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Case No: Claim No. HP-2022-000025

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
PATENTS COURT
SHORTER TRIAL SCHEME

The Business and Property Courts, Manchester
1 Bridge Street West Manchester, M60 9DJ

Date: 4 September 2025

Before:

CAMPBELL FORSYTH

(Sitting as a Deputy Judge of the High Court)

- -

Between:

J. MAC SAFETY SYSTEMS LIMITED

Claimant

- and -

Q DECK SAFETY SYSTEMS LIMITED

Defendant

- -

MAXWELL KEAY (instructed by **TLT Solicitors**) appeared for the **Claimant**
JACQUELINE REID (instructed by **Virtuoso Legal**) appeared for the **Defendant**

Hearing dates:17 to 19 October and post-trial submissions 30 October 2023

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Approved Judgment

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Remote hand-down: This judgment will be handed down remotely at 4pm on 4 September 2025 by circulation to the parties or their representatives by email and release to The National Archives.

I direct that no official shorthand note shall be taken of this judgment and that copies of the version as handed down may be treated as authentic.

The Deputy Judge:

Introduction and General Matters

1. This is a claim for unregistered design right infringement of a safety decking system design. These safety decking systems are used on construction sites as part of working platforms and for fall protection. There were also claims for registered design infringement and passing off. The registered design claim was discontinued earlier in the case and no issues arising from that earlier claim require determination. On the first day of trial the Defendant agreed to submit to judgment on the passing off claim on the basis of its pleaded case. The issue of any inquiry as to damages on that claim will be addressed at the form of order hearing.

2. The Claimant is a company called J. Mac Safety Systems Limited. Mr Luis McCarthy, the managing director of the Claimant, is a third-generation scaffolder. He has been involved in scaffolding since around 2011. In 2015 he established the Claimant company. The Claimant company was intended to innovate specialist scaffolding and access products. The Claimant has various designs and articles made to those designs which are the basis of the claim in this case. These are amongst a number of other innovative products the Claimant explains it produces.

3. Mr McCarthy explained that 10 years ago, fall protection for a scaffolding operative, building an external scaffold on a construction site, would be "*big inflatable bags or bean bags, that were placed inside houses that people used to fall on. That was to provide reduction in the severity of the damage received following a fall.*". Before developing the designs and articles in issue, Mr McCarthy was hiring a pre-priority product called TRAD Deck which was also a safety decking system (see Figure 1 p27). These safety decking systems provide a platform to be built inside the construction area of a new building. Mr McCarthy felt he could improve on the design of the TRAD Deck system. For example, areas identified for improvement were that the carry handles on the TRAD Deck panel are off-set from a centrally balanced position and scaffolding could not be built through the platform. This led to the design and development of a system called the Macdeck. The Claimant says this was designed by Mr McCarthy, and Liam Eley, an external designer with the company Pioneer Procurement Ltd ("PPL").

4. The Claimant asserts design rights recorded in four design documents set out in Annexes 3, 3A, 4 and 5 to the Re-Amended Particulars of Claim ("APOC"); each is reproduced in annexes to this judgment. These are: (1) the Macdeck 1x1 Panel Design (Annex 1 of the judgment/Annex 3 of the APOC), (2) the Macdeck Panel Perimeter

Design (Annex 2 of the judgment/Annex 3A of the APOC), 3) the Macdeck 0.75x1 Panel Design (Annex 3 of the judgment/Annex 4 of the APOC) and (4) the Macdeck Pin Design (Annex 4 of the judgment/Annex 5 of the APOC). Together these are referred to as the Macdeck Designs. Paragraphs 9 and 9A of the APOC set out the pleaded Macdeck Designs. The text from paragraph 9A of the APOC is attached to this judgment at Annex 5. The Macdeck System comprises the articles known as the Macdeck 1x1 Panel, the Macdeck 0.75x1 Panel and the Macdeck Pin. The trial deals with liability but also one issue that goes to the matter of quantum – the date when articles made to the Macdeck Designs were first made available for sale or hire.

5. The Defendant is a company called Q Deck Safety Systems Limited. It supplies safety decking for use in construction sites. It was a customer of the Claimant from 2019 and purchased almost £1 million of products made to the Macdeck Designs. The Defendant does not accept the Claimant has proved these articles are made to the Macdeck Designs. I deal with this issue later in the judgment and determine these products (which I refer to as the Macdeck System or individually as the Macdeck 1x1 Panel, Macdeck 0.75x1 Panel and Macdeck Pin) were made to the Macdeck Designs.

6. In 2019 the Defendant decided it would design its own safety arrest decking system. The resulting articles referred to as Q Deck are the subject of the claim for infringement of the Claimant's unregistered design rights.

7. The Q Deck system here comprises; (1) the Q Deck 1x1 Panels, (2) the Q Deck 0.75x1 Panels and the Q Deck Pins ("the Q Deck Components"). Images of these (other than an image of the Q Deck 0.75 x1 Panel which was not included in Annex 8 of the APOC) are set out in Annex 6 of this judgment / Annex 8 of the APOC.

8. On the first day of the trial there were five separate applications that needed to be considered. One was dealt with by agreement, another related to reliance by the Claimant on late evidence and was not opposed. The remaining applications (all issued days before the trial) dealt with; (1) the Defendant's request for specific disclosure, (2) the Claimant's request to amend its Amended Particulars of Claim, and (3) the Defendant's request to amend its Re-Amended-Defence including regarding innocent infringement pursuant to s.233(1) Copyright, Designs and Patents Act 1988 ("CDPA").

9. It is not necessary to delve into the lengthy history and details of these applications for the purpose of this judgment, except to the extent to briefly note outcomes which impacted issues in this case. Regarding (1), the parties worked to narrow the issues.

During the trial, the Claimant served a fourth witness statement of Mr McCarthy responding to the Defendant's Application dated 26 September 2023 and served a relevant disclosure statement. Regarding (2), the Claimant was given permission to amend its APOC in paragraph 9(ii) to mirror the language in paragraph 9(ii) that the whole designs were the "*upper face and sides of*" the relevant panels. Permission was refused to rely on an amendment to include a perimeter design for the Macdeck 0.75x1 Panel Design equivalent to the pleaded perimeter design referenced at paragraph 9 (ia) APOC for the Macdeck 1x1 Panel Perimeter Design. Regarding (3), the Defendant's application dated 11 October 2023 and the amendments in its Re-Re-Amended Defence ("the Defence") were allowed. Any issues relating to the s.233(1) CDPA defence as set out in paragraph 15 of the Defence dealing with the later introduction of the Macdeck 1x1 Panel Perimeter Design into the case will be dealt with at any subsequent damages inquiry.

10. The parties have helpfully agreed to deal with all the pleaded issues relating to the Macdeck 1x1 Panel Design and the Q Deck 1x1 Panels such that the Macdeck 0.75x1 Panel Design and the Q Deck 0.75 x1 Panel are treated in the same way (i.e. the issues are *mutatis mutandis*). This is a pragmatic way to proceed. There are certain points which cannot be dealt with in this manner. Where necessary I will deal with distinct points between these designs separately, as well as with the Macdeck 1x1 Panel Perimeter Design and the Macdeck Pin Design.

11. The trial of this matter was listed for 3-days. This was optimistic bearing in mind the number of issues disputed. The late applications that needed to be heard and determined at the start of trial further compressed this challenging timetable. I would like to thank the parties and their representatives for their cooperation in managing matters efficiently and working outside normal court hours, both early and late, to achieve an effective trial within the restricted time available. I would also thank the court staff at the Business and Property Courts in Manchester for the last minute accommodation of the extended court sittings.

12. This judgment is delayed, for which I apologise. The circumstances mean this will not happen again. Due to the elapsed time, I have reminded myself of my contemporaneous notes on the trial and witnesses and re-read the transcripts and trial bundles.

The Witnesses

13. Four witnesses gave evidence at the trial. For the Claimant, Mr Luis McCarthy; for the Defendant, Mr Ryan Hall (a Director at the Defendant), Mr William Kershaw (also a Director at the Defendant) and Mr Charles Mills (an employee of Mpac Group Plc). In summary, my views on the witnesses are as follows. At times Mr McCarthy was somewhat combative in his responses. However, any inconsistencies in his evidence were not material. His manner and responses were reasonable in the face of extended and capable cross-examination and criticisms. At times Mr Mills came across as careful, deliberate and prepared in his responses but not to the extent the answers or conduct created concerns. All the witnesses came across as fair and willing to address and concede points reasonably. Criticisms of the witnesses were made, specifically in relation Mr McCarthy and Mr Hall. I deal with these criticisms and the relevant aspects of their evidence below.

Mr Hall

14. It was put to Mr Hall in cross-examination that in preparing his evidence someone else had provided him with his exhibit RLH4. This exhibit contains a selection of the design images from the Defendant's development process, selected from a larger potential set of early design pictures. Mr Hall maintained he selected these images. The selection of images in his exhibit is the same as Mr Mills' exhibit CRM5. The criticism being that Mr Hall did not prepare at least this part of his statement and therefore his written evidence should be treated with caution. On balance, it is not likely the designs in the exhibit RLH4, chosen from a larger set of early designs, would contain exactly the same design selection as that of Mr Mills. Mr Hall comments in his examination that he was new to the court process, to giving statements and was trying to follow his solicitors guidance. It seems he may have received some assistance or input in preparing this exhibit. It is always a concern where there is an indication a witnesses evidence may not be their own evidence, in their own words. Another of the Claimant's criticisms was the absence from Mr Hall's evidence of any explanation the designers started their design process from the Macdeck System. However, Mr Hall conceded this point appropriately in cross-examination. The Q Deck design was not developed from scratch, but based on the Macdeck System. I do not accept the noted criticisms go to any material issues. Overall, I am comfortable the witness gave his evidence in a fair and reasonable manner. I do not therefore accept the criticism as one that should impact the weight I give to Mr Hall's evidence.

Mr McCarthy

15. The Defendant's counsel, Miss Reid, made a series of criticisms about Mr McCarthy's evidence, from which I am asked to conclude his credibility as a witness is in doubt and I should factor this into the weight given to his evidence.

16. The criticisms include the use of 'we' in Mr McCarthy's statements, particularly in relation to the creation of the designs. The issue being it is not clear who is actually responsible for the noted acts. A number of these points of ambiguity were addressed in cross-examination, but not all. It was also alleged his memory of events was poor for the period 2016/2017 (a relevant period for one of the issues in the case – when articles made to the Macdeck Designs (the Macdeck System) were first made available for sale or hire) and that in this context Mr McCarthy referred to documents not provided with his statement or in disclosure. This has some force, particularly in relation to the documents referred to in his statement as assisting his recollection, but which were not provided. However, the use/reliance on these documents was not hidden. I accept that some of Mr McCarthy's responses were confusing. He accepted his recollection was imperfect. On these points, my view is his responses and explanations (such as the early stage of the Claimant's business within the broader J Mac group of companies) were those of a reasonable person recalling detailed issues from 6 - 7 years ago. There is also no broader relevance on the 'first made available' issue. Later in this judgment I determine the date the Macdeck System was made available in favour of the Defendant's case.

17. Another point was the allegation Mr McCarthy was unwilling to accept obvious points. The criticism focused on cross-examination responses relating to the comparative sizing of the Macdeck 0.75x1 Panel made to the Macdeck 0.75x1 Panel Design and the Macdeck 1x1 Panel made to the Macdeck 1x1 Panel Design. The specific point was the hesitation of Mr McCarthy to agree the long side of the 0.75x1 article was the same as the side of the 1x1 article. This question followed a number of other questions on the dimensions of this 'compressed' 0.75x1 version of the larger 1x1 panel (the details on these panels and their relationship is dealt with later in the judgment). Mr McCarthy's response "*Yes, very close, very, very close, yes*" was contextually as described – a cautious one based on his explanation "*They are almost exactly the same, I cannot say they are exactly the same … I am looking at what is in front of me and what I know.*". There were later discussions in the case on sizing of the articles and tolerances. In context, this is an overcareful answer of a witness, but not one that created an impression of an evasive witness.

18. Other criticisms related to the evidence from Mr McCarthy on his employment status at the Claimant around 2015-2017, the lack of the alleged co-author of the Macdeck Designs, Mr Eley, as a witness in the proceedings and the level of disclosure provided, in particular relating to any sales and hire invoices from 2016/2017. These are subjects dealt with in more detail as necessary in the judgment. The circumstances and responses to these issues from Mr McCarthy did not create an impression of a witness that affects my views on his evidence, taken as a whole.

19. A further point of criticism was the destruction of relevant disclosure material from the Claimant's social media during the proceedings. This material was particularly relevant to the issue of when articles made to the Macdeck Design were first made available for sale or hire. Fortunately, the Defendant had access to much of the deleted material and it was available for the trial. The destruction of the material and its relevance is not disputed. Mr McCarthy explained he did not instruct the deletion of the material but he "*did not tell them not to do it and that is my failing*.". The destruction of relevant disclosure material is a serious matter, even if in the context of this case it is unlikely to have made any difference. I do not have all the relevant information on how this occurred or why. The context is the requirement on parties regarding the preservation of documents under CPR PD57AD. In the light of the explanations provided and the context of the evidence from Mr McCarthy overall, I do not accept the level of criticism from the Defendants. However, I have been particularly careful in reviewing the matters impacted by this evidence. The point regarding the destruction of the disclosure is one that can be addressed at the form of order hearing.

The Claim

20. The list of issues agreed between the parties for determination are as follows:

Subsistence of UK Unregistered Design Right

1. Are the features of the Macdeck Designs identified at paragraph 9A of the Amended Particulars of Claim (APOC) original.

2. Are the features at sub-paragraphs 9A(i) (Macdeck 1x1 Panel Design) , 9A(ii) (Macdeck 1x1 Panel Perimeter Design), 9A(iii) (Macdeck 0.75 x 1 Panel Design) and 9A(iv) (Macdeck Pin Design) APOC features which enable the article to be connected to, or placed in, around or against, another article so that either may perform its function as set out in paragraphs 5A – 5D (respectively) of the Re-Amended Defence?

3. Are the features of the Macdeck Designs identified at paragraphs 9A(i)(a), (f), 9A(ii)(a) and (c), 9A(iii) (a), (f), 9A(iv)(a)and (b) APOC features commonplace in the design field in question by reason of the prior design of the TRAD Deck system (or elements thereof) as set out in paragraphs 5A – 5D of the Re-Amended Defence?

4. Do the features of the Macdeck Designs identified at paragraphs 9A(i)(b), (f) 9A(ii)(c), 9A(iii)(b) and (f) constitute surface decoration as set out in paragraphs 5A – 5D of the Re-Amended Defence?

5. Do the features the Macdeck Designs identified at paragraphs 9A(i)(a), (b), (c), (d), (e), (f), 9A(ii)(a), (b), (c), 9A(iii) (a), (b), (c), (d), (e), and (f) APOC comprise a method or principle of construction as set out in paragraphs 5A – 5C of the Re-Amended Defence?

Infringement of UK Unregistered Design Right

6. When were articles made to the Macdeck Designs first made available for sale or hire?

7. Whether each of the Q Deck Components in issue constitutes an article made exactly or substantially to one of the Macdeck Designs.

8. Whether the Q Deck Components in issue were copied from the corresponding Macdeck Designs.

9. Whether the Defendant knew or had reason to believe each of the Q Deck Components in issue was an infringing article.

21. There is a complex history to the pleadings and their revisions. Most of these issues are now resolved and no longer relevant for the trial. However, there are a few outstanding matters which I deal with as relevant when they arise in the judgment.

22. Under s.237 of the CDPA as amended any design right is subject to a licence of right regime in the second five-year period of the term of that right.

Section 237

(1) Any person is entitled as of right to a licence to do in the last five years of the design right term anything which would otherwise infringe the design right.

(2) Terms of the licence shall, in default of agreement, be settled by the comptroller.

23. Based on the creation date of the Macdeck Designs, the relief in this case is limited to the Claimant's right to any licence/damages. To the extent there is any dispute about this issue I will determine it at any form of order hearing when the parties have reviewed this judgment.

The Law - Subsistence of design right

24. The CDPA sets out at s.213 the relevant legislative provisions governing the subsistence of the design right:

Section 213 Design right

(1) Design right is a property right which subsists in accordance with this Part in an original design.

(2) In this Part "design" means the design of the shape or configuration (whether internal or external) of the whole or part of an article.

(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 a qualifying country in the design field in question at the time of its creation; and "qualifying country" has the meaning given in section 217(3).

Part of an article

25. The Defendant disputes whether the Macdeck 1x1 Panel Perimeter Design is "*part of an article*" (s.213(2) CDPA). Until 1 October 2014 an unregistered design could subsist in "*any aspect of*" the "*whole or part of an article*" (s.213(2) CDPA). This was amended by s.1 of the Intellectual Property Act 2014 removing the words "*any aspect of*" from s.213(2). In the present case, only acts of infringement after 2014 are claimed. HHJ Hacon provides a helpful summary of the change to the law and its impact in *Action Storage Systems v G-Force Europe* [2016] EWHC 3151 (IPEC) ("*Action Storage*") [12] – [16].

26. The Claimant relies on *Neptune (Europe) Ltd v Devol Kitchens Ltd* [2017] EWHC 2172 (Pat) ("*Neptune*") where Henry Carr J commented that the amendment to s.213(2) in the 2014 Act "*made a substantive change to the law by preventing claims in respect of disembodied features, arbitrarily selected, which are not, in design terms, part of the design*.". The amendment narrows the definition of "*design*". In this context the Judge referred to paragraph 10 of the Explanatory Notes to the 2014 Act, as cited by HHJ Hacon in the *DKH Retail Ltd v H. Young (Operations) Ltd* [2014] EWHC 4034 (IPEC) ("*DKH Retail*") decision where it states that:

"*Subsection (1) limits the protection for trivial features of designs, by making sure that protection does not extend to 'any aspect' of the shape or configuration of the whole part of an article. It is expected that this will reduce the tendency to overstate the breath of unregistered design right and the uncertainty this creates, particularly in relation to actions before courts*."

27. At [44] Henry Carr J goes on to consider the difference between '*aspects*' and '*parts*' of a design;

"*In my view, aspects of a design include disembodied features which are merely recognisable or discernible, whereas parts of a design are concrete parts, which can be identified as such. Returning to the example of Laddie J in Ocular Sciences, aspects of the design of a teapot could include the combination of the end portion of the spout and the top portion of the lid, which are disembodied from each other and from the spout and lid. They are not parts of the design*."

28. The Judge also concluded at [46] that, as the statute permits designs for parts of articles, it does not make any difference whether those parts are identified by their presence, or by the absence of excluded parts.

Originality

29. The Claimant's position is the test for originality of a design in the context of s.213(1) CDPA is whether "*sufficient skill, effort and aesthetic judgment has been expended on the new design*" and that in the creation of the new design anything more than "*slavish copying*" will result in that design being original. In support of these assessments for originality the Claimant relies on *Whitby Specialist Vehicles v Yorkshire Specialist Vehicles* [2014] EWHC 4242 (Pat) ("*Whitby*"), *Action Storage* and *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat) ("*Magmatic*").

30. The Defendant submits originality in this case is to be assessed in accordance with the requirements for protection of copyright works as set out in the series of EU case law including *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) [33] – [39] [2009] E.C.D.R 16). *Cofemel-Sociedade De Vestuario SA v G-Star Raw CV* C-683/17 [29]-[33] ("*Cofemel*") and *SI v Chedech/Get2Get* C-833/18 [27]-[35] ("*Brompton"*) ("*the EU authorities*"). The Claimant's position is the law of copyright in these CJEU copyright decisions has no relevance to this case. It is therefore necessary to resolve the relevant law that applies in order to determine whether the Macdeck Designs are original under s.213 CDPA.

31. In *Farmers Build Ltd v Carier Bulk Materials Handling Ltd* [1999] RPC at p475 Mummery LJ referred to the earlier decision of Aldous J in *C&H Engineering v F Klucznik & Sons Ltd* [1992] FSR at 427 ("*C&H Engineering*") "*that "original" in section 213(1) has the same meaning as in the earlier provisions of the 1988 Act relating to copyright in original literary, dramatic, musical and artistic works under section 1(1)(a)*". Mummery LJ went on to apply this in deciding in that case the "*designs are original in the "copyright" sense".*" At p481-482 the effect of the provisions of s.213(4) as regards originality was described as a test that must be considered in two stages: (1) the design must be original in the "*copyright sense*" in that it has not been "*slavishly copied from an earlier design*", if the court is satisfied the design is "original" in the "*copyright sense*" then (2) the design must be considered to assess whether it is "*commonplace*".

32. Both parties rely on *Whitby.* At [43] Arnold J (as he was) states that " *In order for a design right to subsist, a design must be "original" in the copyright sense of originating with the author, and not having been copied by the author from another*". The Judge made the same observation in *Magmatic*. In *Whitby*, the Judge went on to apply, without deciding the point, the meaning of "original" as set out in the EU authorities

in the context of copyright i.e. requiring the design to be the expression of the author's own intellectual creation.

33. In *Action Storage* HHJ Hacon considered the same point regarding the application of this CJEU line of cases to the question of whether a design right under s.213(1) is "original" without deciding the point as the distinction made no difference in that case:

"[20] *The point in dispute was whether the traditional test for originality in the copyright sense – that the author has spent sufficient time, labour and skill in the creation of the work – still applies, or whether the new test in copyright law, as defined by the Court of Justice of the European Union and expressed in terms of the work comprising the expression of the author's own intellectual creation, also now applies to s.213. Ms Bowhill submitted that a change in EU law of copyright can have no direct bearing on the UK law of unregistered designs. This was the view I took in Raft [2016] EWHC 1711 [9]. Mr Davis pointed to Whitby [2016] FSR 5 in which Arnold J assumed, without deciding, that the new test now applies (at [43]).*

[21] The EU test of originality comes from the CJEU's interpretation of the various copyright directives. The Court of Justice has now arguably provided a consistent and autonomous standard for originality covering all species of copyright works. It is further arguable that where art. 1(1) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information Society speaks of "copyright and related rights" (including the title of the Directive), this includes unregistered design rights.

[22] The distinction between the old and new test for copyright originality may be only semantic, see Newspaper Licensing Agency Ltd v Meltwater Holding BV [2011] EWCA Civ 890; [2012] RPC 1 at [20], although more recently the Court of Appeal expressed the view that the EU test for originality is higher than the traditional English test, see SAS Institute Inc v World Programming Ltd [2013] EWCA Civ 1482 [2014] RPC per Lewison LJ at [36]-[37]."

34. The parties provided limited submissions on this issue beyond referencing the earlier cases. The CDPA refers to originality at ss.1(1)(a) and 213(1) CDPA. The parties did not draw my attention to any distinction between the application/meaning of this term in the statute. There are good policy reasons to ensure the consistent application of words in a statute unless some other meaning is intended. The CJEU's interpretation of various directives in the EU authorities has provided an approach in assessing

originality in copyright which has been adopted by the courts of England & Wales. In these circumstances, there would need to be a good reason to derogate from that same test for originality in relation to s.213(1) CDPA

35. The Claimant referred to *Landor & Hawa International v Azure Designs Ltd* [2007] FSR 9 CA see [11]-[17] ("*Landor*") in support of its contention stated by Neuberger LJ that "*... there is no principle that a design is precluded from protection merely because it has a functional purpose, and that point does not cease to apply where the design is, or might be described as, "essentially" or "primarily" functional, or because every component of the design has a functional purpose*.". The focus of the Judge here was on s.213(3)(a) CDPA – method or principle of construction, but the point remains relevant.

36. The Claimant also relies on *Ocular Sciences v Aspect Vision Care Ltd* [1997] RPC 9 at 423 lines 6-10 ("*Ocular*") to support its position that the CDPA was "*intended to give protection to wholly functional designs*.". It is worth considering the context of this statement within the paragraph quoted where Laddie J explained that "*There is no reference in the relevant provisions of the 1988 Act to features which appeal to or are Judged by the eye. ... The worth and ingenuity of a functional design over designs of similar overall appearance may be due to detailed relative dimensions. Its shape will, because of the different dimensions, be different*.".

37. The argument is that where the EU authorities on originality in copyright are applied to unregistered designs, this position creates a tension where an article/work is solely dictated by its technical function and therefore not a work of the author's intellectual creation.

38. The EU authorities provide that subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices. Relevant sections from *Brompton* are [26]-[27], [31] and [33]-[35]:

26 It follows that a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices.

27 In that regard, it should be noted that the criterion of originality cannot be met by the components of a subject matter which are differentiated only by their technical function. It follows in particular from Article 2 of the WIPO Copyright Treaty that copyright protection does not extend to ideas. Protecting ideas by copyright would amount to making it possible to monopolise ideas, to the detriment, in particular, of technical progress and industrial development (see, to that effect, judgment of 2 May 2012, SAS Institute, C-406/10, EU:C:2012:259, paragraphs 33 and 40). Where the expression of those components is dictated by their technical function, the different methods of implementing an idea are so limited that the idea and the expression become indissociable (see, to that effect, judgment of 22 December 2010, Bezpečnostní softwarová asociace, C-393/09, EU:C:2010:816, paragraphs 48 and 49).

31…cannot be the case where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom or room so limited that the idea and its expression become indissociable.

33 Where the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright protection.

34 Therefore, in order to establish whether the product concerned falls within the scope of copyright protection, it is for the referring court to determine whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.

35 In that context, and in so far as only the originality of the product concerned needs to be assessed, even though the existence of other possible shapes which can achieve the same technical result makes it possible to establish that there is a possibility of choice, it is not decisive in assessing the factors which influenced the choice made by the creator. Likewise, the intention of the alleged infringer is irrelevant in such an assessment.

39. It is my view that such a tension does not really exist. The referenced English authorities do not go so far as to explain that s.213(1) CDPA allows originality to subsist in the shape and configuration of a design which was solely dictated by its technical function. A design which is wholly functional, has a functional purpose or *"its realisation has been dictated by technical considerations"* can be original. To the

extent any situation may fall between the two propositions, it should be rare and probably not ultimately a matter for this court.

40. In my view, the authorities referenced correctly determine the appropriate interpretation of the statute is that the word "original" in s.213(1) should be given the same meaning as the word "original" in s.1(1)(a) CDPA. It is also, in my view, how a reasonable reader would construe the statutory provisions. This construction has the benefit of making sense bearing in mind the genesis of s.213 and its more restrictive but overlapping nature with copyright. I will therefore apply the principles of the relevant EU authorities regarding originality, such as *Cofemel* and *Brompton.*

41. In *Action Storage*, HHJ Hacon explained the distinction between the historic UK and EU line of authorities on this issue may only be semantic. The Judge went on to recognise that Lewison LJ in *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482 expressed the view that "*the EU test for originality is higher than the traditional English test*". In the post trial copyright case of *THJ Systems v Sheridan* [2023] EWCA Civ 1354 ("*THJ Systems*") Arnold LJ in dealing with the incorrect legal test being applied at first instance confirmed:

"*It is because the test he applied was that of "skill and labour", which was the test applied by the English courts prior to Infopaq, including in Navitaire Inc v easyJet Airline Co Ltd [2004] EWHC 1725 (Ch), [2006] RPC 3 and Nova Productions Ltd v Mazooma Games Ltd [2006] EWHC 24 (Ch), [2006] RPC 14, and not the test of "author's own intellectual creation" laid down by the Court of Justice. As can be seen from cases such as Football Dataco and Funke Medien, these two tests are not the same, and the European test is more demanding; although Painer establishes that even a simple portrait photograph may satisfy it in an appropriate case*."

42. This authority is included for completeness. The decision explains the correct test of originality to be applied in copyright cases is that set out in the noted line of EU authorities. It does not alter the submissions of the Defendant at trial or the EU authorities copyright test to be applied. The Claimant's counsel confirmed the application of the EU authorities in copyright cases and the test for originality in copyright is not in dispute. The Claimant's submissions disputed whether it should apply to this case.

43. I am also aware of a further post trial case, *Sonia Edwards v Boohoo.com & others* [2025] EWHC 805 (IPEC) which dealt with an action for infringement of unregistered

design right. I mention this for completeness, it does not impact my analysis on the issue. In this case Deputy Judge Tom Mitcheson KC applied the noted EU authorities such that "*the design must be the expression of the author's own intellectual creation*." [25]. However, it does not appear the question of the application of the EU copyright standard to originality under s.213 was challenged in that case.

Commonplace

44. The parties do not appear in dispute over the law on meaning of the 'commonplace' feature in the context of s.213(4) CDPA but rely on slightly different case law.

