



[2012] EWPC 42

Cases No: CC 11 P 0410 and CC 12 P 02904

IN THE PATENTS COUNTY COURT

Rolls Building  
7 Rolls Buildings  
London EC4A 1NL

Date: 24/10/12

Before :

**MR RECORDER IAIN PURVIS QC**

Between :

**MAINETTI (UK) LIMITED**

**Claimant**

- and -

**HANGERLOGIC UK LIMITED**

**Defendant**

(‘the infringement action’)

And between :

**HANGERLOGIC UK LIMITED**

**Claimant**

- and -

**MAINETTI (UK) LIMITED**

**Defendant**

(‘the declaration action’)

**Henry Ward** (instructed by **Eversheds LLP**) for **Mainetti (UK) Limited**  
**Michael Hicks** (instructed by **Anthony Collins Solicitors LLP**) for **Hangerlogic UK Limited**

Hearing dates: 13 September 2012

-----

## **Approved Judgment**

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

.....

MR RECORDER IAIN PURVIS QC

## **Introduction**

1. There are two actions before the Court. The first in time ('the infringement action') was brought by Mainetti (UK) Limited ('Mainetti') against Hangerlogic UK Limited ('Hangerlogic') for infringement of three registered designs for garment hangers. Three products are alleged to infringe (one for each Registered Design). Infringement is denied and Hangerlogic counterclaim for revocation of all three registered designs. The second action ('the declaration action') was brought by Hangerlogic at a fairly late stage. Hangerlogic have made some changes to the design of the allegedly infringing hangers and seek a declaration that each of the redesigns does not infringe. In that action, Mainetti have counterclaimed for infringement by the redesigns.

## **The Registered Designs**

2. The registered designs in issue are as follows:
3. (a) No. 2 080 944 registered as of 5 February 1999. This is a 'clip hanger' of the general type used to suspend trousers, shorts and skirts from two clips. A copy is reproduced as Annex 1 to this judgment. I shall refer to it as 'the Mainetti Clip Design'.
- (b) No. 2 060 713 registered as of 7 November 1996. This is used for hanging jackets. A copy is reproduced as Annex 2 to this judgment. I shall refer to it as 'the Mainetti Jacket Design'.
- (c) No. 2 053 286 registered as of 11 January 1996. This is of the general type used for a variety of garments including shirts, t-shirts, blouses and dresses. A

copy is reproduced as Annex 3 to this judgment. I shall refer to it as ‘The Mainetti Tops Design’.

**The applicable law**

4. The European Designs Directive (Directive 98/71 of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs) was implemented in the United Kingdom by the Registered Designs Regulations (SI 2001/3949). These Regulations came into force on 9 December 2001. Under the transitional provisions set out in Regulation 12, the validity of registered designs which were subsisting as at 9 December 2001 continues to be governed by the law of the United Kingdom as it stood immediately before that date. However, the infringement of such designs is governed by the law as set out in the Designs Directive.
5. All three registered designs in this case were applied for before 9 December 2001. So the old law applies to validity but the new law applies to infringement.
6. For the purposes of this action, the relevant test for validity is therefore s1(4) of the Registered Designs Act 1949 as it stood at 9 December 2001:

*A design shall not be regarded as new for the purposes of this Act if it is the same as a design –*

*(a) registered in respect of the same or any other article in pursuance of a prior application, or*

*(b) published in the United Kingdom in respect of the same or any other article before the date of the application*

*or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.*

7. The relevant test for infringement is that set out in Article 9 of the Designs Directive:

*(1) The scope of 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 design in developing his design shall be taken into consideration.*

8. It is of course important to have the right test in mind when considering validity and infringement and not to confuse the two. This is an additional complication which does not apply when considering designs registered after 9 December 2001, in respect of which the tests for validity and infringement (the ‘overall impression’ tests) are the same. For Mainetti, Mr Ward placed particular reliance on the discrepancy between the tests in the present case. He contended that because the tests were different it was not open to the Defendant to run a ‘squeeze’ argument along the familiar lines that ‘if the design is sufficiently broad to catch my product, then it is sufficiently broad to catch the prior art and is therefore invalid’.

