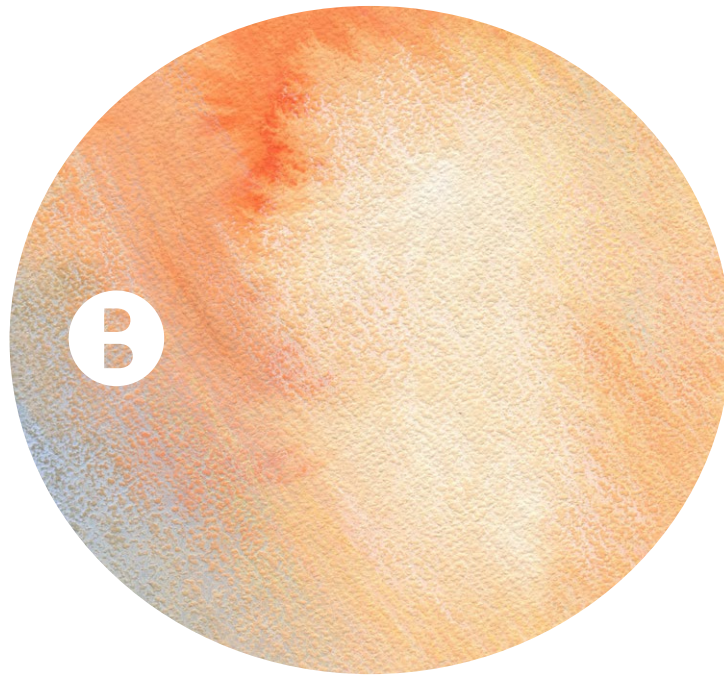


Designs and Copyright

Review of the Year 2024



Bristows

Edited by Simon Clark and Jake Palmer

Quotation of the Year

“It is a small bar (perhaps accommodating about thirty people before starting to feel crowded) and its principal decorative theme – as the name implies – consists of the display of a large collection of troll memorabilia, including statues, statuettes and photographs. Its location, facilities and ambience are not such as to attract the Bright Young Things of the city, nor yet its wellheeled bourgeoisie. Rather, it caters for a highly local and dedicated and mature clientele which, for one reason or another, tends to prefer a quiet drink or two in the company of the trolls to whatever other options might be available to it in the City of Discovery.”

Sky Ltd v Airlie [2024] CSOH 22 – Lord Sandison describing the Defendant’s bar in Dundee, Scotland

The information contained in this document is intended for general guidance only. If you would like further information on any subject covered by this bulletin, please e-mail Simon Clark (simon.clark@bristows.com), or the Bristows lawyer with whom you normally deal. Alternatively, telephone on + 44 (0)20 7400 8000.

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Introduction

Artificial intelligence

As foreshadowed in our [Designs and Copyright Review of the Year 2023](#), the clash between artificial intelligence (AI) and copyright has been at the forefront of the minds of copyright lawyers in 2024.

At the end of 2022, the sudden release and rise of the large-language model (LLM) ChatGPT, demonstrated AI's capabilities and potential.

Now, in 2025, the release of another LLM launched by Chinese AI firm DeepSeek shows the race is on to develop AI. This highlights an important conundrum for the UK Government in the global race for AI development: how can the UK foster AI development without harming its creative industries?

To address this question, in December 2024, the Government launched a consultation on Copyright and AI which closed in February 2025. The Government put forward the option of a new text-and-data mining exception to copyright in the UK. The exception would allow AI developers to collect copyright-protected material for the purpose of training their AI models, provided that the rightsholder had not opted out by "reserving their rights".

In the meantime, the first UK court case between rightsholders and AI developers (*Getty Images v Stability AI*) appears to be proceeding to trial. The Claimants, various rightsholders including Getty Images, allege that Stability AI used Getty's content to train the AI model, Stable Diffusion; the claim is for copyright infringement, database right infringement, trade mark infringement and passing off.

The latest development in the case was the rejection by the Court in early 2025 of an attempt by the Claimants to represent over 50,000 photographers and content contributors. The Court urged the parties to resolve some of the case management issues relating to a case involving so many copyright works and a complex AI product. Depending on how these issues are resolved, the case could serve as a helpful guide to bring or defend claims for use of content in AI models.

More details on this decision can be [found here](#). The final trial is expected to take place in June 2025, which copyright lawyers will be following closely.

Copyright and designs cases

The courts were quieter on the copyright and designs side, compared to the multiple high-profile cases on the trade marks side – for a summary of those, please see our [Trade Marks Review of the Year 2024](#).

Copyright

However, a main thread arising out of the cases has been the incompatibility between EU and UK law regarding what subject matter can be protected by copyright. The EU approach is that subject matter that is identifiable with sufficient precision and objectivity is protectable, provided it is original. On the other hand, the UK legislation provides a "closed list" of subject matter that is protectable. The incompatibility between the laws arise where a work does not obviously fall within the UK's closed list.

This year such works included a wooden rowing machine (*WaterRower*) and high visibility equestrian products constituting a waistcoat, an elasticated hat band and a neck band for a horse (*Equisafety v Woof Wear*). In *WaterRower*, the Court held that EU and UK law were indeed incompatible and then proceeded to apply UK law. In doing so, it was determined that the wooden rowing machine was not a work of artistic craftsmanship. The same conclusion was reached in *Equisafety*.

Designs

The main designs case of the year was the Court of Appeal's decision in *Marks & Spencer v Aldi*. The decision itself was not particularly surprising or insightful. However, the Court did answer several questions that have been puzzling design lawyers for some time.

For example, the Court confirmed that earlier designs of the proprietor which give the same overall impression as the registered design should be ignored when assessing the design corpus for the purposes of infringement.

[See here](#) for a case summary, and [here](#) for a more detailed analysis of the case.

Designs legislation

In late 2024, the Council for the European Union approved revisions to the Design Directive and the Community Design Regulation. The amended Design Directive entered force in December 2024, but EU member states will have until December 2027 to transpose it into national legislation. The amended Community Design Regulation will apply from May 2025.

One of the main aims of the revisions is to make design law fit for purpose in the digital age. For example, the definitions of Design and Product have been broadened to include protection for: moving features, products in a non-physical form and the spatial arrangement of items intended to form an interior or exterior environment.

Copyright

Court of Justice of the European Union (CJEU)



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Kwantum Nederland and another v Vitra Collections AG (Case C-227/23) **EU:C:2024:914**

CJEU rules on copyright protection for non-EU works of applied art

In a significant ruling the CJEU has confirmed that works of applied art that satisfy the criteria for a “work” under Directive 2001/29/EC (the “**Infosoc Directive**”) qualify for copyright protection under EU law even if the work originates from a non-EU country or the author is a third country national. The CJEU’s ruling expands the scope of EU copyright protection and will make it easier for rightsholders outside the EU to enforce copyright to prevent the marketing and sale of imitation products within the EU.

Background

The request for a preliminary ruling was made by the Hoge Raad der Nederlanden (Supreme Court of the Netherlands) in the context of domestic copyright infringement proceedings relating to the sale of a chair by Kwantum that Vitra alleged to be an imitation of the “DSW Chair”.

Vitra manufactures designer furniture, such as the DSW Chair, which was designed by acclaimed American designers Charles and Ray Eames for a furniture design competition organised by the Museum of Modern Art in New York in 1948.

Kwantum is a chain of shops operating in The Netherlands and Belgium selling interior design articles and home furniture, including the “Paris Chair”, which Vitra alleged to infringe copyright in the DSW Chair.

Decision

In this case the CJEU was required to consider the scope of copyright protection for applied art under the Infosoc Directive and the interplay between EU copyright law and the provisions of the Berne Convention. Works of applied art are essentially artistic works embodied in products that serve utilitarian or functional purposes; in this case, a chair. The protection of applied art has proven challenging because the subject matter can straddle the boundaries of several intellectual property rights, including copyright, design rights and patents, which has often resulted in works of applied art not benefiting from copyright protection internationally and domestically.

On the protection of applied art under EU law, the CJEU confirmed that the qualifying criteria for copyright protection under the Infosoc Directive are not determined by or connected to geographic factors, such as the country where the work originated or the nationality of the author. The key is whether the applied art in question qualifies as a “work” and the CJEU confirmed that if it does the work can benefit from copyright protection under the Infosoc Directive.

The CJEU went on to decide that Member States cannot rely on a specific reciprocity exception under the Berne Convention to deny the protection afforded to works of applied art under EU law. Consequently, where a work of applied art qualifies for protection under EU law, Member States must recognise that protection regardless of whether the work would have been protected under the Member States' national laws or the laws of the country from which the applied artwork originated.

Comment

The CJEU's decision is significant as it clarifies and confirms the protection of applied art under EU law. The CJEU's ruling also demonstrates the broad reach of EU copyright law under the Infosoc Directive. The ruling considerably strengthens the protection for rightsholders based outside the EU and will make it more straightforward to rely on copyright as a tool to stop imitation products being sold and marketed within the EU.

From a purely UK perspective, the CJEU's decision is not binding on English courts post-Brexit and therefore does not settle the protection of works of applied art under English law. Even so, the CJEU's decision confirms that those works can be protected throughout the EU and rightsholders will still benefit from EU protection even if the English courts adopt a different approach to that taken by the CJEU.



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Citadines Betriebs GmbH v MPLC Deutschland GmbH (Case C-723/22) **EU:C:2024:289**

Background

This case concerned a request for a preliminary ruling from CJEU by the Higher Regional Court in Munich relating to the “communication to the public” right in Article 3(1) of the InfoSoc Directive.

MPLC, a collective management organisation, had brought an action before the Regional Court against Citadines, a hotel operator. MPLC sought an injunction to prohibit the communication to the public of an episode of a television series – the rights for which it managed – by Citadines in its hotel. Citadines had retransmitted the broadcast signal for this episode via television sets (coupled with coaxial and data cables – i.e., cable retransmission) that it had installed in its hotel guest rooms and fitness area. Citadines had concluded a licensing agreement with German collective management organisations for cable retransmission.

The Regional Court granted the injunction. Citadines appealed to the Higher Regional Court, arguing that its licence agreement entitled it to make available to its hotel guests free-to-air programmes broadcast on public-service television. Conversely, MPLC argued that, by retransmitting the signal through the hotel's own distribution network, Citadines had infringed MPLC's right of communication to the public.

The Higher Regional Court noted that:

- While the mere provision of physical facilities (such as reception equipment) does not of itself constitute a communication to the public, that right is infringed where the signal is retransmitted to that reception equipment by means of a cable distribution network.
- Citadines' acts went beyond the mere provision of such physical facilities, which Citadines was entitled to do under its licensing agreement.
- It was doubtful whether Citadines' acts which it was entitled to perform under the licence agreement (i.e. cable retransmission) showed that it intended to perform an act of "communication", when in all other respects it was simply providing reception equipment.

Some of the Court's doubt was rooted in the manner in which the communication to the public right had been implemented in Germany. Under German law – specifically the Gesetz über Urheberrecht und verwandte Schutzrechte - Urheberrechtsgesetz (the "UrhG") – the implementation of the communication to the public right was subdivided into several different acts, each of which were implemented under a separate paragraph. Broadcasts are addressed in two of those paragraphs.

First is paragraph 20 which covers the right to make a work available to the public by broadcasting. Specifically, paragraph 20b(1) addresses retransmissions of such broadcasts and cable retransmission rights may only be asserted by a collective management organisation (such as MPLC). The Higher Regional Court clarified that paragraph 20b arose from an amendment to the UrhG which was intended to transpose the Satellite Broadcasting and Cable Retransmission Directive into German law (i.e. rather than the InfoSoc Directive, which covers the communication to the public right).

Second is paragraph 22 which covers the right to communicate broadcasts to the public.

So the implementation of the communication to the public right in Germany ostensibly captures cable retransmissions which are covered by the Satellite Broadcasting and Cable Retransmission Directive.

Decision

The question referred

The Higher Regional Court referred the following question to the CJEU for a preliminary ruling:

Must Article 3(1) of [the InfoSoc Directive] be interpreted as precluding a national provision or practice according to which the provision of physical facilities for enabling or making a communication – such as television sets in hotel rooms or hotel fitness rooms – is regarded as communication to the public when, while the transmission signal, in addition, is retransmitted to the physical facilities via the hotel's own cable distribution system, that cable retransmission takes place lawfully on the basis of a licence acquired by the hotel?

The CJEU's response

The CJEU did not accept that Citadines was a "cable operator" or "cable distributor" as those terms are understood in the Satellite Broadcasting and Cable Retransmission Directive. The CJEU also noted that it did not have before it details of the licensing agreement that Citadines had concluded and so did not know what particular acts the agreement covered. Citadines told the Court that its acts were covered by the agreement, whereas MPLC contended that the agreement did not cover the direct and indirect retransmission of the television episode by means of a distribution network belonging to Citadines. The CJEU concluded that it was for the national court to determine what acts of communication to the public were covered by the licensing agreement.

The CJEU went on to restate some of the principles underpinning the communication to the public right before reaching the following conclusions:

- A hotel operator (in this case Citadines) carries out a “communication” when it intentionally transmits protected works to its guests by intentionally distributing a signal through television sets that it has installed at its hotel.
- The guests of such a hotel are a “public” (that is, an indeterminate number of persons, fairly large and limited only by the capacity of the hotel).
- The hotel operator can be said to have made the necessary “intervention” where it intentionally provides access to the broadcast of the television episode to an additional public (through television sets it has installed in the hotel), in full knowledge of the consequences of its actions.
- The fact that the Citadines’ guests may not have switched on the television sets is irrelevant.
- The provision of access to television broadcasts amounts to an additional service which has influence on the hotel’s standing and therefore the price of the rooms at the hotel. So the communication has the necessary “profit-making” nature.
- The provision of television sets within the hotel was not a mere provision of physical facilities.

So the CJEU concluded that where a hotel uses its own cable distribution network to retransmit a broadcast signal of a television episode to television sets it has installed in its hotel, there is a communication to the public within the meaning of Article 3(1) of the InfoSoc Directive. It will now fall to the Higher Regional Court to consider whether Citadines’ licence agreement covers these acts.



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Sony Computer Entertainment Europe Ltd v Datel Design and Development Ltd and others (C-159/23) EU:C:2024:887

Background

This case concerned a request for a preliminary ruling from the CJEU by the German Federal Court of Justice relating to the interpretation of Articles 1 and 4 of the Computer Programs Directive.

Sony Computer Entertainment Europe Ltd (“**Sony**”) had the exclusive licence to market PlayStation consoles and games in Europe. Prior to 2014, the year when Sony stopped making them, Sony marketed the PlayStationPortable (“**PSP**”) - a handheld games console - with accompanying games, including MotorStorm: Arctic Edge.

Datel distributed components which complemented Sony’s PSP. This included the Action Replay PSP software, which could be loaded on to the PSP through a USB stick to enable the user to access features/ functionality that would not otherwise typically be available to the user at that stage of the game. It also included the Tilt FX device, which enabled the PSP to be controlled by motion – this was achieved by inserting the device into the PSP to remove certain restrictions and allow the use of a motion sensor, so that the interface on the screen would respond to the movement of the PSP by the user.

Sony had claimed that game users who used Datel's software altered the software underpinning the game and infringed copyright. The Regional Court in Hamburg upheld Sony's claims, in part. However, on an appeal, the Higher Regional Court dismissed Sony's action. An appeal was brought before the German Federal Court of Justice on a point of law.