45. In *Action Storage*, HHJ Hacon summarised the approach to determining whether a design was commonplace at a relevant date:

"*37. I will summarise the principles which are relevant to this case:*

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

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

(3) A design will be commonplace if it is shown to have been current in the thinking of designers in the field in question at the time of creation of the design, see Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd [2005] R.P.C. 6 at [56]. Another way of looking at this is that a commonplace design will be one which is trite, trivial, common-or-garden, hackneyed or of the type which would excite no particular attention in those in the relevant design field, see Ocular Sciences Ltd v Aspect Vision Care Ltd [1997] R.P.C. 289, at p.429, approved in Farmers Build Ltd v Carier Bulk Materials Handling Ltd [1999] R.P.C. 13, at pp.477 and 479. A third way of characterising a commonplace design is that it will be ready to hand, not matter that has to be hunted for and found at the last minute, see Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd [2005] EWCA Civ 761; [2005] R.P.C. 36, at [60].

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

(5) A design made up of features which individually are commonplace is not necessarily itself commonplace. A new combination of run-of-the-mill features may not be commonplace. See Ocular Sciences at p.429, approved by the Court of Appeal in Farmers Build at p.476 and in Ultraframe at [64].

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

46. Laddie J in *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] R.P.C. 289 also provided helpful guidance on this issue at p429 line 45

"*It is always undesirable to replace one ambiguous expression by another and for that reason it is not right to redefine the word "commonplace" in the 1988 Act, but it seems to me that the flavour of the word is much along the lines suggested by Mr Pumfrey. Any design which is trite, trivial, common -or-garden, hackneyed or of the type which would excite no particular attention in those in the relevant art is likely to be commonplace. This does not mean that a design made up of features which, individually, are common place is necessarily itself commonplace. A new and exciting design can be produced from the most trite of ingredients. But to secure protection, the combination must itself not be commonplace*."

Method or principle of construction

47. S.213(3)(a) is effectively a mechanism by which designs of too high a level of generality are excluded from protection. Neuberger LJ approved a summary of the exclusion from the text *Russell-Clarke and Howe* in *Landor* [13]:

"*A method or principle of construction is a process or operation by which a shape is produced, as opposed to the shape itself ... 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 specific appearances as being made within it, is too broad and will be invalid.*"

48. In *Magmatic* Arnold J [94] noted that a feature which was "*...more like a patent claim than an identification of particular aspects of configuration*" which "*covers a multitude of different specific appearances*" was a method of construction.

49. The effect of the 2014 Act removal of "any aspect of" a design from s.213 CDPA should limit the relevance of this section and will "*almost always by itself prevent a design right owner from claiming protection in relation to a method or principle of constructions*." (*Action Storage* [56]).

Must fit /interface provision

50. Section 213(3)(b)(i) provides that any features falling within this provision are excluded from being considered a design right:

"*(3) Design right does not subsist in –*

...

(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 may perform its function".

51. Both parties addressed me on the well known passage in Ocular Sciences at p424:

"This is sometimes referred to as the interface provision. Its 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."

52. In this case the issue of 'placing around' is a key point of dispute. In *Action Storage Systems* [68] HHJ Hacon dealt with the limits of the scope of this exclusion:

"*There will be a limit to the exclusion of design right protection under this provision. I take the view that the shapes of the relevant parts of the connecting articles must be such that there is a degree of precision in the interrelationship between one article and the other, i.e. the designs afford some precision in the fit. For example, it would be surprising if the handle of a coffee mug were refused design protection solely because it is shaped to enable a human hand to connect to it to pick up the mug. (I use the convenient term "fit" but this does not imply that the articles must touch. Section 213(3)(b)(i) can apply to features of shape or configuration of an article which enable it to be placed around another article and so there may be a gap between them, see Dyson [2006] R.P.C. 31 at [31]–[38])*."

53. The Claimant also drew my attention to a similar statement of Park J in *A. Fulton Co v Grant Barnett &* C [2001] RPC 16 at [75] ("*Fulton*"):

"*Section 213(3)(b)(i) does not provide that design right cannot subsist in an article if it can be placed in, around or against another article. Rather it provides that design right cannot subsist in features of shape or configuration which enable the article to be so placed. If this is going to apply, in my view the particular aspects of shape or configuration in which design right is claimed to subsist, but as respects which the claim is going to fail because of the interface exclusion, must be specifically designed so as to enable the one article to be placed in, around or against the other. One can readily see this with an article like a spare exhaust pipe. It has to be exactly shaped and configured so as to connect up with the engine of the car and to enable the exhaust gases to be avoided into the outer air. With the Miniflat case on the other hand, the particular features which give it its unique shape or configuration (like the rectangular box-shape and the outward facing seams at the edges) are not designed so as to enable it to perform the function of containing the umbrella. Any case of the same approximate dimensions would do that, including simple cylindrical cases like many which were in evidence. The features of shape or configuration which are special to the Minifiat case are designed to perform the function of looking attractive and promoting sales of the product, not to perform the function of enabling the case to be placed around the umbrella*."

Surface decoration

54. The exclusion in s.213(3)(c) CDPA addresses some of the issues of overlap of features with copyright protection. In considering whether a feature is three-dimensional, Henry Carr J in *Neptune* [26] referenced the approach to this 'value judgment' as summarised

in *Russell-Clarke and Howe on Industrial Designs*, 9th edn, at [4-037] "*A feature which is truly three-dimensional, rather than a surface feature, will fall outside the scope of the exclusion from design right (i.e. will therefore be covered by design right), regardless of whether its purpose is functional or decorative. The fact that a design feature exists in a third dimension, but only a small third dimension, does not mean that it must be surface decoration: there is a value judgment for the Court to make.".*

55. In *Dyson v Qualtex* [2006] EWCA Civ 166 [79] ("*Dyson*"), Jacob LJ dealt with the approach of the 'ordinary reasonable consumer' in the context of understanding when a feature may be one of surface decoration:

"*The ordinary reasonable consumer or designer would not think, when looking at this, that they were looking at a decorated surface. I do not see why design law should see things differently: that law already sometimes seems to be a particularly abstruse branch of metaphysics. There is no need to make things worse by finding things to be surface decoration which would not ordinarily be so perceived*."

Issues 1-5: Subsistence of design right

Issue 1 - Are the features of the Macdeck Designs identified at paragraph 9A of the Amended Particulars of Claim (APOC) original?

Ownership and date of creation of the Macdeck Designs

56. For the purpose of this case, the Defendant accepts any unregistered design rights in the Macdeck Designs set out in Annexes 3, 3A, 4 and 5 of the APOC have been assigned to the Claimant such that it is the owner of rights in the Macdeck Designs. The Claimant pleads that its Macdeck Designs were created on 4 January 2016. The line drawings of the Macdeck 1x1 Panel Design and Macdeck 0.75x1 Panel Design relied on as the designs in the case at Annexes 3 and 4 of the APOC are dated 4 January 2016. The Macdeck Pin Design, relied on as the design at Annex 5 of the APOC is not dated. Mr McCarthy was cross examined about points relating to this creation date of these three designs. The date was not disputed. I therefore accept that each of the Macdeck Designs was created on this date.

Originality

57. The Defendant put the Claimant to proof on originality. At trial the Defendant explained its position on the test for originality – the expression of the design has to be the product of its author's own intellectual creation as set out in the EU authorities. The

Claimant relied on the traditional test noted in the cases *Whitby* and *Action Storage,* although, counsel for the Claimant's position was the Claimant would also succeed on originality under the CJEU case law.

58. These are different tests. Their application may result in overlapping outcomes depending on the factual situation, but the assessment is not the same. This was also confirmed by Arnold LJ in *THJ Systems*. The Defendant's position was this Court has to decide what law to apply. I have determined the EU authorities on copyright shall apply to the question of whether a design is original under s.213(1) CDPA.

59. The Claimant made a pleading point that the Defendant should not be permitted to rely on a positive case reliant on this line of CJEU law where this position was only raised at trial. It is therefore necessary to consider the Claimant's position that the Defendant has not properly pleaded a positive case with regards to originality. Other than putting the Claimant to proof on the issue, the Defence did not raise any points relating to the elements of the Macdeck Designs alleging a lack of originality due to their being "*dictated by their technical function*". The Defendant provided responsive pleadings with particulars on its other positions relating to originality, including as regards features of shape or configuration that were commonplace, covered by the interface provision, or amount to a method of principle of construction.

60. In *Action Storage* at [111] the Judge identified the need for the parties to properly particularise their positions and that the "*… list will also perform a valuable function in relation to any case the defendant may wish to run in relation to lack of originality (in the copyright sense), s.213(3), s.213(4) and possibly on other matters*.". I do not accept the Defendant's comments that because *Action Storage* was a case in the IPEC the noted particularisation suggestion by the Judge does not apply to a design action in the High Court. The Judge gave no such indication and the practical guidance is of general relevance. These useful principles should apply to any case dealing with these substantive issues. The Defendant followed this guidance for issues relating to originality, other than the "*dictated by their technical function"* point.

61. The Claimant's position is the Defendant did not plead relevant factual allegations in relation to its reliance on the EU authorities test for originality, or notify it of its position on their position on the applicable law for originality prior to the trial. It is submitted the consequence is the Defendant should therefore not be allowed to rely on the new, unpleaded, factual allegations being asserted at trial, particularly relating to elements of the Macdeck Designs being "*dictated by their technical function*".

62. Pleadings are essential to defining the issues in dispute at trial. A statement of case pleaded at an appropriate level of detail allows the overriding objective to function properly and the case – and the relevant issues therein – to be heard in a fair manner. In this case, the relevant issue was pleaded at a high level of generality in that the Defendant put the Claimant to proof, but raised no positive case. The Claimant's position is that the relevant factual allegations were first made in the Defendant's skeleton argument. The Defendant argues it was clear originality was in issue, that the EU authorities would therefore also be relevant and that as part of that case law it is for the Claimant to demonstrate the author had the required *'creative freedom'* to attract originality.

63. That is right as far as it goes. The Claimant should ensure it provides sufficient evidence on its designs such that the court can make a determination on the question of whether the author has "*expressed his creative ability in an original manner by making free and creative choices*". However, the Defendant should not 'sit back' knowing it will raise a positive case on particularised features being *'dictated by their technical function*' and then rely on argument that the Claimant has not prepared evidence dealing with each of these points. It is precisely this type of unsatisfactory position that HHJ Hacon was trying to avoid by the parties providing appropriate particularisation.

64. In assessing this issue it is relevant to take into account in my approach to the question and particularisation, that the law being applied to originality under s.213(1) CDPA has been an open issue.

65. This is a case where it is the Claimant's position its designs would meet both tests – whether under the earlier English authorities or the EU authorities. The Claimant was on notice of the need to prove the originality of its designs. This was in the context of clear indications from other relevant cases dealing with unregistered designs that the EU authorities on originality were relevant and being applied. I have decided in the circumstances of this case that the issues raised by the Defendant, albeit late, can be addressed by the Claimant based on the arguments and evidence provided at the trial. These situations should and can be avoided by adherence to the pleading principles set out in *Action Storage*.

Are the Macdeck Designs original?

66. In *WaterRower (UK) Limited v Liking Ltd* [2024] EWHC 2806 (IPEC) I set out relevant background to the EU authorities relating to original subject matter in relation to

copyright. This is equally relevant to the assessment of originality under s.213(1). Below are relevant excerpts:

[138] *Cofemel was a case about the protection of various clothing designs by copyright. It follows a line of case law of the CJEU on copyright protection under Art. 2(a) of the InfoSoc Directive. Referring to the earlier CJEU decisions of Infopaq International (C-5/08) [2009] E.C.D.R 16, and Levola Hengelo BV v Smilde Foods BV (C-310/17) [2019] E.C.D.R. 2, the court confirmed [21] the concept of "work" is "… clear from the Court's settled case-law, an autonomous concept of EU law which must be interpreted and applied uniformly, requiring two cumulative conditions to be satisfied. First, that concept entails that there exist an original subject matter, in the sense of being the author's own intellectual creation. Second, classification as a work is reserved to the elements that are the expression of such creation…".*

[139]. *The court went on at [30] to explain in the context of the first condition that for subject matter to be capable of being original "… it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices …". Subject matter with these characteristics qualifies as a work and therefore attracts copyright protection in accordance with the InfoSoc Directive.*

[140]. If the realisation of that subject matter has been dictated by technical considerations, rules or other constraints, which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work. The issue of technical constraints is considered in more detail by the CJEU in Brompton.

[144] Cofemel explained that where a shape is dictated by technical considerations [31] "… which left no room for creative freedom …" the subject matter would not possess the requisite originality. Brompton picked this up at [26] and confirmed that "… even if [the article's] realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices.". However, where the shape of a product is "solely" dictated by its technical function, that product cannot attract copyright protection.

67. Prior to developing the Macdeck Designs, Mr McCarthy had been hiring another safety platform decking product called TRAD Deck. His evidence also details other platform decking products available prior to the creation of the Macdeck Designs. He was aware

of these in the context of creating the Macdeck Designs. These earlier products also included the G&M safe deck, the Swale Deck, the G Deck and the Rhino Deck. Below are pictures of a selection of the safety decking products available prior to the creation of the Macdeck Designs.

Figure 1 TRAD Deck panel

Figure 2 G & M Safe Deck

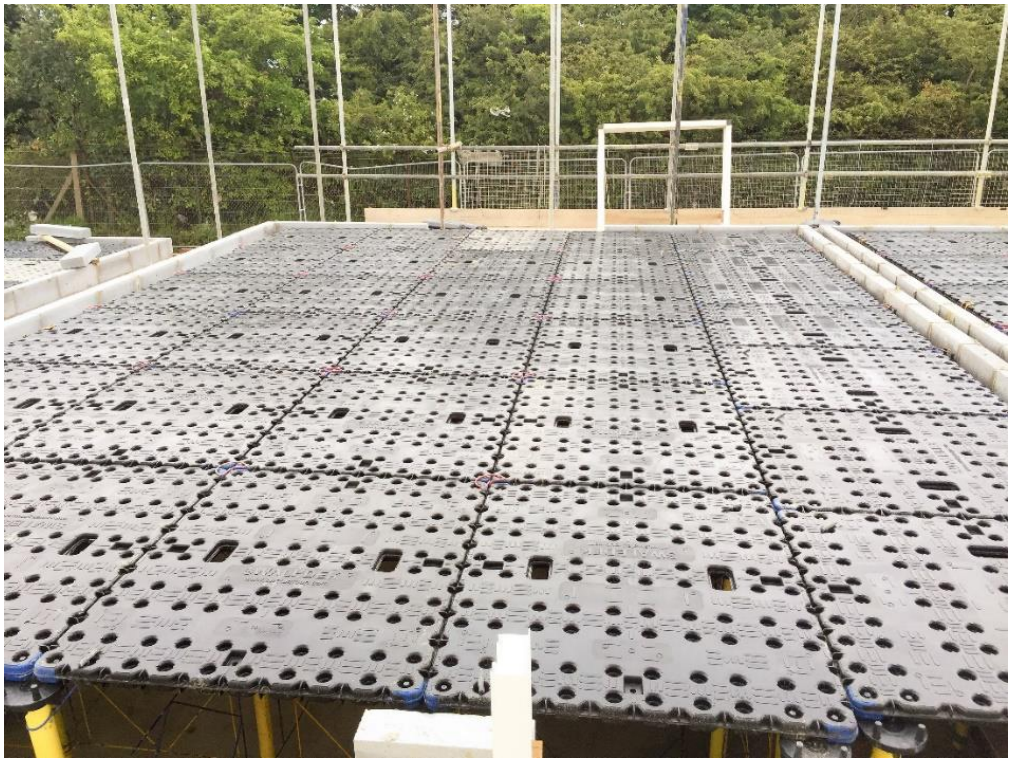

Figure 3 Swale Deck panel

Figure 4 Rhino Deck panel

Macdeck 1x1 Panel Design

68. The Defendant's skeleton argument set out a number of reasons it argues each of the Macdeck Designs are dictated by technical function and therefore not original. In dealing with these issues I am conscious the Claimant was not made aware of the existence of the Defendant's positive case on this issue until shortly before the trial.

69. The Defendant claims that none of the features particularised as significant in paragraph 9A of the APOC are original. These include the following features for each of the designs as ones alleged to be dictated by technical function:

(i) 9A(i)(d) APOC

70. The Defendant's submission is the presence of narrow slot-shaped apertures arranged in two concentric squares (Figure 22 B p98 shows one of the sides of each of the rows of these concentric square shapes) in between the central square area of the upper face of the panel and the perimeter of the panel are provided for the sole purpose of enabling straps to be used to connect the panels together. In cross-examination, Mr McCarthy's acknowledged these slots referred to at 9A(i)(d) APOC were "*to allow a cam strap to go through*.". The cam straps are explained as components put through the decking and an overlap panel that sits on top of the main panelling layer. The strap is pulled tight to push the panels into the wall and reduce lateral movement (see Figure 10 p53). Mr McCarthy's uncontested evidence is the TRAD Deck and G&M Safe Deck systems have holes/apertures but these are not designed for cam straps to pass through them. This makes it more difficult to 'cam' their systems. The Swale Deck has no cam strap holes. Therefore the Macdeck was designed to be functionally more useful for cam straps. Mr McCarthy explains he did not want these holes to be *'too big'*. The position of these slot-shaped apertures relative to other openings on the board was planned to optimise the larger build structure. There is no dispute there are functional considerations which limit choices made in the Macdeck Design. However, the author retained creative freedom sufficient to reflect his personality in this feature of the design. For example the choice of the size of the apertures, the number, their shape and their precise location.

(ii) 9A(i)(c) APOC

71. The Defendant submits the shape and positioning of the 16 apertures that surround the central square area of the upper face of the panel (Figure 22 C p98 shows one of the

rows of a side on the central square shape) are dictated by their technical function. For example, the location of the larger centrally located aperture (the 'hand hold') was designed to be at the point which the board balances so that it can be carried more easily in one hand. The size of the hole cannot be so small that a hand could not fit and could not be much wider or the balancing point will be lost. The 'hand hold' apertures referred to by the Defendant are 4 of the 16 referred to in the APOC. These being the wider 4 apertures which (in the symmetric nature of the design) are at the midpoint of opposing sides of the panel. Mr McCarthy endorses most of the Defendant's submission. He wanted a design where a panel could be picked up "*from any direction*" i.e. the symmetry means it does not matter which side of the panel is used to pick up any article made to this design. It would be balanced such that it was easier to carry and not tip over to a '*diamond*' shape such that the effective length is along a diagonal and the tip of the panel catches on the floor.

72. All these 16 holes (including the 4 larger 'hand hold' ones used to carry the panel) are also used for the scaffolding build i.e. the scaffolding is intended to be able to go through these apertures. The 4 larger apertures have a dual roles for the scaffolding poles and to allow a hand to carry the panel. Figure 5 is a diagram of the Macdeck System with the scaffolding built through these apertures. These apertures therefore have a functional purpose and are to some extent dictated by their technical functions.

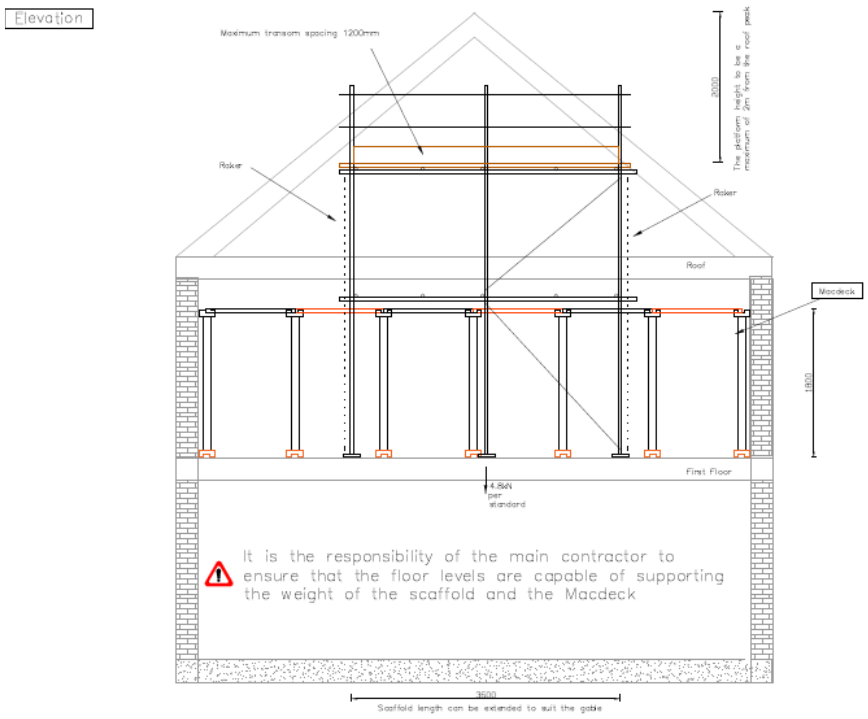

Figure 5 Macdeck System with scaffolding built through

73. There is limited direct evidence on this issue, likely due to the late nature of the Defendant's positive case. However, Mr McCarthy deals with design freedom for safety decking panels in the context of his evidence on infringement by the Defendant's Q Deck Components. The breadth of design freedom can also be seen indirectly from the shapes and sizes of the noted safety panels available before the creation of the Macdeck Designs and the different shapes and layout used in the Q Deck Components. The shape and configuration of these 16 apertures could be slightly bigger or smaller, in different locations within the panel or in relation to each other or there could have been a different number of the holes. The number, size, shape and configuration of the 16 holes leaves sufficient creative freedom for the author to express his personality in this feature.

(iii) 9A(i)(e) APOC

74. The Defendant argues the rectangular holes above the pin-receiving sections which are situated around the perimeter of the Macdeck 1x1 Panel Design are required such that the pin-receiving sections can be viewed from above (see an example of one of the sides of the panel including these holes in Figure 22 A p98). There is no dispute about how the Macdeck System operates. There are legs that can sit on top of the base or under the head. The universal base and head element is connected using a pin (the Macdeck Pin). On the top of the head are 4 intersections (see Figure 6 below). It allows four panels to fit on one head. There are also holes on the sides of the panel which allow the intersections to be joined together. There are four corners of each panel that sit within the head. They can be pinned (with Macdeck Pins) to prevent uplift (i.e. when wind gets underneath can lift a panel).

Figure 6

75. Mr McCarthy's evidence is this is a way to achieve a function of the safety panel. Choices remain, for example, the number of these holes on the top and edge of the Macdeck Panel (Mr McCarthy says the inner, slightly separated holes of the repeating pattern of three holes on the panel perimeter surface and edge do not need to be there), as well as their size and shape. These choices may be limited due to the functional requirement as a viewing 'window' but in these circumstances my view is these restrictions are not such that these holes are solely dictated by their technical function such that the author has no room to display his creative choices. If I am wrong about that and these noted holes on the surface perimeter and edge of the panel were solely dictated by their technical function, this would not alter my below view assessing the design as a whole.

76. In the context of design freedom, Mr McCarthy's evidence is there is no need for the designed panel shape to be a square to achieve its functional requirement as a safety platform decking system, as demonstrated by the different shape of the G&M Safe Deck (see Figure 2 p27).

77. The Claimant's evidence acknowledges the Macdeck 1x1 Panel Design contains features with functions. This is intended to be a platform decking system with improved functionality over prior safety decking systems. The Defendant has focused its arguments on compartmentalised features and their individual functional nature. That

is, at best, only part of the assessment necessary on originality here. The assessment is whether the Macdeck 1x1 Panel Design, as a whole, is original. It is therefore important to consider the whole of the shape and configuration (relative positioning of the different elements) of the design in this context. The assessment of the specific features discussed above are a helpful aid in this exercise as a framework for this analysis. The functional nature of the features discussed have elements of technical restriction due to their functional role in the design. These functional requirements dictate some elements of these features - for example, the apertures that can be used for scaffolding poles to pass through need to be able to fit scaffolding poles.

78. However, even on these more specific features within the design, the evidence supports considerable design freedom. These include the choice of the overall shape of the design (square, rectangular), the size of different holes (beyond the minimum noted for the scaffolding holes or for a hand hold), the number of holes, their shape and the spacing relationship between the different holes and location within the design. The author therefore had the flexibility in creating the Macdeck 1x1 Panel Design to reflect his personality in creating and representing these elements visually as an expression of his free and creative choices. The Macdeck 1x1 Panel Design is original.

Macdeck 1x0.75 Panel Design

79. The parties have agreed to treat the pleaded issues relating to the Macdeck 1x1 Panel Design in the same way as the Macdeck 1x1 Panel Design. Where they had not, for the purposes of this assessment there is no distinction with the Macdeck 0.75x1 Panel Design. It is identical to the Macdeck 1x1 Panel Design, save for the dimension of one side has been proportionately reduced from the Macdeck 1x1 Panel to the 0.75x1 Panel. There is nothing material in this change that impacts my view as set out for the Macdeck 1x1 Panel – it is original.

Macdeck 1x1 Panel Perimeter Design

80. The Macdeck 1x1 Panel Perimeter Design is a part of the Macdeck 1x1 Panel Design (see below at p61). The Defendants arguments are therefore the same as for the Macdeck 1x1 Panel Design but limited to the relevant part. The perimeter design has fewer but similar choices for the positioning, size and shape of the apertures on the surface of the outer perimeter of the panel (for example, they did not need to be square). The presence of the raised profiled pattern on the surface of the upper face of the panel provided further opportunity for design freedom, as did the shape, size and positioning

of the rounded arch shaped slots in the sides of the panel (see one of the sides of the panel design in the line diagram in Figure 23 p98). There were submissions the holes in the side of the TRAD Deck panels were different shapes and in different locations than the arch shaped apertures on the Macdeck 1x1 Panel Design. On cross-examination, the evidence from the Defendant's witness, Mr Mills, strayed into opinion regarding how the interplay of the structural ribs underneath the Macdeck 1x1 Panel Perimeter Design product would dictate the position and shape of the side holes due in part to the injection moulding process. Although experienced, Mr Mills did not consider himself an expert in injection moulding. This evidence was of little value. However, the number and location of these arch shaped (sometimes referred to as rounded) slots in the side of the panel and the size of their apertures do have a technical function. They are used to allow for a pin connection.

81. The nature of the design means the author's choices and opportunity to express these as part of their intellectual creativity are more limited. However, in my assessment, the degree of design freedom in this part still allows the author to reflect his personality in the design, as an expression of his free and creative choices.

82. The Claimant's choices in the design were not solely dictated by their technical function. There is little guidance on how to assess the precise level of intellectual creativity needed for a design to be original (or a copyright work). It is a question of fact and degree. In coming to my assessment here with the part of the design as a whole, I note the more limited number of choices available to the author does not ultimately detract from choices including relative spacing, shape of the different holes and their dimensions. The Macdeck Panel Perimeter Design is also original.

The Macdeck Pin Design

83. I have already explained elements of how the Macdeck Pin operates within the Macdeck System. Mr McCarthy goes on to explain its further importance to the system;

"38. The pin was a major feature when we designed it in terms of how it connected with the system and the shape and size of it [see Figure 7 below and Annex 4]. *You have to push the pins in when you're erecting the system and then pull them out when you're taking it down. This is critical for securing base and heads to legs, securing panels to base and heads and to other panels, and to prevent uplift. There are pins 5 pins to every panel, so it's the most volume of any component. We took all of that into consideration when designing the pin. It shows the level of detail that we go to because every element*

of the design of these products was to think about usability and where the volume is. The size and shape of other system's pins and the design internally is different. When we were using them and looked at our gap analysis, we knew this pin had to allow for two fingers to go in there comfortably."

Figure 7 Macdeck Pin

39. If you try and pull one of these pins out with one finger when using for example a TRAD pin or a GM pin or any other products on the market, it's really difficult to get them out. There can be thousands of them that you've got to get in and out - it's a high volume activity during the process of erection or dismantling of our system. It was another thing that we made simple and improved. We thought about life jacket toggles and looked at the designs and concepts for items like that. Then we started looking at all of these different parts like that and then created the design for our pin around usability. The end of the pin is a flat surface to allow you to push them in and out. Then you have what's a bit like an arrow head, but not sharp. The top is where the two fingers will go in to pull it out and then you push it in using the flat surface.

84. The Macdeck Pin Design is relatively simple. It is for a pin that connects the panel to the pillar support and can be used to pin the intersecting panels to the base and head. The Defendant claims at least the following features (some particularised as particularly significant in 9A(iv) of the APOC and others not) are dictated by technical function:

(i) 9A(iv)(b)

85. The shape of the shaft of the pin, which comprises a groove running down the length of the shaft, has the function of reducing the amount of polymer required, thereby reducing the weight and cost of the pin.

(ii) 9A(iv)(a)

86. The shape of the head of the pin, which comprises two disc shapes either side of a rounded trapezoid aperture, and is wider at the end furthest from the shaft of the pin, was dictated by the technical requirement that 2 fingers could be placed through the formed aperture in the trapezium shape.

(iii) 9A(iv)(a)

87. The lower disc at the end of the rounded trapezoid aperture closest to the shaft of the pin acts as a stop when it abuts the connector.