9. Mr Ward cited Russell-Clarke and Howe on Industrial Designs at 3-003. Here it is averred that because the scope of a design under the Designs Directive is

‘probably wider’ (same overall impression) than the validity test under the old law (identical or differing only in immaterial details), it is ‘likely in many cases’ that a Defendant could be found liable for infringing a valid registered design where all he was doing was reproducing a published prior art design. This is considered by Russell-Clarke to be ‘startling and quite unfortunate’.

10. I am not convinced that the problem suggested by Russell-Clarke is a very serious one. First of all, it is not at all clear to me that the test under the Designs Directive is necessarily ‘wider’ than that under the old law. It is obviously not the same, and therefore as a matter of logic it must be possible to imagine cases which would be decided differently depending on the test to be applied, but I am not convinced that this would happen in very many cases or that the end result would necessarily show the Designs Directive to be distinctly wider in scope. The authorities under the Directive have made it clear that infringement must be considered on the basis of a careful consideration by an informed user who is particularly observant. As HHJ Birss put it in Apple v Samsung [2012] EWHC 1882 (Pat) at [58] ‘*attention to detail matters*’. The notion that the degree of protection granted to registered designs has significantly increased under the Designs Directive from that granted by our old law has not been borne out by the cases which have so far come before the Courts.
11. Secondly, and perhaps more importantly, the Designs Directive requires the Court to take proper account of the ‘design corpus’ which existed at the date of the design when considering the scope of protection. As summarised by Arnold J in Dyson v Vax [2010] FSR 39 at [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 from the design corpus and a narrower scope of protection where it differs only slightly from the design corpus.’*

If the published prior art is part of the design corpus, it seems unlikely that a registered design would be given a scope of protection which would actually cover that prior art.

12. So Mr Ward is literally correct with his ‘no squeeze’ point, but it probably does not matter very much.

### **The evidence**

13. Both parties filed evidence from in-house experts. Neither party wished to cross-examine the other’s expert.

14. The role of expert evidence in registered design cases has been reviewed by the Courts on a number of occasions. The correct position is as follows:

(a) An educated eye can be of some assistance to the Court in pointing out technical matters which might otherwise escape the ordinary observer. In particular, expert evidence can address limitations on design freedom caused by technical or manufacturing considerations.

(b) Where the ‘informed user’ is not simply a member of the public (the ordinary purchaser of a consumer product), expert evidence may be of assistance in explaining the identity of the informed user and the characteristics he/she would be particularly interested in.

(c) Expert evidence may be useful in explaining the ‘design corpus’ as it existed before the date of the design in issue.

(d) Though not necessary, expert evidence may be used as a way of presenting straightforward comparisons between the designs in issue.

15. The parties in the present case used in-house experts. This was entirely sensible given the limited role which they had to play in these proceedings and the fact that the legitimate subject matter of their reports was largely uncontentious. The content of the reports was in some respects useful. In particular, Mr Jones produced a number of useful overlays and other comparisons between the designs in issue in the case on which both sides relied. However, both parties failed to keep their reports within legitimate bounds. As well as the useful material, Mr Jones’s report for Mainetti also contained a great deal of inadmissible and pointless material. For example, it is of no interest in a registered design action for the court to be told that *‘Intellectual property is taken seriously [by the Claimant]’* [para 4 of Jones 1], or how much money the Claimant spends annually on protecting its designs [para 7 of Jones 1], or on research and development [para 21 of Jones 1], or that the Claimant is the market leader [para 23 of Jones 1], or that it produces better designs than its competitors [para 25 of Jones 1, though this was ultimately removed]. Finally, as has been pointed out on a number of occasions, whether the Defendant copied the Claimant is irrelevant in a registered design action, and it is not legitimate for an expert to opine on this subject either [para 122 of Jones 1 – nor does it become legitimate when prefaced by the words *‘I am advised ... that copying is not relevant to the*

