



Design Rights in Lockers Secured

We are pleased to report the successful enforcement of our client Action Storage Systems Limited's UK unregistered Design Rights in their highly successful eXtreme plastic locker. The IPEC judgement, handed down by Judge Hacon on 7 December, demonstrates the power of the unregistered Design Right in restraining copying and the power of disclosure in revealing evidence of copying. Various defences were raised and although none displaced the fact of infringement of the overall design, they did give rise to some interesting points of law.

Infringement

Disclosure in the IPEC is not granted by default but can be ordered in respect of specific issues. In this case disclosure in relation to copying was ordered and the defendant's disclosure included a document created by the person tasked with creating the infringing product which "was replete with references to copying the eXtreme design". This left little room for doubt in the judge's mind that the defendants had copied the designs of the claimant.

"Any aspect of shape and configuration"

Design Right has been criticised as overly broad in allowing protection for "any aspect of the shape or configuration (whether internal or external) the whole or part of an article" (Section 213(2) Copyright Designs and Patents Act 1988). As a result, on 1 October 2014 this section was amended to delete the words "any aspect of". The effect of this deletion had been unclear and the defendants argued it excluded trivial features. The judge referred to a previous decision, DKH Retail, in which he held that the deletion has the effect of no longer permitting a claim to unregistered Design Right which extends other than to a design specifically embodied in an article or part of an article. That is to say, there is no more unregistered Design Right in abstract designs.

Lack of Originality

The defendants argued that the test for originality in copyright law has changed as a result of EU Copyright harmonisation, and that the same change should apply to

unregistered Design Right because it is a tenuously analogous type of right. The judge explained that in the previous case *Raft Limited v Freestyle of Newhaven Limited* he had held that the

change in the EU law of copyright can have no bearing on the UK law of unregistered Design Right. There was no need to decide the point in this case.

Commonplace

UK unregistered Design Right is not enjoyed by designs that, even if original, are commonplace. Judge Hacon gave a summary of the principles relating to whether a design is commonplace. He said that a party alleging that a design is commonplace should set out what are considered to be the significant features of the design, the prior art relied on and the date from which each cited item of prior art was available to designers in the relevant design field. He said the prior art which renders a design commonplace will not be obscure. Further, a design will be commonplace only if it is shown to have been current in thinking of designers in the field in question at the time of creation of the design. Lastly, a design made up of features which are individually commonplace is not necessarily itself commonplace. A new combination of run-of-the-mill features may not be commonplace. If the designer of the article has expended sufficient skill and labour to make his design original over a single piece of commonplace prior art, he is liable also to have succeeded in creating a design that is not rendered commonplace by that prior art.

Must Fit

Another exclusion from the scope of UK unregistered Design Right is features that are necessary to allow a product to fit to another product to enable it to function. The lockers were designed partly to be able to stack one on top of the other. The design feature which enabled this stackability was held to be excluded from design protection under the “must fit” exclusion, notwithstanding that the stackability was not the primary function of the lockers and that the stackability could be achieved by other designs.

Summary

The case is an example of enforcement of unregistered Design Rights in circumstances in which the Design Right owner had no registered rights. The disclosure by the defendant of documents relating to the design process gave the judge an excellent insight into that design process and cross-examination of the key witnesses reinforced that impression.

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For more information, please contact:

Tom Carver - tcarver@jakemp.com

John Leeming - jleeming@jakemp.com