

Design Briefing Paper

Unregistered Design Right: Dyson v. Qualtex

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Unregistered Design Right

Unregistered design right is a form of protection similar to copyright, which provides automatic protection in the United Kingdom for three-dimensional products. The case of *Dyson v. Qualtex*, reviewed below, is the first case in which detailed consideration has been given to several aspects of design right. The case is therefore a valuable guide to the way in which design right will be treated by the UK courts.

Overseas readers should be aware that various qualifications must be met before design right will subsist, for example with regard to the nationality of the designer or his or her employer. In most cases, designs created overseas by, for example, designers of USA, Japanese or Chinese nationality will not be protected by design right in the UK. Those overseas readers should nevertheless be aware that design right may effect their freedom to export to the UK copied products such as spare parts.

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Dyson v. Qualtex – Design Right Decision in the High Court

This case concerns the claim of Dyson Limited for infringement of unregistered design right in respect of a number of spare parts for its vacuum cleaners. The Defendant is Qualtex (UK) Limited, one of the UK's leading suppliers of what are known as "pattern" parts: duplicate spare parts for domestic appliances. The case centres on the scope of the "must fit" and "must match" provisions of the Copyright, Designs and Patents Act 1988 (CDPA) and the ability of manufacturers to control the spare parts aftermarket. It is the first case to examine the significance of these provisions in relation to spare parts.

Two sources of supply exist for the provision of replacement parts. The first is the original manufacturer of the equipment ("OEM"). The second is independent manufacturers and suppliers who make and supply two different kinds of spares. The first kind of spare is purely functional and does not attempt to reproduce the appearance of the original. The second kind is a duplicate of the original (save that it would not bear the mark of the OEM). This latter category is known as "pattern" spares and is an important part of the market. This case is concerned with pattern spares for Dyson cleaners.

The Chairman of Qualtex admitted that all the parts in issue in this case were copied by Qualtex. However, practically every point that could be raised as a bar to the subsistence of design right was raised:

- *Originality*
- *The "must fit" exception*
- *The "must match" exception*
- *Commonplace*
- *Surface decoration*
- *The relevant start date for design right protection.*

The only significant point that was not raised is qualification, as all parties to the case were UK nationals.

It was part of the submissions of Qualtex in this case that the "must fit" and "must match" provisions of the CDPA are designed to protect suppliers of spare parts and that they would fail to give adequate protection if they were narrowly interpreted. Mann J ruled that, from the legislative history, it was clear that while spare parts were to have some protection, the object of the Act was not to be particularly benevolent (or particularly hostile) to the manufacturers of spare parts. They are therefore to be treated in the same way as other functional articles, although certain provisions of the Act have particular application to spare parts.

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Originality

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

Mann J ruled that there must be copying in the tracing or photocopying sense for a design to lack originality. The act of taking an earlier design as a starting point, or being influenced by an earlier design, does not render a later design unoriginal.

Qualtex sought to use the Farmer’s Build¹ text for originality – looking for the “visually significant” differences between two works in order to decide whether the second work is original. Mann J pointed out that in the Farmers Build case there was an initial act of copying of the nature of tracing or photocopying. In that situation, the “visually significant” test can be applied to see if the copy has subsequently undergone sufficient alteration to become a new “original” design. However, where copying is not the starting point (as in this case), Mann J ruled that the Farmers Build test is unhelpful. Where the evidence simply shows that design B was “based on” or “derived from” design A, then copying in the tracing or photocopying sense has not necessarily been shown. The fact that there are no “visually significant” differences between two designs may help give rise to an inference of copying but that is all.

Mann J also ruled that the suggestion of an idea to a designer by a third party does not affect the originality of the resulting design: *“Other things may have been suggested too. However, none of this makes the final design unoriginal. The suggestion of the disc was a suggestion of an idea, not the preparation of a preceding design. Accordingly, this evidence does not mean that Mr Nighy’s designs were not original for the purposes of design right under the Act, and I find they were.”*

Lastly, Mann J reiterated that design right can exist in a combination of features some of which (or even all of which) are copies when taken separately.

Must Fit

“213 (3) (b) (i) 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”

Mann J followed Laddie J in Ultraframe²:

“As a broad generalisation, the must fit exception stopped manufacturers from monopolising the market in spares and consumables by preventing them from obtaining design right in the interface between the consumable or spare and the rest of the article.”