The outcome of the appeal would depend upon whether the use of Datel's software infringes the exclusive right to alter software under German law. That in turn depended upon the interpretation of certain provisions of the Computer Programs Directive, namely Article 1(1) to (3) and Article 4(1)(b) which reads as follows:

Article 1:

- 1. In accordance with the provisions of this Directive, Member States shall protect computer programs, by copyright, as literary works within the meaning of the [Berne Convention]. For the purposes of this Directive, the term "computer programs" shall include their preparatory design material.*
- 2. Protection in accordance with this Directive shall apply to the expression in any form of a computer program. Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, are not protected by copyright under this Directive.*
- 3. A computer program shall be protected if it is original in the sense that it is the author's own intellectual creation. No other criteria shall be applied to determine its eligibility for protection.*

Article 4(1)(b):

Subject to the provisions of Articles 5 and 6, the exclusive rights of the rightholder within the meaning of Article 2 shall include the right to do or to authorise ...the translation, adaptation, arrangement and any other alteration of a computer program and the reproduction of the results thereof, without prejudice to the rights of the person who alters the program.

The question in relation to Article 1 arose because Datel's software did not change the source code or object code of Sony's game software. Instead, it merely altered variable elements of Sony's game software that had been transferred to the Random Access Memory (RAM) of the console when the program was run. The German Federal Court of Justice was uncertain whether the content of the variable elements contained in the RAM fell within the scope of protection of Article 1.

The question in relation to Article 4 concerned the meaning of "alteration" and whether it covered the situation described in the paragraph above.

Decision

The questions referred

Accordingly, the German Federal Court of Justice referred the following two questions to the CJEU:

- 1. Is there an interference with the protection afforded to a computer program under Article 1(1) to (3) of Directive [2009/24] in the case where it is not the object code or the source code of a computer program, or the reproduction thereof, that is changed, but instead another program running at the same time as the protected computer program changes the content of variables which the protected computer program has transferred to the [RAM] and uses in the running of the program?*

2. Is an alteration within the meaning of Article 4(1)(b) of Directive [2009/24] present in the case where it is not the object code or the source code of a computer program, or the reproduction thereof, that is changed, but instead another program running at the same time as the protected computer program changes the content of variables which the protected computer program has transferred to the [RAM] and uses in the running of the program?

The CJEU's response

The CJEU noted the following:

- Article 1 provides protection for “the expression in any form” of a computer program - provided that it is original. This excludes ideas and principles which underlie its constituent elements (including those elements underlying the program’s interfaces).
- “Expression in any form” covers reproduction in different computer languages (namely, source code and object code). The source code and object code allow the program to be reproduced.
- However, neither the graphic user interface produced by a computer program, or the functionality, programming language or data file formats of a computer program, are a protected form of expression, since they do not allow the program to be reproduced.
- The protection is therefore limited to the originality reflected in the source code and object code – in other words, the literal expression of the program within those codes. This is reflected in international instruments, such as the Berne Convention, the TRIPS Agreement and the WIPO Copyright Treaty.

- Datel’s software, which is installed by the user on the PSP and runs in parallel to the game software, does not change or reproduce its object code or source code, or indeed the internal structure and organisation, of the PSP software. It simply changes the content of the “variables” that are transferred by Sony to the PSP RAM used when the game is running. The PSP software runs in parallel to the variables, but is unchanged. The variables in the RAM do not enable the object code or source code of the PSP software to be reproduced and so are not covered by the scope of protection in Article 1.

In light of its answer to this first question, the CJEU found no need to answer the second question. In view of the CJEU’s response, it seems most likely that the German Federal Court of Justice will uphold the decision of the Higher Regional Court.



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GEMA v GL (C-135/23) EU:C:2024:530

The CJEU ruled that Article 3(1) of the InfoSoc Directive (2001/29/EC) (the “**InfoSoc Directive**”) meant that installing a television set with an indoor antenna that could receive television broadcasts, constituted a “communication to the public”, unless tenants had established their principal or secondary residence there.

Background

GEMA, a collecting society handling music copyright, brought a claim for damages under copyright law before the Amtsgericht Potsdam (the **Referring Court**), against GL, the operator of an apartment building.

The Referring Court sought clarification from the CJEU on the interpretation of Article 3(1) of the InfoSoc Directive and specifically whether the concept of “communication to the public” included the provision of television sets equipped with indoor antennas, by the operator of a rented apartment building. These devices enabled tenants to access broadcasts without further intervention. The InfoSoc Directive provides authors with the exclusive right to authorise or prohibit communication of their works to the public. However, its scope, particularly regarding “communication to the public”, has been the subject of extensive judicial interpretation.

Decision

The Court reiterated that the concept of “communication to the public” under the InfoSoc Directive is comprised of two elements: (1) an act of communication and (2) the communication of that act to a public. The assessment of these elements required consideration of several factors, including the role of the user, the deliberate nature of intervention, and the profit-making nature of the act of communication.

It found that the operator of the apartment building deliberately intervenes to provide access to broadcasts by equipping apartments with televisions and indoor antennas. This intervention, performed with the intention of enhancing the attractiveness and prestige of the apartments to prospective tenants, constitutes an act of communication. This is how the Court sought to distinguish a “communication to the public” in this sense, compared to the “mere provision of physical facilities”.

For communication to qualify as being “to the public”, the audience must consist of an indeterminate and fairly large group of people. Here, the Court noted that short term renters, such as tourists, may qualify as a “public” because they represent an indeterminate group. However, long-term tenants establishing their primary residence at the apartments would not constitute a “new public” under the InfoSoc Directive. The long-term tenants would be considered as owners of the television equipment and would constitute a class of the public who were taken into account by the copyright holders when the initial communication was authorised.

Comment

This decision highlights the nuanced interpretation of “communication to the public” and the importance of context in assessing copyright issues under the InfoSoc Directive. By emphasising the deliberate and profit-making nature of the operator's actions, the CJEU distinguished between mere provision of physical facilities and active communication of works to the public.

The decision also highlights the importance of the recipients of the communication, and the requirement that they can be considered a “new public”. The CJEU's response to the Referring Court was essentially to consider whether the apartments are let to tenants who establish their residence there (who are not a “new public”), or whether they are let on a short-term basis (in particular as tourist accommodation) which would be capable of amounting to a “new public”.

Court of Appeal



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Lidl Great Britain Limited and another v Tesco Stores Limited and another [2024] EWCA Civ 262

A version of this article was first published in Kluwer Copyright Blog, April 2024, available on the [Kluwer Copyright Blog](#).

The UK Court of Appeal handed down its judgment in relation to a dispute between UK supermarket giants Tesco and Lidl regarding Tesco's use of Clubcard Price signs.

The first instance decision found Tesco to be liable for trade mark infringement, passing off and copyright infringement through its use of such signs. For a summary of that decision, see our Designs and Copyright Review of the Year 2023 [here](#).

The Court of Appeal upheld the findings of trade mark infringement and passing off, but overturned the finding of copyright infringement.

This article covers the copyright appeal. For the article covering the trade mark and passing off appeal, see our [Brands Review of the Year 2024](#).

Background

The parties are the well-known supermarkets in the UK: Lidl and Tesco.

The CCP Signs

The subject of the dispute was Tesco's Clubcard Prices signs ("**CCP Signs**"), as shown below. These were used as part of a marketing campaign by Tesco to indicate to customers which products were subject to discounted prices for Clubcard holders.



<https://www.bailii.org/ew/cases/EWCA/Civ/2024/262.html>

Lidl's trade mark

Lidl brought an action in the High Court against Tesco. By the time of trial, Lidl's copyright claim was that the CCP Signs infringed the copyright subsisting in the Mark with Text shown below.



The Mark with Text

<https://www.bailii.org/ew/cases/EWCA/Civ/2024/262.html>

First instance¹

The first instance judge, Mrs Justice Joanna Smith, found that copyright subsisted in the Mark with Text and that this was infringed by the CCP Signs.

On subsistence, the judge summarised Tesco's argument as being that the "combination consists of insufficient skill and labour because it is too simple", which she rejected.

She noted that while the artistic quality may not have been high, this did not preclude an artistic work from being original, and that "bringing together the Lidl text with the yellow circle and blue background was an act which involved skill and labour". Accordingly, the Mark with Text was a protectable copyright work as an artistic work.

On infringement, the judge found that the similarities were sufficiently close to be more likely a result of copying than coincidence and so it was for Tesco to explain those similarities. Tesco failed to do so and Lidl successfully argued that the part copied (the blue background with the yellow circle) formed a substantial part of the copyright work (the Mark with Text), and so Tesco was held liable for copyright infringement.

Decision

The process of creation of the Mark with Text is important context to the appeal. Essentially, Lidl explained that the Mark with Text was the product of a "three-stage evolution" shown below, involving potentially different authors over roughly a 15-year period.

1. **Stage 1** – The stylised "Lidl" text only
2. **Stage 2** – The yellow circle with a red border was added to Stage 1 (the "**Stage 2 Work**"),
3. **Stage 3** – The blue square background was added to the Stage 2 Work (the "**Stage 3 Work**")

The Stage 3 Work



<https://www.bailii.org/ew/cases/EWCA/Civ/2024/262.html>

Tesco's appeal relied on two grounds. They claimed the first instance judge was wrong to find (1) the Stage 3 Work was **original**, and, in the alternative, (2) the CCP Signs reproduced a **substantial part** of the Stage 3 Work.

On the judge's **originality** finding, Counsel for Tesco essentially argued that the contribution of the author of the Stage 3 Work was analogous to adding a blue background to Caravaggio's *Medusa*, as shown below.



<https://www.bailii.org/ew/cases/EWCA/Civ/2024/262.html>

¹ *Lidl Great Britain Limited and Anor. v Tesco Stores Limited and Anor.*
[2023] EWHC 873 (Ch), 19 April 2023

However, Arnold LJ found that the Stage 3 Work was “sufficiently original” to attract copyright protection, while noting that “scope of protection conferred [...] is narrow”. In doing so, he referred to the choices made by the author of the Stage 3 work as being:

1. the shade of blue;
2. the positioning of the Stage 2 Work centrally within the square; and
3. the distance between the edges of the square and the edge of the Stage 2 Work.

Accordingly, Tesco’s objection on originality failed.

On the judge’s **substantial part** finding, Tesco argued on appeal that Tesco had not copied what was original to the author of the Stage 3 Work.

Arnold LJ agreed with Tesco and thus allowed the appeal. He explained that Tesco had not copied “at least two elements that make the Stage 3 Work original, namely the shade of blue and the distance between the circle and the square”. Lidl had accepted that they could not complain about the yellow circle since it was only original to the Stage 2 Work, and not to the Stage 3 Work.

So, in short, the Court of Appeal found the Stage 3 Work was original, but was not infringed by the CCP Signs.

Comment

The Court of Appeal judgment highlights two important points of law.

Firstly, where the degree of creativity is low in a copyright work, the consequence is that the scope of protection conferred by the copyright in that work is correspondingly narrow.

So, while the case does helpfully demonstrate that brand owners may be able to rely on even relatively simplistic logos as copyright works, copyright protection for such simplistic logos may only capture close copies.

Secondly, the only protectable elements of a derivative work are those that are original over the antecedent work. Or, as Arnold LJ puts it in the judgment: “If A creates a first original work, B copies A’s work but adds sufficiently to it to create a second original work, and C copies from B’s work only the part created by A, then B has no claim for copyright infringement against C because that which has been copied by C is not original to B.”

Accordingly, when it comes to copyright claims, it is important that brand owners (1) understand the process of creation of any “works” that they wish to rely on, and (2) recognise the original elements of each “work” if the work has been created in stages.



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Parker-Grennan v Camelot UK Lotteries Ltd [2024] EWCA Civ 185

On 1 March 2024 the Court of Appeal upheld the High Court’s decision to refuse summary judgment to Ms Parker-Grennan against the National Lottery operator, Camelot. Camelot’s online terms and conditions were effective in defeating her claim for £1 million which she claimed to have won on their online Instant Win Game. This is the first Court of Appeal judgment which considers what needs to be done to incorporate standard terms and conditions into online contracts for goods or services.

Background

The Defendant, Camelot UK Lotteries Ltd, operated the National Lottery as well as Scratchcards and online Instant Win Games (IWG(s)), all under the well know National Lottery brand. The Claimant, Ms Parker-Grennan, played an online IWG on the National Lottery website in 2015 which required the player to “*Match any of the WINNING NUMBERS*” to any number displayed in the “*YOUR NUMBERS*” section, to win the prize shown alongside that number.

The Claimant matched the number 15, which then flashed green, and a pop up stated that she had won the corresponding £10 prize. She noticed she had also matched a second number, the number 1, which carried the maximum prize of £1 million.

However, this number 1 did not flash and no notification appeared on the laptop screen stating that she had won £1 million (as shown in the screenshot below). The Claimant argued that she was entitled to the £1 million prize, in addition to the £10 prize which the Defendant accepted she had won.

The Defendant explained that the apparent match of the number 1 was caused by a coding error in the animation software and that the animation is irrelevant to the winnings as explained in the website terms and conditions – the prize that can be won by any given ticket purchased is “predetermined” by its computer system. Camelot’s database (the official list of “Winning Plays”) recorded that the prize associated to the Claimant’s ticket was £10 and therefore they refused to pay out more than that.



<https://www.bailii.org/ew/cases/EWHC/KB/2023/800.html>

Decision

High Court²

The Claimant applied for summary judgment on the basis that the relevant terms had not been incorporated into the contract between the Claimant and Defendant; or, if they had been incorporated, they were nevertheless unenforceable under the Unfair Terms in Consumer Contracts Regulations 1999³ (UTCCR). The High Court Judge, Jay J, dismissed the application on the following grounds:

1. **Incorporation** – Camelot’s website terms were properly incorporated into the online contract between the Claimant and Defendant.
2. **Enforceability** – None of the relevant website terms which the Defendant relied upon were unfair under UTCCR.
3. **Construction** – On a proper interpretation of the Defendant’s Game Procedures and IWG Rules, the Claimant had only won £10.

Court of Appeal

Ms Parker-Grennan lodged an appeal against the decision. The Court of Appeal dismissed the appeal, after agreeing with the High Court on the same three issues. The leading judgment was provided by Andrews LJ:

1. **Incorporation** – The Defendant sought to incorporate three sets of terms: the Account Terms, the IWG Rules and the Game Procedures applicable to any specific game, all of which were easily accessible via a series of hyperlinks and drop-down menus.

The relevant legal test applied was whether Camelot took reasonable steps to bring the terms and conditions to the attention of a player of the game which includes giving the player sufficient opportunity to read them. This was a question of fact.

As the terms were drafted clearly and were not onerous or unusual, the Court found that there was no need for specific signposting. The Court noted that there was no requirement to force a consumer to scroll through the terms and conditions as this would not make them any more likely to read them.

The Defendant did not just rely on the Claimant’s original acceptance of these terms via the click-wrap procedure when they opened the account six years earlier in 2009; the Claimant was also required to reconfirm her acceptance as and when the terms were updated from time to time.

Accordingly, the Court of Appeal agreed with the High Court that the relevant terms and conditions had been incorporated into the parties’ contract.

2. **Enforceability** – Having found that Ms Parker-Grennan was bound by the terms, the Court considered whether any term, contrary to the requirement of good faith, caused “a significant imbalance in the parties’ rights and obligations arising under the contract, to the detriment of the consumer” (Reg 5(1) UTCCR) so that it was considered unfair, and unenforceable against the consumer under Reg 8(1) UTCCR.

