

Case No: A3/2005/0406

Neutral Citation Number: [2006] EWCA Civ 166

**IN THE SUPREME COURT OF JUDICATURE
COURT OF APPEAL (CIVIL DIVISION)**

ON APPEAL FROM THE HIGH COURT OF JUSTICE

CHANCERY DIVISION

The Hon Mr Justice Mann

HC 03 C01654

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: Wednesday, 8th March 2006

Before :

LORD JUSTICE TUCKEY

LORD JUSTICE JACOB

and

LORD JUSTICE LLOYD

Between :

Dyson Ltd

- and -

Qualtex (UK) Ltd

Claimant

Respondent

Defendant

Appellant

(Transcript of the Handed Down Judgment of

Smith Bernal WordWave Limited

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Official Shorthand Writers to the Court)

Henry Carr QC and Douglas Campbell (instructed by **Messrs Wragge & Co**) for the **Claimant/
Respondent**

Richard Arnold QC and Tom Moody-Stuart (instructed by **Messrs Robinsons**) for the **Defendant/
Appellant**

Judgment

Lord Justice Jacob:

1.

This appeal is from a judgment of Mann J, [\[2005\] RPC 19](#), [\[2004\] FWHC 2981 \(Ch\)](#). It is about spare parts for Dyson vacuum cleaners. The kind of spare parts in issue are known in the trade as “pattern parts”. These are replicas of the original parts, made deliberately so, to look as close as possible to the original parts.

2.

The original designers and manufacturers of consumer items, (often known as “OEMs – original equipment manufacturers”), not surprisingly sometimes desire to control the trade in spare parts for their machines. The independent manufacturers or dealers generally wish to imitate the original manufacturer’s part as closely as they can – they will sell better than a part which works as well but looks different. The reasons why they will sell better are complicated. One factor though is self-evident: a consumer is likely to have more confidence in a part which looks exactly the same as the broken one. One can readily imagine the consumer going into a shop with his broken part and saying “can I have another of these?” If the part looks different there will be sales resistance.

The legislative history

3.

The history of the battles between the OEMs and the independents is extensive. It really began when in the late 1960s and early 1970s it was realised by the lawyers that copyright in drawings, particularly engineering drawings, could prevent the reproduction of those drawings in three dimensional form. The OEMs saw a weapon which could be used against the independents, particularly for “pattern spares”. Prior to then the trade in pattern spares had grown up over many years with no-one thinking that anyone could prevent their manufacture or sale. In those now distant days the thinking was that articles such as spares could be protected by patent, or registered design (subject to eye appeal) or not at all.

4.

In some countries, most notably the United States, this is, I understand, still the position. As far as continental Europe is concerned, there may in some countries be protection for spares, either under some specific law or by way of a general notion of unfair competition. According to a note provided Mr Carr QC, for Dyson, French law for example regards unnecessarily servile imitation of a non-functional part as unfair competition. It is a pity that there is simply no general rule about what can and cannot be done about spares within Europe. But such is the position.

5.

Turning back to this country, in the 1970s the OEMs began to assert copyright. The first reported case was *British Northrop v Texteam Blackburn* [1974] RPC 57 about parts for weaving machinery. Although occasionally they failed for technical reasons (see e.g. *Hoover v Hulme* [1982] FSR 565, where adequate notice to a dealer had not been given) they were largely successful until the decision of the House of Lords in *British Leyland v Armstrong* [1986] AC 577. There the independent manufacture of spare exhaust pipes for cars was held lawful. Broadly there were two grounds: an implied right of repair and non-derogation of grant. The decision is not without criticism – see particularly the analysis of *Leyland* by the Privy Council in *Canon v Green Cartridge* [1997] AC 728. The conclusion in that case was that the “*Leyland*” defence is limited to clear cases of anti-competitiveness, or those where the ordinary man would “unquestionably assume that he could do for

himself (or commission someone else to do)". No Leyland-type defence is raised explicitly in the present case, though hints of it emerged from time to time.

6.

The independents also sought to defend themselves by invoking, in one way or another, competition law. Thus, in *Volvo v Veng*, case 238/87 [1988] ECR 6211, a defence of abuse of monopoly under Art. 86 (as it then was) of the Rome Treaty was raised and failed. But in a reference to the Monopolies and Mergers Commission, Ford were found guilty of pursuing an anti-competitive course of conduct contrary to the public interest, Monopolies and Mergers Commission Report on the Policy and Practice of the Ford Motor Company Limited of not granting licences to manufacture or sell in the UK certain replacement body parts for Ford vehicles, February 1985, Cmnd. 9437. The Commission recommended changes in the law, the details of which do not matter since they were not followed up as recommended.

7.

It was against this background that the White Paper preceding the Copyright, Designs and Patents Act 1988 was drafted. The judge set out the position as follows:

"The White Paper considered the extent to which spare parts should be excepted from any prevention of copying and pointed out (at paragraph 3.20) that there was a considerable debate as to whether functional articles should be protected or not. There are significant economic factors in play in such an argument. The White Paper indicated that the government adopted neither an extreme protectionist nor an extreme non-protectionist stance. The White Paper recommended some protection, but a more limited protection both in terms of its scope and in terms of its duration than was afforded to artistic works via the copyright regime. At paragraph 3.21 the White Paper said:

"3.21 British industry relies to a great extent on its innovative abilities. It is clear that there are many innovative industrial products which are costly to design but which are not truly inventive and which therefore do not qualify for patent protection. Accordingly, the government has concluded that some protection should be available to give the manufacturer who has spent money on design the opportunity to benefit from his investment, thus providing an incentive to further investment. It has also concluded that this protection should extend to spare parts but it readily accepts that the full protection of copyright law would be excessive."

And the report went on:

"3.26 The remaining alternative considered, and the one that the government intends to follow, is to provide protection on copyright principles but without the more objectionable features of full copyright protection... Where the functional article is also a spare part it is arguable that the potential for monopolistic abuse should be avoided by giving no protection outside patent and registered design systems; the House of Lords decision in *British Leyland -v- Armstrong Patents Company* is consistent with this approach. On the other hand, the Monopolies and Mergers Commission, in its report on the Ford Motor Company's exercise of its copyright in car body panels, which are manifestly mass-market spare parts, recommended that the term of protection for such

panels should be five years. The law must however deal with all classes of articles, whether they are spare parts, components of more general utility or self contained products... Since it is not practicable to distinguish narrowly between articles in generally applicable legislation, a compromise is necessary. The government considers however that the basic premise should be that all original designs deserve a period of protection to give the designer a market lead over the copier.

3.27 Against this background, the government proposes to introduce a new form of protection against copying for original designs, including designs of spare parts..."

8.

The Judge then said:

"From this the following matters are apparent. First, the White Paper clearly has spare parts, and the issues surrounding them, in mind in this context. Second, it clearly rejected the notion that spare parts should be exempted from any protective regime. Thirdly, it rejected the notion that spare parts should be subject to some special regime. They were to be dealt with like all other functional articles, though as will be apparent one or two provisions have particular application to spare parts."

9.

This is obviously right. And it may be noted that the provisions we have to construe and apply exclude certain designs from protection altogether, whether or not they are designs for spare parts.

10.

The Judge's conclusion was that the new unregistered design right ("UDR") created by the Act should be construed on the following basis:

"I shall therefore approach those provisions on the footing that spare parts come within their compass, both in terms of the conferring of the right and in terms of the qualifications or limitations on the right, but without any particular leaning towards the suppliers of original parts, the suppliers of replica parts or consumers. The "must fit" and "must match" provisions are clearly intended to apply to spare parts, but there is nothing in the Act, or in the White Paper, which requires me to lean in any particular direction in construing them. I will also approach the question of construction on the footing that Parliament intended to give real, and not ephemeral, protection to designs - this is important in considering the must fit exception to design right."

11.

From time to time each side suggested we should approach the provisions with some sort of clear purpose in mind. Thus Mr Carr QC for Dyson submitted that UDR was itself a narrow right in point of duration and that the exceptions to it should accordingly be construed narrowly. On the other hand it was implicit in Mr Arnold QC's submissions for Qualtex, that virtually all spare parts, functional or merely visible as forming part of the whole machine, were outside the right. I do not think it is possible to approach the provisions with any clear purposive intent in mind. Given the White Paper and the extremely complex economic arguments involved it is not possible to give a purposive construction - you need a reasonably clear idea of purpose before you can do that. In the context of construing an international treaty by reference to the travaux préparatoires to find a definite legal

intention Lord Steyn said: "Only a bull's-eye counts" (Effort Shipping v Linden Management [1988] AC 605 at 625). Much the same goes for trying to ascertain such an intention from a White Paper which precedes legislation. Here on the one hand Parliament refused to create a general spare parts exception, and on the other hand clearly did not intend that OEMs should have absolute control over the manufacture of spares. A compromise (some might say fudge) in the form of the language actually chosen in the Act was what was done. We must construe it as it would be read by a reasonable reader. Here that means taking the language as it stands. That is what the judge did. He was right.

12.

I should mention one other matter about the legislative background. The parties were agreed that no purpose would be served by consulting Hansard: the Pepper v Hart [1993] AC 593 criteria were not met.

The statutory provision

13.

The provision giving rise to so much dispute is s.213 of the 1988 Act. It reads, so far as it matters here:

"213.—(1) Design right is a property right which subsists in accordance with this Part in an original design.

(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.

(3) Design right does not subsist in—

(a) a method or principle of construction,

(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, or

(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part, or

(c) surface decoration.

(4) A design is not "original" for the purposes of this Part if it is commonplace in the design field in question at the time of its creation."

14.

