

# Bird & Bird & IP and IT Bytes

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## Data protection: Personal data

### Summary

The Court of Appeal has held that a person's name is personal data within the meaning of the Data Protection Act 1998 (DPA) unless it is such a common name that, without further information, a person would remain unidentifiable.

### Background

The DPA, implementing the Data Protection Directive (95/46/EC) in the UK, introduced an extensive data protection regime by imposing broad obligations on those who process personal data (data controllers), as well as conferring broad rights on individuals (data subjects about whom data are processed).

The DPA defines "personal data" as data relating to a living individual who can be identified either from those data, or from those data and other information that is in the possession of, or is likely to come into the possession of, the data controller, including any expression of opinion about the individual and any indication of the intentions of the data controller or any other person in respect of the individual.

The two key elements of the definition are relation and identification. According to the Information Commissioner's technical guidance on determining what is personal data, an individual is identified if that individual can be distinguished from other members of a group ([www.ico.org.uk/upload/documents/library/data\\_protection/detailed\\_specialist\\_guides/personal\\_data\\_flowchart\\_v1\\_with\\_preface001.pdf](http://www.ico.org.uk/upload/documents/library/data_protection/detailed_specialist_guides/personal_data_flowchart_v1_with_preface001.pdf)). In most cases, an individual's name together with some other information will be sufficient to identify them. Data may "relate to" an identifiable living individual in several ways, one being where the information is obviously about a particular individual. If both elements are satisfied, it is personal data.

The European Court of Justice has confirmed that a person's name, in conjunction with job-related information, is their personal data (*Bodil Lindqvist v Kammaraklagaren, C-101/01*). For example, personal data includes the name of a person in conjunction with his telephone co-ordinates or information about his working condition or hobbies.

The Freedom of Information Act 2000 (FOIA) entitles individuals to be provided with information that is held by public authorities, unless an exemption applies. Disclosure under the FOIA is to the world at large. Where an FOIA request is for third-party personal data, section 40(2) of the FOIA (section 40(2)) provides an exemption from disclosure if that disclosure would contravene one of the data protection principles in the DPA.

### Facts

E made a request under the FOIA for information held by the Financial Services Authority (FSA) about him and his complaint that the FSA had failed to regulate Egg Plc properly.

In response, the FSA withheld the names of three junior employees (and the holiday arrangements of another) under section 40(2). All three employees had worked on E's complaint but had not corresponded with him as they did not have public-facing roles. The redacted names were in a small number of internal emails and documents, as sender or recipient of the email. The three employees were not responsible for making significant decisions in relation to the regulation of the firms assigned to their division.

The First-tier Tribunal held that the names were not personal data. On appeal, the Upper Tribunal reversed that decision, finding that the names were obviously personal data and, as there was no legitimate interest under the DPA to disclose them, disclosure would be in breach of the first data protection principle. E appealed.

## Decision

The court dismissed the appeal, holding that a person's name is personal data unless it is such a common name that, without further information (such as its use in a work context), a person would remain unidentifiable despite its disclosure.

The court said that it is not always necessary to consider "biographical significance" to determine whether data are personal data. In many cases, data may be personal data simply because their content is obviously about an individual. Alternatively, data may be personal data where they are clearly linked to an individual because they are about his activities and are processed to determine or influence the way in which he is treated. "Biographical significance" only needs to be considered where information is not obviously about an individual or clearly linked to him.

Following *Lindqvist*, the three employees could be identified from a combination of their names and the documents emanating from the FSA, which showed that they worked there. The three names referred to in the emails were obviously about the three employees and no further enquiry was needed.

The FSA had correctly followed the ICO's guidance on handling requests for personal data about public authority employees in refusing to disclose the names under section 40(2) and both the Upper Tribunal had been correct in declining to order disclosure of the names.

