



Neutral Citation Number: [2021] EWHC 1848 (Ch)

Case No.IL-2018-000105

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

Royal Courts of Justice,
Rolls Building Fetter Lane, London, EC4A 1NL

Date: 9 July 2021

Before:

DAVID STONE
(sitting as a Deputy High Court Judge)

Between:

(1) ORIGINAL BEAUTY TECHNOLOGY
COMPANY LIMITED
(2) LINHOPE INTERNATIONAL LIMITED
(3) RETAIL INC LIMITED (in liquidation)

Claimants

- and -

(1) G4K FASHION LIMITED
(2) CLAIRE LORRAINE HENDERSON
(3) MICHAEL JOHN BRANNEY
(4) OH POLLY LIMITED

Defendants

Ms Anna Edwards-Stuart and David Ivison (instructed by Mono Law Limited) for the First
and Second Claimants

The Third Claimant was not represented

Mr Ben Longstaff (instructed by Fieldfisher) for the Defendants

Hearing date: 24 June 2021

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment
and that copies of this version as handed down may be treated as authentic.

**Covid-19 Protocol: This judgment is to be handed down by the deputy judge remotely by circulation to
the parties' representatives by email and release to Bailii. The date for hand-down is deemed to be 09 July
2021.**

David Stone (sitting as a Deputy High Court Judge):

1. On 24 June 2021 I allowed the First and Second Claimants’ application to rely on a Supplemental Statement of Case which amended their pleadings in a number of ways. That application was opposed by the Defendants and, at their request, I set out below the reasons for my decision.

Background

2. The First and Second Claimants sell bandage and bodycon garments under the brand **House of CB**. The Defendants also sell such garments, under the brand **Oh Polly**. The Claimants sued the Defendants in June 2018 for unregistered design right infringement and passing off.
3. Following a trial over eight days (the **Main Trial**), I gave judgment on 24 February 2021 in relation to the alleged infringement of UK unregistered design rights (**UKUDR**) and Community unregistered design rights (**CUDR**) in 20 selected garments (the **Selected Garments**) out of a total of 91 garments which the Claimants said were infringed by the Defendants. I dismissed the passing off claim. That judgment (the **Main Judgment**) can be found at [2021] EWHC 294 (Ch). I adopted the parties’ nomenclature for the garments, with the Claimants’ garments given the letter C and a number (eg, C37) and the Defendants’ allegedly infringing garments given the letter D and the same number (eg D37). I found that seven of the Selected Garments infringed both UKUDR and CUDR and 13 infringed neither right. Both UKUDR and CUDR require copying: in each case where I found copying, an image of the Claimants’ pleaded garment appeared on the Defendants’ **Trello** card for its garment. As I explained in the Main Judgment, Trello is the Defendants’ internal database, which records the design history of each of their garments. For example, in relation to garment D2, I found at paragraph 147 of the Main Judgment:

“I have no hesitation in finding that D2 was copied from C2. As is clear from her email and the Trello records, Ms Henderson downloaded an image of C2 from YouTube, and instructed that it be sent to the factory to be reproduced.”

4. At paragraph 513 of the Main Judgment, I wrote:

“As noted above, the Claimants’ claim of UKUDR and CUDR infringement in relation to a further 71 garments was stayed as part of the streamlining ordered by Deputy Master Nurse. It is my fervent hope that there are sufficient findings in this judgment to enable the parties to agree how the claims in relation to those 71 garments should be concluded. As became apparent during the course of the trial, the 20 garments in issue before me fell into three “buckets”: (1) where referencing was admitted, and the Claimants’ garment was uploaded to Trello at the beginning of the production process; (2) where referencing was admitted, but the Claimants’ garment was not uploaded to Trello until part way into the design process; and (3) where no referencing was admitted. I add to that

garment D35, where copying was admitted. Whilst there were some minor variations within those buckets leading to slightly different outcomes (usually to do with colourways), I have found that, on the whole, the garments in bucket (1) infringe, but that those in buckets (2) and (3) do not. It seems to me that that ought to provide good guidance for dealing with the remaining 71 designs without the need for further intervention by the Court. Whilst not deciding the point, it seems to me at this stage that a further trial on liability in relation to those designs would likely be disproportionate. If those 71 garments cannot be resolved between the parties, the matter should be listed before me for directions.”