88. The Defendants say each of these features solely dictate the technical function in the design. Mr McCarthy explained the pin design background and development process. The pin could have been made in a number of different ways. For example, the shaft could be a different diameter, the pin could have been multiple pins as shown in an example called the Rev Deck (below at Figure 8) and the shape and size of the discs are choices available to the author.

Figure 8 Rev deck pin

89. The highly functional nature and simplicity of the pin design and the limitations in the number of choices available are relevant to the assessment of originality. Whether the remaining choices for the author are sufficient for the creator to express their intellectual creativity is not purely a question of the quantity of such changes but also the quality. Here the designer made decisions about shape and configuration for the Macdeck Pin Design. These include: that the channel running down the shaft is heavily dictated by the need to remove mass for efficiency and to help achieve a compression fit; the shape, length, and overall dimensions of the trapezoid hole for the fingers to pull out the pin; and the size and shape of the upper and lower discs used to help push the pin into position and to prevent it going in too far.

90. The functional considerations of these features dictate elements of the design. Viewed as a whole, these features do not, in my view, combine to solely dictate the shape and configuration of the whole design. The creator of the design retains sufficient freedom of choice to reflect his personality in the design as an expression of his free and creative choices. The Macdeck Pin Design is original.

Other points on originality

91. The Claimant accepts both Mr McCarthy and Mr Eley considered the TRAD Deck panel (and other platform decking systems available pre-priority date) in arriving at the Macdeck Designs. In the context of its submissions on whether the Macdeck Designs are original the Defendant's skeleton argument considers whether the features of the Macdeck Designs were copied from an earlier pre-Macdeck design. However, in submissions the Defendant's counsel accepted the Macdeck Designs had not been "*slavishly copied*" from an earlier design. For completeness, even if parts had been copied from an earlier design, this would not necessarily prevent a design from being original and, in my assessment, there is nothing in this argument that alters my view on each of the Macdeck Designs being original.

92. The Defendant also takes a point on originality relating to the relative timing of the creation of the Macdeck 1x1 Panel Design and the Macdeck 0.75x1 Panel Design. The point being that whichever design was created second was effectively copied from the first due to the limited differences. This issue was not pleaded by the Defendant. In any event, the parties have agreed to treat the pleaded issues for the Macdeck 1x1 Panel Design and the Macdeck 0.75x1 Panel Design in this case as *mutatis mutandis* (what goes for one, goes for the other). The issues of subsistence and infringement are therefore to be dealt with based on either design, the one chosen was the Macdeck 1x1

Panel Design. I have assessed both designs as being original. It does not matter for the purpose of this case which was created first in time.

The author

93. The designs need to be an author's own intellectual creation. The Defendant takes issue with the identity of the author of the Macdeck Designs. It argues Mr McCarthy's input in this process was limited to purely functional elements of the Macdeck Designs and therefore his input did not satisfy the requirement that this "*subject matter reflects the personality of its author, as an expression of his free and creative choices".*

94. Mr McCarthy was the Managing Director of the Claimant. He explained he came up with a concept in around 2015 that later became the Macdeck Designs. Mr McCarthy had been involved in the safety decking and scaffolding industry prior to the creation of the Macdeck Designs, including his working with the TRAD Deck. He explained he wanted to create a decking system "*that was steadier under foot, that didn't have as much bouncing, but was still able to take the impact and the loads required under the BS EN12811 Part 3 and also the roof non-fragility test which are the testing criteria for platform decking. These drivers were in the forefront of my mind when designing the Macdeck*.". It does not appear disputed that Mr McCarthy instructed Mr Eley of PPL to assist with creating the Macdeck Designs. Mr Eley brought skills as a specialist in injection moulding and a designer of product parts and specialist tools. During his cross-examination, Mr McCarthy confirmed Mr Eley created the CAD line drawings of the Macdeck 1x1 Panel Design (and therefore also the Macdeck 1x1 Panel Perimeter Design) and the Macdeck 0.75x1 Panel Designs relied on in the pleadings. The Defendant's post-trial references also refer to Mr Eley as a creator of these designs. In cross-examination, Mr McCarthy explained the early, in person and informal process where he described the concept of the designs to Mr Eley. When questioned if he had drawn a sketch to show Mr Eley what he was thinking, Mr McCarthy answered "*Yes, you know, it might have been, I might have wrote it down on a piece of paper like a little grid but it was nothing substantial.*". Neither that document nor any draft design documents are available. Mr McCarthy explained he had provided the documents in disclosure that he could find. He had not mentioned this sketch at any prior point. In the situation I appreciate this may (or may not) have opened further routes for investigation and potential allegations, such as the sketch somehow depriving the Macdeck Designs of originality. However, it is necessary for me to make my decision on the available information, carefully weighing these points, their context and timing.

95. It seems Mr Eley created the relevant CAD drawings for at least the Macdeck 1x1 Panel Design (and therefore also the Macdeck 1x1 Panel Perimeter Design) and the Macdeck 0.75x1 Panel Designs. Mr McCarthy and Mr Eley worked together to create the Macdeck Designs; *"...everything we did as a team, everything was agreed and signed off as a team. I was instructing and paying so every decision, at the end of it, was mine because we had agreed it*.". The evidence described the relationship as one with a back and forth type discussion during the formal development and commercialisation process for this design and product development. There appear to have been others involved in the process but the key individuals remained Mr McCarthy and Mr Eley. At times Mr McCarthy's evidence was unclear on precisely how the process of creating the Macdeck Designs was carried out. He referred to a process framework 'New Product' flow chart and the extensive time and effort that were put into the steps bringing this new product to market. He referred to the broader team involved in unspecific and general terms. The evidence from Mr McCarthy regarding his involvement in the process did not really alter on cross-examination. His input focused on functional aspects of the Macdeck Designs. However, there is some evidence he made joint decisions on the shape and configuration of the Macdeck Designs (for example, the location of the apertures as carrying hand holds and his creation of the initial concept). What is missing is evidence from Mr Eley as a witness. This is regrettable as his evidence would likely have been of assistance. Again, this leaves me with the situation of resolving this issue on the information available.

96. The Defendant's position is there is no evidence demonstrating any creative input by Mr McCarthy into the design. On the basis Mr Eley was not called to give evidence the Defendant suggests the court should not seek to rely on matters that Mr Eley "*could perhaps have said*". It is in this context the Defendant's rely on *Efobi v Royal Mail Group Limited* [2021] UKSC 33 to request an adverse inference be drawn due to the failure of Mr Eley to provide evidence. In *Efobi* Lord Leggatt explained that "*Whether any positive significance should be attached to the fact a person has not given evidence depends entirely on the context and particular circumstances*.". Had Mr Eley been in court to give evidence I am confident it would have been relevant and useful. However, although there is limited evidence on the issue, I do not accept this is a case where there was no evidence from the authors of the design. It is unfortunate Mr Eley was not available to give evidence and there was not more supporting documentation in disclosure on this development process. However, on balance, I decline to make any adverse inference in the circumstances of the evidence and context in this case.

97. Mr McCarthy has demonstrated he sufficiently expressed his intellectual creativity in creating the Macdeck Designs by reflecting his personality, as an expression of free and creative choices, as one of the authors, along with Mr Eley. Beyond my assessment of Mr McCarthy's role, the precise quality and degree of the involvement of each is not capable of being identified in more detail on the available evidence.

Issue 3

Are the features of the Macdeck Designs identified at paragraphs 9A(i)(a), (f), 9A(ii)(a) and (c), 9A(iii) (a), (f), 9A(iv)(a)and (b) APOC features commonplace in the design field in question by reason of the prior design of the TRAD Deck system (or elements thereof) as set out in paragraphs 5A – 5D of the Re-Amended Defence?

98. I address issue 3 before issue 2. The assessment of whether the design is commonplace is part of the assessment of originality under s.213(4). Issue 2 is one of the exclusions operating under s.213(3).

99. The Defendant advanced its case on the Macdeck Designs being commonplace in its response to the Claimant's particularisation of its particularly significant features. The Defendant's position is the Macdeck Designs are commonplace by reference to a single item of prior art, the TRAD Deck.

100. The parties did not address me on the relevant design field. The notional designer of the Macdeck Designs would have been involved in the field of safety decking systems for use on construction sites. Their experience may well have extended beyond systems for construction sites but nothing turns on that issue. Mr McCarthy was aware of the TRAD Deck product when developing the Macdeck Designs. There was no evidence this was anything other than a standard way to approach the design process for a new product in this field.

101. This appears to be a situation where there were a relatively small number of relevant safety decking products on the market prior to the creation of the Macdeck Designs. These were available commercially. The creators of the Macdeck Designs were aware of the TRAD Deck panel. It is therefore reasonable to assume the notional designer in this field embarking on designing a 'new safety decking board' would either be aware of the TRAD Deck system or would undertake basic research (as Mr Mills did in developing the Q Deck panel) and identify the TRAD Deck product. The TRAD Deck panel was therefore in the thinking of relevant designers in the field in question at the time of the creation of the Macdeck Designs. The question is whether, with the TRAD

Deck design in mind, the notional designer in the field at the time would view the Macdeck Designs as "*trite, trivial, common-or-garden, hackneyed or of the type which would excite no particular attention in those in the relevant art*" (*Ocular* at p429).

102. The Defendant pleads that none of the features identified in paragraph 9A of the APOC (see Annex 5) are original and puts the Claimant to proof. The Defendant identifies a number of these particularly significant features of the Macdeck Designs as commonplace over the TRAD deck. The Defendant does not accept any of the Claimant's Macdeck Designs are original, but does not make any specific pleaded case that the whole of each of the Macdeck Designs was commonplace, although it does so more broadly regarding originality.

103. The Defendant notes there are two areas where the Claimant conceded (at trial) that elements of the Macdeck Designs are commonplace. The first is Mr McCarthy's acceptance during cross-examination that the 'dimple' situated part way down the shaft of the Macdeck Pin Design was a standard feature (see Figure 7). This is a simple 'locking' mechanism such that it creates a small physical barrier that requires an increased force to overcome to remove the pin after it is in place. I accept the notional addressee would find this feature commonplace. The second relates to Mr McCarthy acknowledging various prior art boards are all either square or oblong (rectangular). Mr McCarthy also accepted in his cross-examination that such shapes here would be "*mundane*". I accept that a board design being square or oblong/rectangular in this field would be viewed as commonplace.

104. The Defendant alleges the further features of the Macdeck 1x1 Panel Design are commonplace.

<u>The outer dimensions</u>

105. The outer dimensions of the Macdeck 1x1 Panel Design on the design drawing at Annex 1 are noted as 1m x 1m x 65mm. The Defendant relies on evidence from Mr Mills that 1m x 1m boards are "*the primary size used across all safety decking companies*.". On cross-examination, Mr Mills could only name the TRAD Deck panel, the Macdeck 1x1 Panel and the Q Deck 1x1 Panel. Of these, only the TRAD Deck panel was known prior to the creation of the Macdeck 1x1 Panel Design. Mr Mills noted there were others, but he could not remember more – he indicated it was more of an "*industry standard to use the 1m x 1m*". It is not clear what industry Mr Mills was referencing. As he had just discussed the point in the context of the safety panel

industry, it seems likely this further comment related to a broader industry of some unspecified nature. In the context of his statement Mr Mills acknowledged he was "*by no means an expert in erecting these boards like some people in this room*".

106. Both Mr McCarthy and Mr Mills accepted that articles made to a 1m x 1m design would not be precisely these dimensions. Mr Mills commented "*there is no exact 1m x 1m board"*. In this context they were discussing engineering/manufacturing tolerances. The Macdeck 1x1 Panel would have tolerances of a few mms but in Mr McCarthy's view, likely less than 5mm. The TRAD Deck panel is 985mm x 985mm. Based on the evidence, the TRAD Deck outer dimensions would be by design and the difference with a 1m x 1m design would be unlikely to be way of engineering tolerances. From a visual perspective, these are small dimensional differences (i.e. the TRAD Deck Panel to Macdeck 1x1 Panel Design). There was also some debate about the differences in the depth dimension of the noted designs. The evidence on this was limited and did not materially impact my assessment.

107. The Defendant's pleading is that a 1m x 1m panel was commonplace. In my view, a safety deck panel with precise 1m x1m dimensions was not commonplace. Assuming the dimensions in the TRAD Deck panel were equivalent to those in the Macdeck 1x1 Panel Design, the evidence does not support the assertion this particular size of panel was well used in the field. There were a number of shapes and dimensions in use for safety decking that were in the "*current in the thinking of designers in the field in question at the time of creation of the design"* . In the circumstances of the evidence in this case, the existence of the TRAD Deck panel in the market for safety decking did not mean the notional addressee would view the use of 1m x 1m outer dimensions in the Macdeck 1x1 Panel Design as commonplace at the date of the creation of the design.

108. The difference in the external dimensions of the Macdeck 0.75x1 Panel Design probably takes that feature of the design further yet from any allegation it is commonplace. However, as the Macdeck 0.75x1 Panel Design is to be considered along with the Macdeck 1x1 Panel Design, its outer dimensions are also not commonplace.

<u>Raised profile pattern</u>

109. The relates to the raised profile pattern on the upper surface of the Macdeck 1x1 Panel Design. The Defendant's case is the TRAD Deck panel has a non-slip surface made up of similar shaped raised bumps (see Figure 1 p27). The Claimant accepts the Macdeck 1x1 Panel Design has raised bumps for the function of non-slip (see Annex 1). Its

evidence is the pattern chosen for these bumps on the surface of the design is decorative and deliberate. There are other safety deck products, for example steel ones, like the G & M Safety Deck, which have no anti-slip raised bumps on the surface. In the circumstances, in my view, the notional addressee would not consider the shape and configuration of the anti-slip bumps on the Macdeck 1x1 Panel Design to be *'trite, hackneyed*' in this field. This feature is therefore not commonplace on the Macdeck 1x1 Panel Design or the Macdeck 0.75x1 Panel Design. The Defendant raised the same argument in the context of the Macdeck 1x1 Panel Perimeter Design. The number of raised non-slip bumps and their different arrangements on the Perimeter Design is necessarily more limited than on the whole Macdeck 1x1 Panel Design and does look visually more like the TRAD Deck Panel. However, they are different. For example, the rows of raised 'bumps' on the perimeter are interrupted by the apertures on the surface of the design in the Macdeck 1x1 Panel Perimeter Design but not in the TRAD Deck panel. Regardless, I do not accept this is a case where the existence of the TRAD Deck panel and its type of anti-slip surface means the skilled addressee would view this feature of the design as commonplace.

The shape of the head of pin

110. The shape of the head of the Macdeck Pin Design comprises two disc shapes either side of a rounded aperture. The Defendant relies on the TRAD Deck pin (see below Figures 9 and the left hand image in Figure 11 in [144]) as the sole prior art article upon which it bases its commonplace assertion.

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Figure 9 TRAD Deck pin

111. The accepted functional purpose of these two discs is to assist pushing the pin into place and also to arrest the movement of the pin when being pushed into place. The TRAD Deck pin has a hole of a size that a finger can be used to pull the pin out. It has a roughly circular flat plate on the top of the pin to help push it into place. The Defendant does not assert the shape of these discs or of the hole for inserting a finger to remove the pins are the same on the TRAD Deck pin and the Macdeck Pin Design. Mr Kershaw noted "*Round and oval ring pulls are commonly found in the building industry and I have seen that type of equipment over the years*" but that he had never seen a trapezium-shaped aperture in a pin, as in the Macdeck Pin Design. This is not a case where this single piece of prior art relied on would influence the skilled addressee such that it would create a view this feature of the Macdeck Pin Design was hackneyed. Even if the TRAD Deck had been central to the skilled addressee thinking, the differences in the designs are sufficient such that this feature of the Macdeck Pin Design would nevertheless not be commonplace. In my assessment, the Defendant's allegation the shape of the head of the pin including the two discs being commonplace does not succeed.

Dimension of the pin shaft

112. This issue relates to the shape of the shaft of a pin comprising a point at the end. Both the Macdeck Pin Design and the TRAD deck pin have a long relatively thin shaft. The precise dimensions were not really debated. Counsel for the Defendant raised a point on the dimension of the shaft (the distance from the end to the raised 'dimple' along the

shaft). This was not in evidence in the case. In my view, had it been in the case, it would also not have added much to the issue. The shaft of both the Macdeck Pin Design and the TRAD deck have a groove running along its length to the end of the pin (at the pointed end). This feature of both the Macdeck Pin Design and the TRAD deck pin look very similar. This is not surprising as the function of both pins is the same - the groove is used to remove mass for weight and cost and acts as a form of cavity to allow some compression as the pin is pushed into the connector. However, this is not a test of novelty. Other types of pins for use in safety platforms were available prior to the creation of the Macdeck Pin Design and would likely have been known by the skilled addressee. For example, the Rev deck pin (Figure 8). Although, it is worth noting the Rev deck pin also appears to be of similar dimensions and with the noted channel.

113. A single piece of relevant prior art can mean a later design (or here a feature within a larger design) is commonplace. However, taking into account all the evidence, I am not convinced the Defendant has sufficiently proved its case that the TRAD Deck System, including its pin, would have influenced the skilled addressee such that they would have viewed the Macdeck Pin Design or this feature of the Macdeck Pin as "*trite, trivial, common-or-garden, hackneyed*". Therefore, although admittedly a borderline decision, in my view this feature is not commonplace.

Shape of the hand holds

114. The Defendant provided post-hearing trial references in support of its submissions that relate to the following features being commonplace over the TRAD deck including; (1) the shape of the hand holds in the Macdeck 1x1 Panel Design, and (2) the viewing holes in the Macdeck 1x1 Panel Design and the Macdeck Perimeter Design. Neither of these allegations was pleaded by the Defendant. I do not therefore believe that they need to be dealt with in the case but briefly address these in the alternative if that is not correct. Regarding (1), hand holds in the panels, the Claimant accepted the TRAD deck, Swale deck (which has not been expressly relied on in the pleadings as prior art for the purpose of the commonplace assessment) and the Macdeck 1x1 Panel Design have apertures for hand holds. These hand holds are in different positions in each design, have slightly different shapes and also differ in number and size. The Defendant may be right to the extent that the concept of a panel having a hand hold to assist with it being carried could be commonplace. However, the Defendant's allegation relates to the feature of the apertures that can be used as hand holds (and for other functions) in the Macdeck 1x1 Panel Design. In the circumstances of this case, the Defendant has not sufficiently demonstrated from the TRAD Deck, or any other prior art, that the notional addressee

would view the feature of the shape of the hand holds or their position or size as being commonplace.

Holes around the perimeter

115. Regarding (2), the holes around the edge of the Macdeck 1x1 Panel Design and Macdeck 1x1 Panel Perimeter Design appear visually similar in shape and size (no comparative dimensions were provided) to the TRAD Deck panel. Their location appears similar, not identical. There were other pre-priority safety panel products on the market which did not have these apertures and which the skilled addressee would likely have been aware. In my view, considering all the circumstances, despite the similarities with the TRAD Deck panel, the Defendant has not sufficiently demonstrated the TRAD Deck panel (or any other prior-art) would lead the skilled addressee to consider this feature commonplace.

116. For completeness, for the same reasons as noted in relation to the specific features, when assessed together, none of the claimed Macdeck Designs are commonplace when considering these designs as a whole.

Issue 2

Are the features at sub-paragraphs 9A(i) (Macdeck 1x1 Panel Design) , 9A(ii) (Macdeck 1x1 Panel Perimeter Design), 9A(iii) (Macdeck 0.75 x 1 Panel Design) and 9A(iv) (Macdeck Pin Design) APOC features which enable the article to be connected to, or placed in, around or against, another article so that either may perform its function as set out in paragraphs 5A – 5D (respectively) of the Re-Amended Defence?

117. The Defendant pleads the following issues (by reference to the particularised features in the APOC) as being excluded from design right protection by the interface provision, s.213(3)(b)(i) CDPA:

The Macdeck 1x1 Panel Design

(i) 9(i)(a) APOC

118. The outer dimensions of the panel (Annex 1); that is, the length and width of the upper face and the height of the sides. The Defendant alleges the outer dimensions of 1m x 1m x 65mm mean the panels are a regular shape of consistent widths and heights so when they are 'attached' together/placed next to each other, they can form a continuous and substantially flat surface. The Defendant submits they are specifically designed to

interface and are therefore excluded from design protection. The Macdeck 1x1 Panel Design is designed to tessellate such that the panels made to the design fit together easily in a regular pattern. Mr McCarthy's explanation there are overlapping panels at points (used in conjunction with strapping – see Figure 10) does not detract from the design's intended function as part of an essentially flat platform. The nature of the manufacturing variability/tolerances of the dimensions of the panels also does not materially affect the nature of these panels closely tessellating for the decking system to operate. An adequate level of precision in the outer dimensions is present for the panels to perform this function. The sides of the Macdeck 1x1 Panel Design have an edge as a feature that is regular i.e. straight. It is this feature that enables another article to be placed next to it, not the length of that edge. The length of the side does not enable another article to be placed alongside to perform its function. Other sizes of panel could allow such tessellation – such as a 0.5m x 0.5m or 2m x 2m panels. The precise dimensions of the edges of the panels are not therefore required to be 1m x 1m, although that may be the most convenient dimensions in the circumstances. The 1m x 1m dimensions of the Macdeck Panel Design are not a feature which enables it to be connected to or placed around the other panels in order to enable it or the other panels to perform their function (using the words of the section). I therefore reject the Defendant's submission that the outer dimensions of 1m x 1m of the panel fall within the exception but I accept the need for a straight edge to allow other panels to be placed next to it means such a straight edge is excluded.

119. The other interface allegation relates to the height/depth of the Macdeck Panel Design. The Claimant does not dispute all the panels in a deck would need to be the same height/thickness to create a level platform. This feature therefore enables the panels to be connected to or be placed around each other in order for the panels to perform their function. This height of the panels is therefore an excluded feature.

(ii) 9A(i)(b) APOC

120. The Defendants say the square central area of the upper face of the panel that is surrounded by 16 apertures, and which contains a circular space for application of a logo (see Annex 1) feature falls within the exception because; (a) these apertures permit scaffolding poles to be inserted vertically through the platform (there are a number of these apertures to allow flexibility on the positioning of the scaffolding poles and for the panel to have necessary symmetry i.e. it does not matter which way round in rotation the panel is placed in the deck (it has 4 fold symmetry)) and (b) that the 4 larger

apertures placed centrally in each of the 4 lines of apertures making up the sides of the central square shape of the panel enable the panel to be carried by hand (the hand holds). The Claimant admits the scaffolding poles can be so inserted through these apertures and that the 4 larger apertures can be used by a hand to carry the panel.

(a) Scaffolding passing through apertures

121. There was debate in the cross-examination about these apertures being bigger than the scaffolding (i.e. larger than the diameter of the circular scaffolding poles) and whether that provided for the necessary connection. However, an article does not need to touch in this context, it can be placed in or around another article. As HHJ Hacon explained in Action Storage, where a "*...feature of the design of an article which promotes stable interaction with another article may be excluded from design protection under s.213(3)(b)(i).*". The scaffolding poles being placed through the design such that these apertures of the panel are around the pole, even with some additional space around the poles, close enough for a 'stable' interaction. The pole is closely related to the space provided by the aperture. The shape of the space within the shape of the aperture and the shape of scaffolding poles are both also sufficiently precise in their arrangement to each other to create the relevant relationship between the two articles. I do not include the 4 larger hand hold apertures in this statement, they appear around twice the width of the other apertures in the central square shape. The scaffolding poles can therefore be placed at a variety of locations within those 4 apertures. That arrangement is not one that is sufficiently precise and does not promote a stable interaction with the scaffolding poles such that these apertures are a feature which enables it to be connected to or placed around the scaffolding pole to perform its function.

122. The main function of the scaffolding pole here is to be able to stand vertically to provide support. This feature of the panel provides apertures for the scaffolding poles to pass through and allow the panel to remain horizontal within the panel system. The Claimant argued these scaffolding poles are not always present or when present, not used in all the apertures. The relevant interaction is one that is based on a feature of the design. The fact that feature may not always be utilised does not affect the assessment of the primary purpose or function of these apertures.

123. The Claimant argues any aperture of sufficient size could perform the same function to receive the scaffolding poles and that the shape and configuration of these apertures in the Macdeck 1x1 Panel Design are not dictated or required by this function. This same argument, that the various sizes, shapes and configurations are not dictated or required

by the noted functions, is repeated by the Claimant in different contexts defending a number of the allegations made by the Defendant regarding the following features being excluded under s.213(3)(b)(i) CDPA. By way of example, in cross-examination, the Defendant accepted the Q Deck 1x1 Panel would allow scaffolding poles to pass through its "*diagonal large holes, through the circular ones, or through the oblong ones in between the circular ones*" (see examples of this aperture in the left and right hand ends of the annotated box in Figure 20 C at p97).

124. In *Fulton* [74]-[75] the Judge held that the particular features of the Miniflat case - the rectangular box-shape and outward facing seams at the edge – were "*not designed so as to enable it to perform the function of containing the umbrella. Any case of the same approximate dimensions would do that, including simple cylindrical cases like many which were in evidence.".* The function of the Miniflat case was to hold the umbrella. However, the Judge assessed that other umbrella cases had features in common and with similar dimensions which could perform the same function. The distinction made by the Judge was that a feature must be specifically designed so as to enable one article to be placed in, around or against the other and that the Miniflat case was not designed to enable it to perform the function of containing the umbrella – albeit that is what it did. The Judge construed s.213(3)(b)(i) CDPA purposively to avoid it being given a breadth which would take is far beyond what it was intended to achieve. If he had accepted the Miniflat case was designed to contain a folded umbrella, then, in the Judge's view, the exception in s.213(3)(b)(i) CDPA would apply to any article which is shaped so as to cover or contain another article such that they could not qualify for design right. The Judge found the relevant feature of the design was not designed to perform the function of enabling the case to be placed around the umbrella.

125. The following points relating to the interface of the scaffolding poles with these noted apertures are particularly challenging issues in the context of the application of UK unregistered design law. The reason for such difficulties was succinctly set out by Jacob LJ in *Dyson* at [14] when describing s.213 CDPA:

"It has the merit of being short. It has no other." ... "It is not just a question of drafting (although words and phrases such as "commonplace", "dependent", "aspect of shape or configuration of part of an article" and "design field in question" are full of uncertainty in themselves and pose near impossible factual questions). The problem is deeper: neither the language used nor the context of the legislation give any clear idea what was intended. Time and time again one struggles but fails to ascertain a precise meaning, a meaning which men of business can reasonably use to guide their conduct.

The amount of textbook writing and conjecture as to the meaning is a testament to its obscurity. We just have to do the best we can, try to arrive at "an interpretation which the reasonable reader would give to the statute read against its background" per Lord Hoffman in R (Wilkinson) v IRC [2005] UKHL 30; [2006] 1 All E.R 529 at [18].. The absence of any clear policy, as to where the line of compromise was intended to run, means that brightline rules cannot be deduced."

126. The point here is the extent of this interface provision and its purposive construction. The Claimant's position is in effect the provision should not apply to exclude features where these do not prevent a third party from using alternative designs to achieve the necessary interaction in order to perform its function, here with the Macdeck 1x1 Panel Design. In another design, the aperture could have moved position, could have been slightly bigger etc. and still performed the same function (allowing the scaffolding poles to pass through). However, the features being discussed here relate to the actual article (or design of that article) in dispute, the features of the Macdeck 1x1 Panel Design, and whether those features were designed to enable it to be connected to another article to perform its function. If that is the policy point being raised i.e. was this provision (the spare parts provision) really intended to prevent design protection of all ways (other hypothetical ways) of achieving the noted functionality, then I do not agree that is the correct interpretation. The wording of the provision requires the assessment to be on the features of the shape and configuration of the specific article in dispute, the Macdeck 1x1 Panel Design and the design enabling those features to allow the scaffolding pole to be placed around / through it. It does not matter if the designer could come up with other ways to achieve the same functional result.

127. This consideration does, however, draw out the specific nature of the relevant features of shape which enables the article (scaffolding) to be so placed. This is a point of more general application in this case as the same point is repeated a number of times in relation to this pleaded exclusion for other features. I will address it in the context of these 16 apertures.

