



Neutral Citation Number: [2020] EWHC 3391 (IPEC)

Case No: IP-2019-000084

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF
ENGLAND AND WALES
INTELLECTUAL PROPERTY (Ch)
INTELLECTUAL PROPERTY ENTERPRISE COURT
COMMUNITY DESIGN COURT

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 16 December 2020

Before:

MR DAVID STONE
(Sitting as a Deputy High Court Judge)

Between:

ROTHY'S INC
(a company incorporated under the laws of Delaware, USA)

Claimant

- and -

GIESSWEIN WALKWAREN AG
(a company incorporated under the laws of the Republic of Austria)

Defendant

MS LINDSAY LANE QC (instructed by **BIRD & BIRD LLP**) for the Claimant
MR THOMAS JONES (instructed by **STOBBS IP**) for the Defendant

Hearing dates: 16 and 17 November 2020 remotely via Skype for Business

Covid-19 Protocol: This judgment was handed down by the judge remotely by circulation to the parties' representatives by email and release to Bailii. The date of hand-down is deemed to be as shown above.

Approved Judgment

DAVID STONE (sitting as a Deputy High Court Judge):

1. Women's shoes known as "ballet flats" or "ballerinas" have been popular since at least the 1950s. They come in many variations – with differently shaped toes, different heel heights, and many types of materials. On 24 November 2017, the Claimant, Rothy's Inc, a California-based company, launched its **Pointed Loafer** shoe. The Pointed Loafer is a type of ballerina shoe with, as the name suggests, a pointed toe and a protruding tongue that gives the appearance of a loafer. The Pointed Loafer is shown here:



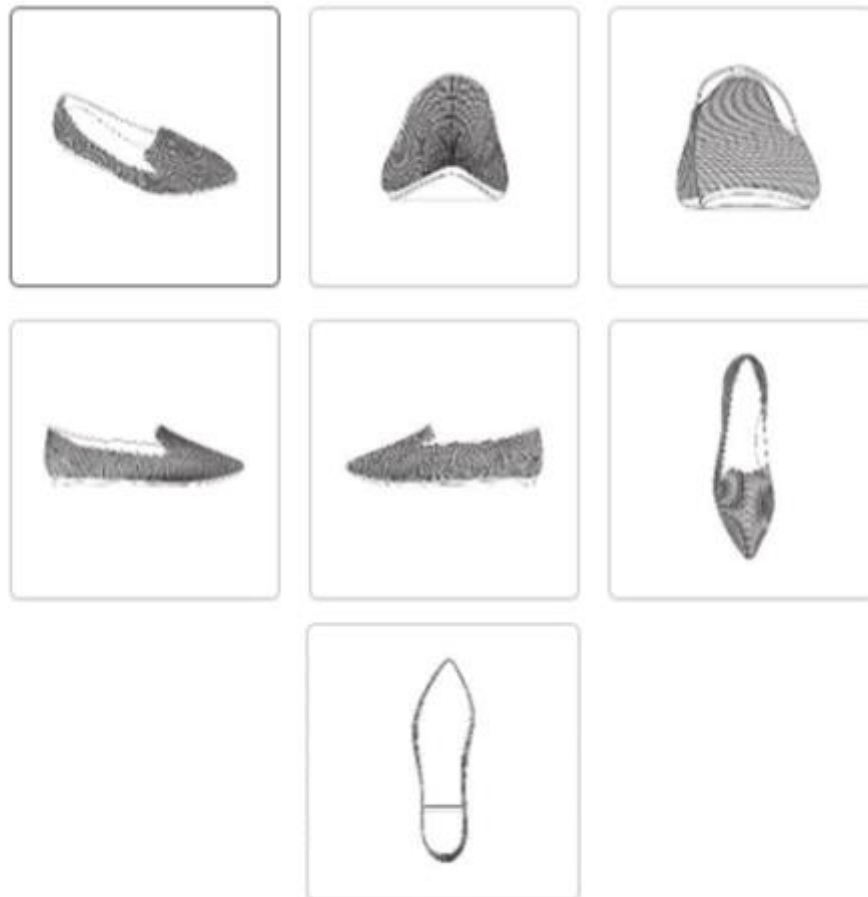
2. The Pointed Loafer had been preceded to market by two of the Claimant's other shoes, known as The Flat and The Point. It was common ground between the parties that The Flat and The Point were the first ballerina shoes to be made of knitted yarn made from recycled plastic. Gym shoes had previously been made from heavy knitted yarn, including yarn made from recycled plastic, but not ballerina shoes.
3. In or about April 2019, the Defendant, Austrian shoe company Giesswein Walkwaren AG, began marketing through its website a range of ballerina shoes the upper parts of which were in a knitted meshwork fabric made from recycled plastic. Relevantly, those shoes included the **Pointy Flat**, shown here:



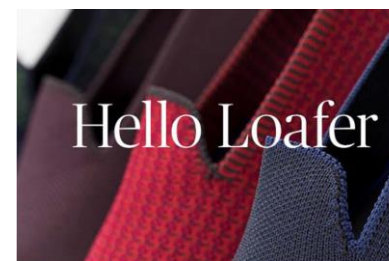
4. On 23 July 2019, the Claimant issued these proceedings, alleging that the Pointy Flat infringed two of the Claimant's EU-wide design rights:
 - (a) registered Community design 4500932-0002 filed on 9 November 2017 and registered later that day (the **RCD**). The RCD lists "shoes" as the product to which the design is to be applied, and claims priority from United States design patent 29/603,576 filed on 10 May 2017; and

(b) unregistered Community design right in the design of the Pointed Loafer as first disclosed in the European Union on 24 November 2017 (the **UCD**).

5. The RCD includes seven views (the maximum currently allowed by the registering authority, the European Intellectual Property Office (the **EUIPO**)):



6. The UCD arises from the disclosure of images of the Pointed Loafer on the Claimant's website, in emails sent to people based in the European Union and on various social media sites including Facebook and Instagram. These images show the Pointed Loafer shoe in various colourways. Some of those images are excerpted below:



We made something special for you this Black Friday. Say hello to our Limited Edition Loafer—just in time for the holidays.

7. The Defendant has counterclaimed for invalidity of the RCD and the UCD on the basis of two prior designs (together, the **Prior Designs**):

(a) the **Allegra K** shoe shown here:



(b) and the **Bonnibel** shoe shown here:



8. I was provided with samples of the Pointed Loafer, the Pointy Flat and the Allegra K. The Bonnibel was in evidence through photographs only.

9. At the remote trial of this matter on 16 and 17 November 2020, Ms Lindsay Lane QC appeared for the Claimant and Mr Thomas Jones appeared for the Defendant. The Court sat as a Community Design Court, that is, as one of the national courts designated to hear EU design matters under Article 80 of Council Regulation (EC) 6/2002 of 12 December 2001 on Community designs (the **Regulation**). As things currently stand, this Court will be unable to sit as a Community Design Court after 11pm UK time on 31 December 2020, given the current end date to the transition period following the UK's departure from the European Union. I was therefore urged by the Claimant to hand down this judgment in sufficient time to enable a form of order hearing to be held prior to 31 December 2020. This judgment has therefore been prepared at speed in an attempt to accommodate that request.

List of Issues

10. As is usual in the IPEC, the list of issues for determination at trial was annexed to the order of HHJ Hacon of 4 March 2020 (I have substituted the defined terms I have already set out above):

“Design Corpus

1. The state of the design corpus as at 10 May 2017.

Registered design

2. Whether the RCD produces on the informed user a different overall impression from that produced by any of the designs of the Allegra K or Bonnibel.
3. Whether the Pointy Flat produces on the informed user the same overall impression as is produced by the RCD.

Unregistered Design

4. Whether the UCD was made available to the public within the Community by reason of the acts identified at paragraph 6 of the Particulars of Claim [that is, the publication on the Claimant’s website, the emails, and the social media posts].
 5. Whether any subsisting rights in the UCD are the property of the Claimant.
 6. Whether the UCD produces on the informed user a different overall impression from that produced by any of the designs of the Allegra K or Bonnibel.
 7. Whether the Pointy Flat is an article which has been made by copying the UCD.
 8. Whether the Pointy Flat produces on the informed user the same overall impression as is produced by the UCD.”
11. The Defendant conceded issues 4 and 5.
 12. I add for completeness that validity of the RCD was to be assessed as at its priority date (10 May 2017), and validity of the UCD as at the date of the launch of the Pointed Loafer (24 November 2017). The parties agreed between them that nothing happened between those two dates that made a difference, and so I say no more about it, but rather adopt the expression **Relevant Date**.

The Witnesses

13. By permission of HHJ Hacon, the Claimant adduced evidence from two witnesses of fact, and a single expert witness. All three were cross-examined remotely.

William Martin

14. William Roth Martin is Co-Founder and Chief Creative Offer of the Claimant. He gave evidence as to the founding of the Claimant, the design and marketing of The Flat, The Point, the Pointed Loafer, and another shoe launched at the same time as the Pointed Loafer called **The Loafer**.
15. He also gave evidence of the purchase by Markus Giesswein, Chief Executive Officer of the Defendant, of various of the Claimant’s shoes, including one pair each of The Point, The Flat and The Loafer, in different colours and sizes on 19 July 2018, and a further 13 pairs of shoes on 27 December 2018, including The Flat, The Loafer and The Point.

16. Further, he gave evidence as to the availability online of images of the Pointed Loafer since 24 November 2017, including on the Claimant's website, but also on Facebook, Instagram, and through the "Wayback Machine" at www.archive.org.

Steve Black

17. Steve Black is a freelance consultant footwear developer and product technician, who, between May 2018 and March 2019, worked for Innolux Group Asia Limited (**Innolux**) in Hoi Chi Minh City, Vietnam. In that role, he was involved in the manufacture of the Defendant's Pointy Flat. He gave evidence of the general process for sampling and prototyping at Innolux, as well as the production of the Defendant's ballerina shoe range. In his role at Innolux, he was provided with three shoes purchased by Markus Giesswein from the Claimant: The Flat, The Point and The Loafer. Mr Black had retained images of various shoes and prototypes, even after ceasing his role at Innolux.
18. No permission had been given at the CMC for Mr Black's evidence. However, the parties agreed between them that that could be "cured" by consent, and an application for the Court's permission was lodged. Later, the parties also consented to the Defendant's being permitted to provide a further witness statement in response. Orders were therefore made by consent, and that course was adopted. In the end, Mr Black accepted in cross-examination that he was not involved in the design process for the Defendant's Pointy Flat, so he was unable to help the Court determine whether the Defendant had copied the Pointed Loafer.
19. No criticism was made of the ways in which Mr Martin and Mr Black gave their evidence. I accept that they were clear and honest witnesses, trying to assist the court.

