

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
PATENTS COURT

Royal Courts of Justice
Date: 29 July 2010

Before:
THE HON MR JUSTICE ARNOLD

Between:

DYSON LIMITED	Claimant
- and -	
VAX LIMITED	Defendant

Henry Carr QC and Hugo Cuddigan (instructed by Wragge & Co LLP) for the Claimant
Iain Purvis QC and Anna Edwards-Stuart (instructed by EMW Picton Howell LLP) for the Defendant
Hearing dates: 8-9 July 2010

Judgment

MR. JUSTICE ARNOLD:

Introduction

1. In this action Dyson Ltd (which I will refer to, together with other companies in the same group, as "Dyson") claims that Vax Ltd ("Vax") has infringed Dyson's United Kingdom Registered Design No. 2, 043,779 ("the Registered Design") by importing and marketing Vax's Mach Zen C-91 MZ vacuum cleaner ("the Mach Zen"). There is no challenge to the validity of the Registered Design.

The Registered Design

2. The Registered Design was applied for on 7 December 1994, and that is its date of registration. It is important to note that the application was made, and the Registered Design was registered, under the Registered Designs Act 1949 as then amended, in particular by the Copyright Act 1956 and the Copyright, Designs and Patents Act 1988 ("the pre-implementation 1949 Act"). This was well before the adoption of European Parliament and Council Directive 98/71/EC of 13 October 1998 on the legal protection of designs ("the Designs Directive"), let alone its implementation.
3. The Registered Design is registered in respect of a "vacuum cleaner". It includes a statement of novelty pursuant to rule 15(1) of the Registered Designs Rules 1989 in the following terms:

"The features of the design for which novelty is claimed reside in the shape and configuration applied to the article as shown in the representations. "

I reproduce the representations in Appendix 1 to this judgment.

Background: the DC01 and DC02

4. As is well known, Dyson was the first to introduce two-stage cyclone dust-separation technology for vacuum cleaners as an alternative to the use of porous bags. The first machine to be marketed by Dyson in the United Kingdom using this technology was an upright cleaner known as the DC01 (DC standing for Dual Cyclone). This was launched in 1993. It was very successful. The second machine was a cylinder cleaner called the DC02. This was launched in 1995. It is common ground that in general terms the Registered Design protects the design of the DC02, but there are certain differences between the Registered Design and the design of the DC02, particularly so far as the rear view is concerned.
5. The DC02 is regarded as a classic design. It received numerous accolades and awards as a result of its novel and striking design. It has been exhibited at a number of museums including the Victoria and Albert Museum and the Design Museum in London. Its impact has extended beyond the field of vacuum cleaners.

The Mach Zen

6. The Mach Zen is a multi-stage cyclone vacuum cleaner launched by Vax in 2009. I reproduce in Appendix 2 to this judgment the photographs of the Mach Zen contained in Schedule 4 to Dyson's Particulars of Claim.

The Designs Directive

7. The Designs Directive includes the following recitals:

"(11) Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application and made available to the public by way of publication or consultation of the relevant file;

.....

(13) Whereas 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;

(14) Whereas technological innovations should not be hampered by granting design protection to features dictated solely by a technical function; whereas it is understood that this does not entail that a design must have an aesthetic quality; whereas, likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings; whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection; "

8. It includes the following operative provisions:

"Article 1

Definitions

For the purpose of this Directive:

(a) 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

(b) 'product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

.....

Article 3

Protection requirements

.....

2. A design shall be protected by a design right to the extent that it is new and has individual character.

.....

Article 4 Novelty

A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

Article 5

Individual character

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 before the date of filing of the application for registration or, if 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.

.....

Article 7

Designs dictated by their technical function and designs of interconnections

1. A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

.....

Article 9

Scope of protection

1. The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration. "

9. The United Kingdom implemented the Designs Directive by amending the 1949 Act by means of the Registered Designs Regulations 2001, SI 2001/3949, made under section 2(2) of the European Communities Act 1972. It is common ground that the 1949 Act as amended by the 2001 Regulations ("the post-implementation 1949 Act") has to be construed as far as possible in conformity with the Designs Directive (Case C-106/89 *Marleasing SA v La Comercial Internacional de Alimentación SA* [1990] ECR I-4135). Accordingly, as is now customary in intellectual property litigation in this country, counsel argued the case by direct reference to the Directive.

The Community Designs Regulation

10. Council Regulation 6/2002/EC of 12 December 2001 on Community designs ("the Community Designs Regulation") contains provisions that correspond to those in the Designs Directive. It is common ground that, where this is the case, the provisions in the Designs Directive are to be construed in the same way as the provisions in the Community Designs Regulation.

Legal principles

11. There are a number of points of legal principle which are relevant to the present case. On some of these there is little or no dispute between the parties, but others are more contentious.

Meaning of "shape" and "configuration" in the pre-implementation 1949 Act

12. Section 1(1) of the pre-implementation 1949 Act provided:

"In this Act 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process being features which in the finished article appeal to and are judged by the eye... "

13. "Shape" and "configuration" have long been regarded in UK designs law as close to synonymous, and as denoting the form in which in an article is fashioned in three dimensions, while "pattern" and "ornament" have generally been regarded as denoting two-dimensional surface decoration. In *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [1999] RPC 717, however, Pumfrey J (as he then was) held that "configuration" bore a wider meaning than "shape", namely "the relative arrangement of parts or elements", and hence extended to a circuit diagram. On the other hand, in *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886, [2005] RPC 6 a majority of the Court of Appeal (Jacob LJ and Mance LJ, as he then was) held that the colourways applied to an article of clothing did not constitute either "shape" or "configuration". Jacob LJ noted at [27] that Pumfrey J's decision in *Mackie* had been criticised and left open the question whether it was correct.

Effect of a statement of novelty under the pre-implementation 1949 Act

14. There was no requirement for a statement of novelty in the 1949 Act itself either as originally enacted or as amended down to 1994. The requirement was contained in rule 14(2) of the Designs Rules 1949, which was replaced by rule 15(1) of the 1989 Rules. Both rules were made under the general rule-making power conferred by section 36 of the 1949 Act. Rule 15(1) provided:

"Except in the case of an application to register the pattern or ornament of a design to be applied to a textile article, to wallpaper or similar wall covering or to lace or to sets of textile articles or lace, a statement satisfactory to the registrar of the features of the design for which novelty is claimed shall appear on each representation or a specimen of the design. "

15. The effect of a statement of novelty was stated by Slade LJ giving the judgment of the Court of Appeal in *Sommer Allibert (UK) Ltd v Flair Plastics Ltd* [1987] RPC 599 at 619-620 to be as follows:

"It is important because it defines the scope of the monopoly claimed. While the court does not have to assume that it is correct, it precludes the proprietor, who has obtained his registration on the grounds that certain features of the design give novelty to it, from thereafter denying their novelty and asserting their immateriality, so as to extend the scope of the protected design. "

16. After quoting this dictum, the learned editor of *Russell-Clarke and Howe on Industrial Designs* (7th ed) comments at §3-285:

"This does not mean that it is permissible wholly to disregard the other features of the design as shown in the illustration; the statement of novelty directs special attention to the part or parts of the design identified in the statement of novelty, but it wholly misconceives the purpose of such a statement to read it as if restricting the design to only those features specified. "

Status of designs registered under the pre-implementation 1949 Act after implementation of the Designs Directive

17. It is common ground that the effect of the transitional provisions in the 2001 Regulations is that the issue of infringement of the Registered Design must be determined by reference to the post-implementation 1949 Act, even though its validity, were it in issue, would have to be determined by reference to the pre-implementation 1949 Act. As the editor of *Russell-Clarke and Howe* notes at § 3-07, the requirement that infringement be governed by the post-implementation law appears to be required by the Designs Directive by implication from Articles 11(8) and 12(2); but as he comments at §3-03 the application of different laws to infringement and validity is capable of having startling and unfortunate consequences.
18. There is no provision for a statement of novelty in the post-implementation 1949 Act or in the Registered Designs Rules 2006, although rule 6 of the 2006 Rules does provide for optional partial disclaimers to be made by an applicant for registration.

