

EIP

No Leg to Stand On: Claimant left out of pocket as hopeless case fails to establish design for cargo trousers is original or infringed

KF Global Brands Ltd v Lead Wear Ltd & Ors [2023] EWHC

Introduction

This case concerned allegations of infringement of UK unregistered design rights (UKUDR) which were claimed to subsist in the design of the Claimant's BKS-001 cargo trousers. By the time of the trial, issues of ownership and joint liability of the Defendants had fallen away, leaving only issues as to subsistence, infringement and whether additional damages would be appropriate to be determined.

The allegedly infringing articles were manufactured for the First Defendant company (of which the Third Defendant was the sole director) by a company in Bangladesh. The Second Defendant purchased and then re-sold the Defendants' products via eBay.

Lack of Originality

The Defendants argued that the BKS-001 design was not original (i.e. it did not originate with the Claimant) and in fact had been copied from an earlier design of cargo trousers sold by Aldi in the UK. The Defendants had also pleaded that the BKS-001 design was commonplace at the time of its creation, having regard to the Aldi design, although oral submissions at trial were focussed on originality.

The judge reiterated that the bar for establishing originality in UKUDR proceedings is a low one; “anything in the creation of the design requiring more than slavish copying will result in that design being original”, quoting Hacon HHJ in **Action Storage v G-Force [2017] FSR 18**. However, it is important to note that, while a small change to an existing design for part of an article may well create an original design right for that part, it does not automatically create a fresh design right in the design of the whole article. This became relevant in the present case as the Claimant sought to argue that its BKS-001 design was original because it had pockets for holding pens, as opposed to the “loops” present in the Aldi design. The Judge held that this was the only material difference between the Aldi and BKS-001 designs and was so minor that no new design right was created in the BKS-001 design as a whole.

This fundamental issue for the Claimant was compounded by the Judge’s other findings about the process by which the Claimant’s BKS-001 design had been created. According to his evidence, the Claimant had the Aldi trousers physically in his office at the same time that he was dictating the design of the BKS-001 trousers to his business partner, Mr Ali (who apparently created the design document). Elsewhere the judge found the Claimant’s evidence about how the design came about to be “confused”.

Damningly, emails between the Claimant and Mr Ali surfaced during disclosure, asking inter alia “Please can you complete the sample you have of the NAVY BLUE ALDI TROUSERS and send it to us to confirm” and, regarding the packaging, “Can you please draw a white outline on the trousers, like the Aldi trouser card”. According to the Claimant, the reference to “Aldi” was merely a “code” and “the sample” referred to samples of fabric from the Aldi trousers which had been allegedly taken for laboratory analysis, but the Judge was not persuaded by this. It was clear that no valid UKUDR subsisted in the BKS-001 as it was a copy of the Aldi design.

Infringement

The Claimant also failed on infringement; despite the judge finding that the First Defendant had copied wording from sales listings (which were licensed by the Claimant) for use on the First Defendant's own listings, the judge made it clear that this was not the correct test for establishing infringement of UKUDR in this case, had it subsisted.

The judge also suspected that there may have been multiple versions of the Claimant's design documents. It was not clear whence the pleaded design document had originated; it had been found by the Claimant "on a USB stick" and, despite his claims that the original design document would have been sent between himself and Mr Ali, no such communications could be located.

Furthermore, discrepancies between the design document as pleaded and the evidence of the Claimant led the judge to reject the Claimant's case that the pleaded BKS-001 design document accurately depicted the design of the Claimants' trousers as of April 2015, and since no secondary design document had been pleaded, the Claimants were unable to make out an infringement case. Attempts to argue infringement by comparing the Defendants' products directly with the Claimant's current products were rejected.

Reason to Believe

A short point arose regarding the knowledge of the Second Defendant with regards to secondary infringement by importing or dealing with infringing articles under s227 of CDPA 1988. The Claimant had argued that the Second Defendant should have known the articles were infringing 1) because of the price and nature of the goods and 2) because the Claimant's letter before action had put the Second Defendant on notice.

The judge however rejected both of these allegations. There was nothing about the price of the goods (at less than £10.49) that should have led the Second Defendant to believe anything other than that they were cheap. The Claimant's argument that the Second Defendant should have done a Google search was hopeless; a failure to undertake such a search does not equate to a "reason to believe". In any event, the Second Defendant's unchallenged evidence was that he had searched for BKS-001 and KF Global and found nothing of relevance.

Finally, the judge criticised the Claimant's letter before action as having so little relevant detail, other than alerting the Second Defendant that he was about to have a claim brought against him, that it could not be said to have put the Second Defendant on notice for the purpose of knowledge.

The full judgment is available [here](#).