

**IN THE HIGH COURT OF JUSTICE**

**CHANCERY DIVISION**

**INTELLECTUAL PROPERTY ENTERPRISE COURT**

Rolls Building,  
110 Fetter Lane,  
London  
EC4A 1NL

Date: 12<sup>th</sup> November 2013

**Before:**

**MR RECORDER DOUGLAS CAMPBELL**  
**Sitting as an Enterprise Judge**

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**Between :**

**UTOPIA TABLEWARE LIMITED**

**Claimant**

**- and -**

**(1) BBP MARKETING LIMITED**  
**(2) THE BRITISH BUNG MANUFACTURING COMPANY LIMITED**

**Defendants**

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**Michael Edenborough QC and Thomas St Quintin** (instructed by **Fasken Martineau LLP**)  
for the Claimant

**Robert Onslow** (instructed by **Baxter Caulfield**) for the Defendants

Hearing date: 24<sup>th</sup> September 2013

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**JUDGMENT**

**Mr Recorder Douglas Campbell:**

**Introduction**

1. This is a design case about beer glasses. The Claimant is represented by Michael Edenborough QC and Thomas St Quintin, instructed by Fasken Martineau LLP. There is no longer any need to distinguish between the Defendants, who are represented by Robert Onslow instructed by Baxter Caulfield.

2. The Claimant relies on UK unregistered design rights relating to a particular beer glass which it sells under the name Aspen, and also on UK registered design no. 4021276 which was applied for on 13<sup>th</sup> August 2011. Copies of the Claimant's main design document for purposes of UK unregistered design right, and the Claimant's UK registered design are annexed to this judgment at Annexes 1 and 2 respectively. The unregistered design relied upon is not quite the same as the registered design.
3. The Defendants' product which is alleged to infringe both rights is called the Aspire. A photograph showing the Aspen and Aspire commercial products side by side is annexed to this judgment at Annex 3. As with many of the photographs in this case, the transparent nature of the glasses themselves makes it difficult to see some of the detail.
4. The Defendants admit that the exterior dimensions of their Aspire product were copied from the Claimant's Aspen glass. However they stress that neither the internal dimensions nor the wall thickness were copied. Both of these differences arise from the fact that the Defendants' product is made of polycarbonate rather than glass. The major issue in relation to the unregistered design right claim was subsistence, and in particular whether the designs relied upon by the Claimant were commonplace.
5. The Defendants also admit that the design of their Aspire product does not produce on the informed user a different overall impression from the Claimant's registered design but "*only insofar as the exterior shape thereof is concerned*". The major issue in relation to the registered design claim was validity, and in particular whether the design was new and/or had individual character.

### **Previous history of the case**

6. The action was commenced by claim form dated 12<sup>th</sup> December 2012. The claim form included an allegation of passing off as well as the allegations of unregistered design right infringement and registered design infringement.
7. On 18<sup>th</sup> December 2012 the Claimant applied for an interim injunction. HHJ Birss QC (as he then was) heard counsel for both sides and his decision is reported at [2012] EWPC 58. The Judge granted the injunction sought, which only lasted pending a full hearing listed for 21<sup>st</sup> January 2013. However the Judge was concerned by an allegation which was made by Counsel for the Defendants to the effect that various emails upon which the Claimant had relied in its evidence in order to establish unquantifiable harm, and which the Claimant had alleged were unsolicited, were not unsolicited at all. The Judge therefore required the Claimant to deal with the Defendants' allegations about these emails.
8. The matter duly returned to Court upon 21<sup>st</sup> January 2013. HHJ Birss QC's decision following that hearing is reported at [2013] EWPC 15. By that time both sides had given further evidence about the Claimant's said emails. The Claimant maintained that the emails were perfectly genuine but the Defendants said that they could not be. The Judge held that he was not in a

position to resolve who was right about the emails. He nevertheless granted an interim injunction pending trial.

9. In early April, the two individuals at the Claimant who had given evidence about these emails (namely Mr Stephen Martin Dodd, a director of the Claimant; and Mr Thomas Martin Core, the Claimant's sales director) admitted that their evidence had indeed been fabricated just as the Defendants had alleged. The Defendants sought an order pursuant to CPR Part 81.18(5) that the matter should be referred to the Attorney-General with a request that the Attorney-General consider whether to bring proceedings for contempt of court. On 1<sup>st</sup> May 2013, HHJ Birss QC made the order sought by the Defendants. His judgment is reported at [2013] EWPC 28. The Judge expressly accepted the Defendants' allegation that Mr Dodd and Mr Core were the lead conspirators in a conspiracy to present a false picture to the Court: see [23]-[24].

## **The witnesses**

### *The Claimant's witnesses*

10. I heard evidence from Mr Dodd, Mr Core, and Mr Mark Edwards of the Claimant. Mr Edwards is the designer of the Claimant's designs relied upon. I also heard evidence from the Claimant's expert witness, Mr Anthony Trusler.
11. In view of the previous history of this case, as set out above, it is not surprising that the Defendants were suspicious of the evidence given by the Claimant's witnesses as to the creation of the designs relied upon. The Defendants therefore took the unusual step of sending the Claimant's solicitors a letter shortly before trial giving advance notice of cross-examination points in order to give Mr Edwards every opportunity to recant from a witness statement which the Defendants said was "*shot through with self-evident inconsistencies*". The Defendants also indicated that in their view Mr Edwards might have been coerced by Mr Dodd and Mr Core into giving his evidence.
12. Given the gravity of the allegations being made by the Defendants, sending that letter was a sensible approach for the Defendants to take. In response Mr Edwards served a short further witness statement dealing with the alleged inconsistencies. The Defendants did not object to this.
13. In cross-examination Mr Dodd and Mr Core were both asked whether they had discussed the content of the Defendants' letter with Mr Edwards. Mr Dodd said that he had had a general discussion with Mr Edwards about the need to respond to it, whereas Mr Core said he had not discussed the letter with anybody. I accept their evidence. The allegation of coercion was not put to either of them, and rightly so since by then there was no basis for it.
14. I will deal with the subject matter of Mr Edwards' evidence below as a separate topic. In general I found Mr Edwards to be a good witness. He had no problem in explaining why the matters which the Defendants had alleged

