



BL O/128/06

Copyright Designs  
and Patents Act 1988

22 May 2006

BETWEEN

Louise Block

Claimant

and

Bath Aqua Glass Limited

Defendants

PROCEEDINGS

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Reference under section 246 in  
respect of certain design rights

HEARING OFFICER

Peter Hayward

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## DECISION

### ***Background***

- 1 This dispute is concerned with the subsistence of design right in glass jewellery. Both the parties in this dispute, Louise Block and Bath Aqua Glass Limited, are designers and manufacturers of jewellery.
- 2 In December 2003, Ms Block launched an action in Bristol County Court against Bath Aqua Glass claiming primary and secondary infringement of design right in her range of striped glass pendants. The action was stayed *sine die* by an order directing that the parties refer to the Comptroller the preliminary issue of subsistence of design right under section 246 of the Copyright, Designs and Patents Act 1988 ("the Act"). Ms Block accordingly launched the present action, naming Bath Aqua Glass as the other party to the dispute.
- 3 Following the filing of evidence by the parties, the matter came before me on February 22 2006. At the hearing, Ms Block was represented by Mr Nick Wallin from Withers and Rogers and Bath Aqua Glass was represented by Mr Robert Franks from Franks & Co.

- 4 I should explain that both parties had initially been unrepresented. With the parties' agreement, I had approached the Chartered Institute of Patent Agents for assistance, and as a result Mr Wallin and Mr Franks agreed to take the case on a *pro bono* basis. I would like to thank them both for doing this especially as the case relates to an area of law, design right, that is not run-of-the-mill even for experienced attorneys. I believe that both parties' cases have been stronger for their participation.

### ***The Law***

- 5 Before getting into the detail, it will help if I set out the statute law. I will deal with the case law when I consider the arguments on specific aspects.
- 6 Section 246 of the Act reads as follows:

A party to a dispute as to any of the following matters may refer the dispute to the comptroller for his decision –

- (a) the subsistence of design right,
- (b) the term of design right, or
- (c) the identity of the person in whom design right first vested;

and the comptroller's decision on the reference is binding on the parties to the dispute.

The present dispute is concerned with subsistence and the term of design right only. No issues arise in respect of subparagraph (c).

- 7 The relevant part of the Act dealing with subsistence is section 213 which reads:

(1) Design right is a property right which subsists in accordance with this Part in an original design.

(2) In this Part "design" means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article.

(3) Design right does not subsist in—

- (a) a method or principle of construction,
- (b) features of shape or configuration of an article which—
  - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or
  - (ii) are dependent upon the appearance of another article

of which the article is intended by the designer to form an integral part, or

(c) surface decoration.

(4) A design is not "original" for the purposes of this Part if it is commonplace in the design field in question at the time of its creation.

(5) Design right subsists in a design only if the design qualifies for design right protection by reference to—

(a) the designer or the person by whom the design was commissioned or the designer employed (see sections 218 and 219), or

(b) the person by whom and country in which articles made to the design were first marketed (see section 220),

(6) Design right does not subsist unless and until the design has been recorded in a design document or an article has been made to the design.

Whilst I have quoted the whole of section 213, I should say that subparagraphs (5) and (6) do not give rise to any contentious issues in the present case.

8 Finally, term of design right is covered by section 216, which reads:

(1) Design right expires—

(a) fifteen years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever first occurred, or

(b) if articles made to the design are made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.

(2) The reference in subsection (1) to articles being made available for sale or hire is to their being made so available anywhere in the world by or with the licence of the design right owner

### ***The claim to design right***

9 I will now turn to the design in which rights are claimed. An important point to note in Section 213 is that design right does not reside in articles *per se*, but in aspects of the shape and configuration of articles. This was emphasised by Mummery LJ in *Farmers Build Ltd v Carrier Ltd* [1999] RPC 461 at page 483 where he said:

*“But the legislation does not confer the design right on the article: the design right is conferred on the aspect of the shape and configuration of the article. A commonplace article may have a shape and configuration which is not commonplace. The nature or character of the article must not be confused with the aspects of shape and configuration of the article. Design right does not, for example, subsist in a fork: it subsists in an aspect of the shape and configuration of the handle or the prongs of a fork.”*

- 10 Thus in seeking to establish design right, the burden is upon the claimant to specify in full and precise terms, those aspects of shape and configuration in which he or she wishes to exercise rights. This was expressed concisely by Mummery LJ in *Farmers Build* at page 484, where he said, in deciding that design right did not subsist in a particular subassembly of a machine on the grounds that no specific claim for design right had been pleaded in respect of the particular sub-assembly:

“This claim highlights the importance in design right cases for the plaintiff to identify as precisely as possible what he claims to be his original design. The burden is on the plaintiff to identify (a) the relevant aspects of the shape and configuration of the article and (b) what is original about the design. The evidential burden shifts to the defendant to allege and to adduce evidence showing that, although a design is original in the sense that the designer originated it, it is commonplace in the field in question. But the legal burden remains on the plaintiff throughout.”

