



Neutral Citation Number: [2014] EWHC 4242 (Pat)

Case No: HP13A00329

**IN THE HIGH COURT OF JUSTICE**  
**CHANCERY DIVISION**  
**PATENTS COURT**

Royal Courts of Justice  
Rolls Building, Fetter Lane, London, EC4A 1NL

Date: 17 December 2014

Before :

**THE HON MR JUSTICE ARNOLD**

Between :

<b>WHITBY SPECIALIST VEHICLES LIMITED</b>	<b><u>Claimant</u></b>
- and -	
<b>(1) YORKSHIRE SPECIALIST VEHICLES LIMITED</b>	<b><u>Defendants</u></b>
<b>(2) AMER RUBANI</b>	
<b>(3) OMAR RUBANI</b>	
<b>(4) GHULAM RUBANI</b>	

And between :

<b>(1) YORKSHIRE SPECIALIST VEHICLES LIMITED</b>	<b><u>Part 20 Claimants</u></b>
<b>(2) AMER RUBANI</b>	
- and -	
<b>(1) WHITBY SPECIALIST VEHICLES LIMITED</b>	<b><u>Part 20 Defendants</u></b>
<b>(2) STUART WHITBY</b>	

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**Michael Hicks** and **Jonathan Moss** (instructed by **ORJ Solicitors LLP**) for the **Claimant**  
The **Second Defendant** appeared in person and on behalf of the **First Defendant**  
The **Third Defendant** appeared in person  
**Christopher Cook** (instructed by **Blacks Solicitors LLP**) for the **Fourth Defendant**

Hearing dates: 10, 12-14, 20 November 2014  
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## **Approved Judgment**

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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THE HON MR JUSTICE ARNOLD

**MR JUSTICE ARNOLD :**

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## Introduction

1. This is a case about the design of ice cream vans. The Claimant (“Whitby”) contends that the Defendants have committed the following infringements of its rights:
  - i) infringement of (UK unregistered) design rights in aspects of the design of Whitby’s Mondial ice cream van;
  - ii) infringement of UK Registered Design No. 4,000,395 (“the Registered Design”) in respect of the external appearance of the Mondial; and
  - iii) infringement of UK Registered Trade Mark No. 2,229,302 (the “Trade Mark”).
2. The Defendants deny infringement and the First to Third Defendants counterclaim for revocation of the Registered Design. Other counterclaims were not pursued at trial. As explained below, the issue which occupied most of the time at trial was the liability of the Fourth Defendant. It is important to note that, although the Fourth Defendant was represented at trial by solicitors and counsel, they were instructed only in relation to the issue of his liability, and not in relation to the underlying issues of validity and infringement. The First to Third Defendants were not professionally represented at trial, and had understandable difficulty in effectively presenting their cases on those issues. Their Amended Defence and Counterclaim had, however, been settled by specialist counsel, and so I have carefully considered the points made there.

## The parties

3. Whitby is the largest manufacturer of ice cream vans in the UK. The business was founded by Bryan Whitby in 1962 and acquired by Whitby in 1973. Since then, Whitby has acquired two other ice cream manufacturers, Morrisons and Cummins, in 1989 and 1999 respectively. It remains a family-owned and run business. It has no connection with the Yorkshire town of Whitby, and is based in Crewe. There are two main aspects to Whitby’s business: the first is the design and manufacture of new ice cream vans and the second is the repair, maintenance and restoration of existing vans.
4. The Second and Third Defendants are brothers and the Fourth Defendant is their father. For convenience, and without intending any disrespect, I shall refer to the Second, Third and Fourth Defendants as “Amer”, “Omar” and “Ghulam” respectively. Ghulam has sold ice cream from ice cream vans for many years, although he also runs a grocery shop with his wife and has some interests in property. When they were younger, Amer and Omar joined their father in his ice cream business, which traded as Paradise Ices. Subsequently, Amer decided to go into business making ice cream vans. It appears that, to begin with, Amer traded as Yorkshire Specialist Vehicles, and that subsequently the business was carried on through the First Defendant (“YSVL”). Amer is, and Omar was, a shareholder in

YSVL. Omar has worked for Amer and for YSVL. There is a major dispute as to whether or not Ghulam has had any involvement in this business.

The witnesses

5. Whitby's principal witness was Stuart Whitby ("Stuart"), Whitby's Managing Director, who gave both factual and expert evidence. Much of his evidence was not challenged. He was a clear and measured witness, and I have no hesitation in relying on his evidence. Whitby's other main witnesses were Stuart's son Edward Whitby ("Edward"), who is Whitby's Production Manager, and Antonio Coronato, a sales executive employed by Whitby. Edward's evidence was not challenged. Mr Coronato was briefly cross-examined. He was a straightforward witness and I accept his evidence. Whitby also called Sean Moss, a private investigator, but his evidence is of peripheral relevance to the issues I have to decide.
6. Amer struck me as a person who, despite lacking much formal education, was of some intelligence and ability. It is therefore regrettable to have to record that, in his oral evidence, he gave me the impression of someone who was saying whatever was necessary to attempt to exculpate Ghulam from involvement in the alleged infringements while maintaining an appearance of candour. There were several problems with his credibility. First, he had previously signed a witness statement with a statement of truth in which he denied copying the Mondial. As he accepted, that denial was untrue. Secondly, he admitted lying to Stuart at their meeting on 1 June 2011 (as to which, see below). Thirdly, he accepted that, on his account of events, he had behaved dishonestly with regard to insurance (as to which, again see below). Fourthly, various aspects of his evidence were either simply incredible or difficult to reconcile with such documents as have been disclosed by the Defendants or internally inconsistent. Fifthly, it is plain that the Defendants' disclosure has been deficient, and that Amer bears at least some of the responsibility for this. Counsel for Whitby submitted that Amer was covering up his father's involvement, and I accept that submission.
7. Omar clearly played second fiddle to his brother, and therefore his evidence is of less significance. He suffered from similar credibility problems to his brother, however. Counsel for Whitby again submitted that Omar was covering up his father's involvement, and again I accept that submission.
8. Ghulam gave evidence through an interpreter, it being his evidence that he only spoke broken English. It was also his evidence that he was illiterate. Despite making every allowance for those difficulties, I found him to be a very unsatisfactory witness. He frequently took refuge in claims that he did not know, or could not remember, matters which he must have known about. When he did answer questions informatively, much of his evidence was incredible or inconsistent. Furthermore, after he had given evidence on the third day of the trial, he gave late disclosure of further documents which necessitated him being recalled the next day. I do not believe that Ghulam told me the truth about his involvement in the infringements.
9. As well as giving factual evidence, Stuart gave expert evidence which was barely challenged. YSVL, Amer and Omar had served an expert report from a Derek Appleby, but they did not call Mr Appleby to give evidence at trial.