were “*self-evident inconsistencies*” were no such thing. The only criticism which the Defendants eventually made about his evidence was that some details about the design history only emerged in cross-examination. However the Defendants did not explain why any of these additional details made any difference and in my view they did not. These details were merely an illustration of the fact that close and careful cross examination will often bring to light additional information. I therefore reject this criticism of Mr Edwards. The Defendants did not submit that Mr Edwards was lying or seeking to deceive the Court, nor did they put to him that he had been coerced into doing so.

15. Mr Trusler holds City & Guilds and HNC qualifications in mechanical engineering. He joined Carlsberg Brewery in 1975 and remained there until he retired in 2012. He also obtained a Bachelor of Science degree with the Open University in December 1998. From 1994 onwards he held a series of positions within Carlsberg which led him to become increasingly involved in glass bottle design. From about 2005 onwards he also became involved with beer glass manufacturers. He was a good source of information about trends in the beer glass industry, and the reasons for adopting particular design features.
16. Mr Trusler’s evidence also included commentary about the similarities and differences between various designs in the case, and his views about the significance thereof. I did not find this part of his evidence helpful since I can see the similarities and differences for myself, and I must form my own view about their significance. Those arguments could and should have been made by way of submission and did not require expert evidence: see *Jacob J (as he then was) in Oren (Isaac) v Red Box Toy Factory Ltd* [1999] FSR 785, *Thermos Ltd v Aladdin Sales & Marketing Ltd* [2000] FSR 402.

*The Defendants’ witness*

17. The Defendants adduced evidence from Mr Michael Steer, who is the General Manager of the First Defendant and also the General Manager of BB Plastics, a trading division and name used by the Second Defendant. He gave evidence about the market generally. For instance he explained that he had been in the business of designing and manufacturing plastic drinkware for over 30 years. He explained that he regularly obtained samples of glasses, both in the UK and abroad, in order to keep in touch with the market. In addition his company was regularly presented with glass samples by breweries, particularly when they wanted the Defendants to reproduce such samples in polycarbonate. Finally Mr Steer was also personally responsible for the development of the Defendants’ Aspire glass and he gave evidence about that.
18. The Claimant invited me to reject Mr Steer’s evidence about the market on the grounds that it was expert evidence, and that although permission had been given for an expert Mr Steer’s evidence did not comply with Part 35. I decline to do so. Like Mr Trusler, Mr Steer was a good source of information about trends in the beer glass industry and the reasons for adopting particular design features. It is true that parts of Mr Steer’s evidence consisted of argument about the similarities and differences between various designs in the case but I

have not given that part of his evidence any weight, for the same reasons as I did not give any weight to the equivalent part of Mr Trusler's evidence.

### **The prior art relied upon**

19. Both sides agreed that prior to the development of the Claimant's design most beer glasses in the UK traditionally fell into one of 4 main categories called dimpled tankard, conical, tulip, and nonic. The nonic glass is like a conical glass but has a bulge a couple of inches below the rim, which assists collection and stacking and also preventing the rim chipping. Some continental style glasses, such as Pilsner glasses and wheat beer ("Weizenbier") glasses were also sold and commonly seen in the UK. Both Pilsner and Weizenbier glasses were tall and slender, with the Weizenbier having a pronounced waist. The glasses in issue in the present case are closer in appearance to the continental style glasses than they are to the traditional style glasses.
20. In their Defence and Counterclaim, the Defendants relied upon the same 4 alleged prior art designs with respect to both unregistered design right and the registered design. These were the Peroni, Amstel, Cobra, and Carlsberg designs. All of them were for tall, slender, waisted glasses. All 4 of these companies are manufacturers of beer, and each of these designs related to a beer glass which had been manufactured on behalf of the relevant company.
21. The Defence to the claim for unregistered design right also stated that "*The Defendants will rely upon such other commonplace design variants as may be disclosed by the Claimant in the course of these proceedings*", but nothing was disclosed, and hence nothing was relied upon, under this provision.
22. In his first witness statement dated 11<sup>th</sup> January 2013 Mr Steer relied primarily on the Peroni and Amstel glasses as "*the most obvious examples of glasses of this kind of appearance pre-dating that on which the Claimant relies*". He also referred more briefly to the Cobra and Carlsberg glasses as providing other examples.
23. However in his second witness statement dated 3<sup>rd</sup> July 2013, Mr Steer referred to a number of other glasses, and still more glasses were referred to in a letter which the Defendants sent to the Claimant's solicitors on 13<sup>th</sup> September. None of these additional glasses was ever pleaded, contrary to Part 63.20. On the morning of the trial the Defendants nevertheless asked for permission to rely on all of the additional glasses. This was despite the fact that a number of these additional glasses were, on the Defendants' admission, not prior art at all; and others were said by the Defendants to require additional evidence in chief, would have brought Part 63.23(2) into play. (This is the rule which prevents the Court considering an application by a party to submit material in addition to that ordered at the case management conference save in exceptional circumstances). In addition, the information provided by the Defendants about some of these additional glasses was itself scanty. For instance the Defendants had not even provided a picture of one glass upon which they particularly sought to rely, called the Madison. The Claimant had had to try and find a picture of the Madison, and was not certain whether it had found the right one. There was no good reason for the Defendants' failure

to comply with the rules and I refused the Defendants permission to rely on any of these additional glasses. The Defendants did not ask for permission to appeal against that decision.

