

Prior to 1 July 1989, three dimensional designs of, for example, a kettle could potentially be protected as registered designs and/or as copyright works. If the design was registerable, copyright protection was only available for 15 years from first marketing of articles made to the design, whereas if the design was not registerable then, extraordinarily, it enjoyed full term copyright protection, which at the time was life of the designer + 50 years. This meant that the designer of a non-registerable functional item (such as, famously, an exhaust pipe<sup>1</sup>) was able, at least in theory, to enjoy very lengthy protection from competition – much longer than he would get, for example, from a patent.

To deal with that situation, the Copyright Designs and Patents Act 1988 (CDPA) introduced a new UK intellectual property right – unregistered design right (UKUDR) – to replace the role of copyright in protecting the designs of three dimensional items which were not themselves artistic works (such as sculptures, which continued to enjoy copyright protection).

UKUDR, which lasts for 10 calendar years from the end of the year of first marketing of items embodying the design<sup>2</sup>, protects certain designs from copying. Determining precisely what features of a design are (or, often as importantly, are not) protected by UKUDR remains an unsatisfactorily uncertain business, as the recent case of *Neptune (Europe) Limited v Devol Kitchens Limited* [2017] EWHC 2172 demonstrates.

## Neptune

*Neptune* was a case about kitchen furniture. Neptune claimed that Devol had produced its Shaker range of kitchen furniture by copying Neptune's Chichester range. Devol denied copying. Neptune had, as claimants often do in UKUDR infringement cases, a problem: Devol's kitchen furniture rather unhelpfully (at least from Neptune's point of view) did not reproduce some fairly prominent features of Neptune's Chichester range. For example, as illustrated below, the doors on Devol's Shaker kitchen furniture did not have the cock-beading feature which appeared on the doors of Neptune's kitchen furniture. There were about half a dozen such prominent missing features ("Excluded Features").

Neptune naturally did not want the Excluded Features to detract from its copying case and so it said that it could simply exclude such features from the designs, which it alleged had been copied. Devol disagreed. The court, therefore, had to consider whether or not Neptune could cherry pick the features of its designs in this way.



Neptune's Chichester range has cock-beading

Devol's Shaker range has no cock-beading

## What Is a Design?

UKUDR, as originally framed, had defined a design as meaning "the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article".

With effect from 1 October 2014<sup>3</sup> the words "any aspect of" were deleted. However, as some (but not all) of the alleged infringements in the *Neptune* case occurred before 1 October 2014, the court still had to consider whether the Excluded Features and the parts of the designs which would be left after their exclusion amounted to either "the design of *any aspect of* the shape or configuration (whether internal or external) of the whole or part of an article" or "the design of the shape or configuration (whether internal or external) of the whole or part of an article".

## The Aspect Issue

"Aspect" had been held to mean merely something which was discernible or recognisable. However, that threshold would appear to be set so low as to be practically non-existent: if the presence of some feature is capable of characterising a design in a statement of case then it must surely be an aspect, as it would *a fortiori* have to be discernible or recognisable to be capable of characterising the design in the first place.

<sup>1</sup> *British Leyland v Armstrong* [1986] RPC 279

<sup>2</sup> Or up to 15 years from the end of the year in which the design is recorded or articles made to the design, if articles made to the design are not marketed in the first five years.

<sup>3</sup> The date when the CDPA was amended by section 1(1) the Intellectual Property Act 2014, ("the 2014 Act").

What Parliament intended to achieve by the deletion of the “any aspect of” language had been considered by HHJ Hacon in *DKH Retail Ltd v H. Young (Operations) Ltd*<sup>4</sup>:

“There is no reason to suppose that Parliament intended the new definition of ‘design’ in s.213(2) to be identical to that in the Design Regulation and plainly it isn’t. However for policy reasons of consistency where that can be achieved, there is much to be said for treating “the design of the shape or configuration (whether internal or external) of the whole or part of an article” as having a meaning as close as possible to “the appearance of the whole or part of a product”. One route to such a result would be to interpret the effect of s.1(1) of the 2014 Act as being that it no longer permits a claim to unregistered design right to extend to designs other than those specifically embodied in all or part of the claimant’s article, i.e. no more unregistered design rights in *abstract designs*...”.

(emphasis added)

To understand what Hacon HHJ meant by an “abstract design” takes us to the very heart of the oddity that is UKUDR. For UK registered designs or Community registered or unregistered designs, what matters is the appearance of the whole thing protected by the right (or at least a distinct part of it). Similarly for copyright, it is the whole of the claimant’s work that matters when determining whether or not it has been copied. UKUDR is very different: because the right can subsist in relation to the configuration<sup>5</sup> of the whole or a part of an article, it is possible to select an arrangement of parts or elements of a design and claim that combination as constituting the design. This makes UKUDR very flexible in scope: a claimant can tailor how he pleads his design so that it best captures the elements that have been copied. For example, a teapot might have a fish head for a spout and a fish tail for the handle. The set of all teapots with such a fish head spout and fish tail handle, other than the claimant’s actual design, would according to Hacon HHJ be abstract designs, excluded from protection after 1 October 2014<sup>6</sup> or as Hacon HHJ put it:

“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.”