It has the merit of being short. It has no other. Jonathan Parker J considerably understated the position, when he said "regrettably, the drafting of s.213 leaves much to be desired" (Mark Wilkinson Furniture v Woodcraft Designs [1997] FSR 63 at p.27). It is not just a question of drafting (though words and phrases such as "commonplace", "dependent", "aspect of shape or configuration of part of

an article” and “design field in question” are full of uncertainty in themselves and pose near impossible factual questions). The problem is deeper: neither the language used nor the context of the legislation give any clear idea what was intended. Time and time again one struggles but fails to ascertain a precise meaning, a meaning which men of business can reasonably use to guide their conduct. The amount of textbook writing and conjecture as to the meaning is a testament to its obscurity. We just have to do the best we can, trying to arrive at “an interpretation which the reasonable reader would give to the statute read against its background” per Lord Hoffmann in *R (Wilkinson) v IRC* [2005] UKHL 30, [2006] 1 All ER 529 at [18]. The absence of any clear policy, as to where the line of compromise was intended to run, means that brightline rules cannot be deduced.

Case management of this appeal

15.

Dyson sued for infringement of UDRs relating to a total of 14 spare parts. They are each described generally in [13] of the judgment. When, at the final hearing, the judge gave permission to appeal, he suggested that it would not be necessary for the Court of Appeal to consider all of the parts in issue, some samples ought to do. At an interlocutory hearing I ordered that, in the first instance, the Court should hear the case about just 6 parts because these ought to cover all the issues between the parties. And if there were any remaining, the parties were agreed that they probably could be dealt with subsequently by a single member of this court.

16.

So it was that the case came before us in relation to the 6 selected parts. However as we read into the case, we appreciated that it was not even necessary to consider every point in relation to each of these. At the outset of the appeal we therefore asked Mr Arnold to argue his points by illustrating each one by reference to just one or two features of one (or more) of the 6 parts. Mr Carr was likewise invited to draw attention to any further particular features of a part or parts which he needed to illustrate the points of his argument, as well as of course to deal with the features chosen by Mr Arnold. The parties were agreed that resolution of the appeal by reference to the features thus identified should be enough to dispose of it. We are grateful for the sensible and pragmatic approach adopted by both counsel. Even with that, the hearing lasted a full four days.

17.

The Judge, faced with a myriad of points, sensibly started by considering the legal principles as a whole and then went on to apply them to the various parts. Because the large number of aspects of the 14 parts in issue had not been reduced by pre-trial case management, the Judge was burdened with a mass of detail and it is not surprising his judgment was so long. From time to time, contended Mr Arnold, although the judge had dealt with a general question of principle satisfactorily, he had gone on to misapply the principle or wrongly apply some other principle.

Approach on appeal to decisions of fact and value judgment

18.

There was no dispute here as to the principles. The Court of Appeal will not interfere with findings of primary fact unless they are shown to be wrong (CPR 52.11(3)(a)). Nor will it interfere with a value judgment based on “the application of a not altogether precise legal standard to a combination of features of varying importance” unless there has been an error of principle per Lord Hoffmann in *Designers Guild v Russell Williams* [2000] 1 WLR 2416 at p.2423.

The Parts considered on this appeal

19.

These were the DC01 wand handle (which had 3 versions, 1992, 1995 and 1997), the DC03/DC04 brush bar, the DC01 lower hose cuff, the DC07 stair tool, the DC02 wand handle and the tool adaptor. Good photographs of these were included as an appendix to the judgment and are well-reproduced in the Reports of Patent Cases report, [\[2005\] RPC 19](#). In addition the Judge describes the parts in the course of his consideration of each. So it is not necessary for me go into a detailed description of each part – I will just describe what I need to deal with the point.

A general argument

20.

Before going to the detailed points, it makes sense to consider Mr Carr's opening, general point – one by way of *reductio ad absurdum*. He submitted that if Mr Arnold were right about his construction of "must-match" it would be open to a third party to produce all the parts which go to make up the external appearance of the machine. And if he were right on his construction of "must-fit" the same would apply to all the working parts. So, if Mr Arnold were right, people would simply be able to copy the whole machine itself. That is absurd and cannot be so.

21.

I do not think this general argument assists. One answer (there are others) is because a separate UDR will subsist in that aspect consisting of the appearance of the whole article, it does not matter if none subsists in the individual parts. That UDR is not a feature of shape which is dependent on the appearance of anything.

What is an "aspect of design?": the "visually significant" point

22.

So I turn to the individual points argued, of which this was the first. UDR can subsist in the "design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article." This is extremely wide – it means that a particular article may and generally will embody a multitude of "designs" – as many "aspects" of the whole or part of the article as can be. What the point was of defining "design" in this way I do not know. The same approach is not adopted for ordinary copyright where the work is treated as a whole. But even with this wide definition, there is a limit: there must be an "aspect" of at least a part of the article. What are the limits of that? I put it this way in *Fulton v Totes* [\[2004\] RPC 16](#), [2003] EWHCA Civ 1514 at para. 31:

"The notion conveyed by 'aspect' in the composite phrase ... is 'discernible' or 'recognisable'".

23.

Mr Arnold suggested that the limit was more extensive – so as to exclude a "mere twiddle" (see *Volumatic v Myriad*, unrep. 10th April 1995). Sir John Vinelott there settled on the test of "visual significance." That is all right for features of shape provided one remembers that UDR can subsist in an aspect of part of an article. The test does not mean that one can simply forget an aspect of the design of a whole article on the grounds that it is a visually insignificant feature of the design of the whole article. If one focuses on that aspect consisting of the alleged "twiddle" alone it is difficult to see how it can be visually insignificant. That is why I prefer my formulation.

24.

The Judge held that “all design aspects in this case would fall into the category of ‘visually significant,’” [29]. Mr Arnold sought to challenge that finding of fact/value judgment by reference to the DC04 lower hose cuff (not actually one of the 6 parts) and the DC01 lower hose cuff (shown at p. 514 of the RPC). He suggested the Judge had made an inconsistent finding about these. In relation to the former the judge said, [224], “again there is not a lot left notionally to look at in relation to commonplace once the must fit items are excluded”. In relation to the DC01 lower hose cuff the judge said: “My conclusions mean that there are not many features left when one has excluded the must fit items”, [184]. Both these observations were made where the Judge was dealing with the “commonplace” argument. I do not see they begin to amount to a finding that the aspects which were left were, in themselves visually insignificant.

25.

Moreover when one came to consider the detailed argument (which took place over the DC01 hose cuff) there were clearly discernible portions of the article not excluded from protection for other reasons. There was ample material for the Judge to make the finding he did. In particular there is the shape of the tab which holds in the wire, (best seen in the upper photo on p.514 of the RPC), the shape of the portion of the outer portion of the cuff (i.e. which does not fit into the machine) and the little ribbing on the tab which goes into the machine (the lower photograph on the same page shows the semicircular tab, but the vertical ribs on it do not show). These are all clearly discernible and I see no reason why they do not count as “aspects” of part of the article.

26.

Mr Arnold’s other way of putting the point here, which he sought to apply in other ways to other objections, was to say that the Judge had been too “finical,” focussing too much on trivial detail. He accepted the word “pernickety” conveyed the same notion. I do not accept that argument: UDR can subsist in aspects of detail: they are “aspects of part of an article” and so qualify within s.213(2). Besides, it hardly lies in the mouth of an exact copyist to say that the exactitude with which he has copied does not matter visually.

s.213(3)(b)(i) So-called “must fit.”

27.

I say this sub-section is “so-called” because that is the term by which it is known. Mr Arnold rightly said that its language did not actually say “must-fit” (just as the next sub-section, so-called “must-match” does not actually say that). I agree that one must go by the actual language and not by the epithet or even the notion behind the epithet. The Judge rightly so said at [34].

28.

In his general consideration of the law, the Judge used the decisions of Laddie J in *Ultraframe v Fielding* [2003] RPC 435 at [73] and *OSI v Aspect Vision Care* [1997] RPC 289 at p.424 to extract three propositions [34]:

“(i) It does not matter if there are two ways of achieving the necessary fit or connection between the subject article (the first one referred to in the sub-section) and the article to which it fits or with which it interfaces. If the design chosen by the design right owner is a way of achieving that fit or interface, then it does not attract design right no matter how many alternative ways of achieving the same “fit” might be available.”

(ii) For the purposes of the sub-section, the article with which the subject article is interfacing can be part of the human body. This might have had relevance in the present case because some of the parts (triggers and a catch) are designed to interface with the human finger or thumb. However, Mr Arnold disclaimed reliance on this – he did not rely on the finger or thumb as a must fit item in the context of any article in the present case.

(iii) The sub-section operates to exclude design right even if the relevant part of the design performs some function other than the function described in the sub-section – for example, it is decorative, or has an additional function not falling within the provision. This additional function does not exclude the operation of the provision.

29.

Mr Arnold quarrelled with none of these. He relied on *Parker v Tidball* [1997] FSR 680 as an example of a case where there were two ways of achieving the necessary fit or connection. The actual decision may be questionable – a window in a mobile phone case is necessary to see the keyboard but if it is made larger or of a fancy shape (e.g. a heart for teenager use) I do not think it is really an example of two ways of enabling the phone or window to perform their function. There is only one way – keep the keyboard visible. A larger window not only enables that, it enables more: that part of the window which is unnecessary for function or fit would not, as it seems to me, be within the exclusion. However I do not think any of that matters here.

30.

Mr Arnold contended that the Judge, having got his general propositions right, nonetheless went on to make four errors of law.

(1) Allegedly wrongly construed “must fit” so as to exclude cases where parts do not touch

31.

The first error of law was, at least implicitly, to hold that the exclusion was limited to cases where there was a true interface, in the sense of touching, of the parts. An aspect of design which consisted of some sort of necessary clearance was not within the exclusion. Mr Arnold here placed reliance on the words “placed around.”

32.

A feature is excluded if it “enables an article to be placed around another article so that either may perform its function.” Mr Arnold took us to four examples which he said showed the Judge making the error he suggested. One was the Judge’s hypothetical example of grooves in an electrical plug placed there to enable cooling (see [169]). It is not necessary to consider this hypothetical and I decline to do so. What matters are the examples relating to the parts in issue.

33.