24. It also turned out that the Cobra glass was not made available to the public until after the application for the Registered Design was filed, and this prior art dropped out of the case. It was further away than any of the remaining 3 designs in any event.
25. Copies of the Peroni, Amstel, and Carlsberg designs are annexed to this judgment at Annex 4. The photographs of the Peroni and Amstel products, on which most of the argument focussed, also show the Claimant's Aspen product alongside.

### **The creation of the Claimant's design**

26. I find that the facts relating to the creation of the Claimant's design were as follows.
27. In 2008-2009 the Claimant had received a number of requests from breweries for tall beer glasses on to which the brewers could place their own brands. One such brewery was Carling, which approached the Claimant some time in late 2008.
28. The Carling project took some time to get going, because Carling had not made any sort of binding commitment and the Claimant had the impression that it was not likely to go through to completion. Mr Edwards produced his first set of drawings, which were referred to in evidence as the "Carling concept" drawings, in February 2009. The starting point for this set of drawings was a tulip glass, although the set included a number of variations thereof. These drawings were sent through to Carling in the middle or end of February. The feedback was positive, but as the Claimant had anticipated the project did not progress after that.
29. Although Carling was not interested, the Claimant decided to persevere. Mr Edwards produced another set of drawings over the course of 1 ½ days on 9<sup>th</sup> and 10<sup>th</sup> March 2009. He did this by opening the computer file he had created for the Carling project and saving it under a new name and date. He also added a number of additional drawings to the same computer file. He was able to produce the new suite of drawings so quickly because many of the drawings were ones he had previously created as part of the Carling project, and all of them were concept drawings as opposed to fully-dimensioned CAD-based manufacturing drawings.
30. Mr Edwards' new suite of drawings was presented to the management of Utopia at an internal product development meeting in late March 2009. Two of the designs were thought to be the best and Mr Edwards was asked to combine them. One of these designs (A) had originated in the Carling project whereas the other (P) had not. Mr Edwards explained that the final design was not so much an amalgamation of designs A and P, but a slight tweak to design

A bearing in mind design P. He saved the tweaked version of design A some time after the March 2009 meeting.

31. As Mr Edwards emphasised, at no point during this process did he refer to any of the Peroni, Amstel or Carlsberg glasses. The Defendants did not put it to him that he had.
32. There was then a gap of almost 2 years until the final design drawing of the Aspen glass (as annexed at Annex 1), which is dated 16 February 2011. The main reason for the delay was because the Claimant wanted to gauge the level of interest from breweries before committing itself to production. The main change in the design from the 2009 version was to thicken the base, and Mr Edwards used a similar thickness to that used in another Utopia product called the Senator.
33. This 2011 design drawing was subsequently used to create manufacturing drawings, and these manufacturing drawings were in turn used to create the Claimant's Aspen product. I did not see these manufacturing drawings since they were not produced by the Claimant, and the Defendants did not ask the Claimant to produce them.

#### *The Aspen name*

34. There was a minor dispute about the genesis of the Aspen name. At one point the Defendants argued that Mr Edwards had copied the name from the Aspen range of glasses having the same name which was manufactured by a company called Sahn. Indeed Mr Steer hinted that Mr Edwards had copied rather more than that from Sahn, even though (as the Claimant pointed out) the Defendants had pleaded no positive challenge to originality of the Claimant's design.
35. There is nothing in this point. Mr Edwards said, and I accept, that he did not know either Sahn or its glasses, and that the similarity in names was a coincidence. It is in any event inherently unlikely that a copyist would draw attention to his copying in this way.
36. Instead Mr Edwards had created the name Aspen himself. In fact it turned out that Mr Edwards had already used the same name for a different Utopia product, namely a plate, back in 2010 but had forgotten about it.

#### **The creation of the Defendants' design**

37. Mr Steer had some experience of creating beer glass designs. For instance in 2002 he designed a range of polycarbonate glasses on behalf of the Second Defendant. In 2007 the Claimant launched what Mr Steer considered to be an "identical range". Mr Steer explained that his solicitors had written the Claimant a letter alleging copying, and that although the Claimant had denied copying Mr Steer did not believe that denial. The Claimant had also made the point that the designs in issue in that dispute were "generic". Mr Steer had reluctantly accepted there was something in the allegation that his designs were generic, and had taken no further action.

38. Mr Steer went on to deal with the creation of the Defendants' Aspire design. He explained that he was aware of continental style beer glasses generally, and the Peroni and Amstel glasses in particular. He came across the Claimant's Aspen glass in 2012, and he formed the view that its shape was commonplace. Hence he concluded that there was no "*valid reason why the First Defendant should not manufacture in polycarbonate a glass which had the same external shape as that of the Claimant*".
39. Mr Steer explained that because of the difference in materials and manufacturing process, the thickness of the sides of the parties' respective products was different and there was also a difference in the straightness of the insides. He explained that "*Accordingly, the exterior of the First Defendant's plastic glass is a copy of the Claimant's, but the interior is not*".
40. Mr Steer was asked why he had copied the Aspen glass, rather than the Peroni or Amstel glasses. His initial response, which I found puzzling, was that he did not know. However he later explained that the Peroni and Amstel glasses would have been more difficult to produce in polycarbonate. The Claimant did not dispute this subsequent explanation. It did not suggest, for instance, that Mr Steer was motivated by revenge for the 2007 incident.
41. The Claimant gave no reason why I should reject any of Mr Steer's evidence, and I accept it.