The Claimant argued that Reg 6(1), which deals with the assessment of unfairness, should be read with Reg 7(2) of UTCCR (“if there is any doubt about the meaning of a written term, the interpretation which is most favourable to the consumer shall prevail”), so that where there were ambiguous competing contractual clauses, the meaning most favourable to the consumer prevails.

Clause 13.3 of the IWG Rules set out the order to apply the applicable rules in case of a conflict, and it unambiguously placed Game Procedures at the top of the hierarchy. The Claimant argued that Reg 7(2) had the

² *Parker-Grennan v Camelot UK Lotteries Ltd* [2023] EWHC 800 (KB), 4 April 2023

³ The events occurred before the Consumer Rights Act 2015 came into force

effect of displacing Clause 13.3, raising the explanation on the Game Details Screen to the top of the hierarchy.

Andrews LJ agreed with the Defendant that Reg 6(1) and Reg 7(2) were two separate provisions that did not operate together. Reg 7(2) would not re-write Clause 13.3, as it concerns the construction of individual clauses, not the re-ordering or disapplication of contractual provisions.

Moreover, Andrews LJ reiterated that Clause 13.3 did not conflict with any other rule; the omission of what should happen in the event of a software error on the Game Display Screen was not an inconsistency, the answer simply lied elsewhere. Andrews LJ went on to say that it was inconceivable that Clause 13.1 (which merely explained that the specific rules relating to the game being played take precedence over other more general rules) created “a significant imbalance in the contracting parties’ rights” or was contrary to the requirement of good faith.

- 3. Construction** – The Claimant submitted that the contractual term on the Game Display Screen stating “Match any of the WINNING NUMBERS to any of YOUR NUMBERS to win PRIZE” [sic.], meant that the actual outcome was a win of £1 million. However Andrews LJ held that in treating this as the only contractual term, the Claimant ignored four key points:

- a. The Game Procedures stated “if You match a number from the WINNING NUMBERS to a number in the YOUR NUMBERS Section, the two matching numbers will turn white and flash in a green circle indicating that you have won the Prize for the matched YOUR NUMBERS” and “When You have revealed all numbers and Prizes a message will appear at the top of the Game Play Window indicating the amount You have won”. Both the flashing numbers and

message consistently showed that the Claimant had won £10. Moreover Andrews LJ considered that both the Game Procedures (which referenced the odds) and the use of the singular “PRIZE” on the Game Display Screen, made it clear that only one prize could be won per play.

- b. The Game Procedures also stated that “You must select “FINISH” to complete the Game”. After the Claimant selected “FINISH”, she was shown the consistent outcome that she had won £10.
- c. In accordance with Clause 6(2)(d) of the IWG Rules, the Claimant was bound by the £10 win that was recorded on Camelot’s official list of Winning Plays.
- d. The computer system that randomly generated numbers to allocate prize tier levels with users’ unique play numbers was working properly (the software error only affected the animations).

Therefore it was held that, whichever way it was looked at, on the true construction of the contract, it was clear that the Claimant had only won £10.

Comment

In this judgment the Court of Appeal proceeded to apply the leading authorities regarding the incorporation of standard terms into contracts, despite noting that they pre-date the digital era. Whilst the Judges purposefully declined the Claimant’s invitation to lay down principles of more general application, Andrews LJ did recommend that it was an opportune time for the Law Commission to conduct another evidence-based review on this area of the law.

While this judgment does not contain any new law, Andrews LJ’s analysis is useful to anyone drafting website terms. The click-wrap process should usually be sufficient to incorporate standard terms and conditions, provided reasonable steps are taken to bring them to

the consumer's attention and the consumer has sufficient opportunity to review them. However, additional steps may be necessary to signpost unusual or especially onerous terms to customers. The judgment illustrates the importance of drafting terms in a transparent, clear and accessible manner (such as through use of plain English and meaningful headings) as well as considering the fairness of each term.

Andrews LJ recognised the difficulty in getting people (even lawyers) to read the "small print" before clicking the accept button, reiterating that companies must balance their need to publicise their terms and conditions with the consumer's need to understand and access them. Camelot showed that online terms and conditions can be drafted in a way that is effective in protecting the business from liability should the website malfunction; this is a contrast to the terms in *Andrew Green v Petfre (Gibraltar) Ltd (t/a Betfred)* [2021] EWHC 842⁴ wherein a payout had to be made.

High Court



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Warner Music UK Ltd and another v Tuneln Inc. [2023] EWHC 2875 (Ch)

Background

Following a finding of copyright infringement by Tuneln (a US-based radio aggregator) in 2019, Warner Music and Tuneln became engaged in an inquiry as to damages. A full review of the liability decision can be found in our 2019 [Designs and Copyright Review of the Year publication](#) to provide some context to the present case. In a judgment handed down

in November 2023, the High Court considered numerous disputes which arose regarding the parties' disclosure obligations.

Decision

The principles governing disclosure are set out in PD 57AD of the Civil Procedure Rules ("CPR"). Deputy Master Raeburn stressed that clarity was particularly important in Model C requests and that they should be limited in number, focussed in scope and concise so that the responding party is clear on the searches it is being asked to undertake. Requests must also not be used in a tactical or oppressive way.

With those principles in mind, the Deputy Master then considered the four main issues in dispute.

1. Are PPL documents under the Claimants' control?

The first question was whether, under the Model C requests made by the Defendant, the Claimants' obligation to search for and disclose documents extended to obtaining documents from PPL (Phonographic Performance Limited, the collecting society which administers a vast number of rights on behalf of rights holders). The Court found it was premature and inappropriate to determine the issue in the present case prior to the parties conducting their searches and providing the disclosure certificates, and so made no determination of whether the Claimants did or did not exercise control over certain documents.

2. What was the correct approach to the disclosure of the stations which Tuneln indexed?

Issue 2 was in relation to the disclosure of indexed stations on Tuneln's service. The parties agreed on the formulation of that issue, and that Model C should be used. However, the dispute which arose was the scope of the searches to be conducted by both sides.

⁴ *Andrew Green v Petfre (Gibraltar) Ltd (t/a Betfred)* [2021] EWHC 842, 7 April 2021

The Claimants contended that the Defendant should identify and disclose all indexed stations on its service since November 2011. The Defendant sought to limit this search to specific internal databases, on the basis of proportionality.

The Court did not consider either of the parties' approaches to be fair, reasonable and proportionate. It endorsed the Defendant's position and proposed constraints while also agreeing with the Claimants that the search of listening activity must not be limited to the UK.

3. What was the correct approach to the disclosure of PPL rates?

Issue 3 was in relation to the PPL rates for webcasters and simulcasters.

The Court agreed with the Claimants that any document relied on by the Defendant in support of the alleged PPL rates should have been provided during Initial Disclosure. Correspondence between the parties revealed that the Defendant would only agree to the inclusion of this issue on the condition that other issues were accepted by the Claimants as issues for disclosure.

The Court firmly noted that it would not accept this approach to attempted negotiation of issues for disclosure and the parties were expected to co-operate with one another to agree the scope of disclosure efficiently. "Tactical horse-trading" would not be tolerated. Ultimately it was found that the issue was necessary, reasonable and proportionate.

4. What was the correct approach to the disclosure of comparable licences?

In short, the Defendant sought the disclosure of the "rates and terms" of "potentially comparable licences" from the Claimants on the basis that these were key documents required for the fair resolution of the assessment of damages. The Claimants rejected this; they claimed that there was no

pleaded basis on which a comparison could be determined and instead contended that the Defendant should first plead what it regarded as sufficiently comparable services.

The Court held there was a sufficient basis in the pleadings and that the issues were appropriate to be included for disclosure; therefore, Extended Disclosure was reasonable in the circumstances. The Court also noted that comparable licences can be important in particularly complex and high value cases of this nature.

Despite this, the Court criticised the framing of the disclosure sought, and in particular the use of vague phrases such as "potentially comparable licences" and "rates and terms" which contained "inherent uncertainty". The wording meant that the requests were not limited in number, concise or focussed and therefore were too wide and inappropriate for disclosure. Ultimately, since the Court did not have the necessary information to determine the appropriate scope of requests for comparable licences, the parties were directed to liaise to agree what specific requests were appropriate.

Comment

This case provides a demonstration of how damages inquiries can quickly become complex, expensive and time-consuming in intellectual property cases and why many parties prefer to settle. It is also a useful reminder to practitioners that the courts will not tolerate "tactical horse-trading" in agreeing issues for disclosure and that disclosure requests should be concise, focussed and proportionate.



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Samherji HF v Fridriksson **[2024] EWHC 2892**

In this case the High Court granted summary judgment in favour of Samherji HF, the Claimant, in a claim against the Defendant, Icelandic conceptual artist Oddur Fridriksson, regarding a mixed media art project.

Background

In 2023, the Defendant created a mixed media art project designed to highlight the Claimant's involvement in the "Fishrot Scandal", which concerned bribery in exchange for Namibian fishing quotas. The project comprised a physical installation in the Reykjavik Museum of Art and a website at samherji.co.uk made to look like the Claimant's official UK website (the "**Website**"). The Website featured the Claimant's logo, brochures and other information about the Claimant. The homepage also featured the words "WE'RE SORRY" with a link to a fake press release that purported to provide an apology for the Claimant's involvement in the Fishrot scandal.

In May 2023, the Claimant successfully applied to the High Court for an interim injunction compelling the Defendant to take down the Website and transfer the domain name to the Claimant. Then in March 2024, the Claimant applied for summary judgment on the basis that the Defendant had no realistic prospect of successfully defending the claim. The Claimant claimed copyright infringement, passing off and malicious falsehood. For the purpose of this article we focus on the Court's findings on summary judgment in respect of the copyright infringement claim.

Decision

The law on summary judgment

The Court has the discretion to order summary judgment on the whole or part of a claim if satisfied that (a) a party has no real prospects of succeeding with its claim or defence; and (b) there is no other compelling reason(s) for the case to be dealt with at trial.

When dealing with an application for summary judgment the role of the Court is to determine if the claim or defence in question has a realistic, as opposed to a fanciful, prospect of success. A "realistic" prospect of success requires some degree of conviction, which means that the claim or defence in question is more than merely arguable. The Court will consider not only the evidence before it on the application for summary judgment, but also the evidence that can reasonably be expected to be available at trial.

Interference with the Defendant's freedom of expression

The Defendant's primary defence was based on the right to freedom of expression under Article 10 of the European Convention on Human Rights ("**ECHR**"). In essence the Defendant argued that the protection of the Claimant's IP rights was outweighed by the interest of society being able to be informed and to debate on matters of public interest.

In seeking to balance the competing rights the Court accepted that political expression, including expression on matters of public interest and concern, requires a high level of protection under Article 10 ECHR. The Court also accepted that artists enjoy considerable protection with respect to their artistic freedom, which may in principle, "offend, shock or disturb".

However, the Judge held that the Defendant had no real prospects of relying on Article 10 alone as a defence in circumstances where the Website had been used as a vehicle for publishing a fake press release and the Defendant's artwork involved a "form of deception and impersonation and misinformation".

Summary judgment on the copyright infringement claim

The Claimant alleged that the Defendant's Website infringed copyright subsisting in the Claimant's logo and certain brochures about its business. There was no dispute that copyright subsisted in the Claimant's logo and brochures and that those works were reproduced on the Website. In defence, the Defendant contested the Claimant's ownership of the copyright works and claimed to be entitled to rely on the fair dealing exceptions under s.30 and 30A of the Copyright, Designs and Patents Act 1988 ("CDPA"): for the purposes of criticism or review, quotation, and/or parody, and/or pastiche.

The issue of ownership was dealt with swiftly as the Court accepted the Claimant's evidence that copyright in the logo and the brochures had been validly assigned by the original authors and therefore the Defendant had no real prospect of successfully contesting ownership at trial.

Turning to the fair dealing exceptions, the Court held that the use of the Claimant's logo and brochures was to give the Defendant's Website authenticity and credibility and not for criticism or review. For the fair dealing defences based on criticism or review, the requisite "criticism" or "review" must be of the work(s) in question, or another work or a performance of a work. In this case it was clear that the focus of the Defendant's artwork was the Claimant's conduct in connection with the Fishrot scandal, rather than a work.

The Court also held that this was not a case of dealing with copyright works for the purposes of parody or pastiche. A parody must evoke an existing work but be noticeably different and involve an expression of comedy or humour. Similarly, pastiche can imitate the style of an existing work, but must be noticeably different. In this case the Defendant had simply reproduced the Claimant's logo and brochures with the sole purpose of giving the Website authenticity.

Although the Defendant did not rely specifically on fair dealing for the purpose of reporting a current event, the Court accepted that the Fishrot scandal qualified as a current event. However, the Judge considered that the means used by the Defendant overstepped the boundaries of fair dealing and there was no realistic prospect of the Defendant successfully arguing that a fake website used to publish a false and misleading press release qualified as fair dealing.

The Judge acknowledged the fair dealing exceptions ought to be applied liberally to respect the freedom of expression protected by Article 10 ECHR. Even so, the Judge held that, by creating a website impersonating the Claimant and distributing a fake press release in the name of the Claimant, the Defendant had crossed the boundary into unfair dealing.

Conclusion

Overall, the Court held that the Defendant had no reasonable prospects of defending the Claimant's copyright infringement claim at trial. Furthermore, the Court did not identify any other compelling reason why the claim should be disposed of at trial and concluded that the claim ought to be disposed of by way of summary judgment without incurring the costs of a trial.

Comment

The *Samherji* case is a useful example of the collision between intellectual property rights and fundamental rights such as the freedom of expression. Although artists have considerable creative bandwidth to operate in, the outcome in this case demonstrates that the freedom of expression is not completely unfettered and artists cannot rely on public and political interest to trample over the IP rights of third parties.

The judgment also provides a useful analysis of the fair dealing exceptions under the CDPA and the conditions for those exceptions to apply. Whilst the fair dealing exceptions can be applied liberally to respect the freedom of expression and other fundamental freedoms, it is unsurprising that the Defendant's conduct in this case was deemed to overstep the mark and fall outside the protection of the fair dealing exceptions.



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Noel Redding Estate Limited and Mitch Michell Estate Limited v Sony Music Entertainment UK Limited [2024] EWHC 128 (Ch)

In early 2024, the High Court dismissed an application for summary judgment and/or strike out brought by the Defendant, Sony Music Entertainment UK Limited ("**Sony**"), in a dispute concerning the copyright in sound recordings of the band The Jimi Hendrix Experience.

Background

The claim was brought against Sony by two companies that were said to have succeeded to the rights in the sound recordings owned by two members of the band, Mr Redding (bass guitarist) and Mr Mitchell (drummer). Sony has a sublicense from Experience Hendrix LLC (a company set up by the father of the lead guitarist, Jimi Hendrix) to exploit, publish and/or distribute the sound recordings in question.

Mr Redding and Mr Mitchell had previously brought claims in the New York courts against the administrator of Jimi Hendrix's estate seeking an account and payment of royalties said to be due to them according to an oral agreement whereby any profits would be divided as follows: 50% to Jimi Hendrix, 25% to Mr Redding and 25% to Mr Mitchell. These claims were settled by the entry into releases, whereby Mr Redding and Mr Mitchell agreed not to sue Jimi Hendrix's estate and any record companies distributing the sound recordings, in return for \$100,000 and \$247,500 respectively. As a result, the claims were discontinued "with prejudice".

