

Neutral Citation Number: [2024] EWHC [2478] (IPEC)

**Claim No. IP-2023-LIV 000001 and PT-2023-000449**

**IN THE HIGH COURT OF JUSTICE**  
**BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES**  
**INTELLECTUAL PROPERTY ENTERPRISE COURT**

**Mr. Ian Karet sitting as a Judge of the Chancery Division**

The Rolls Building  
7 Rolls Buildings  
Fetter Lane  
London EC4A 1NL

Date: 25 September 2024

**Between:**

**EQUISAFETY LIMITED**

**Claimant**

**- and -**

**WOOF WEAR LIMITED**

**Defendant**

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**MS NICOLA FLETCHER appeared in person for the Claimant**  
**MR. MICHAEL HICKS (instructed by Ashfords LLP) for the Defendant**

Hearing date: 18 June 2024

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**Judgment**

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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**Ian Karet:**

**Introduction**

1. This is my judgment following the trial of an action for infringement of copyright in three high visibility (“high vis”) equestrian products - a waistcoat, an elasticated hat band and a neck band for a horse. The waistcoat is to be worn by a rider. The hat band fits over a riding hat. The neck band goes around a horse’s neck. All are reflective and they allow the horse and rider to be seen more clearly. The Annex contains a selection of photographs and images of the items in dispute taken from the Claimant’s disclosure. These representations are used to give a general sense of the types of products in issue.
2. The claim commenced as an action for infringement of registered designs and passing off. The Defendant was granted summary judgment on 5 April 2023. HHJ Hacon permitted the Claimant to amend its claim to cover infringement of copyright in the products as works of artistic craftsmanship under s. 4(1)(c) Copyright, Designs and Patents Act 1988. There is no claim infringement of unregistered designs.
3. Ms Fletcher, the founder and Managing Director of the Claimant appeared at trial. Mr Hicks appeared for the Defendant. At my direction, Mr Hicks outlined relevant areas of the law so that Ms Fletcher was able to present her arguments on them. I am grateful to both of them for their approach at the hearing.
4. The claim arose after the Defendant exhibited three allegedly infringing products at the trade fair “Beta International 2022”. Following the Claimant’s complaint, the Defendant removed the products from sale and none has so far been sold. The Defendant accepts that if copyright subsists in the products, then sales of them will infringe.
5. The products to be considered at trial were identified in an Order made by Ms Pat Treacy on 16 January 2024 (the “Order”) as the waistcoat allege to have been designed by Ms Fletcher in 2020, the hat band designed in 2019 and the neck band designed in 2019. The Order also recited the Claimant’s confirmation that it does not rely on any earlier versions of the products as articles in which copyright is alleged to subsist in support of its case. This will be significant when I turn to consider particular features of the products.
6. The issues to be determined are (i) whether copyright subsists in the Claimant’s products; and (ii) whether the Claimant owns the copyright in them.

### **The evidence**

7. There were two witnesses at trial.
8. Ms Fletcher gave evidence for the Claimant. She is a qualified sportswear and fashion designer. She said that her role is to design and create through sketches and graphic drawings new works of art works that can be turned into 3-D items. She is proud of her company and the range of items that the Claimant offers. She is not happy that the Defendant intends to compete with products that she sees a too close to hers.
9. Ms Fletcher explained that there is a wide range of high vis clothing available in the market. It is, for example, widely used in the construction industry where reflective waistcoats are worn over a coat or jacket. In contrast to shapeless vests, she had designed a well-fitting attractive waistcoat that complemented other riding wear. It was priced at a premium over construction-style vests. There is a European Standard EN1150 that applies to high vis clothing of this type.

