

A case of registered design infringement

- ▶ Final word from the Supreme Court on the design infringement battle between Trunki and the Kiddee Case
- ▶ Court must form an "overall impression" of a design when considering infringement
- ▶ Trunki's "horned animal" different from the "insect with antennae" or "animal with ears" of the Kiddee Case

What's it about?

Magmatic Limited (**Magmatic**), the owner of the Trunki brand, had sued PMS International Group PLC (**PMS**) for registered design infringement in relation to PMS's Kiddee Case. Magmatic won in the High Court, but the decision was reversed on appeal. Magmatic then appealed to the Supreme Court.

Why does it matter?

This marks the first occasion that the Supreme Court has considered the Community Designs Regulation (6/2002/EC), which governs European design rights.

The Supreme Court confirmed that a judge must form a view on the overall impression of the design, which must then be compared to the alleged infringement. It is not enough to say that certain features are the same and certain features are different, which is what the High Court had said. The "horned animal" view of the Magmatic design taken by the Court of Appeal was affirmed. This Supreme Court agreed that this was sufficiently different to the Kiddee Case's "insect with antennae" and "animal with ears" impressions.

Magmatic also said that its registration was for a shape, and the surface decoration on the Kiddee Case should be ignored for the purposes of assessing infringement. The Supreme Court noted that where the shape of the design gave a strong overall impression (like the Magmatic registration), then any ornamentation would need to be positively distracting to strongly influence the infringement assessment. However, while the Supreme Court said that the decoration was a subsidiary part of the Court of Appeal's conclusion (enhancing the overall impression of the shape of the Kiddee Case), it was not prepared to declare that decoration should be ignored in every situation.

The Supreme Court also agreed with the Court of Appeal that the inclusion of computer aided designs (CADs) rather than line drawings in the registration had an impact on the scope of protection of the design. Some parts of the design were shown as black and some as grey. The Court of Appeal said the black elements were "features" of the registered design. Again, when compared with the Kiddee Case, these features were not present and influenced (minimally) the overall impression.

Now what?

Magmatic had said before the judgment that if its appeal was rejected, innovative British design and its contribution to the economy would be placed under threat.

From a design rights holder's point of view the judgment could be seen as disappointing. The Supreme Court did not firmly reject the proposition that ornamentation on the alleged infringement can have an effect on its overall impression when compared with the design. Also, it might be interpreted as narrowing the difference required before a product will be held non-infringing.

Finally, this case may have a sting in the tail for designers who have filed CAD designs rather than line drawings, and in doing so unwittingly limit their protection. The advice for future filings will be to always include a filing with line drawings for the widest possible protection, even if separate applications are made for CADs and/or coloured/patterned representations of the same design.

[PMS International Group Plc v Magmatic Ltd \[2016\] UKSC 12, 9 March 2016](#)

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