Decision

Sony argued, among other things, that the releases constituted a full defence to any claim to the sound recordings by the Claimants. The Judge considered this to be the most substantive ground of Sony's application, dismissing the other grounds for the following reasons:

- the Claimants' failure to comply with CPR 19.3, by leaving Jimi Hendrix's estate out of the proceedings, was a procedural issue which did not justify the proceedings being struck out;
- the Claimants' claim for relief was sufficiently clear despite their failure to specify the actual percentage share of copyright that they were each claiming; and

- the Defendant's argument that the Claimants had failed to plead or provide credible evidence of chain of title was "unfounded and totally unsuited to an application for strike out".

The effect of the releases

The Judge considered this ground of the Defendant's application for summary judgment and/or strike out at the same time as the Claimants' application to rely on the evidence of a New York attorney as to the interpretation of the releases. The Defendant argued that the Claimants should not be allowed to rely on this evidence because they had failed to comply with all of the requirements of CPR 35, relating to expert evidence.

The Judge found that, although the Claimants should have sought permission to introduce the evidence of New York law when the report was first served, their failure to do so should not be fatal to their case. The Judge found the evidence admissible at the interim hearing and considered that it showed evidence that the Claimants had at least a real prospect of succeeding on the issue of the interpretation of the releases at trial.

The Claimants also argued that performers' rights, which arose only after the releases were entered into, could not have been affected by the releases. The Judge found that the Claimants had an arguable case that their original consent did not cover the exploitation of performers' property rights, warranting consideration at trial.

Strike out and/or summary dismissal of parts of the Particulars of Claim

As its application for summary dismissal and/or strike out of the whole claim was rejected, the Defendant sought to strike out certain parts of the Claimants' Particulars of Claim, arguing that they failed to disclose any reasonable or realistic cause of action.

In response, the Claimants withdrew their claims of beneficial ownership and unjust enrichment, and accepted that their claims based on section 191HB of the Copyright, Designs and Patents Act 1988 (relating to certain assigned rights to the producer of sound recordings) were unsustainable.

In addition, the Defendant argued that the claims regarding joint ownership of copyright were effectively partnership asset claims which were statute barred, but the Judge disagreed, noting that the Claimants had merely sought to establish that each of Mr Redding, Mr Mitchell and Jimi Hendrix owned a share of the copyright in the sound recordings. Regarding the Claimants' allegations of undue influence and breach of fiduciary duty in the 1966 recording agreement, the Judge agreed to strike out certain paragraphs but allowed the Claimants to argue specific issues related to copyright assignment. Lastly, the Claimants' claim for secondary infringement was dismissed, as it had no real prospect of success.

As a result, most of the Claimants' claims in this matter will proceed to trial.



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Becker-Douglas v Bonnier Books UK Group Holdings Ltd and others **[2024] EWHC 77 (Ch)**

In this case, the Claimant, Joyce Becker-Douglas, brought a claim against the literary agency Bonnier Books UK as well as against the authors and illustrators of the *Flying Fergus* series of books (together, the "Defendants") for copyright infringement.

Background

The Claimant had authored an unpublished number of literary, artistic and musical works related to a character called *Jimmy Whizz* and alleged that, as her works and the *Flying Fergus* books both concerned a boy with a special flying bicycle, it was a reasonable inference that substantial parts of the *Flying Fergus* series had been copied from the *Jimmy Whizz* works. In addition, the Claimant alleged that the Defendants had access to her works as she had submitted her works to certain publishers which employed individuals who later joined the publisher that ultimately published the *Flying Fergus* series.

In response the Defendants made an application for summary judgment on the grounds that the Claimant had no real prospect of succeeding, noting that there was no evidence that the Defendants had access to any of the *Jimmy Whizz* works when they created the *Flying Fergus* series.

To establish a *prima facie* case of copying at trial, the Claimant had to show at least similarity between the works, coupled with access to the original work. This latter aspect could be inferred if the level of similarity was sufficiently high.

Decision

Similarities

The key question was whether the similarities between the works were such that access and copying could be inferred.

In this respect, the Court held that the supposed similarities between the respective works were very far from being capable of establishing an inference of access and copying and that some of the alleged similarities did not even exist.

The ideas relied upon were commonplace and unoriginal in the context of children's books as ultimately flying bicycles, parallel worlds and bighearted protagonists are not new in children's entertainment.

The Court also held that there were numerous and striking differences between the works so the claim in copyright was "hopeless".

Access

The Claimant also argued that the Defendants had access to her works as she had given a copy of her works to the staff members who worked at the publisher that had published the Defendants' books. However, the Court dismissed this argument as speculative and highly implausible on the basis of the evidence adduced. The evidence was insufficient to establish access or copying and suggested that the main features of the *Flying Fergus* books had been created before the publisher became involved.

Comment

This case highlights the importance of evidence when it comes to copyright infringement claims. While copying and access may be inferred depending on the level of similarity, this is by no means an easy task and robust evidence should support the claim. Commonplace and unoriginal features being present in the respective works are unlikely to be enough to establish an inference of access and copying on their own.

Intellectual Property Enterprise Court (IPEC)



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WaterRower (UK) Ltd v Liking Ltd (T/A Topiom) [2024] EWHC 2806 (IPEC)

Wooden rowing machine does not qualify for copyright protection as a work of artistic craftsmanship

Perhaps the most eagerly anticipated copyright judgment of the year was *WaterRower*.

The dispute gives rise to issues relating to the outer boundaries of copyright under UK law, and the interplay and inconsistencies between UK law and retained EU law. We considered these issues in the 2023 edition of this publication, following an unsuccessful attempt to strike out the claim.

Background

The Claimant, WaterRower (UK) Limited, alleged that its wooden rowing machine (the ‘WaterRower’) was protected by copyright, either as a ‘work of artistic craftsmanship’ under s.4(1)(c) of the CDPA and/or as a ‘work’ under EU law, as interpreted by the CJEU in *Cofemel*⁵.



<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/2806.html>

The CJEU held in *Cofemel* that, under EU law, works are protected by copyright provided they are original, and that Member States cannot impose any requirement that an object has aesthetic appeal or is otherwise “artistic”. The CJEU’s judgment is part of the body of retained EU law.

In contrast, copyright subsistence under UK law requires a claimant to prove its work falls within one of the statutory defined categories. Section 4(1)(c) of the CDPA is one such category, and protects “works of artistic craftsmanship”. The leading House of Lords authority on that term, *Hensher*⁶, makes clear that, to be protected as a work of artistic craftsmanship, it must (among other things) have something more than eye appeal and that the intention of the creator is relevant.

Decision

In the *WaterRower* judgment, the Deputy Judge held that it is not possible to reconcile these two positions. He decided that, to be protected by copyright in the UK, a work must meet the requirements of the relevant category of copyright protected work under UK law – in this case the requirements for “works of artistic craftsmanship” and the tests set out by the House of Lords in *Hensher*.

The Deputy Judge did not entirely disregard the EU position as set out in *Cofemel*, but he said its role under UK law was as a “form of gateway”, in the sense that “Only where a work is original [in the *Cofemel* sense] is it necessary to then consider the application of the statutory phrase in s.4(1)(c) CDPA in the context of *Hensher* and the line of English and related authorities noted.”

⁵ *Cofemel - Sociedade de Vestuário SA v G-Star Raw CV (C-683/17)*, 12 September 2019

⁶ *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1976] AC 64, 1 May 1974

In relation to the Claimant's wooden rowing machine, the Deputy Judge found that the prototype rowing machine passed through the *Cofemel* "gateway". However, he held that it did not meet the threshold for copyright protection because it did not meet the requirements under UK law as a work of artistic craftsmanship under s.4(1) CDPA. The Deputy Judge focused on the ordinary meaning of the words in the statute, and it is clear he was influenced by the technical considerations faced when designing a rowing machine, and the intention of the creator of the rowing machine. In relation to intention, both *Hensher* and the New Zealand case of *Bonz*⁷ suggest this is a relevant factor. Although the Deputy Judge recognised the WaterRower designer's intention was to create a rowing machine which had an "aspirational sensory impact", he ultimately did not think there was any intention to "create a work that went further, one where the craftsmanship in its creation was artistic."

Comment

The judgment will be a disappointment to designers looking to rely on copyright protection for functional products which enjoy commercial success, such as the WaterRower. However, this is not the end of the story because the judgment is clear that UK and (retained) EU law in this area is incompatible. That incompatibility will at some point need to be resolved by the higher courts or by Parliament. In addition, it is important to stress that the case does not prohibit copyright protection for *all* functional items which are commercially successful. There may be other functional items which are more likely to meet the threshold for copyright protection than a wooden rowing machine, even if the higher test required by UK law and by the Deputy Judge in this case is the correct one.

It is not known whether the Claimant has sought permission to appeal, but at some point a case will need to reach the higher courts so that they can resolve the uncertainty in this area of law. IP lawyers and the design community would certainly be grateful for the clarity which a Court of Appeal or Supreme Court judgment should provide.



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AGA Rangemaster Group Limited v UK Innovations Group Limited and another **[2024] EWHC 1727 (IPEC)**

A version of this article was first published in Kluwer Copyright Blog, April 2024, available on the [Kluwer Copyright Blog](#).

In *AGA Rangemaster v UK Innovations*, the IPEC held that AGA's trade marks were infringed by a company selling refurbished AGA cookers in a certain manner. AGA also relied on copyright in a design drawing of an AGA control panel and claimed copyright infringement by the Defendants' control panel. However, the Court found that the Defendants were entitled to rely on the defence afforded under section 51 of the Copyright, Designs and Patents Act 1988. This was on the basis that the control panel itself could not be considered an "artistic work".

This article covers the copyright decision. For the article covering the findings on trade marks, see our [Brands Review of the Year 2024](#).

⁷ *Bonz Group (PTY) Ltd v Cooke* [1994] 3 NZLR 216, New Zealand case

The background

The Claimant (“**AGA**”) make and sell AGA range cookers (the “**AGA Cookers**”). Versions of AGA Cookers have been sold in the UK since 1929.

The First Defendant (“**UK Innovations**”) is a company that, among other things, sold AGA Cookers fitted with an electronic control system (the “**eControl Cookers**”). The eControl Cookers retained the “AGA” logo and externally looked the same as their AGA equivalent, except that they replaced a temperature gauge with an “eControl System” badge, as shown below.



<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/1727.html>

While AGA accepted that AGA Cookers can be legitimately refurbished and resold, it considered the Defendants’ actions went beyond this: the eControl Cookers being sold were no longer the original AGA Cookers.

AGA claimed:

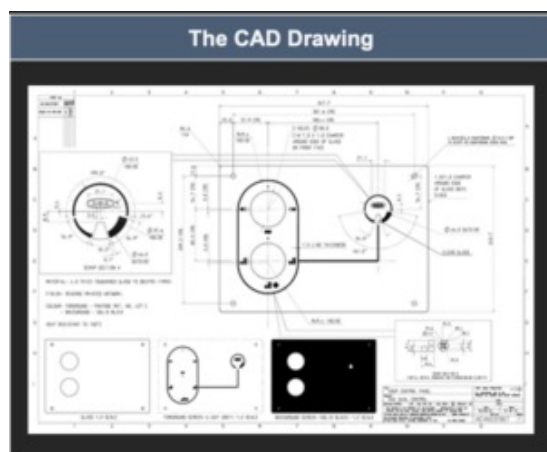
1. trade mark infringement resulting from the Defendants’ marketing and selling of eControl Cookers; and
2. copyright infringement in relation to the control panels fitted to the eControl Cookers, with AGA relying on copyright in a design drawing for a control panel of its own electronically controlled AGA Cookers.

Trade mark infringement

As this review concerns copyright, we will deal with the trade mark findings briefly. We only note that certain uses of AGA were found to infringe: namely the way the Defendants marketed and sold the cookers giving the impression that there was a connection between eControl Cookers and AGA. Other uses of AGA on the retrofitted product did not infringe.

Copyright

AGA claimed copyright subsisted in a CAD drawing showing the design of a control panel for electric AGA Cookers, as shown below (the “**CAD Drawing**”). AGA claimed this was protected by copyright as an original artistic work.



<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/1727.html>

The judgment also included photographs of the control panels of the Claimant's electric AGA Cookers and the Defendants' eControl Cookers (the "**Defendants' Control Panel**"), as shown below. AGA claimed the Defendants' Control Panel infringed the CAD Drawing.



<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/1727.html>

The Defendants denied copyright subsistence and infringement.

Furthermore, they claimed they had a defence to infringement by reason of section 51 of the Copyright, Designs and Patents Act 1988 ("**CDPA**"). Section 51 CPDA effectively provides a defence to copyright infringement, which applies where a defendant makes an article to a design document for an article that is not an artistic work. Put another way, it permits copying of articles shown in design documents, where those articles are not artistic works themselves.

Subsistence of copyright

The Defendants argued that the CAD Drawing was entirely dictated by function and was not an expression of the artist's own intellectual creation.

The Judge rejected this argument. He referred to *Brompton Bicycle*⁸ and *Cofemel* – two CJEU authorities for the principle that copyright can subsist even if a shape of a product is, at least in part, necessary to obtain a technical result.

Applying this principle, the Judge held that although the design depicted in the CAD Drawing was influenced by function of the panel (operating the cooker), he did not consider that it was "*dictated* by that function" (original emphasis). There were sufficient creative choices made, which involved "creating a design drawing featuring rotational dials (rather than push buttons) aligned vertically, to which [the designer] chose to add an elongated oval line around the dials and to add a further line running, initially horizontally, away from that oval across and then vertically up to a thermodial positioned on the upper right hand side of the panel."

⁸ *Brompton Bicycle Ltd v Chedech/Get2Get* (C-833/18) [EU:C:2020:461](#)

Copyright infringement

The Judge dealt with infringement briefly. He found that the Defendants' Control Panel was copied from the Claimant's control panel, thereby indirectly copying the CAD Drawing. He then found that a substantial part had been taken: the features reproduced included those features that were the result of creative choices. In contrast, the main difference was driven by function: the Defendants' Control Panel having five settings, rather than four.

Section 51 CDPA defence

Interestingly, in what the Judge described as the "most difficult aspect of the copyright claim", he noted that "neither party really addressed the issues in relation to s.51".

The Judge accepted the CAD Drawing was a design document recording the Claimant's control panel. Therefore, the issue was whether the Claimant's control panel itself, being the article in question, was an artistic work.

The Judge found that the Claimant's control panel could not itself be considered an artistic work. Accordingly, it was not an infringement of copyright in the CAD Drawing for the Defendants to make control panels to the design recorded in the CAD Drawing.

In making this finding, the Judge referred to the findings in *Cofemel*. However, without submissions from the parties he did not consider it possible to reach any final conclusion as to the impact of *Cofemel* and that instead he had to deal with s.51 on its own wording. Accordingly, while he found that copyright subsisted in the design drawing, the Defendants' actions were permitted by s.51 CDPA.

Comment

On the trade mark side, to an extent this case serves as a caution to sellers of refurbished products: be careful how you advertise. If the products are marketed in such a way as to suggest some connection to the trade mark owner, that is likely to give the trade mark owner legitimate reasons to oppose such use of the trade mark. This would be fatal to an exhaustion defence. However, equally, the case does confirm that selling refurbished products that still have the trade marks applied is not itself an act of infringement.

On copyright, the Judge provided some interesting commentary on the interaction between *Cofemel* and the section 51 CDPA defence. However, unfortunately without submissions from the parties on this point, he did not feel in a position to make a final conclusion on the impact of *Cofemel* on s.51.

The Court has given permission for the Claimant to appeal that decision and the issue long vexing the profession is now going to the Court of Appeal to be decided.

