



Neutral Citation Number: [2024] EWHC 3058 (IPEC)

Case No: IP-2020-000029

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

Royal Courts of Justice, Rolls Building  
Fetter Lane, London, EC4A 1NL

Date: 28 November 2024

**Before :**

**HIS HONOUR JUDGE HACON**

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**Between :**

**SIMON BARBER**

**Claimant**

**- and -**

**(1) STEVEN FRANCIS WAKEFIELD**

**(2) ULTIMATE TOOLS LIMITED**

**(3) SIMON WAKEFIELD**

**Defendants**

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**The Claimant** appearing in person  
**The Third Defendant** appearing in person and for **The First and Second Defendants**

Hearing date: 21 November 2024

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**Approved Judgment**

This judgment was handed down remotely at 10.30am on [date] by circulation to the parties or their representatives by e-mail and by release to the National Archives.

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HIS HONOUR JUDGE HACON

## Judge Hacon :

### Introduction

1. This is a claim for infringement of UK Registered Design No. 4028780 ('the Registered Design').
2. The claimant, Mr Barber, and the defendants all trade in the field of machine tools. The first defendant, Steven Wakefield and his brother Simon, the third defendant, contribute to the running of the second defendant company, Ultimate Tools.
3. The claim form was issued in March 2019 in IPEC small claims track. By an order of DJ Hart dated 15 January 2020 the case was transferred to this court pursuant to CPR 63.27(1)(a) which excludes claims relating to a registered design from the jurisdiction of IPEC small claims. The case came before me in this Court in July of this year. Both sides are litigants in person and I could see why the case had been launched by Mr Barber in the small claims track.
4. The claim and defence as pleaded, though unclear on both sides, was of a wider scope than just infringement of a registered design.
5. The pleadings were not at all in a fit state, satisfying neither CPR Part 16 nor rule 63.20(1). Rather than insisting that the parties spend money on legal advice to ensure compliance with the rules and more clearly explained lines of dispute, I suggested to them that the claim should be limited to the single and central matter of alleged infringement of the Registered Design, that the parties should file evidence and make submissions on that matter alone and that I would then deliver a judgment.
6. The parties agreed to this way forward. The arrangement was formalised along with other directions for the trial in my Order dated 11 July 2024.
7. That Order stated that the trial would be confined to the following six issues:
  - (1) Whether the Registered Design was new as of 19 February 2013, the date of registration.
  - (2) Whether the Registered Design has individual character.
  - (3) Whether any features of the Registered Design are features of appearance of a product solely dictated by the product's technical function.
  - (4) Having in mind the answer to issue (3) above, whether the design of the Second Defendant's tool complained of in the Particulars of Claim, defined as "the Accused Design", produces on the informed user a different overall impression to that produced by the Registered Design.
  - (5) Whether the Second Defendant has used the Accused Design, which shall be taken to mean whether the Second Defendant has either (a) made, offered, put on the market, imported, exported or used a product to which the Accused Design is incorporated or (b) stocked such a product for those purposes.
  - (6) If the Second Defendant is found liable for infringement of the Registered Design, whether the First and/or Third Defendants are jointly liable with the Second Defendant for the use of the Accused Design.

8. The parties have since submitted evidence and argument addressing those issues.
9. Issues (1) and (2) fell away at the trial. The parties were agreed that the Registered Design was new and had individual character as of 19 February 2013. The defendants had a point about technical function but it really went to their argument on infringement.

### **Parties and representation**

10. Mr Barber appeared in person. Simon Wakefield attended by video link for himself and representing the other defendants. Mr Barber and Mr Wakefield gave evidence as well as making submissions, largely in response to questions from me. Both were clear in what they said and were courteous to one another, which does them great credit.

