

**EIP**

## Trunki decision overturned based on different interpretation of scope of design

A recent [decision](#) of the Court of Appeal of England and Wales has highlighted again the importance of the form and amount of detail shown in the views (formally called “representations”) of a design in a Registered Community Design (RCD). The appeal reverses the earlier High Court decision, in which it was held that PMS’s “Kiddee Case” fell within the scope of Magmatic’s RCD for the well-known “Trunki” ride-on suitcase, largely based on a different interpretation being taken on which features of the design depicted in the representations were significant.

The representations in the RCD along with images of the Kiddee Case product are shown in the Annex to the Court of Appeal decision ([linked above](#)).

In the first instance decision (summary [here](#)), the RCD was interpreted as covering the shape of the suitcase alone and was not restricted to any particular colouring or surface decoration (or absence thereof). This was on the basis that the representations were monochrome, and the surfaces were plain (i.e. without decoration). In comparing the Kiddee Case to the representations, all aspects other than the shape of the Kiddee Case were ignored, leading to a finding of infringement.

On appeal, however, it was held that the scope of protection under the RCD had been interpreted incorrectly in two ways.

First, it was held that the representations in the RCD did convey limitations in relation to the surface design. The appeal judge noted that the views in the RCD were 3D images of the suitcase, depicting, the “effect of light upon its surfaces”. The judge also noted that

the absence of imagery on the surfaces of the design "significantly affects how the shape itself strikes the eye, and the overall impression it gives", helping to convey the visual impression of a "horned animal". In short, the appeal judge held that the plain surface of the product in the RCD was, in fact, a design feature.

Second, it was held that the first instance judge did not fully appreciate the depicted colour contrast between the wheels and the suitcase body, which made the wheels a "rather striking aspect of the design as a whole".

Given this, the Court of Appeal made its own determination of the scope of protection provided by the RCD and whether the Kiddee Case fell within the scope of the RCD.

In view of the revised interpretation of the scope of protection for the Trunki design, the Kiddee Case was held by the Court of Appeal not to fall within the scope of the RCD. This was in part because it had surface decoration and did not have "colour" contrasting wheels, but also because of other features of shape which were held to be different.

This decision highlights a number of important practice points in relation to RCDs in particular:

- When considering how to represent a design in an RCD, care should be taken to determine exactly which aspects of the design it is desired to protect. Generally speaking, a line drawing which does not depict surface decoration at all will be taken to cover the shape of the depicted product only – this gives relatively broad protection, albeit at the risk of being closer to existing designs. If surface decoration (or the absence thereof) is an important design feature, however, then 3D or other representations clearly showing the decoration (or plain surface feature) may be more appropriate. Equally, if colour is an important aspect of the design, consider using representations that show the colour of the design.
- Following on from the first point, it may be possible to use different sets of representations to provide "fall-back" positions within an RCD application by filing a so-called "multiple design application". For example, one could file a design application including a monochrome line drawing covering the shape of a design only. This would offer the broadest scope of protection. Within the same design application, one could also file a more detailed representation of the design showing relevant surface decoration, which would cover both the shape and the surface decoration of the design. This would afford a narrower scope of protection, but is more likely to be distinguished from the prior art, and is therefore more likely to be valid.
- It should not be assumed that a monochrome drawing will cover all colours/colour combinations. Differences in shading between different elements of a design could

be interpreted as representing a contrast between the colours of those elements, and thus the design may be limited to articles having such a colour contrast.

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

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