### The development of the Mondial

10. Ice cream vans generally consist of a chassis (and cab) manufactured by a commercial van manufacturer such as Ford or Mercedes onto which has been added a body designed and manufactured by a specialist supplier such as Whitby. This can be done in one of two ways: either starting from a bare commercial van chassis or starting from a complete commercial van, from which the body is then removed. Both ways are referred to as “converting” the commercial chassis/van. The body and interior fittings are commonly made of moulded GRP (glass reinforced plastic – i.e. “fibreglass”) panels.
11. In 2006 Whitby designed a new model of ice cream van, which came to be known as the Mondial, based on the Mercedes Sprinter chassis. The design team was led by Stuart and also included five other employees of Whitby. No design drawings were created apart from rough sketches which were not retained. Instead Whitby proceeded directly to the creation of wooden “plugs” from which moulds were made for the creation of the various GRP panels. In addition to the GRP panels, Whitby designed certain mechanical components, in particular a stand for a soft ice cream making machine and a drive mechanism leading from the engine to the ice cream machine.
12. There are a number of different versions of the Mondial. In the first place there are two variants referred to as the Whitby Morrison Mondial and the Cummins Mondial. The most obvious difference between these two variants concerns the window arrangement. Then there are short, medium and long wheel base versions of each of those variants. The version which is relevant to this case is the short wheel base Whitby Morrison Mondial. In addition, there are large number of optional features and equipment that a purchaser can choose from.
13. Whitby entirely accepts that the design of the Mondial was not revolutionary, but an evolution of earlier Whitby ice cream van designs, and in particular a model called the Millenium. It was nevertheless Stuart’s evidence that his aim was to create a new, aesthetically pleasing and functionally convenient design. Since there was no real challenge to his account of the design process, it is unnecessary to go into details.
14. The Mondial was first exhibited in October 2006 and the first sale was in December 2006. The cabinet design in issue was designed in August 2008 and first sold later that year.

### Amer and Omar’s copying of the Mondial

15. Whitby adduced overwhelming evidence to show that Amer and Omar had physically copied a Mondial by using panels from a Mondial as plugs to produce moulds from which further GRP panels were made and by copying the mechanical components. At trial, Amer and Omar admitted that this was what they had done, despite having previously denied it. I must nevertheless return to what was done in more detail below when considering the issue as to Ghulam’s liability.

### Inspection

16. On 11 November 2014 I had the advantage of being able to inspect a Mondial, one of the Defendants’ allegedly infringing vans (registration number SJ10 VTA, as to which

see below), a Millenium and two other prior vans (namely a Whitby Morrison Castle Body and a Cummins Mk 23).

The claim for infringement of the Registered Design

*The Registered Design*

17. The Registered Design was registered as of 3 November 2006 in respect of a “vehicle body” with a disclaimer stating “[t]he design is that is applied to the vehicle body as shown in the representations by solid lines, excluding the parts shown by broken lines”. There are three representations of the design which are reproduced in the Annex to this judgment together with photographs of a Mondial van and a Millenium van taken from the same perspectives.

*Key provisions of the Designs Directive*

18. The key provisions of European Parliament and Council Directive 98/71/EC of 13 October 1998 on the legal protection of designs (“the Designs Directive”) for present purposes are as follows;

*“Article 3*

**Protection requirements**

....

2. A design shall be protected by a design right to the extent that it is new and has individual character.

....

*Article 5*

**Individual character**

1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.
2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

...

*Article 7*

**Designs dictated by their technical function and designs of interconnections**

1. A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

...

*Article 9*

**Scope of protection**

1. The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.
  2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.”
19. The United Kingdom implemented the Designs Directive by amending the Registered Designs Act 1949 by means of the Registered Designs Regulations 2001, SI 2001/3949, made under section 2(2) of the European Communities Act 1972. It is well established that the 1949 Act as amended by the 2001 Regulations has to be construed as far as possible in conformity with the Designs Directive (Case C-106/89 *Marleasing SA v La Comercial Internacional de Alimentación SA* [1990] ECR I-4135).