## Key factors underlying the court's reasoning were:

- The end user no longer needs to go to W's website, since he can consult the contents in real time through I's website. Therefore, W would lose the income (for example, from advertising) that would otherwise enable it to recoup the investment costs of setting up and operating the database.
- The end user has access to W's database that is different from the access route that W intended, while providing the same advantages in terms of searches.
- The "making available" in Article 7(2)(b) of the Directive is to the public, as anyone can use a dedicated meta search engine. The re-utilisation involves a substantial part of the contents of W's database as the entire contents of that database can be searched as though the query were entered directly into W's search engine. The fact that only part of the W database is actually consulted and displayed on the basis of the search criteria specified by the end user is irrelevant, and does not detract from the fact the entire W database is made available to that end user.

## Comment

This decision distinguishes *Durant v Financial Services Authority*, where the Court of Appeal had previously considered the scope of the definition of personal data ([www.practicallaw.com/9-102-6113](http://www.practicallaw.com/9-102-6113)). Following the *Durant* principles, the First-tier Tribunal had found that the information was not biographical in any significant sense as it simply concerned a transaction or matter in which the employees were involved and they were not the focus of the information. However, such questions of biographical significance were not relevant to the primary question of whether the information was obviously about an identifiable living person or clearly linked to him, such as a person's name and place of work.

*Case: Efiñom Edem v Information Commissioner and Financial Services Authority [2014] EWCA Civ 92.*

## Patents: Innocent infringement

### Summary

The High Court has held that a patent was valid and infringed, and dismissed a defence to a damages claim based on an assertion of innocent infringement.

## Background

Under section 62(1) of the Patents Act 1977 (section 62(1)), in proceedings for patent infringement, damages or an account of profits are not awarded against a defendant that proves at the date of the infringement that it was not aware, and had no reasonable grounds for supposing, that the patent existed. Knowledge, or reasonable grounds for supposing that the patent existed, is not imputed by reason only of the application to a product of the word “patent” or “patented”, or other words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the words in question.

## Facts

C sued A for infringement of its patent for a fire-resistant LED downlighter (the patent). A claimed that:

- The patent was invalid on grounds of anticipation and obviousness.
- If the patent was valid, A’s products did not infringe.
- If A’s products did infringe, C was not entitled to damages under section 62(1) because A was not aware of the patent and had no reasonable grounds for supposing that it existed.

## Decision

The court held that the patent was valid and infringed. On a purposive construction, A’s products involved immaterial variants to the patent. C could recover damages for the infringement as A had not proved the defence of innocent infringement.

In applying section 62(1), the burden was on A to prove that it neither knew nor had reasonable grounds for supposing that the patent existed. Having reasonable grounds is an objective test: if a defendant should have known that the patent existed, it is immaterial that it considered that the patent was invalid or that its product would not infringe.

On the balance of probabilities A, as a major supplier of lighting products, would have been aware of advertisements promoting C’s product. In a field where manufacturers obtained patents for luminaires involving innovative features (A held ten patents for downlighter units) and C’s product was described in a trade magazine article as innovative, this would have been sufficient to put A on notice that C’s product might have patent protection. It was irrelevant that neither the article nor the advertisement identified the patent by number.

The starting point for the design of A’s product was C’s product, which, by mid-2010, was enjoying considerable commercial success. A used a patent agent for its own patents, but did not instruct him to carry out a patent search while A’s product was being designed. A had good grounds for supposing that a patent existed on one of C’s products, and could have been expected to find out. That search would first have been conducted under the name of an associated company, but since no patent was filed under that name, and since A suspected that they were related companies, a search would have been made under C’s name.

The court concluded that this search would have found the international patent application from which the patent derived. In the circumstances, A had not discharged its burden of showing that it had no reasonable grounds for supposing that a patent existed on C’s product.

## Comment

This decision sets a high hurdle for defendants wishing to establish innocent infringement in patent cases. Where a patentee has marketed products within the scope of the patented invention, a defendant in the same industry would be unlikely to have reasonable grounds for supposing that no patent existed without having undertaken a reasonable search, particularly, as here, where the industry is heavily patented.