An interesting but minor point on copyright subsistence raised by the Defendants was that the CAD Drawing was not original since the relevant features had been contained in earlier design drawings or models. Ultimately, the Judge held that this argument had not been sufficiently pleaded. Therefore, the Defendants could not rely on it and the Judge did not have to deal with it in detail. The Judge did note that it is correct that there is no originality in elements of a work that have simply been copied from an earlier work. However, he pointed out that this is rarely a point taken in a case where the work is the result of a "relatively short, creative process".

It is typical in such cases for a claimant to rely on the final work product, rather than earlier drawings or models, with the Judge giving the example of an author relying on a final novel rather than earlier drafts. The Judge made the point that defendants will not normally challenge this approach unless there is a good reason to do so – such as where the earlier work was created by a different copyright owner meaning there would be an issue with title to the copyright.



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Equisafety v Woof Wear **[2024] EWHC [2478] (IPEC)**

Background

In this case, Ian Karat, sitting as a Judge in the IPEC, assessed whether various high visibility equestrian products constituting a waistcoat, an elasticated hat band and a neck band for a horse were entitled to copyright protection.

This judgment was of interest to practitioners as it provided an opportunity for the IPEC to consider the incompatibility between (i) the closed categories of works which are entitled to copyright protection under the Copyright, Designs and Patents Act 1988 (“CDPA”); and (ii) EU law which dictates that to be entitled to copyright protection, a work need only be original in the sense that it is the author’s own intellectual creation and is expressed in a manner which makes it identifiable with sufficient precision and objectivity.

The issues to be determined by the Court were (i) whether copyright subsisted in the Claimant’s products; and (ii) whether the Claimant owned the copyright in those products. It should be noted that during the course of the proceedings, the Claimant’s case was confined to certain features that were added to the Claimant’s products, as opposed to the products as a whole. Photographs of the relevant products as taken from the annex of the judgment are shown.



<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/2478.html>

Decision

Subsistence of copyright

In assessing (i), the Judge asserted that it is not possible to draw from *Response Clothing*⁹ any principle regarding whether a particular type of product will necessarily be protected as a work of artistic craftsmanship. Each item needs to be considered on its own facts.

It was then noted that while the fact that a technical standard exists for the clothing at issue was not determinative of the issue of subsistence, this confirmed that items such as the waistcoat were functional items with particular requirements that meant that certain choices must be made in order to comply with the relevant legislation.

⁹ *Response Clothing Limited v The Edinburgh Woollen Mill Limited* [2020] EWHC 148 (IPEC), 29 January 2020

In relation to the amendments to the products, these were deemed to be functional improvements for better performance and not to reflect the author's personality. Therefore, the amended features did not amount to an original work as required by *Cofemel*¹⁰. The features were deemed practical solutions that could have been expressed differently. In addition, under UK law, the features were deemed not to be the work of an artist and craftsman in line with the CDPA and UK case law on works of artistic craftsmanship.

The Judge also briefly considered whether copyright subsisted in the works as a whole. The products were deemed to consist of practical solutions which can be expressed differently and/or design solutions dictated by the function of the items and therefore not protected by copyright. Therefore, overall the works were not original in line with *Cofemel* and were not works of artistic craftsmanship under the CDPA.

Ownership of copyright

In relation to (ii), the Judge considered *obiter* the question of ownership of any copyright by the Claimant in the works and found that the claim would also have failed on this basis. This was due to chain of title issues and the fact that some of the designs may have been produced in collaboration with factories in China.

Comment

This judgment highlights the difficulty of obtaining copyright protection for items which are in large part functional. In the IPEC's view, under both EU and UK law, designers must demonstrate that their products are not merely practical solutions dictated by function.

In this case, the Court considered that the position in relation to subsistence of copyright in the works at issue was the same under EU law and UK law. Therefore, there was no need for the Judge to address the apparent incompatibility between the closed category approach in the UK and the law in the EU.

Court of Session, Outer House (Scotland)



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Sky Ltd and another v Christopher Airlie [2024] CSOH 22

This case concerned the owner of the Troll Inn (a pub) who had infringed Sky Ltd's copyright in graphics displayed during broadcasts by Sky UK Ltd by explicitly authorising their communication to the public without maintaining a commercial subscription to do so. A publicity order was granted but no damages were awarded.

Background

The case was brought by two corporate entities ultimately sitting within the Comcast Group. These were Sky Ltd (the "**First Claimant**") and Sky UK Ltd (the "**Second Claimant**"). The Claimants raised an action against the owner of the Troll Inn, Mr Christopher Airlie, a pub located in Dundee, and alleged that he had infringed the First Claimant's copyright in artistic works (shown below) by showing the Second Claimant's broadcasts of football matches without owning (or maintaining) a commercial licence. There was no issue as to the subsistence of copyright for these works.

¹⁰ *Cofemel - Sociedade de Vestuário SA v G-Star Raw CV* (C 683/17), 12 September 2019

sky sports

sky sports HD

sky sports football

sky sports main event

sky sports mix



The Claimants sought a declaration (“declarator” in Scottish law) of copyright infringement, injunction (“interdict” in Scottish law) against its repetition, £10,000 in damages and orders under Reg 5 of the Intellectual Property (Enforcement etc.) Regulations 2006 entitling them to publish any decision of the Court at the Defendant’s expense.

The Claimants alleged that Mr Airlie had shown the Second Claimant’s broadcasts of football matches, which featured the copyrighted graphics, on television screens at the Troll Inn during the normal operation of the business, or at least authorised others to do so. In particular, the claim related to at least four matches between March 2023 and September 2023.

Mr Airlie denied having infringed the First Claimant’s copyright. He maintained that a portion of his customers would bring their own electronic devices, such as mobile phones, tablets, laptops and computer monitors, to the Troll Inn and watch the Second Claimant’s broadcasts there on those devices using an app called “Sky Go”.

The Sky Go app authorised these customers to view those broadcasts on any device in the company of family or friends. Mr Airlie noted throughout his evidence that it was imperative that the customers watched the broadcasts on their own devices rather than those provided by the Troll Inn.

In his oral evidence, Mr Airlie noted that he had previously asked the Claimants’ solicitors about the permissible limits for the use of the Sky Go app but had not received an answer despite chasing the matter. He noted that he had also spoken to a Sky sales representative who visited him about the permissible use of the Sky Go app and had been told that “it would be fine for it to be used for two or three people to watch a match together in the bar”.

<https://www.bailii.org/ew/cases/EWHC/IPEC/2024/2478.html>

Additionally, Lord Sandison observed that if the Claimants themselves were unclear about the inter-relationship between the rules of the app and the law then it would not be reasonable to expect Mr Airlie and his customers to keep to the right side of the line, whatever that may be.

Decision

Though there were several questions put before Lord Sandison in the case, the crux of the matter (and the primary question addressed in the decision) was the question of whether what occurred amounted to a communication of the graphics to the public within the meaning of s.16 and s.20 of The Copyright, Designs and Patents Act 1988 (the “CDPA”). If so, this would amount to copyright infringement.

Mr Airlie accepted that after his commercial subscription to the Second Claimant's broadcasts had lapsed he had consented to his customers using Sky Go in the Troll Inn to watch the broadcasts. It was accepted that the usual viewers were known to each other, but that the screens were visible to all who entered.

Lord Sandison noted that the relevant portions of the CDPA are not wholly domestic legislation, rather they are a transposition of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society into UK law. Lord Sandison followed the precedent for construction set out in *Football Association Premier League Ltd v QC Leisure*¹¹ and observed that the First Claimant authorised (it did not matter whether directly or indirectly) the communication of the graphics to those members of the public who subscribed to the Second Claimant's broadcasts. For commercial subscribers, it authorised them to communicate the works to members of the public present in the commercial establishment in respect of which the subscription was held.

The Court held that there was no material before the Court that would enable a conclusion as to authorisation of communication of the graphics via the Sky Go app, and no such authorisation could be assumed. Accordingly, construing s.16 and s.20 of the CDPA in a manner consistent with their antecedents in and reflected by the Copyright Directive, the showing of matches broadcast by the Second Claimant in the Troll Inn (in circumstances where any member of the public that may choose to enter the bar could view them) constituted a communication to the public within the meaning of those sections, and therefore infringed the First Claimant's copyright in the graphics displayed in the course of the broadcasts.

The principles set out in *Morris-Garner v One Step*¹² were followed. Neither party had presented any evidence on the economic value of the graphics, or how there might have been a diminution in its value to the First Claimant by Mr Airlie's unauthorised use. It was also not clear on what basis the Second Claimant might be entitled to damages for infringement of the First Claimant's copyright. No damages were awarded.

Lord Sandison authorised the First Claimant to arrange for one publication of the judgment at Mr Airlie's expense with an upper limit on that expense of £1,000. Any further accounts of the proceedings would be at the Claimants' expense.

Lord Sandison considered that substantial justice between the parties required a considerable modification to the award of costs to which the Claimants might otherwise be entitled: Mr Airlie was found liable for 50% of the First Claimant's costs only.

In summary, it was held that Mr Airlie had infringed the First Claimant's copyright in the graphics displayed during the broadcasts by way of authorising their communication to the public at the Troll Inn. An injunction was granted, but no damages were awarded.

¹¹ *Football Association Premier League Ltd and others v QC Leisure and others* (C-403/08) EU:C:2011:631, 4 October 2011

¹² *Morris-Garner v One Step (Support) Ltd* [2018] UKSC 20, [2019] A.C. 649, [2018] 4 WLUK 243

Designs

Court of Justice of the European Union (CJEU)

EU General Court



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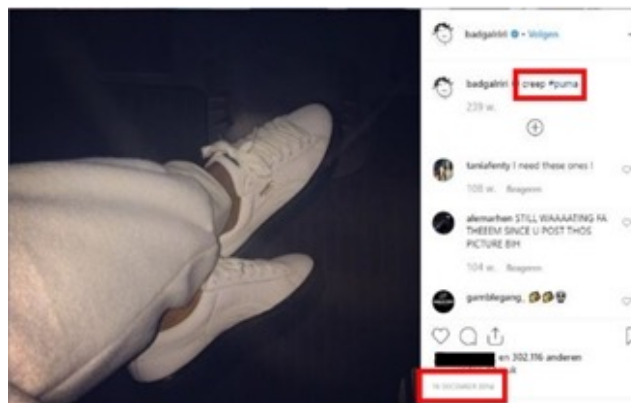
***Puma SE v EUIPO* (T-647/22)**
EU:T:2024:147

Puma's trainer design declared invalid as a result of Rihanna's social media post

The EU General Court's decision in *Puma v EUIPO*¹³ demonstrates the danger of disclosing one's own designs too early.

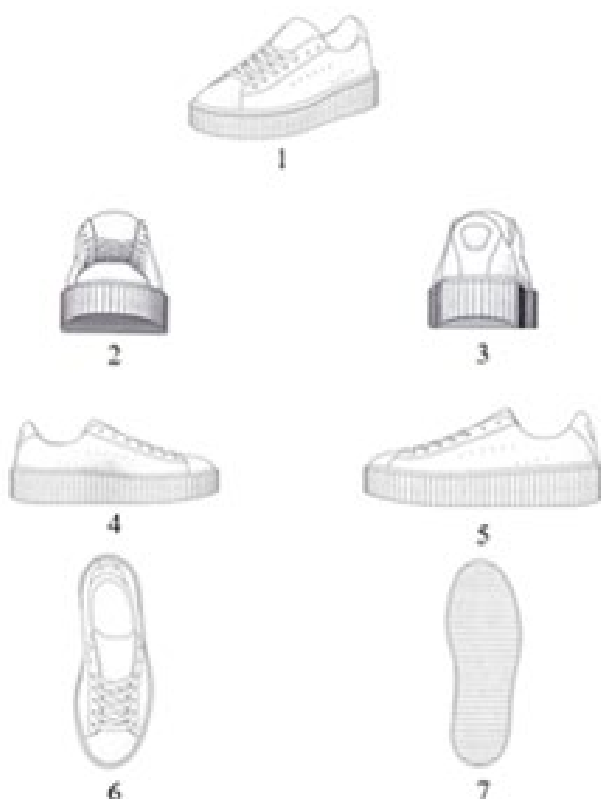
Background

In this case, Puma’s trainer design was held to be invalid because photos were posted on Instagram by Puma’s creative director, Rihanna, of the trainers in question more than 12 months before Puma applied for a Registered Community Design (“**RCD**”). These posts are shown to the right.



<https://curia.europa.eu/juris/document/document.jsf?jsessionid=A802D9EE825C68334A1514DFCA873A1C?text=&docid=283501&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=28930538>

Puma applied in July 2016 for a RCD, as represented by the drawings below:



<https://curia.europa.eu/juris/document/document.jsf?jsessionid=A802D9EE825C68334A1514DFCA873A1C?text=&docid=283501&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=28930538>

A RCD will only be valid if the design is new and possesses individual character. This means it must give a different overall impression from other designs in the design corpus. It also means that designers must not have disclosed their own design before submitting their application for a RCD (although the legislation provides a grace period of 12 months).

In December 2014, Rihanna was appointed Puma's creative director. She posted several pictures on her Instagram account on 16 December 2014 about her appointment, and the post was later reported in the media. Rihanna's Instagram posts showed her wearing trainers which very closely matched the design depicted in the RCD which was subsequently obtained.

Decision

The social media posts by Rihanna were held by the EUIPO Board of Appeal to invalidate Puma's RCD, on the basis that they destroyed its novelty. Puma appealed to the General Court, but the General Court upheld the decision.

The General Court agreed that the trainers were clearly visible in Rihanna's posts, and that the design would have become known to the relevant circles given that both her fans and the fashion sector would have been interested in the posts and what shoes she was wearing. That finding was not particularly surprising, given the evidence in the case that the posts were reported on widely.

Comment

The invalidation of Puma's RCD is a cautionary reminder for those considering celebrity collaborations for their new designs, and demonstrates the importance of caution throughout the design and registration process, particularly in the fashion sector. Ideally, Puma would have applied for design protection prior to disclosing the product, or at least within 12 months of the disclosure, to fall within the grace period provided by the legislation.



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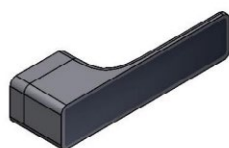
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M&T 1997, a.s., v EUIPO (T-654/22) EU:T:2024:223

The General Court's decision concerned the validity of a Registered Community Design ("RCD") representing door and window handles.

Background

M&T 1997, a.s. ("M&T") owned a RCD for the design of a door and window handle represented below (the "M&T RCD"):



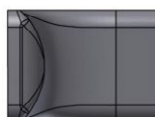
1



2



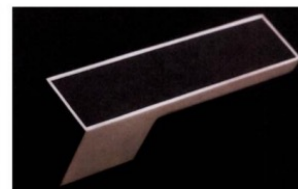
3



4

<https://curia.europa.eu/juris/document/document.jsf?text=&docid=284629&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1&cid=2175044>

In 2020, VDS Czmyr Kowalik Spółka Komandytowa ("VDS") applied to invalidate the design under Article 25(1)(b) of the Community Design Regulation¹³ ("CDR") on the basis that the M&T RCD lacked individual character because the design did not produce a different overall impression on the informed user to the impression created by door handles existing on the market at the filing date. VDS relied on several door handle designs registered or disclosed on the market before the filing date of the M&T RCD, but the validity assessment focused on the following prior art handle design (the "Earlier Design"):



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=284629&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1&cid=2175044>

In 2021, the Invalidity Division¹⁴ held that the M&T RCD was invalid. The Invalidity Division found that the designs in question both had a minimalist shape with a cubic character, identical proportions and a striking dark frontal inlay. The difference between the more rounded edges of the M&T RCD was not considered sufficient to create a different overall impression on the informed user. Moreover, other smaller differences, such as the slimmer grip edges in the M&T RCD and the slight difference in colour, were details that cannot change the overall impression.