The first example is dealt with in the judgment at [92]:

“The flat bottom of the handle which is said to sit on a horizontal surface at the bottom of the socket on the machine which receives the handle. It is curved to match the curve of the handle (actually the catch, at this point). At the front of the handle there is a curved section which is covered by the handle release catch. That runs down to the bottom of the handle. When the handle is placed in the receiving socket on the machine something has to stop its descent. This is achieved by having a horizontal surface (a sort of shelf) on

the machine which provides the stop - there is actually a raised nub on it. At the frontmost part of the curve of the handle (underneath the catch) there is a raised nub - it is about 4 mm square and about 1 mm in height. When the handle is placed in the socket that nub contacts a nub on the shelf and together they stop the descent of the handle. The combination of those features means that the bottom of the handle's curved section does not actually sit on the shelf. It is the two nubs which engage. Nevertheless Mr Arnold says that I should adopt a "practical approach" and say that the whole of the bottom of the handle falls within the must fit exception, and not merely the nub. The nub is clearly a feature which enables the handle to be placed in the machine so that both can perform their respective functions. It is obviously a deliberately placed item - it is apparent that there is intended to be no touching between the shelf and the bottom part of the handle other than at the point of the two nubs. I do not think it is possible to say that any other part of the bottom surface enables the handle to be connected to or placed in, around or against the body of the machine so that the handle (or the machine) can perform its function. The appeal to the "practical approach" is an appeal to ignore the words of the section and the design realities of the part. The section, and the approach of the parties in this case, has required a breakdown of parts into their various aspects, and one cannot move from one aspect which complies to another which does not merely on the grounds of practicality. The point was not put to me on the footing that the curved section of the handle above the nub was somehow the male part of a male/female joint, and on the facts I very much doubt if that could be done. Short of such an argument, I cannot find that the bottom face of the curved section (which is the part relied on by Qualtex) falls within the must fit exception."

A picture may help. One can see the nub on the handle in the picture on p. 507 of the RPC. The flat bottom is also visible.

34.

Putting it shortly, therefore, the nubs are there to make the two parts fit and work together, but the surrounding flat bottom serves no function. I do not see that this finding of fact (which is what it was) shows any error of law, whether about clearances or otherwise. Nor, as I have said, does the "finical" criticism which I have already mentioned carry Mr Arnold further for the reasons I have given. The aspect of the DC01 consisting of the flat bottom is simply not within the exception, or, more to the point, there was material upon which the Judge could so find.

35.

Next Mr Arnold criticised [87]:

"[87] A small area between the stops which prevent outward movement of the handle release catch and the top face of the catch. This requires explanation. The catch is sprung so that, unless restrained, it would be pushed away from and off the handle. It has to be restrained. That restraint is provided by a short vertical protuberance at its top which, when the handle is at rest, presses against a matching short vertical downward protuberance at the bottom of the ribs of the handle. When they meet the handle must stop moving. There is a clearance between the latter protuberance and the top face of the catch. This is the clearance referred to. Like the clearance around the spring, it is not an aspect that formed part of Qualtex's pleaded case, and it did not form part of Mr Hulme's evidential case either, though it was referred to in the cross-examination of Mr

Jupp. In the absence of a pleaded or evidential case in respect of this clearance I am not minded to allow Qualtex to rely on the point, but in any event such evidence as Mr Jupp gave on it did not support the case relied on in final submissions and as a result I do not think it qualifies. The cross-examination did not go so far as to establish that this clearance was a particular aspect of the design capable of falling within the section. Accordingly I rule against Qualtex on this particular aspect. However, I suspect that in any event this alleged point is not material since it is accepted by Mr Jupp and Dyson that the stop itself is within the must fit exemption, and to some extent the resulting clearance is an aspect of the stop itself.”

36.

I just do not read the Judge as there saying that clearances cannot fall within the subsection. Indeed his last sentence seems to me to be an implicit acceptance that a clearance which enables the stop to work is capable, in principle of forming excluded matter.

37.

Finally on the “around” point Mr Arnold submitted that the Judge had shown this error in [88] and [89]:

“[88] The forward facing surfaces of the vertical ridges which interact with the vertical splines on the machines, which must be clear of the handle release catch. The body of the machines contain a vertical spline. When the handle is slotted into the body this spline locates itself into a groove formed by the curved back of the handle as it comes round to the front and by a vertical feature (called a ridge in cross-examination of Mr Jupp – it is like a single raised rib standing proud of the surface of the handle). The rearward facing face of this ridge forms one side of the groove. The forward facing surface does not engage with anything. Qualtex say that this surface falls within the must fit provision because it has to be a sufficient distance from the handle release catch to enable the catch to travel the required distance when depressed. This is said to mean that this surface is a feature or aspect which enables the catch to perform its function. I do not consider this submission to be correct because I do not consider this to be the correct analysis. The surface itself is where it is and what it is. It is merely the reverse side of the ridge whose function is to form a side of the groove. It is true that if it were somewhere else (farther towards the catch) it would foul the catch, but this does not mean that the surface is a feature which enables the catch to function, or which enables the ridge to form the groove.

[89] Flat forward-facing surfaces above and behind the locating ridges at the lower end of the handle. The argument of Qualtex on this is the same as in the preceding paragraph – these surfaces must be clear of the release catch when depressed. I reject this argument for the same reason, though the position is even clearer in relation to this “aspect” of the design. This surface is the finishing point of the rear curved section of the handle. It is true that if it came too far forward it would foul the release catch when the latter were depressed, but that does not make this surface a feature which enables the handle to be connected to or placed around or against the catch so that the catch may perform its function. It is simply the way the designer chose to finish the curved surface. It cannot sensibly be treated as an aspect of the design which enables either part to perform its function.”

38.

First as to [88]. The Judge is not saying that to fall within the exception parts have to touch. He is merely saying that if the surface were closer it would foul the catch - that in itself does not mean it "enables" the handle to perform its function. It is merely so positioned that it does not interfere with the function. Any working part must of course be so located so as not to interfere with the working of other parts - that does mean that any spacing between parts is a feature which enables function.

39.

As to [89], the point is the same, but, as the Judge said, clearer.

(2)

Allegedly wrongly construed the exception as not satisfied by a feature which merely makes an article function more effectively or safely.

40.

Apart from the hypothetical of the electrical plug, Mr Arnold's example here was the bleed holes in the upper knob of the DC01 wand handle along with the cutaway portions on the inside tube opposite the bleed holes. The cutaway portions can be seen on p.506 of the RPC. The bleed holes are slots parallel with the ribbing at the bottom of the groove just below the cutaway. Their function is to prevent excessive vacuum if the whole end of the tube is blocked, e.g. where it is directly used without a tool and placed directly onto a surface, such as a stair carpet. It also stops the motor overheating. The cutaway was intended to ensure that there is bleed even if an eye were placed onto the tube.

41.

The Judge said [95(b)]:

"In its final speech Qualtex contended that the bleed holes in the outer wall and the semi-circular cut-outs in the inner wall fell within the exception because both of them enabled the handle to be placed against an object without stopping the airflow and burning out the motor. However, Mr Hulme did not say that these aspects fell within this exception so technically this point is probably not open to Qualtex. However, if it were I would rule against it. The function just described does not fall within the wording of the section. The relevant words of the section would apply must fit to features which "enable [the handle] to be placed against [another solid object] so that [the handle] may perform its function" (no other interpolation of words makes sense). That is not the purpose of the cut-outs and bleed-holes. They are there so that in the event that the handle is placed against another object (which it should not be, and which it is not designed for) then a third object (the motor) is not affected. One cannot read that cause and effect into the section. If the (gory) safety aspect is considered for these purposes, a moment's consideration will demonstrate how "handle" and "eye" cannot be interpolated in any way that makes sense either. Accordingly I rule against Qualtex on this point."

42.

Mr Arnold submitted that the judge overlooked this: that the bleed holes functioned so as to make the wand handle itself function better as a vacuum path when placed against another object. So, he submitted, they enabled the handle to be placed against another article (e.g. a stair carpet) so that the handle could better perform its function to provide a suction path.

43.

I think Mr Arnold is right here. The Judge focussed on the effect on a third object (the motor) but overlooked the function of the wand handle itself. I think the bleed holes fall within the exception: they enable the handle to be placed against a flat surface so as to perform its function as a vacuum cleaner handle.

44.

Mr Carr submitted that this was a point not open to Qualtex (upon which the Judge made no actual ruling). He submitted that if the point had been taken from the outset then Dyson would have introduced further evidence – such as that there are other bleed holes somewhere in the body to relieve excessive vacuum and prevent overheating of the motor. But I am satisfied that the relevant evidential material about the function of the holes was sufficiently before the court – indeed it was volunteered in the evidence of one of the designers, Mr Jones (Statement para. 14(a) and Day 2 pp. 195 and 199).

(c) Allegedly held that the exclusion could not apply where the articles are designed sequentially.

45.

Mr Arnold's illustration of this was based on what the Judge said about the 1992 DC01 Wand handle and its release catch. He said[84]:

“The semi-circular or curved part of the handle which lies underneath the handle release catch. Underneath the release catch there is a wall of the handle which has a curve parallel to the underside of the catch. They do not touch, even when the catch is pressed – there is a small clearance. As will be apparent later on, Mr Jupp accepted that the curved under-surface of the release catch which lies above and roughly parallel to this surface of the handle was a must fit feature of the catch. However, he resisted the notion that logically this made the surface of the handle must fit as well. He pointed out that the surface of the handle did not have to be that shape at all. I do not think that it is necessarily relevant whether the underlying wall had to be that shape. The fact is that it is that shape. However, I think that there is a different reason why the catch is must fit and the handle is not. Looking at the matter realistically I think that while it can be said that the catch is the shape it is to enable the catch to perform its function, I do not think that the evidence allows me to say that the handle is the way it is to enable the catch to perform its function. Accordingly this aspect of the handle is not must fit. The design history of the parts showed that the handle was designed first and the catch was designed later. The handle had its first expression in a design drawing in February 1992 and the catch found its first expression in a drawing in April 1992. While those are formal drawings which do not necessary reflect the precise form of the order of designs, in my view they are likely to do so, thus making the catch must fit but this part of the body of the handle not must fit.”

46.

