold J in Dyson summarising the General Court in Grupo Promer). Ms Edwards-Stuart also submitted that design freedom could be constrained by the need to incorporate common features and economic considerations. Mr Howe did not disagree about that and so I will assume, without deciding, that this is correct.
16. Overall Ms Edwards-Stuart submitted that I should take the same general approach as summarised in my judgment in Samsung v Apple at paragraphs 53-59.
17. Finally I remind myself that what really matters is what the court can see with its own eyes, the most important things are the registered design, the accused object and the prior art and the most important thing about each of these is what they look like. Although of necessity a verbalised list of features has to be gone through, it is the overall impression which counts and not that verbalised list (see Samsung v Apple in the Court of Appeal paragraphs 27-29).

The distinction between a design and representations of a design

18. A problem in this case related to the proper interpretation of the drawings on the register. The drawings all show a star shape on the base of the punnet. Sharpak

submitted that the informed user looking at the drawings would understand that they meant that the punnet should have a visible star pattern on the base. Sealed Air did not agree. It submitted that when one understood CAD drawing conventions, the star shape represents a slight dome feature on the base. Sharpak replied that the informed user, a buyer of punnets for a supermarket chain or the like, would not know about CAD drawing conventions and, seeing the drawing, would expect to see a star shape pattern on the punnet itself. Mr Howe submitted that Sharpak's argument was wrong in principle. He said a distinction had to be drawn between the design itself and representations of the design on the register. While the informed user was the notional person employed in the law in order to assess overall impression and so on, it was not right to say that the informed user was supposed to be the person who interpreted the representations of the design which appeared on the register. Mr Howe contended that the identification of what the design registered actually is, by scrutinising the representations registered, was a matter for the court and was a question of law and construction. Once the court had determined what the design registered actually was, the notional informed user was to be employed in answering the questions of validity and infringement. So he argued that it was not relevant what an informed user would make of the drawings on the register when a problem like this one arose. Generally the distinction between the design and the representations of the design would not matter but in a proper case it was important. Ms Edwards-Stuart did not agree. She submitted that the informed user was the person to whom the design registration was addressed and so in this case, if the informed user would understand that the design had a star shape on its base, that was that.

19. Neither side cited any authority on the issue. Paragraph 21 of the judgment of Sir Robin Jacob in Samsung, which was dealing with an issue about the interpretation of dashed lines in the representations in that case, is drafted so as to refer to what the informed user would think about the drawing on the register in that case. However both sides submitted that the issue raised here was not before the Court of Appeal in that case. The language used by the Court of Appeal there was not deciding between the rival submissions I have in this case.
20. I prefer Mr Howe's submission. I suspect in the large majority of cases the distinction will not matter but in my judgment the determination of what design is actually registered is a matter for the court. Once the design has been identified, then questions of overall impression and so on are matters to be decided by reference to the informed user. I reject the submission that it is the informed user who is supposed to be employed to interpret the representations of the design which are placed on the register. As in this case, a common way to register a design is to use technical drawings such as the drawings in this case. Informed users will not be experts in the interpretation of those drawings. It may be that the only convenient way to represent a design is by using a drawing which would be readily interpreted by a technical draughtsman but not easily interpreted by the informed user.
21. I can see no reason why the informed user needs to be brought into the analysis at this stage. The design register fulfils an important function of giving notice to the public what designs have been registered. That function does not require the law to say that the representations must be interpreted by the informed user either. After all one of the most important groups of people interested in scrutinising the register will be rival manufacturers and designers of the products in question. They are not users. They

will know how to interpret technical drawings. In practice users are much less likely to consult the register than manufacturers and designers.

Identification of the designs in this case

22. Sealed Air did not produce a list of the features making up the registered designs. A list of features was deployed in the unregistered design case, but that list necessarily was not a complete list of the features in the registered designs. I will create my own. The list of features is used for convenience, bearing in mind that in the end it is overall impression which counts. Before setting out the list I will resolve three issues of interpretation of the drawings. The interpretation issues related to the star shaped pattern on the base of the designs, the ribs, and the lines in the corners. I will deal with each in turn.
23. The star shaped pattern shown on the base of the punnets represents a slight dome on the base. It can be seen (just) in the section side view. In effect the base has a series of very shallow darts or wedged shaped parts forming the slight dome. I do not accept that the star shaped pattern in the representations of the designs on the register means that the designs actually have a visible star shaped series of lines on the base.
24. Sharpak contended that the ribs depicted in the designs had a rounded shape, particularly at the top. It is true that in the perspective views of the designs, the top of the ribs look quite rounded but Sealed Air pointed out that in the plan view the ribs can be seen as trapezoidal in shape. The rounding visible at the top of the ribs exists because the edges of the trapezium are not sharply defined and because the tapering of the rib means that at the top of the punnet the flat top of the trapezium is narrow. I would describe the ribs in the Sealed Air designs as a softened trapezoidal shape.
25. The corners of walls are chamfered but Sharpak argued that the chamfer was not a simple straight line cutting off the corner. The perspective views show pairs of vertical lines at each chamfer edge, rather than a single line as one might expect if a simple cut off of a corner was what was envisaged. Sharpak are correct that these lines exist in the perspective view. They indicate a degree of rounding of the edge between the chamfer and the wall which is visible in the plan view. They do not indicate that the chamfers have anything more complex about them than that.
26. Bearing in mind these points, the design of all three punnets can be broken down into the following elements:
 - i) A rounded rectangular shape in plan with a rim around the top;
 - ii) Sloping vertical walls;
 - iii) A little tooth inside the curved corners.
 - iv) Chamfered corners in the body of the punnet. The chamfers meet the walls at rounded edges.
 - v) A bevel at the bottom of each chamfered corner, down to meet the base.