128. The apertures around the central square shape enable the scaffolding to pass through the deck. These holes could be made to different shapes, different sizes and in different positions, that allow for an aperture which has a sufficient size to allow the scaffolding pole to pass through and the function to still be fulfilled. The question is; what is the feature of the design that enables the article (the scaffolding) to be placed around (through) these apertures. A feature of an article can also be the absence of part of the article (as here, an aperture). The size of the internal void which allows the scaffolding

to pass through these apertures is closely linked to, but distinct from, the shape chosen for the outside of the aperture in the design. The size of these 12 squares (within the total of these 16 apertures) was designed to ensure the dimensions were such that the scaffolding poles could fit within the space the shape surrounds. That square shape, of itself, does not enable the scaffolding to be placed in or through this space, but rather the size of the void within the aperture created by the shape. For example, a triangle aperture or a circular or pill capsule shaped aperture (such as those the Q-Deck 1x1 Panel in Figure 20 p97) that achieves the same functional internal void space requirement. Here the shape was a square, but it was not the features of that square shape that allowed the scaffolding poles to be placed through the void within the aperture of the square shape (other than their dimensions). It is therefore correct these 12 square shapes contain apertures around the central square shape that contain a feature (the void within the shape is large enough to allow the passage of the scaffolding pole) which is designed to enable it to be connected to or placed around the scaffolding. I therefore accept the Defendant's position that voids in the 12 noted positions around the central square shape are excluded from design protection but I do not accept the square shape surrounding these voids (other than its size being such to allow for the scaffolding pole) is excluded. The square shape of itself was not designed to enable the scaffolding pole to pass through (any more than a closely fitting triangle, circle or other shape of adequate dimension could – I mention these other shapes not as hypothetical examples but to demonstrate the shape of the aperture here is not the operative element in relation to any interface). These 12 square shapes are not therefore designed to enable the scaffolding poles to be connected to the panel to perform their function, it is the size and shape of the void within that aperture. Therefore, it is that void which is excluded from design protection.

(b) The hand hold apertures

129. The Claimant accepts the 4 larger apertures are intended to be hand holds to carry the panels (although they could also be used for scaffolding poles). There was debate about the precise size of the hand hold, the size of a hand, whether it may have a glove etc. The point is similar to the example provided in *Action Storage* where at [68] the Judge explained "*...the shapes of the relevant parts of the connecting articles must be such that there is a degree of precision in the interrelationship between one article and the other i.e. the designs afford some precision in the fit. For example, it would be surprising if the handle of a coffee mug were refused design protection solely because it is shaped to enable a human hand to connect to it to pick up the mug.*". The situation

here is that the 4 larger apertures are effectively handles to allow a hand to use them to more easily lift the panel. The interaction of the hand and the hand hold will be transient, imprecise and changing. The relevant degree of precision in the interrelationship enabling the hand to be placed in or around these larger apertures in the panel is absent such that these features do not enable a connection to be made of the kind set out in the statute. The other use for these apertures is to allow scaffolding poles to pass through. They appear to also serve that function. However, these apertures are significantly larger than any scaffolding pole. The pole could be placed in multiple locations within the aperture. There is therefore an imprecision in the relationship between the void created by the rectangular shape and the scaffolding pole to be placed through, around the void/article. These 4 apertures are features that do not therefore enable a stable connection to be made of the kind set out in the statute

130. The shape of these 4 aperture features would also not be excluded from design protection by way of the interface provision as the shape of the aperture (a rectangle) is not the designed feature that enables the scaffolding poles to pass through or in the Macdeck 1x1 Panel Design / Panel. Rather it is the relevant space within the void contained within the aperture shape that enables the scaffolding to pass through.

131. In this analysis, I am conscious of LJ Jacob's comments in *Dyson* regarding the risks of metaphysical type debate in the context of unregistered designs. I will therefore also consider the situation where these 12 square and the additional 4 rectangular apertures are, in the alternative, excluded from design protection.

(iii) 9A(i)(c) APOC

132. This relates to the shape and positioning of the 16 apertures that surround the central square area of the upper face of the panel. The same points noted above appear equally relevant to this feature. The square shapes of the 12 apertures (beyond their containing a void with a minimum size for the scaffolding poles to pass through) are not excluded. My assessment above regarding the 4 larger apertures in the central square shape is also equally applicable to this feature where the words describe the shape and position of these 4 apertures. As explained, these 4 shapes do not have the relevant degree of precision in the interrelationship with the scaffold poles to enable a connection of the type envisioned by s.213(3)(b)(i) CDPA. Therefore, the 4 larger apertures are not excluded.

(iv) 9A(i)(d) APOC

133. This relates to the presence of narrow slot-shaped apertures arranged in two concentric squares in between the central square area of the upper face of the panel and the perimeter (see Figure 22 B at p98). The Defendant argues the function of the slot-shaped apertures is for straps to be passed through these slots in order to secure the panels to other panels or objects and should fall within the exception. Figure 10 below is an example of the strapping using these slot shaped apertures in the Macdeck 1x1 Panel.

Figure 10 Macdeck 1x1 Panels with strapping

134. The Defendant submits the narrowness of these apertures is important as the straps are relatively narrow and wide and/or any apertures in the panel must be kept sufficiently small to avoid or minimise the risk of persons or objects falling through the panel. Further, that the concentric arrangement of the slots in pairs is relevant as a strap needs to be able to pass up through one and down through the other in the pair and these slots need to be concentrically arranged to avoid a risk of damage to the panel and/or the strap when applying force to the strap. The Claimant accepts these apertures can be used for such straps. There was also evidence (from Mr Mills) that such strapping can still operate (perhaps non-optimally) in the rounded holes in the Q Deck board. This is another example of a different design (here the Q- Deck Panel – so not a hypothetical) to the Macdeck 1x1 Panel Design but that can perform the function (here the strapping). I have already explained why I have dismissed this approach.

135. The narrow slot-shaped apertures can be used to accommodate the strapping. The shape of the narrow aperture does not itself enable the strap to pass through and perform its function. The size of that aperture (which is many times larger than the strapping) is the feature of the design which allows the strapping to be placed through it so that it

can perform its function. Therefore, the shape of the slot-shaped apertures is not a feature designed to enable the strapping to be placed around the Macdeck 1x1 Design / Panel to allow either to perform their function. I accept the size of these apertures will have reasonable limitations but the Defendant's reference to them not being so large that a human can fall though on a 1m x 1m square design is not credible and does not impact this analysis.

136. Whether or not this purposive construction is correct, there is a more straightforward reason the two concentric rows of narrow slot-shaped apertures in the two concentric square shapes are not excluded. The evidence on the strap positions within the slot apertures (where there is one at all) is it may vary, for example, depending on the direction of any tension the strap is under or depending on how the strapping is threaded between the various apertures or how the user chooses to set up the panels. The strapping can therefore move around within the confines of one or more of the different slot-shapes. This presumably assists the user with considerable flexibility but it is not a feature of the design which provides a stable interaction with the other article. In my view, it does not provide a sufficiently precise and stable relationship between the straps and slot-shaped aperture to satisfy the exclusion of design right protection under this provision. Therefore, for either of these reasons, the narrow slot-shaped apertures are not excluded.

(v) 9A(i)(e) APOC

137. This relates to the shape and positioning of the 16 rectangular apertures around the perimeter of the upper face of the panel (see an example of one side of the panel in Figure 22 A p98 and in Annex 1). The Defendant argues these apertures (also referred to as cut-outs) enable visual confirmation from above that pins have been correctly passed through the footing support and panel. The Claimant does not accept this design enables the panel to be connected to or placed in, around or against the support connector in any meaningful sense in accordance with the s.213(3)(b)(i) interface provision. I agree, these cut-outs do not enable any level of such connection with another article to perform its function of a kind required in the statute. There is the absence of any such connection. It is entirely imprecise in its nature and cannot create the necessary arrangement to each other to create the relevant relationship between the two articles . The exception does not apply.

138. The Claimant also argues the shape and positioning of these 16 rectangular apertures are not dictated or required by this function. In support there was evidence, including

from Mr Mills in cross-examination, that the pins could be properly fitted without the need for these cut-outs. The Claimant also argues these cut-out apertures are not needed i.e. the pins can be fitted and checked from underneath. I accept this is right but it is still available for that purpose and therefore would not have been determinative where the design had enabled the function to check from above in accordance with the interface provision. There was also debate with Mr Mills in cross-examination about whether the positions of the cut-outs could be moved (noting the differing positions of the cut-outs on the TRAD Deck panel) and that the shapes of the cut-outs could have taken different forms and still functioned – such as rounded/circular i.e. the shape designed was not a feature dictated by the function. The cross-examination of Mr Mills on these points led to a discussion of the influence of the cut-out's positioning based on the structural ribs on the underneath of an article made to the Macdeck 1x1 Panel Design. The design of the underneath of the panel was not in evidence and there was little of relevance in this particular debate. This is another example of the same argument that a different design could enable the same functionality as the Macdeck 1x1 Panel Design. I have explained why I do not accept this approach.

139. The argument on the apertures here can also rely on the same reasoning as those dealing with the voids in the preceding features, that it is not the shape of the aperture that was designed to enable the feature to perform its function. Rather it was the nature of a void allowing sufficient light to pass through such that from above the platform a person could visualise the pin below. I do not agree the exception applies for this further reason.

(vi) 9A(i)(f) APOC

140. This relates to the shape and positioning of a raised profiled pattern on the surface of the upper face of the panel (see Annex 1). The Defendant's position is this raised profile ('bumps') on the surface interface with the soles of workers' shoes or boots in order to increase friction and should be excluded. The positioning of a shoe or boot in relation to any one or number of these raised bumps is entirely unspecific. It cannot realistically be said there is the necessary degree of precision in the interrelationship here between the one article and the other, whether that is to enable the panel to be placed around or next to, the workers boots. In my view, these articles are not really part of any relevant stable interface of a type considered under the statute. A boot being transitorily placed against the raised bumps in an unpredictable and changing location does not enable the boot to be connected to the panel in the ways described. The raised profile pattern is not excluded from design protection.

(vii) 9A(i)(g)

141. This relates to the shape and positioning of the rounded slots (also referred to as rounded arch shaped slots by the Claimant) in the sides of the panel (see an example side of the panel edge in the cropped image in Figure 23 p98 and also Annex 1). These rounded slots enable pins to be passed though the panel and support connectors, including when connecting multiple panels together. It is necessary for there to be an aperture/space to allow the pin to pass through the panel and make its connections with the support connectors. Mr Mills accepted it was not necessary to have the rounded (arch shape) holes and that circular holes (such as in the TRAD Deck) should suffice, albeit he did not seem to think it would be as good due to the need for support for the pin. The holes function to allow the pin to pass through the panel. That feature enables the system and pin to work. The same reasoning applies to this situation as to the earlier analysis of the scaffolding poles passing through voids in the panel at [128]. The pin has to follow a precise trajectory to allow it to connect but the shapes in the edge of the panel preceding that connection are not features which of themselves enable the pins to perform their function. It is the size of the void within that aperture i.e. there needs to be a space the size of the diameter of the pin for it to pass. Therefore, the shape of rounded arch shaped apertures in the side of the panel is not a feature designed to enable the pin to be placed in the Macdeck 1x1 Design / Panel to allow either to perform their function. The exclusion does not apply.

Macdeck 0.75x1 Panel Design and Macdeck Panel Perimeter Design

142. The Defendant's positions regarding this exception are the same for the Macdeck 0.75x1 Panel Design for each of the points dealt with above relating to 9A(i) – (g) APOC. Its position on the Macdeck Perimeter Panel Design is also the same as the Macdeck 1x1 Panel Design, but only in relation to the points relating to 9A(i)(a), (e), (f), and (g). The conclusions on the application for the exception under s.213(3)(b)(i) therefore applies as relevant equally to the Macdeck 0.75x1 Panel Design and the Macdeck Panel Perimeter Design.

Macdeck Pin Design

9A(iv)(a) APOC

The shape of the head of the pin

143. This relates to the shape of the head of the pin, which comprises two disc shapes either side of a rounded trapezoid aperture that is wider at the end furthest from the shaft of the pin (see Figure 25 p99 and in particular labelled parts A, B and C). The Defendant alleges the trapezoid aperture feature at the end of the Macdeck Pin Design should be excluded. It is used by a person to pull the pin out with their fingers. The prior art TRAD Deck has an aperture of a different size and shape and demonstrates the design aperture is not dictated by the function here. The Claimant submits the design was also not so restrictive that this was the only way a person could use their fingers to remove a pin. In the Macdeck Pin Design this feature can be used by two fingers. The TRAD Deck pin is explained to be more suited to one finger. The G&M pin has a larger circular aperture than the TRAD Deck (see Figure 11 below). The Revdeck pin (Figure 8 p36) is a completely different two pin design holding the boards together. Mr McCarthy points out that the pins can be pulled out without use of the aperture. In my view, the Claimant is correct that there are other ways a design could achieve the function here but, as explained, the wording of the provision does not allow this to be determinative of the issue.

Figure 11 TRAD Deck pin and G&M pin

144. The use of fingers in this context is equivalent to the example of the handle for a teapot in *Action Storage* [68]. This feature does not provide the necessary level of precision at the interface between the fingers and the pin to be connected (placed in, around or against) it in the manner envisioned in the statute. The use of fingers here is transitory and the contact is such that any points of contact are unpredictable and would differ to some extent on each use. There is therefore no stable connection that provides the necessary level of precision in the relationship between the articles to enable a connection of the type envisioned by s.213(3)(b)(i) CDPA.

145. The use of the fingers here as the article interacting with the pin again raises the point discussed earlier regarding what function the trapezium shape enables as opposed to the dimensions of the aperture it provides. In cross-examination, Mr McCarthy confirmed he made the size of the top of the pin such that it would allow for two fingers to go in comfortably so that it would be easier to pull out the pin. He compared this to the TRAD Deck pin which has a hole at the top of the pin only big enough for a single finger. In my view, and for the same reasoning as set out in [128], it is not the trapezoid shape itself that enables the fingers to perform their function but the size of aperture it creates which enables two fingers to be placed through that aperture. Here the fingers will need to pull against the trapezium shape to remove the pin. However, in my view there is no relevant evidence that it is somehow the trapezium shape itself that is ergonomically contributing to allowing this function. The evidence is the aperture allows the use of two fingers. The shape *per se* was not the relevant feature for this purpose, rather the size of the void created. Therefore, the shape of the trapezoid aperture in the Macdeck Pin Design is not a feature designed to enable fingers to be placed through the aperture to allow either to perform their function.

146. For each of these reasons, I reject the claim that that this aperture is a feature which enables it or the fingers to perform their function. The shape is not excluded.

The lower disc

147. The Defendant alleges the disc shape closest to the point of the pin (the lower disc) should be excluded. For example, when the pin is fully inserted, the disc abuts the support connector and prevents the disc/pin being pushed further. The planar face of the disc is designed to interface with the planar surface of the connector. The function of the disc is to arrest the pin passing through the connector at a pre-determined point. The system therefore needs something to arrest the pin to stop it going in too far. The TRAD Deck has a similar shaped disc with the same function. The function here is a

useful one, to arrest the movement of the pin – although Mr McCarthy points out that this disc and its function is not actually needed, "*A pin could fit almost all of the way through and it would do the same job*.". There are a variety of shapes that could perform the arrest function although almost all the examples of prior art pins appear to have a planar surface to interface with the planar connector surface. The allegation is this disc enables the pin to be connected to or placed in, around or against, the support connector so that either article may perform their function. That happens when the pin is fully inserted and the disc abuts the support connector in a stable final position. The disc allows the pin to be more effectively (and perhaps more safely) used. When the pin is fully connected to the support connector this disc is placed next to the connector in a suitably precise position such that it is designed to enable the connection between the pin and the connector. No design right can therefore subsist in this disc shape feature. It is therefore excluded.

The upper disc

148. The Defendant also alleges the disc shape furthest from the point of the pin (the upper disc) should be excluded as this provides a flat pushing surface which enables the pin to be placed in, around or against, for example a hand or a hammer. This is not an interface of the sort envisioned by the statute. The placing of a hand against the disc to push in the pin (or the use of a hammer) is a transitory connection. The position of any such interface is unpredictable and certainly not stable. The use of a hand (or hammer) in this manner does not therefore provide the necessary level of precision in the relationship between the articles to enable such a connection of the type envisioned by s.213(3)(b)(i) CDPA.

9A(iv)(b) APOC

149. The shape of the shaft of the pin, which comprises a groove running down the length of the shaft and a point at the end. It appears from the Re-Amended Reply the Claimant accepts the diameter and shape of the shaft of the pin, which fits the hole in the support connector, is excluded under the interface provision. If not for that concession, my view would have been to exclude such a feature. This feature is designed to fit the diameter of the support connector in a snug-fit, including compression due to the groove. The length of the pin is different. There will be a length that is too short and too long but between those there would be a variety of lengths that could be designed to achieve the function of connecting the support connector and panel. Mr McCarthy explained that other panel systems have pins of different size and shape. In my assessment, here, the

length of the pin shaft used to connect the support connector and panels is a feature that enables it to be connected to or placed in the support connector/panels to perform its function. The shaft of the pin after the lower disc shape is excluded.

Issue 4

Do the features of the Macdeck Designs identified at paragraphs 9A(i)(b), (f) 9A(ii)(c), 9A(iii)(b) and (f) constitute surface decoration as set out in paragraphs 5A – 5D of the Re-Amended Defence?

150. The Defendant pleads the below points regarding surface decoration under s.213(3)(c) CDPA in relation to the Macdeck 1x1 Panel Design (and therefore also the Macdeck 0.75x1 Panel Design).

<u>The circular space for application of a logo</u>

151. There are two concentric circle features at the centre of the panel (see Annex 1). Between these there is a 'roundel' shape to add branding/a logo. The Claimant accepts this text within the roundel is surface decoration. Mr McCarthy explains the two circles are raised in profile such that they are in 3D. The height of this feature is said to be about 2.75mm, around the same height as the surface bumps on the panel. The Claimant's case is based on its design drawings and not an article made to those designs. The Macdeck System comprises articles made to the Macdeck Designs. These were available at trial. While it was possible to see the raised profile nature of these circles in the Macdeck 1x1 Panel Design, it was easier to see this on the Macdeck 1x1 Panel. I do not know the exact dimensions. It does not matter. The Defendant questioned whether the pleadings included the inner of these two concentric circles. The reference in the APOC is to *'a circular space for the application of a logo'*. That reference is a specific feature within the pleaded design which is the design drawing. The Macdeck 1x1 Panel Design drawing shows what looks like two concentric circles. The pleadings therefore include both of the noted concentric circles. However, the drawing appears to show the two lines of the concentric circles forming a single 3D circle (i.e. the inner and outer edges of a raised ring shape). The question is whether the ordinary reasonable consumer would think this shape was surface decoration. The roundel neatly delineates the branding area from the rest of the panel. Both the branding and the circle shape are of a similar and minimal 3D height and appear connected as a border to the branding. In these circumstances, in my view, a reasonable consumer looking at this would view the roundel as a composite part of the advertising it encompasses and therefore part of

the same surface decoration. The Defendant's position these circles are excluded therefore succeeds.

The presence of a raised profiled pattern on the surface of the upmost face of the panel

152. Mr McCarthy views the surface 'bumps' covering much of the upper face of the Macdeck 1x1 Panel Design as having both a function (anti-slip) and as decorative. The bumps are raised in 3D. They are configured in mainly regular repeating and non-repeating patterns throughout the surface of the panel. These patterns largely follow the lines of the design and contribute to the effect of the changes in direction of the lines of the panel around the various apertures. The raised 'bumps' contribute to this effect in almost all available spaces on the panel. Considering all the relevant circumstances here the reasonable consumer would on balance not view the raised profile pattern as a surface decoration. The raised bumps would be viewed largely as a functional part of the design.

Issue 5

Do the features the Macdeck Designs identified at paragraphs 9A(i)(a), (b), (c), (d), (e), (f), 9A(ii)(a), (b), (c), 9A(iii) (a), (b), (c), (d), (e), and (f) APOC comprise a method or principle of construction as set out in paragraphs 5A – 5C of the Re-Amended Defence?

Is the Macdeck 1x1 Panel Perimeter Design part of an article?

153. The Defendant alleges the Macdeck 1x1 Panel Perimeter Design is not a design for part of an article (s.213(2) CDPA). This is not formally listed as an issue in the case but it remains a dispute between the parties. I deal with this issue conveniently in this section as some of the considerations on the construction of the features expressed in the pleadings are also relevant to the assessment of the matters in Issue 5.

154. The Defendant says the Macdeck 1x1 Panel Perimeter Design is a disembodied aspect and therefore not a discrete part of an article. The Defendant's criticisms of the specificity of the pleaded Macdeck Designs go beyond the Perimeter Design and include other Macdeck Designs. It is only the Macdeck 1x1 Panel Perimeter Design that is alleged not to be a 'part' of a design. My analysis and conclusions of the construction of the pleadings regarding the Macdeck 1x1 Panel Perimeter Design are equally relevant to broader points made on the other Macdeck Designs.

155. The Defendant's allegations include that; (1) the selection of the Panel 1x1 Perimeter Design is arbitrary, as the line drawn separating the Perimeter Design from the rest of

the panel (see Annex 2) does not have associated specified dimensions, (2) the Perimeter Design only covers the top and side (and not the underside) of the article, (3) the particularised description in Annex 9A (ii) APOC is too broad such that it could cover more than "*a single shape or design or configuration*.", (iv) the cross-examination of Mr McCarthy confirmed these descriptions are not specific to shape or location, (v) the surface features are non-specific as to shape and configuration (not being limited to rectangles or oblongs etc.), and (vi) the Claimants refer to the design as "*an aspect of the claimed panel design*" in correspondence.

156. The Claimant's position is that identifying the design or part of an article "*by putting a line or a box round the bit you want to claim or the bit you do not.*" is entirely standard. Also, that the Macdeck 1x1 Panel Perimeter Design is a contiguous part of what is claimed and not a disembodied design.

157. The letter the Defendant relies on between the parties as support by the Defendant in its pleadings described this element of the claimed design as an "*aspect*". In my view, this was clearly not using the aspect term in the context of the deleted part of s.213(2) but rather using the word in a plain English language sense to describe the part of the article.

158. In support of its submissions on this issue the Defendant criticised the cross-examination responses of the Claimant's witness, Mr McCarthy. He confirmed the 16 apertures described in 9A(i)(e) and 9A(i)(b) of the APOC are the same (both references refer to 16 apertures but they are each a different set of 16 apertures and in different locations on the Macdeck 1x1 Panel Design). In context, this appears to me to be a straightforward error. In my view, Mr McCarthy's answers to the questions leading up to this point fairly respond in turn to each question raised. His responses also demonstrated a level of confusion over the preceding questions to this point. This is understandable in the context of a witness undergoing lengthy cross-examination in an unfamiliar environment. This point taken therefore appears overly technical and does not support the Defendant's position.

159. In *Neptune*, Carr J described the problem of claiming a design involving a teapot with a disembodied design for the lid and the spout. In this case, the pleadings expressly refer to and rely on the Macdeck 1x1 Panel Perimeter Design in Annex 3A of the APOC (Annex 2 of this judgment). Additionally, the particulars in the APOC set out features of the Macdeck 1x1 Panel Perimeter Design expressed in the suggested *Action Storage* format. These particulars are noted as features which are "*particularly significant*". The

design drawing of the Macdeck 1x1 Panel Perimeter Design is a detailed scale drawing. The part of the design being claimed is a clearly circumscribed section of the larger article. This is shown as a shaded part. The design is also a contiguous area of the top and the sides of an article.

160. The particularisation in the pleadings provided by the Claimant at paragraphs 9(ia) and 9A(ii) APOC identify the Macdeck 1x1 Panel Perimeter Design in sufficient detail allowing the Defendant to provide detailed responsive pleadings, without the need for additional clarification. No higher level of specificity is required. Therefore, the Claimant's pleading to the Macdeck 1x1 Perimeter Design as set out in the drawing at Annex 3A of the APOC (Annex 2 to this judgment) and as particularised in the pleadings suitably circumscribes the description of the design such the Macdeck 1x1 Perimeter Design is "part of an article".

Are any features of the Macdeck 1x1 Panel Design, Macdeck 0.75x1 Panel Design or Macdeck Panel Perimeter Design a method or principle of construction (s.213(3)(a) CDPA?

161. The Defendant alleges a number of the Claimant's particularised features of the Macdeck 1x1 Panel Design, the Macdeck 0.75x1 Panel Design and the Macdeck Panel Perimeter Design *"...amount to a method or principle of construction, in that the same do not relate to any individual and specific appearance but rather a generalised concept…*". As the Defendant's counsel, Miss Reid, put it, these features *"... are so vague and they include so many different varieties of potential designs…*" and that *"... there is reference to features which are entirely non-specific as to the shape and configuration.*" Since the amendment to s.213 CDPA in the Intellectual Property Act 2014 the scope of design rights was restricted to the features of a specific article, or part of an article. The result of removing the ability of a design to be defined at a level of abstraction higher than seen in the article itself means, as HHJ Hacon explained in *Action Storage*, it "*will almost always by itself prevent a design right owner from claiming protection to a method or principle of construction*.".

162. It is therefore much less likely a suitably described design would be a method or principle of construction. In essence, the Defendant's position is that in setting out the particularisation of the features of the Macdeck Designs that are particularly significant, the Claimant has used these pleaded particulars to broaden the claimed designs such that it may include multiple different designs. The Defendant's submissions on this issue include the following examples. In relation to the feature described at paragraph 9A(i)(a) of the APOC, that "*It does not describe the angle at*

which the board deflects or whether the edges are straight or curved or wavy" and for the feature at paragraph 9A(i)(f) which refers to the "*presence of a raised profiled pattern on the surface*" the Defendant argues "*These references to the 'presence' of an intermediate number of bumps, are clearly not features of a shape or configuration, and include an infinite variety of shapes and configurations.*". It is, of course, possible, particularly when any wording is scrutinised, to come up with better descriptions of a design's features. I do not believe it was the intention of the pleading proposal for better particularisation made by HHJ Hacon in *Action Storage* to set off a new field of satellite disputes regarding the particularisation of features of a design and whether such particularisation calls into question whether the whole design claimed is therefore still suitably circumscribed. The particularisation of the important features assists in providing a useful framework to assess the different elements of a design, as it has done in this case. The Defendant's points may have had some force if the Macdeck Designs were described exclusively by this particularisation, but they are not. The Claimant expressly claims the whole of each of the Macdeck Designs by reference to the respective design drawings in Annexes 3, 3A and 4 of the APOC. The further particularisation is subject to that express reliance on the specific appearance of those design drawings. This is not an example of design claims that are at a level of generality similar to some form of patent claim.

163. Additionally, I do not believe the Defendant argued the design claims would inevitably cover a method or principle of construction such that various functions could only be achieved by means of a particular shape. There was no real evidence to support such a position. There was evidence supporting the position there were other designs available to perform the safety decking role.

164. This exclusion does not apply to the features of the Macdeck 1x1 Panel Design, the Macdeck 0.75 x1 Panel Design or the Macdeck Panel Perimeter Design or the whole designs.

Infringement of UK Unregistered Design Right

Was Mr McCarthy an employee of the Claimant?

165. The Defendant conceded the Claimant is the owner of the Macdeck Designs. I have determined that each of the Macdeck Designs is original and that Mr McCarthy was a co-creator of the Macdeck Designs. As part of the consideration here, for these designs to be protected by UKUDR under section 219(1) CDPA they need to be created in the

course of employment with a qualifying person. The Defendant does not take a positive position on the issue. It is for the Claimant to prove.

166. The Macdeck Designs were created on 4 January 2016. The remaining point is whether Mr McCarthy, as a co-creator of the Macdeck Designs, was employed by the Claimant. He was a director and shareholder of the Claimant at the relevant time. Mr McCarthy clarified his position in the company in his third witness statement dated 9 October 2023, "*I would like to clarify that I am an employee of the Claimant company and that all the work I did designing the Macdeck system that is described in my First Witness Statement was done in the course of my employment with the Claimant Company.".*

167. Mr McCarthy was cross examined at length on this issue, the nature of the employment and any contract and/or the details of development of the related corporate group and the related partnership (in which he was a partner) which existed prior to the Claimant organisation. His explanation provided the historic context leading up to the creation of the Macdeck Designs. At that time it was early days for the Claimant business and his other related business, "*There was no formal contract or roles or responsibilities … As a business grows you start to understand and learn, making mistakes. As, you know, going from a business in my mum's bedroom with a laptop, to where we are today, the processes and procedures, forms, documentation have evolved in that time*.". He confirmed "*I would have been an employee because I was paid to do a job which was an operational role*…". This was in 2014. He confirmed he had a written employment contract in 2023, but not one in 2016 or 2017. His evidence is vague on the dates when he was paid. Mr McCarthy was not paid by the partnership prior to the Claimant company in 2015 but he still carried out his roles in line with the contract (I understood this to be an understanding rather than written contract). The pay was to be made later, depending on how the business was performing. His evidence confirms he was paid "*as a director employed by the company to carry out a role*."

