



Neutral Citation Number: [2023] EWHC 178 (IPEC)

Case No: IP-2021-000119

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY ENTERPRISE COURT

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

Date: 31 January 2023

Before :

HIS HONOUR JUDGE HACON

Between :

MARKS AND SPENCER PLC

Claimant

- and -

ALDI STORES LIMITED

Defendant

Daniel Selmi (instructed by **Stobbs IP Limited**) for the **Claimant**

Thomas Elias (instructed by **Freeths LLP**) for the **Defendant**

Hearing date: 16 December 2022

Approved Judgment

This judgment was handed down remotely at 10.30 on 31 January 2023 by circulation to the parties or their representatives by email and released to the National Archives.



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HIS HONOUR JUDGE HACON

Judge Hacon :

Introduction

1. In the autumn of 2020 the Claimant (“M&S”) introduced a new line of products for the Christmas market, gin-based liqueurs. The bottles are festively decorated and the liqueur contains gold flakes which become suspended in the liquid when the bottle is shaken. In the base of the bottle there is an LED light which, when turned on, illuminates the contents of the bottle.
2. The design of these bottles is protected by registered designs. M&S pleaded reliance on five registered designs, set out in the following table. The registration date for each of the designs is 29 April 2021. They all claim the unchallenged priority date of 15 December 2020.

UK Design Number	Illustrations
6134278 (“UK 78”)	
6134280 (“UK 80”)	

<p>6134282 ("UK 82")</p>	
<p>6134284 ("UK 84")</p>	
<p>6134276 ("UK 76")</p>	

3. In November 2021 the Defendant ("Aldi") started to sell gin liqueurs containing gold flakes in a light-up bottle. The liqueurs come in two flavours, clementine and blackberry. The bottles look like this (clementine on the left, blackberry on the right):



4. M&S allege that the advertising and sale of these Aldi products infringes UK 78, 80, 82, and 84 (collectively the “RDs in suit”). At trial no submissions were made on behalf of M&S with regard to UK 76, so I can leave it to one side. There is no counterclaim for a declaration of invalidity of any of the registered designs pleaded.

Brexit

5. The Registered Designs Act 1949 (“the 1949 Act”) is EU-derived retained domestic legislation. As such it is to be interpreted in accordance with the principles of EU law as explained by EU and English courts up to exit day (31 December 2020), specifically where the courts consider equivalent provisions of the Community Design Regulation (EC) No. 6/2002 (“Regulation 6/2002”) and the EU Directive 98/71/EC on the legal protection of designs. This is subject to inconsistent authority from the Supreme Court or Court of Appeal since that date, see s.6 European Union (Withdrawal) Act 2018. Regard may be had to judgments of the CJEU and other EU entities delivered since exit day, including the Board of Appeal of the European Union Intellectual Property Office, see s.6(2) of the 2018 Act.
6. Regulation 6/2002 as amended by Schedule 1 to the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (SI 2019/638) (“the Design Regulation”) remains in force in the UK as retained EU law. It provides for UK rights in substitution for what were Community Design Rights and continuing protection for former Community unregistered design rights created before exit day. The Design Regulation thus has no direct application to the present case.

The statutory law on infringement

7. Section 7 of the 1949 Act identifies the right given to the proprietor of a registered design:

“7. ***Right given by registration***

(1) *The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.*

(2) *For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—*

(a) 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

(b) stocking such a product for those purposes.

(3) *In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration.*

(4) *The right conferred by subsection (1) above is subject to any limitation attaching to the registration in question (including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity)."*

8. A design thus infringes a registration if it does not produce on the informed user a different overall impression to that produced by the design as registered. That said, the task of the court involves more than a simple comparison of two designs and a judgment reached on that comparison. Groundwork has first to be cleared.

Interpretation of the registered designs

The law

9. The scope of protection of a registered design depends on what is shown in the image of the design as registered (subject to s7(4), see above). A potential complication is that it may not be self-evident which features are shown. In *Magmatic Limited v PMS International Group plc* [2016] UKSC 12, Lord Neuberger PSC, with whom Lord Sumption, Lord Carnwath, Lord Hughes and Lord Hodge JJSC agreed, said:

[30] ... It is, of course, up to an applicant as to what features he includes in his design application. He can make an application based on all or any of 'the lines, contours, colours, shape, texture . . . materials . . . and/or . . . ornamentation' of 'the product' in question. Further, he can make a large number of different applications, particularly as the Principal Regulation itself provides that applications for registration have to be cheap and simple to make. As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48:

'The registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by prior art. If he chooses too specific a level he may not be protected against similar designs.'

So, 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.”