*question of infringement*’!]. Mrs McCulloch for Hangerlogic filed reports which contained a number of references to statements allegedly made by clothes retailers about the redesigned products. Such statements were irrelevant and in any event could hardly have advanced the case when presented simply as hearsay. They were rightly withdrawn by Hangerlogic at trial. Finally, both experts made numerous references to their opinion (variously) that the designs ‘gave the same overall impression’ or ‘did not give the same overall impression’. Whilst under s3(3) of the Civil Evidence Act 1972 it may be technically admissible for experts to opine on the ultimate issue before the Court, there is certainly no point in doing so in a registered design case. All the more so when the experts are in no sense independent, and they are essentially saying ‘I think my company should win’.

### **Validity - the law**

16. As explained above, the question in the present case is whether the Registered Designs differ only in immaterial details or variants commonly used in the trade from the prior art. These are distinct questions. It seems to me that the only sensible way of applying the test is (i) to identify the differences between the designs; (ii) to consider whether the differences are immaterial (as opposed to ‘substantial’ – see Whitford J in Valor Heating Co. Ltd. v. Main Gas Appliances Ltd [1973] RPC 871 at 878-9); (iii) if the differences are not immaterial, to ask whether they simply consist of variants commonly used in the trade. In making the assessment of materiality of differences, the designs must be looked at as a whole, both on the basis of a side-by-side comparison and *‘also on the basis of having had a look at the registered design, then*



*having gone away and come back and perhaps been put in a position of deciding whether some other article is the one you originally saw.’ (Valor at 878).*

**Validity – the cited prior art**

17. Hangerlogic cited a number of pieces of prior art against each of the three Registered Designs in issue. It is unclear why so many were cited. It should have been clear to Hangerlogic which was their best case on validity on each design. There is no need to burden a case like this (particularly in the Patents County Court) with an unnecessary proliferation of citations.

18. I have considered the invalidity case in relation to each Registered Design in respect of each piece of prior art which has been cited against that design, and I have concluded that none of the three Registered Designs is invalid.

(a) Registered Design 2080944 – ‘the Mainetti Clip Design’

19. Hangerlogic cited 5 prior art registrations. There are substantial differences between each cited prior art design and the clip registration. The most obvious features of the clip registration are the rounded top to the neck area under the hook, the rails which run along the top wall of the hanger (projecting out on each side) down the full extent of the arms between the tip and the neck, and the straight sided clips with oval thumb recesses. None of the prior art hangers has this combination, or indeed any of the individual features alone. In each of the prior art hangers, the clips are in the form of an inverted T and the top of the neck area is either essentially rectangular or essentially trapezoid. Some of the prior art hangers appear to have a rail of some kind, but in none of them

does it extend along the length of the arms. These differences are plainly material and I have seen nothing to indicate that (either individually or in combination) they comprise variants common in the trade.

(b) Registered Design 2060713 – ‘the Mainetti Jacket Design’

20. Hangerlogic cited 3 prior art designs. Once again, the attack on validity can be dealt with quite quickly. The Mainetti Jacket Design is (like the Clips Design) characterised by a fully rounded top of the neck area, which blends smoothly down into the arms at a wide radius. None of the 3 prior art designs has this feature. They are all characterised by an almost flat top under the hook, with a sharp angle down towards the arms. This difference alone is plainly material and there is nothing to suggest that it is a variant common to the trade. I should also record that each piece of prior art also differs from the jacket registration in other material respects which, given my finding above, I do not need to consider.