The informed user

19. In Case T- 9/07 *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal Market* [2010] ECR II-0000 the General Court of the European Union held at [62]:

"It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and 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"

20. In Case T-1 53/08 *Shenzhen Taiden v Office for Harmonisation in the Internal Market* [2010] ECR II-0000 the General Court held:

"46. With regard to the interpretation of the concept of informed user, the status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended.

47. The qualifier 'informed' suggests in addition that, without being a designer or a technical expert, the 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, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

48. However, contrary to what the applicant claims, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product's technical function from those which are arbitrary. "

The existing design corpus

21. Recital 13 of the Designs Directive (corresponding to recital 14 of the Community Designs Regulation) 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.

22. In *Grupo Promer* the Community design was registered for "promotional items for games". The General Court held at [56]:

"... It follows from Article 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."

On this basis the General Court concluded at [60] that the Board of Appeal had properly found that the product in question belonged, within the broad category of promotional items for games, to the particular category of games pieces known as "pogs", "rappers" or "tazos".

Features solely dictated by technical function

23. Article 7(1) of the Designs Directive excludes from protection "features of appearance... which are solely dictated by its technical function". The parties were divided as to the correct interpretation of this provision.

24. Counsel for Dyson relied upon the decision of the Court of Appeal in *Landor & Hawa International Ltd v Azure Ltd* [2006] EWCA Civ 1285, [2007] FSR 9. That case concerned a claim for infringement of unregistered Community design right under the Community Designs Regulation (and a parallel claim for infringement of domestic unregistered design right) in certain features of a design for a suitcase. The defendant contended, *inter alia*, that those features were excluded from protection by Article 8(1) of the Community Designs Regulation, which corresponds to Article 7(1) of the Designs Directive.

25. At first instance His Honour Judge Fysh QC sitting in the Patents County Court rejected this contention for reasons he expressed as follows:

"The question is therefore: is the *appearance* of Landor's design *solely dictated* (i. e. driven without option) by the technical function? In my view, the answer is "no". I say this because of the spatial position of the constituent elements (big piping/zip/normal piping/zip/big piping) and by the presence of the piping elements themselves which introduce an essentially non-functional and even capricious element to the final appearance of the ensemble."

26. In the Court of Appeal the defendant attacked this conclusion on the grounds that (i) the judge had been wrong to construe Article 8(1) so narrowly and (ii) the features in question were purely functional.

27. So far as the construction of Article 8(1) was concerned, the defendant argued that the judge ought to have held that "dictated solely by function" meant "attributable to function", so that if more than one shape could perform the same function then all such shapes were excluded from protection. In support of this argument the defendant relied upon the decision of the Court of Justice of the European Communities (as it then was) in Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475 at [78]-[79] interpreting Article 3(1)(e) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ("the Trade Marks Directive") and on the decision of the House of Lords in *Amp Inc v Utilux Pty Ltd* [1972] RPC 103 interpreting section 1(3) of the 1949 Act as it then stood.

28. Neuberger LJ (as he then was), with whom May and Wilson LJJ agreed, held that neither of these decisions could safely be relied on in order to interpret Article 8(1) and noted the comment of Advocate General Colomer in his opinion in the former case at [34] that the wording used in Article 7(1) of the Designs Directive was narrower than that in Article 3(1)(e) of the Trade Marks Directive. Neuberger LJ also said at [38]:

"The judge's conclusion as to the ambit of Art. 8.1 is consistent with the views expressed by the editors of *Copinger & Skone James (op cit)* at para. 13-208. It is true that it is there said that it is not clear whether the exclusion in Art. 8.1 'will only apply to a design that is the only design by which the product in question could perform its function or whether it operates whenever a design was as a matter of fact dictated solely by the function of the product even though it was not the only design that was capable of allowing that function to be performed'. However, the editors go on to 'submit... that the former (narrower) construction of Article 8.1 is the correct one'. They draw support, rightly in my view, from recital (10) of the Designs Directive, which, they suggest, show that 'the technical function exclusion was intended to be construed narrowly and that it should be construed in a way that does not unduly restrict the availability of protection for non-aesthetic (i. e. functional) designs'."

29. Counsel for Dyson submitted, and I accept, that it is clear that the Court of Appeal endorsed the judge's construction of Article 8(1). Counsel for Vax, however, drew attention to what Neuberger LJ went on to say (emphasis added):

"40. A sure nonetheless contends that the judge should have rejected Landor's case for EUUDR on the facts, namely on the basis that the Expander Design was purely functional. Apart from the fact that this is (either precisely or nearly) the same argument on the facts as failed in relation to Landor's UKUDR claim, it is inconsistent with what the judge's findings in [42], quoted above. In that paragraph, which was directed to the EUUDR claim, the judge found that it was design with non-functional (and as the judge put it 'capricious') aspects.

41. It seems to me that this clearly disposes of the argument that the 'features of a appearance' of the Expander Design in this case were 'dictated solely by its technical function'. *Even if 'solely' is not given the limiting meaning which the judge held*, then, as I see it, the inclusion of the word in Art. 8.1 nonetheless would render it difficult

for Azure to contend that the design in the present case is caught by the Article, because the design has been found by the judge, in circumstances where this was open to him, to be in part 'capricious'."

Counsel for Vax submitted, and I agree, that it followed that the Court of Appeal's decision as to the interpretation of Article 8(1) was strictly obiter.

30. For his part, counsel for Vax relied on the decision of the Third Board of Appeal of OHIM in Case R 690/2007-3 *Lindner Recyclingtech GmbH v Franssons Verkstader AB* [2010] ECDR 1. In that case the Board, whose rapporteur was David Keeling, considered the interpretation of Article 8(1) of the Community Designs Regulation in a passage which merits quotation in full despite its length:

"28. The interpretation of art. 8(1) CDR (and of the corresponding provision in art. 7(1) of Council Directive 98/71 on the legal protection of designs [1998] OJ L289/28) is highly controversial. Similar provisions existed in the designs legislation of several Member States prior to harmonisation of the law by Directive 98/71. The assumption has generally been made that the purpose of such provisions is to prevent design rights from being used to obtain monopolies over technical solutions without meeting the relatively stringent conditions laid down in patent law. Two contrasting views have been canvassed in the legal literature. One view holds that a technical necessity exception, such as that contained in art. 8(1) CDR applies only if the technical function cannot be achieved by any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That theory - known as the multiplicity-of-forms theory - is defended by some German authors (see, for example, P. Schramm, *Der europaweite Schutz des Produktdesigns*, (Baden-Baden: Nomos Verlagsgesellschaft, 2005), pp. 242 et seq., and U. Ruhl, *Gemeinschaftsgeschmacksmuster: Kommentar*, (Köln-Berlin-München: Carl Heymanns Verlag, 2007), pp. 169 et seq.) and was formerly followed by the French courts (see, D. Cohen, *Le droit des dessins et modèles*, 2nd edn, (Paris: Economica, 2004), p. 22). Advocate General Ruiz-Jarabo suggested in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99) [2003] Ch. 159; [2002] E. C. R. I-5475 at [34] of the Opinion that art. 7(1) of the Designs Directive (and therefore obviously art. 8(1) CDR) should be interpreted in that manner. He stated:

'... a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.'