10. Ms Fletcher set out in her second witness statement lists list of features of the works in dispute. For each item the features were divided into in two parts. She described the first as “Original” features and the second as “Added”. The division arises as a result of the terms of the Order. The original features are those present in earlier versions of the products that the Order excludes from consideration at trial.
11. The original features of the waistcoat included: two-toned shoulder colours; two zipped pockets on a slant; reflective strips of silver tape; elastic sides; open sides; adjustable Velcro tab; front zip not stitched to the bottom of the waistcoat; written warnings on the back e.g. “Pass wide and slow”. Ms Fletcher listed the features added in 2019 (which I assume relate to the waistcoat specified the Order as the 2020 version) as: reflective piping around the Velcro tab; better quality fabric; a more robust zip; new warning writing and two examples, e.g. “Smile you are on camera”; and a camera sign.
12. The features of the original hat band included: 2” reflective tape; elastic stitched under the tape; and silicon under the elastic. The features added in 2020 (which following the Order I take to be 2019) were: an increase in size due to an increase in hat sizes for safety standards; LED lights; a 1” increase in the length of the reflective tape; and a new pattern to the band.
13. The features of the original neck band included: 2” reflective tape; and a metal circle attaching the neck and chest strap. The features added in 2020 (which, again, I take to be 2019) were: a metal triangle replacing the circle; adjustment around the neck with a pull through clasp; a pull through clasp for adjustment under the horse’s leg; and better-quality reflective material.
14. Certain features of the waistcoat arose from the requirements of horse riding. For example, a waistcoat needed to be close fitting to avoid flapping around in use. That was addressed by use of the Velcro tabs to give a fitted structure which also allowed adjustment. To avoid interfering with and abrasion of the rider’s saddle, the waistcoat front zip started some way above the bottom of the garment. That positioning was dictated by the relative positions of the rider and the saddle.
15. The shape of the hat band and horses neck band were largely dictated by the shapes of a riding hat and the anatomy of a horse. The replacement of a ring with a triangle was to make the neck band easier to use.
16. Ms Fletcher has made five trips to China since 2010. She said that she sits with the manufacturers to make the samples of the items she has drawn. She described how the factory staff were amused by her approach of working with them in person. She communicates with them through her drawings and working with CAD machines to create the patterns.
17. There were three points about Ms Fletcher’s evidence which need to be considered.
18. First, it was not clear that Ms Fletcher sought at trial to rely only on the versions of the products set out in the Order. That limits the claim to only particular, recent versions of each of the products. While Ms Fletcher’s written evidence described the changes to each of the three products, as set out above, her submissions at trial related to the items as a whole, including, for example, the zip and pockets of the waistcoat. Ms Fletcher thus approached the matter as one of entire items and not the on the basis of the recently added features alone. Mr Hicks said that this raised an originality problem for the Claimant, because it could not rely on old material to form part of a claim for protection of works of artistic craftsmanship.

19. Second, while it is possible that Ms Fletcher created the entire original versions of her products, it was not clear that she herself created the features added to those original versions which are the subject of the Order. Mr Fletcher said that she created “tech packs” of instructions for the products which she sent to Chinese manufacturers in order to manufacture products to her designs. However, the evidence appeared to show that the manufacturer created at least part of the pack, and that followed the visits she had made to China. Ms Fletcher said that she had software to edit the packs, but it appeared more likely that they originated with the factories, and that Ms Fletcher amended those. It was thus not clear whether she had created the whole items herself; it appeared that the factories were significantly involved and that they followed her instructions.
20. The evidence contained, for example, an email confirmation from a Chinese factory sent in November 2019 that samples of each of three the items had been sent to the Claimant by courier. There was also an email sent in January 2020 attaching the tech packs for each of the items.
21. It appeared that the Chinese factory had introduced replaced the circular ring in the neck band with the triangle.
22. It was also not clear that Mr Fletcher could point to an original work that was her own work rather than work carried out with the involvement of others in the making of the items.
23. Third, the position on ownership of the original items was not clear. Ms Fletcher explained that some of the design work had taken place when she was not employed by the Claimant and that the company had not been in business continuously during the relevant period. While it may have been her intention that the Claimant should own all the relevant rights, it was not clear on her evidence that this was the case.
24. Evidence for the Defendant was given by Mr John Felton, its Managing Director. Given the Defendant’s concession on infringement, there was nothing raised in cross-examination that was relevant to the issues to be decided at trial.