(c) Registered Design 2053286 – ‘the Mainetti Tops Design’

21. Hangerlogic cited 5 prior art designs. Each of them differs in a number of respects from the registered design. In each case, looking at the designs as a whole, I consider that the differences are not immaterial. The registered design is characterised (again) by a rounded top to the neck area under the hook which blends smoothly down into the arms at a wide radius. It is also characterised by a long, ridged grip feature on the top of the arms, and a pair of ‘underlegs’ of a particular shape and configuration near the ends of the arms. The two closest prior art designs (2006371 and 2020940) have a similar rounded top and a smooth, wide-radiused join. No. 2006371 is probably the

closer of the two, since it also has similar ‘underlegs’ in the same position. However, in this design the arms project forwards, giving a very different look in plan and side views. Furthermore, there is no grip at all (let alone in the configuration of the registered design) and the hanger is moulded in C-section, giving a distinct ridge around the edges on one side, rather than the smooth effect created by the U-section moulding of the registered design. No. 2020940 is a U-section moulding, but lacks underlegs or any grip. Overall the differences are, I believe, material and cannot be said to consist solely of variants common in the trade.

### **Infringement – the law**

22. As I have indicated above, the applicable law so far as infringement is concerned is that of the Designs Directive. The test is whether the designs alleged to infringe give the same overall impression, seen through the eyes of a notional ‘informed observer’.
  
23. Various authorities have been cited to me on the application of this test. I summarise the relevant principles as follows:
  - (a) The comparison to be made is a visual one between the alleged infringement and the design as it appears on the Register. It may be useful to compare the alleged infringement with an actual product made in accordance with the registered design (being careful to make sure that it is in all respects the same). See Pepsico v Grupo Promer (C-281/10P).
  
  - (b) The comparison is to be made through the eyes of the ‘informed user’. Such a person is particularly observant, has a general knowledge of the

features which are normal in the existing art, but does not have the extent of knowledge of a designer or technical expert. See Shenzen v OHIM (T-153/08).

(c) The scope of protection to be given will vary according to the degree of design freedom enjoyed by the designer in developing his/her design. See Article 9(2) of the Designs Directive. Design freedom may be restricted by technical considerations, functional considerations and (to some extent) economic considerations (General Court in Grupo Promer [2010] ECDR 7 and Arnold J in Dyson v Vax [2010] FSR 39). Thus the common presence of a feature which is required for a technical reason will not be significant in itself. However, commonality in the way that feature is executed may well be significant.

(d) The overall impression test depends also on the ‘existing design corpus’ (see Recital 14 to the Directive). As put by the General Court in Grupo Promer, this means that the informed user would *‘automatically disregard elements that are totally banal and common to all examples of the type of product in issue and will concentrate on features which are arbitrary or different from the norm.’* HHJ Birss in Samsung v Apple [2012] EWHC 1882 pointed out that there is a spectrum of banality from features which are ubiquitous through features which are occasionally found in the art to features which are entirely unique. The significance of any feature which is common to the registered design and the alleged infringement will depend on its position in this spectrum.

(e) The comparison involves attention to detail but not *‘minute scrutiny’* (Apple v Samsung at para 58).

(f) Whether or not the design was copied by the alleged infringer is irrelevant.

(g) Although it is necessary to consider the significance of individual features of the design, one must beware approaching the design as if it were a patent claim consisting of a list of features. The problem with that approach is that it turns into a debate about the level of generality at which the features should be described. See Dyson v Vax [2012] FSR 4 at 30. Ultimately, an overall visual comparison has to be made.

### **Infringement – applying the law to the facts**

(a) Design freedom

24. Within the basic parameters imposed by the function which a hanger has to carry out (the need for a hook to fit a hanging rail positioned in the middle of the hanger, arms which are roughly the size and shape of the shoulders of a garment etc.), there is plenty of scope for the exercise of design freedom. I was provided with a book entitled ‘Cintres, Hangers’ by one Daniel Rozensztroch which contains photographs of hundreds of different hangers collected by the author over a period of years. It demonstrates the wide scope for the creativity of the designer which exists in the world of hangers, even extending to the world of ‘disposable’ plastic hangers. The present day Mainetti catalogue (Appendix 3 to Mr Jones’ First Report for Mainetti) confirms this impression. Mr Jones has summarised the scope for design freedom given in paragraphs 37-41 of his First Report, and concludes that it is very wide. I believe that his account is accurate.

