

COPYRIGHT, DESIGNS AND PATENTS ACT 1988

IN THE MATTER OF references under
Section 246(1) by Christopher Ronald Tasker
for determination of subsistence, term and
ownership of design right in certain designs,
and oppositions thereto by (1) Raymond
Wilson and (2) Victor J Colley

DECISION

Background

1. The referrer, Christopher Ronald Tasker is a designer and manufacturer of sliding mirrored door wardrobes and, in partnership with his wife, trades as Alvista Wardrobes (“Alvista”). Between 1988 and 1995 Mr Tasker designed and manufactured a number of different sliding wardrobe door systems which he identified as Series 200, 300 and 400. In each system the doors were made up of a mirror panel mounted in a frame formed from aluminium extrusions. The aluminium components in the Series 300 Mark I and Series 400 Mark I were identical, the systems differing in that the 400 Series had medium-density fibreboard (“MDF”) mouldings secured to the aluminium extrusions, to conceal the latter as far as possible.

2. The opponents are two competitors of Mr Tasker. Raymond Wilson is managing director of Britannia Wardrobes Limited (“Britannia”), a company he formed in 1985. Victor J Colley, in partnership with his wife, trades as Swan Systems, formerly known as Ideal Doors. Both Britannia and Mr Colley design and manufacture sliding mirrored door wardrobes using aluminium extrusions, including systems in which MDF mouldings are used to conceal parts of the extrusions.

3. In December 1998, Mr Tasker launched an action in the High Court against Mr Colley claiming infringement of design right in certain aspects of shape and configuration of his Series 400 wardrobe system. The action was stayed *sine die* by a consent order “pending determination of the dispute between the parties under Section 246 of the Copyright, Designs and Patents Act 1988” (“the CDP Act”). Mr Tasker accordingly launched not one but two simultaneous actions under Section 246, naming Mr Wilson and Mr Colley respectively as the other party to the dispute. Mr Wilson was not a party to the High Court action, but he has not objected to being named as a defendant so I assume that, even though it may not have got as far as a High Court action, there was a dispute between Mr Tasker and Mr Wilson as well. I observe that although technically it was Mr Wilson who was named as the defendant, both sides have behaved in much of the correspondence as though the defendant were not Mr Wilson personally but his company, Britannia Wardrobes Limited. I do not think much turns on this, save that any order I make will have to refer to Mr Wilson rather than Britannia.

4. Since both actions related to exactly the same alleged design right, by agreement of the three parties the actions were consolidated. Following the filing of evidence by the parties the matter came before me on 28 and 29 February 2000. At the hearing, Mr Tasker represented himself, and Mr Edenborough appeared for both defendants. Mr Edenborough was instructed by Sommerville & Rushton, patent agents for Mr Wilson, and Blake Laphorn, solicitors for Mr Colley.

Technical field

5. Sliding door wardrobes generally comprise top and bottom tracks secured to ceiling and floor respectively, the top track having an E-shape in section, defining a pair of parallel channels to receive the sliding doors, and the bottom track having rails or like on which the doors slide. Mirror panels for the doors are mounted in a frame comprising top and bottom rails and a pair of side stiles. The rails and stiles have a channel, known as a glazing channel, for receiving the edge of the mirror panel. One or both side stiles generally have some form of handle to enable the door to be gripped for moving. Wheels are secured to the rear of the frame near the bottom corners to engage with the rails, and the top edges of the doors are

located in adjacent channels of the top track. It is known to make the frame members of mirrored doors from wood, MDF, steel or aluminium. Aluminium components are formed by extrusion, and in order to provide sufficient rigidity the side stiles generally comprise a hollow box section.

6. Whilst aluminium has the advantage of lightness and rigidity, it has the disadvantage that its surface oxidises over time and becomes visually unattractive. It is possible to prevent this by coating or anodising the surface of the aluminium, but both these processes add significantly to the cost. An alternative approach is to conceal the surfaces of the aluminium as far as possible with another material. Such materials include wood, MDF, veneer or foil, the latter being a decorated adhesive tape simulating a wood-grain or similar finish.

7. Mr Tasker's Series 400 wardrobe system uses MDF mouldings of various forms secured to the rails, stiles and track, and it is various aspects of these components as well as of the overall sliding wardrobe door system, which are the subject of this action.

The Law

8. This dispute is being brought under section 246 of the CDP Act, which 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.

