



Wheels Come Off “Trunki” Child’s Wheeled Suitcase Design Enforcement in Court of Appeal

A registered design may protect the appearance of the whole or a part of a product resulting from its lines, contours, colour, shape, texture or ornamentation. A Community design must include representations of the design suitable for reproduction and an indication of the product in which it is to be incorporated. However, the indication of the product in which the design is to be incorporated does not limit the scope of protection. For example, a design for a wine vessel would also cover a vase. The scope of protection must therefore be determined by the representations of the design alone. Prior to harmonisation under the Community Design system, a UK registered design would include a statement that the novelty of the design lay in shape and configuration or pattern and ornamentation or both. No such statement is made in a Registered Community Design.

It is broadly accepted that a design consisting of line drawings in monochrome, is directed to the shape of the product and is not limited to a particular colour, for example. This principle was established in *Proctor & Gamble v Reckit Beckiser*. The Community design considered in this briefing, consisted of monochrome, computer generated representations. Accordingly, the Judge at the court of first instance concluded that the level of generality at which the infringing products should be compared, did not include colour, or surface decoration. The final comparison and conclusions on the “overall impression” produced by the design and the “Kidee case” was therefore made based only on their shapes.

On appeal, PMS contended that it was wrong to disregard the surface decoration of the “Kidee Case”.

In considering how the design should be interpreted, as well as commenting on *Proctor & Gamble v Reckit Beckiser* (with which the Judge agreed), the Judge also referred to

Samsung v Apple (2012). In that case, although Apple’s design also consisted of monochrome line drawings, a striking feature of the design (as Apple itsecontended) was the absence of

ornamentation. Therefore, the presence of ornamentation, in the form of a Samsung trademark, on the Samsung product, was regarded as a significant point of distinction. The Judge did not consider these two cases as conflicting.

Now, applying the lessons from both of the above cases to the present case, the Judge noted that although the “Trunki” design was in monochrome, it was not a line drawing; the computer generated representations clearly depicted the effect of light reflecting upon its surfaces and distinct colour contrast between the wheels and the body of the design. On this global assessment, it was concluded that the design clearly and intentionally give the impression of a horned animal, in part at least, due to the absence of any decoration suggesting otherwise.

In contrast, in one version of the “Kidee Case” the overall impression is influenced by two tone colouration and spots on the body. This results in a case which looks like a ladybird with antennae for handles. In a second version of the “Kidee Case”, stripes on the body and whiskers at the front convey the impression of a tiger with floppy ears for handles. Neither of these being horned animals.

Accordingly, the overall impression of the “Kidee Case” on the notional informed user was considered different to that of the “Trunki” design, so did not infringe.

This case flags the importance of carefully considering the representations filed with a design application and the impression they create. With the option to file multiple designs in a single application, it is worth thinking about filing multiple variations on a design to ensure that a design is viewed at an appropriate level of generality. For example, it may be advantageous to file line drawings, rendered drawings and colour contrasted drawings in a single multiple design application. If Magmatic had filed a design represented by skeletal line drawings, perhaps the Judge would not have concluded that the surface decoration of the “Kidee Case” should be taken into consideration.

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