¹³ Regulation No 6/2002

¹⁴ VDS Czmyr Kowalik Spółka Komandytowa -v- Material & Technology s.r.o. Invalidity No. ICD-114-141

Board of Appeal decision

On appeal, the Board of Appeal¹⁵ agreed with the Invalidity Division that the M&T RCD did not produce a different overall impression on the informed user compared to the Earlier Design. According to the Board of Appeal, the differences in the designs were limited to the curvature of the edges and the shape of the neck, which were deemed to be insufficient to create a different overall impression considering the high degree of attention paid by the informed user and the high degree of design freedom available to designers in this space.

Appeal to the General Court

M&T argued that the Board of Appeal erred in deciding that the overall impression created by the M&T RCD did not differ from the Earlier Design. M&T challenged the Board of Appeal's findings that the informed user of door handles would pay a high degree of attention and the designer of door handles would have a high degree of design freedom.

However, the General Court upheld the Board of Appeal's conclusions on both of those points. Therefore, the ultimate question for the General Court was whether the difference between the M&T RCD and the Earlier Design were sufficiently marked to create a different overall impression on the informed user.

The General Court agreed with aspects of the Board of Appeal's assessment, confirming that the most visible elements of the handle to the informed user are those corresponding to the outward-facing parts of the handle, namely the front, side and top parts of the handle. Like the Board of Appeal, the General Court also noted that, although features at the rear of the handle may not be as prominent, the informed user would not overlook them.

In contrast, the General Court disagreed with the Board of Appeal's analysis of the prominence of certain design features and how the informed user would perceive those features. The General Court held that the differences in the angles of the grip and the neck on the handles were neither marginal nor minor variations of one and the same design. Further, the General Court took the view that the more rounded shape of the handle generally resulted in a softening of the lines of the neck and grip, which created a significant effect on both the overall appearance and on the ease of use of the door handle.

According to the General Court, these were differences that would attract the attention of the informed user and were sufficiently marked for the M&T RCD to create a different overall impression to the Earlier Design. On that basis, the General Court held that the M&T RCD was valid and annulled the Board of Appeal's decision.

VDS tried to appeal the decision to the CJEU. However, the CJEU took the view that the appeal did not raise a significant issue regarding the unity, consistency or development of EU design law and therefore refused to allow an appeal.

Comment

The line of appeals through to the General Court in this case illustrates the degree of subjectivity in the overall impression test for RCDs, and how different tribunals can reach quite different conclusions as to how a design will be perceived by the informed user and the overall impression designs create.

The General Court's analysis of differences in aspects of the designs and the weight afforded to those differences shows how relatively minor differences can have a significant and decisive impact on the overall impression created by the designs, even in cases involving a high degree of design freedom.

¹⁵ M&T 1997, a.s. v VDS Czmyr Kowalik Spółka Komandytowa Case R 29/2022-3



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Praha Alfa-Med sro v EUIPO **(T-614/23) EU:T:2024:799**

The General Court has confirmed that a RCD for a plasma generator was invalid for lack of individual character, upholding a decision of the EUIPO Board of Appeal.

Background

The appellant, Praha ALFA-MED s.r.o (the “**Registrant**”) was the proprietor of a RCD with the indication “apparatus and installations for medical or laboratory diagnosis” (the “**Registrant’s RCD**”). The device creates plasma to be used in medical applications. One of the claimed design views is pictured below.



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=292258&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=28456454>

Rifetech s.r.o (the “**Invalidity Applicant**”) filed an invalidity application against the RCD based on Article 25(1)(b) of the Community Designs Regulation (“**CDR**”), in conjunction with Article 4(1) CDR, claiming the Registrant’s RCD lacked novelty and individual character in accordance with Articles 5 and 6 CDR. The Invalidity Applicant claimed that its design shown below (the “**Prior Design**”) was on the market earlier than the Registrant’s filing date and produced a similar overall impression on the informed user.



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=292258&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=28456454>

The EUIPO at first instance dismissed the invalidity action. However, on appeal, the Board of Appeal determined that the Registrant’s RCD was invalid¹⁶. The Registrant appealed to the General Court claiming insufficient reasoning in respect of the Prior Design (infringing Article 62 CDR which requires decisions of the EUIPO to be reasoned) and an incorrect assessment of the freedom of the designer and the individual character of the Registrant’s RCD.

¹⁶ Case R 2504/2022-3

Decision

The General Court found that the Board of Appeal had correctly determined that, while the relevant products required the presence of certain features (such as a control unit and plasma tube), the designer did not have restricted freedom in the size and shape of the design: there were possibilities of variations in the shape and appearance of the features, and in the appearance of the product itself. The Registrant had not proved that the technical requirements of the relevant technology imposed a characteristic and therefore common shape. As a result, there was some scope for freedom of design. The General Court noted that the existence of certain trends or habitual shapes does not constitute constraints imposed by the technical function of the product.

The Registrant's RCD was correctly considered to be similar in appearance to the Prior Design: namely, in respect of the cuboid control unit, transparent housing including a lamp with two horizontal bulbs of the same size and transparent vertically placed wide legs. The control panels of both designs were similarly sized and positioned, and any differences between them were found to play a negligible role in the overall impression on the informed user, who would be likely to show a relatively high degree of attention to the designs.

The individual character of the Registrant's RCD had to be assessed in light of the visible appearance of the design and not in light of the technical features of the product as such. The fact that the Prior Design may have been able to have been separated into different elements could not be taken into consideration, as this was not visible from the prior representations, and the representations shown were sufficient to demonstrate a similar impression.

Overall, the General Court found that the Board of Appeal was correct to find that the designs produced an overall similar impression on the informed user.

The General Court also confirmed that the Board of Appeal had set out its reasoning in a sufficiently clear and unequivocal manner as to its review of the Prior Design – it could not be required to exhaustively address each line of reasoning one by one. The reasoning may be implicit so long as it enables the parties and any appellate court to know the reasons for the decision.

Comment

This case provides a practical demonstration of the assessment of individual character. It is also a useful reminder of the need to provide strong evidence, for the purposes of resisting an invalidity attack, to demonstrate that any similarities to a previous design are for technical reasons, rather than resulting from a free design choice.



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Delta Sport Handelskontor GmbH v EUIPO **(T-537/22) EU:T:2024:22**

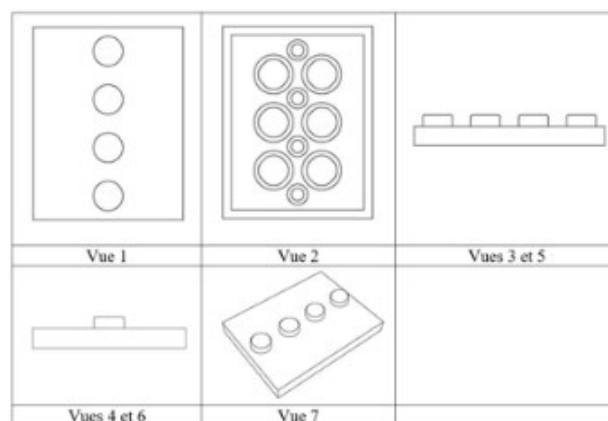
According to design principles, technological function cannot be protected by design rights, pursuant to Article 8(1) of the Community Design Regulation (“CDR”). Moreover, the design must not consist of features whose exact form and dimensions are required for the product *“to be mechanically connected to or placed in, around or against another product so that either product may perform its function”* according to Article 8(2) CDR. These regulations allow free competition for products compatible with other items.

There is a specific exclusion when it comes to modular products, that can be fitted in different ways. According to Article 8(3) CDR, design rights can protect a *“design intended to enable the assembly or connection of multiple compatible products within a modular system”*. Lego bricks are a famous example of such a design.

In this decision, the General Court reiterated the usual principles to determine how a Registered Community Design should be declared invalid and confirmed that the burden of proof in an invalidity action lies with the applicant for invalidity.

Background

Back in 2010, Lego A/S secured the registration of the Registered Community Design No. 1664368-0006, represented in the views set out below and with the description *“building blocks from a toy building set”* (“**Lego RCD**”):



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=282022&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=28462684>

In 2016, the German company Delta Sport Handelskontor GmbH (“**Delta**”) filed an application for a declaration of invalidity of the Lego RCD. Delta claimed that all the features of appearance of the product concerned by the Lego RCD were solely dictated by the technical function of the product and, therefore, were excluded from protection under Article 8(1) CDR.

The application for a declaration of invalidity was rejected by the Invalidity Division of the EUIPO in a decision issued in October 2017, which was appealed by Delta. The Board of Appeal was convinced by Delta’s arguments and declared the Lego RCD invalid on the ground that all the features of appearance of the product concerned by the design were solely dictated by the technical function of the product, within the meaning of Article 8(1) CDR. Lego appealed this decision.

The General Court annulled the Board of Appeal’s decision, finding that the Board of Appeal infringed:

- Article 8(3) CDR, laying down an exception protecting modular systems, in that the Board of Appeal had not assessed whether Lego RCD met the requirements of that article, which Lego had relied on as a defence;

- Article 8(1) CDR, in that the Board of Appeal had not identified all the features of appearance of the product concerned by the Lego RCD, in particular the smooth surface of the upper face of the toy brick (the “**smooth surface**”), and did not establish that all those features were solely dictated by the technical function of that product.

The case was then referred back to the third Board of Appeal. The third Board of Appeal dismissed the appeal on the ground that the application for invalidity was not substantiated. In particular, it found that even if all the features of appearance of the product concerned by the Lego RCD including the smooth surface were solely dictated by the technical function of that product, within the meaning of Article 8(1) CDR, the Lego RCD could not be declared invalid as it fell within the exception protecting modular systems referred to in Article 8(3) CDR. This provision was applied by way of derogation from Article 8(2) CDR, given that all the characteristics of the appearance of the product covered by the Lego RCD were covered not only by Article 8(1) CDR but also by Article 8(2) CDR, as confirmed by the Board of Appeal. Delta appealed the decision to the General Court.

Decision

Delta had three main arguments.

First, Delta argued that the smooth surface (i.e. one of the seven characteristics identified by the Board of Appeal) did not meet the requirements laid down in Article 8(2) CDR. Therefore, the Lego RCD could not be considered as falling within the scope of that article.

The GC rejected this argument, applying the essential principles that a design is declared invalid, in accordance with the provisions of Article 8 CDR, only in the case where all of its characteristics are excluded from protection. If at least one of its characteristics is protected, in particular due to the application of the exception provided for in Article 8(3) CDR, the design is valid.

In this case, Delta argued that only one of the seven characteristics of the Lego RCD (i.e. the smooth surface) would not be covered by Article 8(2) CDR. Therefore, to the extent that a design is declared invalid only in the case where all its characteristics are excluded from protection, Delta’s arguments (even if they were assumed to be well founded) would only have the result of affecting the protection of only one of the seven characteristics of the Lego RCD. Such an argument was unlikely to call into question the validity of the Lego RCD as a whole.

As a second argument, Delta claimed two errors of law since the Board of Appeal:

1. applied Article 8(3) CDR in relation to the Lego RCD as a whole, and not in relation to the features of interconnection only, and
2. placed on Delta the burden of proof relating to the conditions of novelty and individual character.

The General Court examined the second plea first, before analysing the first plea. In doing so, the General Court recalled that for a design to fall within the exception protecting modular systems provided for in Article 8(3) CDR, it must meet two conditions: first, meet the conditions of Articles 5 (novelty) and 6 (individual character) CDR and, secondly, serve the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

The conditions of novelty and individual character of an RCD are presumed during the registration procedure. Consequently, as long as a design is not declared invalid, it enjoys the presumption that the conditions of novelty and individual character are met. Deciding otherwise would place the burden of proof of these on the design owner; this would amount to a requirement to prove the absence of disclosure of any design which could prevent the design from being considered new or having an individual character. This would mean imposing negative proof and therefore impossible evidence to provide. Therefore, since Delta failed to prove any disclosure of relevant earlier designs, the Board of Appeal was correct to conclude that there was no need to carry out the assessment of the novelty and individual character of the Lego RCD.

Delta's third and final argument was that the Board of Appeal did not consider, in the context of the assessment of the disclosure of earlier designs, certain well-known and/or undisputed facts as well as some information provided by screenshots of a website and by a reference to a judgment of the CJEU in a related case.

The General Court disagreed. In proceedings relating to a declaration of invalidity, the EUIPO is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

The disclosure of an earlier design does not, as such, constitute a fact. Rather it is the "result of a factual assessment", with the EUIPO being required to examine all evidence submitted in order to establish whether it actually proves disclosure of the earlier design.

Therefore, as correctly pointed out by the EUIPO in these proceedings, the disclosure of an earlier design cannot be considered to be a well-known fact, which is not required to be demonstrated, even in the event that the products in which that design is incorporated or to which it applies would have been present on the market for a long time and would be generally known to the public.

Therefore, Delta cannot successfully criticise the Board of Appeal for having failed to consider for the purposes of assessing the new and individual character of the Lego RCD, that the disclosure of the earlier designs was established on the basis of well-known facts. Likewise, the disclosure of an earlier design cannot be demonstrated by the mere circumstance that the owner of the design does not contest it.

Accordingly, the General Court dismissed Delta's appeal and the Lego RCD remained valid as a result.

**Dhara Reddy**

Associate

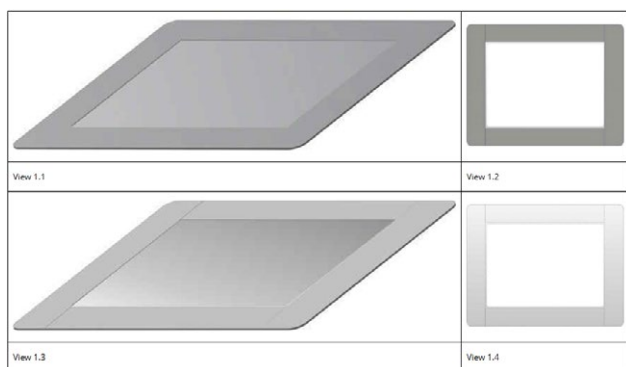
[Email](#) | [Visit profile](#)**Orgatex GmbH & Co v EUIPO
(T-25/23) EU:T:2024:725**

In October 2024, the EU General Court invalidated a RCD for a rectangular floor marking, citing inconsistencies across its multiple views that failed to represent a single, unified design.

Article 25(a) of the Community Design Regulation (“**CDR**”) states that a design cannot be registered if it does not meet the definition outlined in Article 3(a) CDR. Article 3(a) defines a design as the *“appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”*.

Background

The Applicant, Orgatex, secured a RCD for a rectangular floor marking, depicted through multiple views, as shown below.



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=291519&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=354677>

An intervener sought to invalidate the design, arguing that it did not conform to the Article 3(a) definition. Whilst the EUIPO's Cancellation Division initially dismissed this claim, the Board of Appeal later reversed the decision, identifying inconsistencies among the views that suggested they did not represent a single design. The Applicant's subsequent appeal led to the General Court's decision.

Decision

The General Court (the “**Court**”) upheld the Board of Appeal's invalidation of the RCD.

