

**THE HIGH COURT
COMMERCIAL**

[2007 No. 15 P]
[2007 No. 16 P]
[2007 No. 20 COM]
[2007 No. 21 COM]

BETWEEN

KAREN MILLEN LIMITED

PLAINTIFF

AND

DUNNES STORES AND DUNNES STORES (LIMERICK) LIMITED

DEFENDANTS

Judgment delivered by Ms. Justice Finlay Geoghegan on the 21st day of December 2007

Preliminary

1. The plaintiff is a United Kingdom registered company which carries on the business of producing and selling women's clothing. It carries on business in the State in a number of retail outlets including in Brown Thomas, Clerys, BT2 and its own stores in Dublin and Newbridge.

2. The first named defendant is an unlimited company which is connected to a series of companies including the second named defendant which trades under the name "Dunnes Stores" in Ireland and *inter alia* has a retail business in women's clothing.

3. By two separate plenary summons on 2nd January, 2007, the plaintiff commenced proceedings against the defendants arising out of a discovery made in November, 2006 that the defendants were offering for sale in the State three items: a black knit top, a blue shirt and a brown shirt, which are alleged to infringe three designs of the plaintiff. By order of 5th February, 2007, the proceedings were admitted to the Commercial List and consolidated.

4. The claim pursued on behalf of the plaintiff at the hearing of the proceedings was confined to an allegation that the defendants, in offering for sale the black knit top and blue and brown shirts, are infringing the plaintiff's rights to unregistered Community designs pursuant to Council Regulation (EC) No 6/2002 of 12th December, 2001 ("the Regulation") in each of the three designs referred to below.

5. The defendants at the hearing no longer denied that their top and shirts were produced by copying the plaintiff's designs. Copying a design of another is not necessarily unlawful. It depends upon whether there exists a right to the first design protected by law which is infringed by copying and any use made of the copy. The resolution of the plaintiff's claim herein that the defendants by copying have infringed its rights contrary to the Regulation is primarily dependent on whether or not the plaintiff has, as claimed the right to an unregistered Community design for each or any of its designs next referred to.

The Plaintiff's Designs

6. The plaintiff claims the right to an unregistered Community design in the designs of each of the following articles of clothing produced by it:-

1. A black knit top, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the KM top".
2. A blue striped shirt, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the KM blue shirt".
3. A brown striped shirt, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the KM brown shirt".

7. The KM blue shirt and KM brown shirt will also be collectively referred to as "the KM shirt or shirts".

8. The design for the KM top was produced in August, 2005. The products from the design, the KM tops, were subsequently produced in four different colours and made available to the public in the week commencing the 25th December, 2005. It was released for sale in locations both in the State and the United Kingdom.

9. The designs for the KM shirts were produced in 2005. The KM blue shirt and the KM brown shirt were subsequently produced and made available to the public in the week commencing the 18th December, 2005, by release for sale both in the State and in the United Kingdom.

10. It is claimed that each design was developed or produced by an employee of the plaintiff as part of her duties. It is not in dispute that the design for the KM top was so produced. The defendants deny that the plaintiffs have adduced evidence that the designs for the KM shirts were so developed.

The Defendants' Products

11. The defendants' products are sold under the "Savida" label. The three relevant items are:-

1. The Savida black knit top, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the Savida top".
2. The Savida blue striped shirt, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the Savida blue shirt".
3. The Savida brown striped shirt, three photographs of which appear in the appendix to this judgment, hereinafter referred to as "the Savida brown shirt".

12. The Savida blue shirt and the Savida brown shirt shall be collectively referred to as "the Savida shirt".

13. It is not now in dispute that the defendants arranged for a KM top and KM shirts to be purchased on their behalf from one of the plaintiffs' outlets in the State in March, 2006. It is further not in dispute that the Savida top and Savida shirts were produced by copying the KM top and KM shirts and were put on sale by or on behalf of the defendants in the State by November, 2006.

The Claim

14. In the pleadings delivered herein, the plaintiff claims that it is the holder of an unregistered Community design for each of the designs referred to above and that the defendants have infringed same in the production and sale of the items referred to above. In the pleadings delivered it also claimed that the defendants were guilty of passing off and in breach of the plaintiff's alleged copyright in the said designs. These latter claims have not been pursued. The defendants in their pleadings denied all allegations, including that of copying.

15. The documents discovered by the defendants in the course of the proceedings, admitted into evidence without objection, disclose facts which establish unless otherwise explained that the defendants' products were produced by copying the plaintiff's designs. The defendants through their Counsel at the hearing indicated that they were not offering any evidence to the Court to seek to establish that the Savida top and Savida shirts had been produced other than by copying the designs of the KM top and KM shirt.

16. The primary issue in the proceedings is whether the plaintiff is the holder of the right to an unregistered Community design in each of the KM top, KM blue shirt and KM brown shirt. The evidence adduced and the submissions made by the parties raise a number of discreet issues within that primary issue on the application of the Regulation. These are the first contested proceedings on the Regulation in Ireland.

Council Regulation (EC) No 6/2002

17. The Regulation was made on 12th December, 2001, and came into force pursuant to article 111 thereof in March, 2002. The Regulation is made pursuant to article 308 of the Treaty establishing the European Community and creates a new Community design which is directly applicable in each Member State.

18. The provisions of the Regulation relevant to the issues in these proceedings are:

Recitals:

"(14) The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

(16) Some of those sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

(17) This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design.

(19) A Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs.

(21) It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. ..."

"Article 1

Community Design

1. A design which complies with the conditions contained in this Regulation is hereinafter referred to as a 'Community design'.

2. A design shall be protected:

(a) by an 'unregistered Community design', if made available to the public in the manner provided for in this Regulation;

(b) by a 'registered Community design', if registered in the manner provided for in this Regulation.

3. A Community design shall have a unitary character. It shall have equal effect throughout the Community. ...

Article 3

Definitions

For the purposes of the Regulation:

(a) 'design' means 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;

(b) product means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

Article 4

Requirements for Protection

1. A design shall be protected by a Community design to the extent that it is new and has individual character.

Article 5

Novelty

1. A design shall be considered to be new if no identical design has been made available to the public:
 - (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
2. Designs shall be deemed to be identical if their features differ only in immaterial details.

Article 6

Individual Character

1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:
 - (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Article 8

Designs dictated by their technical function and designs of interconnections

1. A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

Article 10

Scope of Protection

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.
2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Article 11

Commencement and term of protection of the unregistered Community design

1. A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.
2. For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

Article 14

Right to the Community design

1. The right to the Community design shall vest in the designer or his successor in title.
2. ...

3. However, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.

Article 19

Rights conferred by the Community design

1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.
2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design. The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

Article 24

Declaration of invalidity

3. An unregistered Community design shall be declared invalid by a Community design court on application to such a court or on the basis of a counterclaim in infringement proceedings.

Article 25

Grounds for invalidity

1. A Community design may be declared invalid only in the following cases:
 - (a) if the design does not correspond to the definition under Article 3(a);
 - (b) if it does not fulfil the requirements of Articles 4 to 9;
 - (c) if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14;
2. The ground provided for in paragraph (1)(c) may be invoked solely by the person who is entitled to the Community design under Article 14.