The Advocate General's comment is clearly an obiter dictum since *Philips v Remington* was a case on the interpretation of art. 3(1)(e) of Council Directive 89/104 to approximate the laws of the Member States relating to trade marks ([1989] OJ L40/1)

(TMD). Article 3(1)(e) TMD excludes from trade mark protection, 'signs which consist exclusively of the shape of goods which is necessary to obtain a technical result'.

29. The multiplicity-of-forms theory has been adopted by courts in the United Kingdom (see the judgment of July 28, 2006 of the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285; [2006] E. C. D. R. 31) and Spain (Juzgado de lo Mercantil PTO Numero Uno de Alicante, Auto No. 267/07 *Silverlit Toys Manufactory Ltd v Ditro Ocio* 2000 SL Unreported, November 20, 2007).

30. There is none the less a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product's appearance is not 'solely dictated by its function' simply because an alternative product configuration could achieve the same function, art. 8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated. That purpose, as was noted above, is to prevent design law from being used to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with. If a technical solution can be achieved by two alternative methods, neither solution is, according to the multiplicity-of-forms theory, solely dictated by the function of the product in question. This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function (see W. Cornish and D. Lewelyn, *Intellectual Property: Patents, Copyright Trade Marks and Allied Rights*, 5th edn, (London: Sweet & Maxwell, 2003), p.549). This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.

31. The principal alternative, discussed by academic authors, to the multiplicity-of-forms theory has its origin in English case law. The case of *Amp Inc v Utilux Pty Ltd* [1971] F. S. R. 572 concerned the interpretation of a provision of the Registered Designs Act 1949 which denied protection to the features of a design that were solely dictated by a product's technical function. The House of Lords held that a product's configuration was solely dictated by its technical function if every feature of the design was determined by technical considerations. The striking similarity between s.1(3) of the 1949 Act and art. 8(1) CDR does not of course mean that the approach of the House of Lords in *Amp Inc v Utilux Pty Ltd* must necessarily be adopted in relation to the Community provision. Indeed, as was noted above in [29], the multiplicity-of-forms theory has now been adopted by the English Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd*. Thus the Court of Appeal must have thought that the approach taken in *Amp Inc v Utilux Pty Ltd* was no longer valid, following harmonisation, in spite of the similar wording of the Community provisions and the 1949 Act. The approach taken in *Amp Inc v Utilux Pty Ltd* would, however, have the advantage of allowing the purpose of art. 8(1) CDR to be achieved. No-one would be able to shut out competitors by registering as Community designs the handful of possible configurations that would allow the technical function to be realised. This may explain why the French courts, which formerly espoused the multiplicity-of-forms theory, began to abandon that theory at the beginning of the 21st century in favour of an interpretation which closely resembles the *Amp Inc v Utilux Pty Ltd* approach (see the judgments cited by D. Cohen, *Le droit des des sins et modèles*, 2nd edn, (Paris: Economica, 2004), pp. 23-24).

32. In addition to being supported by a teleological interpretation, the approach discussed in the previous paragraph is also supported by the wording of art. 8(1) CDR. That provision denies protection to features of a product's appearance that are, 'solely dictated by its technical function'. Those words do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected.

33. Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at. In the case of some products, such as pictures and ornaments, their very function is to please the eye. In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant. That is why the Community design legislation denies protection to component parts that are not visible in normal use. In the case of most products the designer will be concerned with both the functional and the aesthetic elements. That applies also to large items of industrial equipment, such as shredders for use in recycling plants. The shredder must, in the first place, perform its function effectively and safely and without creating excessive noise, but it is also desirable that the shredder should be pleasing to the eye and thus enhance the working environment of the people who operate it and see it in use. For that reason there is no objection in principle to granting design protection to industrial products whose overall appearance is determined largely, *but not exclusively*, by functional considerations.

34. It is often pointed out that the Community design legislation, unlike the old laws of some Member States, does not lay down any requirement of aesthetic merit, artistic creativity or eye appeal. The absence of such a requirement is expressly mentioned in the 10th recital in the preamble of Regulation 6/2002 and in the 14th recital in the preamble to Directive 98/71. Some authors infer from this that purely functional designs are protectable. That is a false analysis. Community design law is concerned with the visual appearance of products. That is clear from the definition of 'design' in art. 3(a) CDR and from the requirement of visibility in normal use for component parts in art. 4(2)(b) CDR. Those parts of a product that cannot be seen are of no concern to the Community law of design because no one cares what they look like. All that matters is that such parts perform their function. If the law were intended to protect purely functional designs it would not be logical to exclude the non-visible aspects of design from protection.

35. The significance of limiting protection to the visual appearance of products is that aesthetic considerations are in principle capable of being relevant only when the designer is developing a product's visual appearance. Most of the time the designer will be concerned with both elements of good design: functionality and eye appeal. In some cases functionality will be the dominant preoccupation of the designer. The need to make a product that works will be uppermost in the designer's mind and will largely determine the appearance of the product. As long as functionality is not the only relevant factor, the design is in principle eligible for protection. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. This is not, it must be stressed, tantamount to introducing a requirement of aesthetic merit into the legislation. It is simply recognition of the obvious fact that when aesthetics are totally irrelevant, in the

sense that no one cares whether the product looks good, bad, ugly or pretty, and all that matters is that the product functions well, there is nothing to protect under the law of designs.

36. It follows from the above that art. 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen. "

31. Counsel for Vax submitted that this was a compelling analysis, and in particular the point made by the Board at [30]. Counsel for Dyson had no convincing answer to that point. It does not appear to be a point which was made to the Court of Appeal in *Landor & Hawa*. In my view the Board of Appeal's analysis is persuasive. I therefore conclude that the interpretation placed on Article 8(1) of the Community Designs Regulation, and hence Article 7(1) of the Designs Directive, by the Board of Appeal is to be preferred to that adopted by the Court of Appeal in *Landor & Hawa*.

The designer's degree of freedom

32. Article 9(2) of the Designs Directive provides that the degree of freedom of the designer is to be taken into account in assessing the scope of protection conferred by a registered design.

33. In *Grupo Promer* the General Court held:

"67.... it must be noted that the designer's degree of freedom in developing his design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned.

68. At paragraph 18 of the contested decision, the Board of Appeal stated that all the 'rappers' or 'tazos' examined in the present case consisted of small, flat or slightly curved discs which may be made of plastic or metal. Accordingly, it concluded, at paragraph 20 of that decision, that the freedom enjoyed by the designer responsible for designing a product of that kind was severely restricted, because, for that type of product, ' [t]he paradigm... is a small flat or nearly flat disk on which coloured images can be printed [and o]ften the disk [is] curved toward[s] the centre, so that a noise [is] made if a child's finger presses the centre of the disk', and ' [a] rapper that does not possess these characteristics is unlikely to be accepted in the marketplace'.