(b) Design corpus

25. The designs in issue date from 1996 (the Tops Design and the Jacket Design), and 1999 (the Clips Design). I have been given only a very limited amount of information about the design corpus as it existed at those dates. This is not a criticism of the parties – as in many cases it was probably very difficult or impossible to obtain evidence of catalogues and the like going back such a long way.
26. The evidence I have seen as to the design corpus comprises (i) the registered designs cited as prior art and mentioned above; (ii) the Rozensztroch book which gives estimated dates for its designs; (iii) the Mainetti catalogue from 1999 exhibited by Mr Jones. Although this latter catalogue post-dates the designs in the case, it is accepted by Mainetti to be relevant to the design corpus (one has to be careful of course because one of the hangers shown in this catalogue is made to the Jacket Design, and another is obviously derived from the Jacket Design).
27. Given this small and highly selective amount of information, it is rather difficult to engage in the exercise of considering where on the spectrum discussed by HHJ Birss in Apple v Samsung any particular feature belongs. However, I have done the best that I can with the information available. My overall impression in terms of each design at its date of application is that it did not represent a startling and radical new departure from the norm. None of the general features found in the designs can be said to be strikingly unique in and of themselves. However, both the specific execution of those features and the way they are combined are in each case original in the sense of conveying

a particular overall impression which is distinct and recognisable. An informed observer would have had no difficulty in recognising that originality.

(c) Informed user

28. The garment hangers with which this case is concerned are of the type used for displaying garments in shops. Although many of them will be supplied to the ultimate customer along with the garment (and may even find their way into his or her wardrobe), this is largely incidental. The real users of these products are retailers. The parties are agreed that the informed user is someone in the position of a buyer responsible for purchasing hangers for a retail store (or group of stores). Such buyers are, the experts both agree, sensitive to design differences and very discerning when it comes to the appearance of a hanger.

(d) Interchangeability

29. A particular factor was relied on by Mainetti in this case. This is the fact that the Hangerlogic designs are interchangeable with the equivalent Mainetti designs. By this they mean that the retailer buyers who purchase the hangers considered that they could be used alongside one another for the same items of clothing on the same rail (indeed it seems from Ms McCulloch's evidence that the Hangerlogic family of hangers were deliberately designed to be interchangeable with the Mainetti family). Obviously retailers wish to have uniformity of appearance when the same items are hung next to each other, and the fact that they are prepared to use the Mainetti designs and the Hangerlogic designs interchangeably in this way indicates that they do not consider that the public would tell the difference when the two are used

alongside each other. So, says Mainetti, this is good evidence that the designs give the same overall impression.

30. The fact of interchangeability is not disputed by Hangerlogic. However, they dispute its significance. They say that interchangeability simply means that the retail buyers consider that the public would not notice the differences between the designs. It does not mean that the buyers themselves would consider the designs to be the same. Since it is the buyers and not the public who are the informed users, interchangeability is therefore irrelevant.

31. I consider that the interchangeability of the products is a factor which I should bear in mind when considering infringement. Retail buyers are concerned about uniformity of appearance within a single range of clothing on display in their stores. There is no doubt that this uniformity is affected by the design of hangers, both in terms of the appearance of the hanger where it is visible on the rail and in terms of the appearance of the clothing (which may be displayed differently by different hangers). If the educated eye of a retail buyer considers that two hangers can be used interchangeably, this is in my view relevant to the question of whether the designs create the same impression.