- vi) Two pairs of ribs in the walls. A pair at each short end and a pair along each side. The ribs are close to the corners. The ribs have a softened trapezoidal shape and a taper, narrow at the top and wider at the bottom.
 - vii) A shelf below the rim around the perimeter.
 - viii) A shelf near the bottom around the perimeter.
 - ix) A raised central section on the base with chamfered corners.
 - x) A very slight dome inside the raised central section, made up of very shallow darts or wedges.
27. This list applies to all three of the deep, middle sized and shallow punnets. The only difference between these three designs is the depth of the punnet.

The informed user

28. It was common ground that the informed user is not a member of the public who buys soft fruit in these punnets but is a buyer of the punnets themselves, typically for a supermarket chain, fruit grower or fruit marketing company.

Design corpus, freedom and functional considerations

29. Sharpak pleaded that the designs were dictated solely by technical function and therefore invalid contrary to Art 8. It is clear that aspects of the punnet design are required or heavily influenced by functional considerations but I reject the submission that these designs are invalid on Art 8 grounds. Sharpak did not seriously challenge the point made by Mr Field that aesthetic considerations play a part in the design of these punnets. I find that the design of punnets is influenced to some degree by aesthetics. The buyers want the punnets to look good when they are displayed at the point of sale. They also want the fruit inside to look good.
30. Although Art 8 does not make these designs invalid, Art 8 has an important role to play in constraining the level of generality at which the design can be considered in this case. For example take the ribs. Ribs are functional. They strengthen the wall of the structure. A design proprietor could argue as follows: my design has ribs, your design has ribs, therefore you infringe. However stated at this high level of generality, ribs are simply functional elements. I should say that Sealed Air do not argue in this simplistic way. Sealed Air's argument relates to the particular design of the ribs in the punnets. The argument is expressed at a more detailed level of generality.
31. A number of general considerations applicable to punnet designs were described by Mr Hill and Mr Field.
- i) Punnets have a "cut size" which refers to the length and width of the overall punnet. Filled punnets are typically transported side by side in standard sized crates. Supermarkets often require suppliers to provide a standard cut size so that all punnets can work in the same supply chain infrastructure. Punnets also hold standard quantities of fruit and so their overall sizes are standardised.

- ii) Punnets are made by thermoforming. Sharp edges, narrow angles and areas of weakness in the punnet are avoided. One reason is to avoid damaging soft fruit. Another is to reduce damage to punnets during transport, stacking and de-stacking and on the production line. Rounded edges and corners and chamfered corners are some of the ways designers address these issues.
 - iii) Punnets are used to display the fruit on a supermarket shelf. As a result their technical features, such as ribs, are designed to allow for the contents to be displayed. The clarity of a transparent punnet is important in the soft fruit market in order to allow consumers to see the fruit.
 - iv) De-nesting is an important functional feature. When used in high volumes, punnets are stacked up and need to be easily separated to be used. This is called de-stacking or de-nesting. It is often done automatically by machines. Punnets are designed so that they stack up with a gap between each one to allow the de-nesting equipment to operate. One way of achieving this is to have teeth and a step. The teeth in one punnet engage the step on another. For this to work the teeth have to alternate between punnets in the stack. So punnets may be designed with an A/B or A/B/C de-nesting feature. In an A/B design there are two kinds of punnet. The A punnets have teeth in one place and the B punnets in another place. A stack will consist of alternating A and B punnets. In an A/B/C system three punnet configurations are made.
 - v) In order to stack correctly, punnets must have an appropriate wall angle. Also to make sure de-nesting works correctly, the wall angle of the punnet has to relate correctly to the de-nesting feature.
 - vi) Punnets have to be strong enough to be used throughout the distribution chain and in the supermarket. Ribs are very commonly used as strengthening elements. To provide maximum strength ribs will typically taper slightly towards the top or bottom. Ribs vary in their cross-section. Many trays or punnets have a large number of ribs. The ribs can extend down the walls and across the base of the tray. In soft fruit punnets, one approach is to have fewer but more substantial ribs to permit greater flat window areas on the walls to allow the fruit to be seen and to attach a label. For soft fruit one would not use sharp edged ribs to avoid damaging the fruit.
 - vii) A raised area on the base provides strength and assists in the manufacturing process of these punnets, which are usually made by thermoforming.
32. In relation to the design corpus, Sharpak relied initially on a collection of catalogues and other materials annexed to the Defence. In addition Mr Hill also exhibited some further materials to his expert's reports. Mr Field emphasised how wide the design corpus of punnets available in March 2003 actually was. He thought the corpus was wider than might be thought from looking only at the collection annexed to the Defence. Mr Field produced a further collection of catalogues of punnets and trays from manufacturers including Sharpak, Dolphin (who were taken over by Sealed Air in 2000) and Sealed Air itself.
33. The design corpus materials demonstrate a very wide range of designs of punnets and trays which were available. Mr Howe emphasised that wide scope however I am not

convinced that this width reflects a high degree of relevant design freedom. The wide range exists because punnets and trays are designed to perform different tasks. For example some punnets have ribs and others do not. However ribs are not added to punnets as decorative or capricious elements, they are used for strength. I cannot simply equate a wide range of product designs with a wide design freedom. In order to deal with design freedom properly it is necessary to consider the features of the Sealed Air design in detail and that is what I will now do. At this stage it is convenient to treat all three sizes as a single design.