#### **Issues to be decided**

42. By order of HHJ Birss QC dated 1<sup>st</sup> May 2013, the issues to be decided are as follows:
  - (a) Subsistence and ownership of the Claimant's unregistered Vessel Designs.
  - (b) Subsistence and ownership of the Claimant's registered design.
  - (c) In particular, in relation to the subsistence of the aforesaid designs, whether, by reference to existing products in the field such as the Peroni and Amstel beer glasses:
    - i. The Vessel Design is commonplace and/or not original; and/or
    - ii. The Registered Design is not new and does not have individual character.
  - (d) Whether the Defendants' Aspire glass infringes the Vessel Designs or either of them and/or the Registered Design.

#### **A. Subsistence and ownership of the Claimant's unregistered Vessel Designs**

43. I have set out the history of the creation of the Claimant's Aspen design generally above. The particular aspects of shape and configuration of the Aspen design which were relied upon were defined more closely in the Particulars of Claim. Paragraph 9 referred to the Claimant's design drawing



which is at Annex 1. Subsequent paragraphs elaborated as follows, with my renumbering for convenience:

- 1) *“A first Vessel Design subsists in the following aspects of shape and/or configuration of the Claimant’s Vessel, each of which has a range of manufacturing tolerances typical of glass products:*
  - (a) The shape of the profile of the outer surfaces of the Claimant’s Vessel, that profile in particular including, above a waisted section, an elongated tulip shaped section which tapers inwardly as it approaches the rim of the Claimant’s Vessel, and*
  - (b) The shape of the profile of the inner surfaces of the Claimant’s vessel,*
  - (c) The shape of the rim connecting the inner and outer surfaces of the Claimant’s Vessel, and*
  - (d) The thickness of the base of the Claimant’s vessel.*
- 2) *A second Vessel Design subsists in the aspects of the shape and configuration of the Claimant’s Vessel set out in (a) above, and in the internal volume of the Claimant’s Vessel, each of which has a range of manufacturing tolerances typical of glass products.”*

#### *Legal context*

44. S 213(2) of the Copyright, Designs and Patents Act 1988 defines “design” for the purposes of design right as meaning the design of “any aspect” of the “shape or configuration” of an article. There is no objection in principle against the Claimant relying on design rights in parts of a larger article: see eg **A. Fulton Co Ltd v Totes Isotoner (UK) Ltd** [2003] EWCA Civ 1514, [2004] RPC 16, at [15]-[29].
45. “Any aspect” extends to any aspect of the shape or configuration that is discernible or recognisable: see **Fulton v Totes** at [31] and **Dyson Ltd v Qualtex (UK) Ltd** [2006] EWCA Civ 166, [2006] RPC 31 at [22]. The word “configuration” has a broader meaning than “shape” and includes the relative arrangement of parts or elements of an article: see Arnold J in **Magmatic v PMS International** [2013] EWHC 1925 (Pat) at [82] citing **CliniSupplies Ltd v Park** [2012] EWHC 3452 (Ch) at [36]-[53] and Pumfrey J in **Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd** [1999] RPC 717.
46. I also bear in mind that the purpose of the pleading is to identify the feature relied upon. As Jacob LJ said in **Dyson v Vax** [2012] FSR 4 at [30] “*you cannot take features of a design, turn them into general words, and then treat those words like a patent claim*”. See also the decision of Mr Recorder Purvis QC in **Mainetti v Hangerlogic** [2012] EWPC 42 at [23(g)].

47. In relation to originality, the test is set out in **Farmers Build Ltd v Carrier Bulk Materials Handling Ltd** [1999] RPC 461 at 475, 482. In particular a design must be “original” in the copyright sense of originating with the author, and not being copied by the author from another.
48. Ownership is governed by s 215 of the Act. Save where a design is created in pursuance of a commission, a designer’s employer is the first owner of any design right in a design created by an employer in the course of his employment (see s 215(2), 215(3)). Commissioning requires a contract involving mutual obligations prior to production of the relevant designs: see **Ultraframe v Clayton (No. 2)** [2004] RPC 24 at [30].

#### *Assessment*

49. With the benefit of hindsight, it can be seen that the Claimant’s formulation is more complicated than it needed to be. For instance the reference to “*a range of manufacturing tolerances typical of glass products*” is confusing since none of the manufacturing tolerances is specified, nor do they appear to be relevant anyway since the alleged infringement is made of polycarbonate rather than glass. The word “including” in integer 1(a) directs particular attention to a sub-region of the profile of the outer surfaces of the Claimant’s vessel but does not exclude, and was not taken by either party as excluding, the rest of the profile of the outer surfaces thereof.
50. The more difficult point as regards integer 1(a) is that it expressly refers to “*an elongated tulip shaped section which tapers inwardly as it approaches the rim of the Claimant’s Vessel*”. This inward taper is not particularly easy to see in the Claimant’s design drawing, but it is discernible.
51. The Claimant also explained to me that the reference to “internal volume” in the context of the second Vessel Design was intended to mean that the inside was capable of holding 20 fluid ounces, or 568 ml of liquid. However this capability is not an “*aspect of shape or configuration*”, even bearing in mind the wider meaning of “*configuration*”. A volume has neither shape nor configuration.
52. I find that design right subsists in each of features 1(a) to 1(d). Each of these features is of such a nature that it qualifies for design right protection, and they were each created by Mr Edwards. It was not suggested that there were any other reasons why design right would not subsist.
53. As regards ownership, it at one point appeared that the Defendants intended to argue that the Claimant’s design was commissioned by Carling. The absence of any contract involving mutual obligations prior to production of the relevant designs would have been fatal to such an argument. Carling did not pay for, and were not obliged to pay for, the design any more than the Claimant was obliged to produce it for Carling. Each of the features relied upon was simply created by Mr Edwards in the course of his employment with the Claimant. I find that design right in each of features 1(a) to 1(d) is owned by the Claimant.

54. However feature 1(b) is academic since it is plain from Mr Steer's evidence, which I have accepted, that this feature was not copied and the Claimant did not submit to the contrary. From now on I will focus on features 1(a), the shape of the profile of the outer surfaces, 1(c), the shape of the rim, and 1(d), the thickness of the base.