10. Generally, issues of interpretation of the image in a registration arise when the image is a line drawing, as was the case in *Magmatic* (see also *Lutec (UK) Ltd v Cascade Holdings Ltd* [2021] EWHC 1936 (IPEC) at [15]-[24] and *Rothy's Inc v Giesswein Walkwaren AG* [2020] EWHC 3391 (IPEC) at [53]-[66]). There are conventions regarding dotted lines, grayscale and so on.
11. Where the image is a photograph of a product, the design claimed consists of the features – the lines, contours, colours, shape, texture, materials and/or ornamentation – visible in the photograph (again, subject to s.7(4)). Usually, there will be no problem of interpretation. The present case is an exception. The point at issue is whether one of the features of each of the RDs in suit is an integrated light in the base of the bottle.
12. A design must be interpreted objectively; the circumstances of the proprietor of the design, and by extension the intention of the designer, are not relevant, see *Celaya Empananza y Galdos Internacional SA v Proyectos Integrales de Balizamiento SL* (Case C-488/10) EU:C:2012:88, at [55].
13. Objective interpretation of a design is a matter for the court – not the court viewing the matter through the eyes of the informed user, particularly since there is no reason to suppose that the notional informed user is aware of the conventional understanding of what dotted lines, grayscale etc. are intended to convey, see *Sealed Air Limited v Sharp Interpack Limited* [2013] EWPC 23, at [20]-[21].
14. Products manufactured by the proprietor which are said to be protected by the registered design are irrelevant to interpretation of the design. *Samsung Electronics (UK) Limited v Apple Inc* [2012] EWCA Civ 1339 concerned an allegation of infringement of a registered design owned by Apple, a design which was adapted in the creation of an early iteration of iPads marketed by Apple. Sir Robin Jacob, with whom Longmore and Kitchin LJ agreed, said:

“[4] So this case is all about, and only about, Apple’s registered design and the Samsung products. The registered design is not the same as the design of the iPad. It is quite a lot different. For instance the iPad is a lot thinner, and has noticeably different curves on its sides. There may be other differences – even though I own one, I have not made a detailed comparison. Whether the iPad would fall within the scope of protection of the registered design is completely irrelevant. We are not deciding that one way or the other. This case must be decided as if the iPad never existed.”
15. Each of the RDs in suit contains the description “Light Up Gin Bottle”. Providing a description is optional under both the UK Registered Design Rules 2006 (“the 2006 Rules”), see rule 4(5), and under Regulation 6/2002, see art.36(3)(a). Both parties submitted that the description was irrelevant to the

interpretation of the designs. That would certainly be true if these were registered Community designs, see art.36(6). I am not sure about the position in relation to UK registered designs for two reasons. First, rule 5(5) of the Registered Design Rules 2006, like art.36(6) of Regulation 6/2002, makes the indication of intended products irrelevant to the scope of protection. But unlike art.36(6) it says nothing about the description being irrelevant. Secondly, whereas the description is not shown on the public register of Community designs, it may appear in the public register of UK registered designs where it has (optionally) been provided by the applicant, see rule 11(2). It does appear in the RDs in suit.

16. I raise this because if it is correct to say that the description is irrelevant in law to the interpretation of a UK registered design, it seems to me that there is a real possibility that members of the public consulting the UK design register could be misled if they are given a steer by the description in a registration when seeking to resolve an ambiguity in the image shown.

This case

17. I was pressed by Mr Selmi for M&S to look at the images of the four RDs in suit as they appear online on the ground that the images there more clearly show the integrated light feature. To my eye the two registrations with images created against a dark background, i.e. UK 82 and UK 84, show the integrated light feature, the other two do not.

Matters to be considered in an assessment of infringement

18. Both M&S and Aldi followed the approach to the comparison of a registered design to an accused design set out in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). This comprises four stages taken from the judgment of the General Court in Case T-525/13 *H&M Hennes & Mauritz BV & Co KG v OHIM* (Case T-525/13) EU:T:2015:617, plus two considerations drawn from other authorities discussed in an earlier section of the judgment in *Cantel*:

“[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.”

19. Points (5) and (6) were not intended to be sequential stages following (1) to (4) but further matters to be taken into account when conducting the comparison in stage (4). They may have been better labelled (4)(d) and (e).

The relevant sector

The law

20. The position in relation to Community Designs was explained by the General Court in *Grupo Promer Mon Graphic SA v OHIM* (Case T-9/07) EU:T:2010:96:

[55] The court observes that, under art.3(a) of Regulation 6/2002 , a design is the appearance of a product, and art.36(2) of that regulation requires that an application for a registered Community design is to contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. However, it must be pointed out that, although the indication of those products in the application for a registered Community design is compulsory, that information does not, by virtue of art.36(6) of Regulation 6/2002 , affect the scope of protection of the design as such.

[56] Accordingly, it follows from art.36(6) of Regulation 6/2002 that, in order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design.

21. This reasoning was not criticised by the CJEU on appeal in *PepsiCo Inc v Grupo Promer Mon-Graphic SA* (Case C-281/10 P) EU:C:2011:679). The upshot is that the indication contained in the registered design of the products in which the design is intended to be incorporated or to which it is intended to be applied provides a pointer to the relevant sector for a Community design, but only “where necessary”. I take this to mean only where the image or “design itself” does not identify the relevant sector clearly enough.
22. Turning to UK registered designs, the 2006 Rules require the applicant for a registered design to specify the product to which the design is intended to be applied or in which it is intended to be incorporated (see rule 5(2)). Yet the RDs in suit here contain no such specification. They contain a Locarno classification, the class being “11- Articles of Adornment”, the sub-class being “02-trinkets, table, mantel and wall ornaments, flower vases and pots”. A Locarno classification is not the same thing as an indication or specification of the relevant product (compare art.36(2) and art.36(3)(d) of Regulation 6/2002). The UK registrar may publish any information he thinks relevant to the registered design (rule 11(2)), so it may be that the registrar thought it sufficient, by way of specifying the relevant products, to state the relevant Locarno classification.