69. In that connection, it must be noted that 'pogs', 'rappers' or 'tazos' are circular in shape and that, on the date of filing of the application

for registration of the contested design, in this case on the date of priority claimed for the design, 'pogs', 'rappers' or 'tazos' had those common features which the designer had to take into account, as set out at paragraphs 18 and 20 of the contested decision and reiterated at paragraph 68 above. That finding is not, moreover, contested by the parties.

70. Therefore, it must be held that the Board of Appeal was correct to find in the contested decision that, on the date of priority claimed for the contested design, the designer's freedom was severely restricted since he had to incorporate those common features in his design for the product in question. Moreover, as the Board of Appeal pointed out at paragraph 20 of the contested decision, the designer's freedom was also limited in so far as those items had to be inexpensive, safe for children and fit to be added to the products which they promote. "

34. Counsel for Vax submitted, and I accept, that this passage indicates 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 (i) economic considerations (e. g. the need for the item to be inexpensive).

35. In *Shenzhen* the General Court held:

"51. In paragraph 21 of the contested decision, the Board of Appeal found that, although certain features must be present in a conference unit if it is to perform its function, the degree of freedom of the designer of a conference unit was nevertheless relatively wide.

52. In order to challenge the validity of that conclusion, the applicant puts forward, first, the fact that many features of a conference unit as well as their configuration are dictated by the technical function of the device and, second, the existence of a general trend favouring small, flat, rectangular devices, often including hinged elements.

53. With regard to the first factor, it is admittedly true that, in order to fulfil its essential function, a conference unit must have, at the very least, a speaker and a microphone, directed in such a way that the user can hear the sound reproduced by the speaker and his speech can be captured by the microphone. Similarly, buttons which are accessible to the user are necessary, in particular, in order to turn the microphone on and to regulate the volume of the speaker. Furthermore, to the extent that conference units also have associated functions, features such as voting buttons, the screen and the card slot may also prove necessary from a functional point of view.

54. However, as OHIM and the intervener have contended, those restrictions concern the presence of certain features in the conference unit, but do not have a significant impact on their configuration and, therefore, on the form and general appearance of the conference unit itself. In particular, it does not seem that a hinged element would be necessary in order to ensure any of the device's functionality.

55. That conclusion is borne out by the design corpus, as submitted by the intervener to O'HIM, which shows conference units of varying shapes and configurations that differ perceptibly from those used in the contested design. Therefore, depending on the model, the microphone is placed on a stem, or not, on the left, or the right or in the middle of the body of the device. In the same way, if the card slot is normally placed on the right, it is generally not integrated into the speaker of the conference unit but in the actual body of the device. In addition, the presence of any hinged element is the exception rather than the rule."

36. Counsel for Dyson submitted, and I accept, that this passage demonstrated that the designer's degree of freedom could be tested by reference to the existing design corpus. As Jacob LJ put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8 at [57]:

"A large departure from the prior design corpus is indeed an indication of design freedom."

37. Counsel for Dyson also submitted, and I accept, that evidence of design freedom could also come from designs produced after the date of the registered design. If a wide variety of designs was produced after the registered design, that is evidence that the designer of the registered design had not been constrained to design the product in the way that he had.

Effect of design freedom on the scope of protection

38. Article 9(2) of the Designs Directive indicates that, other things being equal, a registered design should receive a broader scope of protection where the designer had a greater degree of freedom and a narrower scope of protection where the designer had a lesser degree of freedom. Thus in *Grupo Promer* the General Court held:

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

.....

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

Effect of differences between the registered design and the design corpus on the scope of protection

39. Recital (13) of the Designs Directive indicates that, other things being equal, a registered design should receive a broader scope of protection where the registered design is markedly different to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. Thus in *Grupo Promer* the General Court held at [72]:

"... as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to

common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user.... "

40. Conversely, in *Procter & Gamble* Jacob LJ held at [35(ii)]:

"... 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' (H. H. Judge Fysh's pithy phrase in *Woodhouse* at [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. "

41. Counsel for Vax accepted that in general the proposition stated by Jacob LJ would normally be correct, but submitted that it would not be correct where the striking elements of the design were ones where there was little design freedom, in particular because of technical requirements. More specifically, he argued that, if the registered design was based on a new technology bringing with it new design constraints, then differences between the registered design and an existing design corpus based on old technology might have little relevance when it came to comparing the registered design with a subsequent design based on the new technology. In principle I accept this point.

The date as at which the overall impressions are to be compared

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 Article 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 Article 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 Article 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 Article 9(1) was expressed in the present tense, since Article 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 Article 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 Article 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.

Overall impression

46. It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J in *Rolawn Ltd v Turfmech Ltd Machinery Ltd* [2008] EWHC 989 (Pat), [2008] RPC 27:

"123.... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125.... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of "overall impression" - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as "a canister fitted with a trigger spray device on the top", in the present case it is too general to describe either product as "a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point", and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities....

126 In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised similarities means that the machines give the same overall impression....".

Reference to the Court of Justice?

47. During the course of argument there was some debate as to whether questions should be referred to the ECJ as to the interpretation of the the Designs Directive. Although I consider that some of the issues considered above involve points of interpretation of the Designs Directive which are not *acte clair* and which are likely to require resolution by the ECJ at some point, I have come to the conclusion that a reference is not necessary for the resolution of the present case because those issues are unlikely to be determinative.

The witnesses

48. Dyson called three factual witnesses. Andrew Thomson was the principal designer of the DC02. James Turner was Dyson's Graphics Manager at the time of the launch of the DC02,

and he gave evidence about some photographs used in the publicity campaign. Matthew Johnson is employed by Dyson as a competitor analyst and he gave evidence about some vacuum cleaners advertised in a recent Argos catalogue. Dyson also called Peter Gammack, its Concept Design Director, as an expert witness. Vax called Paul Bagwell, its Head of Product Development, as an expert witness. I should record that Mr Bagwell's report included some helpful marked-up comparative photos of examples of a DC02 and a Mach Zen that had been spray-painted the same colour illustrating points of similarity and difference between the respective designs. (I also had the opportunity to inspect the exhibits in question, as well as quite a large number of other exhibits). Otherwise, it is not necessary to comment on the evidence of any these witnesses individually. I have taken all their evidence into account.

Assessment

49. Applying the principles discussed above to the facts of the present case, my assessment is as follows.

The informed user

50. There is no dispute that the informed user in the present case is a knowledgeable user of domestic vacuum cleaners.

The effect of the statement of novelty

51. Counsel for Vax submitted that the effect of the statement of novelty in the Registered Design was to exclude anything other than the "shape" and "configuration" of the article from the scope of the monopoly, and hence to exclude other aspects of the design of the article shown in the representations, including the fact that the dust collection bin is transparent. He nevertheless argued that the design corpus was to be assessed on the basis that the article shown in the representations was a cyclonic vacuum cleaner, and accepted that the only way in which the informed user could know that it was a cyclonic vacuum cleaner was because the user could see the shroud of the outer cyclone within the bin in the representations as a result of the bin being transparent. He sought to escape from the apparent paradox to which these submissions lead, that one must disregard the transparency of the bin and yet one can only see what is within the bin because it is transparent, by arguing that the court should not notionally treat the bin as opaque, but rather should ignore the transparency of the bin when assessing the overall impression produced by the Registered Design and comparing it to the overall impression produced by the Mach Zen.

52. Counsel for Dyson accepted that the fact that the bin was transparent was not in itself a feature of shape or configuration, but disputed that the statement of novelty required the court to ignore the transparency of the bin. He submitted that the transparency of the bin nevertheless affected the shape or configuration of the article depicted in the representations. Furthermore, he agreed with counsel for Vax that the informed user would know that the vacuum cleaner was cyclonic and that the only way in which the user could know this was because the user would see the cyclone within the bin. He disputed that the transparency of the bin should be ignored when assessing the overall impression produced by the Registered Design.