*Legal principles*

20. *The informed user.* The law as to the nature of the informed user was summarised by His Honour Judge Birss QC (as he then was) sitting as a High Court Judge in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), [2013] ECDR 1 in a passage which was accepted to be accurate by the Court of Appeal on appeal [2012] EWCA Civ 1339, [2013] FSR 9:
- “33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo Inc v Grupo Promer Mon-Graphic SA* (C-281/10 P) [2012] F.S.R. 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* (T-9/07) [2010] ECDR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM* (T-153/08), judgment of 22 June 2010.
34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:
- i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or

- seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzhen* paragraph 46).
- ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
  - iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);
  - iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);
  - v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).
35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).”
21. The CJEU re-iterated what it had said in *PepsiCo* at [53] and [55] in Joined Cases C-101/11 P and C-102/11 P *Neuman v OHIM* [EU:C:2012:641] at [53]-[54].
22. *The existing design corpus.* Recital (13) of the Designs Directive makes it clear that the overall impression produced on the informed user depends on “the existing design corpus”, taking into consideration the nature of the product to which the design is applied, and the industrial sector to which it belongs.
23. In *Grupo Promer* the Community design was registered for “promotional items for games”. The General Court held at [62] that the informed user “has *some* awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed” (emphasis added). In *PepsiCo* the CJEU appears to have approved this statement at [54]. The CJEU went on at [59] to say that the informed user “knows the various designs which exist in the sector concerned, possesses a *certain* degree of knowledge with regard to the features which those designs *normally* include” (emphasis added).
24. *The designer’s degree of freedom.* I considered the designer’s degree of freedom in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), [2010] FSR 39 at [32]-[37], where I concluded that design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations. I also concluded that both a departure from the existing design corpus and the production of a wide variety of subsequent designs were evidence of design freedom. Apart from emphasising that the degree of freedom to be considered was that of the designer of the registered design, the Court of Appeal appears to have agreed with this: [2011] EWCA Civ 1206, [2012] FSR 4 at [18]-[20].
25. *Individual character.* In Case C-345/13 *Karen Millen Fashions Ltd v Dunnes Stores* [EU:C:2014:2013] the CJEU ruled that, in order for a design to be considered to have individual character, the overall impression which that design produces on the

informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.

26. *Effect of design freedom on the scope of protection.* Article 9(2) of the Designs Directive indicates that, other things being equal, a registered design should receive a broader scope of protection where the designer had a greater degree of freedom and a narrower scope of protection where the designer had a lesser degree of freedom. Thus in *Grupo Promer* the General Court held:

“72. In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer’s degree of freedom in developing the contested design must be taken into account. ... the more the designer’s freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.

...

82. In the absence of any specific constraint imposed on the designer, the similarities noted in [79]–[81] above relate to elements in respect of which the designer was free to develop the contested design. It follows that those similarities will attract the informed user’s attention...”

27. *Effect of differences between the registered design and the design corpus on the scope of protection.* Recital (13) of the Designs Directive indicates that, other things being equal, a registered design should receive a broader scope of protection where the registered design is markedly different to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. Thus in *Grupo Promer* the General Court held at [72]:

“ ... as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. ...”

28. Conversely, in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8 Jacob LJ held at [35(ii)]:

“... if a new design is markedly different from anything that has gone before, it is likely to have a greater overall visual impact than if it is ‘surrounded by kindred prior art’ (H.H. Judge Fysh’s pithy phrase in *Woodhouse* at [58]). It follows that the ‘overall impression’ created by such a design will be more significant and the room for differences which do not create a substantially different overall impression is greater. So

protection for a striking novel product will be correspondingly greater than for a product which is incrementally different from the prior art, though different enough to have its own individual character and thus be validly registered.”

29. In *Dyson v Vax* I held at [41] that this did not apply where the striking elements of the design were ones where there was little design freedom, in particular because of technical requirements. This proposition does not appear to have been challenged on the appeal.
30. *Overall impression*. Although it is proper to consider both similarities and differences between the respective designs, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. As Jacob LJ has emphasised repeatedly, the most important thing about each of (i) the registered design, (ii) the accused design and (iii) the prior art is what they look like: see *Procter & Gamble* at [3], *Dyson v Vax* at [8] and *Samsung v Apple* at [28].

#### *Assessment*

31. *The informed user*. Counsel for Whitby submitted that the informed user in the present case was an ice cream van operator (referred to in the trade as a “mobiler”). I agree with this.
32. *The design corpus*. The design corpus regarding the outside appearance of ice cream vans is illustrated by the following:
  - i) The vehicles shown in Part I of Annex 2 to the Amended Defence and Counterclaim which contains photographs of a number of earlier Whitby, Morrisons and Cummins designs including the Millennium.
  - ii) The vehicles shown in Part II of Annex 2 to the Amended Defence and Counterclaim which contains photographs of a number of vans produced by other manufacturers.
  - iii) The registered designs in Annex 3 to the Amended Defence and Counterclaim which show designs of a number of Whitby or Cummins vehicles photographs of which are included in Annex 2.
  - iv) Various photographs of earlier van designs in Whitby’s disclosure.
33. The design corpus shows that ice cream vans generally consist of a box-like structure mounted on a commercial vehicle chassis with a number of standard features. Typical features are:
  - i) A commercial vehicle chassis.
  - ii) A box-like body, extending over the roof of the cab.
  - iii) Large side windows. The rear section of the side window is often smaller where the freezer cabinet is present.

- iv) Louvres or name recesses for signs on all four sides.
  - v) Panels on the sides below side windows for signage.
  - vi) A number plate at the rear.
  - vii) A bumper at the rear.
  - viii) Lighting at the rear to comply with applicable regulations (typically horizontally mounted at the corners in or above the bumper region).
  - ix) Model ice cream cones at the front.
  - x) GRP construction, resulting in smooth edges.
  - xi) A vent on the side for the ice cream machine, which is usually behind the passenger seat.
  - xii) A rear window because of the need for rear view vision.
34. *Design freedom.* The features listed in the preceding paragraph are determined by one or more of the following constraints: (a) technical requirements – e.g. (ii), (iii), (ix); (b) cost requirements – e.g. (i) and (x); (c) regulatory requirements – e.g. (vi), (viii); (d) practical requirements – e.g. (vii), (xii); and (e) commercial requirements/standard practice – e.g. (iv), (v), (ix).
35. It is therefore not surprising that there is considerable similarity between the products of different manufacturers, and also between different generations of products from a particular manufacturer. The informed user would be aware of this, and would therefore consider the way in which the designer has worked within these design constraints and against the background of the design corpus.
36. *Does the Registered Design possess individual character?* YSVL, Amer and Omar contend that the Registered Design is invalid because it does not possess individual character. Counsel for Whitby submitted that the closest prior design was the Millennium. I agree with this. Counsel for Whitby submitted that the Registered Design produced a different overall impression on the informed user than that produced by the Millennium. In support of this submission, he identified the following differences between the Registered Design and the Millennium:

<b>Feature</b>	<b>Millennium</b>	<b>Registered Design</b>
	<b>Front view</b>	
A	Front face consists of two planes when viewed from side elevation. The upper plane angles more steeply towards the back of the van. (This two plane feature runs around the side of the van above the cab.)	Front face consists of a single plane and runs vertical .
B	Louvre is curved on the top, flat on	Louvre's upper and lower edges are

	bottom and confined to the upper plane.	parallel, ends are rounded and occupies majority of front face.
C	No crown visible and upper edge more curved.	Crown visible and only gently curved upper edge.
<b>Back view</b>		
D	Rear name panel recess is smaller with nearly parallel sides.	Rear name panel recess is larger and follows curve of roof.
E	Upper rear lights are on a raised panel.	Upper rear lights are flush with body and no distinct raised panel.
F	Lower rear lights are on the side and are vertical (traditional set-up).	Lower rear lights are horizontal and recessed into bumper region.
G	Bumper is one piece.	Bumper is two pronounced pieces.
<b>Side view</b>		
H	Small wheel arch surround.	Larger wheel arch surround.
I	Top of wheel arch merges into body.	Top of wheel arch has a distinct recessed groove framing the wheel arch.
J	Back corner piece (which runs around the side from the bumper) runs along the side about a foot.	Back corner piece (which runs around the side from the bumper) runs along the side for a few inches.
K	Upper front portion above the cabin is different in shape.	Upper front portion above the cabin roughly rectangular.
L	Height of body above cabin is larger.	Height above cabin is shallower.
M	Top of side windows level with the upper plane of the front portion.	Top of side window is roughly level with bottom of front portion above cabin.
N	No ridge on bottom edge.	Ridge on bottom edge.

37. In my view some of these differences are more apparent when the Millenium is compared with a Mondial van than with the Registered Design. Nevertheless I accept that there are differences between the Millenium and Registered Design. Furthermore, I accept that these are differences which the informed user would notice and which combine to produce a different overall impression. Accordingly, I conclude that the Registered Design does possess an individual character and is therefore valid.
38. *Scope of protection of the Registered Design.* Counsel for Whitby accepted that the Registered Design had a relatively narrow scope of protection. Given that the Registered Design does not represent a significant departure from the design corpus and the constraints on the designer's freedom considered above, he was right to do so.
39. *Does the Defendants' van produce the same overall impression as the Registered Design?* Counsel for Whitby submitted that the Defendants' van did produce the same overall impression on the informed user as the Registered Design. As Whitby accepts,

there are certain minor differences between the design of the Defendants' van and the Registered Design (see Stuart's second witness statement at paragraphs 72-73, 78, 81 and 86 commenting on Annex 4 to the Amended Defence and Counterclaim). Nevertheless, the designs are very similar. In my judgment the Defendants' van does produce the same overall impression as the Registered Design. It follows that the First to Third Defendants have infringed the Registered Design.

### The claim for infringement of design rights

#### *The legislation*

40. Until 1 October 2014, section 213 of the Copyright, Patents and Designs Act 1988 provided, so far as is relevant, as follows:

- “(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 any aspect 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 the design field at the time of its creation.

...”

41. On 1 October 2014 section 213(2) was amended by the Intellectual Property Act 2014 so as to delete the words “any aspect of”. The effect of this amendment was recently considered by His Honour Judge Hacon on *DKH Retail Ltd v H. Young (Operations) Ltd* [2014] EHC 4034 (IPEC) at [10]-[18]. It appears to have been common ground before him that the amendment was fully retrospective, with the potential consequence that an act committed prior to 1 October 2014 which was an infringement of design right as the law then stood retrospectively ceased to have been an infringement. I have to say that I have some doubts as to whether that is correct, but this does not matter for present purposes. As Judge Hacon explained, in many cases the amendment will make no difference. In my view this is such a case.

42. Section 226 of the 1988 Act provides that making an article is an infringement of design right if it involves “copying the design so as to produce articles exactly or substantially to that design”. Section 227 provides that design right is infringed by a person who, without the licence of the design right owner, sells or exposes or offers for sale in the course of a business an article which is, and which that person knows or has reason to believe is, an infringing article.