It agreed with the Board of Appeal's finding that Views 1.1 and 1.2 likely showed the front of the design and 1.3 and 1.4 its rear. On this understanding, the Court found inconsistencies in the contour lines and shading which the Applicant was unable to explain.

The Court emphasised the necessity for consistency across all representations of a design and identified the concept of “unicity of design” asserting that all submitted views must consistently depict the same product. Significant discrepancies, such as variations in contour lines, shading, or other features, without plausible explanations like perspective or lighting differences, can lead to the invalidation of a design.

Comment

Applicants should:

- ensure all views of a design are consistent;
- only submit multiple views if necessary to fully capture the design – unnecessary views can introduce discrepancies that may jeopardize the design's validity;
- maintain uniformity in elements like contour lines, shading, and colours across all representations to prevent inconsistencies.



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Puma v EUIPO (T-757/22) EU:T:2024:291 ***and Puma v EUIPO (T-758/22)*** ***EU:T:2024:292***

In two decisions handed down in May 2024, the EU General Court ruled against Puma in applications it filed to invalidate design registrations for trainers.

The registrations, held by Road Star Group (a wholesaler and retailer based in the Czech Republic) (“**Road Star**”) and a Chinese company, Fujian Daocheng Electronic Commerce (“**Fujian**”), were challenged by Puma on grounds that the contested designs lacked novelty and individual character over Puma’s earlier “PUMA NRGY” designs. The General Court upheld the validity of both registrations with a focus on the role of the disclaimed elements in Puma’s prior designs.

Background

Puma were claiming that its earlier registered designs for its NRGY trainers constituted prior art that should invalidate the Fujian and Road Star registrations. Puma argued that the similarities between its earlier designs and the contested ones were sufficient to demonstrate a lack of individual character.

The EUIPO’s Invalidity Division rejected Puma’s applications finding that the Road Star and Fujian designs had individual character. The Third Board of Appeal upheld the Invalidity Division’s decisions.

Puma appealed to the General Court, on the grounds that the Board had incorrectly assessed the scope of protection of its earlier designs and erred in its findings.

The dispute revolved around defining exactly what elements could be considered in the comparison between Puma, Road Star and Fujian’s designs. Puma argued that only the soles of the contested designs may be considered in the comparison because they are the “essential element of a shoe”. However, Puma failed to justify why the sole should hold such importance that the comparison be limited to that element.

Significantly, Puma’s earlier design registrations had disclaimed certain elements, such as the upper part of the shoe and laces, by depicting them with dotted lines (as shown below). This practice, common in design registration, allows applicants to specify which parts of a design they do not wish to protect. For instance, a designer might disclaim functional or generic elements of a product, focusing protection on more distinctive or ornamental aspects. A question arose as to whether such elements could form part of the prior art.



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=285829&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=10121612>

Decision

The General Court found that Puma had failed to prove that the sole was the essential element of the shoe as Puma had claimed. Accordingly, the General Court found that the Board of Appeal had been right to find that the upper parts of the shoes were part of the prior art, along with the soles.

The Court found that the contested designs by Fujian and Road Star did indeed differ in their overall impression when compared to Puma's earlier designs, particularly because Puma's disclaimed elements should be considered relevant as part of the prior art. Even though Road Star, Fujian and Puma's designs shared certain visual features, such as the outer sole, the Court found that the main differences, such as the decoration of the body of the shoe, the low-cut collar and the characteristics of the sole, were sufficient to create a different overall impression on the informed user.

Overall, the General Court dismissed Puma's arguments, holding that the disclaimed features in Puma's registrations were disclosed to the public and could be used to challenge the novelty and individual character of the contested designs. Consequently, the Court concluded that the contested designs were valid and upheld their registrations.



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Nextrend GmbH v EUIPO (T-82/23) **EU:T:2024:102**

On appeal from the EUIPO, the EU General Court dismissed a claim seeking to invalidate a design for a toilet seat.¹⁷

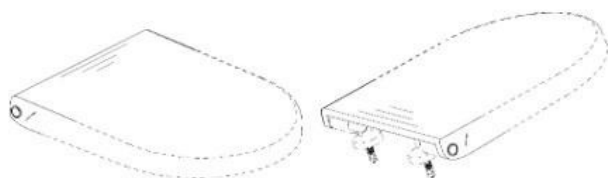
Background

In 2019, Nextrend GmbH (“**Nextrend**”) filed an application for a declaration of invalidity of a design for toilet seats applied for by Xiamen Axent Corporation Ltd (“**Axent**”) as shown to the right:



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=283016&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=355642>

Nextrend sought to invalidate the contested design on grounds that it lacked individual character over an earlier registered design as depicted below:



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=283016&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=355642>

At first instance, both the EUIPO Invalidity Division and Board of Appeal rejected the invalidity application on grounds that the design of a toilet seat lid was subject to technical restraints which limited the design freedom. As a result, the small differences between the contested design and earlier design (namely, the presence of a rectangular recess at the back of the toilet lid, a fixed rear rectangular cover to the toilet lid and the presence of a single control knob) were sufficient to produce a different overall impression on the informed user. Nextrend appealed this decision to the EU General Court.

¹⁷ Nextrend GmbH v EUIPO (T-82/23) [EU:T:2024:102](#) 21 February 2024

Decision

Nextrend appealed the Board of Appeal's decision on three grounds.

1. The Board of Appeal had not sufficiently set out the reasons for its decision, contrary to Article 63 of Regulation 6/2002 on Community Designs (the "**Regulation**").
2. The Board of Appeal had failed to take into account an earlier German design (DM640) which was introduced late into the evidence but pleaded as a prior design.
3. The Board of Appeal had failed to apply the correct legal test for assessing "overall impression", which is to consider the perspective of the informed user, the degree of design freedom, and the assessment of individual character.

On the first ground, the Court confirmed that Article 63 did not require the Board to exhaustively address all lines of reasoning articulated by the parties. So long as the judgment allowed the parties to understand the reasons for the decision, the Article 63 requirement was met. The Court found that the Board of Appeal had explained its reasoning to this extent.

On the second ground, the Court affirmed the Board of Appeal's approach in not considering the earlier design DM640 as this had been introduced late into the evidence. Article 52(2) of the Regulation requires an application for invalidity to state the reasons on which it was based. Prior case law illustrated that whilst the EUIPO has some discretion in allowing the late admission of facts or evidence, this did not extend to admitting additional designs as prior art. This was required to protect the rights holder from being engaged in a dispute that could have the subject matter changed at a late stage in the proceedings.

The final ground was also rejected by the Court. It found that the Board of Appeal had correctly applied the principle that the greater the restraint on design freedom, the more likely small differences between the prior art are sufficient to produce a different overall impression. Further, the existence of design variants is not immediately evidence to mean that the product in question will not be subject to design constraints. In view of the earlier design, the Court agreed that the differences identified by the Board of Appeal (in particular the rectangular recess present in the contested design) would not go unnoticed by the informed user. Even if this feature was present in other designs, the fact it did not appear in the cited earlier design was key. The Court stressed that a validity challenge cannot be based on the mosaicking of components from numerous prior designs. The challenge must be solely based on the earlier design relied on as the basis for invalidity.

Comment

This case is a reminder for invalidity applicants to get their pleaded case right from the start. In particular, it is essential for prior art searches to be carried out at the outset to identify any relevant prior designs as the assessment for invalidity will be based solely on those designs pleaded.

**Kallie Botha**

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TA Towers ApS v EUIPO (T-201/22)
EU:T:2024:27 and (T-202/22)
EU:T:2024:28

This case considers the perception of shape by the informed user, and the impact of perceived differences on the overall impression of the design.

Background

In September 2019, Wobben Properties GmbH (“**Wobben**”) filed an application for a declaration of invalidity of a RCD owned by TA Towers, under Article 52 of the CDR. The RCD was for specialised modular wind turbine towers formed from steel sheets. Invalidity was claimed on the grounds that:

1. The design lacked novelty;
2. The design did not have individual character; and
3. The features of the design were solely dictated by their function.

Wobben relied on various evidence, including an international patent application. The EUIPO Cancellation Division found the RCD to be invalid on the basis the design lacked individual character over the 2010 prior design. The Third Board of Appeal upheld the Cancellation Division’s finding, stating that the design was, when taken as a whole, similar to the prior design from the perspective of an informed user, and therefore infringed Article 6(1) CDR.

Decision

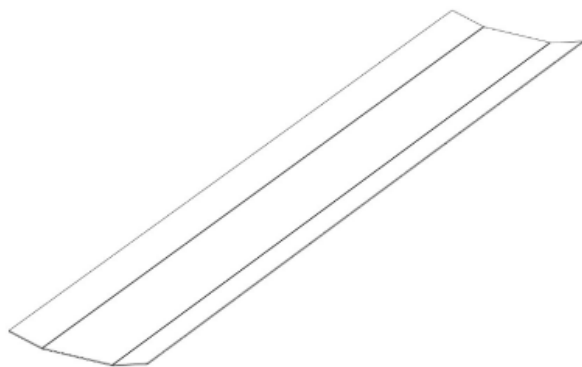
The General Court heard a further appeal of the matter and found that the Third Board of Appeal had erred in its decision, and that the decision should be annulled.

TA Towers, as applicant, did not dispute that the Third Board of Appeal had correctly identified the informed user of the tower segments, but did submit to the General Court that the informed user would display a “high level of attention”. TA Towers cited the small size of the sector and customer base as reasoning for the informed user being highly specialised and fully aware of the details of designs available on the market. The Court rejected this, and held that the Board of Appeal had been entitled to take the view of the informed user being a professional in the construction sector, with some knowledge of the different segments for towers and displayed a “relatively high level of attention”.

The Court found the Board of Appeal’s identified sector and degree of freedom of the designer to be accurate.

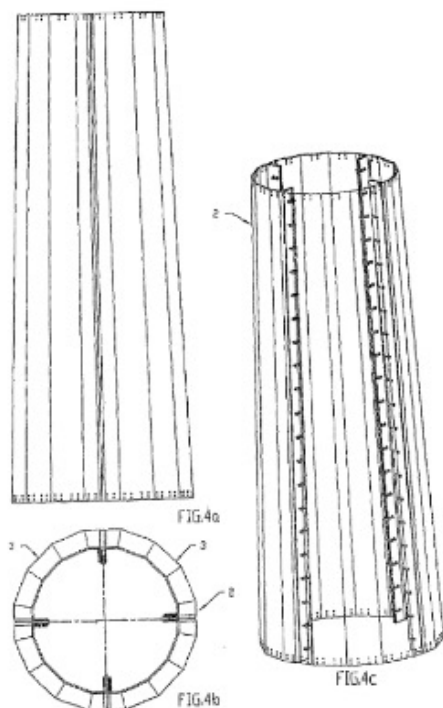
When considering the contested and prior designs, the Court found that the Board of Appeal had incorrectly described the prior design as rectangular. TA Towers’ design, however, was rectangular. The Court found that the informed user would focus on the shape of the designs and form an idea of what the final towers would look like upon assembly of the prefabricated sheets. Further, it found that the informed user would be aware that the rectangular shape of TA Towers’ design would make it possible to produce a cylinder, while the prior design’s shape would produce a truncated cone. The Court declared the informed user would indeed notice this difference.

TA Towers' design:



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=282037&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=394414>

Prior design:



<https://curia.europa.eu/juris/document/document.jsf?text=&docid=282037&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=394414>

The Court further noted that the prior design included four bends in the sheet, whilst TA Towers' design had three. Whilst this difference between the two designs was not sufficient alone to produce a different overall impression, the Court stated the informed user would take note of that difference, and would be aware that the final towers would have slightly different shapes as a result.

Comment

Notably, the General Court made its decision exclusively based on drawings filed with the design applications of TA Towers' design and the prior art, with no observation of a physical product created using the designs.

Additionally, the Court identified that the informed user of products in this sector would show a relatively high level of attention, which would extend to examining the exact shape of the designs, and picturing the finished shape of an object constructed from the considered designs.

**Victoria Rodriguez**

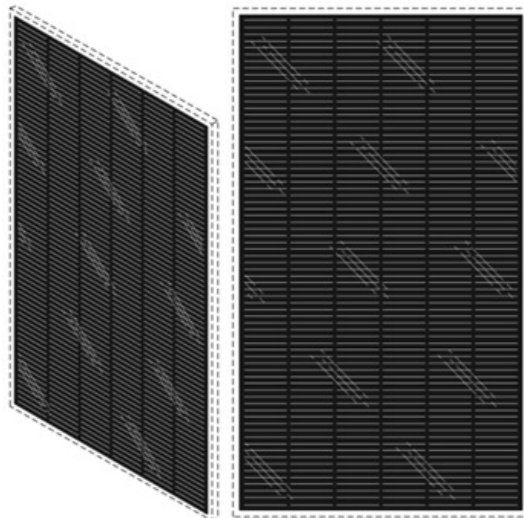
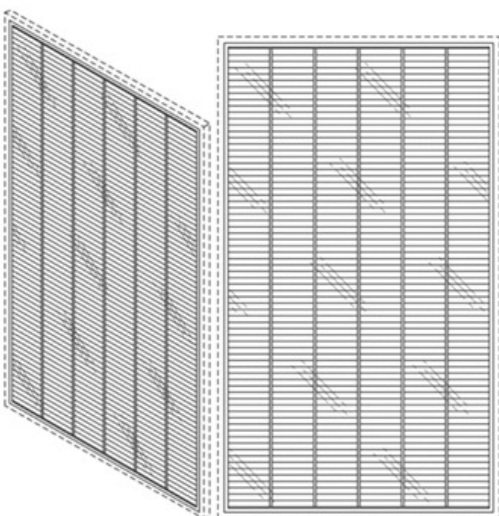
Senior Associate

[Email](#) | [Visit profile](#)***Maxeon Solar Pte Ltd v EUIPO***
(T-62/23) EU:T:2024:224 and (T-63/23)
EU:T:2024:225

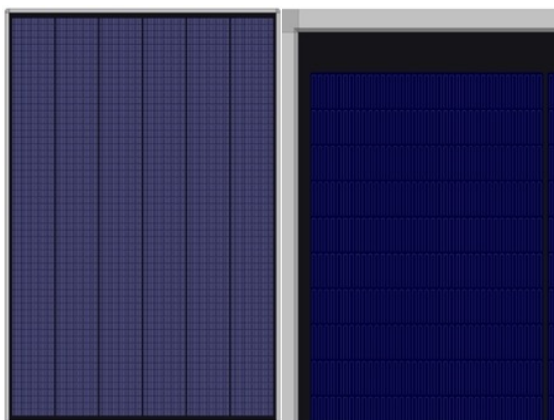
In the joined cases of *Maxeon Solar Pte Ltd v EUIPO*, the General Court upheld decisions which declared a couple of RCDs for solar panels invalid for lacking individual character; in doing so, it provided helpful reminders regarding the assessment of individual character in the context of design protection.

Background

A company called ZO filed an application for a declaration of invalidity of two RCDs for solar panels (the “**Contested Designs**”) registered to the Applicant, Maxeon Solar Pte. Ltd (“**Maxeon**”). The basis for the invalidity action was the existence of an earlier design for a solar panel which the invalidity applicant claimed produced the same overall impression (the “**Prior Design**”).