53. I have not found this issue easy to resolve. Speaking for myself, I find it difficult to see how the scope of protection of the Registered Design under the Designs Directive can be affected by an artefact of the pre-implementation domestic law. Counsel for Dyson did not argue,

however, that the statement of novelty should simply be disregarded. I must therefore proceed on the basis that it is to be taken into account.

54. That being so, I have come to the conclusion that the solution to the conundrum is provided by the comment of the editor of *Russell-Clarke and Howe* quoted above. If one leaves the statement of novelty on one side, the transparency of the bin is plainly a feature of the design depicted in the representations which contributes to its eye appeal. I do not consider that the statement of novelty requires this feature to be ignored even if transparency is "pattern" or "ornament" rather than "shape" or "configuration". (The means by which the transparency is achieved - such as the use of a transparent plastic - is clearly none of these, but in my view that is a separate point.) The fact that it is common ground that the informed user would know that the article depicted in the representations was a cyclonic vacuum cleaner because the informed user would see the cyclone within the bin supports this conclusion.

The existing design corpus

55. The parties were sharply divided as to the relevant existing design corpus in this case. Dyson contends that it consists of cylinder vacuum cleaners. This is narrower than the indication in the registration and takes into account the nature of the product shown in the representations. By contrast, Vax contends that there was no existing design corpus at all in December 1994. This is on the basis that the relevant product category is cyclonic cylinder vacuum cleaners, and the first product to be marketed in that category was the DC02. Indeed, at times counsel for Vax appeared to be contending that the relevant product category was two-stage cyclonic cylinder vacuum cleaners.

56. I have to say that, from a forensic perspective, I find Vax's contention a surprising one, since it would apparently lead to the Registered Design having a broader scope of protection than if the design corpus were as Dyson contends. Be that as it may, I consider that Dyson is correct on this point. Although it is common ground that the informed user would appreciate the article depicted in the representations was a cyclonic cylinder vacuum cleaner, I consider that the informed user would regard it as simply a cylinder vacuum cleaner with a particular dust separation technology. On the evidence, there is not a recognised separate sub-category of cyclonic cylinder cleaners even now. Instead, the distinction that is commonly made is between bagged and bagless cylinder cleaners.

57. The evidence demonstrates that in 1994 there were two main types of cylinder vacuum cleaner, described by Mr Gammack as "sledge" layout machines and "tank vacs". The former were shaped like a lozenge or bar of soap. The latter were barrel-shaped machines. The "sledge" layout machines were quite similar to each other in terms of their overall appearance.

Differences between the registered design and the existing design corpus

58. Dyson contends that the Registered Design is strikingly different both in overall appearance and in numerous detailed aspects of the design to the existing design corpus of cylinder vacuum cleaners in December 1994. In my judgment the evidence supports that contention.

Features dictated solely by function

59. Vax contends that the transparent bin, even if not excluded by the statement of novelty, is a feature dictated solely by function within Article 7(1) of the Designs Directive. The function in question is that of enabling the user to see when the bin is full of dirt and hence needs emptying. I do not accept this. Applying the test set out in *Lindner* at [36], I am not satisfied that

the transparent bin was chosen for purely functional reasons and not, at least to some degree, for the purpose of enhancing the cleaner's visual appearance. Indeed, it was not put to Mr Thomson that this was the case. His evidence was that the clear bin was chosen for a mixture of technical and aesthetic reasons. Considering the matter objectively, I accept that both technical and aesthetic factors are relevant.

Degree of design freedom

60. Dyson contends that the evidence shows that the designer of a cylinder vacuum cleaner has a great deal of design freedom. Dyson says this remains so if one restricts one's attention to bagless cylinder cleaners, and even if one restricts one's attention to cyclonic cylinder cleaners. In support of these contentions Dyson points to a series of cylinder vacuum cleaners that have been marketed since December 1994 that vary widely in their appearance from the Registered Design. In general, I accept that the evidence shows that a considerable variety of designs has been marketed.

61. That is not the end of this aspect of the matter, however, because Vax contends that the marketing of a variety of designs does not disprove the existence of relevant design constraints. Counsel for Vax submitted that the exercise undertaken by Dyson of collecting cylinder cleaners of different appearance was of little probative value for two main reasons. The first was that the degree of design freedom depended on the technical specification of each cleaner, particularly in terms of its dust separation technology, size, weight, electrical power consumption and suction power. As counsel for Vax put it, the freedom of the designer referred to in Article 9(2) is not the freedom to develop a technically inferior product. The second was that the degree of design freedom depended on other intellectual property rights, and in particular patents, owned not only by the parties but also third parties.

62. I accept that, in general, the degree of freedom of the designer must be judged by reference to the technical specification of the product he is designing. Other things being equal, a high technical specification is likely to impose greater technical constraints, and leave the designer a lesser degree of freedom, than a low technical specification. I therefore accept that care must be taken when comparing the Mach Zen, which is a high specification machine, with third party designs of lower specifications. I have endeavoured to take this into account when considering the similarities relied on by Dyson below.

63. I do not accept that the existence of other intellectual property rights is a relevant consideration, or at least not unless it is specifically proved that particular rights existed which imposed particular constraints on the freedom of the designer at the relevant time. In the present case Vax did not prove that any particular rights existed which imposed particular constraints at any relevant date.

Similarities relied on by Dyson

64. Although stressing that overall impression is what matters, Dyson has identified nine respects in which it contends that the Mach Zen is similar to the Registered Design while the Registered Design differs from the existing design corpus. I shall consider these in turn.

65. *A bin inclined at substantially halfway between vertical and horizontal.* It was common ground between the witnesses that it is possible to orient a multi-cyclone separator at any angle from vertical to horizontal. There was also a considerable measure of agreement, however, that there are some technical considerations that favour a vertical orientation and others that favour a horizontal orientation, and that the trade-off between them favours an angle of around 45°. To

that extent, therefore, the degree of freedom of the designer of the Mach Zen was restricted if he wanted to achieve the best technical compromise.

66. Counsel for Vax accepted that, at this level of generality, the Mach Zen was similar to the Registered Design while this feature was not present in the existing design corpus. He submitted, however, that, given the restricted degree of freedom of the designer of the Mach Zen, the similarity in itself was not of great significance. I accept this submission.

67. Furthermore, he submitted that in any event the informed user would consider the design of the bin as a whole and notice a number of differences between the Mach Zen and the Registered Design in this respect. I agree with this. The principal differences are as follows:

- i) The Dyson bin is a simple cylinder shape. The base is largely invisible in the Registered Design since it is hidden by the bumper. Because of the shape of the housing surrounding the bin, the cylinder appears to flare out towards the top. By contrast, the Mach Zen bin is "rocket-shaped", with three sections which step down in diameter towards the top. The larger diameter section flares out towards the bottom. It has a very visible frusto-conical base.
- ii) The handle on the Dyson is a simple triangle shape with a slightly rounded hypotenuse, forming a narrow angle where it meets the bin towards the bottom. It is a simple piece of clear, flat plastic. The handle on the Mach Zen is a much more significant design feature. It runs parallel with the wall of the bin and is formed from a semi-circular section length of plastic, concave where the thumb would sit. There is a grip area at the top, designed for fingers to pass through. The bottom area is filled in with plastic.
- iii) The Mach Zen has a highly visible hinge for the base at the bottom of the hand, so the user can open the bottom to dispose of the dust. The Dyson has no hinged base. (Although one cannot see this from the Registered Design, the dust is tipped out of the top of the bin.)
- iv) The Mach Zen bin is significantly bigger than the Dyson bin in both absolute and relative terms.