Markus Herman Giesswein

20. Markus Giesswein is the Chief Executive Officer of the Defendant, a role he has held since 1 July 2017. Markus Giesswein's native language is German, although he gave his oral and written testimony in English.
21. He gave evidence of the founding of the Defendant by his grandparents in 1954. The Defendant, he said, had started manufacturing ballerina shoes from cotton in 1998, and from knitted wool in 2003. He gave evidence as to the Defendant's relationship with Innolux, the design process for the Defendant's Pointy Flat shoe, and the roles in that process of:
- (a) his brother, Johannes Giesswein, the Defendant's Head of Development;
 - (b) Adi Zuk, a freelance shoe designer; and
 - (c) Roy Jahoda from Innolux.
22. To distinguish Markus and Johannes Giesswein, I use their first names throughout, without intending any disrespect.
23. Counsel for the Claimant submitted that Markus Giesswein gave both his written and oral evidence "trying to put the best possible spin on things for [the Defendant]". Further, it was submitted that his written witness statement had not addressed all the meetings and documents which it later emerged had taken place. Counsel for the Defendant submitted that this was an unfair criticism particularly in the context of the IPEC where matters are to be dealt with proportionately. I agree. I found Markus Giesswein to be an honest and reliable witness who gave his evidence in a straightforward manner. There are some specifics of Markus Giesswein's evidence in relation to copying to which I return below.

Adi Zuk

24. Adi Zuk is a freelance shoe designer. She is an Israeli national and lives in Italy, and gave her written and oral testimony in English even though it is not her first language. Her evidence outlined her 25 years' experience in shoe design (albeit she was not put forward as an expert witness), and the design process for the Defendant's Pointy Flat shoe.
25. Ms Zuk provided a second witness statement to respond to Mr Black's witness statement, the thrust of which was that Mr Black was not involved in the design process for the Pointy Flat shoe.
26. Counsel for the Claimant criticised Ms Zuk for "not engaging with the [litigation] process", whilst suggesting that this may not have been entirely her fault. It was submitted that she did not give her own full account of the design process of the Pointy Flat shoe, but rather referred to and relied on the evidence given by Markus Giesswein. Again, I consider this criticism to be unfair. Ms Zuk answered the questions put to her to the best of her ability. She did not take kindly to the accusation that she had copied the Pointed Loafer, but to my mind that was no more than to be expected of a designer accused of copying. I reject counsel for the Claimant's submission that there is not "an awful lot" I can take from Ms Zuk's evidence. I found her to be an honest witness, trying to assist the court. I return below to some specifics of Ms Zuk's evidence in relation to copying.

Experts

27. Earlier this year, the solicitors for the Defendant wrote to the Claimant's solicitors in the following terms:

"Expert Evidence: we do not consider that this is a case in which expert evidence is necessary or proportionate. The Court is asked to make visual inspection of designs of consumer goods. We do not agree that the Court would be assisted in that exercise by expert evidence."
28. The Claimant's solicitors responded, insisting on expert evidence, noting:

"An IPEC judge, and particularly a male judge, is very likely to need to be informed of the aesthetic context in which such articles fall to be considered."
29. At the CMC before HHJ Hacon, the Defendant's advocate is recorded in a letter from the Claimant's solicitors to have said this:

"Second, there is a dispute as to the extent to which expert evidence should be permitted. The parties agree that expert evidence should be permitted to address the design corpus – to assist the court to orient itself in the state of the design field in question at the relevant time. However, the Claimant goes further. Its position is that the court will be assisted by experts submitting reports and being cross-examined on their views as to the ultimate questions for the court – opining upon whether the claimed designs create a different overall impression to the prior art and whether the alleged infringement likewise creates a different overall impression to the designs."

...limited expert evidence may be instructive are either agreed to be appropriate for limited expert evidence (design corpus) or not in issue (design freedom). What is not agreed is ranging expert evidence on questions of visual comparison – on overall impression and individual character.

The evidence should be tightly controlled in IPEC and allowing expert evidence on issues 2, 3, 6 and 8 is the antithesis of that. The Claimant's approach has all the hallmarks of a party thinking that evidence is required on every point in dispute between the parties. This has been specifically deprecated in design right cases. It is no more the right approach to this case than it is generally in design right cases."

30. By order of HHJ Hacon of 10 March 2020, the parties were given permission to adduce evidence from a single expert each. The relevant order read:

"Each party may rely on an expert witness's report dealing with Issue 1 identified in the Schedule to this Order. Any such expert's report may comment upon the reasons why a design feature relied upon is or is not found in the design corpus."

31. As noted above, Issue 1 was:

"The state of the design corpus as at 10 May 2017."

32. Neither party complied with His Honour's order. Whilst each provided a single witness statement from a single expert, both of those witness statements travel beyond commenting on the state of the design corpus as at 10 May 2017. It should be recalled that 10 May 2017 was the priority date of the United States design patent application – and at that time, neither the Claimant's Pointed Loafer nor the Defendant's Pointy Flat had been launched in the European Union.

33. Correspondence ensued between the parties, each alleging that the other side's expert's witness statement was inadmissible. The Claimant issued an application notice asking for parts of the Defendant's expert report to be struck out, or as an alternative that the Claimant be permitted to reply to it. The Defendant resisted the application, but stated that the Defendant did not object to the Claimant filing additional evidence. Thus, a further consent order was made by HHJ Hacon, and a further witness statement was filed by the Claimant.

34. The Court of Appeal has been clear, on a number of occasions, about the role of expert evidence in registered design cases. A Jacob LJ said in *Procter & Gamble v Reckitt Benckiser* [2007] EWCA Civ 936 (*P&G*) at paragraphs 4 to 6:

"... The evidence of experts, particularly about consumer products, is unlikely to be of much assistance: anyone can point out similarities and differences, though an educated eye can sometimes help a bit. Sometimes there may be a piece of technical evidence which is relevant – eg that design freedom is limited by certain constraints. But even so, that is usually more or less self-evident and certainly unlikely to be controversial to the point of a need to cross-examination still less substantial cross-examination.

5. In *Thermos v Aladdin* [2000] FSR 402 at 404 I said:

"Most registered designs are for consumer articles, objects bought or to be appreciated by ordinary members of the public. I observed in *Isaac Oren v. Red Box Toy Factory Ltd* [1999] FSR 785, at 791, that:

“I do not think, generally speaking that, ‘expert’ evidence of this opinion sort, (*i.e.* as to what an ordinary consumer would see) in cases involving registered designs for consumer products is ever likely to be useful. There is a feeling amongst lawyers that one must always have an expert, but this is not so. No-one should feel that their case might be disadvantaged by not having an expert in an area when expert evidence is unnecessary. Evidence of technical or factual matters, as opposed to consumer 'eye appeal' may, on the other hand, sometimes have a part to play--that would be to give the court information or understanding which it could not provide itself.”

This case was started before the new Civil Procedure Rules came into effect. Leave was given to each side to call expert evidence by an order of April 15, 1999. The spirit and effect of the new Rules require the court to look even more closely at the need for expert evidence. In future in registered design actions, I think the court should take care before allowing any expert evidence. In particular, the court should know precisely to what areas that expert evidence will be directed. If blanket permission is given, each side feels compelled to get an expert who then has to say something. What is then said has to be read by the other side. Thereby time and cost to no particular use is expended.

It was suggested to me that an expert might be able to assist the court about technical matters in this case, such as the fact that the I-beam type of construction used in the handles of the flasks has a function. But this is so obvious that one hardly needs an expert, and certainly one does not need two experts. The expert evidence in this case was completely redundant.

As to factual evidence, again it is clear that there is a temptation, bordering on the compelling, to overdo things. Much the most important matters in a registered design action are what the various designs look like. Everything else is secondary. It is, for instance, clear law that whether or not the defendant copied is irrelevant; see, for example, *per* Aldous J in *Gaskell & Chambers Ltd v Measure Master Ltd* [1993] RPC 76, 81. So it is irrelevant for the claimants' witness to throw down a challenge that he thought the defendant copied, as was done here, and it is equally irrelevant for the defendant to prove or to give disclosure about how his design was arrived at.

Similarly, it is irrelevant for the claimant to prove, if it be the case, that he spent a fortune in arriving at his design. It matters not whether he thought of it in the bath or by engaging the most prestigious design consultants in the world.

One area of evidence which I think is admissible, and is of some secondary assistance, is the reaction of the public and trade (who expect to sell to the public) to the design.”

6. *Thermos* was decided in relation to the then UK domestic law of registered designs. This case is the first to reach this Court concerning a Community Design Registration ("CDR") granted pursuant to Council Regulation EC

6/2002 ("the Regulation"). But everything I said then applies also to actions about CDRs too."

35. In this case, it was common ground that there were no relevant restraints on design freedom and no elements of the designs were said to be solely dictated by technical function. Both parties conceded that interpretation of the RCD was a matter for the Court, as was the identity of the informed user, and the overall impression produced on the informed user by the various designs and shoes. Shoes are basic household items, with which all people have day-to-day experience. Reading the experts' reports helped me to "don the spectacles" of the informed user. However, that could readily and more cost-effectively have been achieved by an agreed, brief primer along the lines of the section I have set out below headed Shoe Design.
36. Having heard submissions from counsel for both parties during the trial, I said that I would not formally exclude any of the experts' evidence, but that that did not mean that I would give it any weight. As counsel for the Defendant put it, the Court "should place no weight on anything that goes to comment on infringement or validity or comparison of the designs in the way that Jacob LJ said is not going to be helpful". I agree. I have therefore admitted the evidence of the experts as to the state of the design corpus as at 10 May 2017 (which was almost entirely agreed), but in relation to the issues that are for determination by the Court, I do not consider myself bound by the expert evidence: I have given it no weight. Significant costs and court time could have been saved had that evidence not been adduced. I return to this issue below.
37. The statement of Jacob LJ above is clear. Litigants would do well to keep it in mind, particularly litigants in the IPEC, where costs capping applies and proportionality is a guiding principle.
38. There is a further point. On the first day of the two-day trial, counsel for the parties asked the Court to sit early, late, and through half of lunch in order to complete the evidence. The Court sat for an extra two hours on top of a usual sitting day of 5 hours. When parties agree to take advantage of the IPEC costs cap, they thereby agree to fit their case within the IPEC case limits. They must therefore trim their sails to ensure that the case can be determined within the allocated time. In this case, that could readily have been achieved, including by not cross-examining the experts. This is no criticism of the experts who gave of their time to assist the Court.

Valerie Hawkins

39. The Claimant's expert, Valerie Hawkins, is a freelance footwear designer, who has worked with and for a large number of footwear brands. She was suitably qualified to act as an expert witness in this case, albeit that she had never given expert evidence previously.
40. Ms Hawkins' first witness statement set out a helpful section on terminology and "anatomy" of a ballerina shoe, much of which I have excerpted below. She then identified a number of different shapes of ballerina shoe, giving examples of each. She discussed in more detail the features of ballerina shoes as she identified them. She also set out a detailed examination of materials, again, with multiple examples. She concluded with a review of the claimed features of the Claimant's designs and her assessment of whether they were "normal features of shoes in the sector concerned".
41. Ms Hawkins' second witness statement responded to Ms Wright's expert's report. Here, Ms Hawkins disagreed with the approach adopted by Ms Wright, and then set out her comments on Ms Wright's assessment of the differences between the Pointed Loafer and the Pointy Flat, as well as between the Pointed Loafer and two prior designs relied on by the Defendant for its invalidity claims. These are all matters which the Court can readily see for itself.