It is worth pausing briefly to consider what a strange formulation this is of the effect of the deletion of the “any aspect of” language. The law has apparently changed so that a claimant cannot assert that his design, characterised by reference to a set of “sufficiently interconnected” design features, extends to designs which are not embodied in all or any part of his article. Or to return to teapots, a claimant can no longer say that the mere presence of a very similar fish head shaped spout and a fish tail shaped handle in a competitor’s tea pot infringes a design defined by reference to a configuration of such features, notwithstanding that the competitor’s item has a totally different body. If the claim was only to an entire *part* of the tea pot – for example the fish head spout – then the claim could still be made out. But if the claim was to disparate parts of the spout – for example to the two ends of it – then the claim should again fail if the middle part of it was materially different.

It is also entirely unclear what “sufficiently interconnected” means in this context. Do the claimed features have to be in physical contact with each other, for example?

## Aspects Post Neptune

In *Neptune*, the court reformulated what an aspect was, saying in effect that an aspect of a design was a disembodied part of a design:

“In my view, aspects of a design include disembodied features which are merely recognisable or discernible... aspects of the design of a teapot could include the combination of the end portion of the spout and the top portion of the lid, which are disembodied from each other and from the spout and lid. They are not parts of the design.”

For the court in *Neptune*, aspects of a design are features inherent in the design of an article which are somehow disembodied both from the larger parts of the article of which they form part and also from each other. This was to be contrasted with the parts of a design which were “concrete parts, which can be identified as such”.

## Where All This Left Neptune

On the above basis the court found that none of the Excluded Features, nor the remainder of Neptune’s designs after such exclusion, were properly characterised as aspects of the designs. The court found that the cock-beading and moulding, for example, were “concrete parts of the designs, which are created separately and then applied to the Chichester cabinets”. Neptune was therefore entitled to rely upon the entirety of the designs in question, without the Excluded Features. It could identify its designs in part<sup>7</sup> by reference to the absence of the Excluded Features.

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4 [2014] EHW 4034 (IPEC) at [10] - [18].

5 A term which itself has been interpreted as including in relation to an article “its relative arrangement of parts or elements”, (*Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd & Ors* [1999] RPC 717 at 721).

6 See paragraphs 8 and 16 of *DKH Retail Ltd v H. Young (Operations) Ltd*.

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7 It further defined its design by reference to the inclusion of a number of pleaded features, as is common practice.

Ultimately, however, this turned out to be a hollow victory for Neptune, which still lost on all its claims. For there to be infringement of UKUDR there must have been copying which resulted in the defendant making something which was at least substantially to the claimed design: it is not sufficient for UKUDR infringement for a defendant to reproduce only a substantial part of a design. As Neptune relied on the entirety of its designs, apart from the Excluded Features, (and not parts of them or combinations of parts) the comparison was, therefore, design of the whole of the claimant's article (less the Excluded Features) versus design of the whole of the defendant's article. This meant that differences between the articles embodying the designs would matter as much as similarities. And so it proved: the court concluded that there had not been copying or that, for other reasons, there was no UKUDR in relation to certain of the features Neptune relied upon.

## Where All This Leaves the Rest of Us

Unfortunately, as the law now stands, there is some real uncertainty as to what are unprotectable "disembodied features which are merely recognisable or discernible" on the one hand and what are "concrete parts [of a design], which can be identified as such". The courts in both *DKH Retail* and *Neptune* appear to agree that features of a design, to be protectable, had to be "sufficiently interconnected"/not "disembodied from each other", but other than that the formulations are hard to reconcile. Following *DKH*, what is now excluded from protection are abstract designs which, although including all the relevant features of the claimant's claimed configuration, nonetheless were not to be found in the claimant's design, presumably because of the presence of other different features. Whereas in *Neptune*, the excluded territory comprises "disembodied features which are merely recognisable or discernible" and are not "concrete parts [of a design], which can be identified as such".

This is not just a jury question that we should rejoice has been carefully crafted to give future judges much needed discretion. It is totally unclear how one should even begin to establish the basis of the *Neptune* distinction. In *Neptune*, the court relied on the fact that some of the Excluded Features were created separately and then added to the furniture. But there is no way of knowing whether this is the determinative factor or only one of many potentially relevant factors. As there is no definition of "disembodied" in the legislation or indeed in the case law, there is no way of knowing, for example, what it is about the shape or configuration of the end portion of a spout that might make it disembodied from the rest of the spout.

The 2014 Act was intended to limit the protection for "trivial features of designs"<sup>8</sup>. It achieved that in a very obscure way by the deletion of the "any aspect of" language. It is not surprising that such a bizarre route has created problems of interpretation for the courts, notwithstanding the best efforts of the very able and experienced judges who sit in them.

This is an unsatisfactory state of affairs. It is going to make pleading out UKUDR infringement cases much more difficult and uncertain than should be the case. UKUDR remains a very important intellectual property right. It will often be the only right that will protect three dimensional mass produced items from copying in the UK. It is imperative that there should be clarity about which features of designs are protected and as importantly which are not. One could forgive manufacturers of items such as exhaust pipes for having some degree of nostalgia for the pre-CDPA world.

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<sup>8</sup> Paragraph 10 of the explanatory notes to the 2014 Act.