### **The Registered Design**

11. The Registered Design is in class 8, for tools and hardware. It was registered as of 19 February 2013. There are three illustrations. There is little or no distinction between them and it is sufficient to reproduce one, which appears as Annex 1 to this judgment.
12. The design has been used by Mr Barber in the creation and sale of a type of product known as a letter box tool. This is a tool which is manipulated through the letter box of a front door to open the door without a key. Strictly, the design is only for the core structure of the tool. As used, the tool will have alternative components at its working end which allow the user to hook the tool under a handle or to loop it around keys on the inside, or to achieve other means of entry. The near end of the tool will have a handle. However, for convenience I will treat the design as registered as a design for a letter box tool.

### **The accused design**

13. The design alleged to infringe (“the Accused Design”) is incorporated in a product made by Steven and Simon Wakefield. It became clear during the trial that it has never gone beyond a prototype and I think that it fair for me to refer to it as ‘the Prototype’.
14. Images of the Prototype appear in Annex 2 to this judgment.

### **The law**

15. The law on infringement was (non-exhaustively) summarised in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat), at [181]-[182], here reproduced with adapted numbering as proposed in *Marks and Spencer plc v Aldi Stores Ltd* [2023] EWHC 178 (IPEC), at [19]:

The court must:

- (1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

- (2) Identify the informed user and having done so decide (a) the degree of the informed user's awareness of the prior art and (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;
- (3) Decide the designer's degree of freedom in developing his design;
- (4) Assess the outcome of the comparison between the RCD and the contested design, taking into account
  - (a) the sector in question,
  - (b) the designer's degree of freedom,
  - (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public,
  - (d) that features of the designs which are solely dictated by technical function are to be ignored in the comparison.
  - (e) that the informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences; this can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.

### **Must fit**

16. Mr Wakefield raised an issue about 'must fit'. This was done for the first time after the Order of 11 July 2024. Normally I would have disregarded it because the hearing which led to that Order was, in effect, the CMC in the action and there was no good reason why either side should be permitted to raise further issues for the trial. However, the parties are litigants in person, so I said I would deal with the point.
17. This is s.1C(2) of the Registered Designs Act 1949 ("the 1949 Act"):

*'(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.'*

18. This is often called the 'must fit' exclusion from registered design protection. It is similar in effect to the equivalent exception to UK unregistered design right protection in s.213(3)(b)(i) of the Copyright, Designs and Patents Act 1988. In *Action Storage Systems Limited v G-Force Europe.Com Ltd* [2016] EWHC 3151 (IPEC), the following suggestion was made:

'There will be a limit to the exclusion of design right protection under this provision. I take the view that the shapes of the relevant parts of the connecting articles must be such that there is a degree of precision in the interrelationship between one article and the other, i.e. the designs afford some

precision in the fit. For example, it would be surprising if the handle of a coffee mug were refused design protection solely because it is shaped to enable a human hand to connect to it to pick up the mug.’

19. The example there does not exactly translate to the law of registered designs because in s.1C(2) the must fit exclusion applies only as between two products. A ‘product’ is defined in s.1(3) as industrial or handicraft item so that the fit could not be with a feature of the human body (unlike the position for UK unregistered designs, see *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289). Nonetheless, I think the general point holds good. The tribunals of what was then the Office for Harmonization in the Internal Market (OHIM) have found that the exclusion applies where one product fits another ‘like a key to a key hole’ (see the helpful summary in *Russell-Clarke and Howe on Industrial Designs*, 10<sup>th</sup> ed, at 2-096, footnote 249.).
20. The OHIM decisions do not seem to say expressly whether something less precise than the fit of a key in a key hole would benefit from the exclusion. However it seems to me clear that while a letter box tool must fit through the letter box and be suitable for close contact with objects on the inside of the door, there is little else in the way of a fit required. The must fit exclusion does not apply to the present case.

### **The informed user**

21. Mr Barber and Mr Wakefield told me that a letter box tool is characteristically used by locksmiths, security agents and sometimes by the police. Typically such individuals use the tool to assist those who have locked themselves out of their home. Other users could be imagined but they are not relevant to this judgment.

### **The design corpus**

22. Mr Barber and Mr Wakefield were agreed that only two letter box tools were available to the public before 19 February 2013: the Souber tool and the Pink tool. They are illustrated in Annex 3 (the core of the Souber tool is the largest object shown held by a strap in the lid of the box). No other relevant prior art designs were drawn to my attention.