Article 80

Community design courts

1. The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.

Article 81

Jurisdiction over infringement and validity

The Community design courts shall have exclusive jurisdiction:

- (a) for infringement actions and - if they are permitted under national law - actions in respect of threatened infringement of Community designs;

Article 85

Presumption of validity – defence as to the merits

1. In proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him.
2. In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the

individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

Article 88

Applicable law

1. The Community design courts shall apply the provisions of this Regulation.
2. On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.
3. Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.

Article 89

Sanctions in actions for infringement

1. Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:

(a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;

(b) an order to seize the infringing products;

(d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

..."

19. The European Communities (Community Designs) Regulations 2003 (SI No. 27/2003) in article 4 designates the High Court as a Community design court of first instance and the Supreme Court as a Community design court of second instance in the State.

20. The parties are in substantial agreement as to how the Court should approach the interpretation and application of the Regulation. The Regulation establishes a new Community design and it is desirable that there be consistency of interpretation throughout the Community. The Court should have regard to relevant decisions (if any) of the European Court of Justice, other Community design courts and those of the Boards of Appeal and the Office for the Harmonisation in the Internal Market (hereinafter, "the OHIM"). The Court should construe the relevant provisions of the Regulation having regard to its recitals and any relevant prior working documents. It should also take a purposive rather than a literal approach to the construction of the Regulation in accordance with the interpretive approach of the European Court of Justice (hereinafter, "the ECJ").

21. Counsel's research disclosed a relative dearth of decisions of the ECJ and Community design courts in relation, in particular, to unregistered Community designs and the issues arising out of the claim for infringement in these proceedings. The few decisions to which I have been referred are of considerable assistance.

22. As appears from the foregoing provisions, the general scheme of the Regulation is for the provision of two separate Community design rights: a registered Community design and an unregistered Community design. Recital (16) makes clear that the unregistered Community design is intended in particular for products frequently having a short market life, where protection without the burden of registration formalities is an advantage. The plaintiff submits that this is highly relevant to the fashion industry and, in particular, that sector in which it operates, namely: the high end of the High Street retail fashion industry. The evidence is that in this sector the life of each design is of short duration.

23. The right to the Community design vests in the designer or, where a design is developed by an employee in the course of employment, the employer in accordance with article 14. Design is given a special definition in article 3(a), meaning the appearance of the whole or a part of a product resulting from its features and, in particular, those specified including colour texture and material. A design is only protected as a Community design if it is both new and has individual character (article 4), in accordance with the definition of those terms in articles 5 and 6. It is agreed that these are cumulative requirements.

24. Whilst the scope of protection of both a registered and unregistered Community design is the same (article 10), the period of protection for an unregistered design is only three years from the date upon which the design was first made available to the public within the Community (article 11) as compared with 5 years, renewable for up to 25 years, for registered designs (article 12). Further, while both confer on the holder a right to exclusive use, an unregistered right only permits the holder of the right to prevent use which results from copying the Community design (articles 19(1) and (2)).

25. The Regulation expressly envisages actions for infringement before Community design courts (articles 80, 81 and 89) and in those proceedings, challenges to the validity of an unregistered Community design, either by way of a plea in the defence or counterclaim (articles 24(3), 25 and 85(2)). The scheme of the Regulation for registration of a Community design as provided in Title V (articles 45-50) does not include any investigation by the OHIM as to whether the design to be registered is either new or has individual character. The grounds for non-registrability in article 47 do not include non-compliance with articles 4-6 inclusive. Rather, the examination relates to certain formal requirements and the claim for the priority date. The Regulation then gives to third parties the right to apply to the OHIM for a declaration of invalidity of a registered Community design. The grounds upon which it may be so challenged include, in accordance with article 25(1)(b), that the design does not fulfil the requirements of articles 4-9. Whilst I have

not set out above all the relevant provisions of the Regulation relating to registration, there is no dispute, that this is the position. This part of the scheme of the Regulation has some bearing on the dispute between the parties, relating to the onus of proof and evidential burden on the respective parties, having regard to article 85 of the Regulation.

Issues not in Dispute

26. By the end of the hearing the following relevant issues to the claim and defence were no longer in dispute between the parties.

1. The designs to the KM top, KM blue shirt and KM brown shirt were each made available to the public within the Community, in the month of December, 2005 and hence were, at the date of the alleged infringement, within the three year period of protection in article 11 and remain within that period.
2. If the plaintiff has a right to an unregistered Community design in each or any of the designs of the KM top and KM shirt, then the designs of the Savida top and Savida shirt fall within the scope of protection of article 10(1) as they do not produce on the informed user a different overall impression. The photographs in the appendix hereto demonstrate this.
3. The alleged acts of infringement by the defendants are a use which results from the copying of the plaintiff's designs to KM top and KM shirt within the meaning of article 19(2).
4. The right to the design in the KM top vests in the plaintiff pursuant to article 14(3).
5. If the plaintiff establishes a right to an unregistered Community design for each or any of the designs of the KM top, KM blue shirt or KM brown shirt, then the defendants have infringed that unregistered Community design.
6. If infringement is found then the Court has jurisdiction pursuant to article 89(1)(d) to grant the plaintiff an order for an account of the profits earned by the defendants from the sale of the infringing products and an order for the taking of such accounts and enquiries as are necessary to determine such profits.

Issues in Dispute

27. The issues which remain in dispute between the parties at the end of the hearing may be summarised as follows:-

1. Has the plaintiff put before the Court evidence to establish on the balance of probabilities that the right to the design in the KM blue shirt and the KM brown shirt vests in the plaintiff in accordance with article 14 of the Regulation.
2. On which party rests the onus of establishing that there exists an unregistered Community design in the design to the KM top, KM blue shirt and KM brown shirt and what evidence is required to discharge such onus.
3. Who or what is an "informed user" for the purposes of the Regulation.
4. How and upon what evidence should the Court assess the overall impact of the plaintiff's designs on an informed user. In particular, should the Court make the assessment on evidence of such impact from a person who comes within the description of an informed user.
5. With what are the plaintiff's designs to be compared for the purposes of article 6 of the Regulation. Should they be compared with an actual design previously made available to the public, as contended for by the plaintiff, or a combination or amalgam of designs or parts of designs previously made available to the public, as contended for by the defendants.
6. Should the Court refer a question or questions to the European Court of Justice as to the proper interpretation of article 85(2) of the Regulation, as requested on behalf of the defendants, prior to determining the plaintiff's claim herein.
7. Following resolution of the above has the plaintiff established an entitlement to an unregistered Community design in each or any of the designs of the KM top, the KM blue shirt or the KM brown shirt.

Plaintiff's right to the design of the KM blue shirt and KM brown shirt

28. The evidence relevant to this issue was given by Ms Gemma Metheringham. At the time of giving evidence she was the Creative Director employed by the plaintiff. At the time of the production of the design for the KM shirt she was the Design Director employed by the plaintiff.

29. The plaintiff had indicated in the pre-trial exchanges that the evidence relevant to this issue would be given by Ms Danielle Benardout and had delivered to the defendants a witness statement for Ms Benardout. Ms Benardout did not travel to give evidence having been advised by a consultant obstetrician and gynaecologist whom she was attending in October, 2007 that it would be unwise for her to travel. A copy of a written statement to that effect from the consultant obstetrician and gynaecologist dated 2nd October, 2007, was produced to the Court.

30. Ms Metheringham's evidence, both contained in her witness statement and in her direct oral evidence, is to the effect that at the time of the design of the KM shirt she managed a studio of the plaintiff which incorporated seven senior designers, of which Ms Benardout was one, four junior designers and two administrative staff. That studio designed all products on sale in Karen Millen stores.