In such cases, it would be expected that a thorough patent search would be undertaken, extending to associated products and related companies where these are known or suspected. Marking products as patented without including the patent number cannot be used to show that a defendant knew or had reasonable grounds for supposing that the patent existed. However, a defendant cannot prove lack of knowledge and no reasonable grounds for supposing that there was a patent merely by reason of the

omission of the patent number in an article, read by that defendant, describing the innovative features of a new product.

*Case: Collingwood Lighting Ltd v Aurora Ltd [2014] EWHC 228 (Pat).*

## Trade mark infringement: Advertising and online searching

### Summary

The High Court has held that the Community trade mark “LUSH” was infringed by means of keyword advertising, and using a website’s search engine to generate sponsored advertisements within search results that directed consumers to products not originating from the trade mark owner.

### Background

Article 5(1)(a) of the Trade Marks Directive (89/104/EEC, now replaced by Directive 2008/95/EC) (Article 5(1)(a)) provides that the owner of a registered trade mark may prevent third parties from using in the course of trade any sign which is identical to its mark in respect of goods or services which are identical to those for which the mark is registered. A claim under Article 5(1)(a) can only succeed if the use affects, or is liable to affect, the functions of the trade mark, which include its origin, advertising, investment and communication functions (*L’Oréal SA v Bellure NV*; see News brief “Smell-alikes: a rose by any other name”, [www.practicallaw.com/4-386-7893](http://www.practicallaw.com/4-386-7893)).

Google France SARL established that where an advertiser bought a keyword that was similar to a trade mark, the trade mark’s function of indicating origin would be adversely affected if the advertisement did not enable normally informed and reasonably attentive internet users, or enabled them only with difficulty, to ascertain whether the goods or services referred to in the advertisement originate from, or were connected with, the owner of the mark or, on the other hand, originated from a third party (see Exclusively online article “Google AdWords: liability shifts to advertisers”, [www.practicallaw.com/8-501-8166](http://www.practicallaw.com/8-501-8166)).

### Facts

L were the registered owner and exclusive licensee of a Community trade mark (CTM) for the sign “LUSH” for cosmetics and toiletries, including soap, in class 3. A had bid on certain keywords, including “lush”, within the Google AdWords service so as to trigger a sponsored link advertisement appearing on the Google search engine results page whenever a consumer typed “lush” into the search box.

A’s website search facility also offered consumers who typed the word “lush” a drop down menu of options, such as “lush bath bombs” or “lush cosmetics”, redirecting them to products similar to, or competitive with, L’s products, but without any overt reference to L’s products not being available from A’s website.

L brought proceedings for infringement of the LUSH CTM against A under Article 5(1)(a).

### Decision

The court held that A’s sponsored advertisements, triggered by keywords including “Lush”, which included the LUSH CTM, infringed Article 5(1)(a). There was also infringement of Article 5(1)(a) where a consumer typed the word “Lush” into A’s website search facility.

The average consumer seeing A’s advertisement would expect to find L’s products available on A’s website at a competitive price. Such a consumer was likely to think that A was a reliable supplier of a very wide range of goods and he would not expect A to be advertising L’s products for sale if they were not, in fact, available. On the facts of the case, the average consumer would not, without difficulty, ascertain that the goods referred to by the advertisement were not the goods of, or connected with, L.

The situation was different in relation to sponsored advertisements that did not include the LUSH CTM. Consumers, familiar with such advertisements, are used to seeing them from competing suppliers. Since L were brand conscious and had made great efforts to build up a reputation in the LUSH CTM, average consumers would expect an advertisement for L’s products to include some reference to the LUSH CTM, in

order to distinguish it from the advertisements of others that they might expect to see on the results page of a Google search.