The semi-circular part of the handle referred to is best seen on p.508 of the RPC. It was called “the saddle portion” before us. The release catch (shown on p.509) goes over it, clipping on to the pivots. If the Judge was saying that sequential design meant the exclusion could not apply, then he was wrong. But I do not think that is what he was saying. He was using the fact of sequential design to illustrate the point he had already made, namely that the saddle portion was not so shaped so as allow the catch

to perform its function. It was so shaped for no particular function at all – but once so shaped, the catch had to be shaped to fit it.

47.

Mr Arnold also challenged this reasoning. He submitted that the saddle and catch were each so shaped so that each could perform their function. He is only partly right. Some parts of the saddle (e.g. the pivot and possibly a portion of the other end which may provide a “stop”) have a function. But a large portion of the saddle performs no function at all. It is true that that portion does not get in the way when the catch is pressed down but, as I said at [38], just not getting in the way is not enough to amount to “enable etc.” So I conclude that those aspects of the parts of the saddle which have no function are outside the exclusion.

(d) Alleged failure to adopt a practical approach to the “must-fit” exclusion

48.

Mr Arnold submitted that the section required a “practical approach”. The submission was a variant of his “finical” submission, that minor matters should be ignored. The trouble with that is that is not what the section says. On the contrary it has gone out of its way to create UDR in any aspect of any part of an article. That is indeed an odd way of going about things but it is what it says. There is no limitation to aspects which have no practical significance. As I have said, the lower limit is where one cannot really say there is an “aspect” at all.

49.

Mr Arnold’s first illustration of his point was the flat bottom of the DC01 Wand handle discussed at [34] above. The flat bottom is clearly discernible. It is an “aspect” of part of the article. That ends the point.

50.

His other example was the 1992 cable winder on the DC01 wand handle, shown on the top left of the picture at p.508 of the RPC. The Judge said:

[125] The semi-circular shape at that part which abuts the boss also falls within the must fit exception. When the winder is rotated downwards, to permit the cable to slide off, this shape lines up with the shape of the upper half of the boss. If it protruded beyond the surface of the boss it would snag the cable and the cable would not be able to slide off so cleanly. I find that this feature of its shape enables the winder to perform its function of releasing the cable when required to do so.

[126] Beyond that there are no features to which the must fit exception applies. Qualtex sought to argue that the sides of the winder fell within the exception because if they were wider they would foul the cable when it was slipped off. Mr Jupp conceded that this was a possibility if it were “much, much fatter”, but I do not consider that that means that this particular design of the winder falls within the exception. The fact that, if designed differently, it would not work is not sufficient. The shape is not one which “enables” the winder to perform its function. The most that can be said is that it does not obstruct it, and that is not enough, in my view.”

51.

This is faultless. It is no good just asserting this is not “practical”. The appearance of the lower portion of the winder is an aspect of part of the article. The Judge was entitled to hold that it is not a feature which enables anything.

52.

Mr Carr introduced the DC03/04 brush bar into the argument. It was to deal with an argument which, so far as I can see, was not really advanced before us by Mr Arnold. The argument was that since it was designed to be an integral part of a complete drive system and without it the system would not work it was a feature which enabled all of the other parts to work. If right all working parts would always be covered by the exclusion. The argument overlooks the word “enable” and clearly proves too much to be right.

s.213(3)(b)(ii) So-called “Must-Match”

53.

The Judge dealt with this subject generally at [51] - [64]. At [64] he said:

“Accordingly, when considering “must match”, I shall apply section 213(3)(b)(ii) by considering whether there is dependency of the kind, or to the extent, which would make the overall article in question (article 2) radically different in appearance if article 1 were not the shape it is. That is not to substitute, or superimpose, a test different from that appearing in the statute. It is to explain how the statute works. This sort of consideration is inevitably one of fact and degree, and of impression. It will doubtless be less than straightforward to apply in relation to various parts or aspects, but that is the nature of the beast. The saleability of the item can be used as a sort of guide to assessment or a cross-check in any particular case.”

54.

Mr Arnold attacked the “radically different in appearance” test. His principal submission was that any feature of the whole article which was externally visible was “dependent” on the appearance of the whole article. The concept of “dependency” is concerned with the relationship between the appearance of the part and the appearance of the whole. He pointed to the fact that a Dyson machine was “a design icon” - the integrity of the design of the whole article, depended on the external shape of each article forming part of that integral design. His submission went so far (as it had to in respect of at least some features) as to cover aspects of parts which, viewed from the point of view of the machine as a whole, were minor (such as the outward portions of the lower hose cuff). The submission also extended to accessories to be added to the end of the wand handle.

55.

This brings one to the elusive concept Parliament intended to convey by the single word “dependent”. Mr Arnold submitted that unless the feature had no dependency of any kind (whether from the point of view of the consumer actually buying the part or from a purely aesthetic point of view, or otherwise) the feature was “dependent” on the appearance of the whole.

56.

He submitted that the language actually used was a draftsman’s re-write of part of the White Paper. Following its discussion of the proposed new UDR it went on to discuss registered designs. It said:

“The Government intends to exclude from registration the design of any article where

a)

it cannot be shown that the aesthetic appearance of the article would be a material factor taken into account in its purchase, acquisition or use; or

b)

the article is an integral or working part of a further article, unless the appearance of the two articles are substantially independent.”

It is tolerably clear that it was contemplated that this exclusion was to also to apply to the new UDR, though oddly this is not exactly spelt out in the discussion of UDR itself. Mr Arnold submitted that the test was whether “the appearances of the two articles are substantially independent” and that the actual must-match provision is merely a re-write of this test. The difficulty with that submission is that one just does not know whether that was intended. Suggestion (a) was not taken up; the “must-fit” exclusion is arguably within (b). The provision as enacted is a different cocktail of the general sorts of consideration involved in (a) and (b) but not the same. There is no “bulls-eye” to go by.

57.

Both sides took us to the authorities. None are binding on us. All but one were not concerned with the meaning of the provision and do not really help, just making passing references to “must-match,” The only case worthy of discussion is Ford’s Design Appn. [1993] RPC 399 (Julian Jeffs QC, sitting as the Registered Designs Appeal Tribunal), [1994] RPC 545 (Divisional Court) – the relevant point was not considered in the House of Lords, [1995] RPC 167). The case concerned the registrability under the Registered Design Act 1949 of design parts for Ford and Fiat vehicles. The Act as it then stood had been amended in 1988 so as to exclude from registration features of shape or configuration defined in the same way as what became s.213(3)(b). Just carrying it over to the new UDR itself was an odd thing to do, for registered designs are for “articles” whilst UDR can subsist in just an aspect of part of a design, but no matter.

58.

Mr Jeffs was faced with applications for registration of a range of parts. He divided them into two groups:

“As I have already mentioned, all the designs are for components of motor vehicles. Such vehicles are assembled from a number of component parts: main body panels, doors, the bonnet lid, the boot lid, the windscreen, and suchlike, all of which form part and contribute to the overall shape and appearance of the vehicle. I shall consider these first and shall refer to them as the first group. Then there are parts which, while in situ are contributing features to the appearance of the vehicle, are subsidiary to its essential shape. These include such items as wing mirrors, wheels, seats and the steering wheel, where substitutions are possible while leaving the general shape and appearance of the vehicle unaffected.”

59.

He then rejected some of the applications on the grounds that they were not really for designs of an “article” within the meaning of the Act. In this he was upheld by the Divisional Court and the House of Lords. It is of no relevance here.

60.

He then considered the “must-match” exclusion. He rejected what he called an “n-1” approach: that you consider the article with the part missing (e.g. a car minus a door) as one “article” and the “part” the other. He said:

“The designer of the door did not intend it to form an integral part of a vehicle with the door missing. From its first conception, the door was intended to form an integral part of a complete vehicle.”

His approach was approved by the Divisional Court

“... to consider the other article minus the part in issue is not what the statute requires,” per McCowan LJ at p.554.

The parties were agreed that was right. No attempt was made to resuscitate the n-1 approach before us.

61.

So at least this much was common ground: that one must ask whether there is a feature of shape of the part which is dependent on the appearance of the whole machine. In his case Mr Jeffs applied that test to his two groups of parts. As regards body panels he held there was dependence. As regards accessories (wheels, steering wheels, wing mirrors) he held there was no dependence and the applications could proceed further. He said:

“I come now to the second group of components, such items as wing mirrors, wheels, seats and the steering wheel. All of them are visible on the car as sold but substitutions can be made without radically affecting the appearance or identity of the vehicle. It is such standard practice that I can take judicial notice of the fact that alternatives may be offered for items such as these and an owner may choose to substitute proprietary items in order to give his vehicle a sportier appearance, or (where a seat is concerned) greater comfort, or for a variety of other reasons. Although if any substitution is made the owner may wish it to blend in the general style of the vehicle, I am of the view that such items are no “dependent upon the appearance of another article.”

62.

Mr Jeffs was upheld by the Divisional Court. McCowan LJ said:

“As to design freedom, Mr Silverleaf says that the question is whether the manufacturer of the spare part has design freedom. If he has, then he is a candidate for registration. If he has not, then he is not such a candidate. The design freedom in the latter instance is in the original designer of the car. So, with a particular spoiler which figured a fair amount in the argument, the maker of that spare part will have to produce one that looks exactly like the original, or it is unsaleable. He has no design freedom. I accept that argument”

63.

Mr Carr’s argument was largely based on this approach: he said that unless as a practical matter a spare part had to be shaped so as to make the whole article look as new, there was no dependency. The judge’s “radically different in appearance” test is much the same as Mr Jeffs’ “substitutions can be made without radically affecting the appearance or identity of the vehicle” test. It is another way of

looking at dependency. If there is, as a practical matter, design freedom for the part, then there is no dependency.

64.

