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Documentation of creative process is key to overcoming inference of copying
United Kingdom - McDermott Will & Emery UK LLP

Design

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In *Albert Packaging Ltd v Nampak Cartons and Healthcare Ltd* ([2011] EWPC 15, June 2 2011), it was found that, while there was an inference that the claimants' unregistered design had been a consideration in the defendant's creative process, the scope of any similarities between the product complained of and the asserted design was insufficient to show infringement.

In 2005 the second and third claimants designed a carton for packaging tortilla wraps. From 2006 to 2008 this carton was sold, via an intermediary company, to a supermarket chain. In 2008 the intermediary undertook a re-tendering process and changed carton suppliers to the defendant. In 2009 the defendant began producing a carton which the claimants said infringed the unregistered design right in their 2005 product. The claimants put forward three different approaches to the assessment of their unregistered design:

1. The shape of the carton in assembled form;
2. A generally rectangular box save in that the top face slopes downwardly from the rear face to the front face, there being a window extending from the sloped top face onto the front face; and
3. The distance from the shoulder of the pack to the top of the back panel, along the back panel, is 35 millimetres regardless of the length or width or depth of the pack.

The defendant denied infringement and said that no design right subsisted.

The judge had to consider whether the first claimant had an exclusive licence to the unregistered design and an associated right to sue. The judge distinguished *Ifejika v Ifejika* ([2010] EWCA Civ 563) and ruled that, as the right in issue was an unregistered design right, the right for an exclusive licensee to sue for infringement would arise only if the formalities under the [Copyright Designs and Patents Act 1988](#) had been complied with. In this case they had not, and the first claimant had no right to bring the claim.

Following *Rowlawn Ltd v Turfmech* ([2008] EWHC 989 (Pat)), the judge found that the exclusion of design right subsisting in a method or principle of construction operated to limit the generality of the design to be relied upon. Applying this to the three design approaches put forward by the claimants, the judge found that approaches 2 and 3 were too general for an unregistered design right to subsist.

The claimants contended that the relevant field was limited to packaging for wraps. The judge, however, found that the notional designer would be familiar with designing cartons for other products. As such, the field was simply found to be carton design. Due to the generality of approaches 2 and 3 and the nature of the packaging in the design field in 2006 (the relevant year), both were excluded from protection.

The judge, however, considered that:

"to say that the particular combination of all the specific features of the Albert Packaging carton in its assembled form is commonplace would deny packaging designers any design right at all."

Accordingly, the judge found unregistered design right to subsist according to approach 1.

The judge further found that:

"from the point of view of the side and front elevations of the cartons in their erected state, the only major visual differences between the Nampak cartons and the Albert Packaging design are the shape of the window and the width".

It was also found that there was opportunity for the defendant to have had access to the claimants' design. There was "plainly" a case to answer, and without an explanation from the defendant, the "only inference to draw would be that the products were copied from the [claimants'] packaging design". The judge thus moved to address the defendant's explanation.

The design history of the defendant's 2009 product went in three stages. In 2005 the defendant produced two designs as samples for a client. In 2007 a design for a 'Pizzatilla box' was produced for the common intermediary. Finally, the design pleaded as the infringing product was produced in 2009. It was said by the defendant to be based on the Pizzatilla box and one of the 2005 designs.

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Because the defendant had replaced the claimants as suppliers to the common intermediary, the judge considered that it was “more likely than not that the claimants’ carton was one of the sources of ideas for the Pizzatilla box”. As the 2009 carton was in part based on the Pizzatilla box, the judge found that the “claimants’ design was also another source of ideas which fed into the later carton designs and, in particular, into the 2009 carton design alleged to infringe”.

Unregistered design right was said to restrain reproduction of the design by making articles to the design. This was to mean “copying the design so as to produce articles exactly or substantially to that design”. The judge found that all that had been derived from the claimants’ design was the dimensions of the side panel. To find infringement in the overall design on this basis would have:

“the effect of undermining Section 213(3)(a) CDPA since, in truth, it would give unregistered design right to something which is no more than a method or principle of construction applicable to articles with many different appearances.”

The case highlights the importance for designers to ensure that they carefully document the design history, with drawings, dates and, if possible, a narrative. If the defendant had not been able to explain, and prove, how it had arrived at the design the claimants complained about, it would have been possible that the court would have had no choice but to infer both copying and infringement.

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