5. A form of order hearing took place on 1 April 2021, where I made orders for dealing with the remaining 71 garments which have not yet been adjudicated (the **Stayed Claims**). I gave a short *ex tempore* judgment (which can be found at [2021] EWHC 836 (Ch)) on the Defendants’ request for declarations of non-infringement. An issue arose after the form of order hearing in relation to the various colourways of some of the infringing garments, and I dealt with that in a judgment which can be found at [2021] EWHC 953 (Ch). I dealt with a further issue relating to costs where a Part 36 offer has been made: that judgment can be found at [2021] EWHC 954 (Ch). By the time of the form of order hearing, the Third Claimant was no longer actively involved in the proceedings.
6. Also on 1 April 2021, I listed the matter for trial on 6 August 2021 to deal with any of the Stayed Claims that were still pressed and which the parties were not able to resolve. To assist in reaching that position, I made the following orders:
 - i) For the Defendants to disclose the Trello cards relating to their garments the subject of the Stayed Claims, and file and serve a Re-Re-Amended Defence to address only the Stayed Claims;
 - ii) Having reviewed the Trello cards, for the First and Second Claimants to set out which claims they would pursue; and
 - iii) For the Defendants then to set out any further admissions of liability, and which issues remained in dispute.
7. Consequently, since the form of order hearing on 1 April 2021, the parties have taken the following steps in relation to the Stayed Claims:
 - i) The Defendants have disclosed for the first time the Trello cards for each of their garments affected by the Stayed Claims;
 - ii) The Defendants have admitted infringement in relation to two further garments (referred to as D85 and D87);
 - iii) The Defendants have admitted copying in relation to 16 further garments;

- iv) The Defendants have admitted subsistence of CUDR in respect of all but eight of the garments in the Stayed Claims; and
 - v) The Defendants have admitted subsistence of UKUDR in respect of all but six of the garments in the Stayed Claims.
8. The First and Second Claimants notified the Defendants on 13 May 2021 that they would pursue only 36 of the Stayed Claims. However, on 10 June 2021, the First and Second Claimants, through their solicitors, wrote to the Defendants' solicitors enclosing a draft Supplemental Statement of Case. This document maintains fewer and different claims to the 36 set out in the notice sent on 13 May 2021 and approaches the Stayed Claims as follows:
- i) Four garments remain claimed as pleaded – D38, D54, D57 and D88. Together with the two garments which have now been admitted to infringe (D85 and D87), these six claims were described by the parties as the Category A claims. The Defendants do not object to this aspect of the Supplemental Statement of Case and so I need say nothing more about it;
 - ii) There is a set of amended claims referred to as Category B where the First and Second Claimants no longer assert rights in the whole of their garments, but only in a part of each garment. These relate to D1, D27 and D57; and
 - iii) There is a further set of amended claims referred to as Category C, where the First and Second Claimants maintain that the Defendants' garments D6, D15, D41, D42 and D48 infringe, but instead of infringing the earlier claimed garments C6, C15, C41, C42 and C48, the five garments are now said to infringe different garments of the First and Second Claimants, namely C107, C110, C108, C109 and C61 (respectively). As might be apparent from the numbering, C107, C108, C109 and C110 are garments new to the proceedings. C61 was already in the proceedings, but is now invoked against D48. For each of C61, C108, C109 and C110, only a part of the Claimants' garment is relied on.
9. The Defendants now admit copying in relation to all of the Category A and the Category B garments. The Defendants have not yet had an opportunity to admit copying in relation to the Category C garments, but the First and Second Claimants submitted before me that the Category C claims were identified because the Claimants' garments were on the Defendants' Trello cards. As set out above, this was also the case for all the infringements I found in the Main Judgment.
10. For the Category A garments, only the following issues remain to be determined on 6 August 2021:
- i) Are the designs of C38 and C88 commonplace?