Mann J emphasised that the essence of the must fit exception is that it applies to features that are essentially part of a **connection** – they facilitate a level of connection even if it is only to the extent of allowing one article to be placed against another.

“The must fit provision presumably reflects a policy that manufacturers should not be able to hold consumers to ransom by maintaining a monopoly on aspects of products which have to be reproduced as a matter of function if replacements are required. A competitor can therefore reproduce those aspects of design which, in practical terms, have to exist in order to make the necessary connections so that the bits can be made to work together.”

Several points regarding the nature of the must fit exception are clarified in the judgement:

- *It must be borne in mind that design right applies to functional designs. Therefore, the fact that a component for a composite article is functional does not necessarily mean that its features fall within the must fit provisions.*
- *The fact that a part enables a machine to work is not sufficient: enabling functionality of a machine is different to **enabling a connection between articles**.*³
- *The fact that, if designed differently, a particular part would obstruct the function of a neighbouring part is also not sufficient. If the shape is not one that **“enables”** either part to perform its function then the sub-section does not apply. **Merely failing to obstruct the function of a neighbouring part is not enough.***⁴
- *The must fit exception does not apply to every aspect of a part that has a function and which happens to lie against another part. There has to be an **enablement of connection, or of placing, or of placing around**. A feature may have a job once a connection is made, but that job may be no part of the connection.*
- *The article with which the subject article is connecting or interfacing can be part of the human body.*
- *It does not matter if there are two ways of achieving the necessary fit or connection between the subject article and the article to which it fits or with which it interfaces. **If the design chosen by the design right owner is a way of achieving that fit or interface, then it does not attract design right** no matter how many alternative ways of achieving the same “fit” might be available.*

¹ *Farmers Building Limited v. Carrier Bulk Materials Handling Limited* [1999] RPC 461.

² *Ultraframe UK Ltd v Clayton* [2003] RPC 23.

³ **Example:** *Imagine a modern three pin plug which is to be used in a situation in which heat is likely to be generated at the connection with the socket. In order to dissipate this heat grooves are cut across the surface between the upper pin and the lower pins so that there is an air passage across this surface when the plug is in. Those grooves do nothing to enable the connection between the plug and socket – that works just as well without the grooves. They enable the plug and socket to be more effectively (and safely) used, but that does not bring them within the sub-section.*

⁴ **Example:** *in the case of a facing surface of a ridge that forms a groove in which a catch sits: “It is true that if the surface were somewhere else (farther towards the catch) it would foul the catch, but this does not mean that the surface is a feature which enables the catch to function, or which enables the ridge to form the groove”.*

- The sub-section operates to exclude design right even if the relevant part of the design performs some function other than the function described in the sub-section – for example, it is decorative, or has an additional function not falling within the provision. This additional function does not exclude the operation of the provision.
- A pattern is not an article – a pattern may enhance the functionality of an article, but that does not make the pattern itself an article for the purposes of the Act and this sub-section in particular.⁵
- The sub-section does **not apply to features that exist for manufacturing purposes only** rather than for the purposes of the machine when used. The sub-section is looking at the situation of the article in its primary use, not at the stage of manufacture.
- The width or depth of a feature is not a “feature” for these purposes, width and depth are attributes of a feature. Attributes are not within the exception; features are.

Must Match

“213(3) (b) (ii) Design right does not subsist in features of shape or configuration of an article which are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part”

A large part of the evidence in this case turned on this provision, and the rulings on this provision have perhaps the widest implications for the pattern parts trade as a whole.

Qualtex submitted an argument that design dependency of the type envisaged by the sub-section does not pre-suppose a single available design solution, and that dependency is a **designer created** thing arising out of the designer’s perception and his employer’s implementation of it. Thus the design of a car bonnet lid would be “dependent” on the appearance of the whole car, because the designer created that dependency when he saw the thing as an integral whole and designed it as such. **Mann J rejected this argument**, stating that *“In Mr Arnold’s reading of the section, the design of each will be dependent on the appearance of the whole because that is how the designer will have intended it. The result of this is that the external aspects of most external parts within a complex product will be exempted from design right. That would make very large inroads into the rights that the statute creates, and might even be said fundamentally to undermine them.”*

Mann J chose to adopt a test put forward by Mr Jeffs in the Ford⁶ case: when considering wing mirrors, wheels and other replacement car parts he observed that:

“All of them are visible on the car as sold but substitutions can be made without radically affecting the appearance or identity of the vehicle.”

