



The Trunki registered Community Design

Design Protection – black and white, or a bit of a grey area?

In a recent appeal court judgement, it was decided that the makers of the Kiddee Case, PMS International, did not infringe the registered Community design held by Magmatic for their Trunki, thereby reversing the decision of Hon. Mr Justice Arnold in the High Court from July 2013.

Magmatic Ltd vs PMS International

Magmatic Ltd sell a children's ride-on suitcase called a Trunki.

PMS International sell a children's ride-on suitcase called a Kiddee Case.

In a recent appeal court judgement, it was decided that the makers of the Kiddee Case, PMS International, did not infringe the registered Community design held by Magmatic for their Trunki, thereby reversing the decision of Hon. Mr Justice Arnold in the High Court from July 2013.

The appeal decision rested on the interpretation of the **greyscale drawings** filed by Magmatic and that whilst a particular colour is not shown, "a distinct contrast in colour between the wheels... the strap... and the rest of the suitcase" is shown, and that this contrast should be taken into consideration when assessing the overall impression.

Background

Despite an unsuccessful appearance on **Dragon's Den**, Trunkis have been rolling off the production line and around airports, train stations and many glamorous (and

probably a few unglamorous) holiday destinations in great number - each with a very happy owner on the back.

PMS International saw this success and produced their (slightly cheaper) version, the Kiddee Case.

Magmatic claimed for infringement of their registered Community design, their unregistered UK design, and their copyright in the Trunki case and its accessories.

At first instance, the Kiddee Case was held to infringe Magmatic's registered Community design, but following a recent appeal by PMS, this decision was reversed.

The Law

A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. Use covers the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated.¹

¹ Art 19 (1) of the Community Design Directive



A Kiddee Case made by PMS International

Various other Kiddee Cases



The scope of the protection conferred by a Community design includes any design which does not produce on the informed user a **different overall impression**.²

The original High Court decision³

Obscure disclosure

At first instance, PMS claimed the Magmatic registered Community design was invalid because Robert Law, a designer of the Trunki, had disclosed a similar design called a 'Rodeo' at a student design competition in 1998. Robert Law won the competition and received an award at a public ceremony attended by a small group of people.

Magmatic argued that the disclosure was obscure and so fell under the following exemption:

"[the disclosure] could not reasonably have become known in the normal course of business to the circuits specialised in the sector concerned, operating within the Community".

The Hon. Mr Justice Arnold disagreed and stated that the intention of the obscure disclosures provision was to counter the growing trend that sellers of counterfeit products often obtained false certification stating that the disputed design had already been created in a third country.

It was reasonable that someone in the luggage trade could have attended the public ceremony because the theme of the competition that year was luggage design. Whether they actually attended was not relevant. The obscure disclosures exemption was therefore deemed not to apply. The registered Community design was, however, declared new with sufficient individual character over the Rodeo disclosure.

Greyscale vs line drawings

Designs filed in black and white cover all colours and combinations of colour. However, the Trunki design (shown above) was filed in greyscale.

² Art 10 (1) of the Community Design Directive

³ <http://www.bailii.org/ew/cases/EWHC/Patents/2013/1925.html>

PMS argued that, as a result, the design right only covered products with similar grey shading – their brightly-coloured Kiddee Cases were therefore not infringing.

The Hon. Mr Justice Arnold ruled that the Trunki design encompassed all colours. However, PMS were given leave to appeal that point, and the result of that appeal is discussed in more detail below.

Surface decoration

PMS asserted that the graphical design on their case should be taken into consideration when assessing the overall impression the case creates. The Hon. Mr Justice Arnold disagreed and declared that the registered Community design was clearly for the shape of the case, and so the shapes alone should be compared.

The Court of Appeal judgement⁴

The Court of Appeal found that Hon. Mr Justice Arnold failed to appreciate two things:

that the registered Community design is a design for a suitcase which, considered as a whole, looks like a horned animal; and

although the registered Community design representations were monochrome (as shown above) meaning that the design was not limited to particular colours, and thus PMS could not point to the colour of the Kiddee Case as being a point of distinction, nevertheless each of the representations **showed a distinct contrast in colour** between the wheels and the strap, and the rest of the suitcase.

The wheels and straps of the PMS Kiddee Cases were the same colour as the rest of the structure.

Furthermore, the judge, Kitchen LJ, added that "...the overall impression created by the Trunki registered design is that of a horned animal. It is a sleek and stylised design and, from the side, has a generally symmetrical appearance with a significant cut away semicircle below the ridge. By contrast the design of the Kiddee Case is softer and more rounded and evocative of an insect with

⁴ <http://www.bailii.org/ew/cases/EWCA/Civ/2014/181.html>

antennae or an animal with floppy ears. At both a general and a detailed level the Kiddee Case conveys a very different impression.”

The Kiddee Cases did not, therefore, infringe the registered Community design held by Magmatic Ltd for the Trunki.

Comment

The clarity this decision provides is welcomed because the UK Parliament is about to introduce criminal penalties for infringement that consists of copying of a registered design.

The decision reinforces the conclusion that the scope of protection provided by a registered design is determined from the representations in the registration.

The Court of Appeal confirmed that designs filed in black and white cover all colours and combinations of colour.

Greyscale representations also cover all colours and combinations of colour, but the contrasts and differences in shading represent contrasting colours which contribute to the overall impression.

Where possible, the representations used in a registered design should, therefore, always be black and white line drawings.



A representation from the Magmatic registered Community design, a Trunki and a Kiddee Case

How A.A. Thornton & Co. can help

If you would like further information regarding the above then please contact one of our patent attorneys.

At A.A. Thornton & Co. our patent and trade mark attorneys are qualified to provide advice on all aspects of design law. Our services include:

- Initial advice concerning the most appropriate form of design protection
- The procurement of registered design protection
- General advice regarding Registered Design filing strategies
- Preparation of Registered Design applications
- Filing all necessary papers at the Designs Registry
- Handling objections raised by the Designs Registry
- Advice and assistance in relation to infringements and attacks on validity
- Advice on licensing and assignment of designs
- Advice on ownership of designs
- Liaising with barristers and solicitors in the conduct of litigation
- Conducting investigations to determine the registration potential of designs and any risk of infringing third-party patent right

Contact

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