31. Ms Metheringham gave evidence of her own knowledge that Ms Benardout was then employed by the plaintiff and, as part of her work, was charged with designing a striped shirt which was to form part of a work wear collection given the name "Cruise" by the plaintiff. She recalled Ms Benardout designing the shirt during a work trip to Hong Kong. The plaintiff's deadline for the sketches for the shirt occurred during the trip to Hong Kong and Ms Metheringham recalled Ms Benardout designing the shirt in her room in Hong Kong.

32. Ms Metheringham also gave evidence that she gave to Ms Benardout a book of fabric cuttings from an Italian supplier, Cangili, whose fabric the plaintiff had previously used and found particularly satisfactory

33. Ms Metheringham gave evidence that she discussed the design for the KM blue shirt with Ms Benardout. Further, whilst Ms Benardout identified three Cangioli blue striped fabrics for potential use, she then developed and altered the precise colouring of these fabrics. Ms Metheringham approved, at the time, the final colour choices for these shirts and, on re-examination, identified her initials on the relevant document discovered by the plaintiff to the court.

34. The evidence given in relation to the KM brown shirt was that the colour and the striped combinations in the materials used were developed by Ms Benardout to co-ordinate with other items of clothing in the plaintiffs "Cruise" work wear range in 2005.

35. On the evidence given by Ms Metheringham, a summary of which is set out above, I find that the design of the KM blue shirt and the design of the KM brown shirt were developed by Ms Benardout following instructions given to her by Ms Metheringham on behalf of the plaintiff. Further, that Ms Benardout was, at the relevant time, employed by the plaintiff. There is no evidence before the Court of any agreement between Ms Benardout and the plaintiff that the design to the KM blue shirt and KM brown shirt should not vest in the plaintiff, nor is there any provision of Irish domestic law which so provides.

36. I have therefore concluded that, in accordance with article 14(3) of the Regulation, the right to the Community design in the KM blue shirt and KM brown shirt vests in the plaintiff.

37. Counsel for the defendants, in the closing submissions, also sought to rely on the absence of any evidence of any assignment from or other agreement with Cangioli, the manufacturer of the fabric, and contends that, in the absence of same, the plaintiff cannot rely upon the pattern of the fabric for the purpose of establishing that the design to the KM shirt possesses individual character.

38. This submission appears misconceived. The plaintiff's claim is to an unregistered Community design in the design for each of the KM blue shirt and the KM brown shirt. The design is of the entire of the shirt, as distinct from any part thereof. There does not appear any basis for such an objection in the Regulation.

39. Further, on Ms Metheringham's evidence, which I accept, there is no factual basis for such an objection. The evidence is that the three different fabrics for the blue shirt were initially chosen from Ms Metheringham's Cangioli fabrics, but that the colour of those fabrics was further developed and changed by Ms Benardout. The colour and striped design for the fabric in the brown shirt were developed by Ms Benardout for the plaintiff.

Onus of Proof

40. The plaintiff in these proceedings claims to have an unregistered Community design right in the designs for the KM top and the KM shirts. The defendants deny that such rights exist in the designs. In accordance with normal substantive and procedural rules, the burden of proving the claim rests on the plaintiff.

41. The defendant contends that such burden includes the plaintiff proving that the designs are new and have individual character in accordance with articles 5 and 6. The plaintiff contends that its burden is more limited having regard to article 85(2) and that the burden of proving that the designs are not new or do not have individual character falls on the defendant in the context of its plea of invalidity.

42. It is necessary to recognise the distinction between the legal burden of proof on a plaintiff and the evidential burden of proving certain facts. This distinction is particularly well recognised in criminal law where the prosecution at all times bears the legal burden of proof, i.e. beyond reasonable doubt, but the evidential burden in relation to certain facts may be shifted to the accused. See *O'Leary v Attorney General* [1995] 1 I.R. 254.

43. Both parties agree that the Court must decide the respective burdens of proof by the proper application of article 85(2) of the Regulation. However, they differ in their submission as to the meaning of article 85(2). Article 85(2) provides:

"In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendants may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity."

44. The plaintiff in its submission relies upon the approach of his Honour Judge Fysh Q.C. in *Bailey & Another v. Haynes & Others* [2006] E.W.P.C.C. 5 in the Patents County Court. That case concerned the alleged infringement of both a UK unregistered design right (UKUDR) and a Community unregistered design right (CUDR). In considering the claim based on the unregistered Community design right (CUDR) his Honour Judge Fysh at para.53 stated:

"53. ...Finally, according to the rubric to Article 4 of the Regulation, novelty and the possession of individual character are threshold 'Requirements for protection'.

54. If this aspect of the design is challenged, the burden said Mr Tritton, falls on Elite to show that its Design possesses both of these qualities, the issue being similar to that of originality in UKUDR (and copyright). I reject that submission. Whereas the facts relating to originality are precise and inevitably fall within the knowledge of the author of a work, the full facts which may affect novelty and individual character usually do not and in addition, may involve questions of opinion. In my view, in CUDR, the onus in this respect is analogous to that arising in an action to revoke a patent: the burden is on the party wishing to impeach the statutory right." (emphasis added).

45. The plaintiff accepts that it does not appear from the judgment that article 85 of the Regulation was drawn to the attention of his Honour Judge Fysh Q.C. or that his conclusion as to where the burden lay derived from a consideration of that article. Counsel for the defendants, correctly in my view, draws attention to the difference between the procedure leading to the grant of a patent and the registration of a Community design right. In the former, there is an independent examination of the claim to novelty and originality, whereas in the latter (as set out earlier in this judgment) no examination takes place as to whether the design is new or has individual character. This difference, it is submitted, undermines the appropriateness of the analogy made by his Honour Judge Fysh Q.C..

46. The plaintiff also submits that, independently of the views expressed by his Honour Judge Fysh Q.C., article 85(2) when construed in the context of the overall scheme of the Regulation, must mean that the evidential burden on the plaintiff is limited to:-

(i) Producing proof that the conditions laid down in article 11 have been met in the sense of proving that the design was made available to the public within the community and firstly on a date which is within three years of the alleged infringement; and

(ii) indicating what constitutes the individual character of the Community design in the sense of identifying those elements of the design which it asserts means the design creates a different overall impression on an informed user from any design which has previously been made available to the public. It is a question of identification of the causes rather than proving the differing overall impression.

47. If such evidential burden is discharged and a defendant challenges the validity of the unregistered Community design the plaintiff submits that the onus shifts to it to prove that the relevant ground for invalidity in article 25 is made out..

48. The defendants submit that the requirement in article 85(2) that the plaintiff produce "proof that the conditions laid down in article 11 have been met" must mean that the plaintiff is required to produce proof that the requirements of all of section 1 of the Regulation (including, in particular, that the design is new and has individual character in accordance with articles 5 and 6) have been met.

49. I have considered the differing meanings contended for in article 85(2) of "proof that the conditions laid down in article 11 have been met" and have concluded that the plaintiff's more limited meaning is the only meaning which is consistent with the scheme of the Regulation and the additional requirement in article 85(2) that the plaintiff indicates what constitutes the individual character of its Community design. I have reached this conclusion for the following reasons.