*Legal principles*

43. *Original*. In order for design right to subsist, a design must be “original” in the copyright sense of originating with the author, and not being copied by the author from another: see *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* [1999] RPC 461 at 475, 482. In *Magmatic v PMS* at [84] I expressed the view that the test is whether sufficient skill, effort and aesthetic judgement has been expended on the new design to make it original. During the course of argument in the present case, the question was raised whether “original” should be interpreted in the same manner as the CJEU has interpreted the requirement for originality in the context of copyright, that is to say, as requiring creativity on the part of the designer: see *C-429/08 Football Association Premier League Ltd v QC Leisure* [2011] ECR I9083, *Case C-145/10 Painer v Standard Verlags GmbH* [2011] ECR I-12533 and *Case C-604/10 Football Dataco Ltd v Yahoo! UK Ltd* [EU:C:2012:115]. I shall assume, without deciding, that this is the correct approach.
44. *Commonplace*. The correct approach to deciding whether a design was commonplace at the relevant date has been considered in a number of cases, including *Farmers Build v Carrier*, *Scholes Windows Ltd v Magnet Ltd* [2002] EWCA Civ 561, [2002] FSR 10 and *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886, [2005] RPC 6. As those cases make clear, it is a question of fact and degree.
45. It can also be seen from the decided cases in this field that, in the past, the question depended to some extent on the level of abstraction at which the claimant sought to define the design relied on. The higher the level of abstraction at which the design was defined, the easier it would be for the claimant to prove infringement, but the easier it would be for the defendant to show that the design was commonplace. As Judge Hacon has pointed out in *DKH v Young*, however, the line of cases which culminates in *Clinisupplies Ltd v Park* [2012] EWHC 3453 (Ch), [2013] FSR 27 and the recent amendment to section 213(2) both make it difficult for a claimant to define the design(s) at a level of abstraction higher than that exhibited by the actual article (or part of the article) which embodies the design (or the actual design drawing which records it). That makes it harder for the claimant to prove infringement, but it also makes it harder for the defendant to prove that the design is commonplace.
46. “*Must fit*” and “*must match*”. The so-called “must fit” and “must match” exclusions were considered by the Court of Appeal in *Dyson v Qualtex*. In the case of the “must match” exclusion, Jacob LJ considered in some detail the earlier case of *Ford Motor Co Ltd’s Design Applications* [1995] RPC 167 concerning parts for motor cars at [57]-[64], holding that “one must ask whether there is a feature of shape of the part which is dependent on the appearance of the whole” of the vehicle and that “[i]f there is, as practical matter, design freedom for the part, then there is no dependency”.

47. *Exactly or substantially to the design.* The correct approach to considering whether an allegedly infringing product is exactly or substantially to the design right owner's design was stated by Aldous J in *C & H Engineering v F. Klucznik & Sons Ltd* [1992] FSR 421 at 428 as follows:

“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.”

48. *Knowledge or reason for belief.* These requirements have been considered by the Court of Appeal in a number of copyright cases, including *LA Gear Inc v Hi-Tec Sports plc* [1992] FSR 121, *ZYX Music GmbH v King* [1997] 2 AL ER 129, *Linpac Mouldings Ltd v Eagleton Direct Export Ltd* [1994] FSR 4545 and *Pensher Security Door Co Ltd v Sunderland City Council* [2000] ROC 249. “Reason for belief” involves the knowledge of facts from which a reasonable person would arrive at the relevant belief.

#### *The designs relied on*

49. In its Particulars of Claim Whitby identified no less than 21 designs it relied on and annexed a series of comparative photographs which showed the relevant aspects of the Mondial and the Defendants' van. In closing submissions counsel for Whitby abandoned two designs, leaving 19 (“the Designs”). As he pointed out, however, the Designs fall into three groups: (i) Designs consisting of aspects of the shape and configuration of the exterior of the Mondial; (ii) Designs consisting of aspects of the shape and configuration of the interior of the Mondial; and (iii) Designs consisting of the shape and configuration of the base frame and the direct drive bracket. Furthermore, so far as the first group is concerned, counsel for Whitby concentrated his submissions on the first Design relied on, namely “the overall appearance of the exterior of the Mondial van”. I shall do likewise. Similarly, the second group of Designs together make up the overall appearance of the interior of the Mondial, excluding the cab and other bought-in components such as the temperature gauge, and I shall consider them on that basis.

#### *Assessment*

50. *Are the Designs original?* Having regard to Stuart's evidence, I have no hesitation in concluding that the Designs are all original.
51. *Are the Designs commonplace?* The question whether the Designs are commonplace is a more difficult one. As discussed above in relation to the Registered Design, the design of the Mondial was not a significant departure from the corpus of earlier ice cream vans. On the contrary, it shares many common features with them.

Nevertheless, it is differentiated from earlier designs such as the Mondial in a number of respects. Although that does not necessarily prevent the Designs from being commonplace, I have concluded that the differences are such that, taken at the level of abstraction exhibited by the Mondial, neither first Design nor the second group of Designs relied on is commonplace. So far as the third group of designs is concerned, I consider that the design of the base frame was commonplace, but, with some hesitation, not the design of the drive bracket.

52. *Are the Designs excluded on the basis of “must fit” and/or “must match”?* In my judgment some of the Designs in the first group, such as Design (5), are excluded on “must match” grounds, since they amount to the designs of individual GRP panels. Furthermore, as counsel for Whitby accepted, certain aspects of other designs are excluded on “must fit” grounds. As he submitted, however, these exclusions do not apply to the first design. Nor do they apply to the second group (except for certain aspects) or the third group of designs (except for certain aspects).
53. *Is the Defendants’ van exactly or substantially to the Designs?* As discussed above, there is no dispute that the Defendants’ van design was copied from the Mondial. Nor is there any dispute that there are a number of small differences between the two. Nevertheless, as I have already said, they are very similar. In my judgment the Defendants’ van is substantially to the first Design and the relevant parts of the Defendants’ van are substantially to the second group of Designs and the drive bracket.

#### The claim for infringement of the Trade Mark

54. The Trade Mark consists of the words “WHITBY MORRISON” registered as of 13 April 2000 in respect of various goods and services including “ice cream vans; ... parts and fittings for the aforesaid goods”.
55. The drive shaft cover on the Mondial has the words “WHITBY MORRISON” moulded into it. Edward downloaded a photograph posted by the Defendants on Facebook which shows a mould bearing the same words in reverse. Whitby contends that this shows that, as part of their copying process, the Defendants took a moulding from a Whitby cover. Until cross-examination, all the Defendants had denied that they had created or used this mould. During cross-examination, Amer accepted that he and his brother had made the mould, but claimed that it had not been used to make a cover.
56. Whitby contends that the Defendants did make some covers using this mould. Whitby accepts that, at some point, the mould was modified, and the Whitby Morrison name changed to that of Yorkshire Specialist Vehicles. Whitby also accepted that the cover on some vehicles was replaced with a new one.
57. Having regard to the photograph posted on Facebook and the Defendants’ previous denial that they had created the mould, I do not believe Amer’s evidence that the mould was not used to make a cover. I find on the balance of probabilities that Amer and Omar did use the mould to make covers for the first few vans they made. Accordingly, they have infringed the Trade Mark pursuant to section 10(1) and (4)(a) of the Trade Marks Act 1994.

