



Neutral Citation Number: [2016] EWHC 3151 (IPEC)

Case No: IP-2015-000088

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY ENTERPRISE COURT

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

Date: 07/12/2016

Before :

HIS HONOUR JUDGE HACON

Between :

ACTION STORAGE SYSTEMS LIMITED

Claimant

- and -

(1) G-FORCE EUROPE.COM LIMITED

**(2) FLETCHER EUROPEAN CONTAINERS
LIMITED**

Defendants

Jessie Bowhill (instructed by **J A Kemp**) for the **Claimant**

Richard Davis (instructed by **Borneo Martell Turner Coulston LLP**) for the **Defendants**

Hearing dates: 24-25 October 2016

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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HIS HONOUR JUDGE HACON

Judge Hacon :

Introduction

1. This is a case about UK unregistered design rights in plastic lockers – the type of lockers used in schools. The claimant (“Action Storage”) makes and supplies lockers, shelving and racking. A range of lockers has been sold since 2006 under the brand name ‘eXtreme Lockers’.
2. eXtreme lockers come in three sizes: 450mm, 600mm and 900mm high and in various colours. All three sizes can be fitted together, so that two 900mm lockers on top of each other may be fitted next to three 600mm lockers, or four 450mm lockers, in any desired combination to make a block. Height aside, all three sizes share a similar look although, for example, the 900mm lockers have three vents whereas the other two sizes have two vents.
3. The second defendant (“FECL”) was established in 1994. Its principal business is the manufacture of moulded plastic containers which it sells largely to the food industry. In 2010 FECL acquired a company called Hygiplas Containers Limited (“Hygiplas”). Since about 2006 Hygiplas had been selling Action Storage’s eXtreme lockers and it continued to do so until 2013. From 2010 to 2012 Hygiplas traded as a separate business and then in 2012 it was merged into FECL’s business.
4. The first defendant (“G-Force”) was established in 2013. FECL and G-Force share the same sole director and operate from adjacent premises in Wellingborough, Northamptonshire.
5. In 2013 the defendants launched a new range of lockers sold under the name ‘SuperTuff’. They are sold by both defendants and are made by FECL. Action Storage alleges that the design of the SuperTuff lockers was created by copying that of the eXtreme lockers and that the defendants have thereby infringed Action Storage’s design rights in the design of the eXtreme lockers as a whole, and also in the designs of parts of the lockers.
6. The defendants deny that their SuperTuff lockers are articles either exactly or substantially to the design of the eXtreme lockers. They also advance a number of grounds for lack of design rights.
7. Save where otherwise indicated, reference to a style of locker should be taken to mean the 450mm version and this size will be treated as representative of all sizes. Argument was largely directed to the 450mm lockers.
8. Jessie Bowhill appeared for Action Storage, Richard Davis for the defendants.

Not features of shape of configuration

9. It is convenient to begin with the defendants’ case that certain pleaded features of Action Storage’s eXtreme locker do not constitute features of shape and configuration. Mr Davis argued that Action Storage’s use of the terms ‘approximate’ and ‘general’ to define features of its lockers in its pleading – for instance ‘the

approximate position of vents in the door’ – indicated that Action Storage’s claim went beyond the precise dimensions of the eXtreme lockers themselves and included alternative designs which exist only in the abstract. He referred to my judgment in *DKH Retail Ltd v H. Young (Operations) Ltd* [2014] EWHC 4034 (IPEC); [2015] F.S.R. 21 and said that because of the amendment of s.213(2) of the 1988 Act pursuant to s.1(1) of the Intellectual Property Act 2014 (“the 2014 Act”), design right could not subsist in any of the features so defined in the Particulars of Claim.

10. During Ms Bowhill’s opening I asked her whether she was relying on design right solely in the precise features of the eXtreme locker or whether repeated use of the word ‘approximate’ to define features in the Particulars of Claim implied a wider claim. (It was not Ms Bowhill’s pleading). Ms Bowhill disclaimed reliance on any feature except those embodied in the eXtreme lockers.
11. Mr Davis was not deterred. He argued that his clients were now facing a case different from that pleaded and that they may have wished to run additional defences had they realised what Action Storage’s case really was.

The law

12. Section 1(1) of the 2014 Act came into force on 1 October 2014. It has not been made subject to any express transitional provision. In *DKH Retail* there was common consent between counsel that s.1(1) was therefore of immediate effect, although it made no difference on the facts of that case and the point was given no close attention. In *Whitby Specialist Vehicles Ltd v Yorkshire Specialist Vehicles Ltd* [2014] EWHC 4242 (Pat); [2016] F.S.R. 5, at [41], Arnold J doubted that the subsection had immediate effect, pointing out that this could retrospectively affect the protection afforded to the owner of a design right. I agree that this is an unlikely result. A further complication arises: if a transitional provision is to be read into the Act, there are alternatives. One is that s.1(1) applies solely to proceedings started after 1 October 2014. Another is that even this retrospectively deprives the owner of accrued rights and that s.1(1) should apply only to designs created after 1 October 2014 (cf. s.1(4)). The present case was started in May 2015 but the designs in issue were created in 2005. Section 1(1) may or may not apply.
13. The subsection deleted the words ‘any aspect of’ from s.213(2) which now reads:

“(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.*”
14. For reasons I explained in *DKH Retail* (at [10]-[14]) it is not easy to tell what the effect of this deletion is. However, in the same case I referred to a line of authority in which it has been held that design right may be claimed in designs extending beyond those embodied in an article:

[7] ... There has long been an issue with regard to claims to UK unregistered design rights concerning the precise scope of the right which may be claimed. In the present case, as is usual, DKH set out the features of the designs relied on in paragraph 4 of the Re-Amended Particulars of Claim, which I have quoted above. There are two ways in which a list of that type can potentially be interpreted. According to the first, the design claimed is defined by and

limited to the shape of the article, or part article, in question. The pleaded list of features does nothing more than to draw attention to the most relevant features of the article or part article on which the claimant relies for the purpose of resolving the dispute. The scope of the claimant's exclusive right is thus restricted to reproduction of articles made exactly or substantially to that specific design (see s.226 of the 1988 Act).