50. In the scheme of the Regulation, a Community design may be registered without any proof of, or examination by, the OHIM of whether or not the design meets the requirements of novelty and individual character as required by articles 4 – 6 inclusive of the Regulation (articles 36, 45 and 47). Notwithstanding such absence, in an action for infringement of a registered Community design the Court is required by article 85(1) to treat the Community design as valid. Validity may only be challenged with a counter claim for a declaration of invalidity. In any such counter claim the onus of establishing the ground for invalidity in accordance with article 25 rests on a defendant making the counter claim.

51. As appears from recital (16) to the Regulation, the reason for the creation of an unregistered design right is the existence of sectors of industry which produce large numbers of designs for products frequently having a short market life and where the protection without the burden of registration formalities is an advantage. A construction of article 85 which imposes in an infringement action a significantly higher burden on a claimant to an unregistered Community design, over that imposed on the holder of a registered design, is not consistent with the creation of an unregistered Community design without the burden of registration formalities.

52. Further, article 11 is directed towards how a period of protection may commence and specifies the length of such period. Insofar as it provides in the opening phrase of article 11(1) that a design "which meets the requirements under Section 1 shall be protected ...", it appears only to be making clear that article 11 is not intended to confer any separate protection, but rather identifies additional conditions which must be met by a design which meets the requirements under Section 1 (i.e. articles 3 to 9 inclusive) if it is to avail of protection. The additional conditions imposed by article 11 are: that the design must be made available to the public within the community, in accordance with article 11(2), and must have been first so made available within three years, if protection is still to subsist. These are "the conditions laid down in Article 11" referred to in article 85(2).

53. If the requirement of producing proof that "the conditions laid down in article 11 have been met" included a requirement to produce proof that the design is new and has individual character within the meaning of articles 5 and 6, then there could be no purpose in an applicant being required to indicate what constitutes the individual character of his Community design, as is expressly provided for in article 85(2). Such a construction is inconsistent with the express wording of article 85(2).

54. The above scheme of the Regulation and what appears to be the clear meaning of article 85(2) is underscored by a consideration of the type of evidence which might be necessary if a plaintiff claiming to be the holder of an unregistered Community design were required to discharge an onus of proving that the claimed Community design was both new and had individual character. Article 5 requires proof of a negative that no prior identical design has been made available to the public. Even if this could be proved through expert evidence what would be the nature of the searches which would be required of a witness who sought to give evidence that in his or her view no identical design has been made available to the public?

55. Similar questions arise if a plaintiff was required to discharge an onus of proving that the design had individual character in the sense of producing a different overall impression on an informed user from that produced by any prior design made available to the public.. It appears to me that there exist good, practical, common sense reasons why the Regulation is structured as it is, permitting of only one meaning of article 85(2).

56. Thereafter the Court treats the unregistered Community design as valid and if its validity is challenged must move to consider the challenge. Regardless of whether the challenge is by a plea of invalidity or a counterclaim for a declaration of invalidity the logic of Article 85 and the scheme of the Regulation is that the onus shifts to the defendant to prove on the normal civil balance of probabilities that one or more of the grounds of invalidity in Article 25 exist.

57. In summary the conclusions which I have reached on the burden of proof in an action for infringement of an unregistered Community design pursuant to the Regulation are:

(1) Where, the plaintiff claims infringement of an unregistered Community design, the legal onus of proof is on the plaintiff to establish a right to the unregistered Community design and its infringement.

(2) There will normally be two distinct aspects of the claim to the right: the claim that the design right vests in the plaintiff and the claim that the design is an unregistered Community design.

(3) The onus of proving that the design right vests in the plaintiff is, and remains, on the plaintiff until proved in accordance with the normal civil burden of the balance of probabilities. Article 14 of the Regulation is relevant to how that vesting may be proved.

(4) Article 85(2) of the Regulation specifies the evidential burden which must be discharged by such a plaintiff in order that the Court treat the design as a valid unregistered Community design. That evidential burden is:

(i) evidence that the design has been made available to the public within the Community within the meaning of article 11(2); and

(ii) evidence that the first date upon which it was so made available is within three years of the date upon which the plaintiff claims the right to protection to subsist for the purposes of the alleged infringement; and

(iii) identification of those elements of the design which the plaintiff contends means that the total design produces a different overall impression on an informed user.

(5) If the Court finds that the plaintiff has discharged the evidential burden referred to in para. (4) above, then the Court treats the design as a valid unregistered Community design subject to the defendant's challenge (if any) to its validity.

(6) Where such a challenge is made (either by plea of invalidity or counterclaim) the onus shifts to the defendant to establish on the normal civil balance of probabilities that one or more of the grounds for invalidity specified in article 25(1) is made out. Where, as on the facts of these proceedings, the defendant denies validity by reason of a failure of the designs to meet the requirements of article 6 for individual character, then the burden of establishing that the design does not meet the requirements of article 6 is on the defendant.

(7) If the defendant's plea of invalidity succeeds the Court ceases to treat the design as a valid unregistered Community design and no issue of infringement arises. If the defendant's challenge to validity fails, the Court continues to treat the design as a valid unregistered Community design and moves to consider infringement. The burden of proving the infringement is on the plaintiff.

58. On the evidence I find as a fact that the plaintiff has adduced proof that the conditions in article 11 have been met. The plaintiff has lead evidence that the designs were each made available to the public within the community in the month of December, 2005 by the plaintiff offering for retail sale in Ireland and the UK the KM top and KM shirts. The alleged infringement occurred in November 2006.

59. In addition I find as a fact that the plaintiff, through the evidence of Ms Hallam in relation to the KM top and Ms Metherringham in relation to the KM shirts, has indicated "what constitutes the individual character of [its] Community designs" within the meaning of article 85(2).

60. Claire Hallam, the employee of the plaintiff who designed the KM top, gave evidence that the following features together constitute the individual character of the design of the KM top.

(1) It is a knitted top made from a fabric which is a mixture in unique percentages of viscose (49%), cotton (30%), nylon (18%), elastine (3%). It was designed to be in four colours. The one at issue in these proceedings is black.

(2) The shape is that of a "faux shrug over cami top". It is made individual with the following uniquely combined design features: ribbed sleeves with a triple-layered trim running from under arm around the back of the neck and also a triple-layered trim at the cuff. A particularly bright viscose material is used for the outer layer of the trim at the neck and the inner layer at the sleeve, to make them stand out. Ribbing is used on the body with two distinctive darts

(3) The V-shaped neckline is accentuated by a tab which pulls it down at the centre and which secures fixed gathers in the centre of the bust to enhance the shape. There is a button with the Karen Millen logo on the tab.

61. The unique combination of all of the above elements in the one design is claimed to give individual character to the design for the KM top.

62. The evidence of Ms. Metherringham, the Creative Director of the plaintiff, is that the following features of the design for the KM blue shirt and KM brown shirt constitute the individual character of those designs:

(1) The fact that the shirt consists of three distinctive striped fabrics utilised in a particular way on the shirt. The striped fabrics used are stated to be unique, being a modification of a Cangioli fabric. The use of the bias cut of the fabric on the central placket for the buttons, the cuff binding and inner cuff and the back yoke.

(2) The letter K has been incorporated in the stitching on the pocket and in the stitching on the sleeve. The buttons and button holes are stitched with a darker coloured thread which contrasts with the stitching elsewhere on the garment. The garment comes with cufflinks which have been designed by Karen Millen. The diagonal seam detail on the cuffs.