A rounded rectangular shape in plan with a rim around the top.

34. This is a visually important element of the design but it is entirely conventional. Very many if not all punnets have a generally rectangular shape in plan with a rim around the top. Many have rounded corners.

Sloping vertical walls

35. This is another visually important but entirely conventional feature. It also has functional significance. There is little design freedom here.

A little tooth inside the curved corners.

36. This is functional de-nesting feature albeit function does not dictate its particular shape. It is almost invisible. Although no doubt the informed user would know that de-nesting features were important, it would have no aesthetic significance.

Chamfered corners in the body of the punnet. The chamfers meet the walls at rounded edges.

37. Many punnets have chamfered corners and there are functional reasons why this is done. This element is of some significance to the appearance of the punnet but the design freedom in this area really boils down to choosing one of the two standard arrangements: either rounded corners or chamfered corners.
38. The Sealed Air design has an unusual combination of a rounded corner on the top rim with a chamfered corner in the walls. This makes the rounded top corners protrude outwards above the chamfered corner of the walls. Sharpak produced representations of many tray designs and Mr Hill exhibited more to his report. However the only example drawn to my attention of this combination of rounded top corner and chamfered wall corner appeared once in an Agripack brochure (1/7/p17). I am not satisfied that the trays on this page actually do have corners with the same shape as the Sealed Air design but even if they do, it is a single example. This combination is the result of the exercise of design freedom in relation to these punnets but it is not a visually important element.

A bevel at the bottom of each chamfered corner, down to meet the base.

39. Bevels between the base and the corner are a fairly conventional feature of punnet designs although they are not universal. Sometimes they are combined with chamfered corners and sometimes with rounded corners. They do not have a strong visual importance. They have some functional significance as well.

Two pairs of ribs in the walls. A pair at each short end and a pair along each side. The ribs are close to the corners. The ribs have a softened trapezoidal shape and a taper, narrow at the top and wider at the bottom.

40. Ribs per se are entirely banal and functional.
41. As for the shapes of the ribs, there are many shapes in use but flat topped, shallow, trapezoidal ribs which taper so as to be narrow at the top are common. The shape of the ribs would not excite the attention of the informed user.
42. The arrangement of the pairs of ribs creates a flat window between the ribs which allows the fruit to be seen. This is an element of the design with aesthetic as opposed to technical significance. Many punnets in the design corpus do not have this feature but a number of previously available punnets did have. Two were the punnets relied on in Sharpak's attack on novelty and individual character but Mr Hill referred to a few others as well. I find that this is an aesthetically significant element in the design but, bearing in mind the design corpus, it does not make the design stand out very much.

A shelf below the rim around the perimeter.

43. Shelves at the top are very common. It would not be a very important element to the informed user.

A shelf near the bottom around the perimeter.

44. Shelves at the bottom are to be found in the design corpus albeit not as often as shelves at the top. They have some functional significance concerned with tooling and making different height punnets. The lower shelf in the Sealed Air punnet gives the bottom a slightly busy appearance which is more pronounced in the shallower punnets.

A raised central section on the base with chamfered corners

45. A raised central base section of some kind is very common and is functional. The particular arrangement in the Sealed Air design, with chamfered corners, is not common and is the product of the exercise of design freedom. However it is not a feature of great aesthetic significance to the punnet overall.

A very slight dome inside the raised central section, made up of very shallow darts or wedges.

46. This is barely visible.

The design as a whole

47. Having broken the design down into elements, it is nevertheless important to remember that the design is considered as a whole with the elements combined and that overall impression is what counts.
48. This is not a design which the informed user would think represented much of a departure in the design of punnets. Most of the gross features of the design are

common and/or constrained by a lack of design freedom and this is not just the case of the features individually but is true of them in combination. There are some details which are unconstrained but are not visually and aesthetically significant such as the chamfered corners on the raised base part and the de-nesting tooth.

49. What I have described so far applies to all three of the design registrations. The only difference between the overall impression created by the three different heights of punnet is that as the punnets get more shallow the busy effect of the lower shelf takes on more prominence and the tapering of the ribs is less apparent.

Novelty and individual character

50. Sharpak relied on two prior designs as depriving the Sealed Air designs of novelty and individual character. The strongest case is based on the M&S 83 punnet. It is closer to the Sealed Air punnets than the other item of prior art, the Avalon design.
51. As I have mentioned already both the M&S 83 punnet and the Avalon punnet have pairs of ribs which make windows on the walls. This gives them a similar character to the Sealed Air design. It is an important similarity.
52. Nevertheless the prior designs do differ from the Sealed Air design. The corners of the walls are rounded, not chamfered. The ribs are round and parallel sided, not trapezoidal and tapering. Neither prior design has a shelf around the perimeter at the bottom. The Avalon has no top shelf. The bases are different. The base of the M&S 83 has a bead in a rectangular shape. The base of the Avalon has protruding feet.
53. Despite the similarity, I am sure that the Sealed Air designs are both novel. As for individual character, I find that the Sealed Air designs create a different overall impression. Each prior design is more rounded than the Sealed Air designs, particularly at the corners. I find that the Sealed Air designs have individual character having regard to either of the cited prior designs.