### Liability of Ghulam

58. As noted above, the major issue at trial was the liability of Ghulam for the infringements. Whitby contends that Ghulam is primarily liable for certain infringing acts and is jointly liable for other infringing acts. I shall approach these issues by first outlining the factual background as uncontentiously as possible, then resolving the major factual issues and then considering the allegations of primary and joint liability.

#### *Factual background*

59. On 11 February 2011 Ghulam transferred £14,000 from his bank account to an account in the joint names of himself and his wife, and on the same day withdrew £14,000 in cash from the latter. As Amer accepted, a one or two year old Mercedes Sprinter 213 van would have cost about that sum depending on mileage.
60. On 22 March 2011 Mr Coronato received a telephone call from Amer in which Amer said that he had a second-hand Mercedes Sprinter van which he wanted to have converted into a Mondial by Whitby.
61. On 28 March 2011 Amer and Omar visited Whitby and met Mr Coronato to place the order. Mr Coronato filled in an eleven page order form during the meeting. To begin with, Amer gave his own name as the customer name and Mr Coronato wrote this down. Mr Coronato then tippexed out "Amer" and wrote "Ghulam" over the top. Mr Coronato gave evidence, which I accept, that he did this at Amer's request and that Amer told him that Ghulam was funding the purchase of the van. Mr Coronato told Amer that Ghulam would have to provide identification and Amer said that he would obtain identification from his father. Amer paid a deposit of £10,000 cash towards an agreed total price of £34,682 including VAT. The order form identified the van which was to be converted as a Mercedes Sprinter 213 registration number SJ10 VTA.
62. Also on 28 March 2011 Ghulam was registered as the keeper of SJ10 VTA.
63. On 13 April 2011 Amer and Omar delivered a different vehicle, namely a Mercedes Sprinter 311 registration number MH06 XJM. During the course of completion of the conversion, the registration number of the van was changed at Amer's request to W111 PYX (approximating to "Whippy").
64. By May 2011 Stuart had received warnings from two different sources that the Rubanis intended to copy the Mondial. He therefore asked Amer to come and see him. On 1 June 2011 Amer and Omar visited Stuart. They denied that they intended to copy the Mondial.
65. On 27 July 2011 the sum of £16,500 was withdrawn from Ghulam's savings account. On the same day the sum of £20,000 was deposited into Whitby's bank account as a second payment for the van. The deposit was made at Barclays Bank's Leeds Dewsbury 31 branch under the reference "Ghulam Rubani".
66. On 28 July 2011 Amer and Omar collected the completed Mondial from Whitby. They paid a further £4,804.40 in cash to cover the balance of the price. During their visit, they showed Mr Coronato Ghulam's driving licence for identification purposes,

and he took a photocopy. Whitby's invoice in respect of the vehicle was made out to Ghulam.

67. Shortly thereafter, Amer and Omar dismantled the Mondial, and proceeded to copy it. It appears that the first copied vehicle was built on the chassis of SJ10 VTA, which was the vehicle originally identified by the defendants as the one which would be provided for conversion. Whitby contends that Ghulam assisted Amer and Omar to carry out the copying, and in particular the making of the GRP moulds and panels. I shall return to this below.
68. On 15 September 2011 Ghulam was registered as the keeper of MH06 XJM.
69. On 26 October 2011 Ghulam telephoned Slade Edwards & Co (Insurance Brokers) Ltd ("Slade Edwards") requesting a quotation for insurance for his ice cream van registration MH06 XJM, cover for which was required as soon as possible. Ghulam gave Slade Edwards permission to speak to his daughter Ifsa to gather the necessary information. The estimated value of the van was stated be £50,000. Slade Edwards gave quotations both for Ghulam only to drive and any driver over 25, and the former quotation was accepted. The documents sent by Slade Edwards to Ghulam include a statement of facts provided which records, among things, that "[t]he vehicle to be covered under this policy is the property of the policyholder or is supplied to them under a hire purchase agreement or vehicle leasing agreement". On 27 October 2011 a payment of £1,217.96 was made to Slade Edwards from Ghulam and his wife's joint account.
70. On 8 November 2011 Ghulam or Ifsa telephoned Slade Edwards to change the registration number to W111 PYX.
71. On 24 July 2012 Ghulam or Ifsa telephoned Slade Edwards to add vehicle SJ10 VTA to the policy and to include Markus Fisher as a driver of this vehicle. The estimated value of the van was stated be £65,000. On 25 July 2012 Slade Edwards wrote to Ghulam to confirm the amendment to the policy, recording that the vehicle was "owned by you". The policy was subsequently renewed on 26 October 2012. On 30 October 2012 a payment of £2,429.47 was made to Slade Edwards from Ghulam and his wife's joint account.
72. According to DVLA records, on 24 January 2013 Ghulam disposed of MH06 XJM to a Wahid Ali.
73. On 3 April 2013 Ghulam or Ifsa telephoned Slade Edwards to change one of the insured vehicles from W111 PYX to WU57 YHX, a Mercedes Sprinter 311 ice cream van of estimated value £40,000 "owned by you". There is photographic evidence that this van was another one copied from the Mondial. The vehicle was removed from the policy on 30 April 2013. The policy lapsed on 25 October 2013, when Ghulam took out insurance elsewhere.
74. There is a photograph in evidence of SJ10 VTA, W111 PYX and WU57 YHX all parked in the garage at Ghulam's house. All three vehicles are painted in Paradise Ices livery. The date of the photograph is unclear, but it would appear that it was probably in April 2013.