(3) The fitted silhouette of the shirt.

63. Similarly it is the unique combination of all of the above elements in the one design which is claimed to give individual character to the design for the KM shirts.

64. Accordingly the Court must now treat the plaintiff's designs as valid unregistered Community designs and move to consider the defendant's challenge to their validity.

Defendant's challenge to validity

65. The Defendant submits that the plaintiff's designs do not fulfil the requirements of article 6 for individual character i.e do not produce on an informed user an overall impression which differs from the overall impression produced on such user by any design made available to the public.

Informed user

66. The informed user is central to a decision as to whether a design has individual character within the meaning of article 6 or is one that infringes a Community design within the meaning of article 10. An informed user is not defined in the Regulation. Recital (14) gives an insight into the knowledge which should be attributed to an informed user.

67. The dispute between the parties in relation to an informed user relates more to how the Court should assess the impression

produced on an informed user rather than the characteristics of the relevant informed user.

68. Both parties rely upon the observations of Lewison J. in *Proctor & Gamble Company v. Reckitt Benkiser (U.K.) Limited* [2006] E.W.H.C. 3154 (Ch) at paras. 30 to 41 inclusive and the other authorities referred to therein. In that case, Proctor & Gamble were the owner of a registered Community design for a spray canister operated by the trigger mechanism. The defendant's "Air Wick" aerosol spray was alleged to infringe the registered design.

69. The defendants in these proceedings rely strongly upon the observation of Lewison J. at para. 30 that the informed user in that case "is a user of sprayers, not a designer or manufacturer of sprayers".

70. At the end of the hearing I inquired whether the judgment of Lewison J. had been the subject of an appeal. Counsel agreed to make inquiries and through the Registrar to inform me of the outcome. I subsequently received via the Registrar a copy of the decision of the Court of Appeal, reported at [2007] E.W.C.A. Civ. 936, given by coincidence on the day after the end of the hearing of this case before me. I have obviously considered the judgment of Jacob L.J. (with whom the other two members of the Court agreed) in preparing this judgment. Neither party herein sought to have the matter re-entered to make any further submissions arising out of the judgment of Jacob L.J. in the Court of Appeal. Whilst the decision of Lewison J. was reversed by the Court of Appeal, it did not appear to me, having regard to the extensive submissions made, that the judgment of Jacob L.J. required me to seek further submissions from the parties.

71. Jacob L.J., at para. 32 of the judgment, sets out the passages from other decisions referred to by Lewison L.J. on the nature of an informed user (with which he agrees) in convenient form and as I have taken these into account in the formulation I have reached below, I quote in full:

"[32] The judge considered the nature of the informed user at 30-41. He considered a formulation by HHJ Fysh in *Woodhouse v Architectural Lighting* [2006] RPC 1 and several decisions of the invalidity division of OHIM. I set the passages out for convenience here, though in the end I do not think they are saying anything different from the Austrian Court or what I have concluded above.

Judge Fysh in *Woodhouse*:

'First, this notional person must obviously be a user of articles of the sort which is subject of the registered design - and I would think, a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently he is not a manufacturer of the articles and both counsel roundly rejected the candidature of 'the man in the street'. 'Informed' to my mind adds a notion of familiarity with the relevant rather more than what one might expect of the average consumer; it imports the notion of 'what's about in the market?' and 'what has been about in the recent past?'. I do not think it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any). In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davis reminded me, these are not petty patents. Therefore, focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).'

Eredu v. Arrmet (OHIM ref: ICD000000024; 27 April 2004, a bar stool):

16. The degree of freedom of a designer is limited by the fact that stools of the type to which the CD relates necessarily comprise a base, a central column and a seat in order that the stool fulfils its function.

17. The informed user is familiar with the basic features of stools. When assessing the overall impression of the design he/she takes into consideration the limitations to the freedom of the designer and weighs the various features consequently. He/she will pay more attention to similarities of non necessary features and dissimilarities of necessary ones.

18. In particular, the informed user is aware of the prior art known in the normal course of business to the circles specialised in the sector concerned. Therefore, he knows that that type of stool usually has a foot rest and a back.'

Sunstar Suisse SA v. Dentaïd SL (OHIM Ref: ICD 000000420; 20 June 2005, an interdental brush):

'18. The informed user is also familiar with the basic characteristics of interdental brushes. Specifically, he will be familiar with all designs that are known in the normal course of business in specialist circles in the sector in question. He will know that brushes of this type have a specific form on account of the function they are to fulfil, this form's configuration being determined by two elements (a head with the wire, plus a handle). There are various basic forms that may be used to configure the appearance of the brush. One of these is the 'L' form.'

Built NV Inc v. I-Feng Kao (OHIM ref: ICD 0000002103; 3 May 2006, a bottle carrier):

'16. The informed user is familiar with bottle bags and other similar bottle carriers of the type to which the CD relates. In particular, he is aware that such devices have the function of holding the bottles and enabling their carriage and therefore must have a compartment for the bottles and at least one handle to carry them in the hand. When assessing the individual character of the CD the degree of freedom of the designer in developing his design for the bottle bags must be taken into consideration. In the present case, this degree of freedom is limited to the functional requirements of the product. Because the bottle bag has to fit the bottles, its body has to follow the generally cylindrical shape of the bottles. Regarding the handle, the designer has a broader degree of freedom in designing it in relation to the bottle bag body.'

Honda Motor Co Ltd v. Kwang Yang Motor Co Ltd (OHIM Ref: ICD 000001006; 30 August 2006, an internal combustion

engine, intended principally for lawnmowers):

'25. The informed user is familiar with internal-combustion engines of the type to which the RCD relates. In particular, he is aware that such devices have the function of powering the tools on which they are installed and upon which they have to fit, so there are certain elements which are obligatorily present and disposed in a certain way in an internal combustion engine. Among them, as the Holder rightfully observes, the muffler, the air filter, the vent and the fuel tank have all to be positioned on the upper side for functionality reasons and since the overall impression of the engine will be mainly given by the appearance of its upper part, as this will remain visible during the normal use of this internal combustion engine, when assessing the individual character of the RCD it has to be taken into account that the degree of freedom of the designer is limited in so far as the internal combustion engines has to fulfil its function.'"

72. Jacob L.J. at para. 26 expressed agreement with what was stated by the Higher Provisional Court in Vienna in a similar dispute between the parties to those proceedings where it stated:

"The 'informed user' will, in the view of the Appeals Court, have more extensive knowledge than an 'average consumer in possession of average information, awareness and understanding' (see 4 Ob 239/04g), in particular he will be open to design issues and will be fairly familiar with them (Bulling/Langohrig/Hellwig, Gemeinschaftsgeschmackmuster [Community designs], Rz 56)."

73. The reference to "average consumer" is a reference to that notional person in trade mark law.

74. The conclusions which I have reached from the Regulation and the above authorities on the characteristics of an informed user in general and for the purposes of the designs herein are:

(1) The informed user is a notional person.

(2) He is what I will term an "end user" of the products to which the design relates. By end user I mean a person who uses them for the purpose for which they are intended, i.e. for the designs herein to be worn, as distinct from any intermediate use such as retail sale. On the facts herein, such user is a woman who purchases and wears knit tops and shirts.

(3) He is aware of similar designs which form part of the relevant design corpus. On the facts herein, she will be a woman with a keen sense of fashion who has a good knowledge of designs of knit tops and shirts which have been made available to the public but not necessarily aware of every such design.