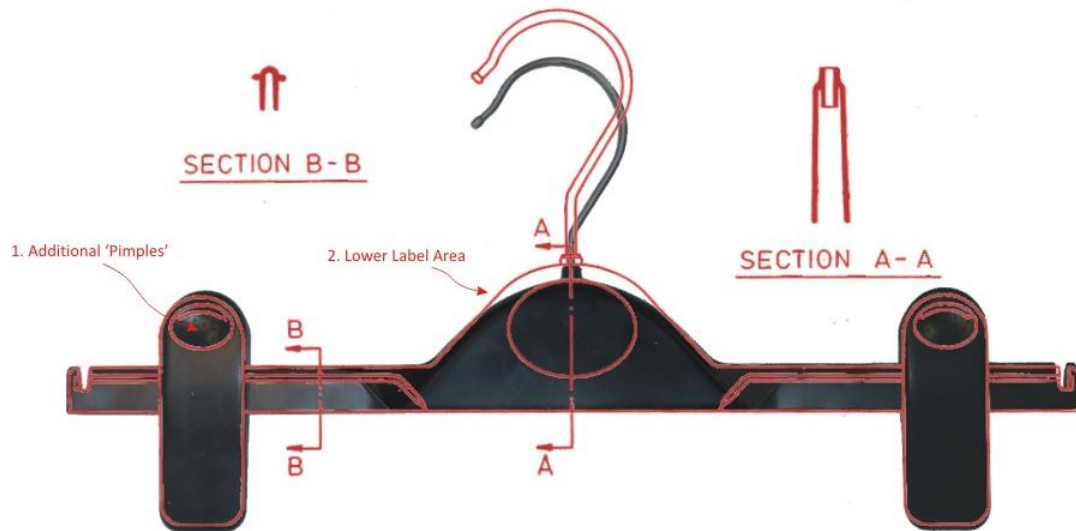
### **Infringement – applying the law to the facts**

32. I now turn to consider the question of infringement by reference to each Registered Design in turn.



(a) Infringement of the Mainetti Clips Design

33. Mr Jones produced an overlay of a photograph of the Hangerlogic Clips Hanger Mark I with the Mainetti Clips Design overlaid. I set it out below.



34. I consider that the Hangerlogic Clips Hanger (Mark I) gives the same overall impression as the Mainetti Clips Design. It is in fact almost identical save in two respects: the curve of the hump under the hook is somewhat less steep, and the thumb recesses on the clips have dimples<sup>1</sup>. With those small exceptions, it has precisely taken all the features which characterise the Clips Design and give it originality.
35. The Hangerlogic Clips Hanger (Mark II) is the same as the Mark I, with a number of changes of detail: (i) the clips have been given a slight 'waist' in the middle; (ii) the thumb recess is now more rectangular than oval in shape; (iii) the top of the clips has been flattened out; (iv) where the rail meets the

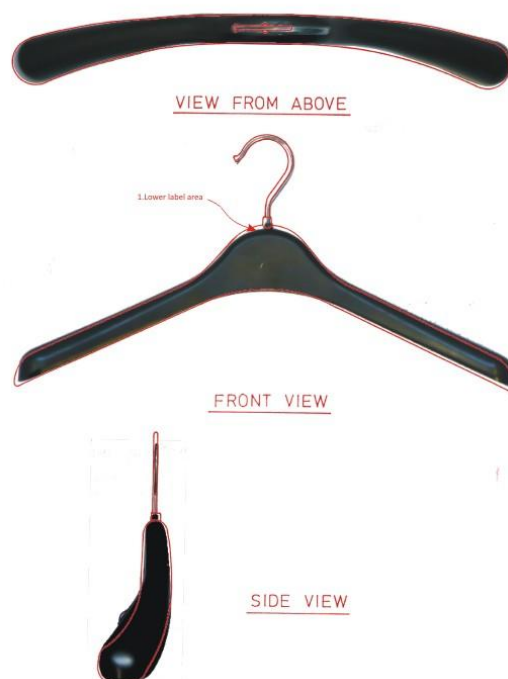
<sup>1</sup> The Mainetti Clips Design also shows an oval label which is a trivial feature and I do not believe would be regarded by the informed observer as having any significance.

neck in the middle of the hanger, it now projects down at 90 degrees rather than 45 degrees; (v) the small notches at the ends of the top of the hanger have been removed.