[8] However if the claimant defines his design as that of the 'configuration' of the whole or part of an article, the 'design' claimed is liable to be a bundle of designs, that is to say all designs which have the pleaded list of features provided that those features are sufficiently interconnected. Thus the bundle of designs claimed includes those not embodied in all or in any part of the claimant's article but which have all the relevant features. These others exist only in the abstract. The scope of the claimant's exclusive right therefore extends to the reproduction of articles made exactly or substantially to any of the designs within the bundle, including the abstract ones, see *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat); [2014] RPC 23, at [82] and [90]-[93] (in which Arnold J felt himself bound by what Pumfrey J had said in *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [1999] RPC 717) and *Clinisupplies Ltd v Park* [2012] EWHC 3453 (Ch); [2013] FSR 27."

15. In *DKH Retail* I suggested that a route to a more satisfactory state of the law would be to take the deletion of 'any aspect of' in s.213(2) as having the effect of no longer permitting a claim to unregistered design right which extends other than to a design specifically embodied in an article or part of an article, i.e. no more unregistered design right in abstract designs (at [15]-[16]). Arnold J, as I understand him, agreed with this in *Whitby*, at [41] and [45].
16. I should mention that the authors of the 17th edition of *Copinger and Skone James on Copyright* have since proposed that s.1(1) of the 2014 was not intended to effect any change in the law at all and that is why there was no need to enact any transitional provisions in relation to it (at 13-60). On the other hand, the authors of the 9th edition of *Russell-Clarke and Howe on Industrial Designs*, while declining to commit themselves to a view on the effect of s.1(1), denounce the suggestion of design right subsisting in abstract designs as 'heresy' (at 4-007). In which case there have been distinguished heretics.

Assessment

17. Fortunately, I can resolve Mr Davis's argument without revisiting the effect of s.1(1). I accept that as a matter of law Action Storage could arguably have presented their claim as encompassing a range of abstract designs. However, paragraph 2 of the Particulars of Claim states:

"2. The Claimant is the owner of United Kingdom unregistered design rights ("the Unregistered Designs") pursuant to s213 of the Copyright Designs and Patents Act 1988 in original designs consisting of the shape and configuration of lockers supplied by the Claimant under the trade mark "Extreme Lockers" since 2006, and the aspects of the shape and configuration of parts thereof as further set out below."

18. I think on a fair reading of paragraph 2 Action Storage was claiming only the designs embodied in the lockers as a whole and in the parts listed in paragraph 4, although use of the word ‘aspects’ and wording elsewhere in the pleading possibly introduced some ambiguity. The solution was for the defendants to ask for clarification. A short request would have been sufficient. It was not appropriate for the defendants to sit on their hands and then make the most of the ambiguity at trial. Ms Bowhill told me that she relied only on designs precisely as embodied in the eXtreme lockers. That is a possibility the defendants must have contemplated before trial and in my view Action Storage was entitled to present its case on that basis.

Lack of originality

The law

19. The defendants alleged that certain features lacked originality in that they were copied from prior art designs. Save for one point, there was agreement on the law. Originality in this sense is to be assessed in the same way as originality in the context of copyright law: anything in the creation of the design requiring more than slavish copying will result in that design being original, see for example *Raft Limited v Freestyle of Newhaven Limited* [2016] EWHC 1711 at [7].
20. The point in dispute was whether the traditional test for originality in the copyright sense – that the author has spent sufficient time, labour and skill in the creation of the work – still applies, or whether the new test in copyright law, as defined by the Court of Justice of the European Union and expressed in terms of the work comprising the expression of the author’s own intellectual creation, also now applies to s.213. Ms Bowhill submitted that a change in the EU law of copyright can have no direct bearing on the UK law of unregistered designs. This was the view I took in *Raft*, at [9]. Mr Davis pointed to *Whitby* in which Arnold J assumed, without deciding, that the new test now applies (at [43]).
21. The EU test of originality comes from the CJEU’s interpretation of the various copyright directives. The Court of Justice has now arguably provided a consistent and autonomous standard for originality covering all species of copyright works. It is further arguable that where art.1(1) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society speaks of ‘copyright and related rights’ (including the title of the Directive), this includes UK unregistered design rights.
22. The distinction between the old and new tests for copyright originality may be only semantic, see *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890; [2012] R.P.C. 1, at [20], although more recently the Court of Appeal expressed the view that the EU test for originality is higher than the traditional English test, see *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482; [2014] R.P.C. 8, per Lewison LJ at [36]-[37]. I think any distinction would make no difference here.

Assessment

23. At the start of the trial Ms Bowhill said that Action Storage no longer claimed originality in the design of the moulded hinges.

24. Even so, the defendants' allegation that the design of the whole of the locker lacked originality did not get off to a flying start in that it was admitted that five features of the locker were original. These were: the overall dimensions and proportions, the shape and dimensions of the raised section on the top, the shape and dimensions of the ribs at the side, the shape of border and inset squares at the rear and the shape and dimensions of the inset section at the base. In other words, it was common ground that those five features had not been slavishly copied from the Remcon locker.
25. Action Storage's case was that the eXtreme locker was designed by Peter Canham, an employee of Haywood, commissioned by Action Storage. There was evidence from Thomas Brialey, Managing Director of Action Storage but not from Mr Canham. Mr Brialey said that Action Storage asked Mr Canham to attend as a witness but his bosses at Haywood denied him permission to do so. In cross-examination Mr Brialey disclaimed any responsibility for the design. He also said that the starting point for the design was the Remcon locker which Action Storage wanted to 'Europeanise'. This is consistent with the memo of a meeting between Action Storage and Haywood on 17 August 2005. Mr Brialey conceded that Action Storage was not interested in "reinventing the entire wheel".
26. I therefore accept Mr Davis's contention that Mr Canham designed the eXtreme locker with the Remcon locker very much in mind, as he was instructed to do by Action Storage. Haywood manufactured or had manufactured the Remcon locker so I can assume that Mr Canham was fully familiar with it.
27. The burden of Mr Davis's submission was that on this evidence the design of the eXtreme locker was necessarily not original. This does not follow. I have already mentioned the defendants' concession that five features of the overall design were original. The defendants alleged that the eXtreme door had been copied from that of the Remcon locker. The only Remcon locker available in court was a 900mm model, so when considered alongside the 450mm eXtreme locker it was not possible to make a like-with-like comparison. Nonetheless, it was apparent that Mr Canham made changes when he created the design of the eXtreme door. On the front of the door there are differences in the shape of the vents and the label indentation, the position of the lock and the absence of a handle in the eXtreme design. On the inside of the door the vents are a different size and shape and the details of the indentations used are different.
28. In my view the design of the eXtreme locker as a whole is original over the Remcon design, as are the designs of the exterior and interior of the eXtreme door. The allegation of lack of originality (in the copyright sense) fails, save in relation to the moulded hinges.