B. Subsistence and ownership of the Claimant's registered design.

55. This was not a live issue at trial and no arguments were directed towards it. I find that the Claimant's registered design subsists and is owned by the Claimant.

C(i). Whether the Claimant's Vessel Design is commonplace and/or not original

56. I have already found that features 1(a), 1(c) and 1(d) are original in the copyright sense. In this section I will consider whether they are original in the sense of s 213(4) of the Act.

*Legal context*

57. S 213(4) of the Act provides that "*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*". The law on this topic has been considered in a number of cases, including **Farmers Build v Carier** [1999] RPC 461 at 482, **Ocular Sciences** [1997] RPC 289 at p 429 line 48, **Scholes v Magnet** [2002] FSR 10 at [32], and **Lambretta v Teddy Smith** [2005] RPC 6. All of these cases were reviewed by HHJ Birss QC in **Albert Packaging v Nampak** [2011] FSR at [27]-[31] and I shall apply the principles set out therein.

*Analysis*

58. The first issue to decide is the identification of the relevant design field for purposes of the Act. The Claimant said that the relevant design field was high waisted beer glasses, whereas the Defendants argued for glasses generally. Although the product itself is obviously a high waisted beer glass I remind myself that, as stated by Jacob LJ in **Lambretta** at [45] (with whom Mance and Sedley LJ agreed on this point):

*"... a reasonably broad approach is called for. What matters are the sort of designs with which a notional designer of the article concerned would be familiar"*.

59. Given the need for a reasonably broad approach bearing in mind the sort of designs with which a notional designer of the article concerned would be familiar, in my judgment the relevant design field is that of beer glasses. That said, nothing seems to turn on the difference between high waisted beer glasses and any other beer glasses since the pleaded prior art and the Claimant's glass are all examples of high waisted beer glasses.
60. As indicated by **Farmers Build** I will consider how similar the Claimant's designs are to the design of similar articles in the same field of design made by

third parties, and in particular to the design of the Peroni, Amstel, and Carlsberg glasses since these are the only examples relied upon.

61. As I have said, the Claimant's glass is clearly the same type of glass as each of the prior art designs in the sense that they are all tall beer glasses with waist sections. However when one focusses on feature 1(a) itself, ie the shape of the profile of the outer surfaces of the Claimant's Vessel, it is obvious that this shape is noticeably different from glass to glass.
- (a) The Peroni profile is the most similar to the Claimant's profile, but the Peroni waist looks narrower than the Aspen waist, relative to the width of the brim of the glass in each case; the Peroni rim looks wider relative to the Peroni base, than the Aspen rim is relative to the Aspen base; the Peroni profile above the waist is a cone whereas the Aspen profile curves in as one goes up the side; the Peroni profile has no inward taper near the rim, and the Aspen profile has this slight inward taper.
  - (b) The Amstel profile is further away from the Aspen profile than the Peroni profile is. The Amstel profile has quite a pronounced curvature which Mr Trusler described as an "hourglass" shape. The Amstel profile also has a lower waist than the Aspen profile, and a noticeably different shape below the waist.
  - (c) The Carlsberg profile is even further away from the Aspen profile than the Amstel profile is. The "hourglass" shape is now even more pronounced, and it also has a lower waist and a more curved base than the Aspen. The Carlsberg profile has no inward taper near the rim, and it has a cone profile above the waist which is similar to that of the Peroni. In both respects it differs from the Aspen profile.
62. When one focusses on features 1(c) and 1(d), ie the rim and the thickness of the base, it seems to me that although there are some differences between the Aspen and the prior art glasses they are much less noticeable and such differences would not excite any particular attention in those in the relevant art. The glass has to have a rim, and the rim shown on the Claimant's design drawing seems to be just a short flat line. The base also has to have a thickness. It is not clear from the relevant drawing what the thickness of the base actually was, although from Mr Edwards' witness statement it appears to have been about 10mm. Mr Edwards did not suggest that there was anything special about the particular rim and/or base thickness which he chose.
63. I find that feature 1(a) is not commonplace, but that features 1(c) and 1(d) are commonplace.
64. Although the Claimant defined its design right in terms of a "Vessel Design" which refers to all of 1(a) to 1(d), no reason was given as to why the Claimant could not rely on just one of these features and I see no reason why the Claimant should not be allowed to do so. All of these features have been expressly pleaded, so the Defendants knew what they were, and as pointed out above there is no objection in principle against the Claimant relying on design

rights in parts of a larger article. Accordingly I will consider only feature 1(a) from now on.

C(ii). Whether the Registered Design is not new and does not have individual character

*Legal context*

65. The law relating to Community registered designs derives from Council Regulation (EC) No 6/2002 (the Community Design Regulation). The law relating to UK registered designs such as the design in suit in this case derives from the relevant provisions of the Registered Designs Act 1949 as amended by the Registered Designs Regulations 2001 to implement Directive 98/71/EC. Although the legislative bases are distinct, as is the numbering of the Articles, the Community and UK law relating to registered designs is substantively the same.
66. The key parts of Directive 98/71/EC for present purposes are as follows. Art 3(2) provides that a design will be protected by Community design right if it is new and has individual character. Novelty is defined in Art 4 and individual character in Art 5. To be new the design must not be identical to a prior design or different only in immaterial details (Art 4). A design has individual character if it produces a different overall impression on the informed user (Art 5 and Recital 13). This includes considering the design corpus, the nature of the product, the industrial sector to which it belongs and the degree of design freedom (Recital 13 and Art 5(2)).
67. The leading case in this area is **Samsung v Apple**. This was an infringement case but the relevant reasoning also applies to validity. At first instance in **Samsung** HHJ Birss QC (sitting as a High Court Judge) summarised many relevant principles: see [2012] EWHC 1882 (Pat) at paragraphs [31]-[59]. This summary was not criticised on appeal: see [2013] FSR 9. I will apply these principles, and I will refer to the relevant numbered paragraphs of the first instance **Samsung** decision.