This section has, as yet, been little used. Indeed, this is only the second reference to have been made under this section, and the first which has got as far as a substantive decision. However, whilst the comptroller has not yet been widely called upon to rule on the subsistence, term or

ownership of design right, the courts have had to consider these issues when hearing design right infringement actions, so there is now a small but growing body of case law.

9. In his references to the Comptroller, Mr Tasker has requested determination under all three limbs of section 246, ie subsistence, the term and ownership (or strictly, first ownership), with regard to various aspects relating to his Series 400 wardrobe system. The most important issue in dispute in the present case is subsistence. This is covered mainly (but not entirely) by section 213 of the Act, which reads as follows:

(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),

or in accordance with any Order under Section 221 (power to make further

provision with respect to qualification).

(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.

(7) Design right does not subsist in a design which was so recorded, or to which an article was made, before the commencement of this Part.

10. There are a number of elements to this section: the definition of “design” in subsection (2); the exclusions from that definition in subsection (3); the requirements for originality in subsections (1) and (4); the geographical qualification of subsection (5), amplified by sections 217 to 221 which I shall consider later, and the requirements for recording the design of subsections (6) and (7). Anyone asserting design right needs to be able to show that all these elements are satisfied, and accordingly in this decision I will go through them one at a time.

11. 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.

12. Finally, ownership is covered by section 215, the relevant parts of which read:

(1) The designer is the first owner of any design right in a design which is not created in pursuance of a commission or in the course of employment.

(3) Where . . . a design is created by an employee in the course of his

employment, his employer is the first owner of any design right in the design.

The claim to design right

13. 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:

“ ... 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.”

14. 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 the *Farmers Build* case at page 484, where he said, in deciding that design right did not subsist in a particular sub-assembly 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.”

15. As Mr Tasker rightly pointed out, an “aspect of the shape or configuration” could include detailed dimensions. Indeed, this was explicitly stated by Laddie J in *Ocular Sciences Ltd & Anr v Aspect Vision Care & Ors* [1997] RPC 289, on page 423. Further - and here I disagree with Mr Edenborough’s submission to me - it could in some circumstances include the materials used, although the mere choice of materials may often be ruled out by the exclusion in Section 213(3) of methods or principles of construction. However, in contrast to registered designs, visibility and eye appeal are irrelevant.

16. In his original statement, Mr Tasker claimed design right in the whole external shape and configuration of his Series 400 system wardrobe, as well as in several components of the Series 400 system. When the defendants complained that he had not sufficiently particularised the aspects in which he was seeking design right, the Office invited him to set out his claim more clearly. This he did in a letter of 22 March 1999 to the Office, which was accompanied by some sketched drawings and samples of three of the components, identified as Exhibits 1, 2 and 3. The relevant part of the letter is as follows:

17. “CLAIMS OF DESIGN RIGHT

ARTICLE I:

The Alvista 400 series Mk I sliding wardrobe system. This system consists of door stiles (Article 2), door rails (Article 3), and top track (Article 4). The photograph at appendix 3 of the statement of case only gives the respective locations and scale of the components of the Alvista 400 series Mk I system. In the photograph the object attached to the ceiling is Article 4 which is specified by Exhibit 1; the top rail of the doors is the arched rail version of Article 3, the bottom rail of the door is the straight rail version of Article 3 which is specified by Exhibit 2; the side stiles of the doors is Article 2 which is specified by Exhibit 3.

The aspects in which I claim design right are:

The whole external shape and configuration of the Alvista 400 series Mk I system

which has been defined as the combination of Article 2, Article 3 and Article 4.

ARTICLE 2: 400 SERIES SIDE STILE

A door stile of a sliding wardrobe door as illustrated by Exhibit 3, and shown in cross section in exhibit TPH4 to Mr Hallett's affidavit, formed from an aluminium extrusion and two MDF mouldings. The side MDF moulding completely conceals the aluminium from the side view and has a part cut out to form a handle grip. The front moulding almost completely conceals the aluminium from the front view, the only visible aluminium being two thin lines.

The aspects in which I claim design right are:

- A] the overall external appearance (all aspects of external shape).
 - B] the configuration of MDF mouldings bonded onto the aluminium extrusion with the objective of concealing the aluminium -100% concealment from the side view, and nearly 100% from the front view.
 - C] the narrow internal channel (width less than 5mm) in the aluminium extrusion. Full dimensions of this channel given in drawing at appendix 9 of further statement.
- Drawing headed Alvista wardrobes series 300 Mk I.