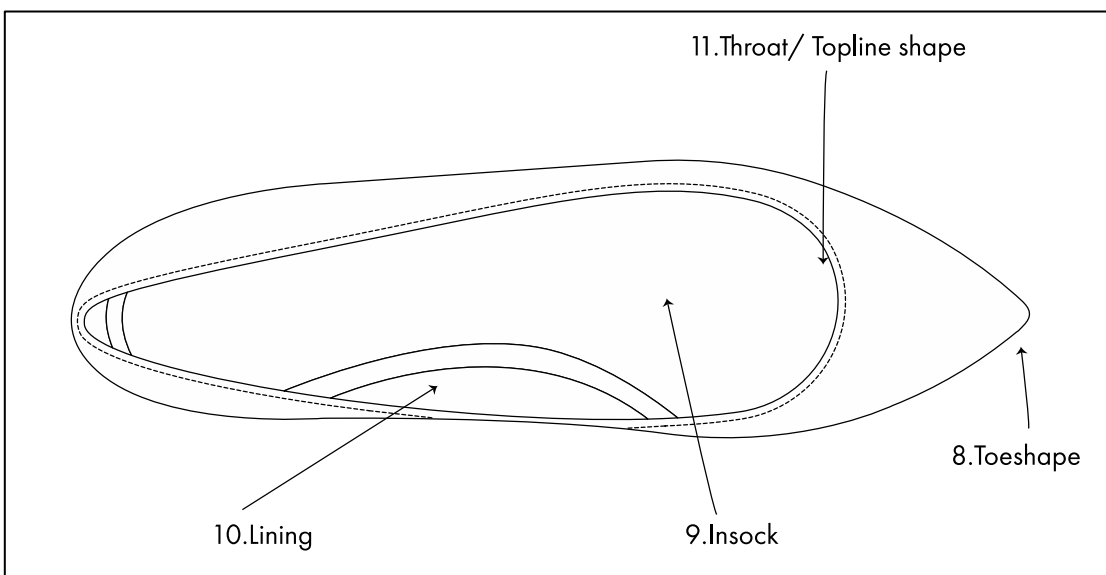
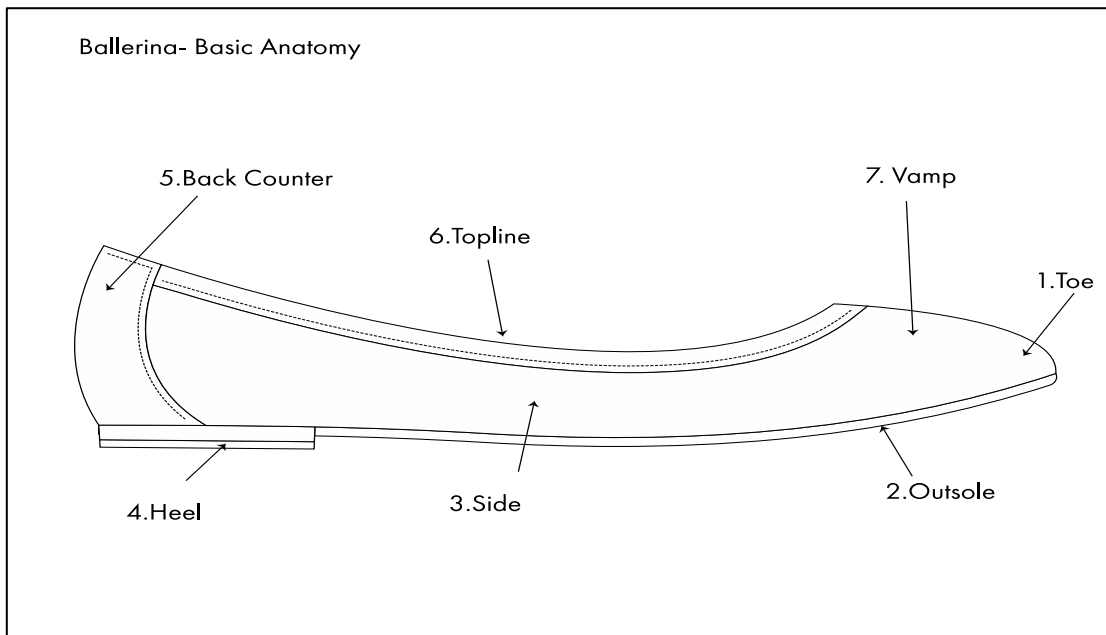
42. There was no criticism of the way in which Ms Hawkins gave her evidence, and I accept that she gave her evidence honestly. She was asked to give evidence on matters which went beyond what was necessary or proportionate for the determination of the case, but that is no criticism of her.

Rosemary Wells Wright

43. Rosemary Wright is the owner of Antoinette Designs, an international design consultancy studio which she founded in 1973. She is the third generation of her family involved in the shoe industry, through which work she has amassed a large archive of footwear-related paraphernalia, including catalogues, books, magazine, photographs, prototypes, lasts, components and materials. She considers that she has one of the largest archives of private reference data on footwear design and materials in the world. Section 1 of Ms Wright's witness statement set out her report on the design corpus as at 10 May 2017 in 10 numbered paragraphs. Section 2 of her witness statement (39 paragraphs) was her "commentary on the design features of the Rothy's Unregistered Design and explanation of design terms". Section 3 undertook the same task in relation to the RCD (15 paragraphs). She concluded with what she considered to be the most distinctive features of the two claimed designs. Ms Wright (through no fault of her own) did not have examples of the actual shoes when she prepared her report.
44. Counsel for the Claimant suggested that Ms Wright occasionally acted as an advocate rather than as an expert, it was suggested, because she has been used as an expert in many sets of proceedings in the past 10 years (a list of her many expert engagements was annexed to her witness statement). There is some force to that criticism, but I consider that issue to stem more from the questions Ms Wright was asked to consider (which are ultimately questions for the Court) than from any issue either with Ms Wright's suitability or manner. I also reject criticisms that Ms Wright was not up to date with the design corpus on account of her expert evidence work: clearly, her report dealt with designs up to the Relevant Date. I consider that Ms Wright was doing her best to assist the Court – it was not her fault that she was asked to give evidence about issues which were for the Court.

Shoe Design

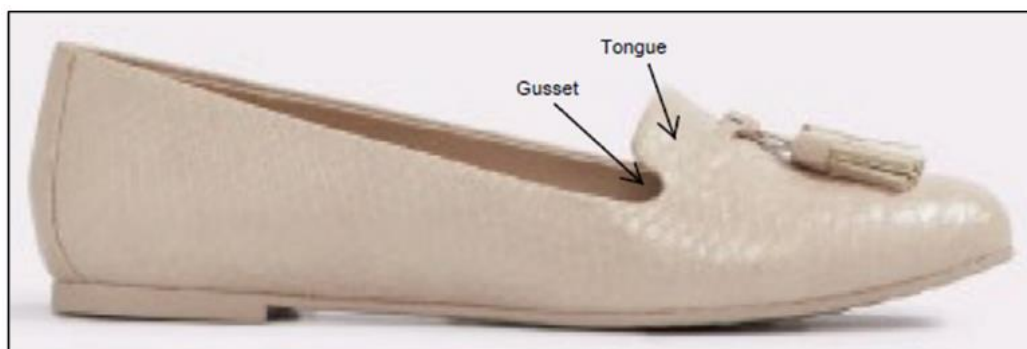
45. My analysis below of the overall impression produced by various designs and shoes on the informed user adopts some language which may be unfamiliar to the casual observer of shoes. So that the parts of the designs/shoes being referred to are clear, I set out the following paragraphs, largely taken from Ms Hawkins' expert's report. She and Ms Wright were largely agreed, and the small disagreements in nomenclature were clarified during the trial as not being differences in substance. What follows, the experts agreed, would have been known to the informed user at the Relevant Date. I have used the information below, and the very many shoes shown in the evidence, to don the spectacles of the informed user in order to undertake the assessments required of the Court.
46. Ballerina shoes, also known as ballet flats, ballet pumps and sometimes flats take their inspiration from dance shoes worn by female ballet dancers. They have been a popular shoe for many years. The term "ballerina" is widely understood to refer to a style of informal, women's slip-on shoe, with a relatively thin, flexible sole and a wide, low heel. Ballerina shoes are a versatile shoe for everyday wear, suitable for a variety of settings.
47. Ballerina shoes consist of an upper part and a sole. The upper part covers or partially covers the top, sides and back of the foot. The silhouette of a shoe refers to its overall shape (usually viewed from the side). Ms Hawkins provided the following diagrams, along with an explanation of the key features of a ballerina shoe.



- | | |
|-----------------|--|
| 1. Toe | <i>The front part of a shoe that surrounds the toes of the foot.</i> |
| <hr/> | |
| 2. Outsole | <i>The bottom part of a shoe, which touches the ground.</i> |
| <hr/> | |
| 3. Side | <i>The side part of the shoe's upper, extending backwards from the vamp. Also referred to as "side quarter" by designers.</i> |
| <hr/> | |
| 4. Heel | <i>The part of the sole that sits below the heel of the foot. A heel may be raised or flat, and may be part of the same piece as the rest of the sole or a separate piece.</i> |
| <hr/> | |
| 5. Back Counter | <i>The rear part of the shoe, which covers the heel of the foot. Also known as simply "Counter".</i> |

- | | |
|-------------|--|
| 6. Topline | <i>The top edge of the upper, which runs all the way around the shoe.</i> |
| 7. Vamp | <i>The part of the upper that covers the front of the foot, from the toe backwards.</i> |
| 8. Toeshape | <i>The shape of the upper across the line of the toes.</i> |
| 9. Insock | <i>A layer of material inside the shoe, which rests in contact with the foot. There may additionally be an insole to provide additional fit and/or cushioning.</i> |
| 10. Lining | <i>The material used to line the inside of the upper</i> |
| 11. Throat | <i>The opening across the toe, defined by the shape of the topline at the vamp.</i> |

48. The slipper cut ballerina shoe is the modern version of the classic smoking slipper (Ms Wright described it as an Albert cut, after HRH Prince Albert of Saxe-Coburg and Gotha). It is characterised by a slipper cut topline shape, with a longer vamp covering more of the foot. The side gussets create a tongue which covers the front portion of the foot. An example of a slipper cut ballerina shoe is shown here:



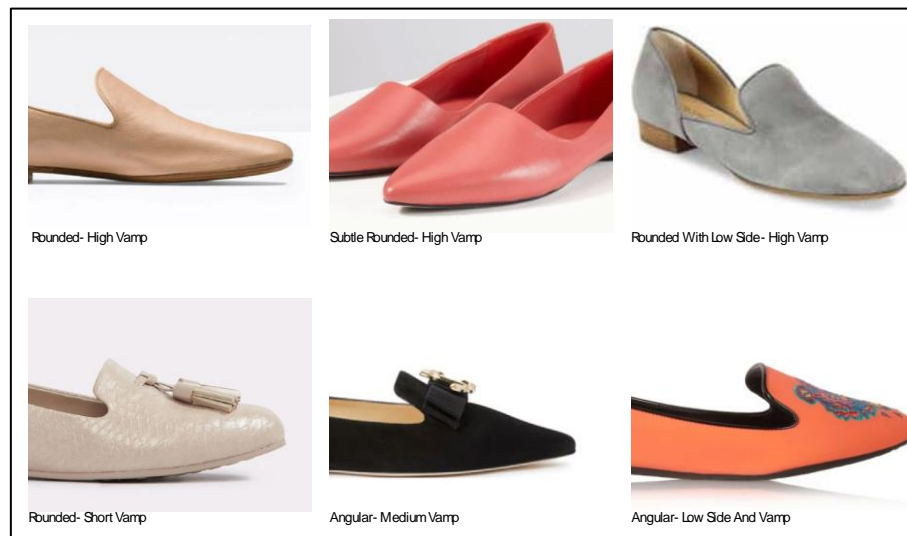
49. Some important characteristics of ballerina shoes include:

- (a) toe shape: toe shapes can be pointed, square, round or almond shaped. Pointed toes also differ, with sharper and more rounded points. Ms Hawkins gave the following examples of different pointed toes;



- (b) heel height: although ballerinas are flat shoes, there can be variation in heel height from no heel to approximately 15mm;
- (c) outsole profile: there can be a wide variation of the shape of the heel step, contributing to what is known as the outsole profile, which can be angled, rounded, sloped or curved;
- (d) topline shape: this is the top edge of the upper, which can vary greatly, including long, standard, shaped, angular, asymmetric and scoop styles;

- (e) vamp: the vamp which covers the toes and the top of the foot can vary in length, with a longer vamp coming further up the foot. Ms Hawkins gave the following examples;



- (f) tongue (also called a tab or integral tab): as the examples immediately above show, slipper cut ballerina shoes have a tongue across the topline of the vamp. The main features of the tongue are shape and length. On either side of the tongue are gussets, referred to as gussets;
- (g) back counter: the shapes across the back of a ballerina shoe can be relatively more round or more square. The seam attaching the counter to the upper can also vary in prominence;
- (h) topline or edge finish (Ms Wright calls this “binding”): variation in the edge finish can be dictated by the material used for the upper (needed with some materials to prevent fraying). The topline finish can also have a decorative aspect, and/or be in a contrasting colour or material to the rest of the upper;
- (i) trim: ballerina shoes can be trimmed with buckles, tassels, bows, and other types of decorations; and
- (j) last shape: a last is the wooden or plastic foot-like shape on which a shoe is created. The last gives the shoe its overall shape.

50. In addition to those aspects of shape, ballerina shoes come in many types of materials, including:

- (a) leather, including pigmented coated; aniline or semi-aniline; metallic coated; embossed; and patent leather;
- (b) suede, metallic and embossed suede (suede is the flesh-side of the leather, rather than the outer side which is used for traditional leather);
- (c) nubuck (whilst nubuck can look like suede, it is the outer side of the leather, but abraded to create a textured surface);
- (d) animal hide or leather with the animal hair still present (either natural or printed);
- (e) woven or braided leather;

- (f) perforated leather;
 - (g) canvas; satin; nylon; velvet; and gros-grain;
 - (h) glitter fabric; lurex and sequined fabric; and
 - (i) mesh, being material with holes in it, achieved by punching, perforating or knitting.
51. Materials not usually used for ballerina shoes, but used for other types of shoes, include knitted polyester; woven flat elastic ribbon; and neoprene.
52. It was common ground between the parties that, prior to the Claimant's launch of The Flat and The Loafer, there were no ballerina shoes made of knitted heavy yarn. Ms Hawkins was unaware of any, as was Ms Wright, who also could not find any in her substantial archive. Both experts accepted that different materials would give very different looks to ballerina shoes, and counsel for the Defendant accepted this in his closing speech.

The RCD

53. In *PMS International Group plc v Magmatic Limited* [2016] UKSC 12 (*Trunki*), Lord Neuberger PSC (with whom Lord Sumption, Lord Carnwath, Lord Hughes and Lord Hodge agreed) approved (at paragraph 10) the pithy summary of Jacob LJ (with whom Dyson and May LJ agreed) in *P&G* at paragraph 3:

“The most important things in a case about registered designs are:

- i) The registered design;
- ii) The accused object;
- iii) The prior art.

And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has “individual character” or what the “overall impression produced on an informed user” is. But “it takes longer to say than to see” as I observed in *Philips v Remington* [1998] RPC 283 at 318. And words themselves are often insufficiently precise on their own.”

Interpreting the RCD

54. There was an issue between the parties as to what the images in the RCD show, and therefore, what is “claimed” as part of the protected design. As Lord Neuberger said in *Trunki* at paragraph 30:

“when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.”

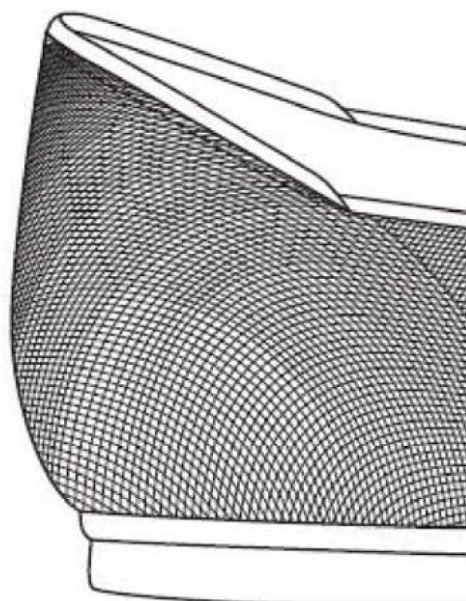
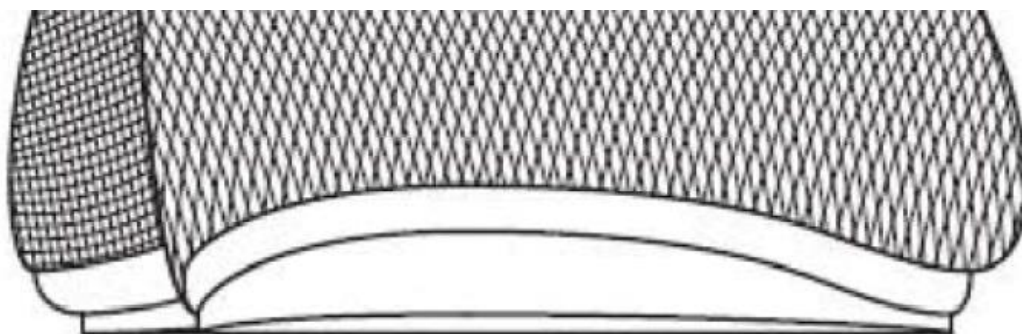
55. The parties agreed that the proper interpretation of the design is a matter for the Court, and not for the informed user or the experts: *Sealed Air Limited v Sharp Interpack Limited and Anor* [2013] EWPC 23 at paragraphs 20 and 21. I add that it is a question of fact, to be determined taking into

account all the relevant material before the tribunal, the most important of which will be what the drawings look like.

56. Three points of interpretation arose.

The material of the upper

57. The first relates to the appearance of the surface of the shoe upper: what is meant by the black lines shown? The Claimant submitted that the lines “make very clear that the upper is meshwork/knitted”. I was encouraged by counsel for the Claimant to look at close-ups of the RCD on the EUIPO website, which I have done. Examples were excerpted in the skeleton argument of counsel for the Defendant:



58. The Defendant submitted, first, that the cross-hatching (as the Defendant's counsel described it) shows merely that this is a three-dimensional shape – similar to the CAD depiction in *Trunki*. In the alternative, the Defendant submitted that the cross-hatching shows some material texture, but in a more general way than depicting a “knitted meshwork fabric”. The Defendant submitted that the “regular, generally square pattern, with lines generally perpendicular to each other, traversing the longitudinal and lateral axes of the shoe, but bending to show rounded areas” depicts not knitting, but a woven textile. The Defendant's case in the alternative was that the lines show a textured appearance “generally”, including knitted, woven, meshwork or animal hide textures but excluding

smooth leather or plastic textures. Within this, the Defendant submitted, if the design is to be interpreted more precisely still, the lines imply a woven texture rather than a knitted one.

59. I was not taken to any drafting convention that helps explain what the lines in the RCD convey. However, looking at them closely, including by zooming in on the high resolution images maintained by the EUIPO on its website, it is clear to me that the lines indicate a knitted fabric, rather than any of the alternative textures for which the Defendant contends. As is apparent from these expanded images, the lines are not consistently applied across the design. For example, at the heel of the shoe, the lines radiate in a circular fashion following the counterline. Similarly, when viewed from the front, the lines radiate out from the toe. This patterning is inconsistent with a woven fabric, or unprinted animal hide such as nubuck or suede, which would not, for example, radiate as it does at the heel. Even a coarse weave would not change direction as the lines in the RCD do. The RCD is also entirely different from the CAD rendition shown in *Trunki*. In my judgment, the RCD shows a knitted fabric, and, more particularly, a fabric knitted from a comparatively heavy thread.
60. In reaching this conclusion, I have not taken into account the following factors:
- (a) Counsel for the Claimant suggested that I could take into account the shoe made to the design in interpreting the meaning of the design, relying on C-281/10 P *PepsiCo Inc v Grupo Promer Mon Graphic SA and Anor* EU:C:2011:679 (*PepsiCo*) where the Court of Justice ruled that a product made to the registered Community design in issue can be used to confirm findings as to the overall impression created on the informed user by the registered Community design. Thus, she said, I could look at the Pointed Loafer to assess what is claimed in the RCD. Whilst superficially attractive, this argument is circular – to determine if the Pointed Loafer is a shoe made to the design, one first needs to assess what the registration means. I reject this submission.
 - (b) The United States design patent from which the RCD claims priority includes a description of the claimed invention: “Figures 1 to 21 include textured portions, which is design[ed] to show a stitched fabric of the embodiments design and can be any color, and in particular, a color different than the remaining portions of the shoe.” Under Article 41 of the Regulation, to benefit from a priority claim, the design applied for must be “the same” as the design from which priority was claimed. The Defendant had conceded that priority was properly claimed – which left it open to me to rely on the United States design patent. The difficulty with that argument is that the EUIPO does not review the scope of protection of the United States design patent in recording the priority claim. Further, US design patent drawing conventions differ, and the requirements of the United States Patent and Trademark Office (**USPTO**) differ from those of the EUIPO. Therefore, whilst Nugee J (as he then was) relied on a United States patent claimed as priority in *E Mishan & Sons Inc t/a Emson v Hozelock Limited and Ors* [2019] EWHC 991 (Pat) at paragraph 74, I do not consider that the position with respect to registered designs is clear cut, and full argument on the point may be appropriate in a future case. Whilst counsel for the Claimant urged me to rely on the US design patent, I did not need to do so in order to reach my conclusion.
 - (c) Ms Wright gave evidence that she could not ascertain from the RCD what the upper was made from, whereas Ms Hawkins opined that the drawings indicate a structured, repeated texture of interlinking elements. As mentioned above, this was not a matter on which permission was originally given for expert evidence: interpretation of the RCD is a matter for the court. Even an experienced expert in a given area of design is unlikely to have experience interpreting registered Community design drawings. I mean no disrespect to either of them in concluding that their views on the interpretation of the RCD are of no assistance to the Court.