Commonplace

The law

29. I discussed the law on commonplace designs under s.213(4) of the 1988 Act in *DKH Retail* at [32]-[42] and quite recently the law was summarised by Arnold J in *Whitby* at [44]-[45]. I regret to notice that in paragraph 39 of *DKH Retail* there is a slip: my suggestion is that the *defendant* (not the claimant) should plead the significant features of the design he alleges to be commonplace and then identify the prior art in

which those features are to be found such as to render the design commonplace. As I will point out in the context of infringement, I think it will be helpful if the claimant has by this time identified the significant features of his design in his Particulars of Claim. If so, the defendant can adopt or amend the claimant's list in the Defence.

30. A dispute arose in the present case regarding the extent to which an allegation of commonplace design must be set out in the Defence. The Defence in this case pleaded some prior art by way of example to support the commonplace plea but went little further. Mr Davis submitted that it was better to have a broadly pleaded case, leaving it to expert evidence in due course to explore and develop the commonplace issue further. I do not agree.
31. If a defendant has in mind a properly reasoned argument that a design is commonplace, he must be aware of prior art, which cannot be obscure, embodying the significant features of that design. In his pleading he should set out (i) his contention as to the significant features of the design, (ii) the prior art he relies on to render the design commonplace at the date of its creation and (iii) the date each cited item of prior art was made available to designers in the relevant field. The parties or their experts (if expert evidence is ordered) can then focus on whether the significant features of the design have been correctly identified, whether they are to be found in the cited prior art and the extent to which the cited prior art was known to designers in the relevant field at the relevant date.
32. Failing to tie down the argument in this way gives rise to a tendency among defendants to throw in a plea of commonplace design on the basis that there might be something in it, though with no real idea as to how the argument may later be advanced. The experts are then obliged to draft unfocussed reports rambling across the relevant design field. This is likely to be a waste of time for all concerned.
33. Where appropriate, the adequacy of the defendant's pleading on commonplace design is something the parties should take up at the CMC.
34. It will not be often that the design of an entire article is found to be commonplace. Most modern articles of commerce are too complex for that and will usually include at least some design features that are not commonplace. Unusual exceptions aside, there may also be the occasional overweening claim to design protection based on nothing more than commonplace features which the claimant's design shares with the accused design – for example, a claim relating to the design of a chair based on the fact that both designs are for a chair with four legs, two arms, a horizontal seat and a back close to the vertical. If the claimant advances his case on such a basis, one option open to the defendant is to take the claimant at his word, adopt the same list of significant features for the purpose of the defendant's plea of commonplace design and show that all those features, even when taken together, are commonplace. Alternatively, to run a squeeze.
35. Much more frequently it will be the design of part of an article that is vulnerable to an allegation that it is commonplace. Any person may freely make and market articles which include parts having a commonplace design, whether such designs have been copied from elsewhere or not.

36. As will be seen, the defendants in this case argued that designs were commonplace by reference to a single item of prior art – the same art over which the designs are alleged to lack originality. This meant, of course, that the defendants had to prove that the design of the prior art was commonplace at the relevant time. Then the assessment becomes similar (though possibly not identical) to that carried out when deciding whether the design of the accused article is original in the copyright sense over the prior art. Commonplace design is an aspect of originality. It seems to me that if sufficient skill and labour is expended by the designer of the accused article to make his design original (in the copyright sense) over a particular piece of commonplace prior art, he is also liable to succeed in creating a design that is not rendered commonplace by that piece of prior art.
37. I will summarise the principles which are relevant to this case:
- (1) A defendant alleging that a design is commonplace should plead the significant features of the design as he contends them to be, the prior art relied on in which those features are said to be found and the date from which each cited item of prior art was available to designers in the relevant design field.
 - (2) Prior art which renders a design commonplace will not be obscure. The evidential burden rests on the defendant to show that it is not.
 - (3) A design will be commonplace if it is shown to have been current in the thinking of designers in the field in question at the time of creation of the design, see *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2005] R.P.C. 6 at [56]. Another way of looking at this is that a commonplace design will be one which is trite, trivial, common-or-garden, hackneyed or of the type which would excite no particular attention in those in the relevant design field, see *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] R.P.C. 289, at p.429, approved in *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* [1999] R.P.C. 13, at pp.477 and 479. A third way of characterising a commonplace design is that it will be ready to hand, not matter that has to be hunted for and found at the last minute, see *Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd* [2005] EWCA Civ 761; [2005] R.P.C. 36, at [60].
 - (4) The design field in question is that with which a notional designer of the article in issue is familiar, see *Lambretta Clothing* at [45].
 - (5) A design made up of features which individually are commonplace is not necessarily itself commonplace. A new combination of run-of-the-mill features may not be commonplace. See *Ocular Sciences* at p.429, approved by the Court of Appeal in *Farmers Build* at p.476 and in *Ultraframe* at [64].
 - (6) If the designer of the accused article has expended sufficient skill and labour to make his design original (in the copyright sense) over a single piece of commonplace prior art, he is liable also to have succeeded in creating a design that is not rendered commonplace by that prior art.
38. The geography of the relevant design field has probably altered. In the case of designs created on or before 1 October 2014 it remains unclear whether the relevant design field is confined to that in the United Kingdom, or some other limited territory,

or whether there is no geographical limit. There is now no doubt that for designs created after that date the issue is whether the design was “commonplace in a qualifying country in the design field in question”, see s.1(3)(a) of the 2014 Act, which applies to designs created after 1 October 2014, see s.1(4) and SI 2014 No. 2330. A qualifying country is defined in s.217(3) of the 1988 Act. It means any of: the UK, a Member State of the EU, other states to which Part III of the 1988 Act extends under s.255 and countries designated under s.256 as enjoying reciprocal protection under that Part.