- 11 In her statement of case, Louise Block claims design right as follows:

“With reference to Annex 1, design right is claimed in the following particular aspects of shape or configuration of the Design, being an item of glass jewellery having:

- a) a generally planar glass component that is substantially quadrilateral in shape having upper and lower major surfaces and at least a first set of opposed substantially parallel sides, the component being apportioned into at least two parts, each part:
  - i) having different material properties such that in the visible light spectrum each part has a different colour from its adjacent part; and
  - ii) is of a shape having a boundary with the or each adjoining part which is substantially straight, that segments the component substantially perpendicular to the two opposed parallel sides, and that connects said sides; and
- b) an attachment means for suspending the component from a chain or the like, the attachment means being located on and extending outwardly from a side of the component other than either of the two opposed parallel sides.

Further or alternatively, the Design further comprises the aspects and configuration relating to:-

- c) The attachment means being mounted on the component such that no non-transparent part of the attachment means extends beyond the plane of the side of the component upon which the attachment means is mounted into or onto the component.”

I shall refer to the above statement as “the claim to design right”.

- 12 Annex 1 is a collection of 35 colour photographs of various items of jewellery all purporting to have the characteristics mentioned above. I include below an extract from the Annex, but I was also given some samples. I should mention that although it might not be wholly clear from the picture below, the glass bodies are transparent. Given the reference to “transparent” in paragraph c) of the statement of design right, I am sure this was assumed to be implicit in the reference to “glass” in paragraph a), but it is worth mentioning because glass isn’t necessarily transparent. (Some of the darker-coloured portions would probably be more-accurately described as translucent, but I don’t think there is any issue over that.)



- 13 Mr Wallin clarified the claimant’s position at the hearing by saying there was no claim in respect of aspects of the shape or configuration of the fitting itself (shown as a silver bail in the picture) that allows the pendant to be attached to a chain or the like, nor (despite the use of the word “alternatively” in the preamble) was it being claimed that there was design right in aspect c) in isolation, that is, without a) and b). Rather paragraph c) should be construed as claiming a further aspect of shape or configuration set out in paragraphs a) and b) should it be found that no design right subsists in the combination of a) and b). Accordingly, for the moment I am going to take the claim to design

right to be for a) and b) alone. I will come back to the status of c) later. No other feature of the fitting such as for example the orientation of the opening through which a chain may pass is subject to any claim.

### ***The evidence***

- 14 Both sides submitted written evidence on the question of originality. The claimant for her part submitted four witness statements each of which was in the prescribed form. The defendants submitted a variety of documents, a number of witness statements including statement of truths, documents claiming to be witness statements but lacking similar statements of truths and a number of other documents. I will discuss their relevance and admissibility in more detail when I come to the issue of originality.
- 15 None of the witnesses was subject to cross examination. Their reliability has not therefore been tested which means, as I explained to Mr Wallin and Mr Franks, that I cannot rate any of them as more or less credible than the others. I must simply take their evidence at face value.

### ***Subsistence of Design Right***

#### **Shape or configuration**

- 16 Subsection 2 of section 213 defines “design” as the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article. The first thing I need to do is decide whether the features of the jewellery in which design right is claimed are aspects of shape and configuration. Mr Wallin contends that they are. Mr Franks however disagrees. He argues in particular that the aspect of the design set out in paragraph a)(i) of the claim to design right, namely that each of the parts has “different material properties such that in the visible light spectrum each part has a different colour from its adjacent part” is not a feature of shape or configuration. So who is right?
- 17 A major part of Mr Franks’ argument is that the material properties of an article cannot be considered a feature of shape or configuration of that article. He relies in this respect on the following statement by Mummery LJ in *Scholes Windows Ltd v Magnet Limited* [2002] E.C.D.R 20 :  
  

*“The definition of “design in subsection (2) [of section 213] covers any aspect of the shape or configuration of the whole or part of an article. The definition of design does not incorporate, either expressly or by implication, the nature or purpose of the article itself or the material structure of the article.”*
- 18 Mr Wallin contends that it is not right to draw a conclusion from this single sentence that material properties or material structure cannot be considered as shape and configuration. This statement, he argues, was made in the context of an examination of what was the relevant “design field”. One side was

claiming it was the field of windows in general whilst the other claimed it was limited to U-PVC windows. This question had a bearing on whether the designs in question, which were made from U-PVC, were commonplace on the basis of similar designs made essentially from wood.