Overall impression of the Sealed Air designs

54. I can now summarise the overall impression created by the Sealed Air designs on the informed user. Save for the difference in height, the overall impression created by the three designs is the same. It is a punnet design composed of conventional elements, albeit executed in a particular way and combined together in a particular way. It does not stand out as a radical departure. A large part of the appearance of the punnet is constrained by functional considerations or is conventional. The faces of the punnet are flat. The edges between flat faces are rounded. The use of pairs of ribs is not distinctive. The only truly unusual elements are (i) the combination of curved top corners and chamfered walls, (ii) the chamfered corners on the raised base part and (iii) the particular de-nesting tooth. None of these elements makes a strong contribution to the overall impression produced on the informed user by the Sealed Air designs.
55. I conclude that the designs have a narrow scope of protection.

Infringement

56. Representations of the various Sharpak punnets are in Annex B. Obviously the fair test is to compare designs of corresponding depth as far as possible. I will start with the Sharpak PP83 compared to the deep registered designs.

57. Taking the features in turn:

A rounded rectangular shape in plan with a rim around the top.

58. The Sharpak PP83 has this but on its own it is of little significance.

Sloping vertical walls

59. This is a similarity of little significance.

A little tooth inside the curved corners.

60. This is a similarity of no significance.

Chamfered corners in the body of the punnet. The chamfers meet the walls at rounded edges.

61. The Sharpak punnets have chamfered corners. They are somewhat thinner than the Sealed Air chamfers and the edge between the chamfer and the wall is sharper than the edge in the Sealed Air design.

62. The Sharpak punnets have the combination of a rounded corner on the top rim with a chamfered corner in the walls. This is noticeable.

A bevel at the bottom of each chamfered corner, down to meet the base.

63. The Sharpak punnets have a bevel at the base and the corner. Just as the chamfer is thinner than Sealed Air, so too is the bevel.

Two pairs of ribs in the walls. A pair at each short end and a pair along each side. The ribs are close to the corners. The ribs have a softened trapezoidal shape and a taper, narrow at the top and wider at the bottom.

64. The Sharpak punnets have two pairs of ribs arranged in a similar way to the ribs in the Sealed Air design.

65. The Sharpak ribs themselves appear flatter and more angular than the ribs in the Sealed Air design. There is a somewhat larger space between each rib and the edge of the relevant chamfer than appears in the Sealed Air design.

A shelf below the rim around the perimeter.

66. The Sharpak punnets have this shelf but it is not important.

A shelf near the bottom around the perimeter.

67. The Sharpak punnets have no shelf at the bottom. This gives the bottom of their punnets a slightly cleaner appearance than the slightly busy appearance of this part of the Sealed Air design.

A raised central section on the base with chamfered corners

68. The Sharpak punnets have a raised central base section with chamfered corners but the shape is more rectangular than the more octagonal appearance of the base of the Sealed Air design.

A very slight dome inside the raised central section, made up of very shallow darts or wedges.

69. The Sharpak base has no dome.

Overall impression of Sharpak and Sealed Air compared

70. Despite having broken the comparison down into elements, I will repeat that it is important to remember that the questions have to be considered from the point of view of the designs as a whole.
71. Although there are many visual similarities between the Sharpak and Sealed Air designs, the vast majority of the similarities between the two designs are due to functional or conventional elements. These do not contribute significantly to the overall impression produced on the informed user.
72. There are numerous differences in detail between the designs. These differences reflect the fact that where design freedom exists, the designer of the Sharpak punnet has exercised that freedom.
73. The Sharpak and Sealed Air designs share the combination of rounded top corner and chamfered wall corner. I mention this because it is the only unusual element of the Sealed Air design which has some aesthetic significance and is not heavily constrained by function. However I do not believe this similarity is enough to create the same overall impression when placed in the context of the other similarities and differences.
74. I find that the Sharpak punnets do not produce the same overall impression on the informed user as the Sealed Air design. The deep Sharpak punnets do not infringe the deep design.
75. The same conclusion follows for the other shallower punnets. If anything the greater prominence of the lower shelf in the Sealed Air designs which is absent from the Sharpak punnets, takes the Sharpak punnets further away.
76. I think the fallacy in Sealed Air's reasoning in relation to the registered design aspect of this case is to argue that once the designs are recognised as valid despite their numerous functional features (because aesthetic considerations do play a part) it therefore follows that one can pray in aid many of the visual similarities between the Sealed Air and Sharpak designs, ignoring the fact that these similarities derive from functional and/or conventional elements. Mr Howe submitted that there was a spectrum between totally functional objects and totally aesthetic objects and that this case was further towards the aesthetic end of that spectrum than the industrial products mentioned by the OHIM Board of Appeal in Lindner. I agree but only up to a point. These designs have an aesthetic element but in truth their appearance is very

largely driven by functional considerations and to an important degree the elements which are not constrained by function are conventional.

77. I will dismiss the action for infringement of the UK Registered Designs and of the Community Registered Designs.

The UK Unregistered Design case

78. Sealed Air rely on UK unregistered design right (UK UDR) subsisting in the designs of the SF-500 range of punnets. The sizes relied on are 30, 40, 50, 60, 70 and 83.

UK UDR – the law

79. UK UDR is defined in section 213 of the Copyright Designs and Patents Act 1988 as follows:

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.