Assessment

39. Mr Davis submitted that there were two relevant design fields: that of lockers and that of rotationally moulded items generally. Ms Bowhill said that it was just the design field of lockers. I think that the notional designer of the eXtreme lockers would have been familiar with designs other than just those of lockers. This familiarity may not have extended to all rotationally moulded items and yet may have included items other than lockers that are not rotationally moulded. Nothing much turns on this so I need take it no further.
40. The eXtreme lockers were designed in 2005. Section 1(3)(a) of the 2014 Act does not apply. There was no argument as to the geographical extent of the relevant design field. It probably did not matter although this was something to have been taken up by the defendants, if at all.
41. The defendants did not in their Defence plead what they perceived to be the significant features of the lockers for the purpose of their argument on commonplace design. However, in argument Mr Davis adopted the features relied on by Action Storage for its allegation of infringement. I will take that as an acknowledgment by the defendants that the significant features are as identified by Action Storage.
42. The Defence pleads that the overall design of the eXtreme lockers was commonplace, relying on the Remcon locker, and also relying on the American equivalent which was referred to as the Remcon XL locker plus two further American lockers: the Fibretech Plastic locker and the Spincraft Plastic LOCX locker. Despite this, Nicholas Henwood, the defendants’ expert, was only prepared to discuss the issue of whether the eXtreme locker design was commonplace by reference to the Remcon locker. Mr Davis attempted to make something of the Fibretech locker but the only evidence regarding its likely familiarity to the notional designer came from Dominic Slingsby, Action Storage’s expert, who said had never heard of any of the American lockers before becoming involved in these proceedings.
43. Ms Bowhill pointed out, rightly, that although Dr Henwood compared features of the eXtreme design with those of the Remcon locker, he did not say that the design of the Remcon locker was current in the thinking of designers in the field in question at the time of creation of the design. Nor did he give any other ground for supporting the idea that the Remcon design was commonplace. For this reason alone, the defendants’ case on commonplace design must fail.
44. In addition, given my finding in relation to the originality of the eXtreme design over that of the Remcon locker, I take the view that the Remcon locker could not by itself render the design of the eXtreme locker, as a whole, commonplace.

45. I should add that in Mr Slingsby's view the overall design of the eXtreme lockers was not commonplace.
46. With regard to parts of the locker, in closing Mr Davis's argument concentrated on overall dimensions, the shape of the interior of the door and the shape of the sides of the locker.
47. Ms Bowhill produced a table of dimensions, annexed to her skeleton argument. Dr Henwood produced a similar table, though it was confined to the 900mm sized lockers. These tables showed that the overall dimensions of the 450mm 900mm sizes of the eXtreme lockers in each case were not identical to the corresponding dimensions of the Remcon locker. In the case of depth, the difference was around 80mm. Dr Henwood's table suggested that the overall dimensions of the 900mm eXtreme locker were the same as a locker identified as 'G-Force', but the status of the G-Force locker was not explored and it was not relied on by Mr Davis.
48. I accept that some of the dimensional differences are not great and that the evidence indicated that the market expected lockers to have, broadly, the same shape for each size. I think the highest that the defendants can put this aspect of their argument is in the form of a squeeze: to the extent that Action Storage were to rely, in running the argument on infringement, on a similarity in overall dimension in broad terms (though this would have to be to the nearest 80mm or so in the case of depth) this sort of approximate size would have been commonplace. The precise overall dimensions of the eXtreme locker, however, were not commonplace.
49. The defendants relied on the Remcon locker's design in respect of the shape of the interior of the door. I have found that the shape of the interior of the eXtreme door was original over the corresponding Remcon design. Even if the latter had been commonplace in 2005, it did not render the corresponding design on the eXtreme locker commonplace.
50. Mr Davis's argument with regard to the design of the side of the locker relied only on the corresponding feature of the Fibretech locker. It was not established that any feature of the design of this locker, including the design of the side, was commonplace in 2005.
51. The arguments on commonplace design do not succeed.

Method or principle of construction

The law

52. Section 213(3)(a) reads:

“(3) *Design right does not subsist in –*

(a) a method or principle of construction”

53. In *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 Mann J took the view that the best approach to the correct construction of this subsection was to bear in mind that a design right is confined to the features of an article or part of an article. He found that for this reason the scope of the design right

being pressed on him by the claimants, which included abstract variants on the design of their article (a wide area grass mower), was too broad:

“[79] It is important to isolate the design in respect of which protection can be properly claimed, and it is vital to ensure that it falls within the definition of design. The Act defines design as “any aspect of the shape or configuration ... of the whole or any part of an article”, and the right cannot exist until there is an embodiment of the design in an article or in a design document. This combination of features means that design right is confined to what one can actually see in an article—either the physical article or a drawing. This is what one would naturally expect from the concept of “design” (which is what is protected) which is a physical manifestation of an idea, not some underlying abstraction, and it is reinforced by the definition of the “designer” in s.214 as “the person who *creates* [the design]” (my emphasis). You cannot create a design until you have actually reduced it to a particular form. It is not a design while it is a conception in the designer's head, and it becomes a design when it takes physical shape on paper or in the flesh.

[80] This means that Mr Alexander's more abstraction-based proposals for design right are not correct. His client is not entitled to claim design right in the abstraction of ideas involving folding over, folding again, and leaning on a stand and so on. Nor is it entitled to claim design right in the concept of a tank between two vertical support stands at the back of a wide area mower. What it is entitled to claim design right in (subject, of course, to matters such as commonplace) is aspects or configuration of the physical manifestation, not some underlying design concept.”

54. In other words Mann J took an early view of the law which I have suggested was not achieved until the entry into force of the 2014 Act: the claimants were limited to claiming design right in the design of a particular mower. The claim to abstract variants was disallowed and by that means the attempt to monopolise a way of constructing a wide area mower was prevented.
55. Mann J ruled that the exclusion of methods or principles of construction under s.213(3)(a) provided another bar to the generalised way in which the claimant characterised its design right, although it didn't add anything on the facts of that case. Mann J described the specific way that the claimant sought to monopolise a method or principle of construction and continued:

“[93] What I have just said seems to me to be self-evident, but it is also supported by authority. In *Landor & Hawa International Ltd v Azure Designs Ltd* [2007] F.S.R. 9 the Court of Appeal approved a formulation in Russell-Clarke on Copyright in Industrial Designs (7th Edn) at para.3–80:

“A method or principle of construction is a process or operation by which a shape is produced, as opposed to the shape itself ... The real meaning is this: that no design shall be construed so widely as to give its proprietor a monopoly in a method or principle of construction. What he gets is a monopoly for one particular individual and specific appearance. If it is possible to get several different appearances, which all embody the general features which he claims, then those features

are too general and amount to a method or principle [of construction]. In other words, any conception which is so general as to allow several different appearances as being made within it, is too broad and will be invalid.”