A's purpose and effect in using the LUSH CTM on its website was to induce consumers to buy non-L products. A's search engine had been designed in order to maximize the sale of goods from its website. The average consumer was unlikely to know how the drop down menu had the content that it displayed, but he was likely to believe that it was intended to be helpful to him and was in consequence of searches that had been carried out. Such an average consumer typing "Lush" into the search box would not think that the drop down menu reference to, for example "Lush bath bombs", was a reference merely to products that were similar to, or competitive with, the L's products. The absence of any reference to L on the display of the goods did not absolve A.

A's search facility assumed that the consumer intended to search for L's products and, without a further indication that such products were not available, offered competing products to the consumer. In these circumstances, the average consumer would find it difficult to ascertain that the products he was shown were not L's products. A was using the LUSH CTM as a generic indicator of a class of goods; conduct that the court considered to be an attack on the ability of the CTM to act as a guarantee of origin.

There was use in the course of trade, which affected the functions of the CTM. As well as damaging the origin function of the LUSH CTM, the court also held that A's use damaged both the advertising function and the investment function of the LUSH CTM. In relation to the advertising function, the quality of attracting custom was damaged by A's use of the LUSH CTM to attract the attention of consumers and attempt to sell to them third party's goods while, at the same time, making no effort at all to inform the consumer that the goods being offered were not L's products.

In relation to the investment function, L had built up an image of ethical trading. To preserve this image it had taken the decision not to allow its goods to be sold on A's website because of the damage that it perceived there would be to that reputation. Some consumers, for example, might regard negatively A's attitude to UK taxation.

## Comment

This decision is an interesting application of the legal principles distilled from *Google France* and *Interflora v Marks & Spencer* (see News brief "Adwords and negative matching: round two for M&S", [www.practicallaw.com/5-535-1306](http://www.practicallaw.com/5-535-1306)). As well as considering the much-litigated issue of keywords through Google AdWords, it also looks at the triggering of sponsored advertisements by a company's own search engine; in this case using A's specially developed software based on analysis of consumers' browsing histories on A's website.

There is a useful analysis of what is required, in the context of infringement by keyword advertising and online search results, to affect the origin, investment and advertisement functions of a trade mark. The court noted, citing *Interflora*, that it can make up its own mind, for example, on the question of whether the average consumer might erroneously think that the goods advertised emanate from the trade mark owner, without the need for expert evidence or the evidence of consumers.

*Case: Cosmetic Warriors Ltd and another v amazon.co.uk Ltd and another [2014] EWHC 181 (Ch).*

## Trade mark infringement: meaning of due cause

### Summary

The European Court of Justice (ECJ) has ruled on the scope of the concept of due cause in Article 5(2) of the Trade Marks Directive (89/104/EEC, now replaced by Directive 2008/95/EC) (Article 5(2)) in relation to trade marks with a reputation in an EU member state.

### Background

Under Article 5(2), the owner of a trade mark that has a reputation in a member state can prevent third parties from using, in the course of trade, a sign which is identical with, or similar to, the trade mark in relation to dissimilar goods or services to those for which it is registered, where the use of that sign without

due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark. Article 5(2) also applies where the goods or services are similar to, or identical with, those for which the mark is registered.

## Facts

R owned the word and figurative mark RED BULL in the Benelux countries for goods in, among other things, class 32 (non-alcoholic drinks). It was agreed that the mark RED BULL enjoyed a reputation in the Benelux countries.

R brought proceedings against V concerning the production and marketing of energy drinks with packaging that displayed the “Bull Dog” sign. R argued that V’s use of the distinctive sign “The Bull Dog” in relation to the packaging and marketing of energy drinks adversely affected its RED BULL marks.

V had been using the sign “The Bulldog” as a trade name for hotel, restaurant and café services involving the sale of drinks since 1975, before the RED BULL mark was filed. V also owned various Benelux trade marks for goods in class 32, including the word and figurative mark “The Bulldog”, registered in 1983. V had also sold energy drinks under “The Bull Dog” from an unspecified date.