ARTICLE 3: 400 SERIES RAIL

A door rail of a sliding wardrobe door as illustrated by Exhibit 2, and shown in cross section in attached drawing headed Article 3, formed from an aluminium extrusion and MDF mouldings. The mouldings were either straight or arched and totally concealed an aluminium rail from the front view. The aspects in which I claim design right are:

- A] the overall external appearance (all aspects of external shape)
- B] the configuration of the MDF moulding bonded onto the aluminium extrusion, totally concealing the aluminium from the front view.
- C] the narrow internal channel in the aluminium extrusion [width less than 5mm]

ARTICLE 4: 400 SERIES TOP TRACK

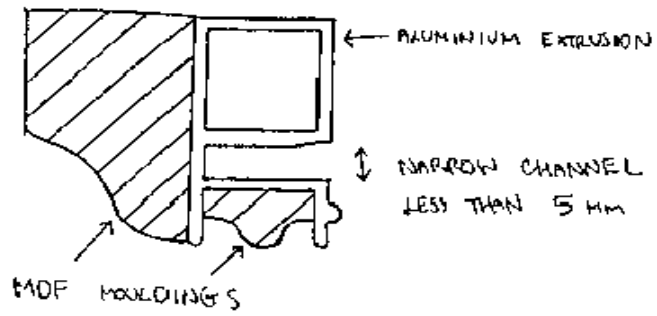
A top track for sliding wardrobe doors as illustrated by Exhibit 1, and shown in cross section on attached drawing headed Article 4, formed from an aluminium extrusion and one MDF moulding. The MDF moulding is bonded onto an aluminium E track so that the moulding totally conceals the aluminium from the front view. The aspects in which I claim design right are :

A] the overall external appearance [all aspects of external shape].

B] the configuration of the MDF moulding bonded to the aluminium extrusion so that the MDF moulding totally conceals the aluminium from the front view. ”

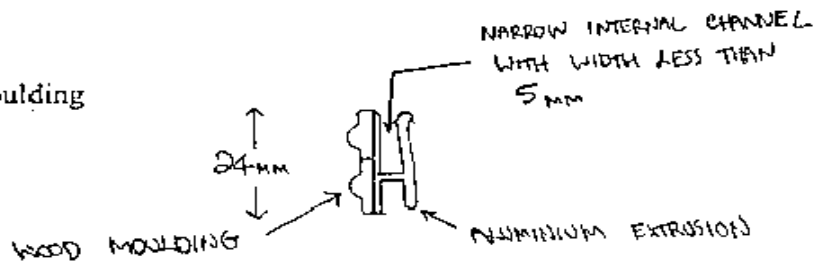
18. In correspondence between the Office and the parties following receipt of Mr Tasker’s letter of 22 March 1999, it was proposed and agreed that this statement of claim would be regarded as the basis of Mr Tasker’s case. At the hearing there were apparent attempts by Mr Tasker to shift his ground and narrow his claim, saying for example that his claim was “precisely those exhibits, to that precise shape”, and reinforcing this with a number of similar comments. However, he did not withdraw his claims to the more general aspects, such as the use of a narrow channel, and from the evasive comments he made when Mr Edenborough tackled him on what might infringe the design right he was claiming I do not think he intended to do so. Indeed, I gained the impression that Mr Tasker might have been hoping he could persuade me simply to make a broad finding that he had design right in these articles without being specific about any aspects, so that he could then continue his infringement litigation by arguing that the alleged infringing products were, in the words of section 226(2), “substantially to that design”. I do not think the High Court would thank me for ducking my responsibility in this way. Moreover, as I have already said, design right does not subsist in an article, but in aspects of the shape and configuration of the article. Accordingly the