68. *The bin is transparent, and through it the cyclone shroud is visible.* For the reasons given above I do not accept Vax's arguments that the transparent bin is not a feature of the Registered Design or that it is excluded under Article 7(1) of the Designs Directive.

69. In the further alternative Vax contends that the designer's freedom was constrained by the need for the user to see when the bin is full. So far as this is concerned, it is common ground that there are other possible solutions. One could have a window, one could have a tinted bin and one could have some kind of a detector with an indicator light or sounder. On the evidence, however, each of these alternatives had drawbacks. A window is unsatisfactory because dirt may not accumulate evenly in the bin, a tinted bin is unsatisfactory because it is less easy to see the dirt and a detector plus indicator involves added expense and complexity. It follows that ease of use and cost considerations both point to adoption of a transparent bin. Again, therefore, the degree of freedom of the designer of the Mach Zen was restricted if he wanted to achieve the best solution.

70. Counsel for Vax accepted that the Mach Zen was similar to the Registered Design in having a transparent bin while this feature was not present in the existing design corpus. He

again submitted, however, that, given the restricted degree of freedom of the designer of the Mach Zen, this similarity in itself was not of great significance. I accept this submission. Furthermore, as I have already said, I also accept that the informed user would consider the design of the bin as a whole and note the differences identified in paragraph 67 above.

71. As for the shape and appearance of the cyclone visible through the bin, this is completely different between the two designs.
72. *A co-axial pair of wheels at the rear of the machine, oversized such that they extend to approximately half the height of the body of the machine.* It is common ground that it is not necessary for a cylinder vacuum cleaner, or even a cyclonic cylinder cleaner, to have large rear wheels. Vax nevertheless contends that the designer's degree of freedom is constrained by technical considerations. The evidence is that there is an advantage to having a pair of large wheels since this makes it easier to drag the machine over obstacles. Furthermore, there is an advantage to locating these wheels close to the motor which is the heaviest part of the machine, and in both the DC02 and the Mach Zen this is at the rear of the machine.
73. Once again, counsel for Vax accepted that the Mach Zen was similar to the Registered Design in having this feature while it was not present in the existing design corpus, but submitted that, given the restricted degree of freedom of the designer of the Mach Zen, this similarity in itself was not of great significance. Once again, I accept this submission.
74. Furthermore, as counsel for Vax submitted, the informed user would notice considerable differences between the respective rear wheel designs:
- i) In the Registered Design the housing is at an angle to the wheels such that the front half of the wheels is approximately flush with the wheel arch while the rear half protrudes increasingly outside the wheel arch and rear housing but not completely. By contrast, in the Mach Zen the housing is parallel to the wheels, and the front half of the wheels protrudes beyond the wheel arch while the rear half is not covered at all.
 - ii) In the Registered Design the wheels are located wholly within the housing and do not extend beyond the rear of the body of the machine. By contrast, in the Mach Zen the wheels do extend beyond the rear of the body of the machine.
 - iii) In the Registered Design the "tyre" portion of the wheels is rounded and quite stylised. By contrast in the Mach Zen the "tyre" portion is more angular and less stylised so that it looks more like a real tyre.
 - iv) In the Registered Design the wheel hub is smooth and featureless apart from a shallow central dimple. By contrast in the Mach Zen the hub bears a prominent central raised disc and eight radiating "sun rays".
75. *The wheels are spaced apart to define the widest part of the machine.* Vax contends there is little design freedom in this respect since the wheels need to be located at the outer part of the machine to give it stability. Dyson ripostes that the wheels do not have to be set so far apart. I conclude that it is advantageous for stability reasons for the wheels to be spaced apart and to that extent the designer's freedom was restricted. Furthermore, the effect of the first of the differences identified in paragraph 74 above is that in the Mach Zen the wheels appear to be spaced further apart than in the Registered Design.

76. *Prominent wheel arches extending over the top of the wheels, part of each of which is formed by an elongated operational button. It is convenient to deal with the wheel arches and buttons or pedals separately.*
77. So far as the presence of wheel arches is concerned, Vax contends that the designer's freedom is constrained by the need to prevent debris from dropping into the wheel mechanism. I accept this. Furthermore, the wheel arches are bound to have some prominence given the size of the rear wheels. Apart from that, however, the respective arches are quite different. In the Registered Design, as noted above, the wheel arch extends almost flush over the wheel. In addition it is designed to align with the front and rear housings so that three parts together form a smooth curve around the wheel. At the leading end this curve is high up the wheel while at the trailing end it is low. By contrast, in the Mach Zen the wheel arch is separate from the main housing and shaped more like a bicycle mud guard. It extends from low down at the leading end to just beyond the top of the wheel.
78. As for the buttons or pedals, Vax contends that there are a number of design constraints. One needs to have an on-off switch and a cable rewind activator. It is desirable, although not necessary, to have the former close to the motor and the latter close to the cable rewind. It is also desirable, although not necessary, to place them over the rear wheels for stability reasons. Furthermore, it was common in the design corpus for buttons or pedals to be provided at the rear of the machine for these purposes. I accept all of this. Furthermore, the designs of the respective buttons or pedals are quite different. In the Registered Design they are formed as part of the smooth curve of the wheel arches. By contrast in the Mach Zen they are separate from and sit on top of the wheel arches, they bear ten prominent parallel ridges, they extend in an L shape around the back of the machine and the rear portions bear raised, moulded switch and cable symbols.
79. *A cyclone top which increases in height towards the rear of the machine.* Vax contends, and I accept, that the designer's freedom is constrained in that the shape of the cyclone top follows the air path between the cyclone and the motor. Of course this does not dictate the precise shape of the cyclone top, but the shapes of the respective cyclone tops are different in a number of respects.
80. *A lower bin support formed from a sweeping and curved forward extension of the wheel arches.* Vax contends that there is little or no similarity in this respect. I agree. One can certainly see this feature in the Registered Design, and it is one of the features which distinguishes the Registered Design from the existing design corpus. But there is really nothing like it in the Mach Zen. It should be noted in this respect that, unlike the Registered Design, the Mach Zen is asymmetric along its longitudinal axis. Viewed from the one side there is a prominent run of hose along the bottom of the bin whereas there is no such feature viewed from the other side. This means that one side view of the Mach Zen is more different to the Registered Design than the other side view. Even if one focuses on the latter, however, I see little similarity in this respect.
81. *A long arcuate handle sweeping from above the bin to the rear of the machine above and behind the wheel which overarches the cyclone top.* It is common ground that the handle does not have to be longitudinal or central to the machine. Vax contends, however, that the designer's freedom is restricted in that it is advantageous in terms of ease of carrying to have a handle which is longitudinal and central. I accept this.

82. On the other hand, there do not appear to be any design constraints which militate in favour of the choice of an arcuate handle. In this respect there is a similarity between the Mach Zen and the Registered Design which is not present in existing design corpus and in respect of which there is design freedom.