- 19 What I understand Mummery LJ to be saying in this case is that if two designs look the same, it is not possible to argue that one is shaped or configured differently to the other because it is made out of a different material. Hence in the present case, if it was shown that jewellery similar to Ms Block's but made of Perspex™ was commonplace, it would not be possible for Ms Block to argue that hers were not in fact commonplace because they were instead made of glass.
- 20 That however does not mean that the properties of a material can never be an aspect of configuration. For example, it is difficult to see how the configuration of a window could be defined without any reference to which parts are transparent and which parts are non-transparent, so in this context material properties matter greatly when considering configuration. It is a question of giving the expression "configuration" its ordinary meaning in the particular context. In doing this, one must avoid the danger of taking an interpretation that is right in one context and applying it without thought in another.
- 21 The material properties that Ms Block relies on are that the body of the jewellery is made of glass and that the parts are of different colours. Whilst as I have indicated above, I do not consider that the choice of glass as against other optically-similar materials can be considered an aspect of configuration, the use of a transparent rather than opaque material is in my view rightly an aspect of configuration in the context of this jewellery. I say that because the fact that you can see into or through the body of the jewellery is crucial to its design – you would have jewellery that was visually completely different if it was opaque. (In saying that, I am conscious that design right is not solely about visual appearance, but in the context of jewellery, visual appearance is clearly pretty important.)
- 22 The issue of colour in design right has already been considered by the Court of Appeal in *Lambretta Clothing Co Ltd v Teddy Smith* [2005] RPC 6. It was perhaps surprising that the defendants did not refer me to this particular case in their skeleton argument, but I brought it to their attention at the hearing because I considered it to be the most relevant of a limited number of available authorities that have dealt with the issue of colour. I should stress that both sides were content with the time that I gave them during the course of the hearing to consider this precedent.
- 23 At the heart of *Lambretta* is a track-top. The shape of the garment was old but the designer had introduced new colours, blue for the body, red for the arms and white for the zip. These were referred to as the colourways. He had also incorporated white stripes and had added the "Lambretta" logo at two places, but these were held to be purely features of surface decoration and hence were ignored as they fell within the exclusion provided in s213(3)(c). This left Jacob LJ to consider whether the selection of colourways for a pre-existing

design of track-top is “the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article”. To answer this question he explored the interpretation of “shape or configuration” in prior cases relating to unregistered design right (UDR). He also took account of how “shape and configuration” had been interpreted in registered designs cases noting:

*“It is impossible to think that the draftsman had in mind two distinct meanings for these terms, one for UDR and one for registered designs.”*

He concluded:

*“Thus the upshot of all the registered design cases is that for over a century no one has ever held that merely colouring an article in a novel way amounts to “shape or configuration.”*

- 24 He then went on to consider Lambretta’s contentions on the issue of colour in particular their submission that the words “configuration ... of an article” can cover the mere colouration of parts of an article such that it would not be an abuse of language to say the red, blue and white components of the Lambretta top were “configured” together. He observed:

*“That is true but beguilingly simple - the truth is that the components are indeed configured to produce the ultimate complete article but their colour has nothing to do with that configuration.”*

He concluded that the mere choice of colourways for a standard track-top was not an aspect of the shape or configuration of an article or part of an article.

- 25 Mr Franks submitted that *Lambretta* provided authority for not treating colour as an aspect of shape or configuration. Mr Wallin, on the other hand, sought to distinguish the present case from *Lambretta* by arguing that at the heart of the *Lambretta* track-top was a piece of clothing the shape of which was known. Here he argues we have “pieces of glass which have different material properties, which yes lead to a different colour but which are still different pieces of glass that have been put next to each other in a certain way to produce a particular shape and configuration”. There are, he contests, features of shape and configuration that go further than just mere colour of a known article.

- 26 I have considered *Lambretta* very carefully, and have come to the conclusion that Mr Wallin is right and that the present case is distinguished from it. In *Lambretta* there was an attempt to take what the ordinary person would have considered to be surface decoration (and thus outside the ambit of design right) and dress it up as “configuration”. The court, not surprisingly, threw out that approach, and it is in that context that the court held that the mere choice of colourways was not an aspect of shape or configuration. However with the present jewellery I do not feel we have ‘mere’ choice of colourways. Giving the word “configuration” its ordinary meaning in the context of this jewellery, the juxtaposition of two (or more) differently coloured transparent parts is in my



view quite properly treated as an aspect of the configuration.