[94] The Court also followed Jacob J. in *Isaac Oren v Red Box Toy Factory Ltd* [1999] F.S.R. 785:

“It is possible to make a device visually very different from Mr Oren's designs but which works the same way ... it follows that there is no principle monopolised here – only a visual embodiment of a device constructed in accordance with a principle.”

56. It seems that Mann J was not referred to Pumfrey J's judgment in *Mackie*. The view expressed by Mann J in paragraphs 79 and 80 of *Rolawn* is hard to reconcile with *Mackie* or with subsequent cases that have followed Pumfrey J's ruling on the correct interpretation of the 'configuration' of the whole or part of an article. On the other hand, if I am right about the effect of s.1(1) of the 2014 Act, subject to any implied transitional provision it now makes no difference. The restriction of the scope of design right to the features of a specific article or part of an article, achieved by one route or another, will almost always by itself prevent a design right owner from claiming protection in relation to a method or principle of construction.
57. Almost always: I do not believe that this approach to the law renders s.213(3)(a) otiose. There will be rare cases in which there is only one way to achieve a method and principle of construction and that is by using the specific design of the article in relation to which design right is claimed. *Bailey v Haynes* [2007] F.S.R. 10 was an example. It concerned design right in a design of micromesh which was made into bags to be filled with fish bait, used by anglers. The claimants claimed design right in the specific design of their mesh, nothing more. His Honour Judge Fysh QC SC held that the design right claimed would nonetheless inevitably cover a method or principle of construction (at [68]).

Assessment

58. The defendants argued that two features of the eXtreme locker were each a method or principle of construction: (i) the tapered ribs on the side of the locker and (ii) the shape of the rear panel of the locker, having a continuous border around the edge with inset squares having rounded corners at each of the four corners of the panel.
59. I do not doubt that both the ribs and the rear panel each enable the locker to perform one of its functions, or two functions. The ribs provide reinforcement so that the sides do not bow or otherwise warp and are wedge shaped to make it easier to remove the panel from the mould. The border of the rear panel provides rigidity and the reinforced holes allow the locker to be securely attached to a wall or other support. Yet none of this is enough to engage s.213(3)(a).
60. Mr Davis argued that Action Storage was attempting to monopolise wedge-shaped ribs. It was not. This part of Action Storage's claim related only to the specific design of the sides of the eXtreme locker, including the particular shape or configuration of the ribs on those sides.

61. Similarly, Mr Davis argued that Action Storage was seeking to monopolise peripheral reinforcement of the rear panel to achieve stability together with the use of a ‘corner pad’ to reinforce the mounting holes. He said that both were standard methods to achieve the relevant functional ends. I have no doubt that this last point is true, but again, Action Storage’s claim was to specific designs, nothing more.
62. Unsurprisingly there was no evidence that these various functions could be achieved only by means of the *particular* shape of side ribs or rear panels, as the case may be, embodied in the eXtreme locker. Alternative designs would have worked just as well. Consequently, neither of the design features targeted is a method or principle of construction.

Must fit

The law

63. Section 213(3)(b)(i) provides for a further exclusion from design right:

“(3) *Design right does not subsist in –*

...

(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”*

64. Ms Bowhill referred to me to the well-known passage from *Ocular Sciences*, at p.424:

“This is sometimes referred to as the interface provision. Its original purpose was to prevent the designer of a piece of equipment from using design right to prevent others from making parts which fitted his equipment. As I read it, any features of shape or configuration of an article which meet the interface criteria must be excluded from being considered as part of the design right. Furthermore, a feature which meets the interface criteria must be excluded even if it performs some other purpose, for example it is attractive. There is also nothing in the provision which requires the feature to be the only one which would achieve the proper interface. If a number of designs are possible each of which enables the two articles to be fitted together in a way which allowed one or other or both to perform its function, each falls within the statutory exclusion.”

65. The point of law in issue under this head was the meaning of “so that either article may perform its function”. The relevant features of the locker were the top and bottom faces and in particular the shapes which enabled one locker to be stacked stably on top of another. Ms Bowhill argued that stackability was not part of a locker’s function. Mr Davis responded that it was.
66. In *Ocular Sciences* Laddie J found that the radius of curvature of the contact lenses in issue was chosen to enable a proper fit between the lens and a human eyeball. This allowed the lens to perform its function of correcting the focusing ability of the eye to the desired extent and to ensure that it centres over the pupil accordingly this feature

was excluded from consideration under s.213(3)(b)(i). Similarly lens diameters were chosen to enable lenses to fit on to the eyeball and under the eyelids to achieve in-eye stability. This and other features which permitted a good fit with the eye were likewise excluded from design protection (at pp.425-8).

67. Thus a feature of the design of an article which promotes stable interaction with another article may be excluded from design protection under s.213(3)(b)(i). That need not be the only function of that article, see the passage from *Ocular Sciences* quoted above and *Dyson Ltd v Qualtex (UK) Ltd* [2006] EWCA Civ 166; [2006] R.P.C. 31, at [40]-[44].
68. There will be a limit to the exclusion of design right protection under this provision. I take the view that the shapes of the relevant parts of the connecting articles must be such that there is a degree of precision in the interrelationship between one article and the other, i.e. the designs afford some precision in the fit. For example, it would be surprising if the handle of a coffee mug were refused design protection solely because it is shaped to enable a human hand to connect to it to pick up the mug. (I use the convenient term 'fit' but this does not imply that the articles must touch. Section 213(3)(b)(i) can apply to features of shape or configuration of an article which enable it to be placed around another article and so there may be a gap between them, see *Dyson* at [31]-[38]).