83. Nevertheless there are a number of differences between the handle designs which the informed user would notice:

- i) The Dyson handle is open and accessible from front to back, enabling the machine to be picked up at a variety of positions including the top of the machine. The Mach Zen handle is only a true handle at the back. The section over the bin (and part of the section over the main body) is filled in. The result is that the handle not only looks different, but also does not enable the user to pick up the Mach Zen at the top of the machine. Furthermore, in the Mach Zen the actual handle does not overarch the cyclone top, as opposed to the continuation of the handle.
- ii) The cross-sections of the handles are different. In the Registered Design the handle has an "I" section. The Mach Zen handle has a semi-circular section.
- iii) In the Registered Design the handle terminates well before the rear of the machine. The Mach Zen handle extends over the rear, terminating in a recess for the tool kit which projects out still further.
- iv) The arc of the handle on the Registered Design is less than the arc of the handle on the Mach Zen.

84. *A body portion which slopes downwards from the cyclone top towards the rear of the machine.* This area houses the air ducts from the motor to the cyclone. Vax contends that, since these ducts pass from a high position (above the cyclone) to a low position (the motor), it is technically sensible for the housing to follow the same line. Of course, one could build up the housing, but this would take up unnecessary space and material. I accept this. Furthermore the details of the respective designs are different.

Other differences relied on by Vax

85. Vax contends that, in addition to the differences identified above, there are a number of other differences between the Mach Zen and the Registered Design which would have an impact on the perception of the informed user. I agree with this. These differences include the following.

86. *The rear of the machine.* The rear of the Registered Design is a smooth curved cover, following the curve of the top of the housing and extending beyond the wheels. The recess for the plug is tucked away right at the bottom underneath the cover. The rear of the Mach Zen is quite different. There is no curved cover. It comprises a vertical wall, with seven parallel plastic ribs and a ventilation grille. The plane of the wall is inside the rear of the wheels. The plug recess is prominent in the middle of the wall.

87. *Hose connector position.* In the Registered Design the hose connector is positioned at the top of the machine. This is a prominent feature which serves to emphasize the height of the machine, and enables the front of the machine to be finished off with a smooth, curved bumper. It also involves a swivel joint which is another prominent feature. The Mach Zen has the hose connector right at the front of the machine, emphasizing its length, not its height. There is no

swivel joint and the appearance of the connector itself is quite different. Nor is there is a bumper or smooth finish around the front of the machine.

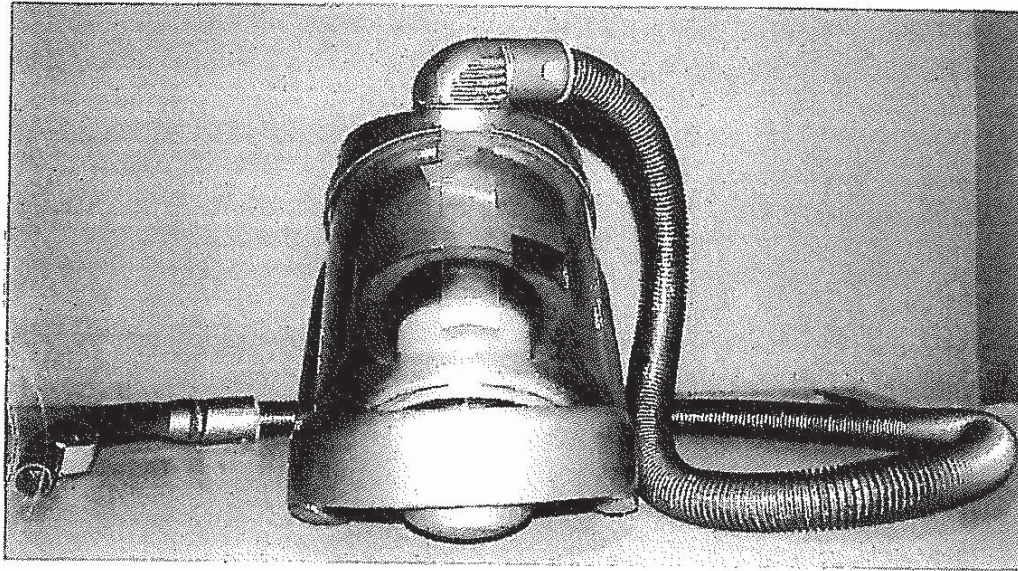
88. *Front wheels.* The Registered Design has a pair of castor wheels at either side. The Mach Zen only has only one in the middle, of different appearance.
89. *Cut-away feature.* The base of the Registered Design has a right-angled cut-away. This enables the cleaner to sit on a stair and is a striking feature of the Registered Design. There is no such feature in the Mach Zen, the base of which is close to the ground.
90. *Footplate feature.* The Mach Zen has a prominent "footplate" jutting out from the main body of the machine and running parallel to the ground on both sides. There is no such feature in the Registered Design.
91. *Wand handle.* The wand handle is the subject of a separate representation on the Registered Design. It is therefore an aspect of the Registered Design of some significance. The wand handle is roughly banana-shaped with a trigger by a grooved area. The base of the wand handle swells to a joint with a hose collar fastened with a clip. The Mach Zen wand is quite different from the Dyson wand. It is made up of three intersecting sections, creating a storage area for tools so that they are made easily available to the user. This results in a triangular configuration. There is no trigger, grooved section, clip or hose collar. In addition, the Mach Zen wand handle has a rather longer nozzle.

The overall impressions compared

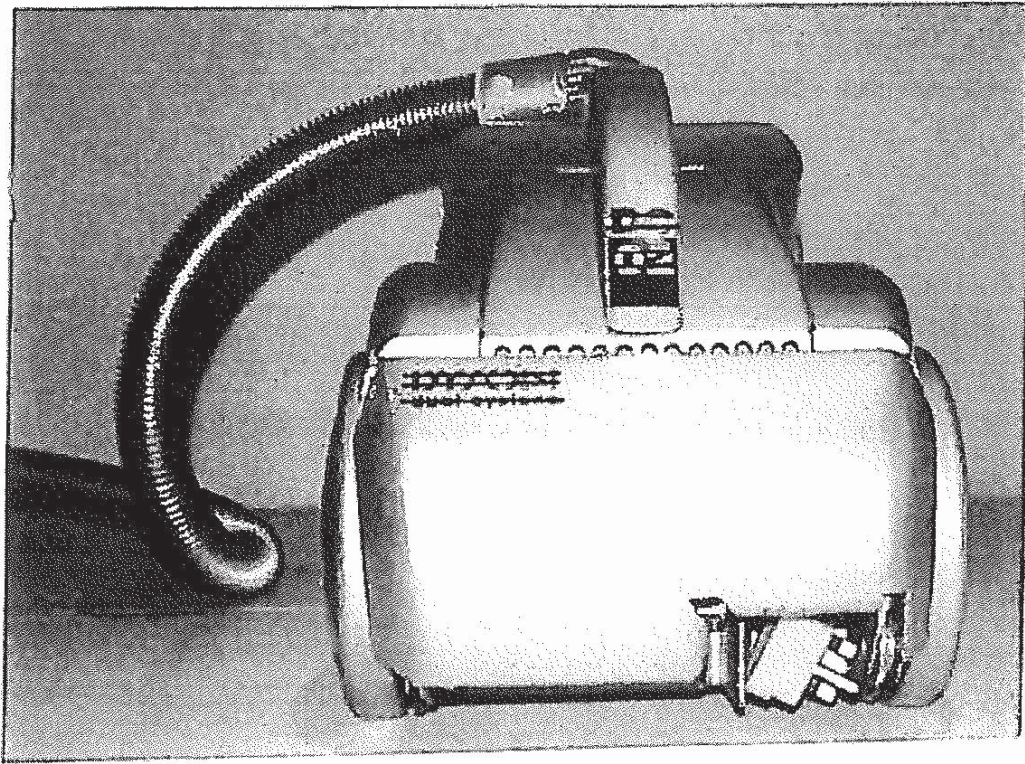
92. Standing back from the details and considering the overall impressions of the respective designs from the perspective of the informed user in the light of the existing design corpus and the degree of freedom of the designer, my conclusions are as follows.
93. In my view the informed user would notice that there were certain similarities between the two designs, in particular the inclined transparent bin, the large rear wheels and the curved longitudinal central handle. For the reasons given above, the informed user would not consider these similarities to be particularly significant. The informed user would also notice many differences between the respective designs, including features present in the Registered Design which are not present in the Mach Zen and vice versa. For the reasons explained above, the informed user would consider a number of these differences to be significant, particularly the rear view, the hose connector position, the bin handle, the wand handle, the cut-away feature and bumper of the Registered Design and the asymmetry of the Mach Zen. The overall impression produced by the Registered Design is smooth, curving and elegant. The overall impression produced by the Mach Zen is rugged, angular and industrial, even somewhat brutal.
94. Even on the basis that the Registered Design is entitled to a fairly broad scope of protection because of the differences between the Registered Design and the existing design corpus and because of the degree of freedom of the designer, in my judgment the overall impressions produced by the two designs are different.

