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IN THE HIGH COURT OF JUSTICE  
BUSINESS AND PROPERTY COURTS  
OF ENGLAND AND WALES  
INTELLECTUAL PROPERTY LIST  
[2022] EWHC 2386 (Ch)



No. IL-2022-000029

Rolls Building  
Fetter Lane  
London, EC4A 1NL

Friday, 29 July 2022

Before:

MR JUSTICE MILES

B E T W E E N :

LEIGHTON VANS LIMITED

Claimant

- and -

(1) DAVID WILLIAM HARRIS  
(2) ALL SEASONS LEISURE LIMITED

Defendants

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MS D. McFARLAND (instructed by Freeths LLP (Birmingham)) appeared on behalf of the Claimant.

MR T. ST QUINTIN (instructed by Sintons LLP (Newcastle)) appeared on behalf of the Defendants.

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**J U D G M E N T**

MR JUSTICE MILES:

- 1 This is an application for an interim injunction. The claim relates to designs for bumpers for VW Transporter vans. The claimant, which manufactures and sells the bumpers, says that they are fitted to the vans to make them look more distinctive or aesthetically pleasing to the owner than the standard factory-fitted bumpers. It appears from the evidence that there is a substantial market in products of this kind.
- 2 I have been shown a design of a bumper manufactured and sold by the claimant. It is common ground that there is a serious issue to be tried that the claimant has the intellectual property rights (the unregistered design rights) in respect of this design.
- 3 The design is described in the evidence as comprising three main elements known as the chin, the splitter, and the fin. The claimant's evidence is that its bumpers are popular and that they are created using high quality, robust, plastic materials which meet relevant regulatory and safety standards.
- 4 Mr Leighton of the claimant has set out the background to the matter in a witness statement. He gives evidence about the way in which the claimant's design was created, the manufacturing process undertaken by the claimant, and the scale of the claimant's business. He also gives evidence which supports the view that the claimant has established a reasonable amount of goodwill in relation to these and other products. It appears from his evidence that the claimant company is reasonably well known in the relevant markets.
- 5 The existing defendants, Mr Harris and a company called All Seasons Leisure Limited, became involved in a dispute with the claimant in about March 2022. The claimant says in the evidence that it discovered that the defendants were offering for sale and supply products made to the same design as the claimant's, but in a fibreglass material. The claimant's evidence is that fibreglass is less robust than the plastic used in its own products. Fibreglass materials are liable to chip or break easily. The defendants have admitted the sale and supply of these products.
- 6 I shall come to the events of yesterday in a moment but in the correspondence which has taken place since March 2022, the claimant sought orders or undertakings concerning the production, sale, or use of products by the defendants:

“...incorporating the designs or any of them set out in schedule 2 to this order (‘the designs’) or to which the designs (or any of them) are or have been applied and/or made to the designs (or any of them) or made to any substantially similar designs to them, such articles being referred to as ‘prohibited articles’.”
- 7 The claimant also sought disclosure of information about the identity of the manufacturers or suppliers of, or anyone involved in the manufacture or supply of, the prohibited articles.
- 8 The defendants took the position in the correspondence that they had ceased making or using bumpers to the same design as the claimant's design and were willing to undertake not to manufacture, use, or sell products of that kind. Until yesterday, they refused to provide any disclosure of information about the manufacturers of the allegedly infringing products and they specifically declined to provide relief in the form sought by the claimant.