### **Features of appearance of a product solely dictated by the product’s technical function.**

23. Section 1C(1) of the 1949 Act provides:

*‘A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.’*

24. Mr Barber accepted that a letter box tool must have a U-shape of some sort so that it hooks through the letter box and bypasses the security hood if present. He pointed to the Souber tool to illustrate the point. Otherwise, Mr Barber said, the tool can have any shape, adding that in the case of the registered design, the particular overall shape was chosen to make the product aesthetically distinctive.
25. Mr Wakefield agreed that a U-shape was a necessary minimum, but said that the particular shape of the Registered Design made the product more effective in bypassing the security hood of the letter box.

26. Mr Wakefield was not able to make clear how the precise shape of the Registered Design improves effective entry over reasonably possible alternatives and why that shape was required to achieve effective performance. I think it is likely that a designer of letter box tools has significant room for variation once the U-shape has been incorporated. Looking at the design corpus, it seems that even the U-shape can vary. I find that s.1C(1) of the 1949 Act has no bearing on the present case.

**Whether the Accused Design produces on the informed user a different overall impression to that produced by the Registered Design**

27. Mr Wakefield had five points. The first was that the angles of bend of the Registered Design differ from those of the Accused Design. Mr Wakefield annotated an image of the Registered Design marking the angles which he designated A to D with his measurements in degrees. I have reproduced that image as Annex 4 with argument from Mr Wakefield redacted. Mr Wakefield said that he had measured the equivalent angles A to D of the Accused Design which are respectively 90, 55, 35 and 60 degrees. He argued that this proved that the Accused Design produced a different overall impression.
28. Secondly, Mr Wakefield underlined that the Prototype comes in component parts. The core section, which is equivalent to what is shown in the Registered Design, is also in component parts. This means that it can be configured into different shapes. The user may or may not assemble the Prototype into the shape relied on by Mr Barber to allege infringement.
29. Thirdly, the Prototype has a scorpion logo on the handle. Fourthly, the Prototype is a different colour. Fifthly, the Prototype always comes with a handle.
30. Mr Barber did not dispute Mr Wakefield's measurement of the angles of the Registered Design and the Prototype although he said that he had not checked them himself. His response was that the Prototype was not really one design. Up to then, discussion with regard to the Prototype had centred on image A in Annex 2. Mr Barber pointed to another illustration of the Prototype in the evidence which I have reproduced as image B in the same Annex, being another Prototype with different angles. (A little care has to be taken with image B because it may have parts attached to the core of the Prototype influencing the perception of the shape of the core).
31. When asked by me, Mr Wakefield agreed that there was more than one Prototype. It seems that four were made and they were not identical, although only two alternative shapes were shown in the photographs in the evidence. Mr Wakefield said that angles of the Prototype which he had presented were taken from the version shown in Image A of Annex 2.
32. In principle it is possible that one or more of the four Prototypes infringes and some or all of the others do not. I know what two of the four look like, but not the other two. I will go with Mr Wakefield's measured angles and if necessary return to whether the detail of the angles matters.
33. Turning to Mr Wakefield's second argument, it raises a point of law: assuming that in one assembled configuration the Prototype produces a different overall impression to

that produced by the Registered Design but in another configuration it does not, does the Prototype infringe?

