

Bicycles, Baby Baths, Bears and more – Recent Developments in Design Protection

Webinar 2 July 2020 - Case Notes

The panellists referred to the following cases and legislation.

Rights cumulation and the borderline between copyright and design protection

Principle of rights cumulation under copyright and registered design law: Recital 8 and article 17 of Directive 98/71/EC on the legal protection of designs (the “**Designs Directive**”).

Restrictions on copyright arising in registered designs in the public domain, are incompatible with art.17 of the Designs Directive: *C-168/09 Flos SpA v Semeraro Casa e Famiglia SpA* EU:C:2011:29 at [44]

Restrictions on copyright that go beyond ‘own intellectual creation’ test, incompatible with EU law; no originality in this sense, where technical constraints or rules determine expression; concurrent design and copyright protection only where a work separately meets the requirements for both: *C-683/17 Cofemel – Sociedade de Vestuário SA v G-Star Raw CV* EU:C:2019:721 at [31], [35] and [45]-[52]

Shape solely determined by technical function, not protectable by copyright; possibility of achieving the same technical effect with a different shape, relevant but not decisive; intention of author irrelevant; patent rights and effectiveness of shape for technical function relevant factors: *C-833/18 SI and Brompton Bicycle Ltd v Chedech / Get2Get* EU:C:2020:461 at [24], [26]-[27], [32], [35]-[36]

UK application of *Cofemel*; fabric, not a graphic work; fabric, a work of artistic craftsmanship: *Response Clothing Ltd. v The Edinburgh Woollen Mill Ltd.* [2020] EWHC 148 (IPEC) [57]-[61], [63]-[64] and [16]-[18]

Gaps in UK copyright protection prior to *Cofemel* and application of s.51 CDPA 1988: *Lambretta Clothing Co. Ltd. v Teddy Smith (UK) Ltd.* [2004] EWCA Civ 886, [2005] RPC 6 at [33]-[41] and [87]-[89]

Definition of sculpture as a three-dimensional work made by an artist’s hand: *Metix (UK) Ltd. v G H Maughan (Plastics) Ltd.* [1997] FSR 718, 721-2

Pre-*Cofemel*, concept of sculpture involves assessment of artistic purpose: *Lucasfilm Ltd. v Ainsworth* [2011] UKSC 39 at [37]-[39], [43]-[44] and [48]

Parts and aspects of UK unregistered designs

Amendment of s.213 CDPA 1988 to remove reference to ‘any aspect of’ the shape or configuration of an article: s.1(1) of Intellectual Property Act 2014

Pre-2014 amendment principle that designer could assert UK unregistered design rights in parts of overall article and could trim article down to match defendant's product: *Ocular Sciences Ltd. v Aspect Vision Care Ltd.* [1997] RPC 289, 422

Effect of 2014 amendment is to preclude claims in abstract designs, not specifically embodied in the article: *DKH Retail Ltd v H Young Operations Ltd* [2014] EWHC 4034 (IPEC), [2015] FSR 21 at [16]

Part are concrete parts of a design identifiable as such, aspects are disembodied features which are merely recognisable or discernible; combinations of unconnected features are impermissible: *Neptune (Europe) Ltd v Devol Kitchens Ltd* [2017] EWHC 2172 (Pat), [2018] FSR 3 at [44]-[45]

Pre-amendment cases relevant to construing 2014 amendment; part of a design does not have to be a separately created element of the article; design 6 appears to be a combination of unconnected features: *Shnuggle Ltd. v Munchkin Inc.* [2019] EWHC 3149 (IPEC), [2020] FSR 22 at [77]-[78], [87]-[90] and Annex 3

Action Storage (or Bowhill) schedules

Charts setting out significant features of design of article against defendant's product and/or to identify features of the design alleged to be non-original, commonplace, an aspect and/or otherwise not entitled to protection: *Action Storage Systems Ltd v G-Force Europe.Com Ltd* [2016] EWHC 3151 (IPEC), [2017] FSR 18 at [109]-[113]

Example of case where *Action Storage* schedules used (at request of HHJ Hacon): *Cantel Medical (UK) Ltd. v Arc Medical Design Ltd.* [2018] EWHC 345 (Pat)

Earlier disclosure of design

Ambiguity on whether novelty of Community design assessed when design first made available to the public in the Community or when first made available otherwise: Article 5(1)(a), 7 and 11 of Regulation (EC) No 6/2002 on Community designs (“**Community Designs Regulation**”)

Amendment of Community Designs Regulation to make it clear that novelty assessed when design first made available in the EU: Article 110(a)(5) of the Community Designs Regulation

German case adopting the above interpretation of article 5(1)(a) of the Community Designs Regulation: *Thane International Group's Application, Re* (3/12 O 5/04) [2006] ECDR 8

Subsequent German case ruling that this interpretation is *acte clair* due to article 110(a)(5): Case I ZR 126/06 *Gebäckpresse II*

IPEC decision endorsing the above cases; preliminary reference made to confirm: *Beverly Hills Teddy Bear Company v PMS International Group Plc.* [2019] EWHC 2419 (IPEC), [2020] F.S.R. 11 [52]-[53], [57] and [59]

Order removing *Beverly Hills* reference from CJEU register: C-728/19 *Beverly Hills Teddy Bear Company v PMS International Group Plc.* EU:C:2020:114

Application of targeting case-law to design disclosure?:

Approach in trade mark cases; mere accessibility not enough; objective assessment based on all the factors: C-324/09 *L'Oreal SA v eBay International AG* EU:C:2011:474, [2011] R.P.C. 27 at [64]-[65]

Approach in database right cases; language of work and types of person interested in work: C-173/11 *Football Dataco Ltd. v Sportradar GmbH* EU:C:2012:642, [2013] F.S.R. 4 at [39]-[42]

South African sub-domain of global website targeted at the UK where second most users of the website were UK-based: *Omnibill (Pty) Ltd v Egpsxxx Ltd (In Liquidation)* [2014] EWHC 3762 (IPEC) [38]-[41]

Transient UK traffic not enough to prove targeting at the UK where 90% of sites visitors were accidental visitors from the UK: *Argos Ltd v Argos Systems Inc* [2017] EWHC 231 (Ch), [2017] FSR 26 [193]-[223]

Thank you for attendance at this webinar. For those interested, the next one will focus on internet evidence and digital forensics and will take place on **Thursday 9 July** at 4.30 (with Martin Howe QC and Jaani Riordan).

This seminar will consider relevant tools, techniques and tactical considerations when gathering digital evidence, including: (1) Identifying defendants and sources of evidence online; (2) Gathering evidence; (3) Website and source code analysis; (4) Advanced search techniques; (5) Social media investigations; (6) Location analysis and (7) Metadata analysis of files and emails.

Henry Edwards, webinar moderator