

**EIP**

# The strengths Of Registered Designs: how Trunki fought off the competition

Viewers of the TV show “Dragons’ Den” might remember the now highly successful Trunki children’s ride-on suitcase which was unanimously rejected by the Dragons as a bad idea. One of the Dragons, Peter Jones, was particularly dismissive, suggesting that the company behind the Trunki was “completely worthless” because the “product is not patentable” and could therefore be copied “within seven days”.

A recent decision from the High Court ([Magmatic Limited v PMS International Limited \[2013\] EWHC 1925 \(Pat\)](#)) has shown, however, that even the Dragons don’t always fully appreciate what aspects of a business can be protected by Intellectual Property (IP). This decision not only proves that the production and sale of Trunki look-alikes can be prevented, but also illustrates how broad the scope of protection afforded by other, often overlooked, forms of IP protection such as registered designs can be.

The claimant (Magmatic Ltd), which manufactures and sells Trunki cases, brought proceedings against PMS International Ltd which imports and sells a similar product named the Kiddee Case. (Readers might recognise the name PMS International from the [Green Lane Products v PMS International \[2008\] FSR 28 case here.](#)) Magmatic claimed infringement of, amongst other rights, their Registered Community Design (RCD), shown in Annexe 2 of the [judgment](#) together with images of the Trunki case, and the Kiddee Case.

## **Wide Scope of Protection for a Striking Design**

Article 10 of the Community Design Regulation (“the Regulation”) states that the scope of

protection conferred by an RCD “shall include any design which does not produce on the informed user a different overall impression”. It can be drawn from Recital 14 of the Regulation that the overall impression produced on the informed user depends on the “existing design corpus”; a design will have a greater scope of protection the further away it is from the existing design corpus.

In this case, the existing design corpus was held to include a range of adult clamshell suitcases. The RCD was determined to have a number of features that were also present in the design corpus. However, the relative arrangement of those features was held to give the design a strikingly different impression from the existing design corpus. The positioning of the clasps (to look like an animal’s nose and tail) and the addition of horns was held to particularly impact the appearance of the design. Thus, it was held that the RCD should be afforded a broad scope of protection.

With this in mind, the Judge described the Trunki design as “sculpted, sophisticated and modern” with “prominent ridge and horn-like handles and clasps looking like the nose and tail of an animal”. The Kiddee Case was held to have all of these features, and was thus held to infringe the RCD.

This case also shows that designers who have come up with an innovative design that is a notable departure from what has gone before may be able to obtain particularly broad and valuable protection for their design at relatively little cost as RCDs are relatively inexpensive forms of registered IP rights, which cover all of the countries of the European Union.

### **The Existing Design Corpus**

Another small, but nevertheless interesting, point raised in this decision was whether a design that has been disclosed to the public (as defined in Art 7 of the Regulation) must necessarily also form part of the existing design corpus of an informed user. In short, the answer appears to be ‘no’. As mentioned above, the existing design corpus is taken into account when determining the individual character of an RCD. Thus, if a seemingly relevant prior design can be argued not to be part of the existing design corpus, the RCD may be afforded a broader scope of protection and vice versa.

This case has shown how RCDs, which are often under-valued and overlooked, can in fact be incredibly versatile and wide-ranging in their scope of protection. Indeed, designers would be well advised to consider registering any new designs, particularly if they are markedly different from existing designs, as the scope of protection may be particularly broad in this case.

By Emma Wilkins and Iain Russell