## **The law**

25. Section 1 Copyright, Designs and Patents Act 1988 (the “CDPA”) provides:
  - (1) Copyright is property right which subsists in accordance with this Part in the following descriptions of work –
    - (a) original literary, dramatic, musical or artistic works...
26. Section 4 CDPA provides:

**Artistic works**

  - (1) In this Part “artistic work” means—
    - (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
    - (b) a work of architecture being a building or a model for a building, or
    - (c) a work of artistic craftsmanship.

27. In *Response Clothing Limited v The Edinburgh Woollen Mill Limited* [2020] EWHC 148 HHJ Hacon considered the issue of what is a work of artistic craftsmanship:

32. The meaning [of the term “work of artistic craftsmanship”] was considered by the House of Lords in *George Hensher Ltd v Restawhile Upholstery (Lancs) Ltd* [1976] AC 64, a case concerned with a claim to a work of artistic craftsmanship under the 1956 Act. It is not a straightforward judgment, as has been acknowledged since. In *Lucasfilm Ltd v Ainsworth* [2011] UKSC 39; [2012] 1 AC 208 Lord Walker and Lord Collins (in a combined judgment with which Lord Phillips and Lady Hale agreed) concurred (at [29]) with Mann J's assessment at first instance that it was difficult to identify the true principle of the judgment in *Hensher* and thus a meaning given to 'artistic craftsmanship' by the House of Lords. The Supreme Court in *Lucasfilm* was not required itself to reach a view on the meaning because after the first instance judgment the claimant no longer contended that its Imperial Stormtrooper helmets and armour, the articles in issue, were works of artistic craftsmanship.

33. The meaning was discussed by Mann J at first instance ([2008] EWHC 1878 (Ch); [2009] FSR 2). Having considered *Hensher*, he turned to a judgment from the New Zealand High Court:

"[131] In *Bonz Group (Pty) Ltd v Cooke* [1994] 3 N.Z.L.R. 216 the New Zealand High Court had to consider 'artistic craftsmanship' in the context of woollen sweaters. Tipping J. considered *Hensher* and other authorities and concluded that:

'... [F]or a work to be regarded as one of artistic craftsmanship it must be possible fairly to say that the author was both a craftsman and an artist. A craftsman is a person who makes something in a skilful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal.'

I find that helpful. Having said that, he was prepared to combine the artistry of the designer and the craftsmanship of the knitters and conclude that the sweaters fell within the description, rejecting authorities which tended to suggest that they had to be the same person. That seems to me to be a sensible approach, at least where there is a proper nexus between the two people."

34. Mann J went on (at [133]-[135]) to find that the production helmets and armour required the activity of a craftsman to realise the vision of the creators of the Star War films in which they featured. They were therefore works of craftsmanship, but not artistic craftsmanship. Their purpose was not to appeal to the aesthetic, but rather to give a particular impression in a film.

35. In *Vermaat (t/a Cotton Productions) v Boncrest Ltd (No.1)* [2001] FSR 5 Evans-Lombe J had also agreed with the conclusion of Tipping J in *Bonz Group*, finding that a bedspread design was not sufficiently artistic to be a work of artistic craftsmanship, although he did not give a reason beyond saying that the designs may be pleasing to the eye but did not exhibit the necessary requirement of creativity.

36. Adopting Tipping J's summary of what constitutes a work of artistic craftsmanship, I would have to decide whether the employee of GIN Textile who created the Wave

Fabric was both (a) a craftsman in that he or she made the fabric in a skilful way, taking justified pride in his workmanship and (b) was an artist in that he or she used their creative ability to produce something which has aesthetic appeal.

28. HHJ Hacon considered in further detail the speeches of the House of Lords in *Hensher* and noted at [54] that while the House of Lords would have concluded in 1976 that the work in issue was not a work of artistic craftsmanship, there were no binding principles of law that could be deduced from the decision which compelled the same conclusion in 2020.