The perimeter of the topline

61. The second controversy of interpretation of the RCD was the meaning of the two parallel lines running around the topline, that is, where the foot enters the shoe. The Claimant submitted that this indicates “a small contrasting collar which runs around the perimeter of the topline”. The contrast was not said to be one of colour. This was also described as the “edge finish”.
62. The Defendant submitted that these lines show “a narrow uniform binding around the whole topline” and that this is “a distinct part from the upper (not just a continuation of it to an edge)”. The Defendant noted that the area between the two lines does not include the texture lines shown on the rest of the upper.
63. A shoe made of a woven fabric would require an edge to ensure that the fabric does not fray – such that had I found that the lines on the upper indicated a woven fabric, these lines would indicate that border or edge. Knitted fabric is different – whilst some (fine) knitted fabrics can be cut, the evidence was that a knitted fabric such as this would unravel if cut. Knitted fabrics such as the one depicted are therefore edged as part of the knitting process, such as at the neckline of a crew-neck knitted woollen sweater. Such an edge will not fray. Given my finding above, it would thus be illogical to interpret the two lines around the topline as indicating an anti-fray border or edge. Rather, in my judgement, these lines indicate the contrasting edge created in the knitting of the shoe (again, such as the neckline of a crew-neck knitted woollen sweater).

Asymmetry

64. I was taken in detail by the Defendant’s counsel to what he submitted were asymmetric aspects of the RCD, particularly in relation to the size and placement of the gussets either side of the tongue. For my part, I found these very hard to see in the RCD itself. Counsel for the Claimant said any apparent asymmetry was caused by the shape of the human foot, and therefore the way that shoe designs tend to be photographed and drawn.
65. Having looked in detail at the RCD, including expanding the version available on-line, I can see that there is some asymmetry in the placement of the gussets – the topline edge on the outside of the foot (the right side on the right shoe) is lower than the topline edge on the inside of the foot, and hence the gussets are placed slightly asymmetrically. However, this is very difficult indeed to perceive. I return below to the impact of this on the informed user.
66. Whilst the parties disagreed about the importance of the various other features of the RCD, and whether they were found in the Prior Designs and/or the Pointy Flat, they were otherwise agreed on what the RCD showed.

Invalidity of the RCD

67. As set out above, the Defendant sought a declaration that the RCD is invalid for absence of individual character over the Prior Designs.
68. Article 4(1) of the Regulation provides:

“A design shall be protected by a Community design to the extent that it is new and has individual character.”
69. Article 6 of the Regulation provides:

“1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:

(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

(b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.”

70. The question for the Court, therefore, is whether the RCD produces a different overall impression on the informed user than the Allegra K and/or the Bonnibel. That simple question hides a dense thicket of further complexity.

71. The law on overall impression was considered in detail in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat) (*Cantel*) at paragraphs 169 to 182. Relying on the judgment of the General Court in Case T-525/13 *H&M Hennes & Mauritz BV & Co KG v OHIM* EU:T:2015:617; [2015] ECDR 20 (*H&M Hennes*) HHJ Hacon (sitting as a Judge of the Patents Court) provided a convenient six stage summary at paragraphs 181 and 182:

“181. I here adapt the four-stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user’s awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

(a) the sector in question,

(b) the designer’s degree of freedom, and

(c) the overall impressions produced by the designs on the informed user, who will have in mind

any earlier design which has been made available to the public.

182. To this I would add:

- (5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.
- (6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

72. In relation to the informed user, HHJ Birss QC (sitting as a Judge of the Patents Court) (as he then was) set out a helpful summary of the informed user in *Samsung Electronics (UK) Limited v Apple Inc* [2012] EWHC 1882 (Pat) (*Samsung v Apple*) which was expressly approved by the Court of Appeal at [2012] EWCA Civ 1339 at paragraph 10 (per Sir Robin Jacob, with whom Longmore LJ and Kitchin LJ (as he then was) agreed). His Honour referred to three cases decided by the Court of Justice and the General Court: *PepsiCo*, Case T-9/07 *Grupo Promer Mon Graphic SA v OHIM* EU:T:2010:96 [2010] ECDR 7 (*Grupo Promer*) and Case T-153/08 *Shenzhen Taiden Industrial Co Ltd v OHIM* EU:T:2010:248 (*Shenzhen*):

“Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

- i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzhen* paragraph 46);
- ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
- iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);
- iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);
- v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).”

73. Both parties submitted that I should take into account the difference of the RCD from the “design corpus”. I was referred to paragraphs 169 and 170 of *Cantel*:

“169. A registered Community design ... which is markedly different from any member of the design corpus will confer protection of a scope greater than would be conferred by a RCD only incrementally different from a member of the design corpus, see *P&G* at [35(ii)].

170. Designs which are strikingly new in every way will be unusual. More often some features will be commonly found in the design corpus, others not. In such a case the correct approach is to give little or no weight to common features. In *Grupo Promer*, the General Court said at [72]:

“... in so far as similarities between the designs at issue relate to common features..., those similarities will have only minor importance in the overall impression produced by those designs on the informed user.”

74. Applying the approach set out in *Cantel*, the parties were agreed on the following:

“(1) The relevant sector is shoes, and more particularly ballerina shoes for women;

(2) The informed user is a user of ballerina shoes, not a designer, technical expert, manufacturer or seller. She is particularly observant, knowledgeable of the design corpus and the design features normally found in the design of ballerina shoes. She is interested and shows a relatively high degree of attention. She neither observes minimal differences in detail, nor does she merely perceive the designs as a whole. She conducts a direct comparison of the design with the relevant product (the prior design or the allegedly infringing design).

(3) The designer of ballerina shoes has a very wide degree of freedom in developing the design – whilst the shoe must stay on the foot, and enable walking, the design corpus shows that ballerina shoes differ in shape, texture, colours and materials.

...

(5) There are no features of the RCD which are solely dictated by technical function and therefore to be ignored in the comparison.”

75. I also take into account HHJ Hacon's sixth point in *Cantel* that the informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.

76. I must say something further about the expert evidence in relation to the informed user. Ms Hawkins was shown the definition of the informed user set out in the Amended Particulars of Claim, and asked if “a buyer of women's fashion shoes is discerning, knowledgeable and pays a high degree of attention”. She answered in the affirmative. She was then asked a series of questions about the reaction of “the informed user” to various features of various shoes. I had understood Ms Hawkins to have accepted the concept on the basis that the “buyer” was a buyer for, say, a department store. Counsel for the Defendant assured me he had meant a consumer – a customer buying the shoes in a retail store. They were not the words he used and this was never clarified with Ms Hawkins. At least in the fashion industry, a buyer refers to someone who buys as part of their job, rather than an individual customer. Ms Hawkins' answers also suggested to me that she meant a wholesale buyer, because of the close level of attention she suggested such a person would pay, and how even very minor differences would “strike” her informed user. As *Shenzhen* makes clear, the informed user is a

user of the product, not a “buyer”. Ms Hawkins’ informed user was, in my judgment, clearly too close to a sectoral expert. To her informed user, who is struck by every difference, many designs will be valid, but few will be infringed. Ms Wright, on the other hand, took the view that the most important thing about all the shoes in issue was that they were what she described as an Albert cut – this meant, to her, that the Allegra K and the Bonnibel were similar to the RCD and the UCD. This was too high a level of abstraction – to such an informed user, few designs will be valid, but those that are will have a very broad scope of protection.

77. In any event, as the parties conceded, the definition of the informed user is not a matter for the experts, each of whom is obviously a sectoral expert, rather than an informed user. Therefore, their evidence of what would or would not have struck the informed user is of limited assistance to me, particularly where it is not clear the basis on which that evidence was being put forward, or, as previously outlined, the basis was, through no fault of their own, incorrect.
78. As mentioned above, the parties were agreed as to the law to be applied. There was one small controversy in relation to the design corpus on which I should comment briefly.
79. As set out above, both experts were agreed that, whilst fabrics knitted from heavy thread were known for shoe uppers for gym shoes and sneakers, the informed user would not be aware that they had been applied to ballerina shoes. Therefore, the use in the RCD and the UCD of an upper knitted from heavy thread would stand out to the informed user as a significant difference to what had come before. That was Ms Hawkins’ and Ms Wright’s clear evidence. The relevance of the Claimant’s earlier shoes, The Flat and The Point, therefore does not arise on the facts. However, I was taken to Henry Carr J’s judgment in *L’Oréal SA and Anor v RN Ventures Limited* [2018] EWHC 173 (Pat) at paragraphs 146 to 152:

“146. The relevance of the design corpus was explained by Arnold J in *Whitby Specialist Vehicles Ltd v Yorkshire Specialist Vehicles Ltd* [2014] EWHC 4242 (Pat); [2016] FSR 5 at [22]–[23]:

“Recital (13) of the Designs Directive makes it clear makes it clear that the overall impression produced on the informed user depends on ‘the existing design corpus’, taking into consideration the nature of the product to which the design is applied, and the industrial sector to which it belongs.

23. In *Grupo Promer* the Community design was registered for ‘promotional items for games’. The General Court held at [62] that the informed user ‘has *some* awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed’ (emphasis added). In *PepsiCo* the CJEU appears to have approved this statement at [54]. The CJEU went on at [59] to say that the informed user ‘knows the various designs which exist in the sector concerned, possesses a *certain* degree of knowledge with regard to the features which those designs *normally* include’ (emphasis added).”

147. In the present case, L’Oréal contended that prior art relied on by RN Ventures, although not so obscure as to be excluded by the exception to Article 7, should not be considered as part of the design corpus, or if such prior art was included, it should be given little weight, as it would not impact on the informed user’s awareness of “*the design features normally included in designs existing in the sector concerned*”. It submitted that RN Ventures was required to prove that the

prior designs had been marketed to an extent that the informed user would be aware of them, and it had failed to do this.