Assessment

69. The features in issue under this head were the shapes of the top and base panels. The top has a slightly domed or raised section, surrounded by a flat periphery. The bottom has a correspondingly concave central section and flat periphery. The bottom of one locker thereby fits on to the top of another.
70. Mr Brialey accepted that the eXtreme lockers are sold as stackable lockers and that it was important that they could be so marketed. He said that the lockers could be stacked without the design features in issue and that they would be better described as an aid to stacking. He also said that the top and bottom of the lockers were not a perfect fit and that without a fixing to keep the top locker in place it would fall off.
71. It seems, then, that the shapes of the top and bottom panels do not interact so securely that the lockers can be stably stacked without further support. But I have no doubt that they enable some stability when one locker is stacked on to another and that this is achieved by a sufficient degree of precision in the fit between top and bottom panels. In my view the defendants' 'must fit' argument succeeds.

Infringement

72. Action Force alleged both primary and secondary infringement against the defendants. The defendants' acts of making, possessing, offering for sale and selling SuperTuff lockers were admitted.

The law

Primary infringement

73. Section 226 of the 1988 Act provides:
- (1) *The owner of design right in a design has the exclusive right to reproduce the design for commercial purposes—*
 - (a) *by making articles to that design, or*
 - (b) *by making a design document recording the design for the purpose of enabling such articles to be made.*
 - (2) *Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design, and references in this Part to making articles to a design shall be construed accordingly.*
 - (3) *Design right is infringed by a person who without the licence of the design right owner does, or authorises another to do, anything which by virtue of this section is the exclusive right of the design right owner.*
 - (4) *For the purposes of this section reproduction may be direct or indirect, and it is immaterial whether any intervening acts themselves infringe the design right.*
 - (5) *This section has effect subject to the provisions of Chapter III (exceptions to rights of design right owner).*
74. I can leave aside subsection (5). Essentially there are two steps to establishing primary infringement by making articles. First, the claimant must show that the claimant's design was directly or indirectly copied by the defendant so as to produce the articles complained of. Secondly, such articles must be exactly or substantially to the claimant's design.
75. Alternative approaches to the second step could be imagined. One would be to weed out all the features in which design right does not subsist pursuant to s.213(3) or which lack originality in the copyright sense or pursuant to s.213(4). Then looking at what is left, and assuming that it still qualifies as a design within the meaning of s.213(2), assess whether it has been copied so as to produce articles exactly or substantially to what is left.
76. An alternative would be to determine whether the claimant's design is either deprived of design right by s.213(3) or lacks originality or is commonplace within the meaning of s.213(4). If none of these, the question whether the defendant's articles are substantially to the claimant's design is assessed by reference to the design including all its features.
77. I think there may be a difference in this regard between s.213(3) and s.213(4). The exclusions under s.213(3) result in no design right subsisting in *features* of design. This is expressly the case in relation to s.213(3)(b) and it seems to me to be equally true in relation to s.213(3)(a) and (c). No design protection is afforded to such features, apparently whether relied on individually or whether they form part of a larger design. I have some hesitation about this because s.226(2) requires a

comparison to be made between the design of the accused article and the claimant's design, unqualified. But if the claimant's design is composed solely of features in which design right does not subsist pursuant to s.213(3), plainly there will be nothing in the claimant's design that can lead to a conclusion of infringement. On balance, it seems to me that the legislature intended the comparison to be made between those features in the claimant's design in which design right subsists and which are therefore relevant to the second step assessment, and only those. Features to which s.213(3) applies should be disregarded when considering infringement under s.226.

78. Once features are excluded from consideration under s.213(3) there may arise a question whether what remains is still a design of the article or the part of an article as claimed in the pleading.
79. By contrast, s.213(4) applies to designs as a whole, whether of an entire article or of part of an article. It is not concerned with features of a design. If the claimant's design as a whole is not commonplace, it is not deprived of design right protection under s.213(4). This is true irrespective of whether some or even all the features of the design are individually commonplace. Therefore infringement should be determined by reference to the whole design including any commonplace features. This appears to have been the approach taken by Aldous J in *C & H Engineering v F. Klucznik & Sons Ltd* [1992] F.S.R. 421, at 428-9. Likewise, the assessment carried out in the second step will take into account not just original features (in the copyright sense) but also any features that have been found, or admitted, to lack originality.
80. The foregoing assessment can only be done in an organised manner if the court and the parties are working from a list of significant features for each design in issue. It will greatly assist clarity if the claimant sets out his list of significant features in his Particulars of Claim and identifies the extent to which those features are to be found in the defendant's accused article. The defendant may wish to propose amendments to the list, but can also make valuable use of it in relation to any case on lack of subsistence of design right he may wish to run. See, for example, my discussion of commonplace design above.
81. I discussed other aspects of the law on whether an article is made substantially to the design of another in *DKH Retail* at [57]-[59], including the following:

“58. In *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group Ltd* [2009] EWHC 26 (Pat); [2009] ECDR 11, Lewison J said this:

...

[33] Although, at least in theory, two separate criteria must be satisfied viz. copying and making articles exactly or substantially to the copied design, it is not easy to conceive of real facts (absent an incompetent copyist) in which a design is copied without the copy being made exactly or substantially to the copied design. In practice, if copying is established, it is highly likely that the infringing article will have been made exactly or substantially to the protected design. If copying is not established, then whether the article is the same or substantially the same as the protected design does not matter. However,

similarity in design may allow an inference of copying to be drawn.”

59. In this last paragraph Lewison J drew on what the House of Lords had said in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] 1 All ER 700; [2001] FSR 11. Both judgments come close to endorsing “the rough practical test that what is worth copying is prima facie worth protection” without quite going that far. This comes from the judgment of Peterson J in *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601, at 610, in the context of whether examination papers were original copyright works, though the majority in *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 (HL) found force in Peterson J’s maxim in the context of copyright infringement (Lord Reid at 279, Lord Hodson at 288 and Lord Pearce at 294.)”

(To the extent that the maxim carries force in the context of infringement, neither any of their Lordships in *Ladbroke* or *Designers Guild* nor Lewison LJ in *Virgin Atlantic* suggested that it can be usefully applied with regard to the subsistence of copyright or design right, Peterson J’s original point.)

Secondary infringement

82. Section 227 of the 1988 Act reads in relevant part:

(1) *Design right is infringed by a person who, without the licence of the design right owner—*

(a) *imports into the United Kingdom for commercial purposes, or*

(b) *has in his possession for commercial purposes, or*

(c) *sells, lets for hire, or offers or exposes for sale or hire, in the course of a business,*

an article which is, and which he knows or has reason to believe is, an infringing article.