- ii) Are D38, D54, D57 and D88 made exactly or substantially to the Claimants' designs and does D54 create the same overall impression on the informed user as the Claimants' design?
11. In relation to the Category B and the Category C claims, the Defendants do not suggest that the First and Second Claimants are not entitled to bring them – however, they submitted before me that these claims should be filed as fresh proceedings to be determined in due course, rather than to become part of these proceedings.

Is this a late (or very late) amendment?

12. The Defendants described the application as a late amendment and also as a very late amendment, on the basis that the First and Second Claimants knew the position back in January 2020 before Deputy Master Nurse stayed the Stayed Claims on 7 April 2020, and hence seeking to amend now is late or very late. Counsel for the Defendants drew my attention to the commentary in the White Book 2021 at 17.3.8 and the helpful summary of principles in *Quah v Goldman Sachs International* [2015] EWHC 759 (Comm). Those principles are well known, and I do not set them out again here.
13. Whilst it is clear to me (and the First and Second Claimants admitted) that it would have been preferable for the Claimants to have provided the Supplemental Statement of Case to the Defendants on 13 May 2021, it does not seem to me that this is a late or very late amendment, because of the factual background, which I will need to describe in some detail.
14. Prior to Deputy Master Nurse staying the Stayed Claims on 7 April 2020, the position was as follows:
- i) The original Defence filed by the Defendants in January 2019 included the following: “Save that garment C35 was referenced in the creation of the design for garment D35, the Defendants created the designs for the Oh Polly garments independently and without copying any of the designs of the Claimants”.
 - ii) The Defendants filed an Amended Defence in January 2020 which stated: “While in some instances a House of CB garment was referenced in the creation of the design for the Oh Polly garment, in all cases the Defendants created the designs for the Oh Polly garments without copying any of the designs relied on by the Claimants.” The Amended Defence provided an annex for each of the Defendants' garments listing the date of design, the name and status of the designer and images of designs referred to.
 - iii) Correspondence and requests for further information followed, but no explanation was provided by the Defendants of how the images of garments referred to had been identified. It is my understanding that up to this point, there had been no mention of the Trello cards.

15. When the case was “streamlined” to 20 garments only, the claims in relation to the other 71 garments were stayed – nothing was progressed in relation to those Stayed Claims until I lifted the stay on 1 April 2021. So at the time those claims were stayed, no Trello cards had been disclosed in relation to those 71 garments. The Claimants had only the denials in the Amended Defence that I have set out above, and the images set out in the annexes to the Amended Defence.
16. In compliance with my order dated 28 April 2021 (actually made on 1 April 2021), the Defendants disclosed for the first time the Trello cards for the garments subject to the Stayed Claims. These contain more information than had previously been provided in the Amended Defence. I referred in the Main Judgment (for example, at paragraph 170) to the Microsoft Paint files created by the Second Defendant, Ms Henderson. These included images and text instructions to the Defendants’ manufacturers. Counsel for the First and Second Claimants took me to an example for garment D1 (Category B). A screen shot of part of the Trello card appears below:



Back of leggings to follow this lace up design - exactly as shown please.
The whole way down the leg.
Width and tie up design should match as shown.
Using lace.

17. Thus, in April 2021, for the first time, the Claimants were provided with a document from the Defendants’ internal records showing an image of the Claimants’ garment, together with instructions to reproduce aspects of it. I should add that significant information about the Defendants’ design and manufacturing processes came out during the course of the trial, and I made a number of findings in the Main Judgment which were not available to the parties until that judgment was disseminated.
18. I turn now to counsel for the Defendants’ submissions in relation to the Category C garments – those for which the Supplemental Statement of Case seeks to substitute a different House of CB garment for the ones already pleaded. Counsel for the Defendants submitted, including in further written submissions following my circulation of a draft of these reasons, that the House of CB garments referenced by the Defendants were known as far back

as January 2020 – and that the Claimants ought to have been able to plead the correct House of CB garments at that point.