ARTICLE 2

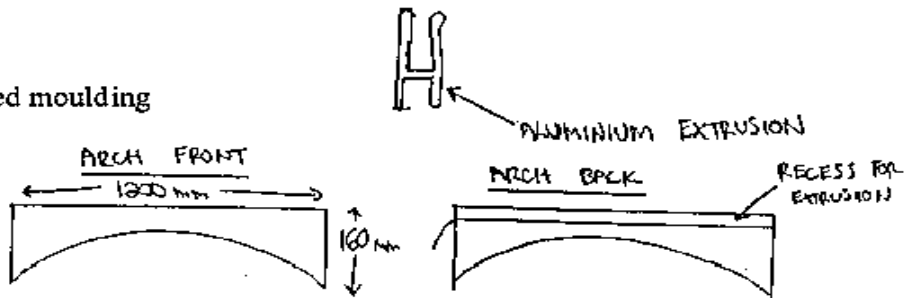


ARTICLE 3

a) Straight moulding



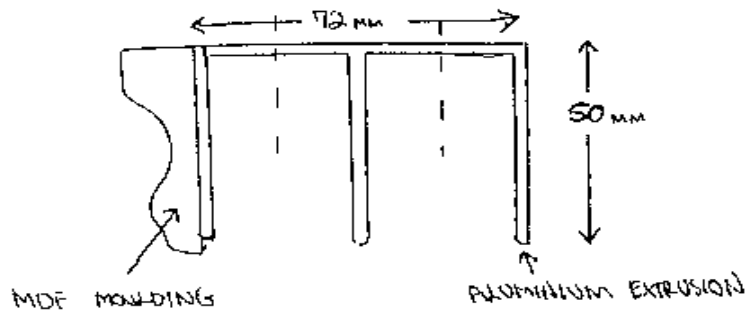
b) Arched moulding



TRACK CENTRE SPACING

← 35.1 mm →

ARTICLE 4



present decision has been made on the basis of all the claims set out by Mr Tasker in the above-mentioned letter.

19. I have included copies of the drawings of Articles 2, 3 and 4 in this decision, but I need to say a word about them. So far as Article 2 is concerned, the aluminium extrusion of Exhibit 3 differs from the drawing in TPH4 in three respects. Firstly, the box section has a distinct chamfer at the entrance to the glazing channel. Secondly, there is a rib of semicircular cross section running down one arm of the forward-facing U section. Thirdly (though probably less importantly) there is a shallow groove running down one face of the box section. Since at the hearing the parties concentrated on Exhibit 3, not TPH4, I shall do the same. In other words, so far as Article 2 is concerned, my decision will be based on Exhibit 3, not the drawing in TPH4. To avoid confusion, in the drawing of Article 2 included with this decision I have modified the drawing from TPH4 myself to show the chamfer and the rib.

20. There is also a minor difference between Exhibit 2 and its drawings, but only to the extent that one of the drawings appears to show one side of the aluminium H section being thicker than the other, whereas in the Exhibit they are the same thickness. I take this to be no more than sloppy drawing, and again will base my decision in respect of Article 3 on the assumption that the thicknesses are the same. I will observe that Article 3 actually embraces two articles, one with two straight mouldings running side by side along the front face (as in Exhibit 2), the other with an arch attached to the front face. Further, the first of these articles actually has mouldings of wood, not MDF as implied in Mr Tasker's claim, so I have interpreted his claim accordingly.

21. Finally, Exhibit 1 has an additional moulding attached to the back face of the aluminium channel. Mr Tasker made clear that this was simply there to illustrate the type of moulding that had been used in an earlier prototype. My decision in respect of Article 4 is therefore based on Exhibit 1 minus this additional solid wood moulding, as shown in the drawing included with this decision.

22. In looking at subsistence of design right, it will be convenient at each stage to consider

first the three individual components, namely Articles 2, 3 and 4, identified by Mr Tasker against the various tests for design right, and then consider the whole wardrobe door system, ie Article 1.

The evidence

23. All of the parties have submitted written evidence. Some of it is, quite frankly, not very satisfactory, and accordingly after the evidence had been filed I took the unusual step of asking for the attention of the parties to be drawn to defects in the evidence. Some, but not all, of those defects were subsequently rectified. In the event no party made an issue of the remaining defects, so I have taken the evidence as it stands, attaching such weight to those parts that are hearsay as seems fit.

24. Mr Tasker cross examined three of those who had given written evidence for the defendants, Messrs Wilson, Colley and Gillies. I have to say that much of his cross examination was of no assistance at all, being aimed at proving facts that did not really further Mr Tasker's case. Nevertheless, for what it is worth, I must assess the three witnesses. Mr Wilson I found to be consistent, clear and plausible. I am aware that he did not have a particularly favourable view of Mr Tasker, but I am satisfied that this did not colour his evidence. I find him to have been an honest witness and I accept his evidence as reliable. Mr Colley was clearly nervous and was reluctant to answer Mr Tasker's questions because he appeared to assume that Mr Tasker was trying to trick him. The situation was not helped by the line of questioning that Mr Tasker followed. The outcome is that I gained very little assistance from his testimony. Mr Gillies I found to be honest, but he had little detailed memory of events and Mr Tasker's line of cross examination was unproductive, so in the event, I found his oral evidence of little value.

