

**EIP**

## Trunki appeal dismissed by the Supreme Court

The Supreme Court has upheld the Court of Appeal's decision that the Kiddee Case produced by PMS did not infringe Magmatic's Registered Community Design for the Trunki suitcase, "the CRD".

Magmatic's CRD consists of six monochrome CAD (Computer Assisted Design) images, two of which are shown in the first paragraph of the Supreme Court decision. The images are of a ride-on children's suitcase with horns. The horns are shown in the same light grey shade as the rest of the body, with the wheels, spoke, strap and stripes shaded black. At first instance, Arnold J had found that the CRD concerned only the shape of the suitcase and was not restricted to any particular colouring or surface decoration (or absence thereof).

The Supreme Court treated the Court of Appeal as raising three criticisms of the first instance decision:

1. "... that Arnold J failed to give proper weight to the overall impression of the CRD as an animal with horns, which was significantly different from the impression made by the Kiddee Case, which in the examples shown in para 4 [of the Supreme Court judgment], were either an insect with antennae or an animal with ears";
2. "...that the judge failed to take into account the effect of the lack of ornamentation on the surface of the CRD"; and
3. "...that the judge ignored the colour contrast in the CRD between the body and the wheels."

On the first criticism, Lord Neuberger said, at [39] that whilst it "is unrealistic for an appellate court to expect a trial judge in every case to refer to all points which influenced his decision

" ... "when a judge has given a full and careful judgment, conscientiously identifying and specifying a significant number of points which weigh with him, an appellate court can properly conclude that his failure to mention a significant point means that he has overlooked it." Whilst in his first instance decision, Arnold J rightly focused on the overall impression given by the CRD and identified specific items of difference between the CRD and the Kiddee Case, he did not mention the horns on the images of the CRD or the horned animal appearance of those images. Accordingly Lord Neuberger found that the Court of Appeal was justified in its first criticism.

Lord Neuberger also considered that the Court of Appeal were correct that the first instance judge had failed to take into account the effect of the lack of ornamentation in the CRD. In obiter comments on this point, Lord Neuberger said "it seems plain to me that the absence of decoration can, as a matter of principle, be a feature of a registered design." He went on to suggest that the use of a CAD rather than a line drawing was one factor which suggested the absence of ornamentation.

In relation to the third criticism, Lord Neuberger stated "[i]f, as in the case of the CRD, an applicant for a Community Registered Design elects to submit CADs of an item, whose main body appears as a uniform grey, but which has a black strip, a black strap and black wheels, the natural inference is that the components shown in black are intended to be in a contrasting colour to that of the main body." He considered that Kitchen LJ had been right to conclude "that the CRD claimed not merely a specific shape, but a shape in the two contrasting colours – one represented as grey and the other as black on the images, and that Arnold J was correspondingly wrong in holding that the CRD was a claim simply for a shape."

Accordingly Lord Neuberger held that the Court of Appeal was right to hold that Arnold J had misdirected himself and so was right to reconsider the question of infringement for itself. He found no grounds for questioning the Court of Appeal's conclusion that the CRD was "for a wheeled suitcase in the shape of a horned animal" with "a strap, strips and wheels and spokes in a colour (or possibly colours) which contrasted with that of the remainder of the product" and that the Kiddee Case did not infringe the CRD. He added "while it may be of little comfort to Magmatic, I think I would have reached the same conclusion. It is a conclusion I would have reached with some regret, as the conception of the Trunki, a ride-on wheeled case which looks like an animal, seems to have been both original and clever....Furthermore, it appears clear that Mr Beverley of PMS conceived the idea of manufacturing a Kiddee Case as a result of seeing a Trunki, and discovering that a discount model was not available. Unfortunately for Magmatic, however, this appeal is not concerned with an idea or an invention, but with a design."

Following the judgment, those registering designs will need to consider both how and when a CAD is used instead of a line drawing. The judgment is also an important reminder of the limited scope of Community Registered Designs in comparison to patents and the potential benefits of filing multiple similar CRDs.

The above comments relate specifically to Registered Community Designs, which cover the European Union. Different considerations apply in other territories.

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