This case

23. M&S proposed a highly specific relevant sector: Christmas liqueur in the UK. Aldi said that the correct sector was, more generally, spirits and liqueurs in the UK.
24. If the published Locarno class and sub-class has any bearing on identifying the relevant sector, I do not find it helpful. There was evidence on which M&S sought to rely that M&S intended to target the Christmas liqueur sector and that its sales of gold leaf liqueur were largely in December. I find this to be of little relevance. It seems to me that just as a design must be interpreted objectively by the court, so the identification of the relevant sector is also an objective assessment. If the image in a registration were to be that of a simple spanner, it would make little sense to be guided by the proprietor’s evidence that it intended, and succeeded, in selling its spanners only during the Christmas period in Norfolk.
25. In the present case I must be guided by the images themselves. The images show decorated and stoppered bottles containing liquid. The decorations are of a winter scene and those images with snow suggest winter. The latter are the images in UK 80 and 84 which show gold flakes in the liquid. UK 82 and 84 further show a light in the base of the bottle.
26. I think that the relevant sector for all of them can be first narrowed down to liquid products sold in decorated bottles, products which may contain gold flakes. The evidence did not identify any liquids other than spirits and liqueurs which are sold in decorated bottles with gold flakes in the liquid. The decorations and the snow, where present, suggest winter, but I do not see that to be a constraint on the months of the year in which sales could be made. Aldi’s characterisation of the relevant sector is correct: spirits and liqueurs in the UK.

The informed user, awareness of prior art and level of attention paid

The law

27. The characteristics of the informed user were summarised by Judge Birss QC in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat) in a passage of his judgment quoted and approved on appeal ([2012] EWCA Civ 1339, at [10]):

“[33] The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo Inc v Grupo Promer Mon-Graphic SA* (C-281/10 P) [2012] F.S.R. 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* (T-9/07) [2010] E.C.D.R. 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM* (T-153/08), judgment of 22 June 2010.

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

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).

However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

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);

He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

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).

[35] 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).”

This case

28. The parties were agreed that on the present facts the user is a consumer, not a supermarket buyer. It follows from the identification of the relevant sector that

the informed user is a member of the UK public who purchases and consumes spirits and liqueurs.

29. As stated in *PepsiCo*, the informed user is more observant than the average consumer of trade mark law, exercising a relatively (relative to the average consumer, presumably) high degree of attention to spirit and liqueur bottles when using them.
30. The direction given by the CJEU that the informed user should where possible be taken to make a direct comparison of the designs in issue (*PepsiCo*, para. 55) is awkward unless the informed user is assumed to have constant access to the register, in which case invariably there will be a direct comparison. The CJEU may have had it in mind that the product marketed by the proprietor of the registered design can be taken as a proxy for the registered design, but that is difficult to accept, see *Samsung* at [4], quoted above.
31. To the extent that it matters, I think that M&S's bottle and Aldi's bottle are used at home, as opposed to being used at two different points of purchase, so there would be an opportunity for direct comparison.

The designer's degree of freedom

The law

32. Arnold J said this in *Whitby Specialist Vehicles Limited v Yorkshire Specialist Vehicles Limited* [2014] EWHC 4242 (Pat):

“[24] ... I considered the designer's degree of freedom in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), [2010] FSR 39 at [32]-[37], where I concluded that design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations. I also concluded that both a departure from the existing design corpus and the production of a wide variety of subsequent designs were evidence of design freedom. Apart from emphasising that the degree of freedom to be considered was that of the designer of the registered design, the Court of Appeal appears to have agreed with this: [2011] EWCA Civ 1206, [2012] FSR 4 at [18]-[20].”

This case

33. M&S filed a witness statement from Jennifer Rea who is their Lead Product Developer for beers, wines and spirits. Ms Rea was the Lead Product Developer for what the development team called the “Gin Globes Project”, which ultimately led to the design protected by the registered designs in suit, via earlier iterations. The first of these, first put on the market on 17 September 2019, was called the “2019 Snow Globe”. Then came the “2020 Glitter Globe”, an elderflower gin liqueur aimed at the summer market, first sold on 14 May 2020. Neither the 2019 Snow Globe nor the 2020 Glitter Globe had an integrated light. They looked like this:

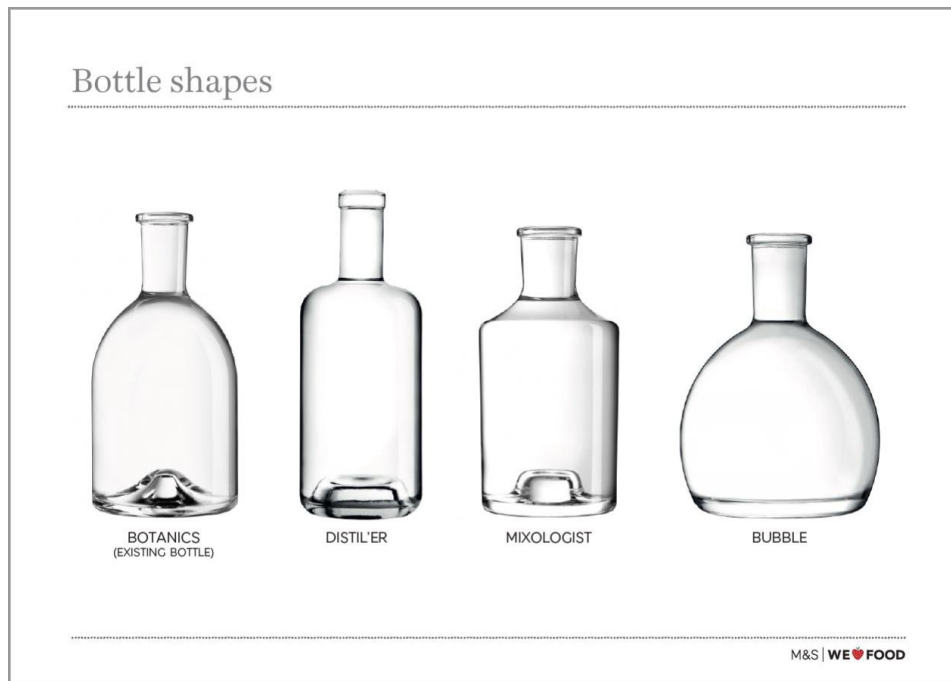


2019 Snow Globe



2020 Glitter Globe

34. The development of the 2019 Snow Globe was done in cooperation with the supplier of the gin liqueur, a French company called Boudier. Ms Rea said that there was a vast range of bottle shapes available, supplied to Boudier by several glass manufacturers across Europe. A prototype was created. Ms Rea identified two design constraints, such as they were: (i) the neck of the bottle had to be sufficiently wide to inject the gin liqueur containing edible gold leaf and (ii) the bottle had to have straight sides in part because they provided a better surface for a design to be created on the glass. There were several alternative options for the stopper, of which a cork stopper was chosen, with what Ms Rea called a “watch strap label” over the stopper.
35. The 2019 Snow Globe was a successful product for M&S in the 2019 Christmas market. In December 2019 it occurred to Ms Rea to wonder whether a light could be added. There were discussions in January 2020 with Boudier and the company that had supplied Boudier with the bottles for the 2019 Snow Globe, Saverglass. A UK-based printer developed the lights which Ms Rea and her team wanted. Five “concepts” were developed with alternative bottle shapes and images to be applied to the bottles. Ms Rea illustrated four shortlisted bottle shapes which were suitable for the project:



36. The team decided on the same “botanics” bottle shape that had been used for the 2019 Snow Globe, with a similar stopper. The winter scene of the 2020 Light Globe was selected for printing on the side of the bottles. The 2020 Light Globe was first marketed on 15 September 2020 and incorporates the designs of the RDs in suit.
37. There was also short evidence from Andrew Maxwell who is a Buying Director at Aldi. He agreed with the two design constraints mentioned by Ms Rea and said that there were more. His first was that it was only possible to create a snow effect using flakes made of gold. A previous Aldi design had used titanium oxide flakes which were appropriately white, but legislation had since prevented their use. Secondly, it was costly to use more than two colours to create the design on the bottle. In cross-examination he said that if the money is available, any bespoke design of bottle could be used but in practice there was a limited off the shelf range. What this limited range would have looked like was not made clear.
38. I find that if a snow effect was to be used, it had to be created by the use of gold flakes. I accept the evidence that the aperture of the bottle had to accommodate the injection of the liqueur with gold flakes in it but I was given no reason to suppose that this was much of a limitation. If a design was to be printed on the side of the bottle, it would be simpler to print on a straight side and the more colours the design had, the more expensive production would be.
39. Otherwise, the designer had considerable freedom, particularly with regard to the shape of the bottle and the design to be printed on it.
40. At least any of the four bottle shapes illustrated by Ms Rea could have been chosen and probably many other shapes without incurring excessive cost. Ms Rea described the range available from Boudier as an “Aladdin’s cave” of alternative designs. It was not clear whether Mr Maxwell’s evidence of a

limited off the shelf range contemplated only one preferred supplier. In evidence five suppliers were mentioned.

41. As to the design on the side of the bottle, if gold snow was to be used in the liquid and if a design was to be printed on the side of the bottle, it made sense to have a winter design. But there was almost complete freedom as to how to make a design look wintry.
42. There was no design constraint requiring the gin to be illuminated. Mr Elias, counsel for Aldi, argued that the light had to be in the base of the bottle. I agree that there would be no other practical place to put it, but this requires the choice of a light in the first place.

Features solely dictated by technical function

The law

43. Section 1C(1) of the 1949 Act provides:

“A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.”