75. It appears that the reason why WU57 YHX was removed from the insurance policy was that it was sold. SJ10 VTA remains in the possession of Ghulam, who uses it in his ice cream selling business.
76. Whitby contends that from October 2011 onwards Amer and Omar manufactured copied vans on a substantial scale. Whitby estimates that they have sold at least 30 vans, some (but not all) through YSVL. Amer and Omar dispute this.

*Main factual issues*

77. The main factual issues are as follows:
  - i) Was Ghulam the owner of SJ10 VTA, MH06 XJM/W111 PYX and WU57 YHX at the relevant times?
  - ii) Did Ghulam fund the purchase and conversion of MH06 XJM/W111 PYX and the copying of the Mondial onto the chassis of SJ10 VTA?
  - iii) Did Ghulam purchase, or at least fund the purchase of, parts for conversions?
  - iv) Is Ghulam an experienced GRP moulder?
78. So far as the first issue is concerned, I have little doubt that Ghulam was the owner of all three vehicles, as indicated by the order form and the invoice, the insurance documents and the DVLA records. Amer tried to claim that he was the owner, but this required him to say that he had dishonestly taken out insurance in his father's name because it was cheaper. It also required him to say that he had made payments for insurance using his father's debit card. I did not believe this evidence. Although Ghulam initially denied being the owner of the vans, he did ultimately admit to having been the owner of MH06 XJM/W111 PYX on 26 October 2011.
79. As for the second issue, again I have little doubt that Ghulam did fund the purchase and conversion of MH06 XJM/W111 PYX and the copying of the Mondial onto the chassis of SJ10 VTA. It is difficult to see how Amer and Omar could have funded this from their own resources, whereas it is clear that Ghulam did have the money. Furthermore, the evidence strongly suggests that the £20,000 was deposited by Ghulam. Amer's account of how he had deposited this money was not credible.
80. So far as the third issue is concerned, Ghulam's bank statements record various payments to suppliers who supply parts suitable for use in conversions. Again, I have little doubt that Ghulam made these payments, or at least authorised them. Amer's evidence that he had made the payments without his father's knowledge or consent was not credible.
81. Turning to the fourth issue, this is more difficult to resolve. It has always been an important plank in Whitby's case that Ghulam is an experienced GRP moulder, but equally the Defendants have always denied this.
82. In his first statement Stuart said that Ghulam was known as being an experienced GRP moulder in the industry and that this information had been conveyed to him by van owners over many years, some of whom had seen him working at the Defendants' premises at Playfair Road in Leeds.

83. In his second statement, Stuart said that Persons A and B had visited the Playfair Road premises when ice cream vans were in production, had met Amer and Omar and had seen a person in overalls whom they had been told was Amer and Omar's father. He also said that Person C was a more regular visitor who had seen a person he was given to believe was Ghulam working in overalls on more than one occasion. Stuart did not name Persons A, B or C, saying that they were reluctant to be identified.
84. In his fourth witness statement Stuart recounted conversations with two ice cream van operators, again without identifying them. He also said that a Tony Delduca had told him that he had seen Ghulam working on ice cream vans at Playfair Road.
85. In his fifth witness Stuart identified the other individuals referred to in his fourth statement as Ian Smith and Richard Thompson. At the same time Whitby disclosed draft witness statements from Mr Smith and Mr Thompson which had previously been taken by Whitby's solicitors. Mr Smith subsequently disavowed his draft statement, however. Whitby did not serve a witness statement, or even a draft witness statement, from Mr Delduca.
86. Although Whitby served a witness summons on Mr Thompson, and although I gave Whitby permission to call Mr Thompson, despite serving his witness summary out of time, in a ruling on the first day of trial, Mr Thompson did not attend to give evidence. Instead, Mr Thompson sent a letter to the Court enclosing a medical certificate from his GP stating that Mr Thompson was, in his opinion, not fit to travel or give evidence in court. The GP explained his reasons for giving this opinion, which appeared cogent.
87. In his oral evidence in chief Stuart identified persons A, B and C in his second statement as Rob Barlow, Mr Thompson and Mr Smith respectively. Whitby did not serve a witness statement, or even a draft witness statement, from Mr Barlow.
88. Thus Whitby did not call anyone to give first evidence either that they had personal knowledge that Ghulam was an experienced GRP moulder or that they had seen Ghulam at work at the Playfair Road premises, although they were prevented from calling Mr Thompson by circumstances outside their control. Nor did Whitby serve a signed witness statement from any such witness. Nevertheless, Stuart maintained that the individuals referred to above had made the statements he had attributed to them. I have no hesitation in accepting that evidence.
89. No reason was advanced as to why Messrs Barlow, Delduca, Smith and Thompson should have lied to Stuart. Amer and counsel for Ghulam relied upon Mr Smith's disavowal of his draft witness statement as undermining not merely his hearsay evidence, but also the hearsay evidence of the other three witnesses. It is clear that Mr Smith wanted to avoid being called as a witness, however. This is understandable: as Stuart said, the ice cream business is a "rough and tough" one, and therefore Mr Smith (and Messrs Barlow and Delduca) may well have feared retribution if they were to give evidence. Furthermore, Mr Thompson did not disavow his draft witness statement and had a good explanation for his non-attendance.
90. Amer, Omar and Ghulam all denied that Ghulam was an experienced GRP moulder. I did not believe this evidence for the following reasons. First, as explained above, all three witnesses lacked credibility. Secondly, as explained above, I am satisfied that

they lied in other respects to cover up Ghulam's involvement. Thirdly, there is the hearsay evidence of Messrs Barlow, Delduca, Smith and Thompson. I recognise that this has not been confirmed by signed witness statements, let alone tested in cross-examination. Nevertheless, I consider that it does have some weight. Fourthly, Ghulam's medical records show that he had suffered two injuries in the past, one of which he admitted had occurred while repairing an ice cream van, suggestive of his involvement in such activities. Fifthly, Amer and Omar had no plausible explanation as to how and when they had acquired the necessary GRP moulding skills to undertake the first conversions in 2011.