25. Mr Tasker was also cross examined. I found him to be not wholly convincing under cross-examination, particularly with regard to the drawings allegedly made in 1988. I felt that Mr Tasker was being selective in the evidence he gave, and the latter was coloured by what he believed he needed to prove. I therefore feel bound to treat his evidence with caution.

26. I must make one other observation on the interpretation of the evidence. Mr Tasker all too readily drew extensive conclusions from the positive statements or omissions in the evidence of witnesses that went way beyond what one could reasonably deduce. In addition, he was fond of using a dictionary definition of a common word to “prove” what the witness must have meant when they used that word. This sort of argument carries no weight whatsoever, because witnesses do not go around with a dictionary in hand, carefully checking the meaning of each word before they utter it or write it. One has to look at what was said or written in the round to understand what the witness was trying to convey, just as one would do in real life.

Methods or principles of construction

27. I will now start looking at the various elements set out in Section 213. Subsection (3)(a) excludes from design right protection methods or principles of construction. The exact wording of the statute is: “Design right does not subsist in a method or principle of construction”. In his analysis of this Section, Mr Tasker attempted to interpret it with the aid of definitions taken from the Oxford English Dictionary. In brief, he suggested that according to the dictionary a design in subsection (2) meant a plan, a designer is one who makes designs or plans for construction, a plan is a method by which a thing is to be done, and so “design” must mean “the method of construction of an article”. He then went on to question why, in the light of this, subsection (3)(a) existed, pointed out that what it excludes is a method as opposed to the method, and seemed to end up concluding, rather unhelpfully, that what it excludes is a method or principle of construction and that it cannot apply to a particular article. This rather tortuous argument is ill conceived on two counts. Firstly, the language of statutes should wherever possible be construed by looking at the plain meaning of the words, not by piecing together definitions plucked out of context from a dictionary, and on its plain meaning subsection (2) is not referring to methods of construction. Secondly, Mr Tasker is overlooking the fact that design right subsists not in articles but in aspects of shape or configuration. In short, I do not think his argument helps at all in understanding subsection (3)(a).

28. There is no case law under the CDP Act 1988 to give any guidance on the interpretation of this particular sub-section. However, the registered design legislation as embodied in part IV of the Act also excludes from protection a method or principle of construction, and this exclusion is carried back through previous legislation in like terms at least to the Patents and Designs Act 1907. Mr Edenborough argued that it was reasonable to have regard to the way in which the phrase has been interpreted under Registered Design legislation in the past, and I agree. In *Pugh v Riley Cycle Company Ltd* [1912] 29 RPC 196, which was drawn to my attention by Mr Edenborough, Parker J, in considering the registrability of a design relating to a vehicle wheel, said:

“A conception or suggestion as to a mode or principle of construction, though in some sense a Design, is not registrable under the Act. Inasmuch, however, as the mode or principle of construction of an article may affect its shape or configuration, the conception of such a mode or principle of construction may well lead to a conception as to the shape or configuration of the completed article, and a conception so arrived at may, if it be sufficiently definite, be registered under the Act. The difficulty arises where the conception, thus arrived at, is not a definite conception as to shape or configuration, but only a conception as to some general characteristic of shape and configuration, necessitated by the mode or principle of construction, the definite shape or configuration, being, consistently with such mode or principle of construction, capable of variation within wide limits. To allow the registration of a conception of such general characteristics of shape or configuration might well be equivalent to allowing the registration of a conception relating to a mode or principle of construction.”