- 9 Yesterday afternoon, 28 July 2022, the defendants served a skeleton argument and a witness statement from Mr Harris, the first defendant. In the witness statement Mr Harris explains that the second defendant is a dormant company which was purchased with a view to transferring trade from a company called Ukpoptops Limited which trades as All Seasons Leisure but that that transfer had not yet taken place. He says that Ukpoptops modifies vans and sells them to members of the public as campervans and that these include VW Transporter vans. It is this kind of van to which the contentious bumpers are attached. He also says that Ukpoptops or the other defendants did not sell parts for campervans separately from the vans they sold.
- 10 Mr Harris then explains how products made to the claimant's design were made and attached to campervans sold by Ukpoptops. He explains that some products were supplied by a supplier called Excel Group Limited and that Ukpoptops obtained some twenty units from that supplier. He says that after obtaining those twenty units, he decided to create his own supply of chin splitter sets and that fifty-two chin splitter sets were created. He says that until he received a letter from the claimant on 9 March 2022, he did not understand what design right was but that since the application was made, he has destroyed the moulds used to make the defendants' supply of chin and splitter sets.
- 11 He also says that the defendants agreed in correspondence not to make or arrange the making of any further samples of the chin and splitter sets which are the same as the chin and splitter sets which are the subject of the application.
- 12 He goes on to say that if the items infringe the claimant's designs, then the defendants (rather than the suppliers or manufacturers) are responsible for the relevant infringements. He then makes some comments about the value of the claim. These comments – and the remainder of his evidence - are disputed by the claimant.
- 13 He then turns to a letter written by the claimant's solicitors on 25 July 2022 which complained that a van that the second defendant was advertising and which the claimant alleged to incorporate an infringing product. Mr Harris says that in fact the chin and splitter set on that vehicle was not made to the designs of the claimant and that it differs from them in many ways in both form and function. He says that they do, of course, share some similarity because they are designed to fit the front of VW Transporter vans, but that is all.
- 14 He then goes on to exhibit the financial statements for Ukpoptops up to 30 November 2020 and says that it had net assets of some £3.77 million.
- 15 The claimant observed with some justification that this evidence was served very late indeed and that there was no explanation for its lateness. The application has been on foot for some time now and counsel for the defendants did not offer any explanation or excuse. Nonetheless, it seems to me that given the subject matter of this application it is appropriate for the court to take the evidence into account.
- 16 I should say a little bit more about the documents which were attached to the claimant's letter of 25 July 2022 concerning one particular van which it is said had bumpers which infringe the claimant's design. I was taken by counsel for the defendants to the photographs of that vehicle. From a visual consideration of the photographs, it does appear that there are certain differences between that bumper and the design relied upon by the claimant. While the claimant's design of the splitter section has a number of horizontal fins, the design shown in the picture shows three

vertical spars between the splitter and the chin. There are differences also in the shape of the splitter and the chin and there also appear to be differences in the design of the fin section. However, Mr Harris does not descend into any real detail about the differences other than to say that the design is different in both form and function.

- 17 The claimant has not had any opportunity to deal with his evidence or the points made in response to the letter of 25 July 2022.
- 18 As I have said, the defendants are prepared to offer some undertakings but these are not as extensive as the orders sought by the claimant. Against this background, the principal points in dispute between the parties today fall under two heads. First, the terms of any undertaking or order, and, second, questions of disclosure.
- 19 As to the first of these questions, the defendants say that any undertaking should be restricted to the manufacture and use of products identical to the claimant's design. The claimant, for its part, says that order should be worded as I have recited above.
- 20 I am not persuaded that the existing draft order proposed by the claimant is appropriate. The drafting refers to an injunction to prevent the manufacture, production, sale, offer for sale, supply, or offer to supply, advertise, promote, or use of any articles "incorporating the designs set out in schedule 2 to the order proposed". That cannot be right because articles do not incorporate designs. Articles may be made to designs but they do not incorporate them. I was told by counsel for the claimant that this was intended to deal with the case of campervans which incorporated parts made to the designs. If that is the intention, it does not seem to me that the wording properly catches it.
- 21 A second problem with the wording presented by the claimant is the phrase that the defendants should be enjoined from manufacturing and selling any articles "made to the Designs or made to any substantially similar designs to them". That wording suffers from the following difficulty. Under s.226(3) of the Copyright, Designs and Patents Act 1988, reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design. The wording suggested by the claimant would do something different, namely, prevent articles being made to the claimant's designs or to any designs similar or substantially similar to the claimant's designs. That is different from the statutory prohibition and wording along those lines would not be justified.
- 22 The claimant's response was to submit that the wording should, in some way, reflect the provisions of s.226(3) and although actual wording was not provided, I understood counsel to say that there should be an injunction preventing the defendants from manufacturing, producing, selling, etc. any articles made exactly or substantially to the claimant's designs.
- 23 The defendants referred me to various authorities concerning the scope of injunctions in other areas of intellectual property law. These were *Biro Swan Limited v Tallon Limited* [1961] RPC 326 at [328]; *Coflexip SA v Stolt Comex* [1999] FRS 473 at [16] - [18]; and *Potters-Ballotini Ltd v Weston-Baker* [1977] RPC 202 referred to in *Coflexip*. Counsel for the defendants submitted that interim injunctions should not be expressed in terms which are sufficiently certain as to make it clear to defendants what they can or cannot do and without reference to rights which have not been established at the relevant stage. So, in the *Biro Swan* case, Russell J was not attracted by making

an order which prevented the defendants from committing a nuisance as that was too vague.

