

Trunki – A Designer’s Case



Magmatic Limited (Appellant) v PMS International Limited (Respondent)

9 March 2016 [2016] UKSC 12

The Supreme Court has upheld the judgment of the Court of Appeal - [2014] EWCA Civ 181 - which overturned Arnold J’s finding of infringement of Magmatic’s registered Community design (“RCD”) at first instance - [2013] EWHC 1925 (Pat). Arnold J’s finding of infringement of UK design right was not the subject of appeal.

Magmatic manufacture and sell the well-known Trunki children’s ride on suitcase. The RCD in issue was a grey-scale CAD drawing of a Trunki. The contours were represented by different shades of grey. The wheels, the strap and a central rubber strip were shown in a darker shade.

The case was of interest to practitioners as it raised the question of how a court should interpret computer generated design drawings used in registered design drawings. Was the RCD in respect of the shape of the Trunki alone? Or was it for the shape of the article, but with a positive absence of surface decoration, since none was shown on the drawings? And what was the effect of showing the wheels and the strap in a darker shade? While the Supreme Court has given some guidance, it did not decide whether the RCD in question was one which included, as a feature, a positive absence of surface decoration.

At first instance Arnold J held that the RCD was for shape alone. This meant that colours, colour contrasts and surface decoration on the alleged infringements should be ignored. He found that the Trunki was a substantial departure from the design corpus existing at the date of application for the RCD, and that as a result it should have a wide scope of protection. He noted differences and similarities between the RCD and the Kiddee Cases imported by the defendant PMS. He held that given the wide scope of protection to be afforded to the RCD, the Kiddee Cases produced the same overall impression.

In the Court of Appeal Kitchen LJ identified 2 errors of principle in the judgment of Arnold J. The Supreme Court said that it was convenient to treat them as 3 criticisms as follows: (1) that Arnold J had failed to give proper weight to the overall impression of the RCD as an animal with horns (2) that the judge failed to take into account the effect of the lack of ornamentation on the surface of the RCD and (3) that the judge ignored the colour contrast between the body and the wheels.

The Supreme Court concluded that the first criticism was justified. While Arnold J had mentioned that the Kiddee Case “shares” the “horn-like” handles of the RCD and noted that the horns formed an important part of the RCD’s appearance, in the view of the Supreme Court the judge did not consider the overall impression of the RCD as that of a horned animal. It took this view because the judge did not specifically mention the point in his judgment.

The Supreme Court’s judgment on the second issue is likely to give rise to debate, because it took the view that the Court of Appeal did not resolve the issue of whether the absence of ornamentation was a feature of the RCD in the present case. At para [50] of its judgment, the Supreme Court said that there were “powerful practical arguments against such a conclusion”, but that since it was not necessary to resolve the issue in the present case, it would prefer to leave the point open. Practitioners will note that although, in paragraph [43] of its judgment, the Supreme Court said it did not consider the second criticism raised by Kitchen LJ to be a “free-standing contention” that it was a feature of the RCD that it contained no decoration, the court appears to endorse the view expressed by Kitchen LJ that it would be wrong to eliminate the decoration on the accused design entirely “because it significantly affects how the shape itself strikes the eye, and the overall impression it gives”.

As to the third criticism of the judgment of Arnold J, the Supreme Court took the view that the colour contrast between the wheels and the strap on the one hand, and the body on the other, was a feature of the RCD, and that the Court of Appeal was therefore right to conclude that the RCD claimed not merely a specific shape, but a shape in two contrasting colours. The Supreme Court therefore held that the Court of Appeal was entitled to consider the question of infringement for itself.

Magmatic and the Comptroller General of Patents, Designs and Trade marks had requested that questions raised by the second and third criticisms (absence of surface decoration and colour contrast) be referred to the CJEU. The Supreme Court refused to do so on the basis that the issues raised did not raise a point of EU law, or a point which was suitable to be

referred to the CJEU, as the issue of the absence of surface decoration was an obiter part of the Court of Appeal's judgment.

Michael Hicks and **Jonathan Moss**, Hogarth Chambers instructed by Margaret Briffa of Briffa LLP for the Appellant.

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