80. Ms Edwards-Stuart referred to my summary of some aspects of the law relating to s213 in *Albert Packaging v Nampak* [2011] EWPC 15 (the Court of Appeal (Lord Neuberger MR) dismissed an application for permission to appeal from that judgment at [2012] EWCA Civ 143). At paragraph 14 of *Albert Packaging* (and see also the cases cited in paragraph 15) I explained that the definition of "design" in s213 allows a claimant to assert design rights in only certain aspects of a larger article, that it is important to identify precisely which aspects of shape or configuration are relied on,

that 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.

81. Ms Edwards Stuart also referred me to the judgment of Mann J in *Rolawn v Turfmech Machinery* [2008] EWHC 989 (Pat) at paragraphs 79-84. In essence the point being made by Mann J in that section is that UK UDR does not protect ideas, but only the actual physical manifestation of them.
82. Sharpak rely on s213(a) (method or principle of construction). Referring to Neuberger LJ in *Landor & Hawa v Azure* [2006] EWCA 1285 at paragraph 13 and paragraphs 91, 92 and 96 of the judgment of Mann J in *Rowlawn*, Ms Edwards-Stuart submitted that this exclusion limits the generality at which a design can be assessed. The more abstract the definition, the more likely it is that the design will be excluded. I accept that submission.
83. It was common ground that a design has to be both original in the copyright sense and also not commonplace in the design field in question. Sharpak contend that a number of the designs relied on by Sealed Air are commonplace (s213(4)). I attempted to summarise the law relating to s213(4) in *Albert Packaging* at paragraphs 27-31. This included references to *Farmers Build v Carrier* [1999] RPC 461, *Ocular Sciences v Aspect Vision Care* [1997] RPC 289 and *Scholes v Magnet* [2002] EWCA 561 (Civ).
84. Ms Edwards-Stuart reminded me of an observation of Laddie J in *Ocular Sciences v Aspect Vision Care* [1997] RPC 289 at 429 which is relevant when combinations of features are relied on. In *Ocular Sciences* Laddie J said that “In many cases the run of the mill combination of well known features will produce a combination which is itself commonplace”. On the other hand Mr Howe reminded me of the Court of Appeal *Ultraframe v Eurocell* [2005] EWCA Civ 761 paragraph 63-66 which shows that just because a design may be composed of elements which are commonplace when taken individually, it does not follow that the assembly of them into the particular combination is necessarily commonplace as well.
85. Section 226 defines acts of primary infringement. There is no need to set it out. To infringe the relevant article must be produced exactly or substantially to the design relied on. Unlike infringement in relation to UK or Community Registered Designs, to infringe UK UDR, the relevant similarities must have arisen as a result of copying.

UK UDR – the designs relied on

86. Sealed Air rely on a number of separate designs, defined by reference to the SF-500-83 punnet. As with the Registered Designs, it is convenient to consider them by focussing on a punnet of one height and deal with the different heights separately. The shape and configuration of the punnet as a whole is relied on and so are certain aspects. The aspects are defined by reference to combinations of elements A to H of the shape and configuration of the Sealed Air punnet. Elements are shown in images of a Sealed Air punnet reproduced in Annex D. The elements are defined in paragraph 6 of the Particulars of Claim. The definitions are set out below with cross-references to Annex D:

- A The feature marked A at Annex D fig 1 in its location at the top corner of a punnet, including the radius of curvature and dimensions of the quadrant section marked; the Claimant also relies on the alternative variants of this feature wherein the "de-nesting" devices further described at C are located at different positions on the quadrant as indicated at Annex D fig 1 and fig 2;
 - B The feature marked B at Annex D fig 3, including the use of a substantially flat straight section of wall in the corner of the punnet as marked, and the shape and dimensions of the said flat section, and its juxtaposition with the surrounding wall sections;
 - C The feature marked C at Annex D fig 4, including the use of a "spur" de-nesting device as shown, and the shape and configuration of the de-nesting device, and its general position in the quadrant corner section of the punnet; the Claimant also relies on the alternative variants of this feature as shown in Annex D fig 1 and fig 2;
 - D The feature marked D at Annex D fig 5, including the use of inward protruding ribs of shallow depth (in the inward and outward direction) which taper towards the top of the punnet, the shape and dimensions of those ribs, and the positioning of the ribs in the end wall of the punnet;
 - E The feature marked E at Annex D fig 6, including the use of inward protruding ribs of shallow depth (in the inward and outward direction) which taper towards the top of the punnet, the shape and dimensions of those ribs, and the positioning of the ribs in the side wall of the punnet;
 - F The feature marked F at Annex D fig 7, including the shape and configuration of the "shelf" section marked and its position within the punnet;
 - G The feature marked G at Annex D fig 8, including the use of a flat trapezoid shaped "bevel" at the bottom corner of the punnet whose top corresponds to the bottom of the straight section of side wall identified as feature B above, and the shape and dimensions of that bevel section and its position in the punnet;
 - H The feature marked H at Annex D fig 9, including the use of a raised central section with chamfered corners in the base of the punnet, the shape and dimensions of the raised central section and the positioning of the raised central section in the base of the punnet.
87. Elements B, D and E are each influenced by the height of the punnet. The other elements do not change with a change in height.
88. The designs relied on in which UK UDR is said to subsist are:
- i) The shape and configuration of the punnet as a whole;
 - ii) The combination of features A, B and G;
 - iii) The combination of features C and F;
 - iv) Feature D alone;

- v) Feature E alone;
- vi) The combination of features D and E;
- vii) The combination of features A, B, D and G;
- viii) The combination of features A, B, E and G; and
- ix) The combination of features A, B, D, E and G;
- x) The combination of all features A to H.