36. Despite these changes, I consider that the Mark II still gives the same overall impression as the Mainetti Clips Design. When considering the Mainetti Clips Design in the context of the prior art, I characterised its primary features as the combination of the curved top of the neck, the rail running right along the arms on either side of the top and the straight clips. These features (which create the overall impression given by the Design) are all still present in the Mark II and generally executed in the same way. The minor changes which have been made to the detail of the execution of the features have not resulted in any real change to the overall impression. I therefore conclude that the Mark II also infringes.

(b) Infringement of the Mainetti Jacket Design

37. The Hangerlogic Jacket Hanger (Mark I) is extremely similar to the Mainetti Jacket Design. Mr Jones' overlay is set out below:



38. On a close examination of the two designs next to one another, one can see a slight difference in the curvature of the top of the neck. The Mark I has a slightly wider radius at the top and consequently has a slightly steeper slope down to the arms. Apart from that there is virtually no difference at all. I conclude that the Hangerlogic Jacket Hanger (Mark I) gives the same overall impression as the Mainetti Jacket Design and is an infringement.
39. The Hangerlogic Jacket Hanger (Mark II) is the same as the Mark I save in one respect. The bottom wall of the neck is flat rather than curved. Does this result in a design which gives a different overall impression? I do not consider that it does. The overall impression of the Mainetti Jacket Design is created by a combination of features. These include the smooth curvature of the top and sides of the neck, the particular angle and forward curvature of the arms relative to each other, the thickness of the arms in proportion to their length, the exaggerated ‘flare’ at the tips of the arms and the configuration of the tips. The Mark II continues to take all those features with extreme precision. Clearly the informed observer would notice that the bottom wall of the neck was flat rather than curved, but the test for infringement is not whether you can tell the difference between the designs. To my mind the Mark II is a slight variant to the registered design whilst keeping the same overall impression. It is an infringement.

(c) Infringement of the Mainetti Tops Design

40. Mr Jones' overlays are set out below:



41. The overall impression of the Mainetti Tops Design is created by its particular combination of the rounded and smoothly curving neck, the angle and relative length of the arms, the curvature of the arms at their tips, the position and

configuration of the under-legs and the length, position and configuration of the grips on top of the arms.

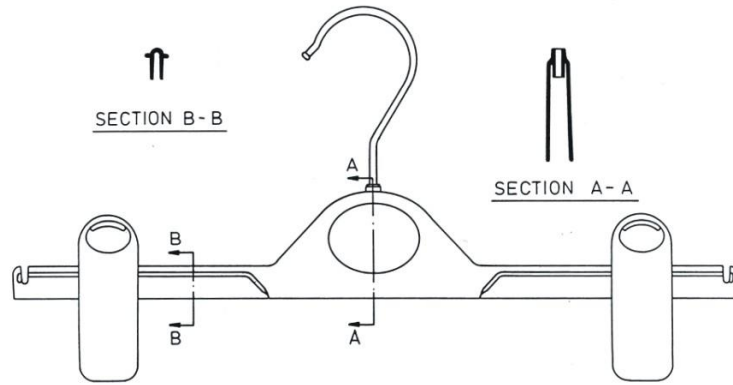
42. The Hangerlogic Tops Hanger (Mark I) has all the same features executed in an extremely similar way. The differences are that the curvature of the Hangerlogic neck is slightly more shallow, the join between the under-legs and the arms is at a different angle, the ridges on the grip are curved rather than straight. These are differences which are only noticeable on a very close examination. Looked at as a whole, and bearing in mind what I have seen of the design corpus, I consider that the overall impression of the two designs is the same.
43. The Hangerlogic Tops Hanger (Mark II) is the same as the Mark I with three differences: (i) the tips of the arms are now slightly tapered on the inside – the outside remains the same; (ii) the tips of the under-legs have been changed – from a ‘ball head’ to a triangle projecting upwards just before the tip; (ii) the bottom wall of the neck has been made straight in the same way as the Mark II Jacket Hanger.
44. Just as with the other redesigns in this case, I do not consider that the changes made to the Hangerlogic Tops Hanger Mark II have created a design which gives a different overall impression to the Mainetti Tops Design. The key features of the Mainetti Tops Design which combine to create the overall impression of that Design (as set out above) have been retained in the Mark II and are still executed in a very similar way. Just as with the Jacket Hanger Mark II, the Tops Hanger Mark II is a slight variant to the registered design whilst giving the same overall impression. It is an infringement.