The Amsterdam Regional Court of Appeal held that the RED BULL mark had a reputation within the Benelux countries and V’s use of the mark “The Bulldog” was seeking to take advantage of the reputation of the RED BULL mark without due cause. The court found that the use of the mark was without due cause, despite V’s prior use of the mark for hotel, restaurant and café services, including the sale of drinks.

The Supreme Court referred to the ECJ the question of whether there can be due cause within the meaning of Article 5(2) where the sign that is identical or similar to the trade mark with a reputation was already being used in good faith by the third party concerned before that trade mark was filed.

## Decision

The ECJ held that the owner of a trade mark with a reputation may be obliged, pursuant to the concept of due cause in Article 5(2), to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that the sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith.

Where the owner of the mark with a reputation had demonstrated the existence of one of the forms of injury referred to in Article 5(2), the onus was on the third party using a sign similar to the mark with a reputation to establish that he had due cause for using such a sign.

The concept of due cause could include not only objectively overriding reasons, but could also relate to the subjective interests of a third party using a sign identical or similar to the mark with a reputation.

In order to determine whether use in good faith by a third party, before a trade mark with a reputation was filed, of a sign similar to that mark may constitute due cause within Article 5(2), and justify the fact that that third party takes advantage of the repute of that mark, the national court must carry out an assessment, taking into account, in particular:

- How that sign has been accepted by, and what its reputation is with, the relevant public.
- The degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered.
- The economic and commercial significance of the use for that product of the sign which is similar to that mark.

Where a sign had been used in good faith before the registration of a mark with a reputation in relation to services and goods that may be linked to the product for which that mark has been registered, the use of that sign in relation to that latter product may appear to be a natural extension of the range of services and goods for which that sign already enjoys a reputation with the relevant public. The greater the repute of the sign used, before the registration of a similar mark with a reputation, for a certain range of goods and services,

the more its use would be necessary for the marketing of a product identical to that for which the mark was registered.

Likewise, where a product is close, by its nature, to the range of goods and services for which that sign was previously used, it is more likely to be perceived as a genuine brand extension. So it would be more likely to be a genuine brand extension if V's sign "The Bulldog" had been used for energy drinks before the mark RED BULL acquired its reputation.

## Comment

Although the judgment provides guidance on the concept of due cause in Article 5(2), the principles need to be applied by the national court and much will depend on the facts in each case. Reliance on the concept of due cause in this context does not lead to the positive recognition of third-party rights connected with a registered mark, but rather obliges the owner of the mark with a reputation to tolerate the use of a similar sign.

The third party use must also, importantly, be in good faith. The critical question is whether, in the light of the recognition enjoyed by V's sign "The Bulldog" among the relevant public, and the nature of the goods and services for which it had been used, the sale of energy drinks contained in packaging which displayed that sign would be perceived not as an attempt to take advantage of the repute of the mark "Red Bull", but rather as a genuine extension, made in good faith, of the range of goods and services offered by V. Since, at least in the UK, *L'Oréal v Bellure* has been interpreted to require an intention to take unfair advantage of the distinctive character or repute of the trade mark, it is not clear how the due cause defence, which requires use of the sign in good faith, could be used to justify taking an intentional advantage (see *News brief "Smell-alikes: a rose by any other name"*, [www.practicallaw.com/4-386-7893](http://www.practicallaw.com/4-386-7893)).

*Case: Leidseplein Beheer and de Vries v Red Bull GmbH and Red Bull Nederland BV, Case C-65/12.*

## Trade marks: character merchandising

### Summary

The High Court has held the use of Betty Boop imagery for a range of merchandise amounted to passing off and trade mark infringement of the BETTY BOOP word and figurative marks.

### Background

Infringement of a registered trade mark occurs when a third party uses, in the course of trade, a sign which is:

- Identical to that trade mark, for goods or services which are identical with those for which the trade mark is registered (section 10(1), Trade Marks Act 1994 (TMA)) (section 10(1)).
- Identical to that trade mark, for goods or services which are similar to those for which the trade mark is registered, or similar to that trade mark for goods or services which are similar or identical to those for which the trade mark is registered, and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark (section 10(2), TMA) (section 10(2)).
- Identical with, or similar to, that trade mark where the trade mark has a reputation in the UK and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark (section 10(3), TMA) (section 10(3)).