44. There is an equivalent provision in art.8(1) of Regulation 6/2002. In *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat) I said that in effect art.8(1) requires the court to ignore features solely dictated by technical function when comparing a registered design with an accused design:

“[166] It has been held by what was then the OHIM Board of Appeal that art.8(1) of the Design Regulation deprives a feature of protection solely where the need to achieve the product’s technical function was the only relevant factor when the feature in question was selected to be part of the overall design. If aesthetic consideration played any part, art.8(1) does not bite. This is to be assessed objectively from the standpoint of a reasonable observer. See *Lindner Recyclingtech GmbH v Franssons Verkstäder AB* (R 690/2007-3) [2010] ECDR 1, at [28] to [36].

[167] Lindner was followed by Arnold J in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat); [2010] FSR 39, at [31] and apparently also approved by the Court of Appeal in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWCA Civ 1339; [2013] FSR 9, at [31].

[168] Since art.8(1), where it applies, deprives a feature of design protection, I think that such features are to be ignored in the assessment of overall impression under art.10(1). This is to be contrasted with the approach to the related question of designer freedom under art.10(2). As discussed below, assessment of the latter is not binary, but more flexible, with greater or lesser weight being attached to similarities or differences in appearance, as may be appropriate.”

This case

45. Mr Elias argued that the following four features of the designs in suit were solely dictated by technical function: (1) the distribution of gold flakes, i.e. scattered throughout the liquid when the bottle is shaken and otherwise settled at the bottom; (2) the use of gold flakes; (3) leaving the upper, curved portion of the bottle clear of markings and (4) putting the integrated light source in the punt (the dimple) at the base of the bottle.
46. All four features are aspects or consequences of aesthetic choices made by the designer. It is true that once the decision to have a snow effect was made, the inevitable consequence was the use of gold flakes and of course they settle at the bottom of the bottle if the bottle is not shaken. But that does not give the gold flakes a technical function.

The relevance of branding

47. The Aldi bottles have on the front the words “The INFUSIONIST Small Batch”. This was relied on as a difference from the registered designs in which no words appear.

The law

48. The significance of a trade mark on the accused product was considered in *Samsung*:

“[15] The second criticism was based on the fact that the judge took account of the fact that the Samsung products had the trade mark Samsung on both their fronts and backs. It was submitted that the informed user would disregard the trade mark altogether as being a mere conventional addition to the design of the accused product.

[16] Actually what the judge said about the trade mark being on the front of the Samsung tablets was said in the context that Apple was contending that a feature of the registered design was ‘A flat transparent surface without any ornamentation covering the front face of the device up to the rim.’ He said:

‘[113] All three tablets are the same as far as feature (ii) is concerned. The front of each Samsung tablet has a tiny speaker grille and a tiny camera hole near the top edge and the name Samsung along the bottom edge.

[114] The very low degree of ornamentation is notable. However a difference is the clearly visible camera hole, speaker grille and the name Samsung on the front face. Apple submitted that the presence of branding was irrelevant However in the case before me, the unornamented nature of the front face is a significant aspect of the Apple design. The Samsung design is not unornamented. It is like the LG Flatron. I find that the presence of writing on the front of the tablet is a feature which the informed

user will notice (as well as the grille and camera hole). The fact that the writing happens to be a trade mark is irrelevant. It is ornamentation of some sort. The extent to which the writing gives the tablet an orientation is addressed below.

[115] The Samsung tablets look very close to the Apple design as far as this feature is concerned but they are not absolutely identical as a result of a small degree of ornamentation.’

[17] So what the judge was considering was the fact that unlike the design, the front face had some sort of ornamentation which happened to be a trade mark (plus speaker grill and camera hole). Little turned on it in his view, he called it ‘a small degree of ornamentation.’ But it was a difference.

[18] I think the judge was correct here. If an important feature of a design is no ornamentation, as Apple contended and was undisputed, the judge was right to say that a departure from no ornamentation would be taken into account by the informed user. Where you put a trade mark can influence the aesthetics of a design, particularly one whose virtue in part rests on simplicity and lack of ornamentation. The judge was right to say that an informed user would give it appropriate weight – which in the overall assessment was slight. If the only difference between the registered design and the Samsung products was the presence of the trade mark, then things would have been different.

[19] Much the same goes for the Samsung trade mark on the back of the products. Apple had contended that a key feature was ‘a design of extreme simplicity without features which specify orientation.’ Given that contention the judge can hardly have held that an informed user would completely disregard the trade marks both front and back which reduce simplicity a bit and do indicate orientation.”

This case

49. It is no part of M&S’s case that its design lacks ornamentation. Nonetheless the word “Infusionist” (which may or may not be a trade mark, it was not stated) is clear enough to make an impression. It is a presence and a difference from the registered designs. The words “The” and “Small Batch” are less conspicuous, especially on the Clementine bottle, and so play no significant additional part in the overall impression of the designs.