- 24 I have so far set out the parties' positions about the wording of any order or undertaking. In the event that I do not consider that the defendants' undertakings are sufficient, I need to consider whether an injunction should be granted on *American Cyanamid* principles and, if so, the scope of the injunction.
- 25 I am not satisfied that the undertaking offered by the defendants in its terms is sufficient. The defendants seek to tie the scope of any undertaking to an exact identity or correspondence between the goods in question and the design. It seems to me that that is too narrow and would allow the defendants too much room to avoid the terms of the undertaking by making slight changes from the claimant's designs. So I am not attracted by that course.
- 26 On the other hand, nor am I attracted by the wording proposed by the claimant. It seems to me that what the claimant is asking the court to do is grant an injunction preventing the defendants from acting in breach of the Copyright, Designs and Patents Act 1988 or, putting it another way, are seeking an injunction against the defendants to stop them acting unlawfully. It seems to me that the court will not generally make an order of that kind. What the court granting an injunction must do is specify the acts which would constitute a breach of the order so that the defendants know what they are able to do and cannot do.
- 27 I also think that there is a practical problem with the suggestion made by the claimant. On any application to commit the defendants for breach of any injunction there would need to be a trial of the question whether or not there has been an infringement within the meaning of s.226(3) of the 1988 Act. It seems to me that the claimant's suggestion is analogous to the kind of order that Russell J rejected in the *Biro Swan* case of requiring a defendant not to act unlawfully or tortiously.
- 28 I also think that the claimant's wording is not greatly improved by the suggestion that there should be a proviso that the defendants should not be allowed to act in any way which might be infringing without the consent of the claimant. It seems to me that that would be to include in the order either a veto right or a qualified veto right and it would then be for the claimant to decide what the defendants should and should not be allowed to do. It seems to me that the order of the court itself should spell what the defendants are able to do.
- 29 So where does that leave matters? It seems to me that the question is whether the court should grant an interim injunction on *American Cyanamid* grounds relating to particular instances of production, manufacture, or sale of identified articles. It seems to me plain that it would be appropriate for the court to grant an injunction in relation to the original kind of bumpers produced by the defendants (which I will call version 1). Indeed, there is no real dispute about this. The defendants' own suggested undertaking would, it seems to me, cover the version 1 goods. Equally, the defendants accept that the mould that was used to produce the version 1 goods has been broken and although there appears to have been at least one case of a vehicle incorporating a version 1 bumper recently appearing on the website of the defendants, they accept that that was wrong and I am told that the advert for the van has now been taken down.
- 30 The more difficult question is whether an interim injunction should be granted in relation to the bumpers on the vehicle which was shown on Facebook and reproduced

as part of the attachment to the letter of 25 July 2022, which one may call version 2. It seems to me significant in that regard that the claimant has not yet had an opportunity to consider the evidence relating to version 2 in any real detail. Mr Harris's witness statement was only provided yesterday afternoon. It seems that there are some visual similarities and some visual differences between the design and version 2. It also seems to me that there may well be a question over the extent to which people in the market, that is to say relevant consumers, might consider the bumper parts to be the same as or closely similar to those supplied by the claimant. Thus far, the claimant has not had an opportunity to respond to the defendants' evidence or to consider those broader questions. It seems to me that, in those circumstances, I have to consider, at least on an interim basis, the *American Cyanamid* principles and decide whether to grant a short-term interim injunction in relation to version 2.

- 31 Considering those principles, it seems to me that there is a serious issue to be tried as to whether the version 2 bumper constitutes an infringement under s.226(3). As Counsel for the claimant said, there is no satisfactory evidence from Mr Harris as to the provenance of the design of version 2 and one might have expected him to produce fuller evidence about that. Putting it another way the absence of any evidence on that point is a matter on which the court may, it seems to me, draw an adverse inference. As to whether the articles are exactly and substantially to that design, it seems to me again that on the material currently before the court, there is at least a serious issue to be tried.
- 32 The next question is whether damages would be an adequate remedy for the claimant if the defendants were to be allowed to sell vehicles containing the version 2 bumpers. The defendants contend that damages would adequately compensate the claimant. Counsel for the defendants says that there is no real basis for thinking that consumers would suppose that the version 2 bumper was based on the designs of the claimant or have been supplied by the claimant so that there is no real reputational risk that might accrue to the claimant that consumers would think that the kind of products found on the defendants' vehicles derived from, or were made by, or licensed by the claimant.
- 33 On the current evidence, it appears to me that the claimant has a good case that consumers would indeed think that the product was something to do with the claimant in the sense of either being made by or licensed by the claimant and it does seem to me that there is sufficient evidential basis for concluding that the claimant might well suffer reputational damage if the defendants were able to carry on supplying these goods incorporated into its vehicles.
- 34 I turn to the question of whether damages would be an adequate remedy for the defendants. It seems to me that the cross-undertaking offered by the claimant is sufficient for at least a short term interim injunction. Moreover there is no evidence as to the number of version 2 bumpers that have been produced or the extent to which they have been incorporated into vans to be sold by the defendants.
- 35 In relation to both these issues of damages, I also record that the evidence of the defendants as to which of them has been involved in the relevant business is and remains somewhat unclear. In the course of correspondence, it was accepted on behalf of the defendants that the business was conducted by the second defendant. It was only in Mr Harris's evidence of yesterday that there was a suggestion that another company had, in fact, been conducting the business but even in his statement, the position is unclear because in para. 19 he refers to a van that the second defendant was