89. Combinations (vii) and (viii) do not add anything to combination (ix) and stand or fall with design (ix) both in relation to subsistence of design right and infringement. I will not consider them further.
90. Mr Howe submitted that the various combinations relied on were not arbitrary collocations but were meaningful combinations of interrelated elements. I think Mr Howe is right that designs (ii), (iii), (vi), (ix) and (x) are true combinations of elements which interrelate to one another. Given the way UK UDR operates a claimant is not precluded from relying on arbitrary collocations of elements if it wishes to do so. However when it comes to considering whether a design is commonplace, the distinction may well matter. If two unrelated elements are commonplace as elements then it is very unlikely that a mere collocation of those elements will avoid the exclusion. On the other hand, if two elements relate to one another then their combination at least stands a chance of not being commonplace, even if the elements individually are.
91. I can deal with s213(3) (method or principle of construction) briefly. None of the designs relied on fall foul of this exclusion. They are all defined in such a way as to be specific aspects of shape and configuration and not improperly wide abstract ideas or principles.

UK UDR - Originality and commonplace

92. At one stage Mr Howe was concerned that Sharpak were running an unpleaded argument that the Sealed Air design was not original in the copyright sense. They were not and there was no real challenge to the originality of the Sealed Air designs in that sense. The challenge related to the question of commonplace.
93. The design field in question is soft fruit punnets. I will deal with the various elements on their own first. I find the following elements were commonplace in the design field in 2003: A, B, D, E, F, and G. Element A is a very conventional corner and variable de-nesting elements like this are standard. Note that the detail of the shape of the Sealed Air de-nesting tooth is not part of element A. Elements B, F and G are standard. Elements D and E are the corresponding pairs of ribs in the side and end walls which make windows to display the fruit. Mr Howe argued that Sharpak's evidence, based on a few catalogues and the like, was not sufficient to demonstrate features were truly commonplace. This point had most force in relation to elements D and E. The number of examples relied on by Mr Hill is relatively low, especially when it is kept in mind that elements D and E include the tapering ribs (and therefore

as defined exclude the Avalon and M&S 83 punnet) but even taking that into account I find that those elements were standard, commonplace aspects of the design of soft fruit punnets.

94. I find that element C was not commonplace. Although de-nesting spurs of some kind were commonplace, the particular shape of the tooth used in Sealed Air's punnets was not. No example was produced which had the same shape, consisting of two concave curves coming to a relatively sharp point. The standard de-nesting spur in the design field is a rounded spur with no sharp point.
95. I am not satisfied element H was commonplace. Mr Hill's examples were not convincing.
96. Having dealt with the elements on their own, I now turn to consider whether the various combinations defined by Sealed Air are commonplace.
97. When elements A and B are combined together this produces what I have already called an unusual combination of a rounded corner on the top rim with a chamfered corner in the walls. I have dealt with Mr Hill's evidence about this already. I find the combination of A and B is not commonplace. That has the result that designs (i), (ii), (ix) and (x) are necessarily not commonplace either since they all include this combination of elements.
98. Design (iii) is not commonplace since it includes element C, the unique tooth shape.
99. Designs (iv) and (v) are commonplace since they relate to elements D and E alone respectively. The combination of D and E is not an arbitrary one but it is just as commonplace as the individual elements and so I find design (vi) is commonplace.
100. I am not satisfied the combination of the windows produced by the pairs of ribs (elements D and E) together with the chamfered corners (element B) was commonplace. No example was drawn to my attention. The features interrelate in that they allow the contents to be displayed through flat surfaces all around the perimeter of the punnet. Thus designs (i), (ix) and (x) are not commonplace on this separate ground as well as for the reason given earlier.
101. I conclude that UK UDR subsists in Sealed Air designs (i), (ii), (iii), (ix) and (x)

UK UDR - Infringement

102. I will start by comparing the Sharpak punnet PP83 with the Sealed Air designs in which design right subsists, referable to an 83mm high punnet (the SF-500 83).
103. The Sharpak punnet is almost identical to design (iii). For designs (ii) and (ix) the differences are trivial. I find that (subject to any question of derivation) the Sharpak punnet is an article made substantially to all of Sealed Air's designs (ii), (iii) and (ix).
104. I reject the case based on the design (x). This includes feature H and in my judgment the base of the Sharpak punnet is materially different from the base of the Sealed Air punnet. The chamfer on the corner is small and gives the raised base in the Sharpak punnet a rectangular shape whereas the Sealed Air punnet base has a more octagonal shape.