148. This is a point of some significance as it applies generally to identification of the design corpus in registered Community design cases. L'Oréal's submission gains some support from the CJEU's statement in *PepsiCo* [2012] FSR 5 that "*the informed user possesses a certain degree of knowledge with regard to the features which those designs normally include*". It is further supported by a passage in the judgment of Arnold J in *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat); [2014] RPC 23 at [46]:

"PMS contends that the design corpus includes all designs which qualify as prior art under Article 7(1) of the Regulation and are not excluded by either the obscure designs exception or the confidential disclosures exception. Magmatic disputes this, and contends that the design corpus consists of the designs with which the informed user is likely to be familiar. Thus there may be designs which are not quite obscure enough to be excluded by the obscure designs exception, and thus can be relied upon as prior art for the purposes of Articles 5 and 6, but nevertheless do not form part of the design corpus when assessing the overall impression created by other designs for the purposes of Article 10. In support of this contention counsel for Magmatic relied upon the passages from *Grupo Promer* [2010] ECDR 7 and *PepsiCo* [2012] FSR 5 that I have just cited. He also relied on passages in the judgment of His Honour Judge Birss QC in *Gimex International Groupe Import Export v Chill Bag Co Ltd* [2012] EWPC 31; [2012] ECDR 25 at [44]–[47] and [65], but those were addressed to a slightly different issue to the one presently under consideration. Nevertheless, I agree that *Grupo Promer* and *PepsiCo* support Magmatic's contention. For reasons that will appear, however, I consider that it makes no difference who is right about this in the present case."

149. Arnold J did not decide the point as it made no difference to the case before him, although he considered that the case law available at the time supported Magmatic's argument. However, the argument presented to Arnold J in *Magmatic* [2014] RPC 23 is criticised in David Stone, *European Union Design Law: A Practitioner's Guide*, 2nd edn (2016) ("*Stone on EU Design Law*") at [10.76] as "*ingenious but misconceived*". The author's view is that:

"There is nothing in a purposive construction of the Regulation, or indeed in the *PepsiCo* decision, that supports such a contention. In order to assess the validity of an RCD it is necessary to compare it against each prior design. If any one of those prior designs creates the same overall impression on the informed user as the RCD, that RCD is invalid. But it cannot be that an RCD that survives such an invalidity attack is then protected from the 'kindred prior art' that may be obscure-ish but not obscure. For the invalidity test to be the flipside of the infringement test the design corpus must include all prior designs. As a practical matter the legislature cannot have intended that the tribunal should have to apply an additional filter once a prior design is found not to be too obscure...."

150. Prior art which is said to invalidate a registered Community design may be excluded by the exception to Article 7 on the basis that it would not "*reasonably have become known in the normal course of business to the circles specialised in the sector concerned*" i.e it is obscure. If it is not excluded for this reason, then a defendant is not required to prove that the informed user would have known of it.

This was made clear by HHJ Birss (as he then was) in *Gimex v Chill Bag* [2012] EWPC 31 at [74]:

“Once the notional informed user is defined, the question of overall impression can be resolved. From the point of view of assessing individual character (validity), the informed user must be presented with any given item of cited prior art whether or not it is a design for the product in question. Whether the cited prior art is or is not within the user’s design awareness is not the issue. If the cited prior art is not a design for a product of the kind the informed user but it still must be considered for the purposes of novelty and individual character. The design is only protected to the extent that it has novelty and individual character.”

151. That has now been confirmed by the CJEU in *Easy Sanitary Solutions v Group Nivelles* (C-361/15 P) EU:C:2017:720; [2018] ECDR 4 (21 September 2017). The Court of Justice overturned a decision of the General Court, which held that for the purposes of assessing individual character within the meaning of art.7(1) it was necessary that the informed user of the contested design should know of the product in which the earlier design was incorporated or to which it was applied. The Court of Justice held as follows at [130]–[134]:

“130. However, the concept of an informed user cannot be interpreted as meaning that it is only if that user knows the earlier design that the earlier design could prevent recognition of the individual character of a subsequent design. Such an interpretation runs counter to Article 7 of Regulation No 6/2002...

131. The General Court’s finding, set out in paragraph 132 of the judgment under appeal, amounts to saying that, for the purposes of examining the individual character of a design, within the meaning of Article 6(1) of Regulation No 6/2002, the earlier design, whose disclosure to the public has been proved, within the meaning of Article 7(1) of that regulation, must be known to the informed user of the contested design.

132. However, nothing in Article 7(1) permits the conclusion that it is necessary for an informed user of the product in which the contested design is incorporated or to which it is applied to know the earlier design when it is incorporated in a product in an industry sector that differs from the relevant sector for the contested design, or is applied to such a product.

133. If the General Court’s finding, set out in paragraph 132 of the judgment under appeal, were to be followed, an applicant for a declaration of invalidity in respect of the contested design would have to prove not only that the earlier design had been made available to the public, within the meaning of Article 7(1) of Regulation No 6/2002, but also that the informed public of the design whose validity is contested knew that earlier design.

134. That would be tantamount to requiring an applicant for a declaration of invalidity to provide evidence of two disclosures: a first disclosure to those in ‘circles specialised in the sector concerned’ and a second disclosure to users of the type of product relevant to the contested design. Such a requirement, besides being incompatible with the interpretation of the phrase ‘sector concerned’ referred to in paragraph 129 of this judgment, would add a condition that neither the letter nor the spirit of Article 7(1) of Regulation No

6/2002 provides and would be irreconcilable with the principle arising from Article 10(1) of that regulation, according to which the protection granted by the Community design extends to 'any design' that fails to produce on the informed user a different overall impression."

152. In the light of the decision of the CJEU in *Easy Sanitary* [2018] ECDR 4, it is not necessary, in my view, for it to be established that the informed user would know of an item of prior art for it to be considered as part of the design corpus. To introduce such a requirement, which is not contained in the Regulation, would apply a different test to overall impression for the purposes of validity and scope of protection, and would add unnecessary complications to registered design claims, which should require very little evidence to determine. It would give rise to satellite disputes about the extent of sales of third-party products, and would enable the owner of a design registration potentially to exclude prior art which is closest to his registration. I agree with the passage which I have cited from *Stone on EU Design Law*. Although it was written before the judgment of the Court of Justice in *Easy Sanitary*, it is strongly supported by that decision."

80. As the Court of Appeal noted in *Pulseon OY v Garmin (Europe) Limited* [2019] EWCA Civ 138, "design corpus" is not a phrase used in any of the provisions of the Regulation. Rather, it appears in Recital 14 of the Regulation, apparently used as a collective term for all the relevant prior designs which could be novelty-destroying:

"(14) The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design."

81. Some of the other language versions of Recital 14 may be helpful: "patrimoine des dessins ou modèles" in French; "Formschatz" in German; "disegni o modelli già esistenti" in Italian; and "dibujos y modelos existente" in Spanish.
82. I respectfully agree with the passages I have set out from Henry Carr J's judgment. The Flat and The Point are not put forward as novelty-destroying (indeed, they were removed from the Counterclaim prior to the trial). Whether or not they were actually known at the Relevant Date is irrelevant, given the clear evidence of both experts, who were expressly giving evidence on the state of the design corpus at the relevant date, that the knitted upper of the RCD and the UCD would strike the informed user as unusual.

Allegra K

83. Turning first to the Allegra K, I have no hesitation in concluding that it produces a different overall impression on the informed user than the RCD. Whilst there are several differences, the following three, conceded by the Defendant, are enough to dispose of the point:
- (a) the heel: whilst the Allegra K and the RCD both show a distinct heel, the heel on the RCD is significantly less pronounced. The Allegra K heel is at the high end of what would still be considered a "flat" shoe. Unlike the heel of the RCD, the heel of the Allegra K is two-toned, with the upper half to two thirds of the heel covered in the same material as the upper. In my judgment, this would strike the informed user as a very significant difference;

- (b) the material of the upper: it was common ground that the Allegra K is made of suede. As mentioned above, suede is leather, but the surface presented is the flesh side of the leather rubbed to create a velvety, napped finish. It is a very different material to the RCD, which I have found to be of a knitted heavy yarn; and
 - (c) the Allegra K does not feature a counterline, which is obvious in the RCD.
84. These three differences would strike the informed user, such as to produce a different overall impression. It is therefore not necessary to describe the other differences between the Allegra K and the RCD. Reviewing the RCD, the informed user, who is aware of available shoe designs and pays a high degree of attention, would be struck by the choice of material. Of course, as counsel for the Claimant conceded, it is not apparent from the RCD that the knitted thread used is made from recycled plastic. But it is obviously a heavy thread. Ms Hawkins' evidence was that the knitted upper "made the shoe unique among others of the slipper cut style" and Ms Wright accepted that the knitted material of the upper was an "interesting design feature". The heel and the counterline are among additional differences that would be noticed by the informed user, but they are variants on existing shoe designs, rather than a new departure, and will not have been as significant to the informed user as the choice of knitted material for the upper.
85. I also remind myself that having looked at these three differences identified by the Defendant, I must also stand back and assess the overall impression. In doing so, I remind myself of the issues set out in paragraphs 74 and 75 above. In my judgment, comparing the seven views of the RCD with the Allegra K, I have no hesitation in concluding that the RCD is not invalid over the Allegra K. The Allegra K produces a different overall impression on the informed user.
86. The Court of Justice has made clear in *PepsiCo* (at paragraph 74), and the parties agreed, that I could also look at the Pointed Loafer "for illustrative purposes in order to confirm the conclusions already drawn". Comparing the Pointed Loafer and the Allegra K (and ignoring the different colourways), the differences are even more striking.

Bonnibel

87. In relation to the Bonnibel, the Defendant admitted certain differences between it and the RCD including:
- (a) the material of the upper: it was common ground that the Bonnibel is made of suede, synthetic suede or microsuede; and
 - (b) the Allegra K does not feature a counterline, which is obvious in the RCD.
88. For the same reasons given above in relation to the Allegra K, I consider that the different material as between the RCD and the Bonnibel means that they produce different overall impressions on the informed user. Unlike the Allegra K, the Bonnibel lacks a high, two-toned heel. But it is made of suede or synthetic suede – clearly not a knitted material. For the same reasons set out above, it, too, produces a different overall impression on the informed user. Having reached that conclusion, it is even more striking when comparing the actual Pointed Loafer with the images provided of the Bonnibel (and ignoring the different colourways).
89. For either of the Prior Designs to invalidate that RCD, the RCD would have to be described at an unacceptable level of generality – such as a pointed-toe, slipper-cut ballerina shoe made of a fabric with some texture. That is not what the RCD depicts.
90. The invalidity attack on the RCD therefore fails.