- 27 There is a further distinction from *Lambretta* in that the claimant here does not seek to define the at least two adjoining parts of her design by reference to specific colours. She merely requires the colours to be different. However, I am reluctant to make much of this distinction because in *Lambretta* the court was not asked to consider a track-top where the sleeves were one unspecified colour, the body another and the zip another, and I do not know what conclusion they would have come to if they had.

### **Surface Decoration**

- 28 Mr Franks argues that colour is also excluded from the definition of design as it is “surface decoration”. Again he relies on *Lambretta*. There Jacob LJ, having decided that the colourways were not aspects of shape or configuration, went on to rule that they were also covered by the exclusion of surface decoration. In particular he noted that

*“ . . . the exclusion of surface decoration from the scope of UDR must cover this case. It is true that the parts of the garment are dyed right through, but any realistic and practical construction of the words “surface decoration” must cover both the case where a surface is covered with a thin layer and also where the decoration, like that in Brighton rock, runs throughout the article. To hold otherwise would mean that whether or not UDR could subsist in two different articles having exactly the same outward appearance, depended on how deep the colours went. Parliament cannot have intended anything so capricious”*

- 29 Mr Wallin suggested that considering surface decoration in this way might be relevant to articles that wear away or as in the case of Brighton rock are dissolved away but it is not relevant to glass jewellery. I confess I found it hard to follow that reasoning. But nevertheless I think Mr Wallin is right in his broad position that the design at issue here does not include aspects that would fall foul of the surface decoration exclusion. If Ms Block were claiming design right in a piece of jewellery with different coloured opaque stripes painted on it, those stripes would have clearly been surface decoration. Following *Lambretta* she would not have been saved if instead of painting on the stripes she had produced the same result by instead gluing together pieces of differently coloured opaque material. However, she is claiming neither of these. Because her jewellery is of glass, the feature that immediately strikes you when you look at a sample (and I admit this is less evident in the pictures) is the fact that the colours do not just have a surface effect. This is where the transparency of the parts is crucial: you can see into and through the body of the jewellery, and the different parts have different, three-dimensional optical effects. That is what gives the jewellery its character, and because of that it is quite different from a striped but opaque body. This is more than surface decoration, even taking into account *Lambretta*.
- 30 Mr Franks did put forward an argument that the internal boundaries between the different layers were themselves “surfaces”. That argument might be valid

if design right were being claimed in each layer individually, but it is not. Design right is being claimed in the object as a whole, so for the purposes of construing the expression “surface decoration” it is the surfaces of the object as a whole that matter.

### **Method of construction**

- 31 Mr Franks put it to me that, in the art of glass fusing, it is common to test the compatibility of various pieces of glass by placing these pieces on to a further strip of glass and then fusing the arrangement. If the various pieces of glass crack then this shows that they are not compatible. If they were compatible, then the result of this test would, he said, be a fused body of glass that fell within the scope of the claimed design. Mr Franks sought initially to use this argument to show that the claimed design is excluded as a method of construction. However as he conceded at the hearing it is, if it is anything, an argument about commonplace. Indeed it is essentially the argument put forward by Mr Mikelledes which I discuss below.
- 32 Mr Wallin in addressing the question of whether the claimed design is excluded as a method of construction directed me to an earlier decision of mine, *Christopher Ronald Tasker*<sup>1</sup>, where at paragraph 30 I had stated:

*“In essence, as I understand it, what both the learned judges were saying was that it may be possible to obtain protection for a particular shape or configuration which arises from a particular mode or principle of construction; however, on the other hand, where the mode or principle of construction leads to the manufacture of articles with a shape or configuration which may be capable of variation within wide limits, then, to allow protection for such a general conception of shape or configuration would effectively be giving protection to a mode or principle of construction, and such protection was not allowable under the statute. I consider that approach must be equally valid for design right.”*

- 33 Mr Wallin believes that the aspects of shape and configuration for which design protection is sought in this case are sufficiently well defined and do not permit wide variation. They therefore do not in his opinion relate to a method of manufacture. I agree with Mr Wallin on this point.

### **Must-fit exception**

- 34 Section 213(3)(b) provides that design right does not subsist in features of shape or configuration of an article which enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part. These are generally referred as the must fit and must match exceptions.