168. The Defendant submits that during his cross-examination, Mr McCarthy accepted he was not an employee in 2016/2017. In the context of Mr McCarthy's overall evidence on the issue, I do not agree. Mr McCarthy was explaining this was a start-up business, he was a director being paid and employed to carry out an operational role by the Claimant at the relevant time. The usual written formalities were absent until later years when the business had matured. In any event, on the evidence I accept Mr McCarthy had agreed expressly or impliedly he was performing a service subject to the Claimant's control to a sufficient degree. There is no other qualifying issue. The design was recorded in a design document. The Claimant is a qualifying person for the purposes

of s.219 CDPA and the Macdeck Designs qualify for UK unregistered design protection.

169. In the circumstances, it is not necessary to consider Mr Eley (as the other co-creator) and PPL. However, I have reviewed this issue and therefore set out my views. The APOC states that Mr Eley was a director and employee of PPL and that PPL was commissioned to create the designs for the Claimant acting in the course of his employment. The Claimant's evidence is Mr Eley is one of the creators of the Macdeck Designs. The Defendant assumes he is a designer of the Macdeck Designs as his name is on the first three Design drawings (i.e. not the Macdeck Pin Design drawing). Mr McCarthy's evidence explains Mr Eley was a contractor at PPL at the relevant time. There is no direct evidence from Mr Eley. Whether Mr Eley was an employee or simply a designer probably does not matter in the end. Either should end up with him being a relevant qualifying person.

Are the products comprising the Macdeck System articles made to the Macdeck Designs?

170. The Defendant does not accept the products comprising the Macdeck System are articles made to the Macdeck Designs. By the end of the trial it was not clear if this position was being maintained. In my view, the Macdeck System comprises articles made to the Macdeck Designs. I have set out below some of the support for this position. In summary, this is the conclusion of reviewing the available evidence, the admissions in the pleadings and not least the visual similarities and lack of any evidence of material differences between the articles of the Macdeck System and the Macdeck Designs (for example see the Macdeck 1x1 Panel Design and the Macdeck 1x1 Panel in Figure 12 below).

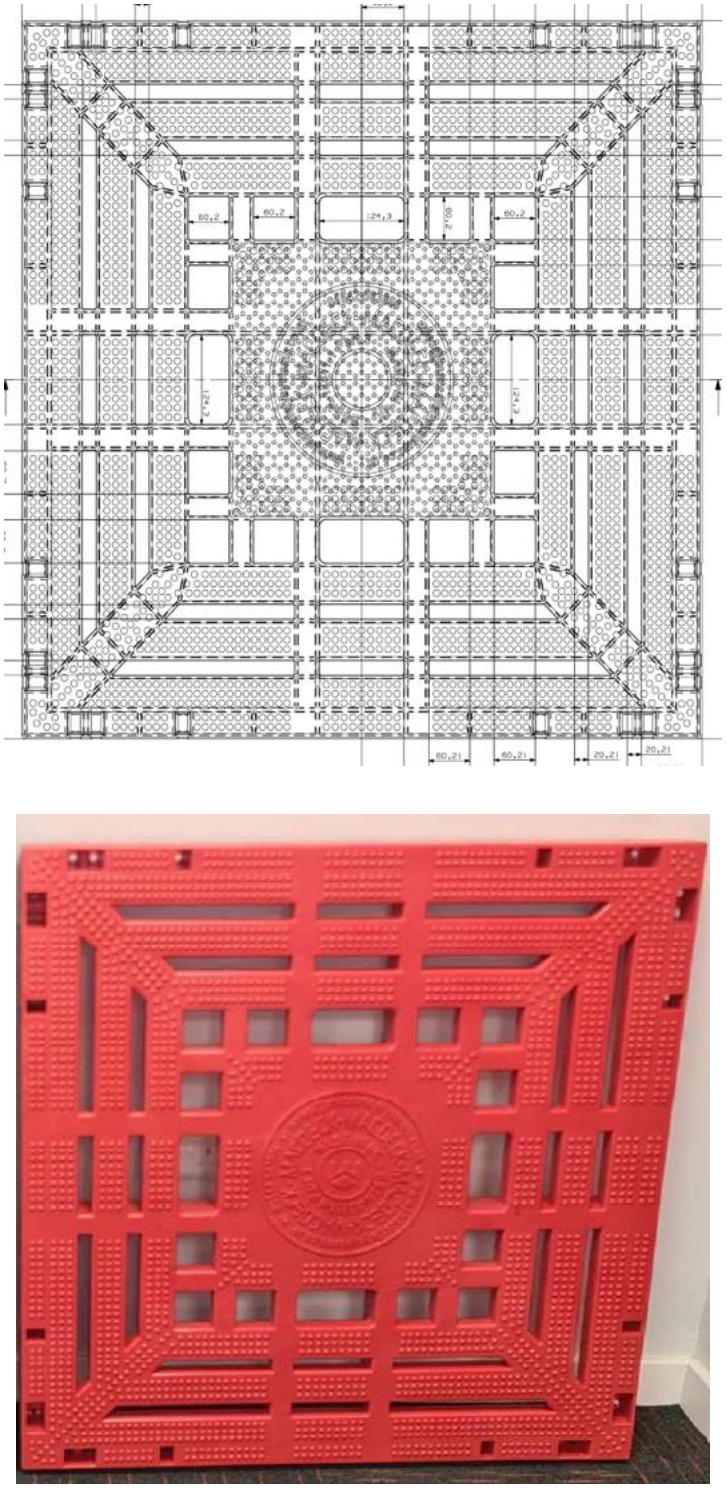


Figure 12

171. In closing submissions in relation to the question of the first date the Macdeck System was made available for sale or hire, Miss Reid, Counsel for the Defendant, argued the Macdeck 1x1 Panel that was being used in the demonstrations on constructions sites in 2016:

" … *was not a prototype.*

This was the design being made available in real life."

172. Mr Keay, counsel for the Claimant, confirmed the products being referred to as the Macdeck Panels and seen in the images from the social media posts in use on construction site in 2016 were "*...articles made to the design*.".

173. Paragraph 10 of the Defence admitted the Macdeck System was made to the Macdeck Designs:

"*Save that it is admitted that: the Defendant was a customer of the Claimant , a user of the Macdeck System, had access to and owned articles made to the Macdeck Designs* ... "

Issue 6

When were articles made to the Macdeck Designs first made available for sale or hire?

174. The relevant period of protection for a UKUDR here is governed by s.216(1)(b) and s.216(2) CDPA:

S.216 (1)Design right expires—

(b) if articles made to the design are made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.

(2)The reference in subsection (1) to articles being made available for sale or hire is to their being made so available anywhere in the world by or with the licence of the design right owner.

175. The Macdeck Designs were created on 4 January 2016. Where a design is "*made available for sale or hire*" within 5 years of that date, the term of protection is reduced to 10 years, "*from the end of that calendar year*". Therefore the precise date in any year is not critical but the calendar year in which a design was first made available for sale or hire is important. The Defendant says the design was first made available in 2016, the Claimant says it was 2017.

176. Two authorities are relied on by the Defendant. In *Ifejika v Ifejika* [2010] FSR 6 at [129] ("*Ifejika*") HHJ Birss (as he was) confirmed that "*... any making available for sale, on any scale, is relevant for this section to apply*.". Jacob LJ provided further guidance on the interpretation of the section in *Dyson* at [118] endorsing the interpretation of the Judge at first instance, "*I consider that the natural meaning of the expression 'made available' connotes something that is actually in existence. If one imagines a case of an offer of goods which have yet to be made (in the sense that none of them are yet made) then I would not consider that those goods are 'available' for sale even if advance orders for them are taken. Taking orders for them is not making them available*.".

177. The issue is that some products made to the Claimant's Macdeck Designs (the Macdeck System) were installed and put to use on various commercial construction sites in 2016. The Claimant's say this was marketing and does not accept the product was sold or hired out as it was not yet in mass production or in its final form. However, there was no further change to the shape and configuration of the Macdeck System between the products being used in 2016 and the later mass produced products. They were made to the Macdeck Designs. The Claimant's witness, Mr McCarthy explained he wanted to exceed the British Standard tests and was still adapting the mechanical make-up of the plastic used in 2016 and had not yet undertaken UV and frost testing. The Defendant has a variety of materials (including the social media posts from 2016 which were deleted during the proceedings) which they say tells an inconsistent story about what the Claimant was actually doing with the Macdeck System articles in 2016.

<u>The social media posts</u>

178. The evidence (mostly undisputed) established that at least by September 2016 (likely by June/July 2016 but nothing turns on this part of the chronology) the Macdeck System had been manufactured as a finished article made to the Macdeck Designs in moulded boards. These had been tested, and met with, relevant British Standards. They were safe for use commercially on construction sites. The precise number made by late 2016 is not clear. In cross-examination Mr McCarthy acknowledged the social media pictures showed there may be 250 panels at the Claimant site in September 2016 (see Figure 13 below).

19 September 2016

J.Mac Safety Systems
@jmacsafety
Sep 19, 2016

"We definitely got our #mondaymotivation when we saw all this MACDECK waiting to be used on site today."

20 September 2016

Sep 20, 2016

"We've got a busy day ahead of us as we head out to building sites across the #NorthEast with our MACDECK."

Figure 13

179. There is a significant amount of relevant information available on this issue in the Claimant's historic media pages and the disclosure. A series of Claimant media posts and emails in 2016 detail statements by the Claimant (and its representatives) that the Macdeck System was being installed, brought to market in the summer of 2016 and being used on building sites. By way of example, the documents include an email from the Claimant's sales manager, Mr Aaron Foley, to Mr Hall of the Defendant on 9 September 2017. Mr McCarthy was copied on the email. It stated, "*We brought the product to Market in the summer of 2016, after 24 months in design and Manufacture…*" In cross-examination Mr McCarthy explained Mr Foley was lying in the way salesmen do – to try to "*push and sell the product*". Mr McCarthy conceded, that although he was copied on the email, unfortunately he did not do anything about this inaccuracy. The justification for this misleading statement (other than the salesman puff) was Mr Foley being new to the Claimant and therefore he lacked relevant knowledge on the issue. The situation, according to Mr McCarthy, was that the Macdeck System was ready and tested in June/July 2016 but further testing and amendments to bring it to mass manufacture were still in progress during late 2016. It is again notable this email from Mr Foley was not disclosed by the Claimant, but by the Defendant (as a recipient of the email). Mr McCarthy confirmed he had searched the relevant email address but did not find this email.

180. Another example is the text in the media posts in Figure 13 which notes, "*We've got a busy day ahead of us as we head out to building sites across #Northeast with our MACDECK*". Mr McCarthy again conceded that, although, in his view, these posts were "*marketing fluff*", he likely approved some of them. Other images in these social media posts show the Macdeck System in operation at a number of construction sites including ones operated by Gentoo Group, Barratt plc and Miller Homes. Mr McCarthy explained that at that time Gentoo Group was not a client of the Claimant (but is now). There was evidence that Gentoo Group was a client of the Claimant at that time. The Defendant's post-trial references point out various transcript references from his cross-examination to support its contention Mr McCarthy was not correct when he explained some of these construction companies were not client's of the Claimant at that time. By way of example, the below reference relates to the company Gentoo:

Q. Gentoo is a customer of Macdeck?

A. It is now, it was not then.

181. The question put to Mr McCarthy was whether Gentoo was a customer of the Macdeck. Mr McCarthy's answered that Gentoo was not a customer of the Macdeck. He also explained the Claimant was hiring in safety decking product from suppliers for use on such sites. The same explanation was given in relation to the Defendant's allegations that the existence of multiple invoices from the Claimant to various construction sites for crash decking during the relevant period were inconsistent with the position that only limited volumes of the Macdeck were available for demonstration purposes. In my view, the evidence of Mr McCarthy on these issues was consistent. On balance, I accept the various orders identified were not for the Macdeck product.

182. Mr McCarthy was adamant the Claimant did not get paid for demonstrating the Macdeck System on these (or any) construction sites in 2016 and that any payment would come later, where the Claimant could "*take over those sites*". In his cross-examination, he set out the process for getting the Macdeck System onto a construction site: "*...prior to using it, you can demonstrate a product on site. It does not mean you are charging them for it. So, like, prior to us getting approval for this product on any of these sites, we had to demonstrate it. We would have to create a risk assessment, a method statement, go for pre-start, and we would have to then get the site to give us approval to erect or dismantle the product on their site. Then it would be reviewed by their production team and their safety teams and then they would give us approval to use it*."… "*We had to go through a process of putting these out there free of charge to enable the house builders to approve them as an approved product.".*

183. The Claimant therefore accepts the Macdeck System articles were made to the Macdeck Designs and were used in safety decking platforms on construction sites in 2016. This was part of a process to obtain pre-approval of these products to be used by national houses builders. These free-of-charge demonstrations would allow the potential clients to see and use the system. This would allow the various construction companies have the Macdeck System approved for use.

<u>The PPL contract for manufacture</u>

184. The Defendant appeared to be pushing a position that, regardless of the earlier produced Macdeck Panels used for the noted demonstrations, once mass manufacturing has occurred, you would expect the Claimant to start selling and hiring out the product. Therefore the timing of those mass produced products would be relevant. The Defendant challenged the Claimant's position regarding timing of mass manufacture of the Macdeck System based on a disclosed agreement for manufacture of the Macdeck

System with PPL. This 2016 agreement was for the mass manufacture of articles according to the Macdeck 1x1 panel Design (referenced as MAC305). Mr McCarthy explained the contract did not go ahead fully for a number of reasons. It seems from the explanation there may have been a partial parting of the relationship between Mr McCarthy and Mr Liam Eley around this point, which in turn may go some way to explaining his absence as a witness. Instead the contract for mass manufacture of the panels (the example invoice provided being for 1,000 MAC305 1m x 1m panels – the Macdeck 1x1 Panel) went to Rutland Plastic. There is a relevant agreement with Rutland dated 19 October 2016. In cross-examination there was debate about the timing of this manufacture. Mr McCarthy indicated it was around November or December 2016.

The ledger entries

185. The Claimant's ledgers detailing its invoices in 2016 were the subject of extensive discussion. The debate focused on whether the disclosure exercise was adequate and whether the documents indicated the Macdeck System had been sold or hired by the Claimant in 2016. At some point after 2016, the Claimant had migrated its accounting system from the software platforms *Sage* to *Xero.* I understand this software has the functionality for creating invoices from the underlying data for relevant period. The Defendant was not convinced all the Claimant's relevant invoices to clients had been fully provided. As a result there was a further disclosure statement and a fourth witness statement of Mr McCarthy dated 17 October 2023 on this issue. This was provided at the trial. This clarified his third witness statement, the result of the search for documents referencing Macdeck and a helpful explanation dealing with a point of confusion on the distinction between a hard copy invoice sent to a client and the nature of the electronic accounts system. The software accounting system appears to store ledger entries with information regarding a customer order from which invoices can be generated. Therefore, the system does not store hard copy invoices sent to clients. There were no hard copy invoices to provide. This created confusion which was enhanced by the possibility that when a 'new' invoice was created from the original order data the information appearing on the generated invoice depends on various selections within the software. This created some inconsistencies in the documents generated and caused the Defendant to challenge the disclosure exercise. I understand the Defendant's concerns regarding the disclosure, particularly in the light of the earlier deletion of relevant Claimant disclosure documents.

186. The date range chosen for the disclosure exercise was challenged based on the timing when the Macdeck System passed the British Standard testing in June/July 2016. In total there were surprisingly few (12) ledger entries for the relevant period. Mr McCarthy explains his accounting and IT systems were not as good at that time as they are now due to the infancy of the business but that regardless he had provided everything. There were ambiguities in the entries on the generated invoices. For example, there was a ledger entry from 25 August 2016 for the Barratts Plc site at North East Yarm stating, "*To install crash decking to the follow…*". Mr McCarthy confirmed in cross-examination that when using the software you could interrogate the program further and see the remaining text. He acknowledged the disclosure is therefore not complete and made offers during cross-examination to provide further disclosure where such information was obscured. Of course, the disclosure relied on should contain the full information for the documents said to be disclosed. The "*crash decking*" referred to in the 25 August 2016 entry is said to be that of third parties RhinoDeck and G&M Safety Deck, which were being hired out by the Claimant here for £45.36. The confusion and inconsistency in the disclosure is unfortunate. However, the explanation provide by the Claimant was reasonable and having considered the evidence on the issue I do not believe there was any indication the search and delivery of relevant documents had not been performed correctly, at least to a material extent that would likely impact the issues of my assessment on this point.

187. There were two disclosed ledger entries where a Macdeck product was referenced. The first on 17 March 2017 was for 100m^2 for 4 weeks and notes a rental cost of 2.00, with a credit of 2.00 referenced as 1 September 2018 and a total cost of 0.00. The explanation and unusual dating is said to be to do with a system migration from *Sage* to *Xero*. The Claimant relies on this entry as the first date the Macdeck System was made available for sale or hire i.e. in 2017. The second is dated 31 May 2017 for the supply, hire, erection and dismantle Macdeck Birdcage 1.8M Universal Platform for £450. This was explained to be a different type of scaffolding to the Macdeck System.

188. There is also a ledger entry on 28 September 2016 for the client Barratts for crash decking being delivered for hire and charged. Mr McCarthy explains these and other similarly referenced entries are not for the Macdeck System for the same reasons; (1) they were not charging for the Macdeck installation in 2016, (2) the quantities in question were likely larger than the estimated 250m^2 Macdeck System available at that time, and (3) the early Macdeck System was distributed to a number of sites seen in the media posts and would then remain in use on that site being demonstrated for about 10

weeks. The total quantity available for each site was therefore modest, only enough for about one unit – as seen from the social media posts.

What is the relevant year when the articles made to the Macdeck Designs were made available for sale or hire?

189. This issue therefore has a fairly complex and incomplete factual matrix. However, a number of undisputed or accepted issues can now be identified. The Claimant had produced articles made to the Macdeck Designs by June/July 2016. These had been tested to an appropriate British Standard and could be used commercially. The Claimant was not satisfied with that product and was still working on the final properties of the plastic used for the articles and planned to conduct further tests, to go above and beyond what was needed. The further work fine tuning the Macdeck System was not on the shape and configuration – that remained the same as the Macdeck Designs. There were at least around 250m^2 of Macdeck System available for use by June/July 2016. All or some of these were in use functioning as a British Standard compliant safety decking platform at commercial construction sites in 2016. I accept the purpose of these products being provided to the various commercial sites was to obtain the approval of the companies operating those sites so that the Macdeck System could be adopted more broadly. The product would remain on these sites for use as safety decking over a period of about 10 weeks. Finally, that on the evidence, an order was placed for 1,000 articles made to the Macdeck 1x1 Panel Design on 19 October 2016.

190. The media posts and the email of the Claimant's sales manager, Mr Foley, all indicate the Macdeck System was brought to market in a more commercial manner. However, the comments are not entirely inconsistent with the Claimant's position that the Macdeck System was on the market and being used but in the limited demonstration capacity. In the context of all the available material in the case, I accept the Claimant's position. This was the marketing agency overstepping in their roles. It was marketing puff. The ledger issue took up considerable time. In the end, little was resolved. There are ambiguities in the various disclosure entries, the disclosure documents are imperfect and likely incomplete. This was a company in its early stages. Mr McCarthy accepted these shortcomings (in the main) in an open and fair manner. I did not get the impression there was an exercise in hiding a tranche of documents showing that the Macdeck panels had been hired out in 2016 to these construction sites for a fee. Overall, the evidence was consistent with the Claimant's position. The process to get the Macdeck System approved takes some time, around 10 weeks to start with and then

presumably a further period prior to the approval of the Macdeck System. Regarding the 'mass manufacture' of the Macdeck panels, the precise date at the end of 2016 (October, November or December) does not alter my view on this issue. In my view, the Macdeck System was not being sold or rented out for payment on a mass manufactured scale before the end of 2016. On balance, I also accept there was no payment for the use of the limited volumes if the Macdeck System made available to construction companies using the system to evaluate the new product in 2016.

191. In applying these findings to s.216(1) CDPA, the precise number of construction sites that used the Macdeck System in 2016 does not matter (see [129] *Ifejika v Ifejika*). In *Dyson* the Court of Appeal at [118] confirmed that taking orders for items not yet made was not enough to trigger the section. The goods needed to exist. The relevant articles, the Macdeck System, made to the Macdeck Designs were available in 2016. The words of the statute are "*made available for sale or hire".* It does not say the timeline commences from the first article sold or the first hire. It also does not express whether a sale or hire needs to be in return for payment.

192. There was limited submission or guidance from the parties on the underlying policy regarding the commencement of the relevant period of protection and the action of the article being made available. In my view, the natural construction is the relevant point in time is when the article made to the design is made available for sale or hire and commercially benefiting the party. In other words, when the use satisfies the reasonable requirements of the relevant consumer. The Court of Appeal in *Dyson* appeared to distinguish an existing product being offered for sale and one that did not exist. The commercial engagement of the safety decking industry with its construction clients commences with trials of their decking products on construction sites. This may have been, in the view Mr Foley expressed in his email, bringing the product to the market in 2016. The construction companies used the safety decking in a real world building environment with the express purpose of the use leading to the Macdeck System obtaining approval to supply the site with commercial quantities of the safety decking. This was part of the sale and /or hire process. Where, despite my view, the Claimant had obtained large quantities of the Macdeck System during 2016, based on my analysis, this would likely not have affected the Claimant's ability to offer the product to these construction clients. A trial period to test whether the new safety decking was acceptable to the construction companies would still be required to determine any later purchases/hire. Therefore, the ultimate outcome of the process where the construction client makes commercial orders of the safety decking is not the trigger for the making

available date. The provision of the product to these companies for its use is part of the process to commercialise the product. That is enough to satisfy the requirement to make this article available for sale or hire. The calculation of the duration of the 10 year duration of protection under s.216(1)(b) and s.216(2) therefore runs from 2016.

Infringement

193. The Claimant alleges primary and secondary infringement by the Q Deck Components in relation to each of the Macdeck Designs. The Q Deck Components includes; Q Deck 1x1 Panels, Q Deck 0.75x1 Panels and Q Deck Pins. The Defendant admits the photographs in Annex 8 of the APOC (reproduced as Annex 6 to this judgment) show the Q Deck 1x1 Panel and the Q Deck Pins but does not accept it shows the Q Deck 0.75x1 Panel. The acts of manufacture (or authorised manufacture of), stocking, offering for sale and sale for each of the articles in the Q Deck Components have been admitted.

The law

Primary Infringement

194. The relevant parts of s.226 CDPA provide:

(*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.

195. There is no disagreement on the law here. The question of infringement by making an article has two stages – albeit they are linked; (1) to determine if there was copying, and (2) whether an article made by the alleged infringer was made "*exactly or substantially to that design*".

196. Aldous J (as he was) in C*&H Engineering* at 428 set out the approach to assessing an allegedly infringing product: "*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*."

197. In *Neptune*, Henry Carr J addressed the correct approach to considering whether an allegedly infringing article is produced exactly or substantially to the design at [49] to [53]. At [53] the Judge went through the reasoning for the difference between the approach to infringement in copyright and UK unregistered designs (it is not an infringement of a UK unregistered design right to copy a substantial part of a design) referencing the decision in *Wooley v A Jewellers* [2002] EWCA Civ 1119 at [19] and which I reproduce in part below:

"*... there is a difference between an enquiry to whether the item copied forms a substantial part of the copyright work and an enquiry whether the whole design containing the element which has been copied is substantially the same design as that which enjoys design right protection. ... on that test* [for design right infringement] *it may not be enough to copy a part, even a substantial part. Regard has to be had to the overall design which enjoys design right*."

198. In *Original Beauty v G4K Fashion1* [2021] EWHC 294 (Ch) at [96]-[97] , Mr David Stone, sitting as a Deputy Judge of the High Court, accepted the Defendant's submission in relation to establishing copying in that case:

"*...a simple causal link is enough to establish copying. If the claimant's design has contributed to the defendant's creation of its design there is copying. Whether or not that amounts to infringement will depend on whether or not - assessed quantitatively and qualitatively - what has been reproduced is sufficient*".

199. In *DKH Retail Ltd v H. Young (Operations) Ltd* [2015] FSR 21 at [57] to [59] HHJ Hacon relied on *C&H Engineering* and also referenced Lewison J (as he was) in *Virgin Airways Lt v Premium Aircraft Interiors Group* [2009] EWHC 26 (Pat) setting out the interlinked nature of this two part test and the resulting logical difficulty that any design could be copied without being made exactly or substantially to the copied design:

"*33. Although, at least in theory, two separate criteria must be satisfied viz. copying and making articles exactly or substantially to the copied design, it is not easy to conceive of real facts (absent an incompetent copyist) in which design is copied without the copy being made exactly or substantially to the copied design. In practice, if copying is established, it is highly likely that the infringing article will have been made exactly or substantially to the protected design. If copying is not established, then whether the article is the same or substantially the same as the protected design does not matter. However, similarity and design may allow an inference of copying to be drawn*.

200. Copying may be direct or indirect. Drawing inspiration from the earlier protected design is not in itself enough if there is not also copying. In situations where, as in this case, there is a comprehensive appreciation of the earlier protected design, evidence of independent design efforts can be important to rebut the inference of copying, see for example *Ocular* p423.

201. Finally, Mummery LJ explained the need for caution in the approach to assessing copying 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."

Secondary Infringement

202. S.227(1) of the CDPA provides as follows:

Secondary infringement: importing or dealing with infringing article.

(1) Design right is infringed by a person who, without the licence of the design right owner-

…

(b) has in his possession for commercial purposes, or

(c) sells, lets for hire, or offers or exposes for sale or hire, in the course of a business,

an article which is, and which he knows or has reason to believe is, an infringing article.

203. An article is an infringing articles in relation to a design if its making to that design was an infringement of design right in the design (s.228(2) CDPA). Secondary infringement under s.227 CDPA therefore requires knowledge that the relevant article is an infringing article under s.228 CDPA. HHJ Hacon considered the law relating to secondary infringement in *Action Storage* and set out a helpful summary at [82]-[87]. One point that had some relevance to this case is where a party is aware of an earlier article but has worked to try to distinguish their new design from that earlier one. As part of HHJ Hacon summary on the principles of the law on secondary infringement he confirmed:

"(8) A mistaken belief in the law [that] an act is not an infringing act does not serve to deprive the defendant of knowledge under s.227, provided the defendant is aware of all the relevant facts. This includes the mistaken belief of the law that the claimant has no enforceable design right, inferred from the facts.".

Issues 7 and 8

7. Whether each of the Q Deck Components in issue constitutes an article made exactly or substantially to one of the Macdeck Designs?

8. Whether the Q Deck Components in issue were copied from the corresponding Macdeck Designs?

204. Although these are separate parts of the two stage test being applied under s.226 CDPA, I deal with them together as the issues are inexorably linked. In considering the question of infringement, the analysis of the Macdeck Designs needs to include the outcome of the assessment under s.213(3) and s.213(4) as relevant. In *Action Storage* HHJ Hacon considered the application of these exclusions and originality/commonplace to the second step of this two stage process; are the articles alleged to be copied exactly or substantially to the claimant's design:

"77. I think there may be a difference in this regard between s.213(3) and s.213(4). The exclusions under s.213(3) result in no design right subsisting in features of design. This is expressly the case in relation to s.213(3)(b) and it seems to me to be equally true in relation to s.213(3)(a) and (c). No design protection is afforded to such features, apparently whether relied on individually or whether they form part of a larger design. I have some hesitation about this because s.226(2) requires a comparison to be made between the design of the accused article and the claimant's design, unqualified. But if the claimant's design is composed solely of features in which design right does not subsist pursuant to s.213(3), plainly there will be nothing in the claimant's design that can lead to a conclusion of infringement. On balance, it seems to me that the legislature intended the comparison to be made between those features in the claimant's design in which design right subsists and which are therefore relevant to the second step assessment, and only those. Features to which s.213(3) applies should be disregarded when considering infringement under s.226.

78. Once features are excluded from consideration under s.213(3) there may arise a question whether what remains is still a design of the article or the part of an article as claimed in the pleading.

79. By contrast, s.213(4) applies to designs as a whole, whether of an entire article or of part of an article. It is not concerned with features of a design. If the claimant's design as a whole is not commonplace, it is not deprived of design right protection

under s.213(4). This is true irrespective of whether some or even all the features of the design are individually commonplace. Therefore infringement should be determined by reference to the whole design including any commonplace features. This appears to have been the approach taken by Aldous J in C & H Engineering v F. Klucznik & Sons Ltd [1992] F.S.R. 421, at 428-9. Likewise, the assessment carried out in the second step will take into account not just original features (in the copyright sense) but also any features that have been found, or admitted, to lack originality."

205. I adopt this reasoning and apply the same principles set out by HHJ Hacon. Therefore, in making my infringement assessment; (1) my analysis is carried out taking into account the whole design (including features found to commonplace), but does not include (2) the features where design right does not subsist and determined to be excluded, these are disregarded. It is also necessary to consider whether, once the features are excluded under s.213(3) CDPA, there remains a design of an article or part of the article as pleaded.