I accept this latter proposition. One has to approach the provision bearing in mind that Parliament did not intend to exclude all spare parts, or even all externally visible portions of spare parts, yet such was the substance of Mr Arnold's submission. "Dependency" must be viewed practically. In some cases the answer is obvious - the paradigm example being body parts of cars. In others it may be necessary to examine the position more carefully. But unless the spare parts dealer can show that as a practical matter there is a real need to copy a feature of shape or configuration because of some design consideration of the whole article, he is not within the exclusion. It is not enough to assert that the public "prefers" an exact copy for it will always do so for the reason I gave in [2] above. The more there is design freedom the less is there room for the exclusion. In the end it is a question of degree - the sort of thing where a judge is called upon to make a value judgment. Unless wrong in principle, his evaluation will not be interfered with on appeal.

65.

Turning to the facts here, Mr Carr showed us a black spare wand handle which fitted a DC02 machine and had been sold, successfully, by Qualtex prior to the part now complained of. The Dyson handle is shown on p.518 of the RPC. That complained of is virtually identical. But the prior one was visually different - it had a different suction release, no ribbing and so on. So far as one can tell from the sales figures, it went about as well as the later replica, though one cannot be entirely certain for other factors clearly enter the equation (the earlier one was cheaper, one does not know the overall level of demand, whether there were hiccups in supply by Dyson and so on). Certainly commercial dependence was not established for this item, and commercial dependence is likely to be in part a reflection of design dependence, as the Judge recognised.

66.

Mr Arnold illustrated his argument mainly based on the DC01 Wand handle. This had 3 Dyson versions, 1992, 1995 and 1997. The differences between the 1995 and 1997 versions are immaterial for the present discussion (they concern a redesign of the means of fixing the cable winder). The photographs at pp. 505 to 509 of the RPC could be of either version since one cannot see the detail of the winder. The 1995 version was similar to the 1992 save that the central portion was redesigned so as to accommodate within the plastic a longer length of the aluminium tube. The redesign involved moving the cable winder nearer the top and lengthening the unribbed portion so as to extend it above the catch. Qualtex copied the 1997 version.

67.

As regards the design of the whole, Mr Arnold attacked [79]-[80] of the Judgment:

"[79] Qualtex's first case was that this handle overall made an important contribution to the overall shape and appearance of the DC01 and was therefore in the same position as the car body panels in the Ford case. I was invited to come to this conclusion by simply finding it obvious on looking at the machine, and from the evidence of some of the Dyson designers who are said to have admitted that the handle was a key part of the design of the machine. There was no evidence that anyone had ever marketed a non-replica spare handle, and it was said to be highly improbable that there would be any market for such a wand handle even at a reduced price. For its part, Dyson maintained that there was considerable design freedom in relation to this handle - design freedom extended to

practically every part of the handle, as was demonstrated in part by the fact that later handles on later machines had, for example, different rib spacing and profiles. Mr Jupp produced drawings which he said demonstrated the different sort of approaches a designer might take to some of those aspects and which would not copy Dyson's designs.

[80] To my mind and eye the must-match provision does not apply to this part. Changing one or more or all of the design features of this handle would not necessarily make the whole machine (including the handle) look "radically different" within the guidance that appears from the cases. I do not think that this part is like the door panels in Ford. It is of course true that one could make the handle so different that the overall appearance of the machine would be radically different, but that is not necessarily the case. One could alter the detail of the bulge at the top, or not have a bulge at all, or have different ribbing details lower down the handle, or have different (or no) grooves on the underside where the hand naturally rests, without radically changing the overall appearance of the overall machine within the meaning of that phrase. But it does not follow that any change would make the handle radically different. So far as one can make a cross-check by inquiring what sort of a market there is or would be for a non-replica handle, while it is true that there was no evidence of any such market, there is no evidence that there would not be one. In the absence of solid and reasoned evidence (which in the circumstances would have had to have been opinion evidence) I do not think it is possible to say that no-one would buy a non-replica handle, and I would be a little sceptical of assertions to that effect. It is conceivable they might, if there were a price differential which made it worthwhile. As I have said, I do not think the handle is like a car body part. Cars have a certain public display element to them. They are seen in public, and customer choice is likely to be affected, at least in part, by the design and the customer's willingness to be associated with the design by driving in it or having it parked in his driveway. The same cannot be said of vacuum cleaners. A Dyson vacuum cleaner may well be purchased at least in part because of its design, but I would require some evidence were it to be said that the design preference of the customer for this piece of household utilitarianism would lead the customer to require it to keep its looks after a repair in the same way as a car is required to keep its looks. This is, I accept, somewhat speculative in the absence of solid evidence, but it is plausible and I certainly cannot find that that is wrong and Qualtex has not discharged its burden of showing it is right."

68.

The Judge's error here was said to be to apply the "radically different" test which had first appeared in Mr Jeffs' formulation. As I have said I think that is essentially the right test. As I sat writing this judgment with a DC01 before me I asked myself how much does the design of the wand handle really matter to the overall design? Would it matter, for instance, if there were a ribless handle? The more I looked the less I thought it mattered. From the point of view of a consumer, I doubt, as did the judge, whether he/she would care whether his/her Dyson cleaner, if repaired with a ribless wand handle, looked a bit different from as new. There was no evidence of any such concern by a consumer. Such inference as one could get from the sales of the DC02 wand handles suggest otherwise (see above). This is just the sort of area where the Judge has made a value judgment, here as to dependency, upon which a court of appeal should not interfere unless there is an error of principle.

69.

That is really all that need be said as regards the “must match” exclusion but I must deal briefly with Mr Arnold’s other examples. The first was the main ribbing of the 1992 Wand Handle considered as an aspect of the design of part of the article. He attacked [81(a)]:

“In his report Mr Hulme said that these areas of ribbing match the ribbing on the handle release catch and an area of the machine under the cyclone. One of Dyson’s witnesses (Mr Jones) agreed that there was a visual link with the latter, and Mr Jupp agreed that the ribs matched with the former, though he added they did not have to. In some senses it can be seen there is a match. The thickness, spacing and profile of the ribs on the lower part of the handle are the same as on the handle release catch. But that is not the point. This sort of approach demonstrates that dangers of using words that are not in the section. The section does not refer to a “match”. It refers to a dependency, of which a match may be a part but not the whole. In my view the dependency is not made out. If you are going to have ribs on the front of the handle above the release catch, then harmonious design might mean that those ribs would have the same pitch, spacing and profile as those on the handle, but the presence of ribs on the catch does not dictate a design requirement of ribs on the front of the handle above it so as to make the design of that area dependent on the catch. Furthermore, the design dependency required by the section does not require the ribs to be continued round the back to any extent. I do not consider that these lower ribs on the handle fall within the must match provision on that line of reasoning. A “match” with ribbing anywhere else on the machine does not suffice either, but for the record I should say that I do not think that there is a visual match with other ribs anyway, save insofar as they are both ribs. So far as the existence of a visual link is concerned, again the concept by itself is not particularly helpful. The existence of a visual link may be an element of the design dependency required by the section, but it is not sufficient, and it takes the debate no further to say that there is one. As Laddie J said in *Ultraframe* at para 79:

“In my view the fact that [certain features] help in achieving a “consistent theme”, as Mr Wyand puts it, does not mean that these particular features are “dependent upon the appearance of another article” as required by s.213(3)(b)(ii).”

70.

This was said to be wrong because the Judge used the word “dictated” as well as because he had applied the wrong test generally. I can see no such error – in context he was looking for a dependency and a finding of no dictation of the design of one part by the design of another goes a long way to ruling one out. It is an aspect of design freedom.

71.

Mr Arnold also complained the Judge had in effect misquoted Laddie J out of context by omitting the next sentence which reads:

“The fact that the feature is of little visual impact means that it is less likely to be dependent on similar features on other articles and vice versa”

Whilst that is true (and applies here to some of the aspects of design of parts of the articles relied upon) I do not see that it makes any difference to what he was saying in the sentence before. It too is right and applies here.

72.

Mr Arnold briefly also attacked the conclusion at [81(b)] about the ribbing on the bulge at the top of the DC01 handle. The Judge dealt with it fairly peremptorily:

“Turning to the ribbing in the bulge at the top of the handle, other than to identify it as ribbing, there is, in my view, little in common with ribbing elsewhere. Again, the dependency required by the section has not been made out, and merely to identify a match (which on the facts is misplaced) does not take one very far. I find that this ribbing is not excluded by must match.”

I think the Judge was right to deal with this point so shortly. Without the ribbing the overall appearance of the DC01 would be virtually unchanged. It is not possible to challenge the Judge’s finding of no dependency for there is no error of principle. The same goes for the ribbing on the tool adaptor.

s.213(3)(c) Surface decoration

73.

Here it is said that the Judge wrongly construed surface decoration as limited to decorating a surface that is already there. Mr Arnold began by asserting that the exclusion necessarily encompassed, indeed only encompassed, three-dimensional surface decoration. He reasoned thus: UDR is only created in an aspect of the shape or configuration of the whole or part of an article. So it only subsists in 3D shapes. So the exclusion must be dealing with 3D shapes only.

74.

I do not accept that argument for two reasons. First you can have 2D features of shape or configuration, e.g. one produced by cutting one out from a piece of paper. Second, exclusion (a) (to a method or principle of construction) is an exclusion which is probably not necessary – a method or principle of construction can hardly be a mere feature of shape or configuration. Mr Arnold’s implied premise that the exclusion does not extend beyond the definition of the right is false – an exclusion can go further than is necessary and clearly does so in the case of (a).

75.

Next it seems clear that the exclusion will cover what are essentially 2D designs on a 3D article. A willow-pattern plate, or a painted vase, have what can fairly be described as 2D decoration on a 3D article – and the painting is merely “surface” even though it has a 3D nature. And you can also clearly have a surface decoration of just a flat part of a 3D article.

76.

It is also clear that the exclusion of surface decoration is related to its inclusion as the subject of “ordinary” copyright. Paraphrasing and simplifying, s.51 excludes from the ambit of ordinary copyright protection, a design document for making an article to that design or copying such an article, unless the design is for an artistic work. For the purposes of the provision “design” is defined. The definition is:

“‘design’ means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part an article, other than surface decoration.”

So, broadly, surface decoration will not be excluded from ordinary copyright protection but correspondingly is excluded from UDR. There are exceptional cases where what is sought to be

protected may fall between the two (see *Lambretta v Teddy Smith* [2005] RPC 6 where the shape of the article was unoriginal and so not within UDR and the colourways had no independent notional existence from the article and were not surface decoration), but they will be rare.