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<sup>1</sup> [2000] BL O/184/00

- 35 In this case Mr Franks sought to argue that the glass protrusion extending from one of the surfaces of the planar glass component, which is provided in Ms Block's jewellery to enable the planar component to be attached to the metal fitting (a silver bail), is excluded under the must fit exception together with the design of the metal fitting itself.
- 36 In fairness to Mr Franks, I should say that this argument was raised before Mr Wallin had clarified that there is no claim in respect of the fitting, the general design of which he conceded was commonplace, or in any particular aspect of the attachment means other than in respect of its location on and extending outwardly from a side of the component other than either of the two opposed parallel sides. Such a location would ensure that the stripes extend generally horizontal when the jewellery is worn.
- 37 Therefore the only issue I need decide is whether this particular positioning of the fitting is excluded under this exception. Although neither side put forward any case law on this point, I think it is well established that the provision seeks only to exclude those aspects of the shape and configuration of articles that enable those articles to be connected together so that they can perform their function. It is not intended to cover those aspects of the shape and configuration of these articles that do not enable them to be connected together. Hence here, although the shape of the glass protrusion and the shape of the opening in the fitting to accommodate it may be excluded, as may be the opening in the fitting through which a chain might pass, other aspects of the shape and configuration of these articles such as the overall external shape of the fitting would not be excluded. This would include the positioning of the fitting on the planar part of the jewellery.
- 38 Therefore I am satisfied that no aspect of the design right as claimed is covered by section 213(3)(b).

### **Original - principles**

- 39 Under section 213(1), design right protection is only available to original designs. Section 213(4) goes on to state that a design is not original if it is commonplace in the design field in question at the time of its creation. There does not seem to be any real dispute that the design in field in question is jewellery. Equally there does not seem to be any significant dispute that the time of creation of the particular jewellery by Ms Block was around 2001. Therefore what matters is what was commonplace in 2001, not what is commonplace now. By the same token, in my view what was commonplace 10, 100 or 100 years prior to 2001 must also be irrelevant.
- 40 Both Mr Wallin and Mr Franks referred me to the guidance provided in *Farmers Build Ltd* on how I should determine whether a design is original. In that case Mummery LJ states:

*"In the light of the language, context and purpose of section 213(4), what is the proper approach of the court faced with the issue that the design of an article is not original because it is alleged to be 'commonplace'?"*

*(1) It should compare the design of the article in which design right is claimed with the design of other articles in the same field, including the alleged infringing article, as at the time of its creation.*

*(2) The Court must be satisfied that the design for which protection is claimed has not simply been copied (e.g. like a photocopy) from the design of an earlier article. It must not forget that, in the field of designs of functional articles, one design may be very similar to, or even identical with, another design and yet not be a copy: it may be an original and independent shape and configuration coincidentally the same or similar. If, however, the court is satisfied that it has been slavishly copied from an earlier design, it is not an 'original' design in the 'copyright sense' and the 'commonplace' issue does not arise.*

*(3) If the court is satisfied that the design has not been copied from an earlier design, then it is 'original' in the 'copyright sense'. The court then has to decide whether it is 'commonplace'. For that purpose it is necessary to ascertain how similar that design is to the design of similar articles in the same field of design made by persons other than the parties or persons unconnected with the parties.*

*(4) This comparative exercise must be conducted objectively and in the light of the evidence, including evidence from experts in the relevant field pointing out the similarities and the differences, and explaining the significance of them. In the end, however, it is for the court and not for the witnesses, expert or otherwise, to decide whether the design is commonplace. That judgment must be one of fact and degree according to the evidence in each particular case. No amount of guidance given in this or in any other judgment can provide the court with the answer to the particular case. The closer the similarity of the various designs to each other, the more likely it is that the designs are commonplace, especially if there is no causal link, such as copying, which accounts for the resemblance of the compared designs. If a number of designers working independently of one another in the same field produce very similar designs by coincidence the most likely explanation of the similarities is that there is only one way of designing that article. In those circumstances the design in question can fairly and reasonably be described as 'commonplace'. It would be a good reason for withholding the exclusive right to prevent the copying in the case of a design that, whether it has been copied or not, it is bound to be substantially similar to other designs in the same field.*

*(5) If, however, there are aspects of the plaintiff's design of the article which are not to be found in any other design in the field in question, and those aspects are found in the defendant's design, the court would be entitled to conclude that the design in question was not 'commonplace' and that there was good reason for treating it as protected from misappropriation during the limited period laid down in the 1988 Act. That would be so, even though the design in question would not satisfy any*