Infringement of the RCD

91. The test for infringement of registered Community designs is the flipside of the invalidity test which I have just applied. The difference is that, instead of looking back from the RCD to the Prior Designs, I must look forward from the RCD to the allegedly infringing product. I must compare the drawings in the RCD with the Defendant's Pointy Flat, although, again, both parties submitted that I could compare the Claimant's Pointed Loafer with the Defendant's Pointy Flat "for illustrative purposes in order to confirm the conclusions already drawn".
92. I have set out above my interpretation of the RCD in relation to the three areas of dispute.
93. The Defendant's counsel (and Ms Wright) spent much time drawing out differences between the RCD and the Pointy Flat. These were set out in detailed *Action Storage* charts (named after *Action Storage Systems Limited v G-Force Europe.Com Limited & Anor* [2016] EWHC 3151 (IPEC)) which I have reviewed carefully, and include the following:
 - (a) In the RCD, the topline is made up of a straight line heading from the gusset towards the heel, with a marked upkick to the heel, whereas the Pointy Flat has a gradual curve from the gusset to the heel. Whilst I consider this to be a discernible difference between the RCD and the Pointy Flat, against the background of multiple different topline designs in the design corpus, I do not consider that this difference would strike the informed user as significant;
 - (b) Counsel for the Defendant submitted that what he described as the "topline contrast" is missing in the Pointy Flat. I disagree. I have found above what the parallel lines in the RCD mean, and that is exactly how they appear in the Pointy Flat – a narrow area of knitted heavy yarn used to create an edge to the knitted upper;
 - (c) Counsel for the Defendant submitted detailed analyses of the differences in the vamp length and the tongue length, together with different angles within the gussets. Again, whilst these differences are discernible on a detailed side by side study of the RCD and the Pointy Flat, they are not differences that will strike the informed user, particularly because they are well-known variations of ballerina shoe design;
 - (d) In the RCD, the gradation between the heel and the main sole is gradual and sloping, whereas in the Pointy Flat it is a step. Counsel for the Defendant also pointed to the intermediate sole apparent from the RCD drawings, which he said was absent in the Pointy Flat. The informed user is going to pay more attention to those parts of the design that are visible whilst using the product in question: *Shenzhen* at paragraph 34. Whilst the differences in the heel and sole are discernible, they will not strike the informed user as important differences, including because they are all variations of well-known ways of designing a ballerina shoe; and
 - (e) The Pointy Flat has a tab on the back of the foot. Such tabs developed to ease pulling the shoe onto the foot, though, in this instance it may be decorative. The tab, made of gros-grain ribbon, includes the Defendant's trade mark GIESSWEIN and two examples of its ram's head logo. The Pointy Flat also has a decorative button on the outer side of the heel which shows the Defendant's ram's head logo. Neither party appeared to place much reliance on these embellishments. Counsel for the Claimant submitted that the tab is the same colour as the shoe upper, and is "quite short and quite slender". In her submission, it was insufficient to create a different overall impression on the informed user, and should probably be ignored anyway in the comparison of like with like: *P&G* at first instance ([2006] EWHC 3154 (Ch)) per Lewison J (as he then was) at paragraph 46. Counsel for the Defendant (rightly) did not put these differences very highly. I agree. Even if I do take the tab and the button into

account (which I am not convinced I ought to do), informed users may expect a level of branding on shoes – neither the tab nor the button, nor the combination of the two, will strike the informed user sufficiently to produce a different overall impression. Further, it would run rough-shod over registered design law if infringement of a registered design could be avoided simply by adding such branding elements.

94. In his skeleton argument, counsel for the Defendant noted “the differences in appearance articulated in the *Action Storage* chart will not benefit from yet more words trying to explain the same, ultimately visual comparison”. This sentence captures pithily the difficulty of deciding registered design cases. To adopt the expression from the Court of Justice’s reasoning in *PepsiCo*, too close attention to every difference, and the informed user moves too close to the sectoral expert from patent law. To this over-informed user who notices every difference, most designs will be valid, but few designs will ever be infringed. At the other end of informed-ness is the average consumer from trade mark matters. To this under-informed user who does not notice differences, many designs will look the same, so few designs will be valid, but those that are valid will be granted a wide scope of protection. In *PepsiCo*, the Court of Justice required a middle road, with the informed user lying somewhere between the sectoral expert and the average consumer.
95. As counsel for the Claimant urged in her skeleton argument:
- “the intimate familiarity which will unavoidably be gained with the details of the shoes over the course of the case may serve to emphasise the differences between the two in a manner which is not consistent with the correct test to be applied.”
96. That is an obvious risk of an elongated trial over-burdened with expert evidence on issues which are actually for determination by the court. The risk is that the tribunal becomes too expert – too close to the sectoral expert who notices every difference.
97. The submission of counsel for the Claimant is also consistent with the comments of Jacob LJ set out above about the role of expert evidence in registered design cases, and his oft-repeated (but rarely achieved) invocation that “[b]y and large it should be possible to decide a registered design case in a few hours” (*P&G* at paragraph 4).
98. Whilst there are undoubtedly differences between the RCD and the Pointy Flat, when the informed user steps back and forms an overall impression, that overall impression is, in my judgment, the same. In reaching that conclusion, I remind myself of the matters set out at paragraphs 74 and 75 above, including the agreed very large design freedom. Both the RCD and the Pointy Flat are pointed-toe slipper cut ballerina shoes, with a low heel, obvious counterline, protruding tongue and recognisable gussets. The differences in some measurements and ratios will be noticed by the informed user, but not to such an extent as to create a different overall impression, even in combination. The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. Most importantly, and what will most strike the informed user in *this* case, is that both the RCD and the Pointy Flat have uppers knitted from a heavy thread. As that was a departure for ballerina shoes, that will strike the informed user. Put a different way, if the RCD is taken at the right level of generality, the informed user will conclude that the RCD and the Pointy Flat are not identical, but they do produce the same overall impression.
99. In my judgment, the Pointy Flat therefore infringes the RCD.

UCD Infringement

100. The law on unregistered Community designs is largely identical to that in relation to registered Community designs, other than in relation to three main issues:
 - (a) Creation: whereas registered Community designs arise by virtue of the act of registration by the EUIPO, unregistered Community designs arise by virtue of being disclosed for the first time within the territory of the European Union;
 - (b) Duration: registered Community designs can be renewed up to four times for a total period of 25 years whereas unregistered Community designs last for only 3 years; and
 - (c) Infringement: in addition to the allegedly infringing product's having to produce the same overall impression on the informed user as the unregistered Community design, copying must also be proved.

101. In this case, disclosure was not in issue: the Defendant accepted the Claimant's pleading that the Pointy Loafer had been first disclosed in the European Union on 24 November 2017, so-called Black Friday, being the day after the celebration of Thanksgiving in the United States, when many businesses offer discounts on their products. That disclosure was said to be simultaneous around the world, by virtue of:
 - (a) disclosure on the Claimant's website at www.rothys.com;
 - (b) a publicity email sent to the Claimant's customers' email addresses; and
 - (c) postings to the Claimant's social media accounts including Instagram and Facebook.

102. The Claimant supported its disclosure with evidence that:
 - (a) 51 people from the United Kingdom visited the Pointed Loafer webpage on 24 November 2017;
 - (b) 10 people from the EU purchased the Pointed Loafer on 24 November 2017;
 - (c) the promotional email featuring images of the Pointed Loafer was sent to at least 452 people with email addresses in the EU, including various fashion editors; and
 - (d) the Claimant's Instagram followers included various shoe designers and writers based in London.

103. Whilst, technically, the UCD exists in the images shown in the email, website and social media postings of 24 November 2017 (for that was what was disclosed), the parties agreed that UCD subsisted in the whole Pointed Loafer shoe, as shown here:



104. In relation to duration, the parties accepted that the three-year UCD ran out on 25 November 2020, shortly after trial but before delivery of this judgment. That, of course, prevents the grant of forward-looking remedies such as injunctions, but it does not prevent backward-looking remedies such as damages or an account of profits.
105. On many of the same grounds as I have dismissed above, the Defendant denied that the Pointy Flat produces the same overall impression on the informed user, but the principal dispute rested on the third main difference between registered and unregistered Community designs: the need to prove copying of an unregistered Community design.

Copying

106. Article 19 of the Regulation states:

“Article 19

Rights conferred by the Community design

1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.”

107. I note that paragraph 2 of Article 19 expressly states that the contested use must result “from copying the protected design”.
108. The Court of Justice addressed copying in *C-479/12 H Gautzsch Großhandel GmbH v Münchener Boulevard Möbel Joseph Duna GmbH* [2014] RPC 28 at [37] to [44], concluding:
- (a) the onus of proving copying lies on the holder of the design right in issue;
 - (b) the onus of proving independent creation lies on the alleged infringer; and
 - (c) the onus of proving copying may be lightened or reversed, in accordance with the rules of national law, where it is otherwise likely to be impossible or excessively difficult to prove copying.
109. Counsel for the Claimant relied on United Kingdom case law on copyright and UK unregistered design right pursuant to which the burden of proving copying may shift. She submitted that, in this case, the close similarity between two works or designs, coupled with the opportunity of the alleged copier to have access to the work or design, gives rise to an inference of copying. She relied on *A Fulton Co Ltd v Grant Barnett & Co Ltd* [2001] RPC 16 at paragraph 95 per Park J:

“It is rare in intellectual property cases for there to be direct evidence of copying of someone else's copyrights or designs. Plagiarists do their copying in secret. The courts proceed on the basis that a close similarity between the claimant's design and the alleged infringing article, coupled with the opportunity for the alleged copier to have access to the claimant's design or work, raises an inference of copying. It is then up to the defendant to rebut the inference by evidence which shows that the apparent similarity arose in some other way. In *Ibcos Computers Ltd v Barclays Finance Ltd* [1994] FSR 275 at page 297, Jacob J said that “the concept of sufficient similarities shifting the onus on to the defendant to prove non-copying is well recognised in copyright law”. He added that he thought that the proposition “is not so much one of law as of plain rational thought”.