The elements of the tort of passing off are:

- Goodwill or reputation attached to the relevant goods or services.
- A misrepresentation by the defendant to the public (whether or not intentional) leading, or likely to lead, the public to believe that the goods or services offered by it are those of the claimant.

- Damage to the claimant, arising from the erroneous belief (caused by the defendant's misrepresentation) that the source of the defendant's goods or services is the same as the source of those offered by the claimant.

## Facts

H owned registered UK and Community trade marks (CTMs) for the word "BETTY BOOP" and for a figurative mark, sometimes together with the words "BETTY BOOP" in small letters underneath, for merchandise in a number of classes.

H claimed that it was the only legitimate source of Betty Boop merchandise in the UK and that A had committed trade mark infringement under section 10(1) in relation to the word marks, and under sections 10(2) and 10(3) in relation to all the marks, and had also committed passing off.

A denied trade mark infringement and passing off and claimed that it was also a legitimate source of Betty Boop imagery, which it had derived from reconditioned old movie posters. A argued that its imagery was decorative and made no representation about trade origin. A also argued that the marks were invalid as devoid of distinctive character because they constituted the name or image of the well-known Betty Boop character and/or were descriptive.

## Decision

The court held that A had infringed H's UK and CTMs under sections 10(1), 10(2) and 10(3) and had committed acts of passing off; namely, that the Betty Boop merchandise sold under licence by A was authorised by H or was official Betty Boop merchandise (a deception practised on both the trade and the public). There was also a deception practised on A's licensees; namely, that they had been granted a licence in respect of Betty Boop by H or by a party authorised by H.

On the issue of whether there had been "use of a sign in relation to the goods" the court held that the public would (as well as seeing the image as aesthetic and decorative) also see Betty Boop as a sign related to trade origin.

The court held that passing off was established on the facts. H had been the sole source of Betty Boop merchandise in the UK for about 20 years. This trading had led licensees and their buyers to be familiar with Betty Boop character merchandise and licenses relating to it as deriving from one source. They believed that there was an official source of Betty Boop merchandise and that it was H. This was the case whether or not H was known by name.

The general public had also come to recognise Betty Boop merchandise as licensed by a single "official" source and to see Betty Boop as a "brand". On the evidence, the court concluded that the average consumer had been educated by H and their agents to see these signs as trade marks that conveyed origin information.

## Comment

Characters used in merchandising have traditionally been difficult to protect under English law by trade mark infringement or passing off primarily because the appearance of a well-known character (real or fictional) on a product may not have origin significance. Without many years of education, the public is likely to regard the appearance of a famous character on a t-shirt or in a poster as not conveying any origin information. Each case will turn on its own evidence.

The court cited its own decision in *Fenty v Arcadia* (involving the pop star Rihanna) in which it noted that there was in England no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image ([2013] EWHC 1945). However, the court also pointed out that it was probably easier to educate the public to believe that goods relating to an invented character, such as Betty Boop, derived from a single official source than it might be for a real person, since copyright law might give the inventor the ability to control the reproduction of the character for a very long time.

*Case: Hearst Holdings Inc and another v AVELA Inc and others [2014] EWHC 439 (Ch).*



# Community registered design: Assessment of infringement

## Summary

The Court of Appeal has held that a child's ride-on suitcase did not infringe a Community registered design (CRD).

## Background

Registered (and unregistered) Community designs are governed by the Community Designs Regulation (6/2002/EC) (CDR); they must be new and have individual character (Article 4(1)). A design is defined as 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 (Article 3(a), CDR).

A design is 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 that has been made available to the public before the filing or priority date of the design for which protection is sought (Article 6, CDR). When assessing individual character, the degree of freedom of the designer in developing the design is taken into consideration (Article 6(2), CDR).

