

Kluwer Copyright Blog

UK: eXtreme Lockers but not an extreme case

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United Kingdom unregistered design right (“UDR”) cases are complicated. The precise nature of the UDR claimed is often difficult to express (from a claimant perspective) and often difficult to comprehend (from a defendant perspective).



UDR were created to complement the protection afforded by copyright and registered design rights in the UK. Registered design law provides designers with monopoly rights for the (external) appearance of a product, including its lines, contours, colours, shape, texture, materials or its surface decoration. However, it explicitly excludes protection for features consequent to the product’s technical function (s.1C Registered Designs Act 1949 (RDA)). To protect the functioning or internal aspects of a product, designers were having to rely on the copyright in the underlying drawings for a product. This was contrary to the intention of copyright law and afforded the designer an extensive period of protection. To resolve this conflict, the UK legislated against this for non-artistic designs and implemented provisions for UK UDR. These rights subsist automatically in an original design of three-dimensional shapes or configurations, whether internal or external, and for whole or part of an article (s.213(2) Copyright Designs and Patents Act 1988 (CDPA)). It does not protect surface decoration nor would it be appropriate to protect an artistic product such as sculpture or artistic craftsmanship.

The eXtreme Lockers case

Late last year, Judge Hacon gave judgment in *eXtreme Lockers* [2016] EWHC 3151 (IPEC). This case concerned the claimant’s plastic lockers, sold under the brand name ‘eXtreme lockers’. A previous manufacturer of the eXtreme lockers launched a new range of lockers, in conjunction with another defendant company sharing the same sole director. The claimant subsequently sued the defendants for infringement of its unregistered design rights in the whole and part of its lockers.

The Intellectual Property Enterprise Court (IPEC) has now delivered numerous decisions relating

to UK UDR disputes and Judge Hacon is clearly developing this area of law. In particular, Judge Hacon is the guardian of actively managing cases in the IPEC to ensure issues are clear and circumscribed. There are a number of interesting points arising, and this case will be remembered for his suggested approach to pleadings as well as the outcome – that the claimant’s unregistered design rights in its ‘eXtreme’ lockers were indeed infringed by the defendant’s lockers.

Does a valid UDR exist?

Hacon J found that the eXtreme lockers were original, despite the claimant having had another, pre-existing model in mind: a designer needn’t reinvent the entire wheel to ensure their design is original. Nor were the defendants successful in showing the design was commonplace under [s.213\(4\) CDPA](#). On this issue, the judge concluded that the defendant’s expert had failed to show that the prior art relied upon was commonplace or that it was current in the thinking of designers in the field in question at the time the eXtreme lockers were created. To be ‘commonplace’, a prior design must be common in the thinking of designers in the field. It is not enough simply to identify a piece of prior art that is helpful that pre-dates the UDR. Evidence is required to show the prior art designs were familiar to the notional designer in the field. In this case, the evidence did not establish the design was commonplace. Hacon J further highlighted that, as the design was original, even had the prior art been commonplace it was unlikely to render the design so.

The approach to infringement

Hacon J first considered whether any of the claimed features would lack protection due to the principle of construction and/or must fit exclusions in [s.213\(3\) CDPA](#). The top and bottom of the locker, shaped so as to fit together as an aid to stacking, was excluded from protection for contravening the exclusion on features that ‘must fit’. In this case the panels of the locker interacted with another locker to aid stacking and therefore enabled the connection to another article so that either article may perform its function. Hacon J clarified that there needs to be a sufficient degree of precision in the fit between two articles, though they needn’t touch, which the shape of the lockers achieved (even though further acts were needed to guarantee stability, e.g. drilling the lockers to the wall).

Features which are excluded from protection under section [213\(3\)](#) are disregarded when considering infringement under section [226](#), the judge confirmed. Such features are not afforded design right protection.

However, features which are commonplace are not disregarded: infringement is assessed by reference to the whole design, including any commonplace features. The judge reasoned that [s.213\(4\)](#) applies to the whole design: individual features are important only if they are sufficiently significant to render the design as a whole commonplace. If not, commonplace features alone do not lose their design right protection. As a logical consequence, the judge must then, when considering infringement, compare the defendant’s article to the claimant’s design as a whole, including any commonplace features.

The judge recognised the difficulty of this approach, hence his emphasising the importance of clear pleadings (are you enforcing your rights in part or whole of an article?) and working from a list of significant features of a design.

The defendant’s design document referred constantly (and only) to the claimant’s lockers and “*duplicat[ing]*” certain features. This left Hacon J in no doubt that the defendant had copied the

claimant's design. The defendant failed to achieve the “*uphill climb*” to show that their design was not made exactly or substantially the same as the claimant's, save for their locker's interior.

Hacon J also provided advice on how to best plead one's case, recommending that the claimant lays out the significant features of their design and which of these the defendant's article allegedly infringes. If helpful, the claimant could also provide a labelled diagram to locate each significant feature. The defendant can use the list (which need not be agreed) to identify its arguments in relation to each feature.

Comment

The judge has set out remarkably useful guidance for practitioners on the practical way of progressing a UDR case, as well as a structured approach to the legal assessment. Undoubtedly the future of UDR cases, not just in the IPEC, will involve the creation of a list of significant features to focus the dispute.

The Judge's approach to assessing the claim is also important to understand. If a feature of a design fails section 213(3) (e.g. for breaching the 'must fit' exclusion') then it is disregarded when assessing infringement. However, a feature that is commonplace in a design (where the design as a whole is not commonplace) is not disregarded.

This adherence to, and deduction from, the strict wording of the statute ought not to overextend protection. If the design (of either whole or part of an article) is commonplace (as opposed to a feature of the design being so) then there is no design right to infringe. Where there are commonplace features of a non-commonplace design, the infringing design will still need to be exactly or substantially identical to the claimant's whole design to infringe. It perhaps only emphasises the importance of carefully pleading the significant features of the design that they may be considered appropriately under section 213(4).

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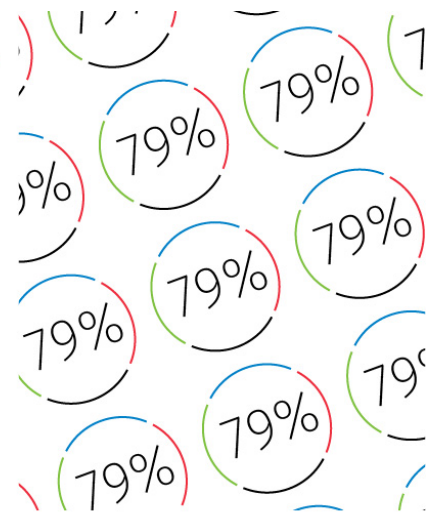
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