77.

First then, did the Judge actually say that surface decoration is limited to decorating a surface that is already there? After examining the cases (*Mark Wilkinson v Woodcraft* [1998] FSR 63, *Jonathan Parker J, Fulton v Grant Barnett*, [2001] RPC 16, *Park J* and *Hi-Tech Autoparts v Towergate Two* [2002] FSR 16, *Christopher Floyd QC*) he said [38]:

“Accordingly, when I come to consider the parts to which this exemption is said to apply, I shall consider them on the following basis:

There is a useful distinction between surface decoration on the one hand and the overall shape and configuration of the product on the other.

That distinction may be clear in some cases, but overall it may well be a matter of fact and impression, or a value judgment.

A subsidiary functional purpose does not take the design aspect out of this exemption if the primary purpose is surface decoration. However, the additional purpose has to be subsidiary. This means that I consider that it is likely that this qualification is unlikely to apply in many cases. If an item of decoration has a functional purpose, then it seems to me that it is going to be difficult to say that that functional purpose is sufficiently subsidiary to make the feature surface decoration (or “mere” surface decoration, to use the qualification applied by *Park J* and *Mr Recorder Floyd QC*). In truth, I think that the subsidiary purpose of beading that is used to conceal a joint can also fairly be described as decorative.

I can take into account the expressed intention of the designer. *Jonathan Parker J* obviously did that. This is not determinative, but it is useful material, particularly in relation to functionality.

78.

There is nothing express there about limiting “surface decoration” to a surface that is already there. *Mr Arnold* said the error came in para. [97] where the judge considered the 1992 wand handle (for this purpose the wand handle shown in the RPC will serve as well to understand the point):

“**The lower ribbing area.** The first area of the ribbing is the pronounced and obvious area starting just above the cable winder boss and running down to the handle release catch. The evidence of *Mr Jupp* was that this was there to hide the change in diameter of the two main parts of the wand handle that occurs in that general area. *Mr Jones*, the designer, said that their purpose was to create something of an optical illusion - to make the handle appear more substantial there than it in fact was. There is a slanted rib running at right angles to the horizontal ribs at the front of the handle and parallel to their top surface. This rib was, according to *Mr Jones*, to give the impression of a stronger handle. *Mr Arnold* submitted that all these features demonstrated that the

ribbing was surface decoration (though the vertical rib was not pleaded, nor did it appear in Mr Hulme's evidence). I disagree. I think they demonstrate precisely the opposite. The ribbing is carefully designed to convey a shape, defined by that ribbing; it does not merely decorate a surface which is already there. It goes far beyond that. Even Mr Hulme accepted that without the ribbing the shape of the handle would be completely different. I find that this ribbing is not surface decoration."

79.

So the context in which the judge said that the ribbing "does not merely decorate a surface which is already there" was by way of contrast to his finding that it was "carefully designed to convey a shape." I can see no fault with this. The ordinary reasonable consumer or designer would not think, when looking at this, that they were looking at a decorated surface. I do not see why design law should see things differently: that law already sometimes seems to be a particularly abstruse branch of metaphysics. There is no need to make things worse by finding things to be surface decoration which would not ordinarily be so perceived.

80.

Is it in any event wrong to ask whether what is alleged to be surface decoration and so excluded is limited to the decoration of a surface which is already there? That actually depends on what you mean. If you mean limited to a subsequent decoration of a previously undecorated surface (e.g. painting a vase) then it would be wrong: there is no reason why the "decoration" should not come into existence with the surface. But if you mean that notionally the article can readily be perceived as one with a surface provided with a decoration, then I can see nothing wrong.

81.

What the Judge did not do, which I think is perhaps implicit in Mr Arnold's argument, is to hold that a "surface decoration" cannot be 3D at all. Jonathan Parker J in *Mark Wilkinson* held otherwise, holding that some beading and grooves on kitchen units were surface decoration. That makes perfect sense in context. It does not follow that anything provided on a surface amounts to surface decoration - it is, as the judge observed, a question of degree. At times Mr Arnold's argument was close to suggesting that anything provided for some sort of non-functional eye appeal - anything "decorative" - was enough. But the words used are "surface decoration". "Surface" limits the exclusion to that which can fairly be described as a decorated surface. Such a reading accords with the general policy of putting that which is surface decoration into the arena of general copyright rather than design right.

82.

The other point raised by Mr Arnold was the question of surface features which have a function. Does the exclusion not apply if they do? Mr Floyd QC in *Hi Tech Autoparts* (a case about anti-slip rubber mats provided with a slightly raised pattern) held that the features there were not "merely decorative features which have an incidental functional effect". And:

" the dominant consideration was the functional performance [of the alleged surface decoration]. Moreover the question here is not whether the design is aesthetic but whether it is merely surface decoration."

83.

The old debate about function and aesthetics ("form follows function") shows signs of resurfacing here. It would be a mistake to go into more metaphysics to reach the answer. That lies in the policy of according ordinary copyright to surface decoration and UDR to original designs, irrespective of

whether they are functional or not. The functional is to go into the UDR box. For that reason I would not include surface features which have significant function as “surface decoration”. Trivial additional function may not matter – for instance the function of covering cracks as in the case of the beading considered in *Mark Wilkinson* (if indeed you regard that as function at all, which, like the Judge, I doubt – covering visible cracks for appearance reasons is hardly functional).

84.

Mr Arnold’s examples here were the 1992 DC01 Wand handle ribbing on the top bulge (p. 506 of the RPC shows that of the identical portion in this respect of the 1997 version) and the ribbing on the tool adaptor (p. 524 RPC). The Judge held this ribbing to have the function of providing a grip – a finding of fact for which there was ample material. He held that accordingly the ribs were not “surface decoration.” He was right to do so.

Originality

85.

It was common ground that to be “original” a design does not have to be novel in the sense used by patent law – absolute novelty is not the test. The test is as set out by Mummery LJ in *Farmers Build v Carrier* [1999] RPC 461 at p.482:

“(2) The court must be satisfied that the design for which protection is claimed has not simply been copied (e.g. like a photocopy) from the design of an earlier article. It must not forget that, in the field of designs of functional articles, one design may be very similar to or even identical with another design and yet not be a copy: it may be an original and independent shape and configuration coincidentally the same or similar. If, however, the court is satisfied that it has been slavishly copied from an earlier design, it is not an “original” design in the “copyright sense”

86.

Mr Arnold took us to *Interlego v Tyco* [1989] AC 217 to develop the point he wished to make about originality – namely that where a later work was “derived from” an earlier, it was not original. In *Lego* the question was whether 1976 engineering drawings were “original”, given that they were produced by a re-drawing process equivalent to photocopying or tracing a 1968 drawing and making some alterations. Lord Oliver spells the differences out as well as can be done in words but to see the actual drawings makes it all more vivid. For that reason we asked counsel to find copies of the drawings, which had been annexed to and form part of the printed case to the Privy Council. As soon as you see the two drawings you see they are of the same thing, not surprisingly for they are both for the same article, a Lego brick with 4x2 studs on the top. The differences, such as they are, are nearly all in what is written on the drawing. There is one very minor visual difference in that the 1968 brick had a small portion on the top of the inside which was to allow flow of plastic – the so-called “flow rib”. You have to look hard to find it.

87.

It was in this context that Lord Oliver said (p.256):

“Essentially artistic copyright is concerned with visual image. This is of particular importance in the instant case, which has the unusual feature that the artistic copyright claimed stems in origin from drawings which are themselves out of copyright and therefore available for copying. The post-1972 drawings do demonstrate some very

minor visual deviations from the original pre-1973 drawings from which they are derived, but they are visually insignificant, with the possible exception of the omission of the radii on the outer diameters of the tubes.”

Mr Arnold submitted that is exactly what is going on here in the case of some of the design rights relied upon.

88.

Lord Oliver later said (p.258):

“The significant thing about all these changes is that they involve no substantial alteration to the drawing as such. The outline of the object depicted is, in each case, virtually identical save for the minute differences occasioned by the abandonment of the flow-rib, the depicting of radii on the edges of the knobs and the abandonment of the radius on the outer diameter of the tubes. The significant changes, however important technically, are not indicated by any substantial alteration of the drawing as an artistic work. That remains basically the same and was admittedly copied from the 1968 drawing in the same way as if it had been actually traced. The changes are indicated not by altering the drawing but by substituting for the figures shown on the original for the purpose of indicating dimensions and tolerances new figures which will constitute manufacturing instructions for those who will design the moulds from which the finished articles will be produced. It may be and no doubt is the case that that information involves important functional concepts, and even a good deal of technical research, but Mr Jacob stresses that what this case is concerned with is not an idea or a concept but artistic copyright claimed in the drawings. Nobody draws a tolerance nor can it be reproduced three-dimensionally. What is important about a drawing is what is visually significant and the re-drawing of an existing drawing with a few minimal visual alterations does not make it an original artistic work, however, much labour and skill may have gone into the process of reproduction or however important the technical significance of the verbal information that may be included in the same document by way of information or instruction.”

Again Mr Arnold said that applied here.

89.

What the Judge said in relation to Mr Arnold’s originality argument was ([34]):

“In *Interlego* the position was that the later drawings started life as, in effect, copies of the earlier drawings. There was an act of copying of the same nature as tracing, or, in the terminology of the Court of Appeal in *Farmers Build*, photocopying. To that were added some very minor changes. Where that is the situation, one can apply the “visually significant” terminology of Lord Oliver, and the test sought to be applied by Mr Arnold, in order to decide whether the second work is original. However, it is important to appreciate that the starting point in that case is an act of copying. Where that is found to be the starting point in relation to any of the parts in the present case, the test can then be applied. However, where copying is *not* the starting point, the test is unhelpful. Where all that the evidence shows is that design B was “based on” or “derived from” design A, copying in the “tracing” or “photocopying” sense is not necessarily made out. Of course,

if there are no visually significant differences, then that may support an inference of copying, and therefore lead to a finding of unoriginality, but that is using the test for a different purpose. It is important to bear in mind the purpose for which the test is being deployed and I do not think that Mr Arnold's utilisation of it does so."