19. In my judgment, that misrepresents the history of this matter as I have set out above and in the Main Judgment. As I said at paragraph 51 of the Main Judgment, the Defence was false at the time the Second Defendant signed it. By the time of the Main Trial, the Amended Defence had already been superseded, but as will be clear from my findings in the Main Judgment, I found copying in relation to those Oh Polly garments which I held to infringe the Claimants’ design rights. Therefore, I rejected the position pleaded by the Defendants in the paragraph of the Amended Defence I have set out above. I also rejected the Defendants’ submissions that (a) if more than one garment is referenced there cannot be copying and (b) the Second Defendant conceived of her garment designs in her head prior to viewing the House of CB garments images of which were attached to the Trello cards. In short, in the Main Judgment, I rejected many of the positions that had been adopted by the Defendants in relation to the House of CB garments relied on by the Second Defendant in describing her design process. I found in relation to D2, D4, D12, D13, D35, D61 and D91 that the Second Defendant had copied the Claimants’ garment designs. The Main Judgment was not appealed.
20. I therefore do not accept counsel for the Defendants’ position that the annexes provided in January 2020 were sufficient to enable the First and Second Claimants to plead the garments they now rely on. Rather, it seems to me that in January 2020, the Claimants were having to deal with the shift in the Defendants’ position from that in the Defence (namely that C35 was referenced but everything else was independently designed) to the position in the Amended Defence (namely that various garments were referenced but nothing was copied), in circumstances where shortly thereafter, streamlining was ordered, and the Category C garments ceased to be relevant as the 20 Selected Garments were prepared for trial.
21. None of us can know how this case might have run had the Trello cards for all garments been disclosed in January 2020. The Trello cards provide a clear documentary record of the Second Defendant’s design process, and of the Defendants’ manufacturing process. They clearly show, for example as I said in relation to D2 in the Main Judgment that “Ms Henderson found a picture of C2 on social media and took a screen shot. That screen shot was uploaded to Trello for the Defendants’ manufacturer to work from. There were no other drawings, patterns or plans.”
22. Only after the Defendants disclosed the Trello cards for the Category C documents in April 2021 were the First and Second Claimants able to assess them, for the first time, in light of my findings in the Main Judgment. The Claimants conceded that they had the images of the referenced House of CB garments in the annexes to the Amended Defence in January 2020, but the fact is that they did not have the Trello cards nor the text shown in them, and were then working against the background of the Defendants’ pleaded positions, which in the Main Judgment I rejected. I therefore reject the Defendants’ submission that there was nothing to prevent or hinder the Claimants from

pleading in January 2020 the designs relied on in the Supplemental Statement of Case.

23. If I am wrong in my analysis, then I still do not consider that the First and Second Claimants have delayed in making this application. As I set out in the Main Judgment, in January 2020 there were still 91 garments that were claimed to infringe. The Amended Defence was served on 31 January 2020. Streamlining was ordered on 7 April 2020. Neither side selected the Category C garments: the claims in relation to them were stayed, and the parties' attentions were directed elsewhere until the stay was lifted in April 2021. That left a period of just over two months for the Claimants to review the annexes provided with the Amended Defence (remembering that 91 garments were in issue). It should also be recalled that the Defendants had taken 6 months to file their Defence, and the Claimants had taken 5 months to file their Reply. The Amended Defence was filed more than 6 months after that. It is therefore unsurprising to me that the Claimants did not replead their case in relation to the Category C garments between 31 January and 7 April 2020, but rather focussed on the streamlining process and on the garments selected for it by both sides.
24. Counsel for the Defendants made a separate submission in relation to the part-designs now claimed by the First and Second Claimants – that these had to have been known in January 2020. During the Main Trial, it was submitted on behalf of the Defendants in relation to some of their garments that they did not infringe because the image of the House of CB garment uploaded to the Defendants' Trello system was only of the front of the garment. Hence, it was submitted that key features at the back could not have been copied. An example was D35. I dealt with this at paragraph 261 of the Main Judgment. To the extent that the proposed amendments to claim unregistered design rights in only a part of some of the House of CB garments are in response to this sort of submission by the Defendants, then I accept that such an amendment is not late.
25. Therefore, it seems to me that it is not open to the Defendants to say that nothing new has happened since January 2020. To the contrary – the First and Second Claimants now have considerably more information from the Defendants to enable them to refine their pleadings – much of which was only made available on 29 April 2021 or included in the findings I made in the Main Judgment. I therefore do not consider this to be a late amendment (nor a very late amendment), and therefore I do not consider that a heavy burden sits on the First and Second Claimants in accordance with the principles set out in *Quah*. The amendment thus falls to be considered in the usual way.