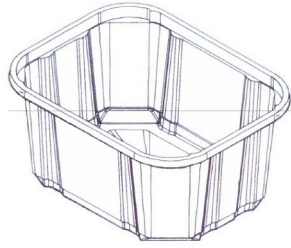
105. I reject the case based on design (i). That is the design of the Sealed Air punnet as a whole. The base is different (see above on design (x)) and when looking at the design of the punnet as a whole, the Sealed Air punnet has a lower shelf which is absent in the Sharpak punnet.
106. My findings in related to designs (ii), (iii) and (ix) will apply to all of the various Sharpak punnets of different heights. Design (iii) is the same irrespective of height. The height of the punnet has an influence on designs (ii) and (ix) but given that for each height of Sharpak punnet there is a corresponding Sealed Air punnet with the same height, it makes no difference to my conclusion.
107. Sealed Air alleges that the designs of the Sharpak punnets were copied from the Sealed Air SF-500 range. Sharpak do not deny copying but they do not admit it either. Their position is “not admitted”. They advanced no positive case of independent design and no positive case relying on any evidence to seek to negative an inference of copying which might be drawn in the circumstances. In oral submissions Ms Edwards-Stuart referred to evidence, which was in Mr Hill’s reports, that the M&S 83 punnet had been designed by Sharpak a matter of a few months before the Sealed Air SF-500 punnets were launched. So it was suggested that rather than copy the Sealed Air SF-500, perhaps all the Sharpak designers did was base their design on their own M&S 83 punnet and that copying could not be inferred. Mr Howe complained that this argument had not been properly foreshadowed. I agree with Mr Howe but even if it had been open to Sharpak I would reject it on its merits. It is true that the prior M&S 83 punnet has the two pairs of ribs feature which makes the windows on the sides of the punnet, but that design has rounded, parallel sided ribs whereas the Sharpak designs complained of have tapering trapezoidal ribs, just as the Sealed Air punnets do. On any view those features of the Sharpak punnets did not derive from the prior M&S 83 punnet. Neither does the M&S 83 punnet have a de-nesting feature like element C. That element of the Sharpak punnet plainly came from Sealed Air.
108. I find that all the similarities relied on arose by copying. Accordingly I find that Sharpak has infringed Sealed Air’s UK UDR in relation to designs (ii), (iii) and (ix).

Conclusion

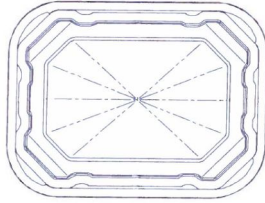
109. I find that the Sharpak punnets do not infringe any of the Sealed Air Registered Designs but do infringe Sealed Air’s UK unregistered design rights.

Annex A

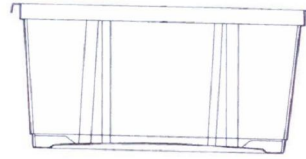
Deep punnet



Perspective View

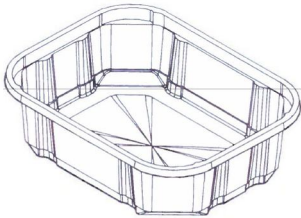


Plan View

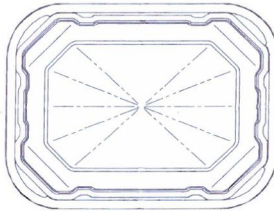


Sectional Side View

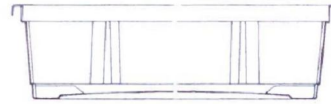
Middle sized punnet



Perspective View

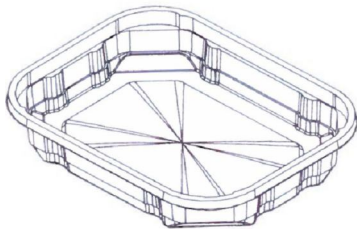


Plan View

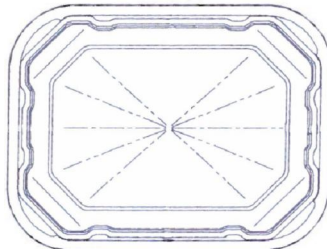


Sectional Side View

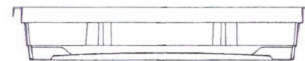
Shallow punnet



Perspective View

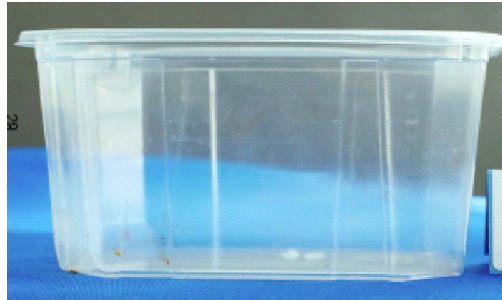


Plan View



Sectional Side View

Annex B
Sharpak punnets
PP83



Sharpak PP60



PP50



PP40



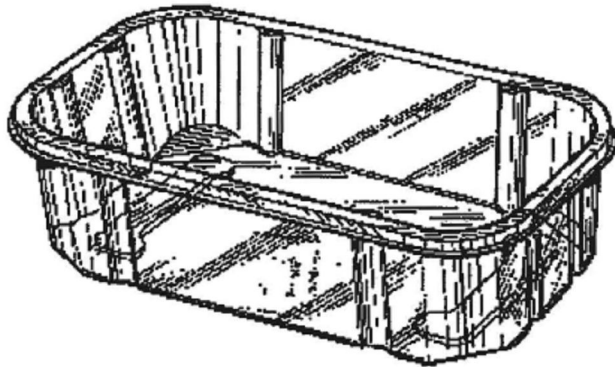
PP30



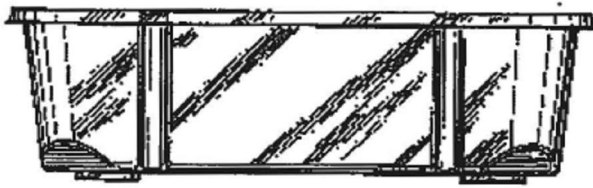
Annex C

Prior designs

UK RD 2066116 Avalon

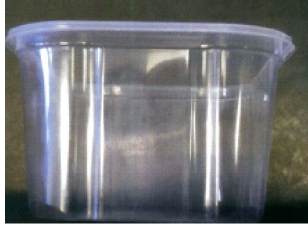


PERSPECTIVE VIEW FROM ABOVE



SIDE VIEW (OTHER SIDE CORRESPONDS)