83. Secondary infringement requires that the defendant knew or had reason to believe that his articles are infringing articles, see s.227 of the 1988 Act. The meaning of those terms can be derived from authorities dealing with the same concepts in the context of secondary infringement of copyright under ss.22 and 23 of the 1988 Act, see *Whitby* at [48] and the cases there cited.

84. *Sillitoe v McGraw-Hill Book Company (UK) Ltd* [1983] F.S.R. 545 concerned three consolidated actions brought by the owners of copyright in well-known literary works. Alan Sillitoe and his publisher sued in relation to *The Loneliness of the Long-Distance Runner*, Laurie Lee and his publisher in relation to *Cider with Rosie* and the trustees of the estate of George Bernard Shaw in relation to *Saint Joan*. The defendant was the same in each case, a Canadian importer of study notes in booklet

form used by school pupils studying works of literature for O-level examinations. The booklets contained verbatim extracts from the copyright works.

85. Section 5(2) of the Copyright Act 1956, then in force, provided for infringement by importation into the UK and required that to the knowledge of the defendant the making of the imported article constituted an infringement, or would have done if the article had been made in the UK. Section 5(3), which provided for infringement by sale and related acts, likewise required that the defendant knew that the making of the article in issue constituted an infringement, or would have done had it been made in the UK.
86. The defendant had taken legal advice and had been informed by counsel that it had a defence to infringement, particularly because of the fair dealing defence under s.6(2) of the 1956 Act. Judge Mervyn Davies QC disagreed. The defendant also argued that even though the defendant was aware of all the relevant facts, it did not possess the requisite *knowledge* of infringement, having been advised by specialist counsel that the importation and sale of the study notes were not, in law, acts of infringement. The judge did not accept that argument either (p.557):

“The defendants are in effect saying that if they are right in law, then there is no infringement and if they are wrong in law, there is no infringement either because they believed the law to be otherwise. What the defendants have done here, and knowing of the plaintiffs' complaints and the facts on which the complaints were based, was to take the risk of finding their legal advice wrong. If a person takes a deliberate risk as to whether what he is doing is wrong in law, I do not see that he can say later that he did not, at the time, know that what he was doing was wrong, if, in the event, his action is held to be wrong.”

87. In *ZYX Music GmbH v King* [1997] E.M.L.R. 319 the Court of Appeal expressly approved this reasoning of the judge in *Sillitoe* in the context of actual knowledge within the meaning of s.23 of the 1988 (at p.340). The Court of Appeal did not even have recourse to ‘reason to believe’ in applying the principle in *Sillitoe*.

Summary

88. I will summarise the principles of law on infringement which I will apply to the present case:
- (1) There are two principal steps to establishing infringement by reference to articles complained of. In the first the claimant must show that his design was directly or indirectly copied. In the second the claimant must show that such copying was done so as to produce articles exactly or substantially to the claimant’s design.
 - (2) If copying is not established, there is no infringement. If copying is established, assessment of infringement moves on to the second step.
 - (3) In the second step features in which design right does not subsist pursuant to s.213(3) are to be disregarded.

- (4) Once features deprived of design right pursuant to s.213(3) are set aside, there may arise a question whether what remains is still a design of the article or the part of an article as claimed, within the meaning of s.213(2).
- (5) Features found to lack originality, whether pursuant to s.213(4) or in the copyright sense, are not excluded from the assessment in the second step.
- (6) If copying is established, and if s.213(3) has not eliminated design rights such that no relevant design is left, it is highly likely that the infringing articles will have been made exactly or substantially to the protected design.
- (7) The concepts of knowledge and reason to believe in s.227 of the 1988 Act are the same as their equivalents in ss.22 and 23 of that Act.
- (8) A mistaken belief that in law an act is not an infringing act does not serve to deprive the defendant of knowledge under s.227, provided the defendant is aware of all the relevant facts. This includes a mistaken belief of law that the claimant has no enforceable design right, inferred from the facts.

Assessment

Primary infringement

89. According to the law of primary infringement as I have suggested it to be, I disregard the top and bottom panels since I have found that design right does not subsist in relation to them. What remains is in my view still sufficiently a design of an entire locker within the meaning of s.213(2). Action Storage's case on the locker design as a whole does not fall away.
90. I must also consider the features of the eXtreme locker relied on individually and which remain in play.
91. Evidence was given by Colin Fletcher who is the Managing Director and sole shareholder of the defendant companies. He said that an employee of FECL, Tom Boutle, had the task of liaising with designers and toolmakers to produce what became the SuperTuff lockers. Mr Boutle put forward an initial design proposal and consulted Alan Taylor, a local rotomoulding designer who created further drawings. The aluminium doors were designed by Stuart Bowler, an employee of a design firm called High Peak CAD. Mr Fletcher said in his witness statement that although Action Storage's lockers were among the products considered during the design process, there was no question of copying their designs.
92. Mr Boutle did not give evidence but I was shown his design proposal. It suggests that Mr Boutle's design process was based a good deal more on the eXtreme locker design than Mr Fletcher's witness statement suggests. It mentions no other prior art locker. It constantly references the eXtreme lockers, in all three sizes, including this:

“To differentiate the SuperTuff lockers from the rival range I have marginally increased the length and width dimensions. This can also be used as small selling point offering slightly larger volume and greater stability than the Extreme range. The proposed overall height is the same as the Extreme

lockers, the sizes they have used makes them interchangeable offering overall stack heights of 1800mm. ... ”

93. Mr Boutle apparently wrote the design proposal in at least two stages. Below the passage above it says this in italics:

“Since writing this I have had second thoughts on the size. It may be beneficial for us to duplicate the footprint of the Extreme lockers. Our locker could then be designed to interwork with the Extreme range, meaning existing users of their product could buy our version to seamlessly interwork alongside their existing lockers. ... ”

94. In their final design, the SuperTuff lockers have dimensions identical to those of the eXtreme lockers.

95. Elsewhere the design proposal was replete with references to copying the eXtreme design:

“If we decide to mirror the Extreme lockers size to enable our design to interwork we will need to replicate their stacking feature.” (There follows a diagram of the dimensions to be replicated).

...

“The Extreme lockers have marked fixing points which act as a guide to show where the end-user should drill if they intend to bolt the lockers together. We need to incorporate similar markings into our design in the following places ... ”

...