Should the amendment be allowed?

26. Counsel for the Defendants made the following submissions opposing the amendment.
27. First, he said that the First and Second Claimants have introduced the amendments “well past the juncture at which this Court has clearly signalled that all remaining loose ends should have been tidied up (not to mention well

past the point at which [the First and Second Claimants] could have done so)". As set out above, I disagree. At the time of their application, the First and Second Claimants had had the Trello cards in relation to the Stayed Claims for under 2 months.

28. Second, counsel for the Defendants submitted that it is "intolerable that [the Defendants] should suddenly be forced to defend those garments against a different set of allegations that [the First and Second Claimants] could have raised at the outset or at the latest since January 2020". Again, I disagree, for the reasons I have set out above.
29. Third, counsel for the Defendants submitted that the amendments would cause "huge prejudice" and "intolerable unfairness" to the Defendants and jeopardise the trial on 6 August 2021. Again, I disagree with this submission. There was no evidence before me of the steps required to be taken to defend the allegations now contained in the Supplemental Statement of Case. I accept that the Defendants' advisors must now consider four new House of CB garments which they have not seen before, but the Defendants have had images of them since those images were uploaded to the Trello cards at the time the Defendants' garments were designed (for example, some in 2017). Counsel for the Defendants was unable to tell me specifically what tasks would be necessary, but working from the Main Trial (where he did not appear), it seems to me that the potential issues for consideration are:
 - i) **Subsistence:** Counsel for the First and Second Claimants submitted that none of the Defendants' subsistence attacks at the main trial had succeeded. Be that as it may, the Defendants are entitled to defend the claims, for which they may wish to undertake additional prior art searches. I do not consider that this task will be overly time-consuming or burdensome, and there was no evidence before me to suggest that it would be. Agencies are available for that task, and the Defendants have availed themselves of such agencies previously, including introducing 35 new prior designs 6 weeks before the PTR prior to the Main Trial. Counsel for the Defendants also submitted that they "may also need time to request disclosure, if appropriate". Counsel for the Defendants was unable to tell me what category of document the Defendants may wish to see disclosed and I was provided with no evidence on the point. Whilst forming no concluded view on the issue, it is difficult for me to see, in light of the Main Judgment, what disclosure could be requested. Counsel for the First and Second Claimants submitted that no disclosure was provided prior to the Main Trial, and none is sought in relation to the Category A garments. If the Defendants wish to consider their position (if they have not done so already), then there is, in my judgment, sufficient time in which that can be done, and directions can be given to enable them to do so.
 - ii) **Copying:** Counsel for the First and Second Claimants submitted that this would not be controversial, because in each case, the House of CB garment relied on appears on the Defendants' Trello cards as an image sent to the factory. All the Category B and the Category C Oh Polly garments were designed by the Second Defendant: see the annexes to

the Amended Defence. The Second Defendant gave evidence over two days at the Main Trial as to her design process, and I made findings on that issue at paragraphs 29 to 55, 112 to 117 and 135 of the Main Judgment. It seems to me that the design process for the Category B and the Category C Oh Polly garments is very likely to be the same as that for the garments designed by the Second Defendant that I considered in the Main Trial. Certainly, there was no submission or evidence before me on this application to suggest otherwise. The Defendants did not suggest that additional evidence is required in relation to the Category A garments. So it seems to me that provision can be made for the Defendants to consider their position and to adduce any additional evidence they wish to, and that those steps can be accommodated in the timetable.