The Contested Designs

<https://curia.europa.eu/juris/document/document.jsf?text=&docid=284633&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=44546>

The Prior Design

<https://curia.europa.eu/juris/document/document.jsf?text=&docid=284633&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=44546>

The EUIPO's Invalidity Division upheld the invalidity applications made by ZO. Maxeon appealed the decisions but the EUIPO Board of Appeal dismissed the appeal. Maxeon subsequently appealed to the EU General Court and principally argued that the Board of Appeal was wrong to consider that the Contested Designs lacked individual character as they produced a different overall impression on the informed user from that produced by the Prior Design.

Decision

The Board of Appeal had identified the informed user as a person who purchased/used solar panels and who was familiar with those available on the market. The informed user was not an expert capable of observing in detail the minimal differences that may exist between solar panel designs and it was appropriate to take the non-expert impression into account for the assessment of individual character. This was the correct approach in the General Court's view.

The Contested Designs were rectangular in shape, containing six separate columns in which solar cells were represented. The Prior Design instead included rows of 'n'-shaped elements in which the cells were represented. This was therefore a distinguishing factor according to Maxeon. Further, Maxeon claimed that the rectangle proportions were not perfectly identical, and that in relation to one of the contested designs, the upper and lower parts of the designs were also distinguished by a thickening of the inner frame or presence of bars.

While the Board of Appeal considered that the informed user could perceive the differences between the designs if the solar panels were placed side by side, this was not enough. As noted by the General Court, these differences did not demonstrate that the designs produced a different overall impression. This was because the individual character of a design results from an overall impression of difference (or lack of "déjà-vu") from any previous presence in the design corpus. This is to be assessed without taking account of any differences that are insufficiently significant to affect the overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce a dissimilar overall impression.

Comment

These cases emphasise the importance of assessing individual character and overall impression from the perspective of the informed user that may include "non-experts". It is important to remember that differences, unless sufficiently marked, may not be enough to produce a different overall impression.

Court of Appeal



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Marks and Spencer plc v Aldi Stores Limited [2024] EWCA Civ 178

Aldi's infringement of M&S's registered design upheld by Court of Appeal

You can read a more detailed analysis of this case [here](#).

The Court of Appeal upheld a High Court finding of UK registered design infringement by Aldi in respect of gin bottles which featured a winter scene, gold snow globe-style flakes and a light in the base. For a summary of the High Court judgment, see our Designs and Copyright Review of the Year 2023 [here](#).

Although successful registered design cases are few and far between, the actual result on appeal was not that surprising. This is due to the relatively high hurdle which Aldi faced in trying to overturn an experienced judge's findings that the Aldi design gave the same overall impression to the informed user as the M&S registered designs, which is the test for infringement. Aldi would have to have persuaded the Court of Appeal that the judge had made an error of law or come to a decision which no reasonable tribunal could have reached.

However, the decision is interesting as it answered several questions which have been puzzling design lawyers for some time.

Decision

The designs in issue

One of the four M&S designs



<https://www.bailii.org/ew/cases/EWCA/Civ/2024/178.html>

One of the two Aldi infringements



<https://www.bailii.org/ew/cases/EWCA/Civ/2024/178.html>

Four images of the M&S gin bottle had been registered as colour photographs, two of which were said by M&S to have been taken against a dark background. However, Aldi argued that they showed a dark liquid in the bottles, or a dark bottle. As the judge had not addressed this issue, nor had he given his reasons for finding that two of the registrations showed a light in the bottles but two did not, the Court of Appeal had to revisit the findings. It concluded that M&S was correct: the two registrations in question did show a clear liquid against a dark background, and all four registrations showed a light in the bottle.

In reaching these conclusions the Court of Appeal corrected the trial judge's statement that examining products made to the designs was irrelevant to the interpretation of a design, and cited several cases which had approved the use of actual products as a reference.

Does the product indication have any bearing on the interpretation of a design?

When filing a registered design, it is necessary to assign a product indication e.g. "gin bottle". This assists people searching the register to find a design in a particular category. The Court of Appeal held that this purpose leads to the conclusion that the product indication can be relied upon to resolve an ambiguity in terms of what is shown in the registration. The description in this case of "Light Up Gin Bottle" would confirm that the representations did show the presence of the light in the bottle.

Should earlier designs of the proprietor be ignored when assessing the design corpus for the purposes of infringement?

The scope of protection of a registered design is based in part on the existing design corpus. A design which is very different from other earlier designs will attract wider protection than one which is only slightly different from the existing design corpus, when the scope

of protection is likely to be limited to those features which set it apart from the earlier designs.

The legislation gives the proprietor a 12-month grace period in which they can test the market for their design before having to apply to register it. However, if different iterations of the design are released, these could serve to destroy the novelty of any subsequent application for the design, since they would be earlier designs which could give the same overall impression.

The legislation therefore includes an exception for the disclosure of the proprietor's own earlier designs, saying that these should be ignored when considering novelty and individual character for the purposes of determining registrability of the design. Aldi argued that such designs should be taken into account when assessing infringement, rather than registrability, as there was nothing in the legislation to say that they should not be.

However, the Court of Appeal held that just because there was no express wording in the legislation to that effect, it would be wrong to take them all into account as that would defeat the purpose of the grace period, as they would reduce the scope of protection of the registration potentially to nothing. It was right that the same test applied to both validity and infringement.

Which earlier designs should be ignored?

The Court of Appeal then had to decide what earlier designs should be excluded; namely, whether it should be: any earlier design of the proprietor, only earlier designs of the proprietor which gave the same overall impression as the registered design, or just the identical design.

The Court of Appeal concluded that the middle option was the correct one. This serves as a warning for designers who test the market with a range of different designs – unless they apply to register all of them, some of those designs which may not give the same overall impression to the one(s) registered could narrow the scope of protection of the registered designs.

When should the overall impression of a design be assessed for infringement purposes?

In many cases this will simply be the filing date of the registered design. However, it is possible to claim a priority date from an earlier registration filed for the same design in another convention country provided that that earlier registration was filed within 6 months of the UK filing.

The Court of Appeal held that the priority date was the key date, and did not agree with Aldi that it was illogical that the overall impression of the design would be assessed at a date which was earlier than the date from which the design could be infringed (i.e. the date of registration of the UK design). Again, the assessment of overall impression should be the same for both validity and infringement.

Comment

It is reassuring to see confirmation of the principle that there should be no difference between the assessment of the overall impression given by a design for the purposes of validity and infringement. Design law is already complicated enough, so anything which helps to simplify it can only be a good thing.

High Court



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Praesidiad Holding BVBA (previously Betafence Holding BVBA) and another v Zaun Ltd [2024] EWHC 1549 (Pat)

This case concerned the Defendant's alleged infringement of the Claimants' RCD. In this judgment, the Court struck out the Defendant's counterclaim for invalidity.

Background

The Defendant opted to seek a declaration of invalidity in respect of the RCD and the equivalent re-registered UK Design (the "**Re-registered Design**"). This followed a finding of validity of the RCD at the EUIPO.

The Claimants asserted that this was an attempt to re-run in the UK an invalidity challenge that the Defendant has already unsuccessfully made before the EUIPO. They applied for the counterclaim for invalidity to be struck out.

A timeline of the key events is set out below.



Decision

The Claimants argued that the Defendant was precluded from challenging the validity of the RCD and Re-registered Design, either because Article 86(5) of the Community Designs Regulation (“**Article 86(5)**”) still applies following Brexit (as a result of the provisions of the withdrawal of the UK from the EU (the “**Withdrawal Agreement**”), which have direct effect in English law), or pursuant to the English law principles of *res judicata*.

The Defendant contended that Article 86(5) has been disapplied as a result of paragraph 9(2) of Schedule 1A to the Registered Designs Act 1949 (“**RDA**”) which sets out that “the provisions contained or referred to in Title IX of the Community Design Regulation (with the exception of Articles 86(2), (4), (5) and 91) shall continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from IP completion day” [emphasis added]. This provision was argued to have the further consequence of implicitly disapplying any otherwise applicable common law principle of *res judicata*.

Article 86(5)

Mr Justice Zacaroli in this action ruled that Article 67(1) of the Withdrawal Agreement, which sets out that in respect of legal proceedings instituted before the end of the transition period a number of provisions of EU law shall apply, provides for the continuing effect of Article 86(5) in relation to the Claimants’ infringement action. This is notwithstanding Paragraph 9(2) of Schedule 1A to the RDA, as this provision does not purport to terminate or otherwise derogate from the direct effect of Article 67(1).

This conclusion was deemed to be supported by the principles of interpretation of secondary legislation, including that they should, where possible, be interpreted in a way that avoids the conclusion that they are *ultra vires* (i.e. outside the scope of the statutory power pursuant to which the legislation was purportedly made).

Res judicata

In any event, Mr Justice Zacaroli ruled that, irrespective of Article 86(5), the Defendant is precluded by the common law principles of *res judicata* from re-litigating the question of invalidity, whether in respect of the RCD or the Re-registered Design, having litigated that question to a final conclusion before the EUIPO.

In order to reach this conclusion, the Judge ruled that the EUIPO was a court of competent jurisdiction for the purposes of the English law doctrine of *res judicata*.

The notion that paragraph 9(2) of Schedule 1A to the RDA was intended to enable a party who has litigated the invalidity of a design right to a final conclusion before the EUIPO to ignore that conclusion and start again free from any statutory or common law species of *res judicata* was deemed difficult to square with the other provisions in Schedule 1A (such as paragraph 9A). In fact, paragraph 9A applies where at IP Completion Day there were pending invalidity proceedings (including at the EUIPO) in relation to a registered design, and the registered design is subsequently declared invalid. The effect of paragraph 9A is to extend that conclusion, automatically, to the re-registered design.

Accordingly, Mr Justice Zacaroli concluded that even if Article 86(5) has been implicitly disapplied by paragraph 9(2) of Schedule 1A to the RDA, the common law principles of *res judicata* continue to apply so as to preclude the Defendant from re-litigating the question of invalidity which it had contested to a final conclusion before the EUIPO.

Therefore, the Defendant's counterclaim was struck out.

Looking Ahead

Copyright

Looking forward to 2025, we await to see an outcome of the UK Government's Copyright and AI: Consultation. The Government has not set out the detail of the next steps following the closing of the consultation. However, it has said that it will publish a summary of the responses to the consultation on the gov.uk website. In the meantime, it will assess the responses and use them to design a policy to achieve the objectives of the consultation.

Staying on AI, the trial in the *Getty Images v Stability AI* case is due to take place in the summer of 2025, with an estimated duration of 18 days. There have been two interim decisions (one in December 2023 and one from February 2025) on the case, which have provided details of the claims being made. More details on the 2023 decision rejecting an application for summary judgment can be found [here](#), and more details on the 2025 decision rejecting a representative claim can be found [here](#).

It is easy to see how a final decision in either direction could dramatically affect the extent to which data is collected: a favourable decision for Stability AI could embolden AI firms to collect and use data more freely; a favourable decision for Getty should have the reverse effect, and may amount to even more trouble for AI firms if content holders are emboldened to bring infringement claims for suspected past infringements by AI firms.

That being said, the summer of 2025 will only be when the trial takes place and a decision may not be handed down until some time after that. Indeed, the Government appears keen to find a solution, via the Consultation, before a decision is made in the *Getty Images v Stability AI* case.

As for important copyright appeals in 2025, at time of writing, it is understood that there will not be an appeal in *WaterRower*.

However, the AGA Rangemaster case is being appealed, with a Court of Appeal hearing set for October 2025. It is understood that the appeal relates to the findings on copyright, although the issues in that case appeared to be far more clear cut than in *WaterRower* in deciding whether or not the article in question was an artistic work under UK law.

As a brief reminder, as far as the copyright claim was concerned, the Claimant alleged that copyright in a design drawing for a control panel for a cooker was infringed by the equivalent control panels on the Defendants' cookers.

The Defendants had argued that the design drawing was entirely dictated by function and was not an expression of the author's own intellectual creation.

The first instance judge determined that the Claimant's design drawing for the control panel was an artistic work; in doing so, he relied on *Brompton Bicycle* (C-833/18) and *Cofemel* (C-683/17) – two CJEU authorities for the principle that copyright can subsist even if a shape of a product is, at least in part, necessary to obtain a technical result. A finding of infringement followed given the similarities between the works.

However, it was held that the Defendants could rely on a defence under Section 51 of the Copyright, Designs and Patents Act 1988 (“**CDPA**”). Section 51 CDPA prevents a claimant from enforcing the copyright which subsists in their design document, if that design document shows a design for an article that is not an artistic work (which for three-dimensional articles effectively means a sculpture or a “work of artistic craftsmanship”). Put another way, it permits copying of items shown in a design document, where the item in question is not an artistic work itself.

In making this finding, the judge held that the control panel itself could not be considered an artistic work, and therefore the Section 51 defence applied. The judge referred in his decision to various findings in *Cofemel*, but considered that, without submission from the parties, he could not reach any final conclusion on the impact of *Cofemel* on this point. Instead, he dealt with the Section 51 CDPA issue “on the basis of its own wording”.

Accordingly, the Court of Appeal may get its chance to address the applicability of *Cofemel* and other CJEU case law on UK copyright.

Designs

In February 2025, the UK Intellectual Property Office (“**UKIPO**”) published a “Survey on priorities to shape UK system for protecting designs” aimed at designers, design businesses, legal professionals and “anyone interested in design”. The survey aims to understand designers’ and users’ priorities for the designs system.

The key areas “under the spotlight” for the survey are:

1. **Value for money.** Exploring the balance between affordable protection and a robust system (bearing in mind registration costs, renewal fees and legal enforcement costs).
2. **Smart checking systems.** Exploring how thoroughly design applications should be examined by the UKIPO. The UKIPO refers to the benefit of more thorough checks boosting the confidence in protected designs, and the downsides of longer waiting times and potential higher costs.
3. **Speed.** Similar to the above, this explores offering different service speeds for different designers. This bears in mind the potentially competing needs of designers, with some requiring a quick registration process for earlier protection, while others would benefit from a more comprehensive review.
4. **Flexible protection options.** This area relates to the different routes that can protect a design, including registered designs, copyright and automatic unregistered protection. The survey asks if this flexibility is helpful or overly complicated (the discussions above regarding *WaterRower* and s.51 may answer the latter question!).
5. **Clarity.** Exploring the benefits of a simple system where designers can understand their rights, and an oversimplified system whereby valuable features of protection could be lost.

A more detailed consultation on UK designs is then due to take place later on in 2025. Once this is launched, it may give an indication of the direction the Government intends to take UK design law.

The survey forms part of a broader review of the UK design regime, which included a consultation in 2022 – see the consultation outcome [here](#).

In the meantime, the EU's amended Community Design Regulation will apply from May 2025. The impacts of that legislative change are likely to be watched closely in the UK by the Government, designers and legal practitioners alike.

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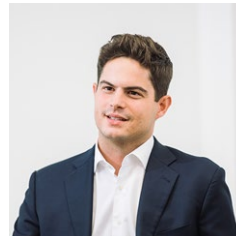
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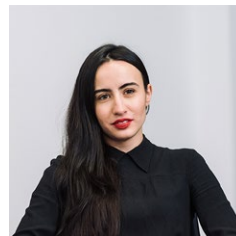
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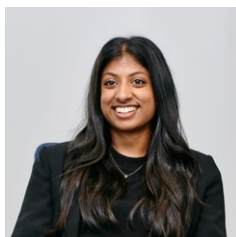
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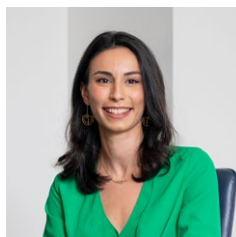
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