

# AIPPI Rapid Response: Observations on the Supreme Court decision in *Magmatic v PMS*

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# What is a design?

## Community rights – what is protected?

**Art 3(a)** “design” means the appearance of the **whole** or a **part** of a product resulting from the features of, in particular, the lines, contours, colours, **shape**, **texture** and/or materials of the product itself and/or its **ornamentation**;

**Art 3(b)** “product” means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

**Art 4(1)** A design shall be protected by a Community design to the extent that it is **new** and has **individual character**.

# Obscure disclosures - legislation

**Art 7(1)** - For the purpose of applying Articles 5 [*new*] and 6 [*individual character*], a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed [*before the relevant date*]

except **where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.**

Included to balance worldwide novelty requirement (previously some states only looked at national novelty)

# Trunki – Magmatic v PMS



rodeo  
the rideable  
childrens  
luggage  
system



1998 BASF/ Institute of Materials Design Awards

# How obscure?

Designer entered student design competition – sponsored by plastics industry – poster shown at the awards ceremony:

- Not on the BASF website at priority date
- Event only attended by 20 or so people – no list available
- Nearly all students
- Picture only put on web *after* Trunki became well known
- Even if you could find picture there was no way, short of asking designer, to get hold of the actual Rodeo

HELD: Does constitute prior art – it was possible that people connected with the luggage trade would have attended the award ceremony and seen Rodeo poster

# P&G v. Reckitt Benckiser

## Shape alone?

0001.2



0001.3



0001.4



# Samsung v Apple

## UK Court of Appeal

[16]... Apple was contending that a feature of the registered design was “A flat transparent surface without any ornamentation covering the front face of the device up to the rim.”



# The Trunki, the Kiddee Case, & the Rodeo



Magmatic's Trunki case



Magmatic's RCD



PMS's Kiddie case



**rodeo**  
the rideable  
childrens  
luggage  
system





## Was the design for:

1. Shape alone, with contrast/surface decoration irrelevant
2. Shape + tonal contrast
3. Shape + absence of surface decoration
4. Shape + absence of surface decoration + presence of tonal contrast



# What was the original permission to appeal?



- (1) Whether, when making the assessment of the overall impression created by the Kiddee Cases, the court should take into account the graphical designs printed on the surface of such cases (the “surface decoration”) or whether it should only take into account the features of shape of the Kiddee Cases



- (1) If surface decoration is to be taken into consideration, whether the Kiddee cases do not produce on the informed user a different overall impression

# How was Magmatic's appeal to the Supreme Court structured?

- (1) Interpretation of a design is a question of fact, therefore following *Designer's Guild* first instance decision should be reinstated.
- (1) If not a question of fact, then a legal question which is not *acte clair* and so it must be referred.

# Court of Appeal criticisms of Arnold's judgment



1. The judge failed to give proper weight to the overall impression of the Trunki CRD as an animal with horns.
1. The judge failed to take into account the effect of the lack of ornamentation to the surface of the CRD, i.e. that the absence of decoration reinforced the horned animal impression.
1. The judge ignored the colour contrast in the CRD between the body of the suitcase and its wheels.

# Absence of ornamentation claimed?

The point on which permission to appeal was given. But the Supreme Court did not decide it because it considered it irrelevant.

[50] There are powerful practical arguments against such a conclusion, namely the absence of any apparent reason for such a limitation and the inherent unlikelihood of the design of a child's ride-on suitcase positively requiring no ornamentation *[arguable whether relevant]*. On the other hand, there is the elegant uncluttered appearance of the CRD with the play of light on the product's surface as described by Kitchin LJ, the use of a CAD rather than a line drawing, the existence of some specific limited colour differentiation (the strap, strips, wheels and spokes), and (in so far as admissible) *[how can these be admissible?]* the initial unornamented product and the contrast with Magmatic's subsequent registered designs (see para 3 above).

# If relevance of ornamentation not decided, how can infringement be decided?

Logically, the only way to decide infringement in these circumstances would be to say that either

- (a) the shape alone (and possibly colour contrast) were sufficiently different for there to be no case of infringement or
- (b) the shape alone was sufficiently similar for there to be infringement whatever the surface decoration/colour contrasts of the Kiddee Case.

Is (a) what the Supreme Court decided? Or was there some other basis for the decision?

# Court of Appeal

“41. ... Further and importantly, the suitcase looks like a horned animal with a nose and a tail, and it does so both because of its shape and because its flanks and front are not adorned with any other imagery which counteracts or interferes with the impression the shape creates *[Absence of surface decoration a feature of the design?]*. ... the CRD is, in that sense, relatively uncluttered and it conveys a distinct visual message. Here then the first of the judge’s errors can be seen: he failed to appreciate that this is a design for a suitcase which, considered as a whole, looks like a horned animal.”

# Court of Appeal

[47] First and most importantly, ... the judge failed to carry out a global comparison having regard to the nature of the CRD and the fact that it is clearly intended to create the impression of a horned animal *[Because judge considers an absence of surface decoration to be a feature]*. This is plainly one of its essential features. Necessarily, therefore, a global assessment of the CRD and the accused designs requires a consideration of the visual impression they each create and in so far as that impression is affected by the features appearing on their front and sides, it seems to me those other features must be taken into account *[Taking into account surface decoration]*. ...



# Court of Appeal

[47] .... Thus taking the insect version of the Kiddee Case, I believe that the impression its shape creates is **clearly influenced** by the **two tone colouring of the body and the spots on its flanks**. As a result it **looks like a ladybird** and the handles on its forehead look like antennae. Overall the shape conveys a completely different impression from that of the CRD. It was, in my judgment, **wrong for the judge to eliminate the decoration on the accused design from his consideration** entirely because it significantly affects how the shape itself strikes the eye, and the overall impression it gives. At least in the case of this particular registered design, the global comparison necessarily requires account to be taken of the context in which the accused shape appears. ...”

# Supreme Court

40. As he explained in paras 41 and 47 of his judgment, Kitchin LJ disagreed with Arnold J when it came to the question of the decoration on the Kiddee Case. Kitchin LJ was of the view that the fact that the CRD image was “not adorned with any ... imagery” reinforced the impression it gave of “a horned animal with a nose and a tail”. By contrast, he said, “the impression” which the shape in the first example of the Kiddee Case in para 4 above creates is “clearly influenced by the two tone colouring of the body and the spots on its flanks”, so that “it looks like a ladybird and the handles on its forehead look like antennae” ....

# Supreme Court

40. ... This, he said, effectively reinforced the conclusion that the Kiddee Case produced on the informed user a completely different overall impression from the horned animal embodied in the CRD design. The same conclusion, he said, applied to the second example of the Kiddee Case, as “[t]he stripes on its flanks and the whiskers on either side of its nose immediately convey to the informed user that this is a tiger with ears. It is plainly not a horned animal.

41. In my view, the point which Kitchin LJ was making in this second criticism was that the absence of decoration on the CRD reinforced the horned animal impression made by the CRD. In other words, he considered that it supported what I have called his first criticism of Arnold J’s judgment. ...”

# Supreme Court

41. ... In my view, there is limited force in this point, in that, unless the decoration had been positively distracting in nature, such as flashing lights, it would have been unlikely to have much effect in diluting the horned animal impression made by the CRD. However, I accept that the point has some force, in the sense that, unless it included items such as eyes and a mouth, any decoration could well detract from the animal impression, and, even if it consisted of such items, it could be said to distract the observer's attention from the horns.

**Any Questions??**