- iii) **Infringement:** This is not a matter for evidence – it is a matter for submissions. The legal issues have already been traversed fully in the Main Judgment. Therefore, what remains is a comparison of the claimed design with the allegedly infringing garment. Given the smaller number of garments now involved, and the findings I have already made in the Main Judgment, this task seems to me to be limited, and the Defendants provided no evidence to the contrary.
30. In summary, the Defendants will not be shut out from any steps they wish to take. Given the findings in the Main Judgment, it seems to me that those steps will actually be very limited, and hence able to be accommodated between now and 6 August 2021. That point ties back to the Defendants’ submissions on the lateness of the application and the jeopardy to the trial date. As I have said, this was made as a free-standing submission, but it is a related point. As is apparent from the above, I do not consider that the 6 August 2021 date needs to be adjourned, because I consider there is adequate time for the Defendants to undertake the steps they have set out, and they have provided no evidence to the contrary.
31. Fourth, counsel for the Defendants submitted that the First and Second Claimants have not provided “any credible justification” for bringing the new claims. Again, I disagree. As set out above, the First and Second Claimants have explained, and I accept, that they did not have either the Trello cards or the Main Judgment until recently, and both enabled them to refine their claims.
32. Fifth, counsel for the Defendants submitted that the First and Second Claimants were prevented from now claiming design rights in only parts of their garments by the Fourth Recital to the order of Deputy Master Nurse of 15 October 2019. But as I read that recital, it notes that part claims were not at that time being pursued (and they were not pursued for the Main Trial) but that this was “without prejudice to [the Claimants’] right to seek to amend their Particulars of Claim to introduce such claims following service of the Amended Defence.” Following the service of the Amended Defence, the Stayed Claims were stayed, and so it is unsurprising that the First and Second Claimants did not seek to amend until after the stay was lifted on 1 April 2021.

33. Sixth, counsel for the Defendants submitted that the claims to design rights in parts of garments as set out in the Supplemental Statement of Case are imprecise. I agree, and during the hearing on 24 June 2021 I gave orders for the First and Second Claimants to be more precise. I was told that that could be readily accommodated, and I ordered that that be done within 24 hours.
34. Seventh, counsel for the Defendants submitted that my refusal of the application to amend would not prevent the Claimants from issuing a new set of proceedings for each of the Category B and the Category C claims should they so wish. Whilst that is true, it is not a submission that could be described as proportionate or compliant with the Overriding Objective. As will be apparent from what I have set out above, this case has run for a number of years, through various iterations, and it is time to bring finality to the dispute. It would, in my judgment, be grossly disproportionate for another set of proceedings to run in parallel to these proceedings, including in circumstances where these claims can be accommodated now without considerable difficulty.
35. As will be clear from the above, I consider that the First and Second Claimants are entitled to amend their claims at this point in the way that they have proposed. Whilst it would have been preferable for the application to have been made on 13 May instead of on 17 June, it is by no means late or very late. In my judgment, the Defendants are well able to accommodate the tasks they need to do to prepare for the trial on 6 August 2021 – and no evidence was provided to suggest that they could not. This is a significantly smaller exercise than that which faced the parties in relation to the Main Trial, due to the findings I have already made in the Main Judgment, and the smaller number of garments now in issue.
36. I do not consider that granting the application puts the parties on an unequal footing or adds an excessive burden to the Defendants' task of preparing for trial. It does not jeopardise the trial date. It would be unjust to refuse the application, thereby forcing the First and Second Claimants to commence fresh proceedings for those designs. That would also be contrary to the interests of other litigants before the court. The new claims proposed are not frivolous – indeed, they are made by the First and Second Claimants in light of the rulings I have made already in the Main Judgment.
37. I therefore allow the application to permit the First and Second Claimants to rely on their Supplemental Statement of Case.
38. For completeness, if I had found that this was a late or very late amendment as the Defendants urged me to do, I would still have allowed the amendment for the reasons I have given.