110. I therefore need to look in detail at the evidence before me relating to the creation of the Pointy Flat.

Designing the Pointy Flat

111. The Claimant accepted that the Pointy Flat was designed by Markus Giesswein, Johannes Giesswein and Ms Zuk. Ms Zuk was described as “the main designer of the Pointy Flat”. Whilst others at Innolux were involved in producing the shoes, including Mr Jahoda and Mr Black, they did not make design decisions.
112. As early as December 2017, Markus Giesswein came up with the design concept of a ballerina shoe for summer. The Defendant had already made ballerina shoes from wool, but many consumers, he said, (wrongly) considered wool to be too hot for summer wear. He undertook some online research (scrolling through Google search results and clicking what was interesting on websites and social media), and discovered an article about the Claimant’s use of recycled plastic material for its shoes. Johannes Giesswein was also undertaking Internet research at this time, including looking at Facebook and Instagram. Markus Giesswein accepted that he had likely visited the Claimant’s website by spring 2018 at the latest.
113. On 19 July 2018, as noted above, Markus Giesswein purchased one pair each of The Flat, The Point and The Loafer. At the time, the Pointed Loafer was not available. The Flat, The Point and The Loafer are shown here:



114. On 2/3 August 2018, Markus Giesswein hosted a “kick off” meeting at the Defendant’s offices in Austria, attended by Johannes Giesswein, Ms Zuk and Mr Jahoda. Those present viewed the Claimant’s shoes that Markus Giesswein had purchased, and decided to use knitted plastic yarn for ballerina shoes, of which there would be a pointed toe version and a round toe version.
115. On 13 August 2018, Markus Giesswein came across a post from one of his contacts in China (a Mr Herman Lim) about “fly knit” women’s shoes. He forwarded this post by email to Johannes Giesswein with the comment “hermann lin makes shoes like rothys” [sic]. There was some debate over the exact translation of these words from their original German, but I do not consider that anything turns on it.
116. Ms Zuk undertook her own research, following which she put together sketches and “spec sheets”. This research included looking at the Claimant’s website, and its Instagram and Facebook pages.
117. On 20 August 2018, Mr Jahoda sent to Johannes Giesswein a photograph of the last he intended to use. Also included in the photograph was the Claimant’s The Flat.
118. On 3-5 September 2018, there was a meeting at Innolux’s premises in Vietnam, but Markus Giesswein said that the Pointy Flat design was not discussed in any detail.
119. Mr Black gave evidence that the first prototype of the Pointy Flat was made around 4 September 2018.
120. Ms Zuk sent designs for the Pointy Flat sole by email on 18 September 2018.
121. On 8 October 2018, Markus Giesswein sent Johannes Giesswein an email headed “giesswein ballerina”, attaching pictures of the Claimant’s shoes.
122. On 12 November 2018, Ms Zuk sent Markus and Johannes Giesswein an email with attachments showing proposed designs for the Pointy Flat, including reference to “The border different knitted as shoes ROTHYS” [sic]. Further emails from Ms Zuk followed on 14 November 2018 attaching designs for the insock and back counter of the Pointy Flat, noting “back counter of ROTHY’S”.
123. On 15 December 2018, prototypes of the Pointy Flat were received at the Defendant’s premises in Austria, and were tried on by a model. They were checked against the Claimant’s shoes.
124. On 27 December 2018, Markus Giesswein made a further purchase of the Claimant’s shoes, including 13 pairs of The Flat, The Loafer and The Point. Those shoes were taken to Innolux in

Vietnam for a meeting on 11-17 January 2019, where new prototypes of the Pointy Flat were tested by models, along with the Claimant's shoes.

125. As is apparent from this abbreviated telling of events, the three people responsible for designing the Pointy Flat had, almost throughout that whole process, the Claimant's shoes. Those shoes were The Flat, The Loafer and The Point, but not the Pointed Loafer. Those shoes were thoroughly analysed and used throughout the process of designing the Pointy Flat. But Markus Giesswein and Ms Zuk both gave evidence that they had never seen the Claimant's Pointed Loafer, and hence could not have copied it, and they were not shifted from that stance during counsel for the Claimant's skilled cross-examination.
126. Counsel for the Claimant did not ask me to make a finding that Ms Zuk and Markus Giesswein lied to the Court. Rather, the Claimant's case rested on two planks:
 - (a) Johannes Giesswein had seen and copied the Pointed Loafer, and he was being shielded from giving evidence so as not to be exposed in cross-examination; and/or
 - (b) Markus and/or Johannes Giesswein and/or Ms Zuk had seen the Pointed Loafer on-line, and had unconsciously copied it in designing the Pointy Flat.
127. Each of these planks rested on a general allegation that the Defendant "downplayed" the influence of the Claimant's shoes in the design process of the Pointy Flat. I accept that the legal case has been modified on both sides, but I do not detect in the Defendant's evidence, or the disclosed documents with which I was provided, or from the honest way in which the Defendant's witnesses of fact gave their evidence, any attempt to hide the fact of the purchase and use of the Claimant's shoes.
128. Turning to the first of the Claimant's allegations, it was clear from Markus Giesswein's and Ms Zuk's evidence, unswayed under cross-examination, that Ms Zuk was the main designer of the Pointy Flat. The idea had been Markus Giesswein's, but the actual design was by Ms Zuk. She took direction from both Markus and Johannes Giesswein, but there is nothing in the contemporaneous correspondence or the evidence that suggests that Johannes Giesswein either ever saw the Pointed Loafer, or was some-how secretly pulling the strings to copy that shoe. The Claimant accepted that disclosure had been properly carried out. Various documents were disclosed, including some which could be misconstrued as damaging to the Defendant's case on copying. The Defendant was upfront about the shoes it bought, and the Claimant was aware of these from its own records. There is nothing in the written record to support the suggestion that Johannes Giesswein had, saw or copied the Pointed Loafer, and Markus Giesswein's and Ms Zuk's testimony flatly denied it. I also do not accept the submission that I should draw a negative inference about the Defendant's case because Johannes Giesswein was not called to give evidence. As I have set out above, the Pointy Flat was Markus Giesswein's idea, which Ms Zuk then implemented. Mr Jahoda and Johannes Giesswein were involved – but in the IPEC (where the Claimant commenced these proceedings), decisions have to be made to ensure that a trial can be held proportionately: see *Manvers Engineering Limited & Anor v Lubetech Industries Limited & Ors* [2013] EWHC 3393 (IPEC) per Mann J. Markus Giesswein and Ms Zuk were available to be questioned – and they were, skilfully and in depth. I therefore decline to draw any negative inference against the Defendant for its failure to adduce evidence from Johannes Giesswein.
129. In relation to unconscious copying, again, this submission seems to me to be far-fetched. The Claimant conceded that the Pointed Loafer was a limited edition product, which was shown on its website for a short period of time only. I accept Markus Giesswein's evidence that he and his brother Johannes were undertaking Internet-based research at the time, including visiting Instagram and Facebook. However, the Pointed Loafer was not on the Claimant's website on either of the occasions that Markus Giesswein is known to have visited – on both occasions, he bought all the shoes that

were then available. There is no image or reference to the Pointed Loafer in any of the disclosed documents. I also do not accept that any of Markus or Johannes Giesswein or Ms Zuk would have trawled past copies of the Claimant's website using the "Wayback Machine": Markus Giesswein was cross-examined on this point, and stated that he was unaware of the Wayback Machine prior to these proceedings. I also do not accept that any of Markus or Johannes Giesswein or Ms Zuk would have gone back over past Instagram or Facebook postings once they had located the knitted plastic shoes in which they were interested.

130. In my judgment, the allegation of copying therefore fails.
131. Counsel for the Claimant submitted that that was insufficient to exculpate the Defendant. Having raised the inference of copying, she submitted that the onus shifted to the Defendant to prove independent design, which, she submitted, they had not done.
132. I reject that submission on the facts before the Court: in my judgment, the Defendant has set out its independent design case, which I find to be coherent and consistent. Markus Giesswein wanted to make a ballerina shoe of a summer-weight material. He, his brother and Ms Zuk all took inspiration from the three of the Claimant's shoes they purchased. Two of those had a rounded toe, and one had a pointed toe. It is a small and readily apparent step for an entity wishing to make a pointy-toed ballerina shoe to do so. Ms Zuk, the designer of the Pointy Flat, was cross-examined, and unswayed on her version of how she designed the Pointy Flat. She sufficiently explained the Defendant's independent design story.
133. I also do not accept the submission that Markus Giesswein's account of the design of the Pointy Flat "omitted key events in the time line". Whilst his written account omitted some details, and some dates needed to be corrected, Markus Giesswein readily accepted additional steps when they were put to him in cross-examination, and nothing in his demeanour suggested that he was trying to obfuscate or dissemble. Further, I have accepted the evidence of Ms Zuk and Markus Giesswein that they never saw the Pointed Loafer – the actual shoe or an image of it. It was not put to me that the Pointed Loafer was so famous that any such failure to be familiar with it would be unreasonable (as set out in Article 19 of the Regulation). The Pointed Loafer was a short run product, only available on the Claimant's website for a comparatively short period. In my judgment, the design of the Pointy Flat was an independent work of creation by a designer who may be reasonably thought not to be familiar with the Pointed Loafer.

Conclusions on copying

134. The Pointy Flat was not copied from the Pointed Loafer. The Claimant's case for infringement of the UCD therefore fails.

Differences between the RCD and the UCD

135. In case things go further, I set out briefly my conclusions on whether or not the UCD and the Pointy Flat produce the same overall impression on the informed user. The parties agreed that the Pointed Loafer was a shoe made to the RCD, but also pointed out a number of differences between the RCD and the UCD. From the Defendant's perspective, three main differences made the UCD closer to the Pointy Flat:
 - (a) the material of the upper in the UCD is clearly similar to the material of the upper of the Pointy Flat;
 - (b) the asymmetry counsel for the Defendant identified in the RCD was less obvious on the UCD;

- (c) the importance counsel for the Defendant attached to the edge of the topline in the RCD was not apparent in the UCD.

Counsel for the Defendant accepted that these three differences made it *more* likely that the Pointy Flat produces on the informed user the same overall impression as the UCD.

136. Counsel for the Defendant submitted that the shape of the topline (what he described as the upkick in the heel) was more pronounced on the UCD than in the RCD. Both experts thought so, but as neither had correctly put themselves into the shoes of the informed user, I do not consider that that helps me. Looking very carefully at the RCD and the Pointed Loafer, I can discern the difference identified by counsel for the Defendant – but it is not sufficient to make a difference to my judgment above comparing the RCD and the Pointy Flat. Comparing the UCD and the Pointy Flat, and reminding myself of the matters set out at paragraphs 74 and 75 above, I reach the same conclusion as with the RCD for the same reasons I have set out above. The UCD and the Pointy Flat produce on the informed user the same overall impression.

Invalidity of the UCD

137. Given my findings, I can deal with this issue briefly. For the reasons I have set out above, comparing the Pointed Loafer with first the Allegra K and then second with the Bonnibel, it is clear to me that neither of the Prior Designs creates the same overall impression on the informed user. The UCD departs from the design corpus primarily through the use for the upper of a knitted heavy yarn. That is what will strike the informed user of ballerina shoes, who has seen all the other variations before. Together with the differences in the heel and the counterline (the Allegra K) and the counterline (the Bonnibel) that is sufficient to produce a different overall impression.
138. The UCD is not invalid over the Allegra K or the Bonnibel.

Summary

139. For the reasons set out above, in my judgment:
- (a) The RCD produces a different overall impression on the informed user than does the Allegra K and/or the Bonnibel;
 - (b) The Pointy Flat does not produce a different overall impression on the informed user than does the RCD;
 - (c) The UCD produces a different overall impression on the informed user than does the Allegra K and/or the Bonnibel;
 - (d) The Pointy Flat does not produce a different overall impression on the informed user than does the UCD; and
 - (e) The Pointy Flat does not result from copying the UCD.
140. The RCD and the UCD are not invalid. The Pointy Flat infringes the RCD. The Pointy Flat does not infringe the UCD. The Claimant succeeds on the RCD but not the UCD. The Defendant's counterclaim for invalidity fails.