34. I have found no UK authority on this. In Stone, *European Union Design Law*, 2<sup>nd</sup> ed., the author says at para. 4.46:
- ‘Kits or self-assembly items may be different. The issue arose before the Rechtbank ‘s-Gravenhage in *Bike First International* [Case KG ZA 11-752, 22 July 2011]. The various defendants were involved in the sale of kits to be made up into children’s bicycles. If made in accordance with the instructions included with the kit, the bicycles did not infringe the plaintiff’s RCD 43658-0002. However, the central beam of the bicycle could be inverted, so that the bicycle would look much more similar to the design shown in the RCD. The court found that the fact that a consumer could put the bicycle together in an infringing way did not mean that the kit infringed – something more was required (for example, directions to construct the bicycle so that it is infringed the RCD).’
35. I have not been able to access the judgment in *Bike First*. I cannot be guided by directions accompanying the product as suggested by the Dutch Court since, unsurprisingly, there were none to accompany the Prototype.
36. I think I must approach this from basic principles. If on the facts there is a configuration of an accused product which the user is likely to adopt and in which configuration the product has a design which does not produce on the informed user a different overall impression to that produced by the Registered Design, I think it would be unsatisfactory if the marketing of the accused product can escape infringement solely because the product could in theory be configured in a different manner for use and in which configuration its design creates a different overall impression to that of the Registered Design. Adopting that view of the law would open up what may offer an easy route to using a registered design while evading infringement. This may be a question of fact and degree. As the *Rechtbank ‘s-Gravenhage* observed, directions may be important. I take the view that if the accused design would infringe in a configuration of the accused product likely to be used by the end user, that is sufficient to establish infringement under the Act.
37. In relation to this aspect of the case I can ignore the different angles discussed above in relation to Mr Wakefield’s first argument. Mr Wakefield told me that the way in which the component parts of the Prototype would likely be put together by the end user is in the configuration shown in the images of Annex 2. I find that I can assess infringement solely by reference to that configuration.
38. As to Mr Wakefield’s third, fourth and fifth arguments, I asked him to point out the scorpion logo on those images. He said that it was too indistinct to see. I will disregard the logo. Colour is not an issue; the Registered Design is in monochrome which, by convention, means that it claims a design irrespective of colour. Finally, the design claimed relates to the core part of a letter box tool. The fact that a handle can be added at one end is not relevant to the comparison of overall impressions of cores.

39. Having in mind the foregoing, I consider first the overall impressions created by the Registered Design as illustrated in Annex 1 and by the Prototype as shown in Annex 2, image (a).
40. Both have a substantially U-shaped section. The longer first side of the U shape ends at the termination of one end of the core. The shorter second side of the U shape is continued by the design extending at an obtuse angle away from the first side and then extends at an obtuse angle in the opposite direction before coming to an end. My conclusion is that, particularly when compared to the design corpus, the Prototype does not create a different overall impression to that created by the Registered Design.
41. It is not clear from Annex 2, image (b) where the core ends and the parts added to it begin. The main differences are that the U-bend is sharper, as is the angle of the shorter side extending away from the first side. However, again having regard to the design corpus, this version of the Prototype does not, in my judgment, create a different overall impression to that created by the Registered Design.

### **Whether Ultimate Tools has used the Accused Design**

42. Mr Barber's belief that the Prototype was sold, not as a prototype but as a final marketed product, came from the fact that it was clearly publicised in a trade fair and elsewhere. He particularly relied on a photograph in the evidence of the Prototype, in disassembled form, in a tool box with a lid on which is the label 'UltIMATE Tools from ALDRIDGE'. Aldridge is the name of a retailer of machine tools.
43. Mr Wakefield explained that one of the four prototypes was given to a Master Locksmith called Julian Alder so that he could test it and provide feedback. Mr Alder had a box of tools made by Ultimate Tools obtained from Aldridge. He used it as a convenient place to store the Prototype. The photograph relied on by Mr Barber was of Mr Alder's box with the disassembled Prototype in it. Mr Barber very fairly offered no reason to doubt the accuracy of Mr Wakefield's account of this and I accept it.
44. The Prototype was undoubtedly publicised in media posts and at least one trade fair. No examples of the Prototype have been sold. Only one left the defendants' possession, the one that was provided to Mr Alder for testing.
45. Sections 7 and 7A of the 1949 Act provide, so far as is relevant:

**'7 Right given by registration.**

*(1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.*

*(2) For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—*

*(a) the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or*



(b) *stocking such a product for those purposes.*

...