Mann J ruled that **the degree of dependency required to bring an article or aspect within the must match provision is reflected in Mr Jeffs’ test of “radically affecting the appearance or identity of the article”**. He stated:

“The must match provision can be said to be consistent with a policy that consumers should not be held to ransom by manufacturers maintaining a monopoly over those aspects of aesthetic design which, in common sense terms, have to be reproduced if, after replacement or repair, the customer is still to be left with something which is, in aesthetic terms, the same sort of article as he originally bought.”

Mann J therefore applied the “must match” provisions by considering **whether there was dependency of the kind, or to the extent, which would make the overall article in question (article 2) radically different in appearance if article 1 were not the shape it was**. The saleability of the item was also used as a guide to assessment or a crosscheck in particular cases.

A common theme in the judgement is that the existence of a visual link between components of an article may be an element of the design dependency required by the section, but it is not sufficient. Mann J followed Laddie J in Ultraframe:

“In my view the fact that [certain features] help in achieving a “consistent theme”, as Mr Wyand puts it, does not mean that these particular features are “dependent upon the appearance of another article” as required by s.213(3)(b)(ii).”

It was also highlighted that similarity or actual matching should not be confused with the sort of design dependency that is required by the “must match” exception – the words “must” and “match” do not actually appear in the legislation.⁷

If design dependency suitable to bring the design of a component article within the must match exception is to exist, then it must be the case that any alternative design would make the overall article (the machine) look radically different. The fact that one particular alternative would have that effect is not enough.⁸

⁵ **Example:** Consider the helix bristle pattern on a brush bar; the bristle pattern is not an article; it is a pattern. The bristles have a function – brushing the carpet – and the pattern may enhance it. But that does not make the pattern the article the shape of which may be excluded by section 213(3)(b)(i).

⁶ Ford Motor Co. Ltd’s Design Applications [1994] RPC 545.

⁷ **Example:** Consider a ribbed release catch situated within the handle of an upright cleaner: if you are going to have ribs on the front of the handle above the release catch, then harmonious design might mean that those ribs would have the same pitch, spacing and profile as those on the catch, but the presence of ribs on the catch does not dictate a design requirement of ribs on the front of the handle above it so as to make the design of that area dependent on the catch.

⁸ **Example:** Consider the handle of a Dyson upright cleaner: changing one or more of the design features of this handle would not necessarily make the whole machine (including the handle) look “radically different”. It is true that one could make the handle so different that the overall appearance of the machine would be radically different, but that is not necessarily the case. One could alter the detail of the handle without radically changing the overall appearance of the overall machine.

Commonplace

“213 (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”

Mann J ruled that, when considering commonplace, the court must have regard to designs which could be seen, rather than designs which were marketed at the relevant time. For example, whether or not historical designs were marketed at the time is not important. What is important is what is apparent to those operating in the design field in question. It may be extremely difficult for a design to acquire sufficient status in the field without its appearing in a marketed product, but that is purely a matter of practicality. Commonplace does not depend on marketing. It follows that that it also does not depend on marketing in the UK. It was accepted, however, that a design must be commonplace in the UK in the sense that UK designers in the field would have to be aware of the design to an extent sufficient to make it commonplace if the statutory exemption is to operate.

Mann J followed Laddie J in *Ultraframe* in indicating the stage of analysis at which it is appropriate to apply the commonplace test. It occurs after the other exceptions have been applied (or not applied) as appropriate:

“The combination of features left after individual features are excluded under the must fit and must match provisions is the design in issue. If that combination of features is commonplace, the design is not protected.”

Mann J gave the following approach to commonplace:

- Give it the meaning elaborated on by Laddie J in *Ocular Sciences*⁹, so that “any design which is trite, trivial, common-or-garden, hackneyed or of the type which would excite no peculiar attention in those in the relevant art is likely to be commonplace”.
- Consider other alleged exceptions first to see what is left after they have been properly applied.
- Where it is appropriate to consider commonplace, consider whether the design is commonplace in the UK, to which question the marketing of the other article or articles in which the design appears will be relevant but not essential.