206. The features I assessed were excluded under s.213(3) CDPA and would not therefore form part of the infringement assessment of the Macdeck 1x1 Panel Design, the Macdeck 0.75x1 Panel Design and the Macdeck 1x1 Perimeter Panel Design were; the height, the straight edges and the central circular roundel. For the Macdeck Pin Design these exclusions were; the diameter of the shaft of the pin required to fit the necessary hole, the length of the pin (after the lower disc) for it to operate and the lower disc. What remains of the Macdeck 1x1 Panel Design, Macdeck 0.75x1 Panel Design and Macdeck 1x1 Perimeter Panel Design remains sufficiently the design of the pleaded whole Macdeck 1x1 Panel Design and Macdeck 0.75x1 Panel Designs and the pleaded part of the design in the Macdeck 1x1 Panel Perimeter Design.

207. I am conscious this is a complex assessment. Bearing in mind the cautionary metaphysics risk noted relating to assessments in unregistered designs by Jacob LJ in *Dyson,* I have dealt with various alternative positions below. Therefore, if I am wrong about my earlier views on the operation of s.213(3)(b)(i) CDPA regarding the 12 central square apertures (see the example row in the annotated box Figure 22 C at p98) or the additional 4 'hand hold' apertures in the central square shape and these are excluded, I need to consider whether the remaining features are still sufficiently a design of the noted panel designs. In my view, due to the number of remaining features and their quality within the overall Macdeck 1x1 Panel Design and Macdeck 0.75x1 Panel Design, these are sufficient to continue to justify as the pleaded designs of the panels within the meaning of s.213(2) CDPA.

208. I noted it would also be prudent to consider the alternative where the slot apertures on the side of the panel were excluded and therefore do so as part of the infringement analysis. In those circumstances, on the assumption these side rounded arch shaped apertures are excluded from the design, I need to consider I this context whether the remaining features of the Macdeck 1x1 Panel Perimeter Design still constitute part of a design (in my view the remaining features within the Macdeck 1x1 Panel Design and Macdeck 0.75x1 Panel Design are sufficient to continue to be a relevant design). The removal of these features from the pleaded part of the design, in addition to the other noted excluded features, is significant. However, on balance my view, there remains a sufficiently significant and contiguous element of the pleaded part of the overall design such that it continues to be a part of the design within the meaning of s.213(2) CDPA.

209. For the Macdeck Pin Design, the exclusion of the diameter of the shaft, the length of shaft below the lower disc and the lower disc changes the nature of what remains from the pleaded whole Macdeck Pin Design. The remaining features are contiguous but comprise only a part of the whole pin design. The remaining trapezoidal shape at the end of the pin and the connected upper disc are therefore not sufficiently a design of the whole pleaded pin within the meaning of s.213(2) CDPA. The remaining features are not pleaded in the alternative as a part of the Macdeck Pin Design. However, as I have been addressed on the issues and considered the situation where the remaining features of the Macdeck Pin are sufficient to be a design in the context of the pleading for the purpose of an infringement assessment, I will, in the alternative, set out my assessment on the point.

210. There was a point taken by the Defendant regarding the infringement comparison with the Q Deck Components and the images in Annex 8 of the APOC which show side by side pictures of the Macdeck 1x1 Panel and the Macdeck Pin with the Q Deck 1x1 Panel and the Q Deck Pin in Annex 9 of the APOC, reproduced as Annex 7 to this judgment. The Defendant did not accept the Macdeck 1x1 Panel and the Macdeck Pin as being made to the Macdeck Designs. Counsel for the Defendant submits there are "*...parts of the design which are not reproduced in the articles. So, to the extent that the articles are not made to the design, obviously the design cannot be copied*.". I have determined the Macdeck System contains articles made to the Macdeck Designs and that the Macdeck Designs are suitably circumscribed (to the extent this was a further issue being raised by the Defendant) . In my view, the Defendant's arguments about the parts of the design said not to be reproduced in the articles were not adequately

supported. The differences that seemed to be asserted were such that in any event they would be immaterial to the issues being determined.

211. In any event, the Defendant correctly asserts the comparison that should be undertaken is between the Macdeck Designs and the Q Deck Components. That is the comparison undertaken, although to be clear, I do not believe there would be any material difference were the comparison made with the Macdeck System. To the extent relevant, I also agree the Defendant did not have access to the Macdeck Designs and therefore any copying would be indirect via the Macdeck System.

Copying

The development of the Q Deck Components

212. Safety boards such as in the Macdeck System and the Q Deck Components can be used for construction on the ground floors of buildings or low building extensions. The Defendant was a customer of the Claimant from around 2019. During that time the Defendant purchased around £1,000,000 worth of the Macdeck System. They chose the Macdeck System because, "*At the time we felt the best boards were J Mac Safety Systems Limited's*.". There was a close working relationship during this time. The Claimant supported the Defendant with training on the Macdeck System, health & safety and related risk assessments. At that time, the Defendant's business model was to buy safety decking systems and rent these out on construction sites. Later, around 2020, the Defendant tried to re-negotiate the arrangement with the Claimant such that it could reduce costs. The parties looked at creating a form of franchise and distribution model but this did not ultimately succeed. Before this engagement with the Claimant, in 2019, the Defendant was separately also looking at taking the third party manufacturer and distributor out of the supply chain i.e. developing its own safety decking panel.

213. These background facts are relatively uncontentious. The decisions (and reasons for those decisions) taken by the Defendant from this point onwards are, however, heavily contested. Mr Hall explained the idea to create the Q Deck System was not just about reducing costs and increasing profits by removing the third party manufacturer and distributor, but also to create a safety board that was *"...lighter and faster and easier to erect*.". To achieve this, Mr James Mann, the Defendant's Operations Manager at that time, advised on the board's design (i.e. the number of slits/holes and their positions on the board). He was experienced with setting up safety decking systems on sites. Mr

Hopkins (another director of the Defendant) instructed Mr Charles Mills of Brookmill Design Limited ("Brookmill") around May 2019 to assist in designing, as Mr Hall puts it, *"...a completely new design to fit our desire to have the best type of board*.". Having never created a design 'from scratch' Mr Hall explains a considerable amount of time and money went into the design of the Q Deck System. His evidence goes into details of their considering and testing safety panel products that were on the market. Mr Mills explained he had not been aware of the TRAD Deck prior to being instructed by the Defendant and therefore considered the "… *available safety decking systems in the market. Guided by the Defendant, we looked at the boards manufactured by J Mac … and TRAD Group …"*. Samples of safety panels were provided to Mr Mills' team, a Macdeck 1x1 Panel, a Macdeck 0.75x1 Panel and a TRAD Deck panel. In addition to this design being lightweight, strong, robust and quick and easy to install, a premise that is consistent through the evidence is the requirement that it is compatible to the Macdeck System. The Defendant owned a significant amount of the Macdeck System product and wanted their new product to be interoperable with it. Mr Mills explained that in 2019 when the process commenced "*the Defendant did not have a specific design in mind already for us to work on*.". I was taken through the disclosure and evidence of Mr Mills, Mr Kershaw and Mr Hall relating to the Defendant's design process. In cross-examination, Mr Mills accepted he started from the Macdeck panel in the design process and then made changes. The task set out in Mr Mills' quotation dated 15 May 2019 for this work was to "*design an equivalent product to the J Mac Safety Systems Ltd fixed work platform*". By the conclusion of the trial I understand the Defendant accepted the starting point for the development of the Q Deck Components was the Macdeck System. Where it did not, it is my view the evidence supports this position. The Defendant's evidence acknowledged that, as part of their design process for the Q Deck Components, there were functional constraints built into their design due to the need for interoperability with the Macdeck System.

214. At the start of the design project in May 2019, Mr Hopkins provided instructions to the Brookmills' team. At that time, Mr Hall was in Australia. His involvement became more direct in the process around early July 2020. On cross-examination it transpired much of Mr Hall's early evidence about the design process prior to his direct involvement was necessarily second hand and of limited weight and relevance. It does not have any material impact on my view of the events.

215. Mr Mills accepted they chose the same (or effectively the same) external dimensions for the Q Deck 1x1 and 0.75 x1 panels as the Macdeck 1x1 Panel and 0.75x1 Macdeck

Panel. This was explained as a critical mating functional constraint. It was a conscious choice to use the same external dimensions as the Macdeck panels. Mr Mills refers to many of the choices as based on the requirement that "*The system had to be interoperable with the Macdeck, so inspiration had to be taken from there*.". The reason appears straightforward, the Defendant had £1m of the Macdeck System and wanted to be able to use it interchangeably with the new Q Deck Components.

216. Mr Mills put together a summary of the various designs being considered in the first 10 months of the process. The leading design at that time appears to have been the "honeycomb" one (see Figure 14 below):

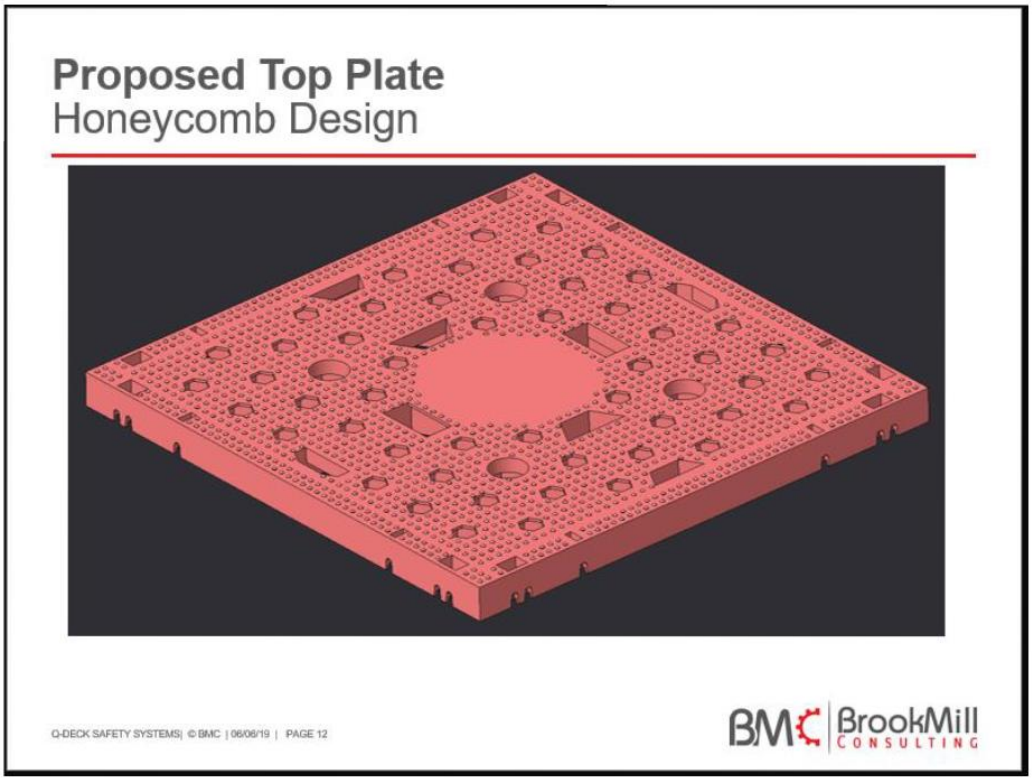


FIGURE 3 – DESIGN 5 APRIL 2020 (UPPERSIDE)

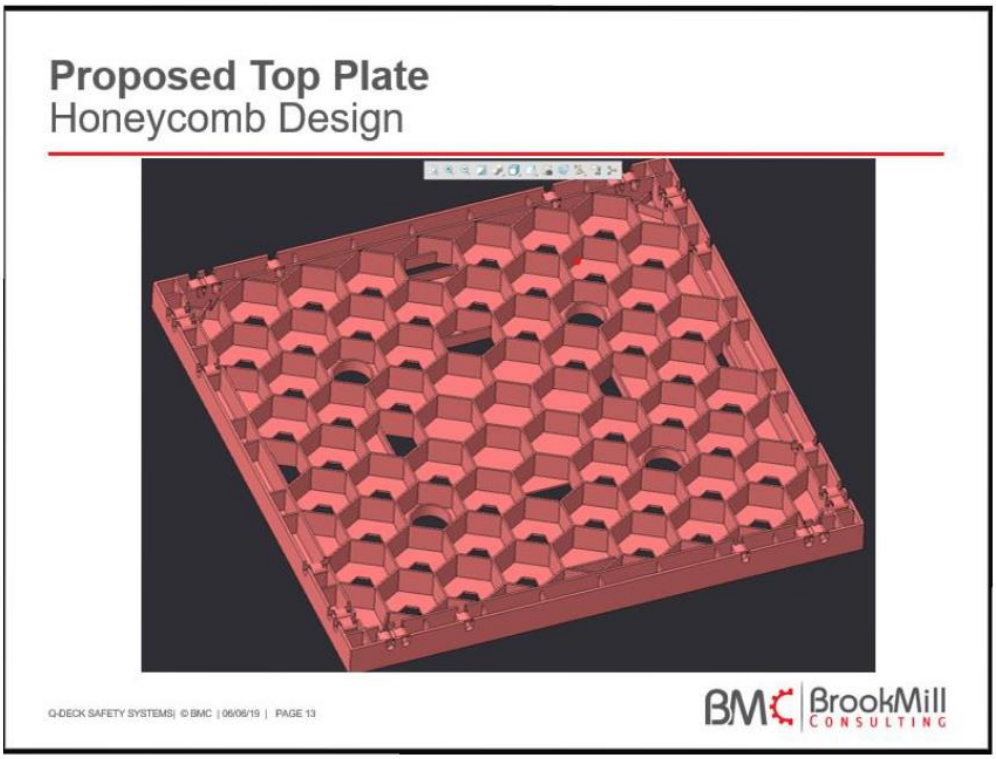


FIGURE 4 – DESIGN 5 APRIL 2020 (UNDERSIDE)

Figure 14

217. On 6 July 2020 input on these designs from the Defendant was referenced in a WhatsApp group chat within the Brookmill design team. Specifically, Mr Hall had been in touch with Mr Mills from Australia. The resultant exchange was;

"*Guys nightmare! Just had someone from Q Deck ring from Australia. They have now looked at our designs and said there is loads of issues with the functionality.*" … "*He wants a complete copy of J Mac's board and get around the patent. I said we are hundreds of hours into the design already and redesigned it twice.*"

218. In his cross-examination, Mr Hall explained these comments were a hot headed response in a context where the team had worked hard on the current proposal. He explained his comments were really about how the new board needed to work with the functional features of the JMac board. Mr Mills confirmed the Brookmill design team continued looking at the Macdeck panel and discussing it with colleagues and the Defendant throughout the design process.

219. On 28 July 2020 a message on the Brookmill WhatsApp exchange explained the Defendant (Mr Hall could not recall who at the Defendant) provided feedback on a design (see Figure 15 below) noting the yellow and red lengths in the diagram show

the distance apart between both slits and the edge of the board must be the same as it is at the J Mac boards so the strapping is easiest. In cross-examination, Mr Hall accepted "*I am not saying you could not strap it if it was not in that location.*". This appears to be more of a functional requirement the Defendant wanted to be the same as the Macdeck Panel because it was more convenient rather than one that was needed.

Figure 15

220. In an email on 23 September 2020, in a discussion between the Brookmill team and Mr Hopkins regarding the design process, Mr Mills explained in the context of a further design (see Figure 16 below) that "*We have concerns that it is still too similar to the J-Mac but we will pursue.*". On 28 September 2020 Mr Hall reported to his team on the WhatsApp chat that the design (Figure 16) received negative feedback from the

Defendant due to concerns about its functionality. In the exchange, Mr Mills asks his colleague;

```
[28/09/2020, 20:43:03] Charles: Nick, will you modify
yours slightly to make the slots match more? Also could
you remove the diagonal full height web.
```

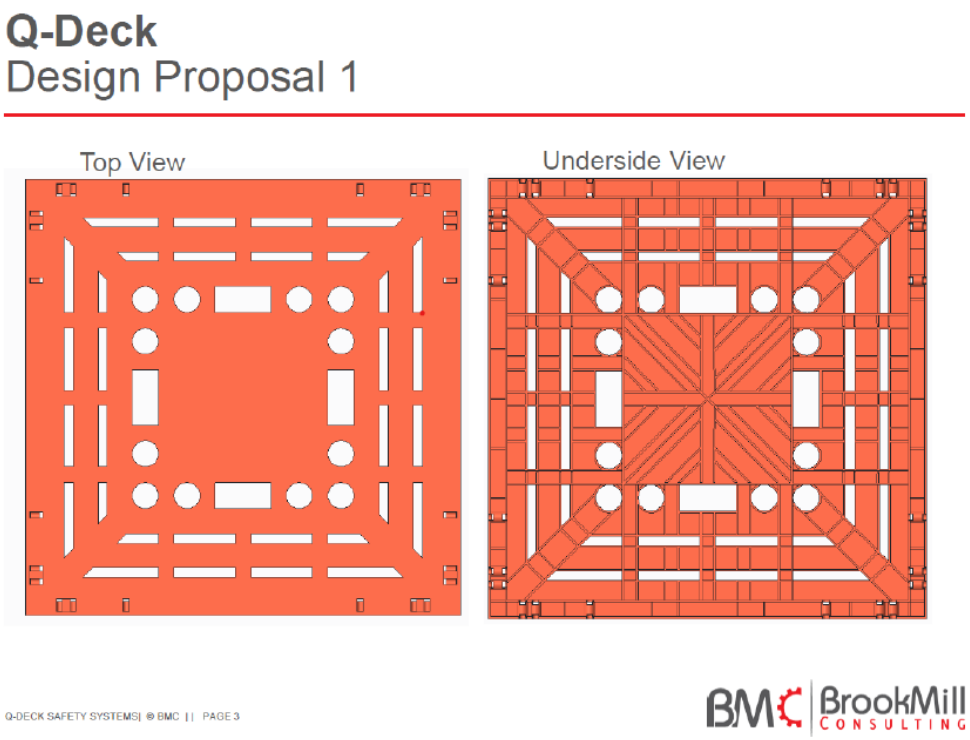


FIGURE 5 – DESIGN 26 SEPTEMBER 2020, PROPOSAL 1 (UPPERSIDE)

Figure 16

221. The exchange continued (set out below) with Mr Mills confirming the slots were in the "*correct location on that model as I measured them from their board*". By this I understand Mr Mill to mean the Macdeck panel.

```
[28/09/2020, 19:47:54] Charles: Rick mentioned the slots
wernt in the right place. So I put the model I've been
working on, on Dropbox. The slots are in the correct
location on that model as I measured them from their
board
[28/09/2020, 19:50:59] Nick: No point if they hate it
[28/09/2020, 19:52:52] Charles: We need your idea as it's
likely the IP guys are gonna say the design they want is
not different enough.
[28/09/2020, 19:53:05] Charles: It looks exactly the same
as the j-Mac
[28/09/2020, 19:53:30] Charles: Like exactly the same.
```

222. In the chain of this discussion, Mr Mills responded "*We need your idea as it's likely the IP guys are gonna say the design they want is not different enough. ... It looks exactly the same as the J Mac. ... Like exactly the same*.". Mr Hall diverged slightly from this position in cross-examination, noting the design and the Macdeck panel were very similar (not the same). Mr Mills also relied on the design of the underside of the Q Deck Panel in the context of the functional constraints of the design on the upper side of the panel. There is some evidence on the design of the lower part of the Defendant's design. However, that evidence is limited in nature. That evidence does not really explain why the underside of the panel had to be designed in the way chosen or how that impacts on the design of the upper side. The point edges into expert opinion of structural requirements. There is no expert evidence in the case. I am therefore aware of the evidence of the underside of the Defendant's design asserting its impact in the context for the overall panel design but due to its nature I do not place much weight on that evidence.

223. Regarding the viewing holes around the upper face of the perimeter of the panels (see an example row in Figure 22 A at p98 and Annex 1) for the Macdeck 1x1 Panel Design and the Q deck 1x1 Panel, Mr Hall's view is the size and location of these holes are slightly different. Below in Figure 17 are cropped images from the APOC Annex 9 and the Macdeck 1x1 Panel Design from Annex 1 showing a closer comparison for convenience.

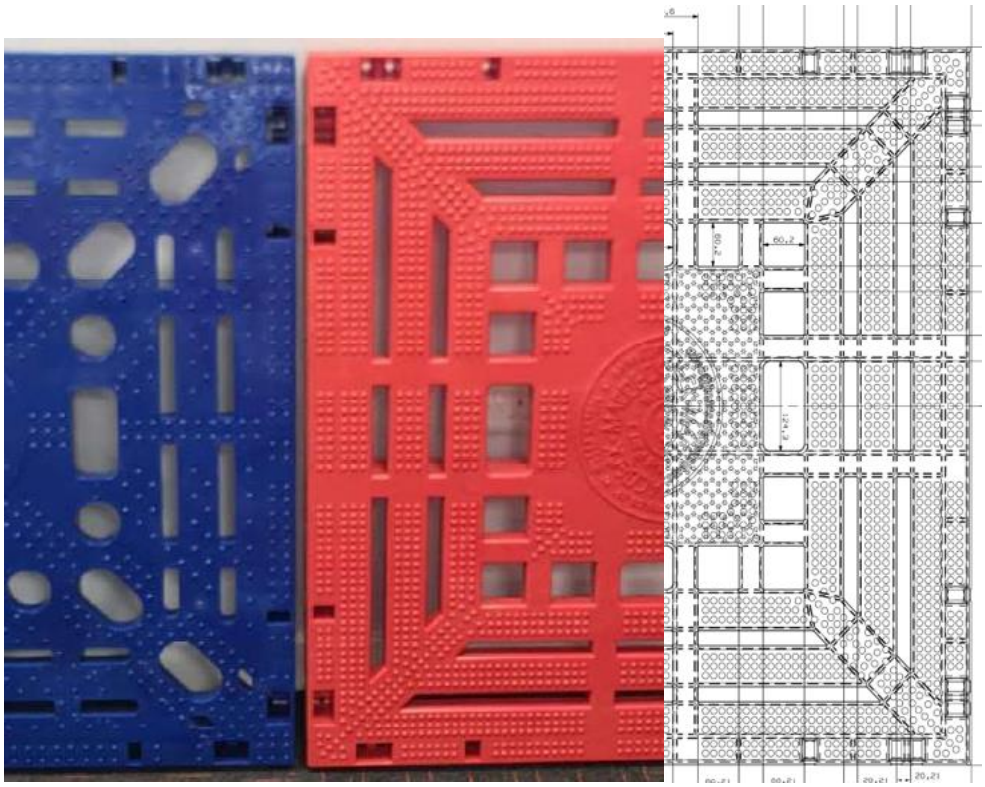


Figure 17 Q Deck 1x1 Panel, Macdeck 1x1 Panel and Macdeck 1x1 Panel Design

224. In a continuation of the Brookmill WhatsApp discussion on 4 October 2020, Mr Mills noted (regarding the design in Figure 16) that "*We need to adjust the top of the plate to make it look different. … If that's adding slots/holes some sort of features. … I think they were keen on having a slot in the corners but they were wanting a kind of X shape. … To take your eye of all the J Mac features*.". (reproduced more fully in context below). At that point it seems Mr Mills understood the design was too close to the Macdeck Panel and additional features and functionality were needed to try to give a difference of appearance.

```
[04/10/2020, 13:40:09] Charles: We need to adjust the top
of the plate to make it look different.
[04/10/2020, 13:40:35] Charles: If that's adding
slots/holes some sort of features
[04/10/2020, 13:49:01] Richard Sandbrook: To which?
[04/10/2020, 13:49:15] Richard Sandbrook: We each doing
one?
[04/10/2020, 14:15:26] Charles: Think we need to come up
with some ideas. Maybe individually. I think they were
keen on having a slot in the corners but they were
wanting to show a kind of X shape
[04/10/2020, 14:15:42] Charles: To take your eye of all
the J-Mac features
```

225. On 20 October 2020 a presentation entitled "*Q Deck safety systems final design & FEA testing*" was provided by the Brookmill designers to Mr Hopkins. The covering email from Mr Mills once again references the J-Mac Panel in the context of discussing a proposed design and the attempt to change the look of the surface tread on the panel to provide a "*little more visual difference*" to the Macdeck panel.

"Hi All,

Please see attached presentation.

It seems the deflection between the j-mac and the new q-dec latest design is very similar.

We still have a little work to do but getting really close now.

We did the tread in the 'X' formation to try add a little more visual difference. Please let us know your thoughts."

226. The presentation provides a side by side comparison between the Q Deck panel and what is described as the J-Mac panel (which is the Macdeck 1x1 Panel), both visually and structurally (I have reproduced sections showing the Q Deck and J-Mac panel from the presentation in Figure 18 below:

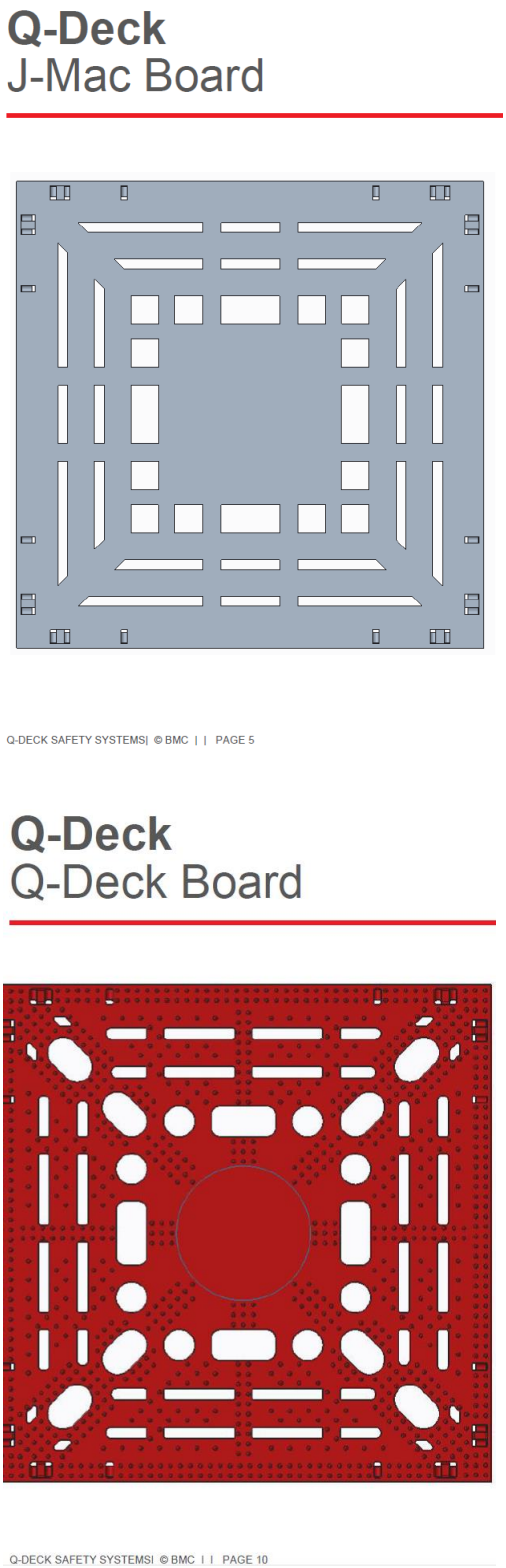


Figure 18

227. The presentation also lists the relevant "*non-negotiable*" features they had been required to implement in the Q Deck design. These are set out below in Figure 19:

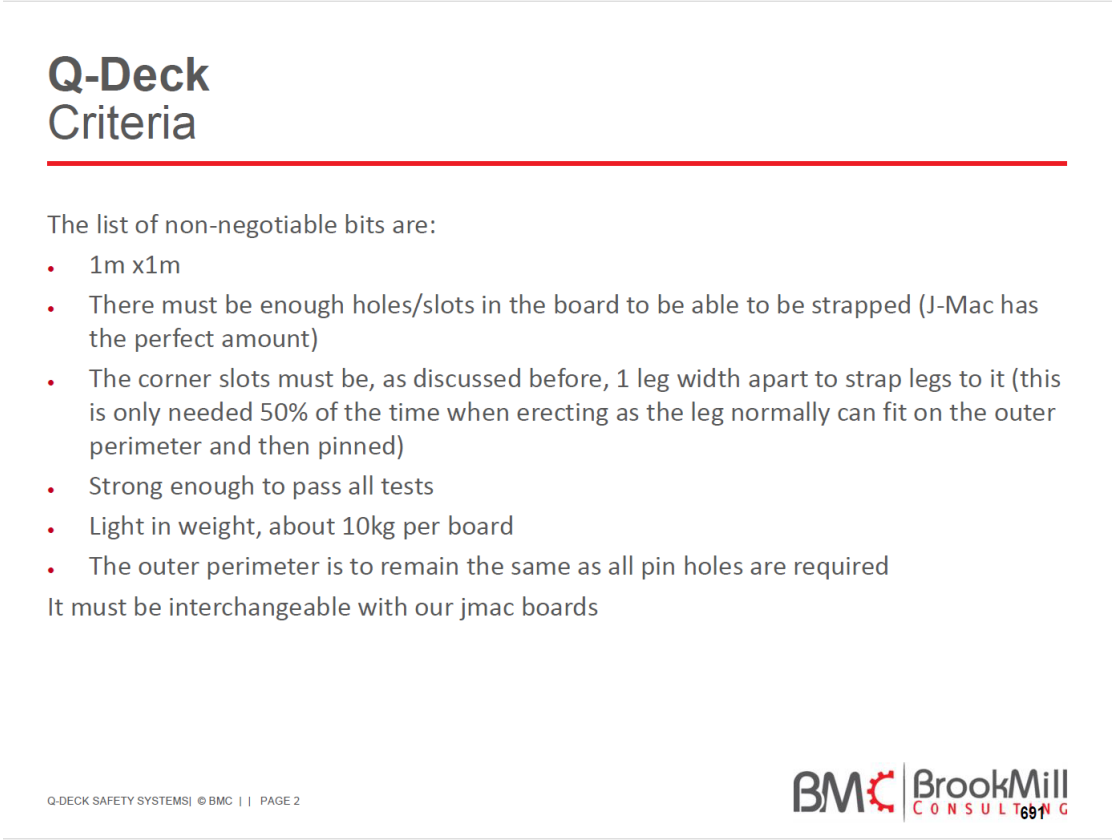


Figure 19

228. When challenged about the statement in the presentation that the "*outer perimeter is to remain the same as all pin holes are required*", Mr Mills accepted these cut-out holes around the outside edge of the perimeter (see an example row from the Q Deck 1x1 Panel in the top image (blue in colour) in Figure 23 p98) of the Q Deck 1x1 Panel and the slots on the side of the Macdeck 1x1 Panel "*need to be in the same position*" and the perimeter part of the Q Deck 1x1 and Macdeck 1x1 Panel look "*very similar*". There was a debate about the precise millimetre level dimensions such that the precise "*fine dimensions*" in the Q Deck may have changed during the design's refinement and it was not possible to confirm if the positions in the Q Deck of the cut-outs on the top of the panel (see example row in Figure 21 A p98) and the slots around the side were identical to the Macdeck 1x1 Panel. There was no empirical evidence on this point.