#### *Primary liability*

91. In his closing submissions counsel for Whitby focussed the allegation of primary liability on the sale by Ghulam of WU57 YHX. So far as infringement of the Registered Design is concerned, sale of an infringing article is an infringement without proof of knowledge or reason for belief. So far as infringement of the design rights in the Designs is concerned, knowledge or reason for belief is required. In my judgment Ghulam had the requisite reason for belief due to his participation in the copying of the Mondial. In addition, Whitby's patent attorneys sent all of the Defendants letters before action on 9 January 2012. Accordingly, I conclude that Ghulam infringed both the Registered Design and the design rights in the Designs.

#### *Joint liability*

92. The principles concerning joint tortfeasance were reviewed by Kitchin J (as he then was) in *Twentieth Century Fox Corp v Newzbin Ltd* [2010] EWHC 608 (Ch), [2010] FSR 21, where he concluded at [108]:

“I derive from those passages that mere (even knowing) assistance or facilitation of the primary infringement is not enough. The joint tortfeasor must have so involved himself in the tort as to make it his own. This will be the case if he has induced, incited or persuaded the primary infringer to engage in the infringing act or if there is a common design or concerted action or agreement on a common action to secure the doing of the infringing act.”

93. Applying these principles, I conclude that Ghulam is jointly liable for Amer and Omar's infringements of the Registered Design, the design rights in the Designs and the Trade Mark since he funded the purchase and conversion of at least two vans, he participated in the copying of the Mondial and he sold at least one of the copy vans.

#### Conclusions

94. For the reasons given above, I conclude that YSVL, Amer, Omar and Ghulam have all infringed the Registered Design and the design rights in the Designs except for the base frame. I also conclude that Amer and Omar have infringed the Trade Mark, and that Ghulam is jointly liable for Amer and Omar's infringements of the Registered Design, the design rights in the Designs and the Trade Mark. I should make it clear that I have only concluded that Ghulam is liable for the specific infringements considered in this judgment. Whether he is liable or jointly liable for later

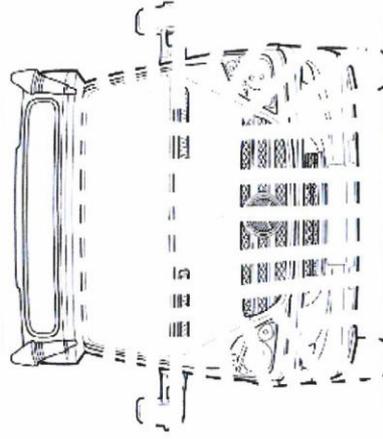
infringements will have to be determined on the inquiry as to damages or account of profits.

Annex

Mondial Registered Design  
and corresponding photo



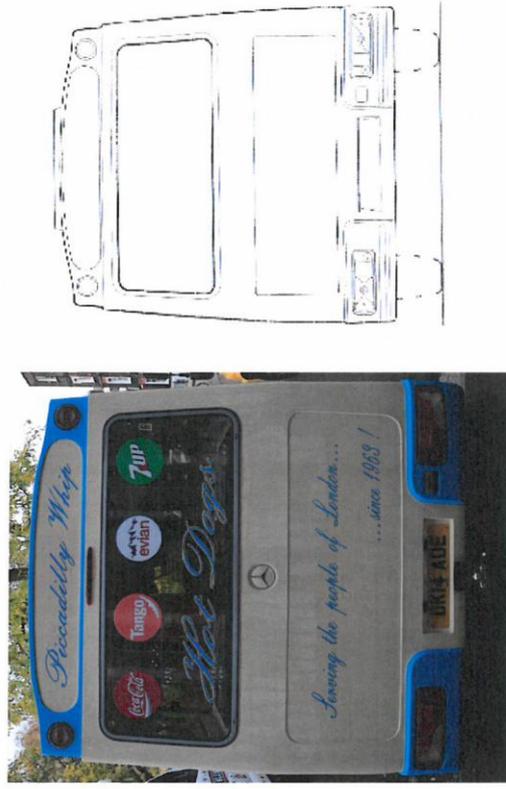
Millennium



Millennium

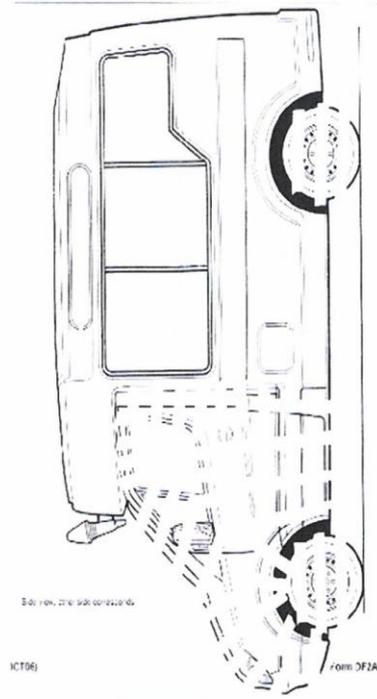


Mondial Registered Design and corresponding photo



(For back view of Millennium  
see 2/334)

Mondial Registered Design



Millennium



Millennium

Mondial Registered Design and corresponding photo

(For side view of Millennium  
see 2/327-328)