## **Conclusion**

45. I conclude that all of the Defendants' hangers in issue in the 2 actions are infringements of the Claimants' registered designs.
  
46. I will invite submissions as to the form of relief which should be granted.

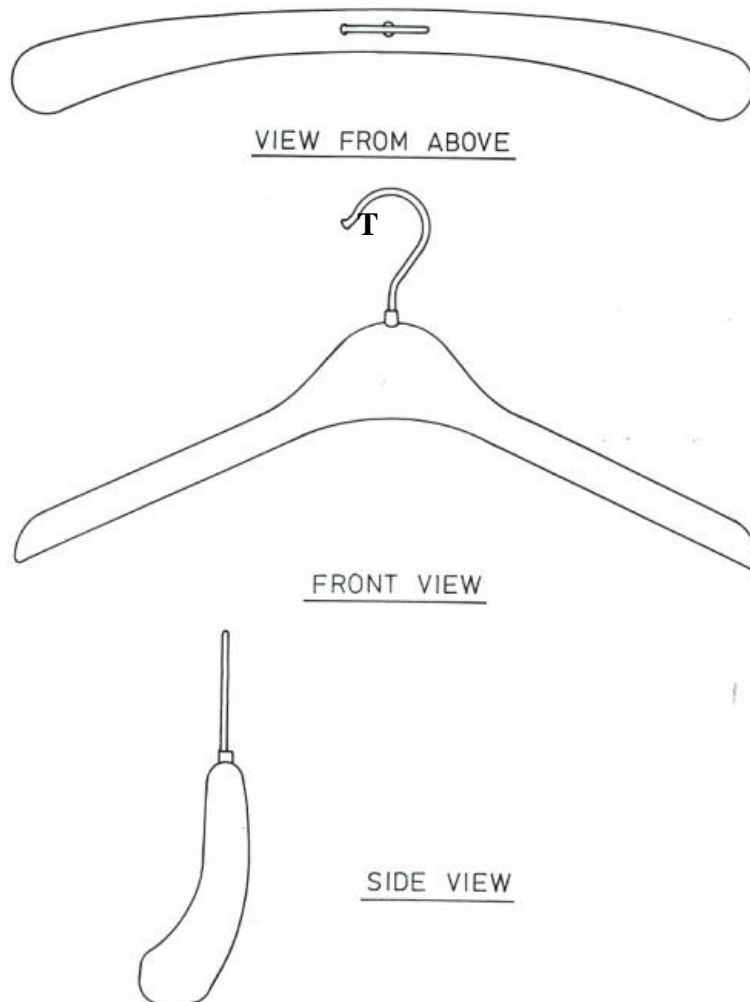
### ANNEX 1

#### The Mainetti Clips Design



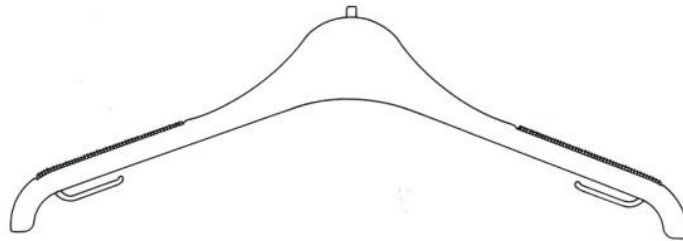
### ANNEX 2

#### The Mainetti Jacket Design



### ANNEX 3

#### The Mainetti Tops Design



FRONT VIEW

REAR VIEW CORRESPONDS



VIEW FROM ABOVE



VIEW FROM BELOW



VIEW FROM ONE END

VIEW FROM OPPOSITE END CORRESPONDS