229. Mr Mills gave some generalised evidence in his cross-examination about difficulties in manufacturing certain shapes of holes on the side of the panels due to the injection moulding process. He is not an expert in injection moulding, although he explained he

has considerable experience in the field. In my view this statement does not take matters further forward. All this would mean is different features on such a safety deck panel may be interrelated and therefore there can be certain constraints on the shape and configuration. That may be right, but the Defendant provides very limited support for anything relevant to this case.

230. As part of Mr Hall's justification that the Q Deck Components were created by way of an independent design exercise, his evidence explains "*The cost of designing, testing, prototyping, 3D printing, and research cost the company around £250,000 over 2 years to do. We would never have had this expense or gone to this effort to completely develop a board from scratch had we copied anything else available. We never set out to copy. We wanted to innovate and create the best boards on the market*.". However, when challenged by Claimant's counsel, Mr Keay, in cross-examination, Mr Hall conceded fairly that the actual design costs as part of this development costs was "*only a small portion*" and the moulds were most of this cost.

Interoperability in the safety panel industry – FASET

231. Both parties relied on evidence relating to the question of whether safety deck panels from different suppliers could be used interchangeably on construction sites. The Defendant's position is the interoperability and interchangeability of the Macdeck System and the Q Deck Components for use on construction sites is important. The Claimant disagrees. Its position is this asserted interoperability is not permitted. The point here seems to be whether the Defendant was entitled to make any product to be interoperable with the Macdeck System.

232. The Claimant explains that FASET (Fall Arrest Safety Equipment Training) is a membership based industry body for temporary safety systems, such as platform safety decking. The main document relied on by the Claimant in support of its position is produced by FASET. Relevant excerpts are re-produced below:

"FASET Bulletin APD02 (Revision 1)
Cross-Contamination of Access Platform
Decking Systems
FASET recommends that under no circumstances should you mix the components of different manufacturers. If you choose to create or use a cross-contaminated system, you must be able to provide clear justifications to support your decision and ensure

that all operatives involved with the edge protection system have received sufficient training and have the appropriate user instructions available to them.

The Construction (Design and Management) Regulations 2015 (CDM) states that any person that amends a design or instructs another person to amend a design takes on design liability."

233. Following cross-examination on the subject, the issue about the interchangeability of safety arrest panels did not really appear to be about any broader industry position but rather the interchangeable use of the existing stock of the Macdeck System owned by the Defendant along with their new Q Deck product. Mr Hall explained that interoperability is "*Very important to us, as we have spent a lot of money and (unclear) amount of stock of the Macdeck board…".* It is important to the Defendant commercially that it can use the Q Deck and Macdeck panels interchangeably on construction sites, and has been doing so. The result is the Defendant has been suspended from the FASET membership. Mr Hall explained discussions are ongoing with FASET. The Defendant has carried out safety testing on the interchangeable nature of these products on sites. It believes that where this testing is accepted, FASET has confirmed it will consider re-wording its noted section set out above. From the evidence, it appears the real arguments about the use of such mixed product systems were to do with the responsibility and accountability of the party mixing components from different manufacturers. In my assessment, there is nothing in the FASET guidance or that I have been made aware of, which prevents such mixed use.

Why the Defendant developed the Q Deck Components

234. Mr Hall confirmed that on 5 March 2020, 3 months into the design process for the Q Deck panel, the Defendant was still interested in finding a way to work with the Claimant, using its moulds for the Macdeck System in a model where the Claimant charged the Defendant for the use of the moulds. This is evidence in support of the position that the real driver behind the Defendant's design process was simply to reduce cost either by coming up with its own design for a safety deck or to work on a better financial arrangement with the Claimant and to continue using its Macdeck System. There was little evidence from the Defendant of the promulgated *"...lighter and faster and easier to erect*." safety board. For example, it was accepted the weight difference between Macdeck 1x1 Panel and the Q Deck 1x1 Panel is "…*very similar. It was*

negligible…". Nothing material on this point arises out of the further details that were in the comparison table of the 20 October 2020 presentation.

235. As in any case where there are factual presumptions and shifting evidential burdens, the question of copying is a question of fact and one which must be proved by the Claimant on the balance of probabilities. By the end of the trial it did not appear disputed that the Defendant had used the Macdeck System as the starting point for its own design and had continued to refer back to the Macdeck System throughout its design process to ensure interoperability of the two designs. At the same time, the Defendant was trying to make its designs for the Q Deck Components 'different enough' to the Macdeck System such that it would avoid any design right or other intellectual property right issues. The actions of the Defendant were primarily directed at finding a way to get use of safety decking panels in a more commercially efficient model than buying these from the Claimant. This resulted in it designing a safety deck panel, the Q Deck 1x1 Panel, that was copied from the Macdeck 1x1 Panel. The considerable amount of time and effort put into its development of a new design did not alter the fact this exercise was a close copy. Such copying is only finally established when considering the second part of the infringement test. In principle, there is nothing wrong with using an earlier design to assist with creating a new design, but it comes with a risk if the differences are not enough. If the Defendant succeeded in its attempts to be 'different enough' from the Macdeck System such that the Q Deck Components were not made exactly or substantially to the Macdeck System then there would not have been copying within the meaning of s.226(2) CDPA.

Made exactly or substantially to one of the Macdeck Designs

236. To assist with this comparison, the Claimant included side by side comparison photographs of the Macdeck 1x1 Panel and the Q Deck Panel in Annex 9 of its APOC. These are a helpful and relevant aide as the Macdeck System are articles made to the Macdeck Designs. Annex 9 of the APOC has been incorporated in full at Annex 7 to this judgment. However, I will assess a direct comparison between the Macdeck Design drawings and the Q Deck Components. The Defendant takes issue with images 3, 5 8 and 9 in Annex 9 APOC (Annex 7) on the basis these pictures do not encompass the entire articles. This is a fairly technical point. However, there is no need to rely on these images and it does not impact the assessment. Below are comparison photographs from Annex 9 APOC and from other references in the case with added annotations showing the Q Deck 1x1 Panel next to a Macdeck 1x1 Panel and the top view of a Macdeck 1x1 Panel Design (Figures 20, 21 and 22), an example edge of a Q Deck 1x1 Panel above

an edge view of a Macdeck 1x1 Panel and the edge view of the Macdeck 1x1 Panel Design (Figure 23) and an annotated Macdeck Pin, Macdeck Pin Design and Q Deck Pin (Figures 24, 25 and 26 respectively). The top cropped image I prepared as part of this judgment in Figure 23 is taken from image 5 of Annex 9 APOC. This is one of the images criticised by the Defendant because it does not show the entirety of the panel. This is an image of the edge section of the Macdeck 1x1 Panel article made to the Macdeck 1x1 Panel Design. The relevant feature from the pleaded design drawing is also set out underneath this image in Figure 23. The cropped parts of the more complete image in Annex 7 is simply for convenience to convey the comparison.

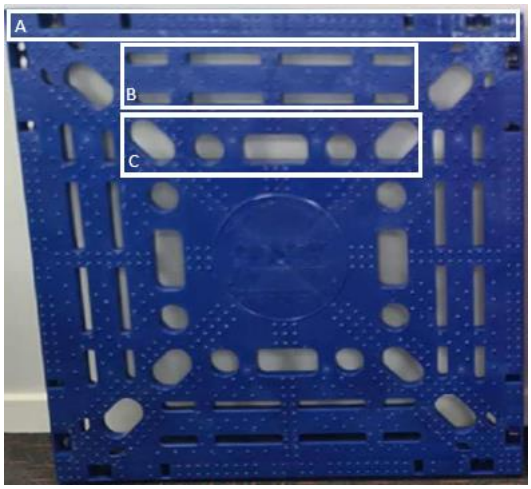


Figure 20 Q Deck 1x1 Panel

Figure 21 Macdeck 1x1 Panel

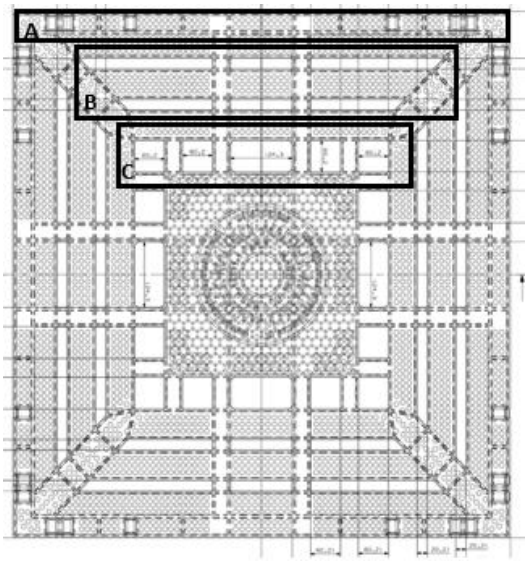


Figure 22 Macdeck 1x1 Panel Design

Figure 23 side of the Q Deck 1x1 Panel, Macdeck 1x1 Panel and Macdeck 1x1 Panel Design

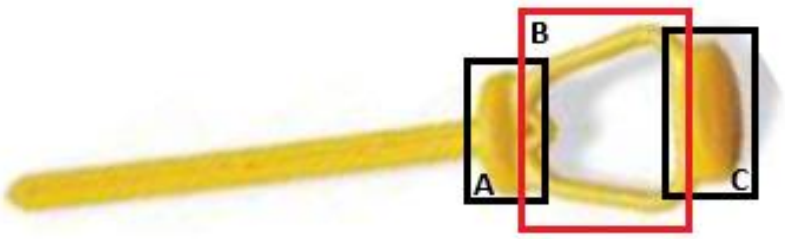


Figure 24 Macdeck Pin

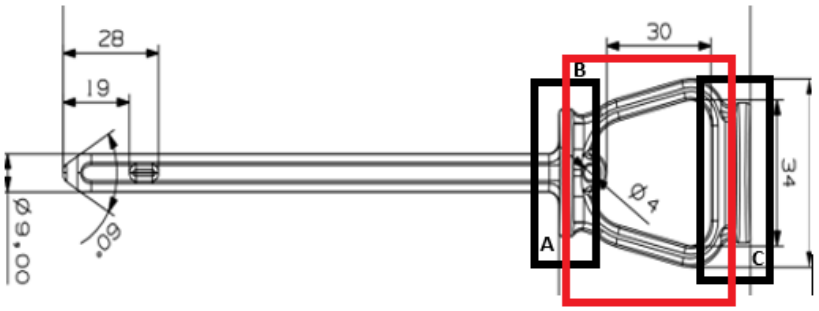


Figure 25 Macdeck Pin Design

Figure 26 Q Deck Pin

237. The Defendant has provided, both in its Defence and in a helpful table prepared by the Defendant's counsel, an item by item comparison of the Q Deck Panel Components and the Claimant's pleaded case in paragraph 9A of the APOC on the particularly significant elements of its Macdeck Designs. These provide a useful framework for the analysis of these individual features. The test to be applied is with regards to the overall designs. The Defendant raises a number of points on the images in Annex 9 of the APOC (Annex 7) generally as well and the below specific features. In my assessment I have not relied on the images or discussion on the underside of the panels. There is little evidence of any relevance on the impact of the underneath of the panels and it does not make any difference to the issues to be determined. Formally, the underneath of the panel was not part of the case at trial.

Q Deck 1x1 Panels – features referred to in paragraph 9A(i) APOC

238. I have used the framework provided for the particularly significant features in the APOC for the analysis:

9A(i)(a)

239. The Defendant admits the outer dimensions of the panels being its length, width, and height of the sides are substantially the same.

9A(i)(b) and (c)

240. This relates to square central area of the upper face of the panel that is surrounded by 16 apertures (see Annex 1). For this feature the Defendant links its admission to the level of generality of this part of the Claimant's pleadings. I have dealt with the point regarding the Claimant's pleading for its Macdeck Designs. The Defendant denies these 16 apertures are of a shape and/or position that is identical or similar to the Macdeck 1x1 Panel Design.

241. The relevant apertures on the Q Deck (see an example of one side of the central square shape annotated in Figure 20 C p97) are set out in a similar approximate square style to the Macdeck 1x1 Panel Design. The four larger hand hold apertures are about the same size as those in the Macdeck 1x1 Panel Design. However, these and the other apertures in this approximate square shape are different shapes to those in the Macdeck 1x1 Panel Design. Mr Hall describes the difference as these apertures being "*softer, rounded holes*" compared with the more "*angular*" holes in the Macdeck 1x1 Panel Design.

242. In more detail, these 16 apertures in the Macdeck Panel 1x1 Design are in a regular square shape and are symmetrical. The Q Deck 1x1 Panel also has apertures in a mostly regular square central shape of effectively the same overall size. This square shape is not as regular as in the Macdeck 1x1 Panel Design due to the impact of the oblong (pill capsule shape) apertures at each vertex of the square shape in the Q Deck 1x1 Panel. These extend outwards from the square shape (see the apertures at either end of the annotated box Figure 20 C p97). Other than these longer oblong apertures at the corners of the square shape, the dimensions of each of the apertures appear effectively the same length and width. This includes the longer sizes of the 4 hand hold apertures relative to the 8 smaller adjacent circular apertures. All the apertures (including the pill capsule shaped ones at the vertices) are spaced in the same manner around this square shape as in the MacDeck 1x1Panel Design. However, the shapes of these apertures in the Q Deck 1x1 Panel differ from the Macdeck 1x1 Panel Design. The Macdeck 1x1 Panel Design apertures are regular squares or (for the 4 larger hand hold apertures) rectangles with slightly rounded corners. The Q Deck 1x1 Panel apertures are circles where the

Macdeck 1x1 Panel Design has squares and a rectangle shape but with more rounded corners in the 4 longer hand hold apertures.

9A(i)(d)

243. The Defendant accepts the Q Deck 1x1 Panel contains narrow slot-shaped apertures in concentric pairs in between the central square shape and the perimeter of the panel (see an example row in Figure 20 B p97). These slot-shaped apertures look to have the same width, contain the same 4 fold symmetry in both designs and similar spacing between the slot-shaped apertures in each of the two concentric rows along each edge. Also, the spacing between the two concentric rows is the same and the locations of the spacing between the slot-shaped apertures within each line are such that the spaces match between each concentric set of slot-shaped apertures. However, the Macdeck 1x1 Panel Design 'completes' more of a square shape with the two concentric lines of slot-shaped than the Q Deck 1x1 Panel. The number of shapes in each of the two concentric lines are different, 3 in the Macdeck 1x1 Panel Design and 4 in the Q Deck. The lengths of these slots and the consequential pattern of those lengths in the sequence of the slot-shaped apertures also differs with the Macdeck 1x1 Panel Design. Other than the ends of the slot-shaped apertures facing the vertices of these concentric square shapes, the shape of the slot-shaped apertures in the Q Deck 1x1 Panel are also regular quadrilaterals with 90 degree corners. Towards the vertices of the concentric square shape the Macdeck 1x1 Panel Design has a tapered straight edge which follows the line of the diagonal from the corner of the central square to the corner of the perimeter. In the same position, the Q Deck Panel has a rounded edge.

244. The Q Deck 1x1 Panel interrupts this square shape of the concentric slot-shaped apertures at each vertex with a second oblong aperture. This oblong is the same size and shape as the one that partly interrupts the central square shape at its vertices. The two oblong apertures extend in a straight line end to end (with spacing) from and incorporating the vertices of the central square towards the corner of the panel. The Macdeck 1x1 Panel Design also has a feature of a solid 'arm' rather than interspersed oblong apertures that extends from the corners of the central square to the perimeter in the same line as that line created by the Q Deck oblong apertures. As with all the shapes this is repeated in a 4 fold symmetry (the same 4 fold symmetry as the Macdeck 1x1 Panel Design).

9A(i)(e)

245. The Defendant admits the shape and positioning of the 16 rectangular apertures around the perimeter of the upper face of the Q Deck 1x1 Panel (example row in Figure 20 A p97) is substantially similar to those identified in 9A(i)(e) for the Macdeck 1x1 Panel Design.

9A(i)(f)

246. The Defendant admits a raised profiled pattern on the surface of the upper face of the panel in the same general terms referenced in paragraph 9A(i)(f) APOC. However, the APOC reference is also tied specifically to the related drawing of the design at Annex 1. That is, a close packed design on the surface where most of the raised pattern (bumps) is in groups making up mainly shapes of spaced rectangles of 3 rows (sometimes 2 rows) of varying lengths. The spacing between the individual raised bumps in each 'shape' and between the rows of these bumps is regular except at some of the joins (for example changes in direction) and more irregular spaces. The spacing between the individual raised bumps on the Q Deck 1x1 Panel varies depending on location on the panel, as does the spacing between the parallel lines of raised bumps. The raised bumps form some regular shaped rectangles and squares with two rows in a similar layout to elements of the Macdeck 1x1 Panel Design but, even there, the spacing is less dense than the Macdeck 1x1 Panel Design. Overall, the spacing and shape of the raised bumps across the Q Deck 1x1 Panel (which also maintains 4 fold symmetry) has considerable differences to the Macdeck 1x1 Panel Design, although the raised bumps are of similar size in each design and contain the noted similarities in some elements of the pattern.

9A(i)(g)

247. The Defendant admits the rounded arch shaped slots in the sides of the Q Deck 1x1 Panel are in substantially the same position as those referred to in 9A(i)(g). It does not accept these shapes are identical or highly similar. The edges of these arch shaped apertures leading to the bottom edge of the panel are tapered outwards slightly compared to the straight vertical lines of the arch shape in the Macdeck 1x1 Panel Perimeter Design.

Assessment

248. In considering whether the Q Deck 1x1 Panel retains features which are made exactly or substantially to the Macdeck 1x1 Panel Design I have considered the quantitative

and qualitative aspects of the differences as well as the similarities. There are a number of similarities with the Macdeck 1x1 Panel Design contained in the Q Deck 1x1 Panel, including; the outer dimensions of the panels, the 4 fold symmetry maintained in the panel, the central square shaped area of the upper face formed by the 8 circular, 4 hand hold and 4 pill capsule shaped corner apertures, the dimensions and shaping of most of these 16 apertures, the parallel rows of the narrow slot-shaped apertures in the outer concentric square shape, the configuration and elements of the dimensions and shape of these outer concentric square shape apertures, elements of some of the shaped groupings of the raised profile pattern, the shape and positioning of the 16 rectangular apertures around the perimeter of the upper face and the positioning and shape of the rounded arch shaped slots in the side of the panel. Together these form a significant portion of the overall panel and work together to create the various internal square shapes from the configurations.

249. The Defendant was keen to describe the different underlying internal shape in the form of the 'Union Jack' feel of their Q Deck 1x1 Panel – the superimposed cross and diagonal cross. There is (with some effort) such an image – or at least a more definitive image of a diagonal cross created by the additional oblong apertures and the directions of the parallel lines of the surface bumps to draw the eye to these two crosses. This is not nearly as apparent in the Macdeck 1x1 Panel Design, due largely to the absence of the additional oblong apertures in the diagonal cross. The raised surface bumps in the Macdeck 1x1 Panel Design are also not directed to draw the eye to these diagonal lines but are more evenly distributed to more optimally fill the available space on the surface of the panel. The Q Deck 1x1 Panel also has additional small apertures (diamond shaped) in a repeating pattern towards the perimeter (slightly above and the left and right of the pill capsule shaped apertures closest to the perimeter.

250. The curved nature of the apertures on the central square shape of the Q Deck 1x1 Panel create a softer and altered look as there are no quadrilateral 90 degree angled apertures. The apertures on the central square shape with the closest approximation to the Macdeck 1x1 Panel Design being the oblong hand holds. The groupings of two circles and the curved shape at the end of the oblong handle apertures disrupt the central square shape and create a softer image. The same happens on the ends of the slot-shaped narrow slot apertures closest to the diagonals – these have a rounded end. However, the rest of these slot-apertures are angular in a similar pattern to the Macdeck 1x1 Panel Design despite the total numbers of apertures being different.

251. The different panels are both pieces of engineering and safety equipment. The dimensions are important – not least for the functional requirements of tessellation at installation and consistency to ensure the scaffolding fits in the appropriate scheme for the site. However, on the evidence, this is not a case where any detailed, non-visible differences in sizing are material. The Q Deck 1x1 Panel was carefully designed to ensure the scaffolding can fit in the same way as a Macdeck 1x1 Panel Design but its design created additional flexibility within the system for construction of scaffolding through the panel with the oblong pill capsule shaped apertures on the diagonals.

252. The nature of these designs and articles means there are not really any specific features that are particularly attractive or offer a distinction as part of any eye appeal. Many of the similarities in the features come from their functional nature. The visual cues of the frame of the panels are similar. At that level of generality there are other similar shaped panels on the market (such as the TRAD Deck). These considerations of the similarities and differences (both qualitative and quantitative) of the significant features are a useful aid to the actual assessment, which is conducted objectively on the overall design from the perspective of a relevant person the design is directed towards. That person is a user of safety decking. If that person was from a broader group, such as also being involved in the manufacture of such panels, that would not affect the assessment or outcome.

253. The Macdeck 1x1 Panel Design covers the whole of the upper surface and sides of a panel. In my view here, the objective observer considering the Q Deck Panel would have been drawn to the functional and stylistic differences in the overall shape and configuration to the Macdeck 1x1 Panel Design more than the similarities. For example, the different number and shapes of the rounded apertures, the cross diagonals created by the large oblong (pill capsule shaped) apertures, the more dispersed and less regular look of the surface bumps. Combined, visually these changes contribute to a different overall appearance compared with the Macdeck 1x1 Panel Design. These differences are not in the quantitative majority. The majority of similarities are relevant to the functions required of the panel and, although important to the objective observer, would not have the same impact as the appearance of the additional functionality and different shapes and configuration in the Q Deck 1x1 Panel.

254. In my assessment, taking all the features of the two designs into account, I take the view that, considering the designs as a whole, the Q Deck 1x1 Panel is not made exactly or substantially to design of the Macdeck 1x1 Panel Design. Where, in addition the features already excluded from this consideration, the 12 or 16 (including the hand-

hold apertures) apertures in the central square shape of the Macdeck 1x1 Panel Design were excluded and/or the rounded side arch apertures were excluded in the alternative, these changes would not alter my assessment of the observer's view due to the impact of the combination of the shape and configuration of the remaining features noted. This is a case where there was extensive copying, but on this occasion the attempts by the Defendant to try to create a design on the 'right side of the line' were successful. Therefore, there was no copying in the sense that the Q Deck 1x1 Panel was not produced such that it was made exactly or substantially to the Macdeck 1x1 Panel Design.

255. The Macdeck 1x1 Panel is an article made to the Macdeck Designs. In this context, the Defendant's copying is indirect regarding the Macdeck 1x1 Panel. Nothing turns on this point. The Defendant also acknowledged this indirect copying is still copying within the meaning of the Act, but only to the extent the Macdeck System is made to the Macdeck Designs.

Q Deck 0.75x1 Panels

256. The same positions set out in relation to copying regarding the Macdeck 1x1 Panel Design apply equally to the Macdeck 0.75x1 Panel Design. There will be differences in the actual shape as the panels being compared here have 2 fold symmetry. They are effectively proportionately 'squashed' versions of the larger panel. The Defendant pleads all the same points *mutatis mutandis* as are set out in relation to the Q Deck 1x1 Panels in paragraph 7(16) of its Defence where it repeats subparagraphs (7)-(13). It does not specifically repeat subparagraph 7(14) of the Defence again (this dealt with the 9A(i)(g) APOC feature). If paragraph 7(14) had been so repeated it would not have altered my assessment or determination on the issue. The parties agreed all the points on the Macdeck 1x1 Panel Design as being the same for the Macdeck 0.75x1 Panel Design. My conclusion is therefore the same as for the Macdeck 1x1 Panel Design – the Q Deck 0.75x1 Panel does not infringe as the Defendant did not copy the design such that it was made exactly or substantially to the Macdeck 0.75x1 Panel Design .

Q Deck 1x1 Panel - perimeter

257. The below analysis again follows the framework of the pleaded particularly significant features. The Defence to the allegations of infringement of the Macdeck 1x1 Panel Perimeter Design repeats the positions dealt with for the Macdeck 1x1 Panel Design at paragraph 7(15) incorporating subparagraphs (7), (11), (12) and (13). I mention this as

the Defence to the Macdeck 1x1 Panel Perimeter Design does not appear to specifically repeat its pleaded position in subparagraph 7(14) (this dealt with the 9A(i)(g) APOC feature) which deals with the rounded slots in the side of the Q Deck and which are alleged to infringe as part of the Macdeck Panel Perimeter 1x1 Design. It also expressly incorporates paragraph 7(11) of the Defence, which deals with the concentric square's narrow slot-shaped apertures. This does not form part of the Macdeck 1x1 Panel Perimeter Design. Regardless, the Defendant's positions on the additional points in subparagraph 7(14) were argued by both parties in relation to the Macdeck 1x1 Panel Design and were understood to be in dispute *mutatis mutandis* for the relevant parts of the Macdeck 1x1 Panel Perimeter Design as part of the Macdeck 1x1 Panel Design. I have therefore also considered that paragraph 7(14) of the Defence was also repeated here within my analysis. If I am wrong about that and the Defendant did not repeat its pleaded position in paragraph 7(14) in relation to infringement of the Q Deck 1x1 Panel features relevant to paragraph 9A(ii) APOC (the Macdeck 1x1 Panel Perimeter Design) my analyses covers either scenario.

258. The similarities in relation to the relevant part of the Q Deck 1x1 Panel are such that it was not possible for the Defendant to identify many differences beyond some comments about minor dimensional differences that are difficult to see. The main differences worth mentioning are; (1) the less dense, but mainly regular and parallel raised profile pattern around the perimeter of the Q Deck 1x1 Panel and (2) the rounded arch shaped apertures on the side of the panel – the edges of these arch shaped apertures leading to the bottom edge of the panel are tapered out slightly compared to the straight vertical lines of the arch shape in the Macdeck 1x1 Panel Perimeter Design. In my assessment these differences are minor in quality such that they would be immaterial to the objective assessment of the noted observer in this context. They would view the relevant part of the Q Deck 1x1 Panel design as being made substantially to the Macdeck 1x1 Panel Perimeter Design. Overall, considering the Macdeck 1x1 Panel Perimeter Design part of the design as a whole, the Defendant copied this design such that the relevant part of the Q Deck 1x1 Panel was made exactly or substantially to the Macdeck 1x1 Panel Perimeter Design.