90.

I think this is an entirely correct approach. One article, particularly a simple article (even of a thing as simple as a washer) may look like another and yet be original (see *British Northrop* where the point related to drawings for simple things such as a washer). The question is whether the author was using his own skill to create the design or was in substance merely copying.

91.

Mr Arnold suggested that his best example of non-originality was the cable winder on the 1997 DC01 wand handle. Attention was focussed on the outside rotatable tab, the remaining aspect being excluded as "must-fit." The winder had been redesigned in 1995 when it was located further up. And its method of fixing changed in 1997, with a consequent change in that portion of the winder. The 1997 change meant a larger stud on which it rotated - which in turn meant a greater width and diameter of the hemi-circle at the stud. However the length and shape of the tab in other places left design freedom. What was chosen was something which looks a lot like the 1992 tab, though larger and not in exactly the same proportions. The Judge dealt with the tab in this way [139]:

"Originality. This time there is no admission of copying of any form. In fact, the widening of the tab was not mentioned by the designer, Mr Thomson, who gave evidence. The point emerged in his cross-examination. It was not put to him that he had merely copied the 1992/1995 tab, and he did not say that he had. In the circumstances there is no direct evidence of copying in the relevant sense. I am not prepared to draw an inference of copying. Accordingly, this time the tab design is original for the purposes of unregistered design right."

92.

Mr Arnold complained that this was not right, that Mr Thompson had as good as admitted that he had copied the 1992 tab. For this we were taken to the cross-examination at Day 4 p.482. I do not propose to set it out here - I have read and re-read it. The questions were essentially focussing on the differences between the two versions. I do not think it fair to say that it was put that he had actually started with the earlier, made a slavish imitation by copying, and then made minor modifications. Actually I doubt that a designer would go about it that way, though there is no evidence about it. It is not like Lego where the drawing was intended to be for essentially the same item - the Lego brick. I am not satisfied the Judge was wrong.

93.

Mr Arnold's other example of non-originality on the Lego point was the tool adaptor. The ribbing of this was said to be non-original as being a copy of the ribbing on the bulge at the top of the wand handle. The Judge dealt with it at [187]. The two lots of ribs have similarities but are not the same. It was not put that the designer had merely started with the bulge design, copied that, and made trivial, non-visual alterations. And he obviously did not do that. There was ample material for the Judge to make his finding of originality.

94.

Mr Arnold also ran a general point: that the Judge had considered originality of the whole design of the article, and, having found that, gone on to assume originality in each and every aspect. The Judge did indeed consider originality of the whole, but when he came to consider individual aspects, e.g. the tab on the winder or the ribbing on the tool adaptor, he clearly also did so in relation to that aspect. Technically of course originality should be considered in relation to each and every aspect of a design in suit. But I see no reason why a judge should not take a short cut by considering whether the design of the whole of an article was original first. Then, unless there is a special point about a particular aspect, each and every aspect will be original too. Mr Arnold's complaint here simply runs into the sand: there is no specific aspect relied upon by Dyson which, notwithstanding the originality of the design as a whole, is, considered on its own, unoriginal.

95.

I turn to Mr Arnold's final point on originality. It is best illustrated by his example, which, unless I am mistaken, is his only example. The 1992 wand handle had a winder which was simply copied from an earlier machine called the Fantom. No attempt was made to claim design right in it as such. What was claimed was UDR in the whole handle, including the winder. The judge accepted that this was original, saying [130]:

“ . The fact that the cable winder was copied from the Fantom means that ~~that article~~ is not original for the purposes of design right. I do not think that that deprives the combination of originality. In Ultraframe counsel for the defendant is recorded (at para 71) as not disputing that a combination of features that are commonplace could still be the subject of design right, and Laddie J did not question that concession. I would respectfully agree. Commonplace goes to originality – see section 213(4) – and in my view the same goes for items which are not original because they are copied; that is to say, design right can exist in a combination of features some of which (or even all of which) are copies when taken separately. Reverting to the present case, therefore, the fact that the cable winder is a copy does not prevent design right from arising in the whole of the handle assembly of which it forms part, provided the overall design is original (which, in my view, it is).”

96.

I think the Judge fell into error here. I quite accept that there may be a new original design right by creating a combination of old designs. At that point the judge made no error. However he did not really consider whether an original design was created by adding the old winder to the rest of the handle. I do not regard the last bit in brackets as making such a finding – or, if it was, it was done without an adequate basis. Just adding an old thing on to something else, even if that is new, is not enough to create an original new design. Here, the decision to add the old winder to the new handle was not one involving originality in the copyright sense. Borrowing from the language of patents, what was done was to create a mere collocation. So that part of the aspect of the design of the whole handle consisting of the old cable winder must be disregarded. I do not think it makes any difference to the overall result.

97.

One other example of originality which was raised (initially by Mr Carr) was on the DC07 stair tool. He raised it to show how dangerous arguments based on the word “derived” can be. For it can be said that the DC07 tool is “derived” from the earlier DC03 tool. If they are compared some parts are seen to be identical, e.g. the shape of the footprint, the pipe portion and some of the ribbing. But others are

clearly not. There has been considerable re-design of these. Those new aspects of the DC07 must clearly be original. The fact that some of the design is old and “derived” makes no difference. True it is that old, unchanged, aspects are not original. So there is no UDR in these aspects of the DC07 tool. That does not assist Qualtex – for it copied the DC07, taking the new aspects of that. In any event, as I understand, they are also accused of infringing the UDR in the DC03 tool – and they have taken the new aspects of that too.

Commonplace

98.

Here it makes sense to commence with the examples specifically discussed in argument. “Commonplace” is a far from easy concept and there is a danger in discussing it divorced from specific examples.

99.

Mr Arnold accepted that if he failed to knock-out the design of the whole 1992 DC01 wand handle as being “must-match” and failed to knock-out the main features of the handle (e.g. the ribbing) for one reason or another, as I have held he has, his “commonplace” argument does not arise on it. What he was going to advance here, is that, stripped of all those design features, all you really had was a 135^o angled tube which was virtually standard for all vacuum cleaners at the time and so commonplace, whatever the limits of this near-impossible concept are. Given the premise the argument seems right, but the premise has failed.

100.

Next Mr Arnold submitted that the 1995 wand handle (which is the same as the 1997 wand handle, save for the minor redesign of the cable winder) should be regarded as “commonplace,” given the widespread knowledge, by 1995, of the 1992 wand handle. The design of the latter was, he submitted, “commonplace” by 1995.

101.

This raises several points. The first of these is whether a design which is well known but emanates from a single manufacturer can be “commonplace”. In *Farmers Build Mummery LJ* said at p.482:

“(3) If the court is satisfied that the design has not been copied from an earlier design, then it is “original” in the “copyright sense”. The court then has to decide whether it is “commonplace”. For that purpose it is necessary to ascertain how similar that design is to the design of similar articles in the same field of design made by persons other than the parties or persons unconnected with the parties. [The Judge interposed to say that “unconnected” should probably read “connected”.]

(4) This comparative exercise must be conducted objectively and in the light of the evidence, including evidence from experts in the relevant field pointing out the similarities and the differences, and explaining the significance of them. In the end, however, it is for the court and not for the witnesses, expert or otherwise, to decide whether the design is commonplace. That judgment is one of fact and degree according to the evidence in each particular case. No amount of guidance given in this or in any other judgment can provide the court with the answer to the particular case. The closer the similarity of the various designs to each other, the more likely it is that the designs are commonplace, especially if there is no causal link, such as copying, which accounts for the resemblance of the compared designs. If a number of designers working independently of one another in the same field produce very similar designs by coincidence the most likely explanation of the similarities is that there is only one way of designing that article. In those circumstances the design in question can fairly and

reasonably described as “commonplace”. It would be a good reason for withholding the exclusive right to prevent the copying in the case of a design that, whether it has been copied or not, is bound to be substantially similar to other designs in the same field.

(5) If, however, there are aspects of the plaintiff’s design of the article which are not to be found in any other design in the field in question, and those aspects are found in the defendant’s design, the court would be entitled to conclude that the design in question was not “commonplace” and that there was good reason for treating it as protected from misappropriation during the limited period laid down in the 1988 Act. That would be so, even though the design in question would not begin to satisfy any requirement of novelty in the registered designs legislation.”

102.

Mummery LJ’s suggestion that it is necessary that there must be similar designs by persons unconnected with the parties before a design can be “commonplace” has been challenged by the authors of Laddie Prescott and Vitoria, see para. 53.25 of the 3rd edn. (2000). In the previous edition (para.40.13) they had expressed the view that well-known designs (e.g. the Eiffel Tower or the Statue of Liberty) should be treated as commonplace because they are well-known. The basis of their reasoning was that: “It should not be open to one trader to obtain a monopoly in the use of well-known design concepts”.

103.

A rather different view of the meaning of “commonplace” was expressed by Laddie J in *Ocular Sciences v Aspect Vision* [1997] RPC 289 at p.429. He noted the origin of the word was from Directive No. 87/54/EC of 16 December 1986 on the legal protection of topographies of semiconductor products. In that context he pointed out if:

“any new combination of well-known features was intended to be the subject of a monopoly, all semiconductor topographies would be protected and the commonplace exclusion would be no exclusion at all”

He went on to suggest that:

“ the flavour of the word is any design which is “trite, trivial, common-or-garden, hackneyed or the type which would excite no peculiar attention in those in the relevant art”

This would not necessarily exclude a well-known prior art design from being commonplace just because it emanated from a single manufacturer.

104.

In *Lambretta v Teddy Smith* [\[2004\] EWCA \(Civ\) 886](#), [2005] RPC 88 at [56] I said that:

“what really matters is what prior designs the experts are able to identify and how much those designs are shown to be current in the thinking of designers in the field at the time of creation of the designs.”

105.

