

Kluwer Copyright Blog

UK: Neptune failed to ‘Shaker’ down DeVOL in its unsuccessful infringement claim

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In a recent UK judgment, *Neptune (Europe) Limited v deVOL Kitchens Limited*, Neptune was unsuccessful in its claim against a fellow kitchen designer, DeVOL. DeVOL’s ‘Shaker’

kitchen was found not to have infringed the UK unregistered design rights (“UDR”) and a Registered Community Design (RCD) in Neptune’s ‘Chichester’ range.

UDR was created to complement copyright and registered design rights in the UK. Registered design law protects the visual appearance of a product, but since internal features and features consequent to a technical function are excluded from protection (s.1C RDA), rightholders previously had to rely on the copyright in technical drawings instead, thereby acquiring a much longer period of protection. The UK therefore introduced UDR: rights, lasting 10 – 15 years, which automatically subsist in the shape or configuration, whether internal or external, of a whole or part of a product (s.213(2) CDPA). The rightholder thus obtains a ‘bundle of rights’.

As Mr Justice Carr emphasises in this case: a claimant must clearly define what rights are being relied upon to allow a defendant to understand and defend the case being made against it. The nature of the rights, however, can make navigating a UDR case extremely complex. This judgment provides clarification of the parameters of UDR protection and reminds us of the differences between UDR and copyright, despite the apparent similarities.

The Chichester v Shaker kitchen ranges

This case concerned a kitchen range sold under the brand name ‘Chichester’ in which Neptune claimed both RCD and UDR in 12 articles (11 by the time the trial was heard). DeVOL had previously sold the Chichester range but it later ceased to do so and developed its own ‘Shaker’ range which it asserted was developed from its own ‘Classic’ range. Neptune brought proceedings against DeVOL alleging the ‘Shaker’ range copied and infringed its rights in the ‘Chichester’.

Neptune was ultimately unsuccessful but more interesting for third parties are the legal aspects of this decision.

“Any aspect of”

In 2014, the definition of “design” was amended such that UDR no longer subsisted in an “aspect” of an article, only the whole or part of it. There has been much debate regarding the timing of its implementation (given the absence of a transitional provision) and the deletion’s effect on what UDR might be claimed in an article. Mr Justice Carr took the opportunity in this case to extinguish uncertainty by deciding on these points.

The judge held that the amendment to remove “*any aspect of*” is not fully retrospective and that the law applicable to an act is the law in force at the time it was committed. Consequently, while it is possible to infringe “any aspect of” a design by acts committed prior to 1 October 2014 (when the above amendment came into force), it is not so on or after this date. From 1 October 2014, therefore, some rights are removed from a rightholder’s “bundle”.

As to the effect of the deletion, contrary to what some had previously asserted, Mr Justice Carr stated that the deletion is not merely declaratory of existing law (and therefore of no effect whatsoever). Quoting from the Explanatory Notes to the 2014 Act implementing the amendment: it was clearly intended to narrow the definition of (an unregistered) design, to “*reduce the tendency to overstate the breadth of UDR and the uncertainty this creates*”. As to what exactly has been removed, Mr Justice Carr provided some guidance but did not fully resolve the ambiguity. An ‘aspect’ includes “*disembodied features which are merely recognisable or discernible whereas parts of a design are concrete parts, which can be identified as such*”. Of course, it is not immediately clear what constitutes a “concrete” part. However, it is quite clear that combinations of disembodied features, for example the combination of a cuff and a collar of a shirt, or the end of a spout and the top portion of a lid in a teapot, would constitute aspects which are not protectable after the amendment was implemented.