The scope of the protection conferred by a Community design includes any design that does not produce on the informed user a different overall impression (Article 10(1), CDR). In assessing the scope of protection, the degree of freedom of the designer in developing his design is taken into consideration (Article 10(2), CDR).

In *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd (Ch)* the Court of Appeal considered in the circumstances of that case that, when considering the overall impression on an informed user, surface decoration in the accused design should be disregarded (see News brief "Community registered designs: spot the difference", [www.practicallaw.com/1-378-7732](http://www.practicallaw.com/1-378-7732)).

In *Samsung Electronics (UK) Ltd v Apple Inc* the defendant contended that a feature of the registered design for its tablet computer was that it had no ornamentation ([www.practicallaw.com/3-522-6097](http://www.practicallaw.com/3-522-6097)). The Court of Appeal accepted that a departure from no ornamentation would be taken into account by the informed user.

## Facts

M manufactured and sold a child's ride-on suitcase under the trade mark "Trunki" in respect of which M had been granted a CRD (the CRD).

P imported and sold a product similar to M's under the name "Kiddee Case", which came in two basic versions: an animal version with handles formed to look like ears; and an insect version with handles formed to look like antennae.

The High Court held that the CRD was infringed by the Kiddee Case. The CRD was for the shape of the suitcase and the graphical designs representing different animals and insects on the surface of the Kiddee Case were therefore not relevant when considering whether it gave a different overall impression to the informed user from that of the CRD. P appealed, arguing that the graphical designs on the surface of the Kiddee Case should have been taken into account.

## Decision

*The court upheld the appeal, finding that P's Kiddee Case did not infringe the CRD.*

*The High Court had erred in two respects. It had failed to appreciate that:*

- The CRD was a design for a suitcase which, considered as a whole, looked like a horned animal both because of its shape and because its flanks and front were not adorned with any other imagery that counteracted or interfered with the impression the shape created. A global assessment involved

considering the visual impression of each design, and where that impression was affected by features appearing on the suitcases, those features had to be taken into account.

- Each of the various representations of the CRD showed a distinct contrast in colour between the wheels and the strap on the one hand, and the rest of the suitcase on the other.

In view of the errors in the analysis of the CRD and, therefore, in the way that the global comparison of the two designs was carried out, the court was free to form its own view.

The court found that, although there were some similarities between the Kiddee Case and the CRD at a general level, the overall impression conveyed to the informed user by the Kiddee Case at both a general and detailed level was very different from that of the CRD. Whereas the impression created by the CRD was that of a horned animal, with a sleek and stylised design, generally symmetrical appearance, and a significant cut away semicircle below the ridge, the Kiddee Case was softer, more rounded and evocative of an insect with antennae or an animal with floppy ears. The Kiddee Case therefore did not infringe the CRD.

## Comment

*The key feature of this decision* is that in determining the scope of the CRD, the surface decoration and the colour contrast features, not only the shape, were relevant. It remains the case that, if a CRD comprises line drawings in monochrome and colour is not a feature of it, it is not a defence to infringement for a defendant to say that it was using the same design, but in colour or in a number of colours.

However, even though the representations in the CRD were in monochrome, the sophisticated nature of the computer-generated images of the design in this case meant that the surface decoration significantly affected how the shape struck the eye, giving the overall impression of a horned animal. Here, the global comparison necessarily required account to be taken of the context in which the accused shape appeared. In this context, the absence or existence of surface markings changed the way that the designs would be visualised by the informed user.

The decision may seem at odds with Procter & Gamble. However that case may be distinguished because it concerned line drawings rather than sophisticated computer-aided design images. In comparison with Samsung Electronics, the CRD did have some surface markings, but these likewise created a different overall impression from that of the accused design with its different surface decoration.

*Case: Magmatic Ltd v PMS International Ltd [2014] EWCA Civ 181.*