(4) He will be alert to design issues and better informed than the average consumer in trade mark law. This view is consistent with the views expressed by Jacob L.J. in *The Proctor & Gamble Company v. Reckitt Benkiser (U.K.) Limited* [2007] E.W.C.A. Civ. 936, with which I agree. This characteristic derives directly from the description "informed" in relation to the user in the Regulation. However, the extent to which an informed user should be considered as alert to design falls short of a specialist interest in design detail which might be expected from a person who is a designer. This follows from the fact that he is a user rather than designer.

(5) He must be considered to be familiar with the functional or technical requirements of the design or, perhaps more precisely, the product for which the design is intended. This appears necessitated by the requirements of article 6(2) and 10(2) that "degree of freedom of the designer in developing the design" should be taken into consideration in assessing individual character (article 6(2)) or the scope of protection (article 10(2)). It is important to emphasise that the informed user should only be considered to have a basic appreciation of the functional or technical aspects of limitation impinging on the design. He is not considered to have extensive technical knowledge appropriate to a manufacturer of the product.

75. In summary, the notional informed user for the designs at issue is a woman with a keen sense of fashion, a good knowledge of designs of women's tops and shirts previously available to the public, alert to design and with a basic understanding of any functional or technical limitations on designs for women's tops and shirts.

Assessment of overall impression on informed user

76. The parties are in dispute as to the evidence which is necessary or relevant for the purpose of the Court determining whether or not the challenged designs have individual character within the meaning of article 6, i.e. whether the overall impression it produces on the informed user differs from the overall impression produced on such user by any design previously made available to the public.

77. The defendants submit that the Court should determine the issue on evidence from witnesses with attributes similar to the characteristics of the relevant notional informed user for the designs in question of the overall impression produced by the designs on them. In these proceedings they submit that they have tendered evidence from three such persons, Ms. Maher, Ms. James and Ms. Corletta. They further submit that the plaintiffs have not tendered any evidence from persons with the characteristics of an informed user for the designs in issue and that such lack of evidence is fatal to the plaintiff's claim. They dispute the Court's entitlement to rely on the evidence of Ms. McAlinden called by the plaintiff as she is a designer and it is contended cannot be considered to have the characteristics of an informed user.

78. The plaintiff submits that evidence from a person who may have the attributes or characteristics of the notional informed user of the overall impression created by the challenged design and earlier designs is neither essential nor helpful to determining whether the challenged designs have individual character within the meaning of article 6. The plaintiff submits that such issue is to be determined by the Court making its own assessment of the overall impression produced by the challenged designs on the notional informed user; a similar assessment of the overall impression created by any earlier designs relied upon by the defendants and a determination as to whether such overall impressions clearly differ or differ within the meaning of article 6. In support of this submission they rely on the approach of the Courts of England and Wales in *Bailey t/a Elite Angling Products v. Haynes t/a R.A.G.S.* [2006] E.W.P.C.C. 5 and the High Court decision in *The Proctor & Gamble Company v. Reckitt Benkiser (U.K.)* [2006] E.W.H.C. 3154 (Ch), and that of the Board of Appeal of OHIM of 22 November, 2006 in case R 196/2006-3 *Daka Research Inc. v. Ampel 24 Vertriebs-GmbH & Co. KG*.

79. In *Daka*, the appellant was the holder of a Registered Community Design (RCD) for underwater motor devices. The respondent had filed an application for a declaration of invalidity of the RCD and, at the hearing before the Invalidity Division of OHIM, appears to have submitted that the RCD did not fulfil the requirements of novelty or individual character. The declaration of invalidity was granted. In its decision on appeal, the Board of Appeal set out the relevant provisions of the Regulation and then stated:

"18. In its application for a declaration of invalidity the respondent referred to the lack of novelty of the contested RCD with respect to Article 4 CDR and contended that the design had been anticipated by a European patent application published on 28 April 2004. It was also argued that a product into which the design had been incorporated was marketed by a company associated with the respondent from June 2002.

19. The respondent did not, in its application for a declaration of invalidity, refer to the contested RCD's lack of individual character. That concept was first mentioned by the appellant in the observations that it filed on 13 June 2005. There the appellant argued that the contested RCD possessed both novelty and individual character. From that point on, both parties have addressed the issues of novelty and individual character jointly without striving to make a clear distinction between the two concepts. It is in any event clear that novelty and individual character, although presented as separate requirements in Articles 4 to 6 CDR, overlap to some extent. Obviously, if two designs are identical except in immaterial details, they will produce the same overall impression on the informed user. It is equally obvious that, if two designs produce a different overall impression on the informed user, they cannot be identical.

20. In spite of the overlap between novelty and individual character, there are certain differences between the two requirements. The test for novelty is essentially of an objective nature. The Board simply has to decide whether two designs are identical. The only area where difficulties of interpretation might arise is in relation to the term 'immaterial details'. The test for individual character is less straightforward and is likely to give rise to slightly more subjective appraisals. The Board is required to take into account the overall impression on the informed user, having regard to the degree of freedom of the designer in developing the design. Presumably this means that if the designer had relatively little freedom in developing the design, especially on account of technical constraints, even small differences in relation to earlier designs may be sufficient to endow the design with individual character.

21. In the contested decision the Invalidity Division held that the contested RCD lacked individual character because it produced the same overall impression on the informed user as the design shown above in paragraph 6 (third indent). That design corresponds to the product known as the ZS01. The appellant does not dispute the finding in the contested decision that that design was made available to the public in 2002. The appellant's argument is that the design shown in paragraph 6 above (referred to hereafter as 'the earlier design') and the RCD do not produce the same overall impression on the informed user, as a result of a number of differences between the handles of the underwater scooter shown in the two designs. The appellant has listed these differences and described them in great detail (see paragraph 13, second indent, points (i) to (vi)).

22 The appellant recognises that the RCD is an updated version of the earlier design. The updating concerns only the handle element but that, according to the appellant, is sufficient to confer individual character on the updated design as a whole.

23. The appellant could have sought design protection for the handle alone, since it is a component part of a complex product which remains visible in normal use (see Articles 3(c) and 4(2)(a) CDR). The question then would have been whether the handle in the earlier design and the redesigned handle produce the same overall impression on the informed user. The question might well have received an affirmative answer in view of the differences enumerated by the appellant.

24. Since, however, the contested RCD concerns the underwater device as a whole (and not merely the handle), the comparison must be effected between the whole of the earlier design and the whole of the contested RCD. If the two designs are looked at as a whole, the conclusion must be that they produce the same overall impression on the informed user. They have the same body, the same propeller, and the same propeller shroud. The contours of the handle may vary but the position and general configuration of the handle are the same. In both designs the handle appears to be centrally attached to the body, a plate extends outwards beyond the sides of the body and two grips sweep down at a similar angle.

25. The appellant contends that the handle merits greater attention because that is the area where the designer enjoys the greatest margin of freedom, the design of the other elements being dictated by their technical function. That argument is not convincing. The shape of the body and the propeller shroud could differ significantly without compromising their technical function. The body could be more elongated or more bulbous. The propeller shroud could be broader or narrower and could slope at a different angle. It could incorporate ornamented features that would not affect its function. It follows that there is no reason to focus attention on the handle element rather than on the design as a whole.

26. The Board concludes that the contested RCD is invalid for lack of individual character. The appeal must be dismissed."