The date of assessment

The law

50. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J expressed the view that the date as of which the overall impression of the registered design is compared with that of the accused design is the date of registration, a view apparently not in issue on appeal [2011] EWCA Civ 1206. It appears that there

was no priority date claimed in relation to the registration in *Dyson*. The reasoning of Arnold J (at [42]-[45]) is relevant:

“[42] The parties were divided as to the correct date as at the overall impression of the allegedly infringing design should be compared with the overall impression of the registered design.

[43] Counsel for Vax contended that the comparison should be made as at the date of the alleged infringement. He submitted that this followed from the fact that art.9(1) of the Designs Directive was expressed in the present tense and from the fact that design freedom could change over time. He accepted that this meant that the scope of protection of the registered design could change over time and could either diminish or increase, but argued that there was no reason why should this not be the case. He also submitted that, if art.9(1) were interpreted as requiring the comparison to be made as at the date of registration of the registered design, then there would be a conflict with art.5(1).

[44] Counsel for Dyson contended that the comparison should be made as at the date of registration of the registered design for four reasons. First, he submitted that it was immaterial that art.9(1) was expressed in the present tense, since art.9(2) must be referring to the degree of freedom of the designer of the registered design which pointed to a comparison as at that date. Secondly, he pointed out that recital (13) referred to the existing design corpus, which must be the design corpus which existed at the date of registration, and that recital (13) had been treated in the authorities as relevant to infringement as well as validity. Thirdly, he submitted that otherwise the scope of protection could be eroded by subsequent designs which adopted the striking features of the registered design one by one. Fourthly, he submitted that the comparison with art.5(1) supported this conclusion, since if the scope of the monopoly could get broader over time a prior art design which was not close enough to invalidate the registered design under art.5(1) could later infringe it.

[45] In my judgment the reasons given by counsel for Dyson for making the comparison as at the date of the registered design, and having regard to the existing design corpus as at that date, are convincing.”

51. Section 14 of the 1949 Act provides:

“14. Registration of design where application for protection in convention country has been made.

(1) An application for registration of a design or designs in respect of which protection has been applied for in a convention country may be made in accordance with the provisions of this Act by the person by whom the application for protection was made or his personal representative or assignee:

Provided that no application shall be made by virtue of this section after the expiration of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

(2) Where an application for registration of a design or designs is made by virtue of this section, the application shall be treated, for the purpose of determining whether (and to what extent) that or any other design is new or has individual character, as made on the date of the application for protection in the convention country or, if more than one such application was made, on the date of the first such application.”

52. It seems to me that Arnold J’s reasoning, taken with s.14(2), leads to the conclusion that where there is a valid priority date, the comparison of overall impressions is to be assessed as of the priority date.

The law on the comparison of overall impressions

53. The key stage in assessing infringement, having done the groundwork of the other stages, is the comparison of the overall impression produced by the registered design with that produced by the accused design, as seen through the eyes of the informed user. The Court of Appeal has given guidance about this in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, at [35], *per* Jacob LJ, with whom May and Dyson LJJ agreed:

“i) For the reasons I have given above, the test is ‘different’ not ‘clearly different.’

ii) The notional informed user is ‘fairly familiar’ with design issues, as discussed above.

iii) Next is not a proposition of law but a statement about the way people (and thus the notional informed user) perceive things. It is simply that if a new design is markedly different from anything that has gone before, it is likely to have a greater overall visual impact than if it is ‘surrounded by kindred prior art.’ (Judge Fysh’s pithy phrase in *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, para 58). It follows that the ‘overall impression’ created by such a design will be more significant and the room for differences which do not create a substantially different overall impression is greater. So protection for a striking novel product will be correspondingly greater than for a product which is incrementally different from the prior art, though different enough to have its own individual character and thus be validly registered.

iv) On the other hand it does not follow, in a case of markedly new design (or indeed any design) that it is sufficient to ask ‘is the alleged infringement closer to the registered design or to the prior art’, if the former infringement, if the latter not. The tests remains ‘is the overall impression different?’

v) It is legitimate to compare the registered design and the alleged infringement with a reasonable degree of care. The court must ‘don the spectacles of the informed user’ to adapt the hackneyed but convenient metaphor of patent law. The possibility of imperfect recollection has a limited part to play in this exercise.

vi) The court must identify the ‘overall impression’ of the registered design with care. True it is that it is difficult to put into language, and it is helpful to use pictures as part of the identification, but the exercise must be done.

vii) In this exercise the level of generality to which the court must descend is important. Here, for instance, it would be too general to say that the overall impression of the registered design is ‘a canister fitted with a trigger spray device on the top.’ The appropriate level of generality is that which would be taken by the notional informed user.

viii) The court should then do the same exercise for the alleged infringement.

ix) Finally the court should ask whether the overall impression of each is different. This is almost the equivalent to asking whether they are the same – the difference is nuanced, probably, involving a question of onus and no more.”

54. Jacob LJ’s point (iii) introduces consideration of the design corpus into the assessment of infringement.

55. In *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat) I said:

“[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 Mon Graphic SA v OHIM* (Case T-9/07) EU:T:2010:96; [2010] ECDR 7, 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.’”

