

HHJ Birss sees through Bristan's excuses

This case ([2013] EWPC 2), heard in the Patents County Court, concerns designs for electric shower units. Mira (the claimant) alleged that the Glee, Joy and Smile products, supplied by the defendant Bristan, infringed two of its Registered Community Designs (RCDs) 000578463-0001 ("RCD 0001") and 000578463-0002 ("RCD 0002") as well as UK unregistered design right (UDR) relating to aspects of the design of Mira's Azora product. Bristan denied infringement. Bristan also contended that the RCDs lacked individual character and hence were invalid. Furthermore, with regard to the UDR claim, Bristan argued that the designs were derived independently of the Mira design and also that certain elements of the Azora were commonplace in the field. It may be noted that Mira argued for infringement of their UK UDR as that enabled them to argue for infringement of aspects of their design that only related to certain parts of the design, and were therefore not limited to arguing for infringement of the design of the whole product.

Choosing to focus initially on RCD 0002, HH Judge Birss was called upon to settle the ambiguity as to the meaning of the dashed lines in the registered design. Bristan submitted that the dashed lines indicated what was visible by virtue of a transparent front face and that Mira's Azora product (which possesses such a face) should be used to interpret the design. The judge rejected the latter request to avoid prejudging the issue at hand. Mira instead argued that the lines were in place in order to show what lies beneath the non-transparent front face because, they alleged, the front face was not transparent. Despite the OHIM Guidelines for Examination indicating that dotted/dashed lines may be used to indicate invisible features, the judge sided with the defendant and ruled that the front face was indeed transparent. If the dashed lines were supposed to indicate what lies beneath a non-transparent unit, he concluded that they were not applied consistently. On this basis he found RCD 0002 valid as possessing individual character.

Turning to the issue of infringement, the judge ruled that there was no infringement due to the “striking transparent front panel” of RCD 0002 which was not present in the defendant’s product.

With regard to RCD 0001, the judge again had to determine what was meant by the dashed lines in the registered design. Even though the claimant argued that the dashed knobs meant that these features were optional, the judge sided with the defendant and agreed that, in this instance, an objective reader would understand that the dashed lines are showing elements for which no protection is sought. On the basis of the remaining features of the front plate, RCD 0001 was also held valid but not infringed.

This just left UK UDR, which was claimed in the design of the whole of and certain specified parts of Mira’s Azora product. The aspects of shape or configuration relied on by Mira for this purpose were:

- a) The whole of the unit.
- b) The rectangular “tombstone” appearance of the unit when viewed from the front.
- c) The two vertically aligned circular knobs, one at the centre of the front face and the other below it.
- d) The circular power switch and associated collar which is vertically aligned and located below the two circular knobs.

Within the field of “electric shower units”, both parties agreed that the design as a whole (aspect (a)) was not commonplace, nor was the combination of aspects (b) plus (c) plus (d). After hearing the submissions of the witnesses, the judge decided that aspects (c) and (d) were commonplace but that aspect (b) was not. So, in all, he concluded that Mira had UK UDR in four “designs”: aspect (a); aspect (b); aspects (b) plus (c), and aspects (b) plus (c) plus (d).

Moving on to the question of infringement, and despite the different individual aspects, the judge noted that the “striking” overall similarity between Bristan’s Glee product and Mira’s earlier highly successful Azora raised a “strong inference of copying” (copying being required for an infringement of UDR). The judge did not question the integrity of Bristan’s only witness in the UDR case, who denied copying and explained that he had not been aware of Mira’s products until after he had created his original designs. However the judge concluded that other staff at Bristan must have been aware of Mira’s Azora product whilst being in a position to guide the overall design process. The judge was not satisfied that Bristan had provided a cogent and credible explanation as to how the

designs of the Glee, Joy and Smile products produced were independent of Mira's Azora. He hence ruled that the similarities were indeed due to copying.

With regard to the question of whether the Bristan products were made exactly or substantially to the designs (the test for infringement of UK UDR), in spite of acknowledging some important differences between the products the judge found that Glee and Joy were made substantially to the Azora design as a whole. Hence, the Glee and Joy products were found to infringe all four "designs" and the Smile product only (a), (b) and (b) plus (c) due to its lack of a power button.

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