advertising and that seems to be at odds with the rest of his evidence. It does seem to me in the light of his evidence that it would be appropriate in any case for this third company Ukpoptops Limited to be joined as a party to the proceedings and as a party to any injunction.

- 36 Taking matters in the round, it seems to me that the court should grant a short-term injunction in relation to version 2 (as well as in relation to version 1). I will discuss with counsel the length of that injunction but I am not going to grant an injunction down to trial because it seems to me that on fuller evidence and more mature consideration, a court might reach a view that it is not appropriate to continue the injunction in relation to version 2.
- 37 What I am not prepared to do, for the reasons I have already given, is make a generally worded injunction in relation to goods being made to the claimant's design or substantially to that design. For the reasons I have already given the injunction should be concerned with the two sets of alleged infringements that have been identified. If in due course the claimant complains that the defendants are seeking to get around the injunction by making further changes, it can return to court and seek to expand the relief. It will also be plain to the defendants that simply making minor or cosmetic amendments to the goods is unlikely to remove them from the protection of the statute.
- 38 So I will hear counsel further on the length of any short interim injunction and the return date. I will also hear them about any submissions they have about the service of further evidence in that regard.
- 39 I turn to the second main head of dispute which concerns provision of information. The claimant seeks disclosure of information about any person, company, firm, or other entity from whom the defendants or either of them have obtained supplies of articles, or it being involved in the copying and/or other reproduction of the designs or any of them. Mr Harris has explained in relation to the twenty sets of bumpers which were provided by third parties that these came from a company called Excel Group Limited and he has already provided contact details in relation to them. The claimant says that this is not sufficient and that it wishes to have information about anyone who was involved in producing the moulds for the version 1 bumpers. The claimant says that it requires this information so that it can either pursue the relevant third parties as joint tortfeasors or, if not, can inform them about its designs in order to ensure that they understand the dangers of an infringement.
- 40 The claimant referred me to the case of *Eli Lilly v Neopharma* [2008] EWHC 415 (Ch). That was a patent case in which the claimant sought the names of customers to whom allegedly infringing goods had been supplied and the Deputy Judge in that case set out a number of principles ultimately derived from the *Norwich Pharmacal* jurisdiction. Counsel for the defendants referred me to a more recent case called *Orb ARL v Fiddler* [2016] EWHC 361 (Comm) where Popplewell J summarised the *Norwich Pharmacal* principles. Among other things Popplewell J explained that there was a threshold requirement of necessity before such an order could be made and that this was different from whether such an order was desirable or might reasonably have been sought. He also explained that once the threshold requirements were met, there was a broad discretion as to whether or not to order disclosure.
- 41 Counsel for the claimant said that there was no evidence to show that the defendants or any other person would suffer any particular prejudice from this information being

provided. There was no evidence that there would be a breach of confidence or any other real harm to the defendants or the third parties.

42 Counsel for the defendants said that this information was not necessary. The defendants had explained that after using the Excel Group Limited products they had obtained moulds in order to manufacture the products themselves and that the moulds have now been destroyed. There was therefore no real necessity for this information. The defendants also accepted that to the extent that infringing acts had taken place, that was their responsibility and they would answer for any losses.

43 In relation to this part of the application, I am not satisfied that it is necessary to make the order. It seems to me, on the basis of the current evidence, that to the extent that infringing acts took place, it will be the defendants which will be primarily liable. It appears that the defendants asked for the moulds to be produced and no doubt provided instructions for that to take place. I do not think there is any evidence that whoever it was responsible for producing the moulds has itself produced separate moulds or other goods. Equally there does not appear to be any reason to doubt it, that the moulds that were produced for the defendants have been destroyed. The defendants have accepted that they are responsible. There is also a question of proportionality here. I can quite understand that the claimant wishes to protect its intellectual property rights but there is also a concern that there should not be overkill in its protection of its rights. As a matter of discretion, I would not have made the order for disclosure.

44 I will discuss with counsel the terms of the order, including the length of the interim injunction in relation to the version 2 bumpers.

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