**7A *Infringements of rights in registered designs.***

(1) *Subject as follows, the right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which by virtue of section 7 of this Act is the exclusive right of the registered proprietor.*

(2) *The right in a registered design is not infringed by—*

(a) *an act which is done privately and for purposes which are not commercial;*

(b) *an act which is done for experimental purposes;'*

46. The Prototypes were made by Steven and Simon Wakefield for the business of Ultimate Tools. The acts of making and using were acts of infringement, subject to s.7A. There were no offers for sale. Possibly, the offer to supply a Prototype to Mr Alder was a further act of infringement, though I need not resolve that.
47. I have found no direct authority on the effect of s.7A(2)(a) and (b). The second limb of s.7A(2)(a) is satisfied: my understanding of Mr Wakefield's evidence is that neither the making and using of the Prototypes nor their supply to Mr Alder were done for commercial purposes.
48. With regard to the first limb of s.7A(2)(a), I take 'privately' to be the opposite of 'publicly'. In the case of 'putting on the market' it is hard to see how that could ever be done privately. 'Offering', on the other hand, could either be done privately or publicly, in the former case where an awareness of the supply is restricted to the supplier and recipient or recipients, or possibly also to some other limited category of people. Similarly an act of use could be either public or private.
49. Subsection 7A.(2)(a) is directed to acts which would otherwise infringe. The Prototypes were undoubtedly made public in media posts and at a trade fair. But those acts of making public were not acts of infringement under s.7(2)(a). The subsection contains the word 'includes' but I doubt that it was Parliament's intention (or the intention of the European legislature, see art. 19(1) of Council Regulation 6/2002) that a person who has done nothing but receive a product and shown it to others in public should be held to have committed an act of infringement.
50. The acts in issue are making and using the Prototypes and (arguably) offering one of them to Mr Alder. It would make little sense to say that the Prototypes were made publicly. As to offering, I have no reason to think that anyone other than Steven and Simon Wakefield and Mr Alder was aware of the act of supply. Likewise the use made of the Prototypes by the defendants does not seem to have been made public. Accordingly I find that, pursuant to s.7A(2)(a), the making and use of the Prototypes and their supply to Mr Alder were not acts of infringement.

51. I am more doubtful about whether those acts fall within s.7A(2)(b). They were made and used by Steven and Simon Wakefield for the purpose of testing with regard to function but also with regard to likely market response. It may be stretching the term 'experimental purposes' to include the exploration of marketing potential, as opposed to the more obvious meaning of experiments to explore an article's performance in use. I need not decide the point.
52. I find that pursuant to s.7(1) and (2) and s.7A(2)(a) there has been no infringement of the Registered Design.

**Whether either Steven or Simon Wakefield is jointly liable**

53. The joint liability of Steven and Simon Wakefield does not arise.

**Relief**

54. I have reviewed the six issues which seemed to arise from the pleadings and arguments made before the trial. Had there been legal representation there would have been no need to go further.
55. In the present case I do not think that would be fair to the parties. At best, they are liable to be left wondering whether a finding of non-infringement means that the defendants are free to take the Prototype forward towards the sale of products made commercially. At worst, the defendants may assume that they have been given a green light to do just that, which is likely to lead to a future waste of the court's and the parties' time.
56. The effect of my findings is that if the defendants were to market commercially letter box tools of the shape the same as or sufficiently similar to that of the Prototype, they would infringe the Registered Design. I asked Mr Wakefield what his and the company's plans were regarding the Prototype. He said that time has gone by and his attention has move on to other projects, but if the court were to find that he was free to market letter box tools like the Prototype, he would consider taking it forward.
57. This is not a case in which it has been either possible or sensible for the proceedings to be conducted with close attention to the wording of the pleadings. It seems fair for me to assume, as is likely, that Mr Barber intended to seek an injunction if there was a threat of future infringement. Given what Mr Wakefield told me, there is a threat – by which I do not imply any sort of criticism of Mr Wakefield or his brother. I therefore think that an injunction should be granted. The defendants would be wise to ensure that any letter box tool they market in the future looks conspicuously different from the Registered Design. This only applies until the Registered Design expires.
58. No other relief is appropriate. Nothing has been done which would warrant an inquiry as to damages or an account of profits. As to costs, neither side was legally represented, honours in the case are about even, so I will make no order as to costs.