Configuration

Other rights within the “bundle” are those of “shape or configuration” (s.213(2) CDPA), configuration being wider than shape and including the relative arrangement of parts or elements of an article. In this case, Neptune sought to rely on the “shape *and* configuration” of the rear rotatably adjustable foot and the fixed front legs. Having held that the parties’ adjustable feet were “*completely different shapes*”, Mr Justice Carr held that Neptune, given its pleading, was not then at liberty to rely on configuration alone. However, even had it claimed configuration alone, this combination would be so generalised as to amount to a method or principle of abstraction, or a mere idea of using that combination (none of which are protected by UDR). In any event, the parties’ combinations were also held to be different.

Differences between copyright and UDR

The first difference between copyright and UDR that this judgment highlights, is that of originality consequent to amendments. Both copyright (bar a few excepted works such as sound recordings and film) and designs must be original to gain protection (s.1(1) and s.213(1) CDPA respectively). In one article, Neptune sought to rely on a modified version of an earlier design, having a straight top to the glazed door (similar to that of DeVOL’s) rather than the original design’s curved top. It asserted, referring to a copyright case, that it is able to do so given that earlier versions do not

deprive later versions of originality: each drawing made by the artist is his original work. Mr Justice Carr rejected this assertion. Accepting DeVOL's submissions and relying upon case law establishing that the position in UDR is different, he confirmed that it is necessary to consider whether the changes are sufficient to give rise to a new design right in the whole or only in those changes as parts. Given the very different durations of copyright and UDR, this is "*important to prevent 'evergreening' of such design rights*", where small changes would bypass the duration determined by legislation.

The second difference is the test for infringement. To infringe copyright, one must copy *the whole or any substantial part* of the copyright work (s.16(3) CDPA). It is established UK case law that 'a substantial part' is not a quantitative but a qualitative assessment, relating to the original skill and labour which has gone into the work. Has what went in been taken out by the infringing copy? For UDR, the test is phrased slightly differently: one must copy the design so as to produce articles *exactly or substantially to that design* (s.226(2) CDPA). Consequent to a Court of Appeal judgment (*Wooley v A & A Jewellers*) which unambiguously decided that these tests were different, Neptune was unsuccessful in arguing that the tests were analogous. Substantiality is quantitative for UDR: it is *not* an infringement of UDR to take a substantial part of the design as it is in copyright. Mr Justice Carr pointed out that this is an important distinction, as can be shown by the facts of this case. Having relied on the *entirety* of the article as a design (apart from features which Neptune excluded) rather than asserting design rights in the article's parts, Neptune had to show that DeVOL's article has been made substantially to the same design. It would not be sufficient to show that certain features or combinations of features were taken (i.e. a substantial part in copyright).

Comment

This is an interesting case which resolves at least one hot topic of debate in UK UDR law. There is now a clear framework to construe when and what rights of action accrue in relation to the deletion of "any aspect of" from the definition of design. While perfect clarity was not brought to what constitutes an aspect or a part (such that debate will likely continue in the complex pleadings of UDR cases), Mr Justice Carr's comments do at least remove combinations of disembodied features from the bundle of rights which may be asserted against a defendant.

Once again, we are reminded that a claimant should be clear what rights he is asserting in an article and convey them clearly and carefully. However, as was the case for Neptune, however the designs are asserted, and even where the judge might ponder on alternatives, sometimes they simply haven't been infringed.

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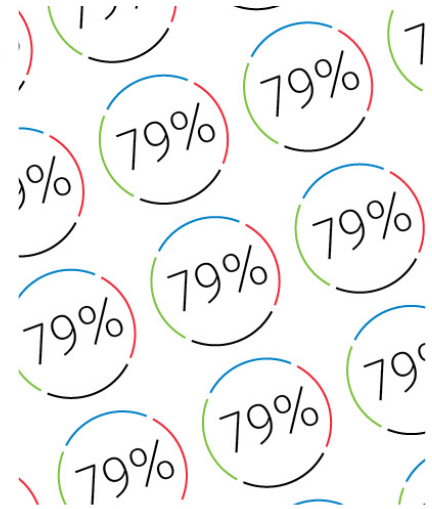
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