The design corpus

56. The corpus includes designs of which the informed user is not aware, see *Easy Sanitary Solutions BV v Group Nivelles* (Case C-361/15 P) EU:C:2017:720, at [130]-[134]. In that case the CJEU was concerned with validity but I will assume the same applies in the context of infringement. The corpus includes any design “disclosed” within the meaning of art.7 of Regulation 6/2002 at the relevant date. The apparent legal fiction is that for the purpose making a

comparison of overall impressions, the informed user may be directed to compare a design within the corpus of which he or she had hitherto been unaware.

The grace period

The law

57. Section 1B of the 1949 Act sets out what is protected by a registered design. So far as is relevant it provides:

“1B. Requirement of novelty and individual character

(1) *A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.*

(2) *For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.*

(3) *For the purposes of subsection (1) above, a design has 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 before the relevant date.*

...

(5) *For the purposes of this section, a design has been made available to the public before the relevant date if—*

(a) *it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and*

(b) *the disclosure does not fall within subsection (6) below.*

(6) *A disclosure falls within this subsection if—*

...

(c) *it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;*

...

(7) *In subsections (2), (3), (5) and (6) above ‘the relevant date’ means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.*

58. Thus, the designer of a registered design is accorded a grace period in which he may disclose his design without such disclosure being considered relevant to the novelty or individual character of that design when registered, provided the application for registration is made no more than 12 months from the date of disclosure.
59. Pursuant to s.1B(7) and s.14(2), where there is a valid priority date, the grace period extends back over the 12 months preceding the priority date. Put another way, although the novelty and individual character of a registered design falls to be assessed as of the application or priority date, any disclosure of the design by the designer or his successor in title (generally the proprietor) over the previous 12 months is to be ignored in the assessment.
60. Two questions arise. First, does the grace period apply in the context of infringement? The design corpus existing at the appropriate date of comparison is relevant to the assessment of infringement (see para.35(iii) of Jacob LJ's judgment in *Procter & Gamble* above), but should that be taken to include any disclosure of the registered design by the designer in the 12 months preceding the application date or, as the case may be, the priority date?
61. If one assumes that the test of overall impression in relation to any one registered design will invariably be identical for both validity and infringement, the answer must be that the grace period does apply in the context of infringement.
62. Regulation 6/2002 provides an equivalent grace period by art.7(2). So far as is relevant it states:
- “2. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:
- (a) by the designer, his successor in title, ...
- (b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.”
63. The rationale for the grace period was given by the General Court in *Sphere Time v OHIM & Punch SAS* (Case T-68/10) EU:T:2011:269:
- “[24] In relation, first, to the applicability of art.7(2) of Regulation 6/2002 to this case, it should be noted that the objective of that provision is to offer a creator or his successor in title the opportunity to market a design, for a period of 12 months, before having to proceed with the formalities of filing.
- [25] Thus, during that period, the creator or his successor in title may ascertain that the design concerned is a commercial success before incurring the costs relating to registration, without fear that the disclosure that takes place at that time may be successfully raised during

any invalidity proceedings brought after the possible registration of the design concerned.”

64. If the designer’s disclosure or disclosures during the grace period formed the bulk of designs in the relevant sector made available before the application (or priority) date, this would provide no barrier to a registered design being treated as new and having individual character as of that date. But if those earlier disclosures were to be considered relevant to the assessment of infringement, the protection could be reduced to a narrow scope, liable to be insufficient to cover very similar designs of competitors inspired by the designer’s earlier disclosures. The rationale of the grace period would be substantially defeated. It seems to me, therefore, that the design corpus to be considered when assessing infringement excludes the designs disclosed by the designer during the grace period. This is also consistent with the assumption referred to in paragraph 61 above (see *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2006] EWHC 3154 (Ch), at [26]).
65. The second question is whether a disclosure during the grace period is irrelevant to an assessment of novelty and individual character only if it is the specific design claimed in the registered design in suit, or whether the same applies to other similar designs disclosed by the designer during the grace period.
66. Going back to the rationale for the grace period identified in *Sphere Time*, it will commonly be the case that a party wishing to see whether its design is a commercial success, before going to the expense of applying for a registered design, will make and disclose successive iterations in the course of the design’s development before finding the most successful iteration and registering that design. There were three possible intentions of the European legislature at the time the rule of the grace period was created. The first was that in such a case the party would be obliged to apply to register every iteration, including all the failures, in order to be protected. The second, proposed by David Stone, see *European Union Design Law*, 2nd ed., at paras. 10.110-111, was that the rule protects the designer from adverse consequences of any disclosure by him (or a successor in title) during the grace period of (a) the registered design or (b) any design which does not produce a different overall impression to that of the registered design. The third was that a disclosure by the proprietor of any design at all in the grace period does not count as a prior disclosure. Mr Stone indicates that this has support from a decision of the OHIM Invalidity Division (Stone at para. 10.112-113) and is likely to be the correct interpretation of art.7(2).
67. The third best fits the words of s.1B(5) and (6) of the 1949 Act and therefore I think that it is the correct interpretation of those subsections.