*Generally*

68. First of all I remind myself that what really matters is what I can see with my own eyes, and that it is the overall impression which counts as opposed to a verbalised list of features: see **Samsung** at [31]-[32]. These points are repeatedly emphasised in all of the cases, as this passage from **Samsung** makes clear.
69. Secondly, although novelty was pleaded it was not pressed. This is a case about individual character.

*The informed user*

70. Next I have to identify the informed user: see **Samsung** at [33]-[35]. The parties agreed that this was a user of beer glasses, but thereafter their views diverged.

71. The Defendants submitted that the informed user included an end user such as a beer drinker; that a drinker would not consider differences in the curvature of a glass to be material; and hence the registered design was not novel. They relied on **Sphere Time v OHIM** [2011] ECDR 20, a decision of the General Court, as authority for the proposition that if one group of informed users perceived the Aspen registered design as producing the same overall impression as the prior art, then the Aspen design lacked individual character: see [54]-[56] thereof.
72. I note, however, that in **Sphere Time** itself it was not suggested that the perception of the designs in issue in that case was in fact any different between the two groups being considered. It follows that the comments made by the General Court in the passage identified were not necessary to their decision. Nor did the General Court explain any particular grounds upon which one group of informed users could have had a different opinion to another group of informed users considering exactly the same design.
73. The Claimant submitted that what was important was not the identification of the real-life person to whom the informed user was most closely approximate, but the fact that such person had knowledge of the existing design corpus and of the design features usually included in it.
74. I accept the Claimant's submission, which is supported by **Pepsi Co v Grupo Promer** [2012] FSR 5 at [59]; see also **Samsung** at [34]. I add that the informed user is also interested in the products concerned and shows a relatively high degree of attention when he uses them, and conducts a direct comparison of the designs in issue unless there are specific circumstances which make it impractical or uncommon to do so: see again **Samsung**, *ibid*. In at least some, and perhaps all, of these ways the informed user of design law – who is, after all, a legal construct - is unlike some, and perhaps many, beer drinkers in the real world.
75. Moreover I am not even sure that the factual premise of the Defendants' argument is correct. Some beer drinkers may pay little attention to the design of their beer glasses but as Mr Trusler explained brewers had been making substantial efforts since the mid-2000s to use their own designs of beer glasses as a means of attracting beer drinkers. As he put it, in evidence which was not challenged by the Defendants:
- “The aim has been to have a tall, iconic glass which would create more theatre at the point of dispense. I use ‘iconic’ because it is important for a company to have a unique and identifiable shape for its brand and, as large amounts of money are invested in developing a glass and its launch campaign, it has to be right first time and not leave consumers thinking it is just a copy of another glass already on the market. It is also relevant that at each major brand redesign a new glass will often be launched as part of the wider brand launch, possibly occurring every 2 to 4 years”.*
76. The Peroni, Amstel, and Carlsberg glasses are all real-world examples of brewers investing in their own designs of glasses in order to market their products to beer drinkers. So the proposition that no beer drinkers in the real

world are interested in design is too broadly stated. Some would be interested, even if others might not be.

*How much design freedom did the designer have?*

77. This topic was the other major dispute between the parties on validity. The relevant law is discussed in **Samsung** at [40]-[52], but as is apparent its application in any given case involves a mixture of law and fact.
78. The Claimant submitted that designers of tall, waisted beer glasses of the type at issue in these proceedings had only a limited degree of freedom. Hence it submitted that even minor differences were sufficient to confer individual character, although it accepted that the design itself might have only a limited scope of protection.
79. The Defendants submitted that designers of beer glasses had a wide degree of freedom, and that use of a tall, waisted shape was a mere convention not a restraint. Hence they submitted that only the first tall waisted beer glass would have had individual character, and that since the Claimant's design was not the first such design it was merely a variation of a theme which lacked individual character.
80. I accept the Claimant's argument. This is supported by **Samsung** at [48], and the cases cited therein. One of these cases is **Grupo Promer**, which also provides a useful illustration of the relevant principles in operation.
81. In **Grupo Promer** the General Court accepted that whilst the contested design related to the general category of promotional items, the designs were for "rappers" which consisted of small, flat or slightly curved discs made of plastic or metal. As a result the designer's freedom was "*severely restricted since he had to incorporate those common features in his design for the product in question*": see *ibid* at [66]-[70]. It went on to hold as follows:

*"72. In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer's degree of freedom in developing the contested design must be taken into account. ... the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.*

...

*82. In the absence of any specific constraint imposed on the designer, the similarities noted in [79]-[81] above relate to elements in respect of which the designer was free to develop the contested design. It follows that those similarities will attract the informed user's attention..."*

82. The Defendants relied upon **Kwang Yang Motor Co v OHIM** [2012] ECDR 2. In this case the General Court held at [33] as follows:

*33 Therefore, the greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the*

*designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user."*

83. There is no conflict between **Kwang Yang** and **Grupo Promer**. If the designer has a high degree of design freedom when creating his design, but his end result has only minor differences over the prior art, then the new design is less likely to produce a different overall impression than the prior art (because there is plenty of design freedom, and the differences are minor hence unlikely to be noticed). The converse also follows. If the designer had a low degree of design freedom, then minor differences become more important (because there is less design freedom in the first place, and the informed user is more likely to notice the differences). The same considerations then apply when one considers the issue of infringement. For instance if there is a lot of design freedom, then the presence of minor differences may not avoid infringement, but if there is not much design freedom then they may do.
84. In the present case, although the contested design relates to the general category of beer glasses, the actual design is plainly for a tall waisted beer glass and the designer's freedom was restricted by the constraints of this product. In particular it has to be tall, and it has to have a waist. The design freedom may not be quite as restricted as it was for the rappers in **Grupo Promer**, but the principle is the same. Minor differences may accordingly be sufficient to confer individual character on the Claimant's design, but by the same token minor differences might take the Defendants' product out of infringement.
85. In closing submissions the Defendants specifically identified the following as capable of being varied: *"the position of the waist up the glass, the proportions of the waist at the base, the proportions of the waist, the base on the rim, the contact points"*. (By *"proportions of the waist at the base"*, etc I understood them to mean *"the diameter of the waist in proportion to the diameter of the base"*, etc). I agree. These are the sorts of things which the designer can vary, within the overall constraint of a tall waisted beer glass. For the same reason, they are the sorts of differences which the informed user would notice.

*The overall impression produced by the Claimant's design*

86. I have already referred to feature 1(a) of the Claimant's design in the context of the UK unregistered design right claim, and I considered that with reference to the Claimant's design drawing. Now I have to consider the overall impression of the Claimant's design registration. This is a different legal question, being considered with reference to a different document.



87. The determination of what design is actually registered is a matter for the Court: see **Sealed Air v Sharpak** [2013] EWPC 23 at [20]. Once the design is identified, the questions of overall impression and so on are to be decided by reference to the informed user: *ibid*.
88. In this case there was a dispute as to what the registration actually showed. In particular, does it show any slight inward taper in the profile of the outer surface as one approaches the rim? There are several options: (a) it does not show any inward taper, and the widest point of the glass is at the rim; (b) it does show an inward taper, and the widest point of the glass is just below the rim; or (c) there is no inward taper, but a kink just below the rim, and the side of the glass then goes vertically upwards. Option (c) was the Defendants' preferred interpretation.
89. Figure 2, the top view of the glass, does not enable one to distinguish between options (a), (b), and (c). This is because although the outermost rings have very nearly the same diameter, this could either be because the Figure is representing the width of the rim itself or because it is showing that the widest point of the exterior of the glass is just beneath the rim. The innermost ring of Figure 2 is showing the waist, since this is the narrowest point of the interior. Figure 3 provides even less assistance.
90. It is difficult to tell from the registration whether the widest point of the glass is at the rim or just below it. On the left side of Figure 1 it looks like there is this inward taper. It is not so clear on the right side, but on balance I consider this is most likely a photocopying error, and that the right side is intended to represent a mirror image of the left side. On balance I therefore prefer option (b).
91. However nothing turns on this for two reasons. First, I do not consider that this inward taper forms part of the overall impression of this design, as I explain below. Secondly, even if it does form part of the overall impression then it only forms a small part thereof, and it was not suggested that this small part made any practical difference to either validity or infringement.
92. The overall impression of the Claimant's design is of a tall waisted glass, with a rim diameter that is wider than the base diameter, the waist being somewhere between  $\frac{1}{3}$  and  $\frac{1}{2}$  way up the glass, the side curving gently in from the base to the waist, then curving gently out again as one goes from the waist up to the rim, with the curve gradually approaching the vertical as one approaches the rim.
93. The precise location of the widest point does not form part of this overall impression because the inward tapering just below the rim is minimal, and would not strike the eye. The informed user might notice it in practice since it affects where adjacent glasses of the same design would touch each other. (This is the "contact point" mentioned above). However I was not convinced by the argument that this feature would for that reason be given particular attention by the informed user. Nor do the interior details of the design form any part of the overall impression either. The design does not even show any details of the interior of the glass, save for the mere presence of the waist as

shown in Figure 2 and I have already mentioned this since it is much more clearly shown in Figure 1. I therefore discount both the inward taper below the rim, and the interior of the glass, from now on.

*The overall impression produced by the existing design corpus*

94. I have also touched on the existing design corpus above, but that was for the different purpose of assessing whether feature 1(a) was commonplace under UK unregistered design right law. I now have to consider the overall impression produced by the existing design corpus taking into consideration the nature of the product and the degree of freedom of the designer in developing this design: see recital 13.
95. I start with the Peroni glass. The overall impression is of a tall waisted glass, with a rim diameter that is wider than the base diameter, the waist being narrow and located somewhere between 1/3 and 1/2 way up the glass, the side going in fairly sharply from the base to that narrow waist, and then having a cone-shaped profile as one goes from the waist up to the rim.
96. This verbal description of the overall impression already indicates some of the differences with the Claimant's design, such as the narrower waist and the cone-shaped profile above the waist. The Court is also required to conduct a direct comparison: see **Samsung** 34(v), citing **Pepsico**. Upon conducting such a direct comparison it is obvious that there are other differences too: for instance the shape is different in the region of the waist. The cone-shaped profile above the waist is the biggest single difference and this has a strong visual impact in itself. These differences are all of a type which the informed user would notice: see paragraph [85] above. Overall I am in no doubt that the Claimant's design has individual character over the Peroni design.
97. The other designs are further away so I will be briefer. The overall impression of the Amstel design is that it has a low and narrow waist, pronounced curvature around the region of the waist, and such curvature approaches the vertical from about 1/3 of the way down the vertical side of the glass. The overall impression of the Carlsberg design is that of single large radius curve, quite a fat waist judged relative to the base, and a conical upper region with the embossed letters "Carlsberg" running upwards from around the waist. The Claimant said that the Carlsberg glass looked like a flower vase and I agree. The Claimant's design has individual character over each of these designs as well.
98. I have used different wording to describe my assessment of the designs in this section as compared to the wording which I used in relation to the feature relied upon for purposes of UK unregistered design right, but this is because the nature of the exercise is different. There is no inconsistency. In any event the wording is simply trying to encapsulate what is apparent to the eye.
99. I find that the Registered Design is new and has individual character.