I am not sure that these differences of opinion have any significance. For it is difficult to think of an example where it matters. It is important here to focus on exactly the context in which the question

“commonplace or not” arises. That context is this: a particular aspect of the shape or configuration of an article or part of an article has been identified and has been found “original” in the copyright sense. One then asks whether that aspect is “commonplace.” Clearly there will be cases where the answer is “yes” – for instance every aspect of the washers whose design drawings were held “original” in British Northrop. To that extent at least the criticism of Farmers Build in Laddie et al. para. 53.25, namely it can be read as “giving the commonplace exclusion a vanishingly small scope” must be an error. If all you have done is a design of a common object, you have merely made your own design of that which is commonplace.

106.

But consider the case where the designer started with something old, very well-known but unique to a particular manufacturer. Laddie et al. postulate the Eiffel tower. Perhaps a Coca-Cola bottle would be a better example for, unlike the tower, it is ubiquitous. If a man just copies it, his work will not be “original”. So there is no need for the commonplace exception there. If he copies it but makes visual variants which can properly be called “aspects of part of his design” then those variants will get UDR unless they themselves are either not original or are commonplace. But that is unlikely. The example shows that what one is focussing on is the ultimate “design”: whether the designer started with some well-known prior art or not. Only if the designer makes an “original” (because not copied) design of a bottle which happens to be the same as that of the Coca-Cola bottle does the problem arise of whether that design is to be regarded as commonplace. But that is improbable.

107.

I turn back to this case. The Judge dealt with the point at [136]

“Qualtex ran a new argument on commonplace. It said that by 1995 the DC01 handle had become one with which any vacuum-cleaner designer would be familiar. The 1995 variations were trite. Accordingly, it was said, all external aspects of the 1995 handle were commonplace. This argument is false because it confuses familiarity with a design without more with commonplace. It may well be that designers were familiar with the handle by 1995. However, that does not make it commonplace. As a design it still appeared only on Dyson vacuum cleaners and it was not, and had not become, hackneyed, run of the mill or any of the other attempted synonyms for “commonplace”. The 1992 handle had been on the market for 2 to 3 years by this time, and it is common ground that it was a striking design. To move from striking to commonplace, merely by virtue of the familiarity of designers with the striking design and its success in the market place, would have been quite remarkable. It would introduce yet another paradox – a very good design which, by reason of its great design merit, becomes very well known, would lose design right because it has become commonplace. Such a line of reasoning would run completely counter to the intention of creating design right. I find that there is no question of this having happened. I note that in Farmers Build at page 481 Mummery LJ expressed serious misgivings about a suggestion in a text book that the Eiffel Tower had become a commonplace design. I think that I can safely conclude that the learned Lord Justice would have had even more difficulty with the suggestion that Dyson had made its own design commonplace in the manner suggested by Qualtex.”

108.

I think he fell into error here. His supposed paradox cannot arise. There can be no question of a very good design which becomes very well known losing design right by reason of becoming well-known.

Ex hypothesi at the time of its creation such a design would not be commonplace on any view. What happens thereafter could not affect the subsistence of the right. What would be “lost” would be a protection by way of any further design right in an aspect of a variant of the original design which was only different from the original in a commonplace manner.

109.

Given the Judge’s error, I must consider afresh the question of the 1995 wand handle. I will assume that the 1992 handle was indeed well-known by 1995. The differences are significant. A quick comparison of the two articles is enough to show that the redesign exercise was no trivial operation – there is nothing trite about it. The new aspects of the 1995 handle cannot remotely be said to be commonplace as of that date.

110.

Mr Arnold’s other example was the DC07 stair tool. I have discussed this under the head of originality already. That was in relation to the prior DC03 stair tool. The “new” aspects are original. I am quite unable to see why they should be regarded as commonplace. Mr Arnold’s approach was to say that all aspects of the DC07 which were not original, or which were must-fit, or were otherwise excluded should be stripped out and that what was left was essentially some sort of basic stair tool shape – a sort of Platonic ideal stair tool – and that given the range of such tools on the market, that generic shape was commonplace. The argument fails on the facts, for there is little to be “stripped out”, particularly of the detailed DC07 internal design. If the aspect of the DC07 relied upon was no more than a general shape of stair tool, then his argument would have a point. But that is not so.

Treatment of the Defendants’ Case

111.

Mr Arnold makes a general point that the Judge “held that the Defendant was precluded from advancing a number of contentions on the individual aspects because those contentions were not contained in the expert reports of its expert witness”. I can deal with this briefly. First it is clear that in some cases the Judge did allow a point to be taken which had not really been taken in advance of trial. Mr Carr showed us an example at [155] about a part called the soleplate. In other cases the Judge did not allow the point in. In yet further cases he said if he had allowed the point in it would have made no difference.

112.

I cannot see that any of these points amounts to a wrongful failure of the very wide discretion which a trial judge has to allow or refuse late amendments (which is in effect what these points were). He had more than enough points which had been properly raised. It was not the case that any of the new points were “killer” points, knocking out the whole case on a particular part. I think there is nothing in this argument.

Infringement

113.

This was not a main plank of Mr Arnold’s appeal, arising only if he succeeded in knocking out many of the designs relied upon. He suggested that the Judge had fallen into error by, in some cases, comparing each side’s whole parts whereas the test for infringement is essentially to compare the design relied upon (the relevant “aspect”) with the alleged infringement. He is right as a matter of law: infringement consists of “reproducing ... articles to that design” (s.226(1)(a)). That means “copying the design so as to produce articles exactly or substantially to that design”.

114.

I am not convinced the Judge made any such error, or that if he did it made any difference. Mr Arnold's example was the tool adaptor. He submitted that the tubular ends were excluded by "must-fit". Thus the relevant comparison was between the central ribbed sections of the two parts. That is right. But he then submitted that was where the differences between them lie. I can see no difference. There is no separate non-infringement point.

The Date point

115.

Section 216(1) provides that design right expires:

(a) fifteen years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, which first occurred, or

(b) if articles made to the design are made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.

116.

If a man offers and takes orders for sale of articles for sale at the end of December, but does not actually deliver any until January, when does the 5 year period of s.216(1)(b) start to run? When are articles "made available for sale or hire?" In [307] the Judge held that it when the public first actually could get the articles. So in the example, it is January. And it would make no difference if there had been prior manufacture of a prototype, shown to the public but no more. The Judge held merely taking orders with future delivery (contemplated by the contract or in fact) was not enough. The first actual delivery is when the article is "made available for sale."

117.

Mr Arnold said that was wrong - the statute was aimed at exploitation of designs. This starts when orders for the article are actually taken. Mr Carr submitted that UDR was for a short period in itself. It was unlikely that in some cases (e.g. the example above) the period of full protection would be cut down to virtually 4 years only.

118.

Neither argument is particularly persuasive. Again the provision is not well-thought out - potentially it makes a 20% difference in the period of full protection whichever party is right. In the end I think the Judge was right to go by the actual words without any notion of underlying policy to guide him. He reasoned thus:

"I consider that the natural meaning of the expression "made available" connotes something that is actually in existence. If one imagines a case of an offer of goods which have yet to be made (in the sense that none of them are yet made) then I would not consider that those goods are "available" for sale even if advance orders for them are taken. Taking orders for them is not making them available."

119.

I agree and see no point in trying to say the same in my own words.

Conclusions

120.

Save for a few points which make no difference to the overall result, I think the Judge was right. I would like to pay tribute to his painstaking and careful judgment.

121.

But there are lessons to be learned about how to try a copyright or design right case of this sort, i.e. one with a host of overlapping and similar points. There will seldom be any point in ploughing through them all. Cases like this call for effective and early case management to control them.

122.

First it will be important that the claimant should identify with precision each and every "design" he relies upon. Just claiming design rights in parts, for instance, will not do - each aspect said to constitute a "design" should be spelt out. This will focus minds from the outset. Well-advised claimants will confine themselves to their best case "designs." In principle the defendant should then plead to each, raising challenges to originality or alleging commonplace and saying, if it is so contended, that one of the exclusions of must-match or must-fit apply. There may be cases where, either by agreement at that early stage, or by application to court pre-defence, the issues can be limited to sample issues even at that stage.

123.

In those cases where there is no earlier identification of such issues, there should be a case management conference at which such issues are identified. They should be such that they will in principle determine the whole case. Such an approach will obviate the evidence covering unnecessary detail, and very likely much else. It will considerably shorten the trial. It was adopted in the recent case of *Sweeney v MacMillan* [2003] EWHC Ch 460 [2002] RPC 651 about the copyright in "Ulysses." A case management decision well-prior to trial limited each side to reliance on just four pages of its own choosing (see [67]). That was enough. Another case, where such an expedient was not adopted, was *Sawkins v Hyperion* [2005] EWCA Civ 565, [2005] 1 WLR 3281. Four pieces of music were in issue throughout. It seems clear now that it would have been possible to resolve the issues with one, or at the most two, of them.

124.

Following identification of the sample issues the parties should produce a sort of Scott schedule, identifying each design relied upon, and each of the defences raised to that design. In that way it should be possible for all to keep the case within proportionate bounds.

125.

Another question of proportionality relates to expert evidence. If one is not careful this can mushroom out of proportion, particularly where the legal questions are not all that well defined and the expert is not given much guidance as to exactly what he/she should be doing. Many of the points which arise under s.213 do not really need expert evidence at all (cf. the registered design case, *Isaac Oren v Red Box Toy Factory* [1999] FSR 785 and *Thermos v Aladdin* [2000] FSR 401). And even if there are technical points they are likely to be uncontroversial and amenable to the single joint expert procedure. This again suggests that early firm case management is called for. Normally this would best be done by a judge, moreover one who has some experience of this sort of case.

126.

The overall lesson here is that the exceptions to UDR created by the Act do not give a carte blanche for pattern spares. Those who wish to make spares during the period of design right must design their own spares and cannot just copy every detail of the OEM's part. To be on the safe side they will have

to make them different as far as is possible - for trying to navigate by the chart provided by this crude statute is a risky business.

Lord Justice Lloyd:

127.

I agree.

Lord Justice Tuckey:

128.

I also agree.