80. The plaintiff appears to me correct in submitting that in accordance with the above decision it is neither necessary nor relevant for the Court to consider evidence of the overall impression produced on a witness, even if that witness has the characteristics of the relevant notional informed user. Rather, it appears that the approach of the Board of Appeal is for the court to make its own assessment of the overall impression created by, in the *Daka* case, the RCD as compared with the earlier design relied upon. That assessment appeared to be based on the allegedly differing elements of the overall design noted by the Board of Appeal, either from its own observation and considered in the context of submissions made by the parties recorded earlier in the decision at para. 13 or possibly with the assistance of evidence which identified the differing and similar elements of the two designs.

81. Lewison J. in the High Court in *The Proctor & Gamble Company v. Reckitt Benkiser (U.K.) Limited*, followed a similar approach, identifying from his own observation of the designs the overall impression created by the RCD and the allegedly infringing design. He also identified the similarities and differences of the two designs. He concluded that the same visual overall impression was created by the two designs.

82. When he came to consider the challenge to the validity of the Registered Community Design by reason of certain identified pieces of prior art, he also carried out a similar analysis and comparison of the overall visual impressions created by each design. He rejected the challenge to the validity of the RCD.

83. The Court of Appeal dismissed the appeal against the validity of the RCD. However, the High Court decision on infringement was reversed and Lewison J. was found to have erred in principle. The error of principle submitted on behalf of the appellant is summarised in the judgment of Jacob L.J. at para. 37 as:

"He [Lewison J.] first correctly identified the overall impression of the P & G design. He also at some points identified the overall impression of the Air Wick product. But in the end he failed to compare the overall impression of the P & G design

as he had found it to be, with the overall impression of the Air Wick product.”

84. The trial judge was found to have erred in principle, essentially for those reasons. The specific errors of principle are identified at para. 59 of the judgment of Jacob L.J. Whilst those errors may be of relevance to how this Court should compare the overall impressions created by two relevant designs, they are not relevant to the essential dispute on this issue between the parties. As appears from the above recital by Jacob L.J. of the submission to the Court of Appeal, there was no challenge to the approach of the Court itself identifying the overall impression produced by each of the designs and then comparing the difference (if any) in those overall impressions. Jacob L.J. puts it pithily at para. 35(v):

“The court must ‘don the spectacles of the informed user’ to adapt the hackneyed but convenient metaphor of patent law.”

85. By reason of this conclusion it is unnecessary to consider the objection to the evidence of Ms. McAlinden.

86. The second area of dispute between the parties in relation to the assessment by the Court of compliance with article 6 is whether or not the comparison to be made is between the challenged unregistered Community designs and specified designs which had been made available to the public prior to December, 2005. The plaintiff contends, correctly in my view, that such comparison must be made.

87. The defendants’ submission made primarily in reliance upon recital (14) to the Regulation, is that the comparison should be made with a design which is a hypothetical amalgam of a number of prior designs as these form part of the “design corpus” rather than an actual design made available to the public. The essence of the defendants’ submission is that to have individual character the overall impression produced by the Community design of the informed user must differ from the overall impression created on such user by the existing design corpus in the sense of the amalgam of elements of different designs previously made available to the public. The defendants have not produced any authority in support of this submission.

88. It does not appear to me that article 6, even when construed taking account of recital (14) of the Regulation is capable of bearing that meaning. The wording of article 6(1) is clear. The design is considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by *any design which has been made available to the public* (emphasis added). To have been made available to the public it must be an actual design (as defined). This clearly calls for a comparison between the challenged Community design and an identified prior design. All the authorities relied on in the course of the proceedings which concern challenges to validity of a Community design were based upon an identified prior design (often referred to as the “prior art”). It is irrelevant to this issue that the decisions relate for the most part to registered Community designs.

89. Where, as here, the Community design is claimed for the plaintiff’s whole designs for each of the KM top and KM shirts, it is the overall impression of the whole design, rather than any part thereof, which must be compared with the prior designs. See paragraph 24 of the Daka decision above.

90. Hence, it appears to me, subject to the clarification below which does not apply to the facts of this case, that the comparison must be between the overall impression created by the whole challenged Community design and the overall impression created by one or more specified earlier designs made available to the public.

91. That clarification arises from the definition of “design” in article 3(a). As stated therein, it means “the appearance of the whole or a part of a product ...”. There may be factual circumstances in which it would be legitimate to compare the overall impression of the challenged Community design with the overall impression produced by a prior design in the sense of a design of a part of a product. For example, if in these proceedings the defendants had produced a prior design of a knit dress and contended that the overall impression created by the KM top did not differ from the prior design for part of the knit dress (the top half), it may be arguable that such comparison should be made. None of the prior designs produced by the defendants fall into this category.

92. In these proceedings, the defendants, through their witnesses, identified a number of prior designs which contain, they contend, at least one or more elements of the design for the KM top or KM shirts. However, it was accepted that if the proper test was a comparison of the overall impression created by the whole design for the KM top and KM shirts with a specified prior design, then, for the most part, the overall impressions produced differed.

93. The prior designs produced by the defendants closest to the whole designs for the KM top and KM shirts and with which I propose making the comparisons are:

(1) a design of a Dolce & Gabbana grey knit top, the “D&G top” whose photograph appears in the appendix to this judgment;; and

(2) a blue striped shirt, “the Paul Smith Shirt” whose photograph appears in the appendix to this judgment

Reference to ECJ

94. Counsel for the defendants submitted in closing that this Court should, prior to reaching its decision herein, submit a question or questions to the European Court of Justice on the proper interpretation of the Regulation. He further specified that the question should relate to the proper interpretation of article 85(2) of the Regulation.

95. This Court, as a court from whom there is an appeal, has a discretion as to whether it should or should not make a reference to the European Court of Justice pursuant to Article 234 of the E.C. Treaty, even where questions of interpretation of the Regulation arise. I have determined that I should not make a reference to the ECJ prior to determining this claim. The primary reasons for which I have taken this view are as follows. The proceedings raise a significant number of issues. Both parties have a right of appeal from my decision on every issue of law to the Supreme Court. The submissions do not identify any discrete issue on the interpretation of the Regulation or article 85(2) thereof which would of itself determine the claim. Insofar as it has been necessary to construe article 85(2) of the Regulation, the view I have formed appears the only one consistent with the terms of the article and the scheme of the Regulation. There is no issue of interpretation of the Regulation on which I have formed a view different from that expressed by OHIM or a Community design court in another Member State in any of the authorities opened to me. Those decisions support the view I have taken.

Conclusion on individual character

96. By reason of the conclusions and findings above, the onus is on the defendants to establish on the balance of probabilities that the designs for the KM top, KM blue shirt and the KM brown shirt did not have individual character in accordance with the requirements of article 6 of the Regulation when made available to the public in December, 2005.

97. Where, as in this case, it is contended that each of those designs did not produce on the informed user an overall impression which differed from the overall impression produced on such a user by a prior design available to the public, the defendant must produce the identified design or designs on which it relies for that submission. On the facts herein, those designs are the D&G top and the Paul Smith shirt. The defendants have produced photographs of same.

98. The overall impression produced by the challenged Community design and relevant prior designs on the notional informed user must be assessed and determined by the Court "donning the spectacles of the informed user" primarily from its own observation of the designs and then determining whether such overall impressions differ.