The relevance of the grace period to this case

68. Aldi relied on many items in the design corpus in support of its case on infringement and its argument on the narrow scope of protection of the RDs in suit. The items undoubtedly closest in design to the RDs in suit were these:
- (1) M&S’s 2019 Snow Globe, marketed from 17 September 2019.

- (2) M&S's Glitter Globe, first marketed on 14 May 2020.
- (3) M&S's Snow Globe (the same as the registered designs), first marketed on 15 September 2020.
- (4) Aldi's peach & elderflower gin liqueur, first marketed on 7 April 2021.

69. The priority date of the registered designs in suit is 15 December 2020 and so the grace period began on 15 December 2019. For the reasons I have given, in my view, of the above four only the M&S 2019 Snow Globe is to be considered part of the design corpus relevant to the assessment of infringement.

The design corpus in this case

70. As part of its Gin Globes Project M&S produced a concept document in April 2019 which included illustrations of what it called the "gin competition":



71. A later concept document was produced on 18 December 2020, which had an illustration of another 14 bottles (presumably all available three days earlier):



72. The 33 bottles shown here represent a small proportion of the totality within the design corpus by December 2020. Many of the examples in the evidence which are not shown above were extravagantly different to the RDs in suit.
73. Excluding M&S's products, four bottles with an integrated light were marketed before December 2020 but none with a shape like that of the RDs in suit. Five members of the corpus had a snow effect of some sort, none with a bottle shape similar to that of the RDs in suit. Two among the foregoing had both a snow effect and an integrated light.
74. Aldi drew attention to the Crosby and Thatcher gin bottles shown in paragraph 71 above (the latter is in the lower row, second from the right). Within the large corpus, five further examples were found having a shape very similar to these two (Glen Wyvis, Perth, Koppaberg, Morrisons and Todley's). All have relatively high shoulders and are visibly different from the "botanics" shape of the RDs in suit. None has either a snow effect or an integrated light.
75. Saverglass, the manufacturer of the bottles supplied to M&S, has a UK registered design for its botanics shape, registered as of 18 November 2015. It forms part of the corpus:



76. Of the totality of the design corpus and excluding M&S designs made available in the grace period, only the M&S 2019 Snow Globe has the botanics shape and a snow effect (no integrated light).

The comparison of the overall impressions in this case

77. The task of the court is not to identify the closest prior art and then to decide whether the accused design is closer to that prior art or closer to the registered design, see *Procter & Gamble* above at [35(iv)]. Particularly where the closest prior art is, as here, among hundreds of members of the design corpus, its influence on the assessment may be limited.
78. Relevant to this, Jacob LJ also observed in *Procter & Gamble* that the design corpus does not have a bearing on the assessment of infringement because of any statutory provision or other rule of law. It arises from the way that human observation works. There is a continuous spectrum of possibilities but the more strikingly different the registered design is from the design corpus generally and the fewer in the corpus that are close to it in appearance, the more likely it is that an accused design with something of the registered design's unusual features will produce the same overall impression.
79. I did not understand it to be in dispute that Aldi's bottle has a "botanics" shape which is either identical to that of the RDs in suit or so close that it is hard to see any real difference (see the illustrations above).
80. The features that the informed user would note as being in common between the RDs in suit and the Aldi bottle are these:
- (1) The identical shapes of the two bottles. The informed user would pay little attention to the fact that both have in part straight sides. That is true of the vast majority of the spirit bottles shown in the evidence. The informed user would take into account that for economic reasons the range of bottle shapes for spirits and liqueurs does not extend to every functional and aesthetic possibility. However, this would not detract from the apparent identity in shape when measured against the design corpus as a whole.
 - (2) What appear to be the identical shapes of the two stoppers.
 - (3) A winter scene over the entirety of the straight portion of the side, consisting in one case entirely, and in the other case mostly, of tree silhouettes.

- (4) In the case of UK 80 and 84, a snow effect.
 - (5) In the case of UK 82 and 84, an integrated light.
81. In my judgment and with the design corpus in mind, each of those similarities would appear significant to the informed user and cumulatively they would be striking.
82. There are differences. Aldi relied on these:
- (1) The winter scene of the RDs in suit is in white only and features a stag and a doe. On the Aldi bottles the scene is in white and a colour with trees only.
 - (2) The Aldi bottle has the “Infusionist” branding. The RDs in suit have none.
 - (3) The foregoing two features of the Aldi bottle give it a front. There is no front to the RDs in suit.
 - (4) The Aldi winter scene is brighter and busier than that on the RDs in suit.
 - (5) The Aldi stoppers have a watch strap label with the Aldi logo on the top, the RDs in suit do not.
 - (6) The Aldi stoppers are darker in shade than those of the RDs in suit.
83. Going back to the statutory test, it is whether the RDs in suit and the Aldi bottles produce a different *overall* impression. In my judgment they do not because of the features they have in common, set out above. The differences to which Aldi points are there, but they are differences of relatively minor detail which do not affect the lack of difference in the overall impressions produced by the Aldi bottles on the one hand and each of the RDs in suit on the other.

Conclusion

84. The marketing of Aldi’s gin liqueur products complained of infringes M&S’s UK 78, 80, 82 and 84 registered designs.