Conclusion

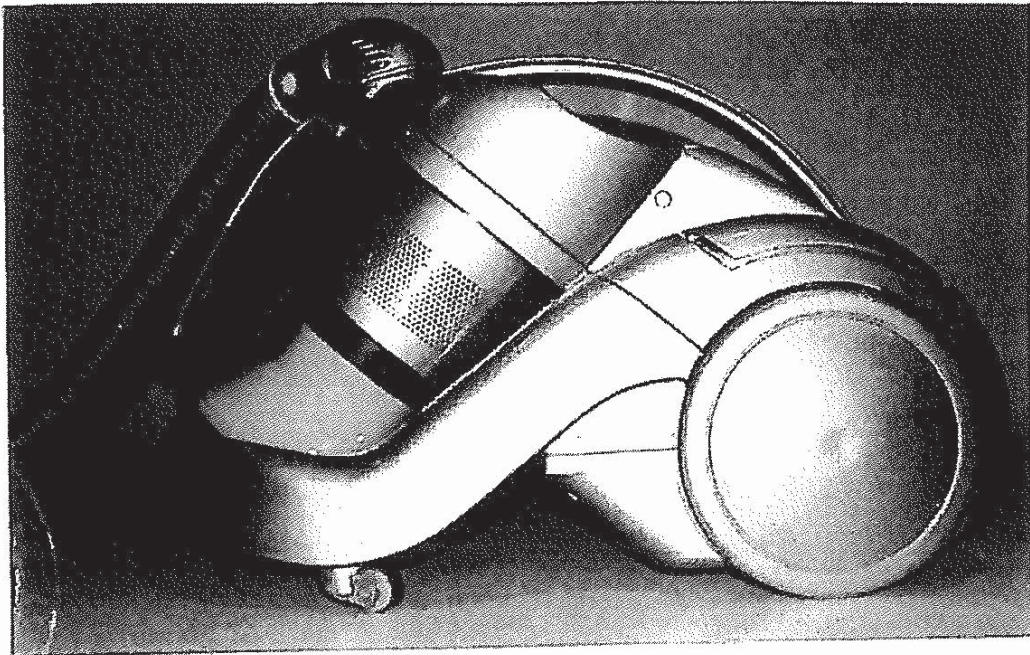
95. The claim is dismissed.



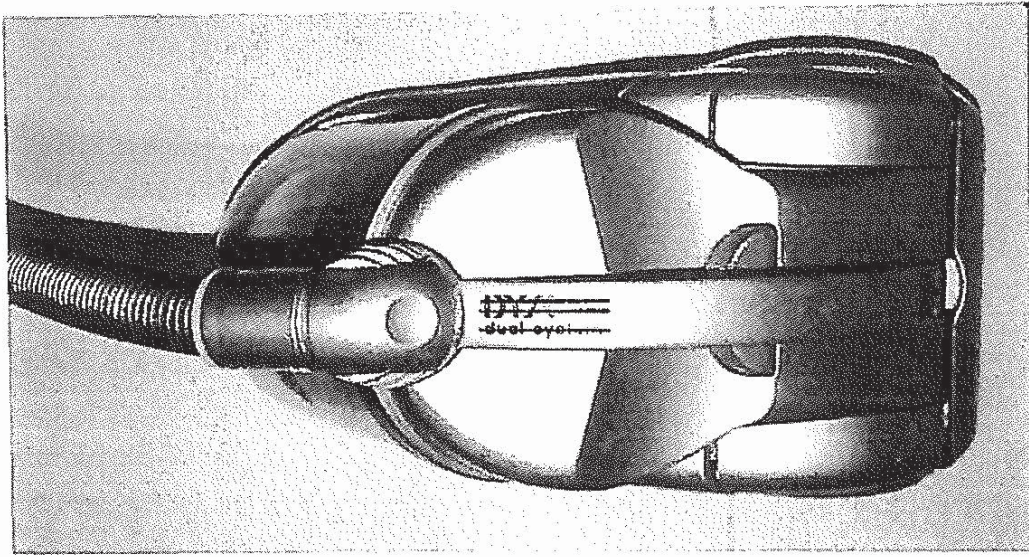
FRONT VIEW



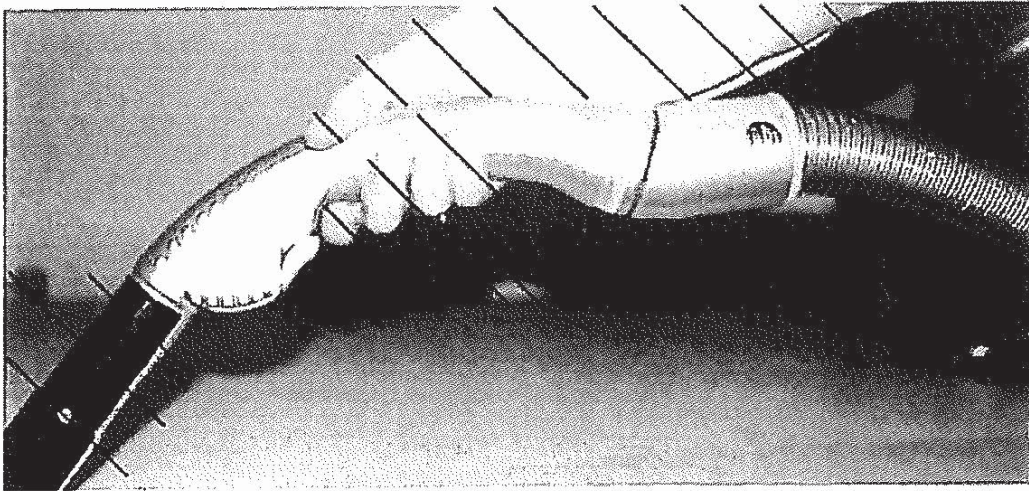
FRAGMENTARY
REAR VIEW



FRAGMENTARY SIDE VIEW



FRAGMENTARY PLAN VIEW



FRAGMENTARY SIDE VIEW
OF NOZZLE ~~IN USE~~