D(i) Whether the Defendants' Aspire glass infringes the Vessel Designs or either of them

*Legal context*

100. The Claimant relied upon both primary and secondary infringement. It did not explain what the allegation of secondary infringement added and I shall focus on primary infringement under s 226 of the 1988 Act.
101. The correct approach in law is not in doubt. Whether or not the alleged infringing article is made substantially to the Claimant's design must be an objective test to be decided through the eyes of the person to whom the design is directed: see Aldous J in **C & H Engineering v F. Klucznik & Sons Ltd** [1992] FSR 421 at 428. The test is different from copyright infringement and regard has to be had to the overall design which enjoys design right: see Arden LJ in **L Woolley Jewellers v A&A Jewellery** [2003] FSR 15 at [19].

*Analysis*

102. The only feature which I have not already discounted is feature 1(a), so that it is the only one which needs to be considered for purposes of infringement. Copying is admitted.
103. I do not find this a difficult question. Whether or not one takes the inward taper just below the rim into account, the outer profile of the Defendants' glass is plainly made substantially to the design of feature 1(a). The Defendants' non-infringement arguments relied on the difference in the design of the interior of the Defendants' glass, but this is irrelevant to feature 1(a).

D(ii) Whether the Defendants' Aspire glass infringes the Registered Design.

*Legal context*

104. Infringement is governed by Art 9 of the Directive. This provides as follows:
1. *The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.*
  2. *In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.*
105. I have already dealt with the informed user and the degree of freedom of the designer above.

*Analysis*

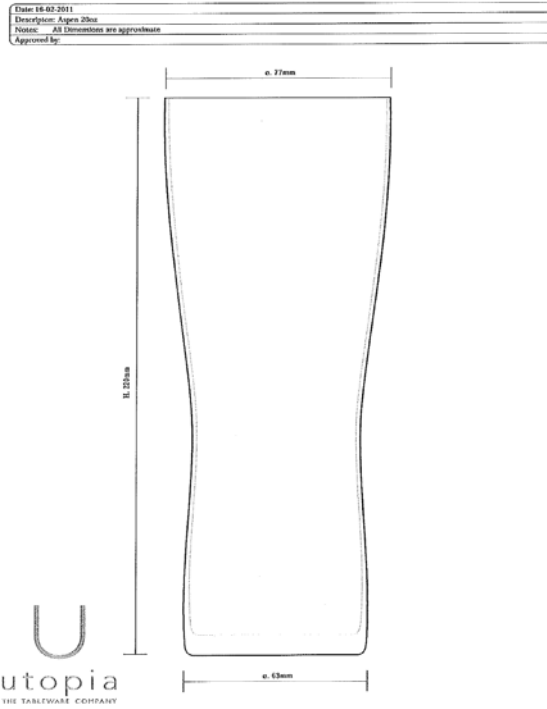
106. As noted above the Defendants admitted that the design of their Aspire product does not produce on the informed user a different overall impression from the Claimant's registered design "*only insofar as the exterior shape thereof is concerned*". I do not understand the significance of the qualifier. The Defendants either admit infringement of the design as registered or they do not. I shall assume for the moment that it is not admitted.

107. The overall impression of the Defendants' design is that of a tall waisted glass, with a rim diameter that is wider than the base diameter, the waist being somewhere between  $\frac{1}{3}$  and  $\frac{1}{2}$  way up the glass, the side curving gently in from the base to the waist, then curving gently out again as one goes from the waist up to the rim, with the curve gradually approaching the vertical as one approaches the rim.
108. As my choice of wording indicates, and as a visual comparison with the Claimant's design as registered confirms, the overall impression of the Defendants' design is the same as that of the Claimant's design. The Defendants' product is made of a different material, but the Claimant's design does not specify any particular material and in any event this makes no difference to the overall visual impression of the Defendants' design. Hence the effect of the Defendants' qualified admission does not matter.
109. Accordingly, even though the Claimant's design has a narrow scope of protection the Defendants' product infringes that narrow scope. Indeed not only is the prior art relied upon all further away from the Claimant's design than is the Defendants' product, but the prior art provides a good illustration of what can be done with the limited design freedom available to those wishing to produce tall waisted beer glasses.

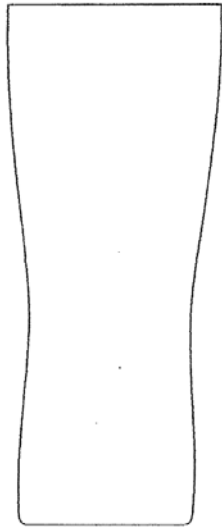
### **Conclusion**

110. UK unregistered design right subsists in feature 1(a) of the Claimant's Aspen design, is owned by the Claimant, and has been infringed in relation to the Defendants' Aspire product. The Claimant's registered design is also valid, owned by the Claimant, and infringed.

Annex 1 – the Claimant’s main design drawing



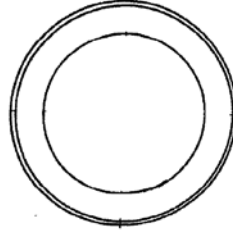
Annex 2 – the Claimant’s UK design registration



Side elevation

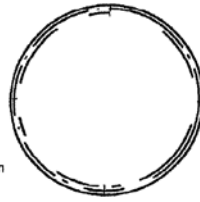
**Fig. 1**

Top Plan



**Fig. 2**

Underneath Plan



**Fig. 3**

Annex 3 – Both side's commercial products.



The Claimant's product is on the left, and the Defendants' is that on the right.

Annex 4 – Aspen and Peroni designs; Aspen and Amstel designs; Carlsberg design



ASPEN AND PERONI



ASPEN AND AMSTEL





CARLSBERG