99. Article 6(2) requires that in assessing individual character the degree of freedom of the designer in developing the design shall be taken into consideration. For the KM top there appears to be great freedom. The only small limitation being its function of covering (at least some parts) and possibly keeping warm or adorning the top half of the female body. The limitation in developing the designs for the KM shirts is a little greater. A shirt has certain basic features, collar, front opening with buttons. However within these there is scope for great variation in designing an item which will be regarded as a shirt. Hence the limitation plays little part in the assessment.

100. In assessing the overall impression created by the designs, It appears that the court should have had regard inter alia to the colour, texture and material of the product. This appears required by the special definition of design in article 3(a) of the Regulation. I make this observation as the definition of "design", insofar as it refers to the appearance of the whole of the product resulting from "the features of the colours, . . . texture and/or materials of the product itself and/or its ornamentation", includes matters which may not come within the common understanding of the word "design". The "design" of an item, in everyday language, more normally refers to the other features listed in the definition namely the lines, contours and shape of the product which are also taken into account.

101. There may be further interpretive issues on the Regulation as to whether for the purposes of article 6 the overall impressions must "clearly differ" or only "differ" and whether the test in article 6 is the same or not as that in article 10 for infringement.. Jacob LJ addresses these in *The Proctor & Gamble Company v. Reckitt Benkiser (U.K.) Limited*. It is unnecessary for me to reach any conclusions on those issues on the facts herein. I have applied the higher test of "clearly differ" to article 6 without determining that it is necessary.

102. In accordance with the above, I have reached the following conclusions on the overall impressions produced by each of the plaintiff's three designs, the two identified prior designs and as to whether they differ.

103. The overall impression of the KM top on an informed user is that of a black knit top in a style known in the fashion world as "faux shrug over cami top" of a relatively close knit creating a dense appearance with a V-neck and three-quarter length sleeves and certain distinctive features. It has a distinctive triple-layered trim from underarm around the back of the neck which accentuates the "faux shrug". It has similar triple-layering on the end of three quarter length sleeves. It is ribbed on the sleeves and in the body and has a distinctive dart feature up the front of the body to under the bust line. The V-neck is pulled down by a tab held in place by a button and there is, under the tab, a gathered effect on the bust line. These features produce the impression of a fitted garment with certain distinctive features which accentuate the female shape.

104. The D&G top creates an overall impression on an informed user of a grey knit top in the style of a "faux shrug over a cami top" It is a long-sleeved top with a V-neck. It has distinctive ribbing on a portion only of the sleeve and on a corresponding central portion of the body. It also has ribbing on the edge of the faux shrug, from under the arm, around the back of the neck, , and on the V of the neck. The remainder of the garment is in plain loose knit. The material used creates various shades of grey and the knit a relatively loose fit.

105. I have concluded that the overall impression produced by the design of the KM top on an informed user clearly differs from that produced by the D&G top on such user. Both tops are knit tops in the style known as "faux shrug over cami". However, that is where the similarity ends. They differ in colour; type of knit; obvious design features around the neck; length of sleeve; gathered feature at bust of a tab with button and absence thereof; dart and shaping features present in the KM top, which appear absent in the D&G top; and the distinctive ribbing at matching positions on the sleeves and body in the D&G top, which is absent in the KM top.

106. The design of the KM blue shirt produces an overall impression on an informed user of a long sleeved striped shirt with double cuffs, predominantly blue, using three distinctive striped fabrics with a shape in the bodice for the female form. It gives the impression of a shirt with distinctive features of three different materials: one striped material for the main body; a second, differing striped material for the outer side of the cuffs and the collar and a third striped material, used in two different ways: vertical on the pocket, the inside of the cuff and diagonal (on the bias) on the placket (centre button panel), on the yoke on the back and on a panel up from the cuff. The main fabric has a wide, pale blue stripe with a darker shade at the edges; it is broken by a series of vertical narrow stripes of navy with a white background. The second fabric has a wide band of pale blue and then a narrow band of white outlined with navy blue thin lines. The third fabric has a stronger blue background with regular single lines of navy.

107. The design for the Paul Smith shirt as gleaned from the photograph creates an impression on an informed user of a long sleeved blue striped shirt principally of one material but with a different stripe for the collar and cuffs. The shirt is also cut for the female shape. The main material has several shades of blue and navy with stripes of differing width. The contrasting material on the cuffs is a regular stripe of navy and white.

108. I have concluded that the overall impression created by the design of the KM blue shirt on an informed user clearly differs from that created by the Paul Smith shirt on such. Both are striped shirts based on a male style but with a shape appropriate to the female form. They both have collars, long sleeves and double cuffs, the outsides of which are in contrasting materials to the main material of the shirt. They differ in that the striped materials of each differ significantly in colour and stripe design. The KM shirt has further distinctive and obvious features of a third striped material used on a front pocket, the central button panel, the inside of the cuff, a band on the sleeve and the yoke on the back none of which are present in the Paul Smith Shirt.

109. The overall impression created by the KM brown shirt on an informed user in terms of shape and distinctive features is similar to that of the blue shirt, save that the colouring and stripes of the three materials used differ significantly from that of the blue shirt. As appears from the photographs in the appendix hereto, the colours used are a combination of brown, beige, navy and white.

110. The defendants have not produced any design closer to the design of this shirt than the Paul Smith shirt referred to above. I also conclude that the overall impression created by the KM brown shirt on an informed user clearly differs from that created by the Paul Smith shirt on such user.

111. Accordingly, I have concluded that the defendants have failed to establish, as a matter of probability, that any of the designs of the KM top, KM blue shirt and KM brown shirt do not fulfil the requirements of article 6 for individual character and reject the challenge to the validity of the plaintiff's unregistered Community design in each of the KM top, the KM blue shirt and the KM brown shirt.

112. In accordance with article 85(2), the Court continues to treat the plaintiff's unregistered Community designs as valid.

Reliefs

113. The plaintiff has the right to a valid unregistered Community design in the designs for each of the KM top, the KM blue shirt and the KM brown shirt. It is undisputed that the Savida top, Savida blue shirt and Savida brown shirt are within the scope of protection of such unregistered Community designs within the meaning of article 10. Further, that those items were produced by copying the plaintiff's unregistered Community designs, hence the use made is an infringement of the plaintiff's unregistered Community design and it is entitled pursuant to article 19 of the Regulation to prevent the defendants making use thereof.

114. Having regard to the reliefs pursued and the position taken by the defendants in relation to the claim for an account of profits, the plaintiff now appears entitled to the following reliefs:

- (1) An order restraining the defendants their servants or agents or any person with notice of the making of the order from selling or otherwise disposing of the Savida top, Savida blue shirt and Savida brown shirt.
- (2) An order for the delivery up to the plaintiff of the Savida tops, Savida blue shirts and Savida brown shirts remaining in the possession of the defendants, their servants or agents or any person with notice of the making of the order and
- (3) An order for an account of the profits earned by the defendants (or any company associated with the first named defendant trading as Dunnes Stores) from the sales of the Savida top, the Savida blue shirt and the Savida brown shirt.

115. I will hear counsel as to the precise form of the last order. Whilst the order for an account of profits was conceded as appropriate relief I am unclear as to whether the claim is confined to trading by the second named defendant or whether, by agreement, at an earlier stage of the proceedings the claim relates to other companies associated with the first named defendant operating different Dunnes Stores outlets and trading as Dunnes Stores.