29. He considered the position under European Union law (discussed below) and concluded at [64]:

“I will adopt the *Bonz Group* summary definition of a work of artistic craftsmanship with clarifications which I believe to be consistent with the definition: (i) it is possible for an author to make a work of artistic craftsmanship using a machine, (ii) aesthetic appeal can be of a nature which causes the work to appeal to potential customers and (iii) a work is not precluded from being a work of artistic craftsmanship solely because multiple copies of it are subsequently made and marketed. No binding English authority has been drawn to my attention which prevents me from construing s.4(1)(c) in that way.”

30. Mr Hicks argued that this court was not free to ignore the views of their Lordships in *Hensher* and that that decision throws a long shadow. He drew my attention to *Harper v National Coal Board* [1974] QB 614, which was not drawn to the court’s attention in *Response Clothing*. In that case Lord Denning said that a court can only accept a line of reasoning which supports an earlier actual decision of the House of Lords; it cannot accept a decision that shows the House of Lords to have been wrong. In a case where the later court cannot discover the reasoning on which the majority of the House of Lords based their decision, the later court is free to adopt any reasoning so long that that supports the decision of the House. He submitted that the effect of that is that any work that would not have satisfied their Lordships in *Hensher* cannot now meet the statutory test.

31. The role of EU law is governed by the Retained EU Law (Revocation and Reform) Act 2023 (REUL), which came into force on 1 January 2024. By s. 3A2: “any provision of retained direct EU legislation must, so far as possible, be read and given effect in a way which is compatible with all domestic enactments, and is subject to all domestic enactments, so far as it is incompatible with them”.

32. In *Wright v BTC Core* [2023] EWCA Civ 868 Arnold LJ explained at [34] that legislation which transposed an EU directive into domestic law prior to 31 December 2020 remains part of UK law unless and until it has been repealed or amended. The question there was whether Article 2(a) of the Information Society Directive (2001/29) had an effect on copyright protection under the CDPA.

33. At [54] and [55] Arnold LJ held that the starting point is that copyright protection “is liable to apply only in relation to a subject-matter which is original in the sense that it is its author’s own intellectual creation” (see Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569) and that:

“The Court of Justice has elaborated upon the requirement that the work be its author’s own intellectual creation in a number of subsequent judgments. What is required is that the author was able to express their creative abilities in the production of the work by

making free and creative choices so as to stamp the work created with their personal touch: see in particular...Case C-683/17 *Cofemel*—*Sociedade de Vestuário SA v G-Star Raw CV* [EU:C:2019:721] at [30]...

34. In *Cofemel*, the CJEU confirmed its decision in *Levola Hengelo BV v Smilde Foods BV* (Case C-310/17) EU:C:2018:899 that there are two cumulative conditions to copyright protection. First, there must be subject matter that is original in the sense that it is the author's own intellectual creation. Second, the subject matter protected by copyright must be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.
35. In considering the first condition the CJEU ruled that the subject matter must be an expression of the free creative choices of the author, and that where there are technical considerations, rules or constraints that leave no room for creative freedom the subject matter cannot possess the originality required.
36. The CJEU held at [53] of *Cofemel* that the subjective aesthetic effect that may be produced by a clothing design did not meet the second condition because “the aesthetic effect that may be produced by a design is the product of an intrinsically subjective sensation of beauty experienced by each individual who may look at that design. Consequently, that subjective effect does not, in itself, permit a subject matter to be characterised as existing and identifiable with sufficient precision and objectivity, within the meaning of the case-law...”.
37. In *Cofemel* the applicant in the main proceedings sought protection for: “designs [of] sweatshirts and t-shirts, ... compris[ing] a number of elements, inter alia, an image embossed on the front of the sweatshirt, a combination of colours, placement of the pocket on the stomach, and pocket insertions ...’ and ‘[the jeans] design ... characterised by the way in which each of the three different pieces are cut and put together. Using pieces of different lengths and shapes creates a trouser leg with ... three-dimensional (3D) effect, which bends inwards and backwards and which wraps around the wearer’s leg (corkscrew effect). Other aspects which contribute to the “corkscrew effect” are the darts on the knees of the trousers, one on each leg”.
38. The CJEU endorsed the reasoning of the Advocate General at paragraph [60] of his opinion that: “...I take the view that characteristics such as the ‘specific composition based on shapes, colours, words and numbers’, the ‘combination of colours’, the ‘placement of the pocket on the stomach’ or even ‘the way the jeans are made by assembling the three pieces’, which *Cofemel* is alleged to have copied, should be analysed as ideas capable of being expressed differently, or even as practical solutions, and should not be protected by copyright”.
39. In *Brompton Bicycle Brompton Bicycle Ltd v Chedech/Get2Get* C-833/18 the CJEU held that:

[20] By its two questions, which it is appropriate to examine together, the referring court asks, in essence, whether Articles 2 to 5 of Directive 2001/29 must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is, at least in part, necessary to obtain a technical result.

...

[26] It follows that a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical

considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices.

40. Mr Hicks also relied on the decision of Robert Walker J (as he then was) *Biotrading and Financing Oy v Biohit Limited* [1996] FSR 393 as authority that where the Claimant did not rely on earlier versions of a work, it could not claim originality in material that formed part of an earlier version; it could rely only on the changes made to the earlier version. In this case the changes recorded above were not sufficient to amount to works of artistic craftsmanship.

## **Discussion**

*Which items are in dispute?*

41. Following *Biotrading*, I should consider only the amendments made to the works which are described above. That is because under of the terms of the Order the earlier material is not relied upon. The Order restricted the Claimant from relying on any earlier version of the products than those made in 2019 and 2020. This prevents the Claimant from relying on the earlier versions of the designs and limits the claim to only those features added to the 2019 and 2020 versions.
42. As I have noted, it appeared at trial that Ms Fletcher had not fully appreciated the significance of this limitation on the claim. There was no significant discussion of this point. In my view the claim is limited to the recent versions, but in case I am wrong about that I will also consider the matter on the alternative basis that the earlier versions of the works described by Ms Fletcher as “Original” are in dispute.

*Does copyright subsist in the Claimant’s products?*

43. Ms Fletcher’s position was straightforward. She is a qualified artist and she works as a craftsman. The works in issue are thus all works of artistic craftsmanship. She relied on the result in *Response Clothing* to show that items like those in this case can be protected.
44. It is in my view not possible to draw from the decision in *Response Clothing* (or the other cases cited) any principle about 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.
45. Mr Hicks submitted that the works fell outside the definition of the term in section 4(1)(c) CDPA because of their nature. He submitted that as well as failing because of the nature of the items, the use of CAD tools to create them went beyond what was permissible in the creation of such works.
46. In my view the use of tools is not a bar to a claim for protection of a work of artistic craftsmanship. This point also has relevance to the question of ownership which I consider below.
47. Mr Hicks said that the position was the same whether analysed under the cases on the CDPA alone or also considering the EU law approach.
48. I consider first the Claimant’s amendments to the products as described above. In my view none of the three works is a work of artistic craftsmanship. That is for the following reasons.