Other matters clarified in the decision:

- One should not confuse, on the one hand, **evidence that someone has once thought of a design concept** in a particular context, with, on the other, **evidence of general designer-awareness** (whether through marketing or otherwise). Only the latter is relevant.
For example, ribbing on a particular vacuum cleaner part is not simply “ribbing on a vacuum cleaner”; it is particular ribbing with particular dimensions and particular aspects. That is the design (or designs) over which design right is claimed. That is the design that must be shown to be commonplace.
- **Being well known is not the same as having become commonplace.** It may well be that designers are familiar with a particular design. However, that does not make it commonplace. A design may be familiar and yet not be hackneyed, run of the mill or in any other way “commonplace”. **A striking design does not become commonplace merely by virtue of the familiarity of designers with the striking design** and its success in the marketplace.
- To fall within the exception, the particular design in question must be shown to be commonplace. For example the common nature of car door panels would not make a particular design of car door panel commonplace. Also, previous uses of an idea do not make a particular design incorporating that idea commonplace.

Surface Decoration

“213 (3) (c) Design right does not subsist in surface decoration”

Mann J followed Parker J in *Mark Wilkinson Furniture*¹⁰:

“There is no assistance given in the 1988 Act as to what does or does not constitute surface decoration. In my judgment, the expression “surface decoration” in section 213(3) and section 51 is apt to include both decoration lying on the surface of the article (for example, a painted finish) and decorative features of the surface itself (for example, beading or engraving).”

Surface decoration is therefore to be considered on the following basis:

- There is a useful distinction between surface decoration on the one hand and the overall shape and configuration of a product on the other.
- That distinction may be clear in some cases, but overall it may well be a matter of fact and impression, or a value judgment.
- A subsidiary functional purpose does not take a particular feature out of this exemption if the primary purpose is surface decoration. However, the functional purpose has to be subsidiary. A functional feature that also happens to be decorative would not be excluded.¹¹
- The expressed intention of the designer can be taken into account. This is not determinative, but it is useful material, particularly in relation to functionality.

⁹ *Ocular Sciences v. Aspect Vision Care Ltd.* [1997] RPC 289.

¹⁰ *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1988] FSR.

¹¹ **Example:** Consider a pronounced area of ribbing on a wand handle: its purpose is to create something of an optical illusion – to make the handle appear more substantial in that area than it actually is. The ribbing is carefully designed to convey a shape, defined by that ribbing; it does not merely decorate a surface which is already there.

Duration

“216 (1)(b) 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.”

A question of law arose as to when “articles made to the design are made available for sale”.

There is apparently no known authority on the point, and no known authority on the meaning of “made available for sale”. Mann J stated:

“I agree that the paragraph is aimed at firing the starting gun at the point at which commercial exploitation starts, but I do not think that that takes the debate any further. The question is: what is that point?”

The question was whether the taking of advance orders for goods which had not at that time been made should constitute making those goods available for sale. Mann J ruled that **taking orders for goods is not making them available for sale**. This conclusion is not affected by the existence of prototypes or samples. Prototypes or samples, unless the evidence shows otherwise, are not available for sale – they are examples of what will, in due course, be available for sale. The acts of taking orders and having a made up machine available for demonstration do not mean that articles are made available for sale within the meaning of the section.

Articles made to a design cannot, therefore, have been made available for sale before the date on which production started.

Acquiescence

In so far as design right might otherwise have been infringed, Qualtex relied on a defence of estoppel, waiver or acquiescence by Dyson, on the basis that Dyson knew what Qualtex was doing and did nothing to stop it. It was found that Qualtex could not rely on this defence, as the Chairman had deliberately not informed Dyson of their activities for the very reason that he knew Dyson has a reputation as a litigious firm and he feared to be sued. The Chairman of Qualtex knew his actions might not be justifiable, he also knew of the existence of the law of acquiescence and hoped to make use of it in the event that the case came to court. Mann J ruled that this deliberate attempt to engineer a situation in which an acquiescence defence could be used amounted to “estoppel by entrapment”. It was emphasised that the laws of acquiescence and estoppel “are intended to protect those with erroneous beliefs in their rights; they are not intended to protect those who know that they may not have those rights”.



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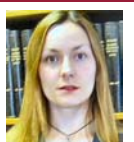
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