*requirement of novelty in the Registered Designs legislation."*

### **Original in the copyright sense**

- 41 I will deal first with points (1) and (2). The question I need to ask is whether Ms Block simply copied an earlier design. Mr Franks contends that she did and in particular she copied the design from a book entitled "Glass Fusing Book One" by Boyce Lundstrom. He referred me specifically to a particular figure, figure 125 on page 57. This figure shows a range of glass jewellery including a pair of oblong like ear-rings having black or dark brownish stripes.
- 42 Mr Wallin contends that the shape of these ear-rings differs in a number of significant ways from the design at issue here. For example the overall shape of the ear-rings in the Lundstrom book is more rounded as opposed to the required "substantially quadrilateral" in Ms Block's designs. According to him, the stripes also do not clearly extend substantially perpendicular to the two opposed parallel sides nor do they clearly connect these two sides.
- 43 The designs shown in Annex 1 of the statement of claim are not sharply-defined quadrilaterals. Whilst they all have vertical sides that are substantially (though not absolutely) straight, their top and bottom edges show varying degrees of rounding. Thus it is clear that the term "substantially quadrilateral" needs to be interpreted with a certain degree of elasticity. However, even allowing for that elasticity, I agree with Mr Wallin that the design of the ear-rings in the Lundstrom Book is different from the design claimed here and illustrated in Annex 1. The stripes are not as straight, and the overall shape is noticeably more rounded. It is, I admit, a question of degree, but jewellery is a heavily-worked field, and in such a field even small differences are often significant. I do not believe a reasonable person would look at the Lundstrom earrings and the designs in Annex 1 and say one is a copy of the other.
- 44 Even if the ear-rings were the same as Ms Block's design, to prove copying it is also necessary to show that Ms Block did copy, or on balance of probabilities is likely to have copied, her design from this book. Mr Franks said that this book was a text well known in the field. He did not however put forward any evidence to support this view. He did not for example demonstrate that it was widely available in the UK (the book is a US publication), that it was widely referred to in the field, that it was a standard text book for students in the field or anything else along these lines. In the absence of any such evidence it is simply not possible for me to infer on any reasonable basis that even if the design was the same, Ms Block copied her design from this book.

### **Commonplace**

- 45 Having satisfied myself that the design is original in the copyright sense, I now need to consider the second test set out in paragraphs 3-5 of the passage from *Farmers Build Ltd* quoted above, namely is the design commonplace? For that, I must turn to the evidence submitted by both sides.

- 46 Mr Wallin rightly said that in assessing the value of the evidence, I should have regard to the following from comment from Jacob LJ in *Lambretta*:

*"I turn to experts. Both opined on the ultimate question commonplace or not. This is technically admissible by virtue of the Civil Evidence Act 1972 although the question is really for the judge. I recently said in a patent case, Rockwater v Technip Francer-*

*Because the expert's conclusion (e.g. obvious or not) as such although admissible, is of little value it does not really matter what the actual attributes of the real expert witness are. What matters are the reasons for his or her opinion?*

*That is particularly true of opinions as "commonplace". What really matters is what prior designs the experts are able to identify and how much those designs are shown to be current in the thinking of designers in the field at the time of creation of the design in question.*

- 47 The point Jacob LJ makes is very pertinent in the present case. Neither the claimant's nor the defendants' witnesses had sought to compare the design in question with what was current in the thinking of jewellery designers in or around 2001. Rather they relied on bald statements to the effect that Ms Block's design is or is not commonplace. Such statements are of very limited value unless they are substantiated with an explicit and detailed analysis of the type that Jacob LJ refers to and was envisaged by Mummery LJ in *Farmers Build*. I will nevertheless look at what the various witnesses have said in the light of comments from Mr Wallin and Mr Franks.
- 48 I will start with the two witnesses for the claimant, Lorraine Coles and Benedict Wallis. Ms Coles is the owner of a craft gallery that sells a range of craft based goods including jewellery. She established the gallery 22 years ago. She also regularly attends trade fairs and receives trade publications and claims that she is very aware of trends and fashions in the area of jewellery and glass products. She goes on to claim that the striped rectangular pendants are "original" and that she does not "recall having seen anything similar before stocking them in 2001".
- 49 Mr Wallis was the manager from February 1999 to April 2003 of a shop that sold goods from local artists and craftsmen including Ms Block. He claims to have bought pendants according to the claimed design from the claimant on 22 August 2001. He goes on to claim that he considered the design to be "unique" and that he had never seen other work which was "in any way similar to these striped glass pendants".
- 50 Mr Franks questioned whether these people were able to really assist on the question of commonplace given that they were involved solely in retailing rather than designing. I find this to be a tenuous argument at best. Whilst clearly what matters is what is current or commonplace in the mind of the designers, it seems inconceivable that that current thinking would also not be reflected in the marketplace and therefore also accessible to retailers.