49. The features added to the waistcoat in 2020 as described in Ms Feltcher's evidence do not amount such a work either under EU law or, if it is to be read in a different way, the wording of the CDPA. The reflective piping around the Velcro tab is a variation to a larger, pre-existing item. If the waistcoat is to be high vis then material needs to be in a place in which it will reflect. There are a number of places in which such material could be applied. The nature of the waistcoat as a work for the purpose of this analysis does not appear to have been changed in a copyright sense by the use of different quality fabric and zip. The new logos and wording applied to the waistcoat are functional improvements to improve visibility that could be made in a number of ways; they do not reflect the author's personality as required. Considered individually and taken together, the added features do not amount to a work as required by *Cofemel*. The pre-existing waistcoat dictated the positions that changes could be made to it. The changes, are as the Advocate General put it in *Cofemel*, "practical solutions" which can be expressed differently and so are not protected by copyright. An analysis under the older UK law gives the same result. The additions do not amount to a work of artistic craftsmanship because they were not the work of a craftsman.
50. While the fact that there is a technical standard for this type of clothing is not determinative of the issue, it confirms that the waistcoat is a functional item with particular requirements set for it that will have an effect on what can be made that will comply the relevant regulation.
51. The LED lights added to the hat band in 2019 were also a practical solution to achieve greater visibility, and the inclusion of a new material for the band and an increase in length did not make that a work of artistic craftsmanship but addressed the fit required by a hat. Taken together these matters do not amount to an original work under *Cofemel*. They are not a work of artistic craftsmanship under the CDPA.
52. The features added to the neck band in 2019 were all functional improvements for better performance. The metal triangle in the band replaced a metal circle. The addition of clasps for better adjustment and better-quality reflective material are not a work of artistic craftsmanship. Taken together they do not lead to a work that qualifies for protection. They do not amount to an original work under *Cofemel*. They are not a work of artistic craftsmanship under the CDPA because it is not clear that Ms Fletcher was both an artist and a craftsman in the creation of the work.
53. In case I am wrong to consider only the new features of the pleaded products, I turn to the entire items.
54. The waistcoat has features that make it more attractive in the equine market than a mass market builder's vest, but they respond to the requirements of the specific use in horse riding for which the waistcoat is intended. It is fitted so that it does not flap about in use, and it is given its shape by the Velcro tabs. The pockets need to be accessible when the rider is astride a horse and so are placed at a slant. The zip does not reach the bottom of the waistcoat so that it will not abrade the saddle. These design matters are dictated by the function of the item and are practical solutions to the problem of making a high vis jacket for a horse rider. The features do not reflect the author's personality are not the work of a craftsman; they are solutions to design issues. The waistcoat does not meet the test of an original work in *Cofemel* because they are practical solutions that could have been expressed differently. The waistcoat is not the work of an artist and craftsman under the CDPA.
55. Similarly the hat band and neck band are each made of reflective material adapted to fit the specified use as a hat band or a horse's neck band. These are functional items that are dictated

by form. They are not original in the sense of *Cofemel* are they are not works of an artist and craftsman under the CDPA.

56. It follows that I do not have to decide whether following *Harper v National Coal Board* the House of Lords in *Hensher* would agree with these conclusions, although it appears that they would.
57. I appreciate that Ms Fletcher genuinely considers that she has created a valuable market segment in high vis apparel for riders and that her products deserve copyright protection. That does not, however, mean that the test for copyright protection has been met.

*Does the Claimant own copyright?*

58. It follows from my finding that none of the items in dispute is a work of artistic craftsmanship that I do not need to decide the question whether the Claimant owns copyright in the works.
59. If I had to do so (and on the assumption that there were relevant rights), I would hold that the Claimant had not in this case established that it owns rights in the original works. They were all created some time ago and in evidence Ms Fletcher accepted that the Claimant did not have a continuous ownership of the business. She explained that she had started creating the items before working through the Claimant, and there was a reorganisation of her business that did not involve the Claimant. The position on ownership is thus unclear and on balance the Claimant did not prove ownership.
60. The position in relation to the pleaded works is also complicated. The evidence also showed that the replacement of the ring in the neck band with a triangle was a collaboration between Ms Fletcher and the factory with which she worked. It appears that Ms Fletcher instructed the factory what to fit and that they then did the work. It is not clear that Ms Fletcher created that work on her own, or that any rights that might belong to the factory have been transferred to the Claimant.
61. The remaining items appear to follow from design documents which Ms Fletcher produced while she was in China. The items were likely to have been produced in collaboration with the factories.

**Conclusion**

62. The claim fails because the works do not qualify as works of artistic craftsmanship under the CDPA. If they did qualify, the Claimant has failed to establish ownership of the rights.

## Annex

Waistcoat, left; Hat band, upper right; Neck band, lower right



Images taken from a tech pack

Waistcoat – front and back, showing Velcro tabs



Hat band



Neck band