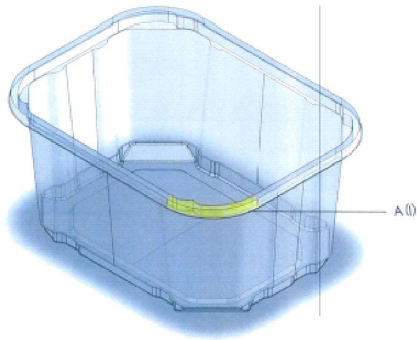
M&S 83 punnet



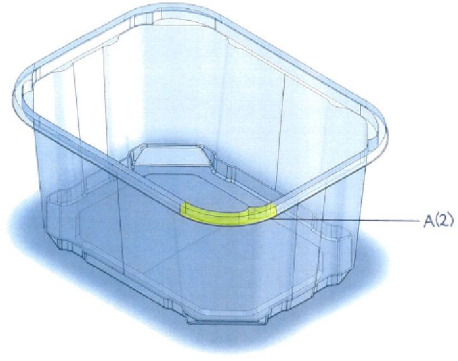
Annex D

Elements of the Sealed Air design relevant to UK UDR

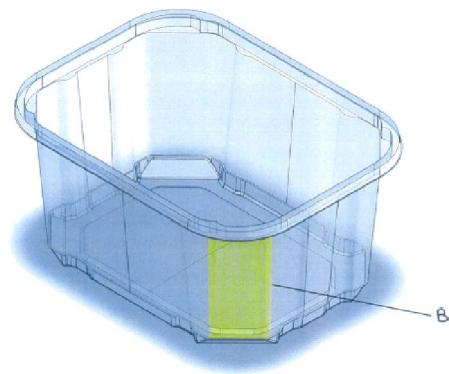
Element A Fig 1



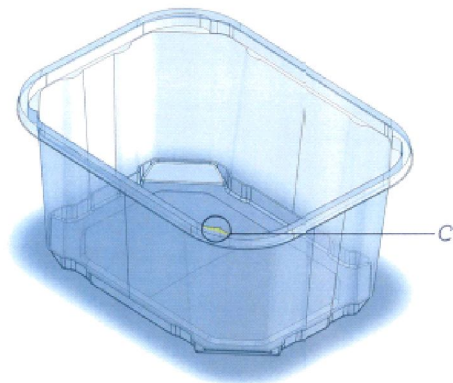
Element A Fig 2



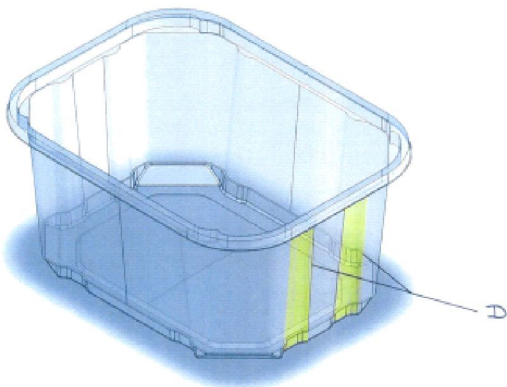
Element B fig 3



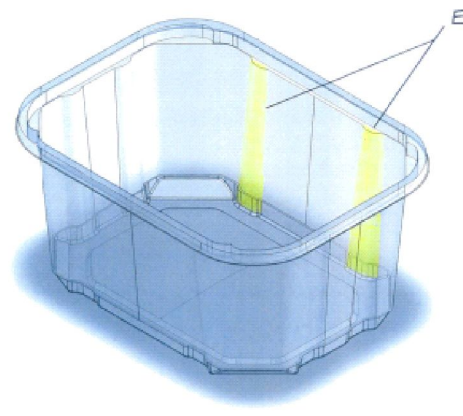
Element C fig 4



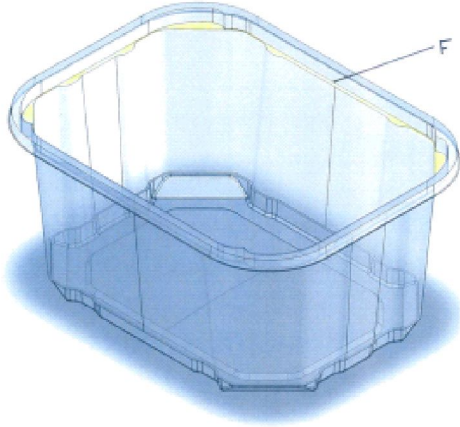
Element D fig 5



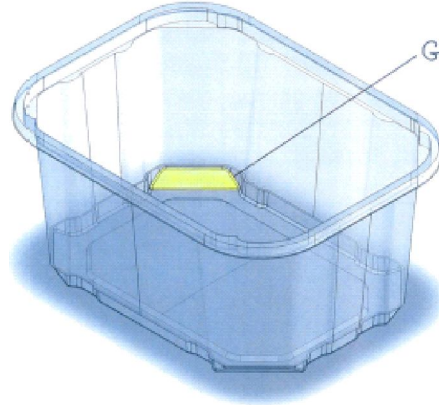
Element E fig 6



Element F fig 7



Element G fig 8



Element H fig 9