- 51 He also questioned the limited experience of Mr Wallis in the field noting correctly that he only had two years experience prior to the generally agreed date of creation of the design in question. It is of course possible that Mr Wallis spent those two years doing extensive research on the field, visiting countless other shops and trade fairs, reading endless publications and talking to numerous designers. If he had done all of those then he may well have been in a position to pass authoritative judgment on what was or was not commonplace. The simple fact is that I have no idea of on what basis Mr Wallis is making his assertion that the design is “unique”. Nor do I know what aspects of the design he considers to be unique. Neither he nor for that matter Ms Coles give any detail of what they considered to be commonplace in 2001 or of which features of Ms Block design were not commonplace at that time. Hence neither of these statements really assists me in determining whether the design is or is not commonplace.
- 52 I turn now to the defendants’ evidence on commonplace which comprises observations from a number of people. Only some of these, as I mentioned earlier, are in the form of witness statements, but I will gloss over that.
- 53 I will start with letters from a Michael J McCoy and a Mr Veit Hermesmeier. Both of these go to the issue of whether the design of the fitting is commonplace. The design of the fitting is not however subject of any claim to design right and since neither of these documents discusses whether the positioning of the fitting as claimed is commonplace, I do not need to consider them any further.
- 54 Also submitted was a letter from a Miss Jody Cory who is a goldsmith of 19 years experience. She states that it is commonplace to have pendant caps attached to glass. Mr Wallin was content to accept this, but pointed out correctly that it did not address the specific aspect of the claim in regards to the fitting which is the particular positioning of the fitting on the item of jewellery. Thus this evidence too is of no assistance to me.
- 55 Ms Nina Bulley, in her witness statement, states that she has been making glass jewellery since “about 2000” and has been fusing glass for “about 8 years”. She claims in her professional opinion that “rectangular shaped glass pendants with slightly rounded corners and bottle-necked protrusions positioned at the top for clasps and fixings have been commonplace items in the jewellery trade”. Even if all that was true, and she has not provided any supporting evidence, it would still not show that the particular claimed design is commonplace. She also claims to have made similar shaped items in “about 1999/2000” and to have also seen “this shape of jewellery on the internet” around that time too. Mr Franks sought to argue that an internet publication is a very penetrative publication in that it provides access to anybody with a computer. That may be so but it doesn’t follow that the content is commonplace. In any case, Ms Bulley doesn’t say that the aspects specified in the claim to design right were commonplace – she only refers to a limited number of features such as the overall shape and is silent on all the other aspects.

- 56 Witness statements were also submitted by two directors of the respondent, Annette Martin and Themis Mikellides. Ms Martin has been working in glass since 1985. She refers to various products manufactured by herself and her brother and in particular drop earrings and pendants with silver cupped bails on them. However, there is nothing in what she says to suggest that what she and her brother made included the aspects set out in the claim to design right. She goes on to describe how through visits to various fairs and shows she has been able to see “many different versions of fused rectangular tab pendants by different artists since opening my shop in 1996 and before”. , but she does not particularize this rather-vague statement and certainly does not identify any specific examples. She concludes by stating that “In my professional opinion, fused rectangular glass pendants, stripy in colouration, are a commonplace item and have been since at least 1996 when I became aware of them”. However, as Jacob L J said in *Lambretta*, assertions like this are of little value. What I need are the reasons for that opinion, and without them, her evidence gets me nowhere.
- 57 Mr Mikelledes notes that during his HND course in glass from 1990 to 1994 he was taught about fusing by making test stripes. These were made by laying stripes of coloured glass onto a long rectangular base piece of glass. This was then fired in a kiln to produce rectangular tabs having slightly rounded edges. He goes on to say that many of his fellow female college students turned these test stripes into jewellery. He concludes by stating that “I feel that Ms Block’s claim that her design is a non-commonplace item/design is not true. If you talk to lecturers in glass at most colleges, you will find many of this style of jewellery has been made and shown at degree shows since the 1980”. I am sorry, but this simply isn’t enough. Mr Mikelledes’ evidence isn’t specific enough to establish that what the students made had the aspects specified in the claim to design right, but even if it did, the fact that students at one particular college made such jewellery doesn’t establish it was commonplace. He asserts, in effect, that if we talked to other colleges we would get evidence to show it was commonplace, but as Mr Wallin rightly said, it is not the responsibility of the claimants, nor for that matter me, to go and speak to lecturers. Thus whilst Mr Mikelledes’ evidence may get a step closer than any of the other evidence, it still isn’t close enough.
- 58 A further witness statement was provided by a Mr Brad Walker. I should perhaps say that Mr Wallin objected to the inclusion of this particular statement on the basis that it was filed late. There was some slight confusion over the precise date it was filed although at worst it seems only to have been a day or two late. When asked, Mr Wallin was unable to identify any prejudice to his client arising from this short delay in filing and I therefore admitted the statement.
- 59 Mr Walker is the author of various books on contemporary glass. He also teaches courses on glass fusing at his studio in North Carolina. He was shown the pictures of Ms Block’s pendants in Annex 1 and asserts that pendants “like those shown in the figures 1 to 5 attached are very common and have been since before 2001”. Once again, I can attach little weight to such bald assertions, particularly as he fails to explain what he means by “like those