259. Alternatively, where the rounded arch shaped slot apertures on the side of the panel were excluded, in my view the remaining features noted would still lead the reasonable observer to conclude the remaining contiguous features on the surface part of the panel, considered together, provided a sufficiently similar shape and configuration such that

the relevant part of the Q Deck 1x1 Panel was made substantially to the Macdeck 1x1 Panel Perimeter Design.

Q Deck Pin

260. I determined that once the exclusions have been removed from consideration, what is left of the Macdeck Pin Design is not a pleaded design within the meaning of s.213(2) CDPA. No decision is therefore required regarding infringement. However, where I am wrong on that point, I have set out my analysis on the basis what remained was a design within the meaning of s.213(2) CDPA.

261. The Defendant denies the head of the Q Deck Pins are identical or highly similar to the Macdeck Pin Design. That is the part with the two disc shapes either side of a rounded trapezoid aperture, which is wider at the end furthest from the point of the shaft of the pin. The reason is because the shape of the head of its pins is more angular. The Defendant accepts its pin has a groove running down the length of the shaft but that is excluded matter.

262. This is a simple design. The two disc shapes (Figure 26 A and C p99) are in essentially similar positions, orientation and thickness. The observer would not pay significant attention to this functional feature, albeit the feature is very similar in each design. Looking at the relevant part of the pin which is not excluded, as a whole, the observer would be drawn to the trapezoid shape at the top of the pin. Both trapezoid designs have parallel top (furthest from the pointed end) and base (where the two arms of the trapezoid meet the pin/disc boundary) within the trapezoid shape. In both, the top is longer than the base. The width of the top and the bottom of the trapezoid shape would appear similar in size to the observer. Both designs also have a small bump with a hole through it on the base between the joining arms on the trapezoid shape. The difference is that the top of the trapezoid shape in the Q Deck Pin (see Figure 26 B p99) appears slightly further away from the base than in the Macdeck Pin. This creates a trapezoid with slightly larger angles between the top and each of the arms leading to the base. The symmetry for both designs is maintained. This difference gives the Q Deck trapezoid a slightly elongated feel compared to the Macdeck. The Defendant refers to the Q Deck trapezoid shape as being like an isosceles triangle and the other an equilateral triangle. These are helpful to approach the concept of the elongation but otherwise there is no similarity to triangles here. The overall shape, proportions and dimensions are almost identical. In my assessment, looking at all the features of these pin designs as a whole but excluding the parts noted where design right does not subsist,

the objective observer would view the Q Deck pin as being copied indirectly from the Macdeck Pin Design and constitutes an article made exactly or substantially to that design.

Issue 9

Whether the Defendant knew or had reason to believe each of the Q Deck Components in issue was an infringing article

263. In closing, the Defendant's counsel accepted that where the conclusion was the Q Deck Components are infringing articles under s.226 CDPA, the Defendant did not dispute knowledge under s.227 and s.228 CDPA. The evidence on this issue showed the Defendant was aware of all the relevant facts and would have been strongly in favour of finding the requisite knowledge from the Defendant's awareness of the Macdeck System and the potential design right issues. The Defendants therefore knew or had reason to believe the Q Deck Components were infringing copies of the Macdeck System. Any belief held by the Defendant had been the 'right side of the line' would not alter the position that the Defendant had the knowledge or reason to believe under s.227 CDPA. The Defendant alleges that it has a further distinct position on infringement by the Q Deck Panel with regards to the Macdeck Panel Perimeter Design. This is on the basis it had no knowledge or reason to believe that design right subsisted in that design. I have determined design right does exist in that design. A mistaken belief of the Defendant that there was no enforceable design here does not deprive the Defendant of knowledge (see [88] point 8 in *Action Storage*). As mentioned in paragraph 9 of this judgment, any issues of innocent infringement due to the later introduction of the Macdeck 1x1 Panel Perimeter Design in the case will be dealt with at any subsequent damages inquiry. Therefore, the acts of primary infringement by the Defendant led to acts of secondary infringement.

Conclusion

264. In summary my decisions on the case are therefore:

(i) The Claimant has succeeded in its claim that the Macdeck 1x1 Panel Perimeter Design is infringed under primary and secondary infringement by the Q Deck 1x1 Panel.

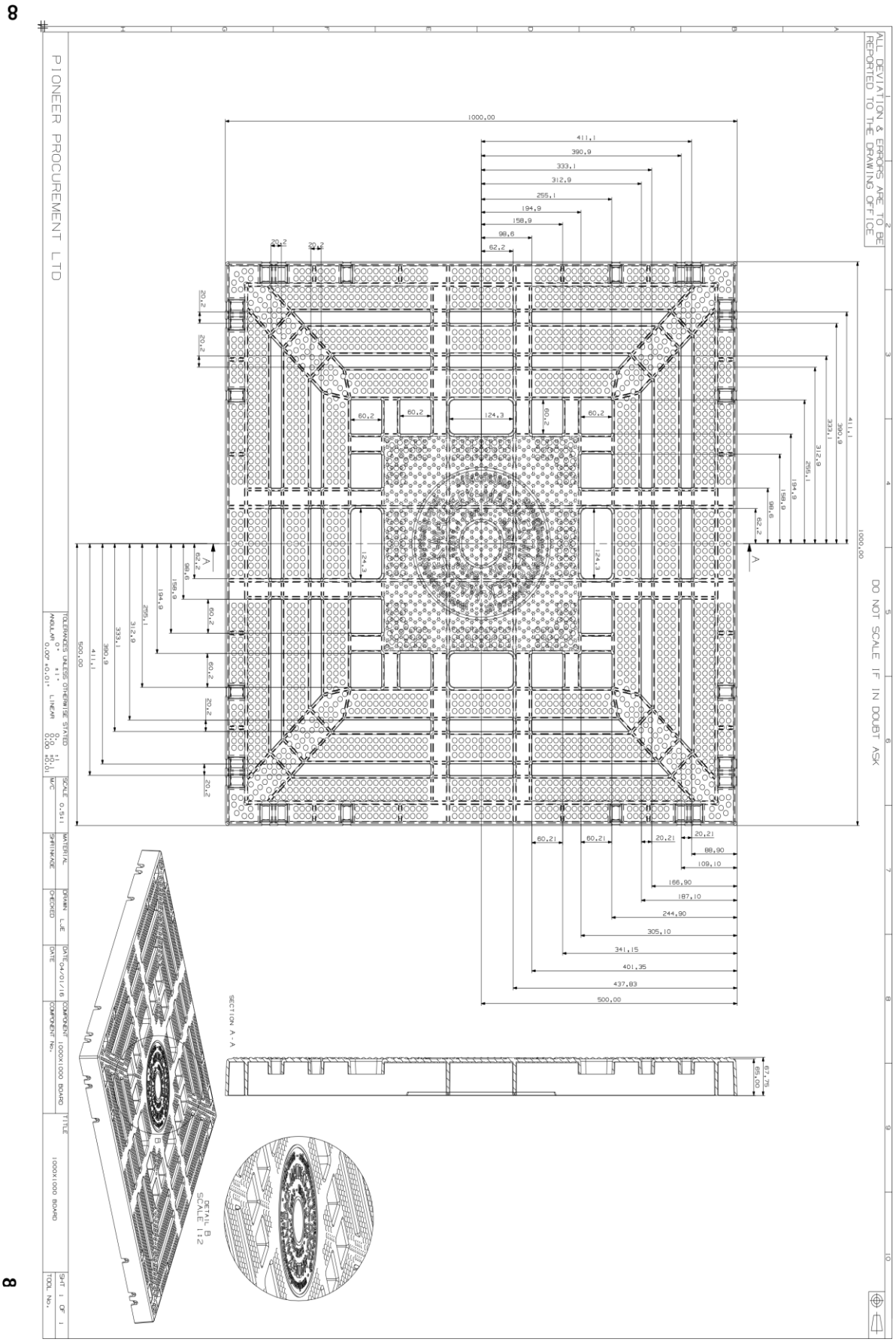
(ii) The Claimant did not establish primary or secondary infringement of the Macdeck 1x1 Panel Design (and therefore also the Macdeck 0.75x1 Panel Design) or the Macdeck Pin Design by any of the Q Deck Components.

(iii) The Macdeck System was made available for sale or hire during 2016. The calculation of the duration of the 10 years of protection under s.216(1)(b) and s.216(2) CDPA runs from 2016.

(iv) The Claimant's claim for passing off succeeds. The Defendant submits to judgment on the basis of its pleaded case. Submissions on any inquiry as to damages can be dealt with at any form of order hearing

265. I will hear Counsel as to the form of Order if it cannot be agreed. I direct that time for seeking permission to appeal shall not run until after the hearing on the form of Order (or the making of such Order if it is agreed).

Annex 1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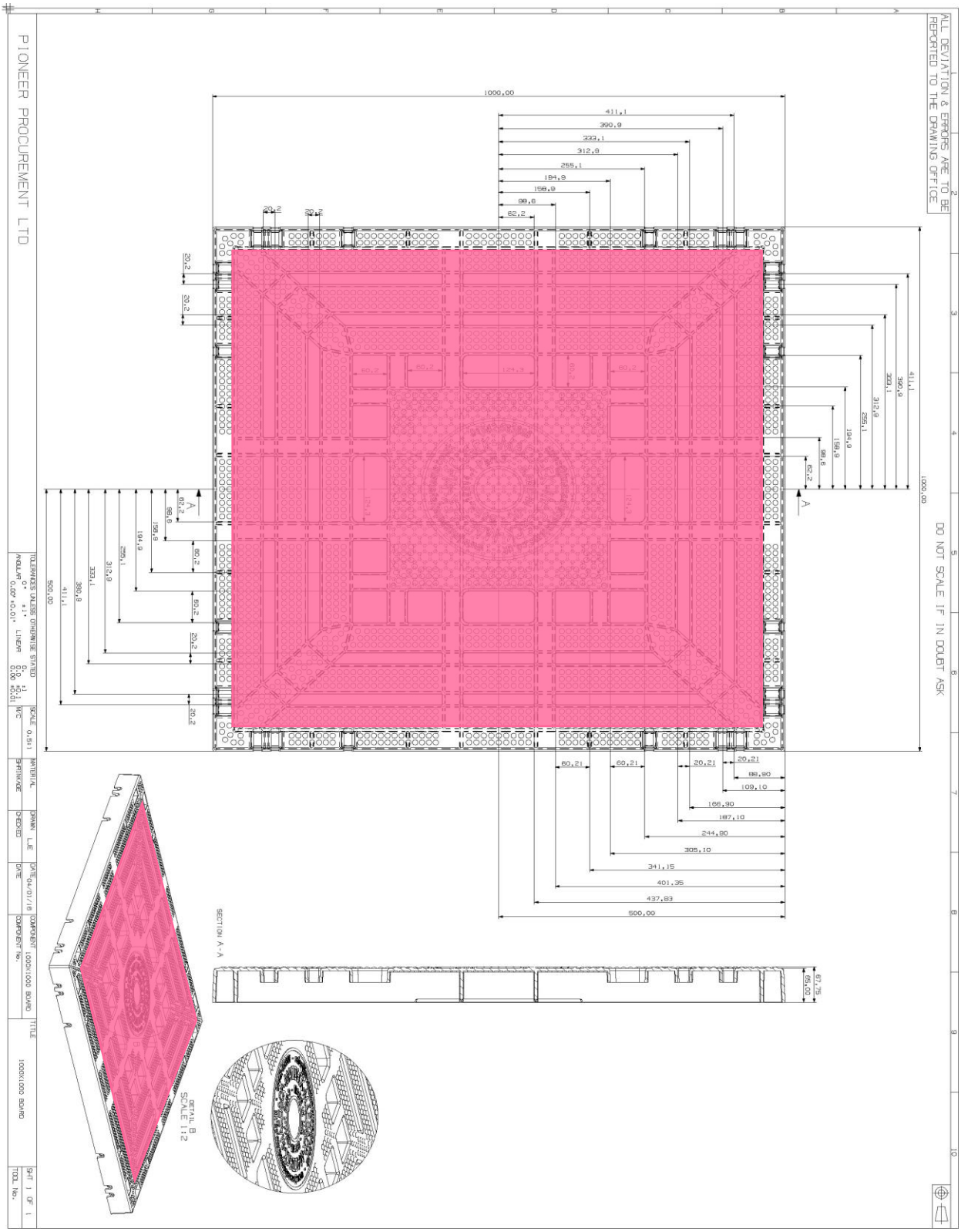
Annex 2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Annex 3

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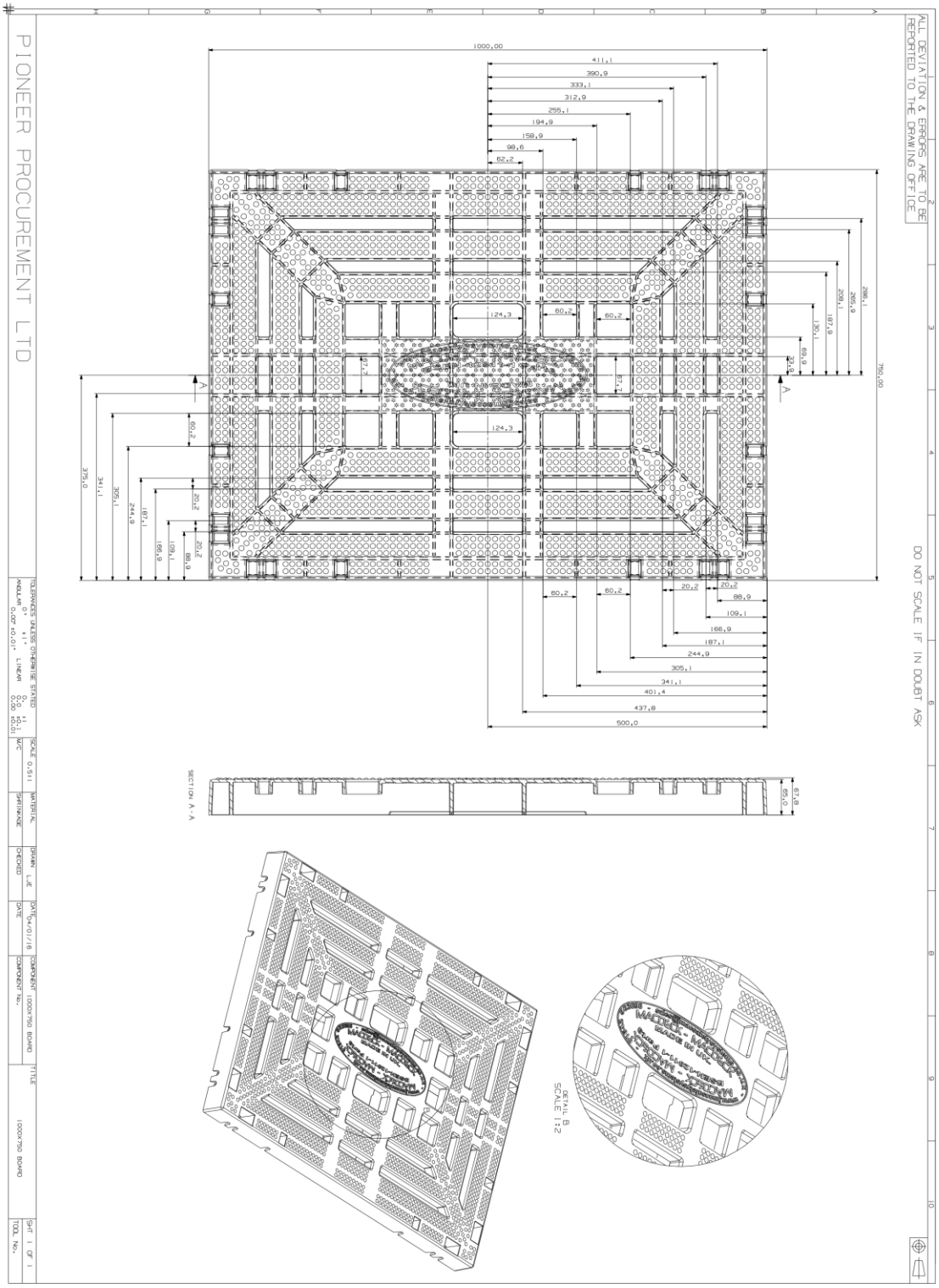
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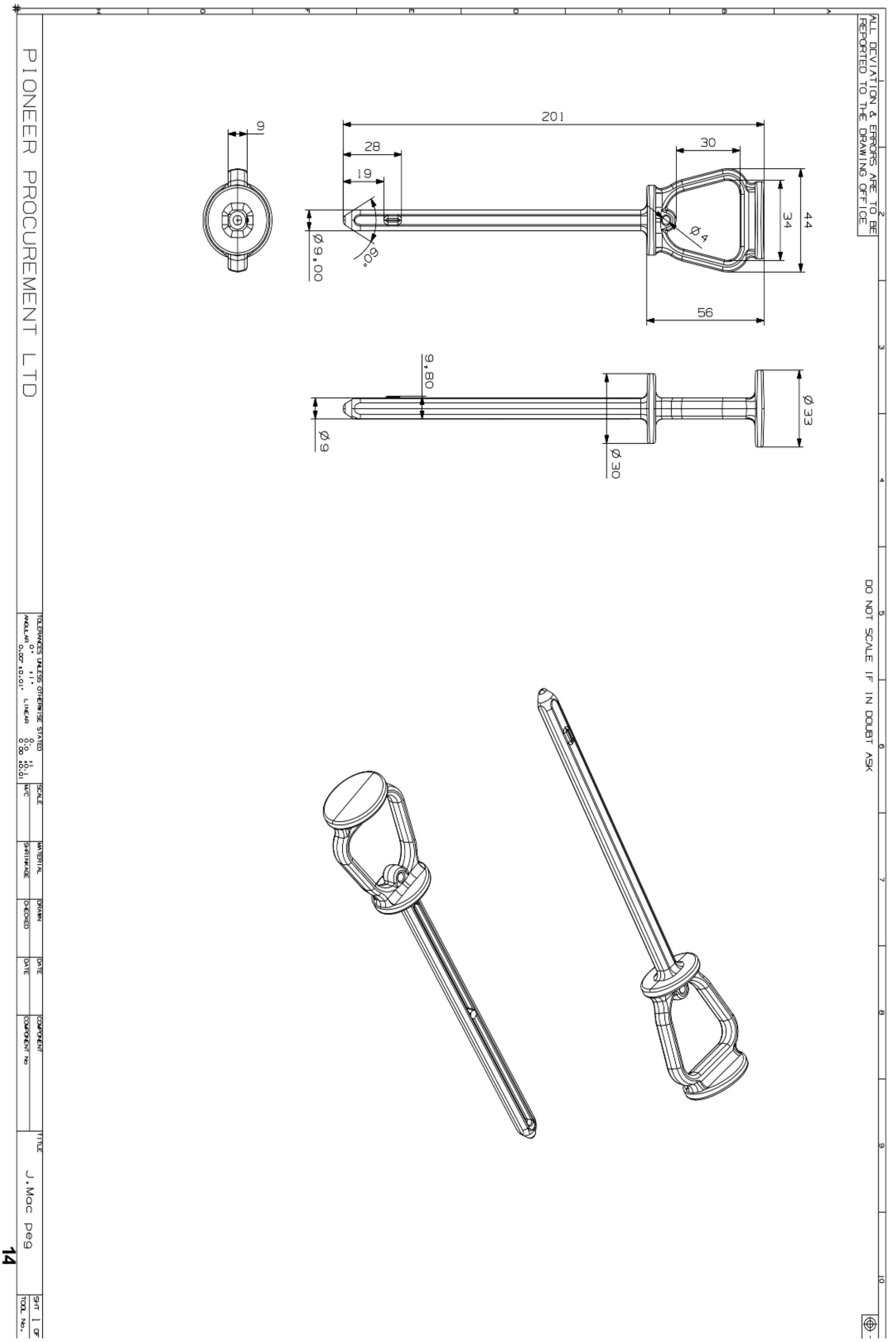
Annex 4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Annex 5

9A. The Claimant relies on the following features of the Macdeck Designs as being particularly significant:

(i) In respect of the Macdeck 1x1 Panel Design:

(a) The outer dimensions of the panel: that is, the length and width of the upper face and the height of the sides.

(b) A square central area of the upper face of the panel that is surrounded by 16 apertures, and which contains a circular space for application of a logo.

(c) The shape and positioning of the 16 apertures that surround the central square area of the upper face of the panel.

(d) The presence of narrow slot-shaped apertures arranged in two concentric squares in between the central square area of the upper face of the panel and the perimeter.

(e) The shape and positioning of the 16 rectangular apertures around the perimeter of the upper face of the panel.

(f) The presence of a raised profiled pattern on the surface of the upper face of the panel.

(g) The shape and positioning of the rounded slots in the sides of the panel.

(ii) In respect of the Macdeck 1x1 Panel Perimeter Design:

(a) The outer dimensions of the panel: that is, the length and width of the upper face and the height of the sides.

(b) The shape and positioning of the 16 rectangular apertures around the perimeter of the upper face of the panel.

(c) The presence of multiple small circular bumps on the surface of the outer section of the upper face of the panel.

(d) The shape and positioning of the rounded slots in the sides of the panel.

(iii) In respect of the Macdeck 0.75x1 Panel Design:

(a) The outer dimensions of the panel: that is, the length and width of the upper face and the height of the sides.

(b) A rectangular central area of the upper face of the panel that is surrounded by 12 apertures, and which contains an oval-shaped space for application of a logo.

(c) The shape and positioning of the 12 apertures that surround the central rectangular area of the upper face of the panel.

(d) The presence of narrow slot-shaped apertures arranged in two concentric rectangles in between the central rectangular area of the upper face of the panel and the perimeter.

(e) The shape and positioning of the 16 rectangular apertures around the perimeter of the upper face of the panel.

(f) The presence of a raised profiled pattern on the surface of the upper face of the panel.

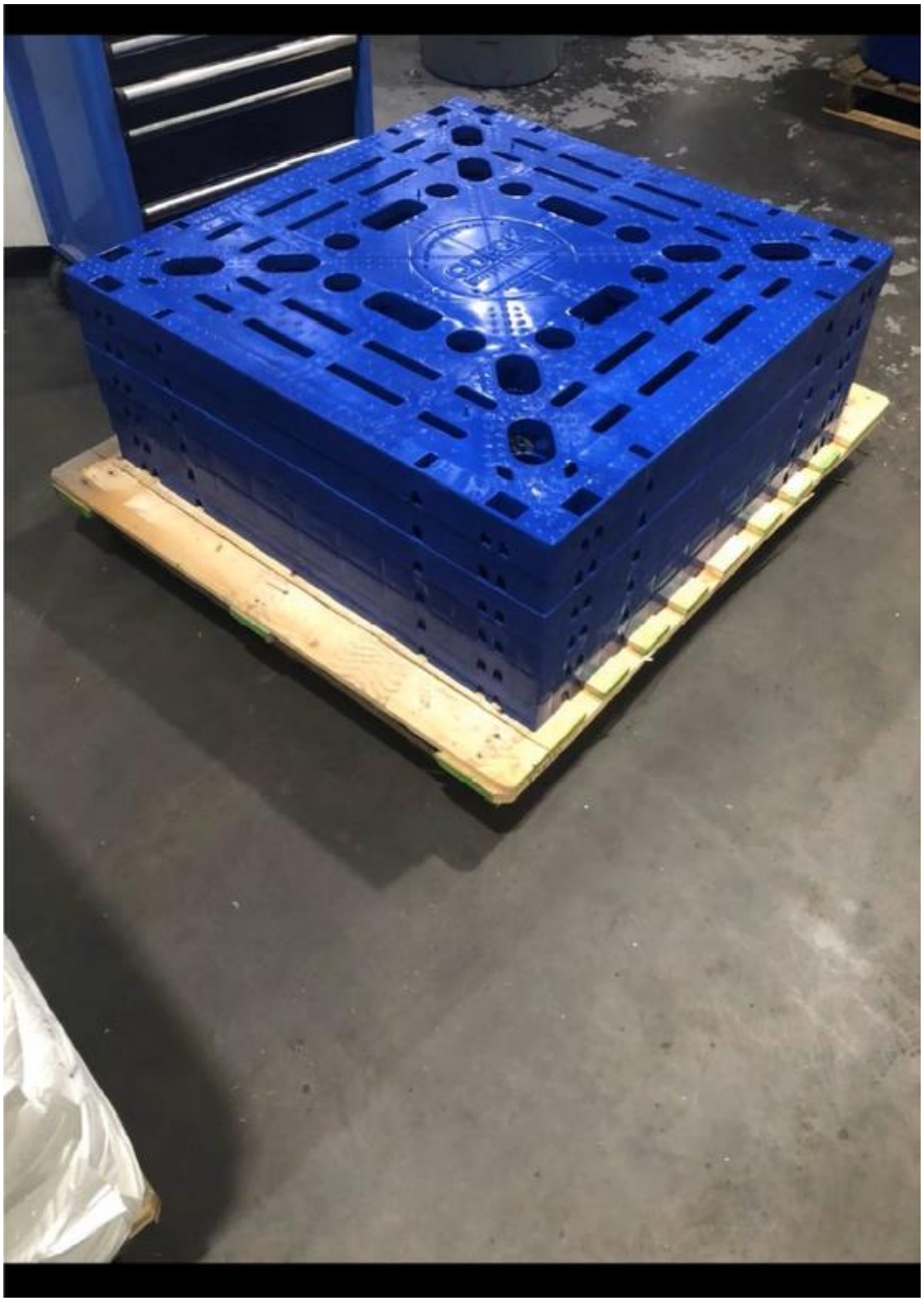
(g) The shape and positioning of the rounded slots in the sides of the panel.

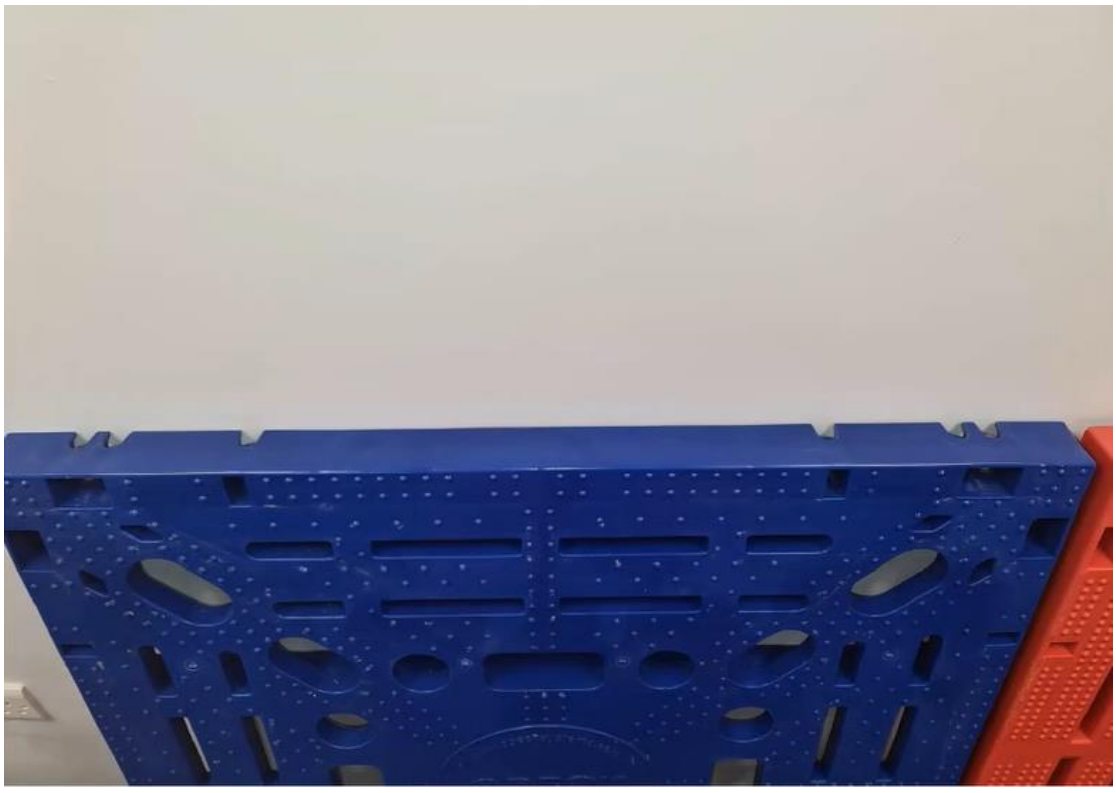
(iv) In respect of the Macdeck Pin Design:

(a) The shape of the head of the pin, which comprises two disc shapes either side of a rounded trapezoid aperture that is wider at the end furthers from the shaft of the pin.

(b) The shape of the shaft of the pin, which comprises a groove running down the length of the shaft and a point at the end.

Annex 6





Annex 7