“It is stated on the Action Storage website that their new range will have optional shelves, it is important that we match their offering.”

...

“The Extreme locker door is 25mm thick; their model has a curved front which increases the thickness to around 40mm in the middle. Our door will have a nominal thickness of 25mm which can then increase/decrease subject to the final design.”

96. Taking the overall design of the lockers first, I have no doubt that the defendants copied the designs of the eXtreme lockers.

97. In line with the observation of Lewison LJ in *Virgin Atlantic*, quoted above, the defendants next face an uphill climb to show that despite copying, the SuperTuff lockers are *not* substantially to the design of the eXtreme lockers.

98. This is a matter for the eye of the court. Beginning with the 450mm versions, there are many similarities. It was admitted that the overall dimensions and proportions of the lockers are the same and that the overall shape of the door, the position of the vents, the position of the moulding for the lock and the position and shape of the oval

indentation for the label are similar. In addition, it seems to me that the curved section at the top of the door, the shapes of the rear of the lockers, and the shapes of the sides are very similar.

99. There are differences. The shape of the moulding for the lock and the shape of the vents at the front are not the same. On the inside of the door the vents are different as are many, though not all, of the details of the moulding.
100. There are more differences between the 900mm eXtreme locker design and the corresponding SuperTuff locker. The SuperTuff locker does not have a vent in the middle of the door and the positions of the moulding for the lock and the oval indentation are more distinct.
101. Taking all features of the two sets of design into account, I take the view that the SuperTuff lockers are made substantially to the overall design of the eXtreme lockers in all sizes.
102. Given that finding, nothing of practical consequence would follow from infringement of any of the design rights in the designs of the individual features that remain in play. I have already found that the defendants copied. My views are as follows with regard to primary infringement:
 - (i) The overall dimensions and proportions of the lockers are identical. The design right associated with this feature is infringed.
 - (ii) The shapes of the oval indentation for applying a label appear to be identical as between the two lockers. The design right associated with this feature is infringed.
 - (iii) The interior of the SuperTuff door displays differences compared to the eXtreme door. The appearance of the vents is striking: there are two instead of four and they are smaller and of a different shape. There are no triangular indents. The doors share what was called the 'raised E area', which Action Force particularly relies on, but it is not of an identical shape and has no rectangular indent near the middle or small circular indent at the bottom. I take the view that the design right in the design of this feature is not infringed.
 - (iv) The shape of the side of the SuperTuff locker is extremely similar to that of the eXtreme locker. The wedge shaped ribs are not identical in size and shape, but they are nearly so and there is the same number of them. The design right in this feature is infringed.
 - (v) The respective shapes of the rear of the locker are very similar. The design right in this feature is infringed.

Secondary infringement

103. Action Storage inferred the requisite knowledge from the defendants' awareness of the eXtreme lockers and the fact that such products are routinely protected by UK unregistered design rights. In addition, the defendants were put on notice of Action Force's claims by a letter dated 6 June 2014.

104. Secondary infringement following a reasonable period for investigation after receipt of the letter before action on 6 June 2014 was admitted. I will estimate that period to have been 21 days. On any view there was secondary infringement after 27 June 2014.
105. As to the period before then, infringement turns on whether the defendants knew or had reason to believe that the SuperTuff lockers were infringing copies of the eXtreme lockers within the meaning of s.227 of the 1988 Act. The pleaded defence was that the defendants believed the eXtreme lockers to be copies of the Remcon lockers and that the design of the latter was commonplace.
106. This is a defence analogous to that run in *Sillitoe* and I do not accept it. The defendants knew all the relevant facts. They compared the eXtreme lockers with the Remcon lockers and reached a view that in law the designs of the eXtreme lockers, as a whole and in relevant parts, were all commonplace. They believed that this deprived Action Storage of its claim in law. I accept that the defendants honestly held these beliefs but it does not follow that the defendants lacked knowledge or alternatively reason to believe under s.227 of the 1988 Act.
107. All acts of primary infringement by the defendants led to acts of secondary infringement.

Conclusion

108. Action Storage has established primary and secondary infringement of its design rights in the design of the eXtreme locker as a whole and the designs of the overall dimensions and proportions of the locker, the shape of the oval indentation, the shape of the side panel and the shape of the rear panel.

Pleadings and Design Charts

109. As I have indicated above, it will be helpful if the claimant in a design right case sets out in his Particulars of Claim the significant features of the design or designs as he sees them and the extent to which those features are to be found in the defendant's accused article. Sometimes it may be useful to employ a labelled diagram to locate each significant feature.
110. In his Defence the defendant may adopt the claimant's list of significant features or propose amendments. He should also admit or deny the presence of significant features in the design of his accused article.
111. That list will also perform a valuable function in relation to any case the defendant may wish to run in relation to lack of originality (in the copyright sense), s.213(3), s.213(4) and possibly other matters. For example, the defendant can use it to identify whether any of the significant features of the design are said to be commonplace, or which features are said to lack design right protection because of the 'must fit' exclusion, and so on. It will greatly clarify the points of dispute between the parties' trial if the arguments on infringement and design right subsistence can all be anchored to a single list of significant design features. It does not matter that the list may not be agreed – this will be something to be settled by the court having heard argument and possibly evidence on the point.

112. The present case did not go forward in exactly that way, but Ms Bowhill prepared two charts. Both listed the significant features of the design of the eXtreme locker as a whole and the significant features of the designs of the parts of the locker separately relied on. The first chart identified which of those features were said (i) not to be features of shape or configuration at all (the 2014 Act point), (ii) not to be original, (iii) to be commonplace, (iv) to be 'must fit' features and (v) to constitute a method or principle of construction. The relevant prior art was identified. The second chart identified which features were alleged to be present in the designs of the SuperTuff lockers and in each case whether this was admitted or denied by the defendants.
113. I found this extremely useful and strongly suggest that all litigants in design right cases attempt something similar. It need not be exactly as above, some other format may work as well or better in different cases. However, something along these lines will very much help the efficient conduct of the trial.

ANNEX

(1) The front		
Remcon	eXtreme	SuperTuff
		

(2) The rear		
Remcon	eXtreme	SuperTuff
		

(3) The inside door		
Remcon	eXtreme	SuperTuff
		
(4) The top		
Remcon	eXtreme	SuperTuff
		
(5) The side		
Fibretech	eXtreme	SuperTuff
		