shown". That is not a pedantic point, because much of the rest of his witness statement is simply concerned with the overall shape of the pendant and/or the fact that it is made of fused glass, leaving me with the distinct impression that "like those shown" does not refer to all the aspects set out in the claim to design right. For example, he states that the idea of a fused rectangular pendant has "been around for so long that it is ridiculous for someone to claim they invented the shape and the form" and that fused rectangular shapes have been around since at least the ancient Phoenicians in around 6 BC. That may all be true, but it doesn't establish that the specific design in question has been around all this time. He also claims that the techniques used to make the pendants are well known from many books, some of which he cites. That may also be true, but it doesn't get us anywhere because the claim is not (and could not be) to a method of construction. In an email he sent to the respondent he also identified a number of websites that in his opinion show rectangular pendants, but these have not been exhibited and so I can take no account of them.

60 In short, whilst the evidence provides me with plenty of broad-brush assertions, none of it is specific enough for me to be clear about exactly what is being asserted, and certainly none of it meets the requirements established by *Farmers Build* and *Lambretta*, ie giving reasons for assertions, identifying specific prior designs and analyzing the various aspects of those designs. The defendants have not therefore discharged the onus on them to show that the design in question is commonplace. I would observe that the defendants have also failed to show that the design minus the feature of the different colouration of the two parts was commonplace. Hence even if I am wrong on the issue of the colour being an aspect of shape and configuration, I would still not have been able to exclude the design as being commonplace.

61 I should note that the claimant's introduced, with the agreement of the opponents, additional evidence in the form of an alleged infringing item of jewellery produced by the opponents. In the light of step 5 of the *Farmers Build* test, Mr Wallin suggested that the similarities of the alleged infringing article with those claimed pointed to the design in question not being commonplace. Given that the defendants have been unable to point me to any prior designs which are anything like as close as this, I agree.

### ***Subsistence of design right in aspect c)***

62 So far I have only considered subsistence in relation to the aspects defined in paragraphs a) and b) of the claim to design right. I must now consider aspect c), that is, the mounting of the bail so as not to encroach on the main faces of the jewellery. Mr Wallin portrayed this as a further aspect that was to be added to a) and b) if I had found against him on a) and b). If I understand his position correctly, therefore, I do not now need to consider c) at all given my finding in respect of a) and b). Indeed, I would have difficulty doing so anyway because I received negligible argument from either side on aspect c

### ***Duration of Design Right***

- 63 The claimants submitted four witness statements which according to Mr Wallin showed that jewellery in accordance with the claimed design was sold in 2001. Ms Block also confirmed in the statement of case that she first marketed such jewellery in summer 2001. Notwithstanding some reservations that Mr Franks had about the witness statements from Ms Morgan and Ms Wright in particular, I am satisfied that articles made to the design were available for sale in 2001. Therefore design right expires at the end of 2011.

### ***Conclusions***

- 64 In summary, I have determined that design right subsists in the aspects a) and b) claimed by Ms Block in her claim to design right (as set out in paragraph 11 of this decision), with the added clarification that the planar glass component is transparent. I make no finding on aspect c).
- 65 I have also determined that the term of design right runs to December 31 2011. I would add that under section 237 the design right is subject to licences as of right from 1 January 2007. This means that anyone may from that date obtain a licence to do anything that would otherwise be an infringement of the design right. The licence will be on terms agreed with the owner of the design right, Ms Block, or in the absence of any such agreement by the Comptroller.

### ***Costs***

- 66 Neither side has asked for costs, which is entirely consistent with their being represented on a *pro bono* basis. I therefore make no award.

### ***Appeal***

- 67 Under Section 251(4) of the CDP Act 1988, any appeal against this decision is to the High Court; and under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days.

**P HAYWARD**

Divisional Director acting for the Comptroller