29. Mr Edenborough also drew my attention to *Kestos Ltd v Kemp Ltd and Vivian Fitch Kemp* [1936] RPC 139 which was again a registered design case brought under the consolidated Patents and Designs Acts 1907-1932. In that case, Luxmore J said in considering registrability:

“Further, anything which amounts solely to a mode or principle of construction cannot be the subject-matter of registration under the Consolidated Acts. A mode or principle of construction is a process or operation by which a shape is produced as opposed to the shape itself. I agree with the statement to be found at page 17 of Mr Russell-Clarke’s useful work, “Copyright in Industrial Designs”: “To say that a shape is to be denied registration because it amounts to a mode or principle of construction is meaningless. The real meaning is this, that no design shall be construed so widely as to give to its proprietor a monopoly in a mode or principle of construction. What he gets a monopoly for is one particular individual and specific appearance. If it is possible to get several different appearances which all embody the general features which he claims, then those features are too general and amount to a mode or principle of construction.”

30. 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.

31. On that basis, I will now consider which, if any, of the aspects of Mr Tasker’s claim fall foul of the exclusion specified in Section 213(3)(a). Article 2 is the side stile, with an aluminium extrusion of a specific cross section to which are secured two MDF mouldings. With regard to this item Mr Tasker claims design right firstly in “the overall external appearance (all aspects of external shape)”, and I am satisfied that this does not relate to a method or principle of construction.

32. Secondly Mr Tasker claims design right in “the configuration of MDF mouldings bonded onto the aluminium extrusion with the objective of concealing the aluminium - 100%

concealment from the side view, and nearly 100% from the front view”. Now if this were simply a claim to mouldings of this particular shape bonded on to an aluminium extrusion of this particular cross section, it would not differ from the first claim. Thus it can only be construed as a claim to the general concept of using MDF mouldings of unspecified shape or configuration to conceal an aluminium extrusion likewise of unspecified shape or configuration, and on this basis, applying the principles I have just discussed, it is a method or principle of construction and so is excluded from design right protection.

33. Thirdly, Mr Tasker lays claim to design right protection for “the narrow internal channel (width less than 5mm) in the aluminium extrusion” and refers to the full dimensions of this channel given in a drawing. There is some ambiguity regarding the scope of this claim, with regard to the size of the narrow channel. Although the claim mentions in general terms a width of less than 5 mm, the full dimensions in the drawing referred to specify a width of 4.45 mm (and incidentally a depth of 13.8 mm). The purpose of the narrow channel is to enable the stile to cooperate with a standard mirror panel whose thickness is 4 mm, using only glazing tape. Going beyond the precise form as specified by the exact dimensions takes one into a situation where the channel width may vary between 5 mm and, say, 4 mm. (I postulate this lower limit as it corresponds to the thickness of the glass panel). In the context, I would regard this as a substantial variation in shape or configuration. In addition, the point was well made by Mr Edenborough that the depth of this channel is not specified, and thus, I think it is fair to say that, in the words of Parker J in *Pugh v Riley Cycles Limited*, one has “not a definite conception as to shape or configuration, but only a conception as to some general characteristic of shape and configuration, necessitated by the mode or principle of construction, the definite shape or configuration, being, consistently with such mode or principle of construction, capable of variation within wide limits”. On that basis, I conclude that the broad concept of a narrow glazing channel, namely one of width less than 5 mm, is in fact a method or principle of construction and so is not protectible by design right.

34. Turning now to Article 3, this is the door rail comprising an aluminium extrusion of generally H-shape in section. In one version of this Article there are a pair of identical wood mouldings which effectively completely conceal one face of the extrusion. In the second

version there is an arch attached to this face instead, the rear of the arch having a rebate at its top edge identified as ‘recess for extrusion’. In addition to claiming design right in the overall external appearance, (which again I find not to be a method or principle of construction), Mr Tasker claims the configuration of the MDF moulding bonded onto the aluminium extrusion, totally concealing the aluminium from the front view, and the narrow internal channel in the aluminium extrusion (width less than 5mm). As for Article 2, I find that the generalised claims to the configuration of MDF mouldings bonded to the aluminium extrusions totally concealing the aluminium, and to a narrow (less than 5 mm) glazing channel to be excluded from design right protection since they essentially relate to methods or principles of construction.

35. Article 4 is the top track, and comprises an aluminium extrusion of E-shape in cross-section, an MDF moulding being secured to the outer face of one of the end limbs of the E to totally conceal this face. Mr Tasker claims rights in the overall external appearance, and again I am satisfied that this does not relate to a method or principle of construction. For this article Mr Tasker also claims protection for the configuration of the MDF moulding bonded to the extrusion so that it totally conceals the extrusion when viewed from that direction. Again I find this amounts to a method or principle of construction and thus is excluded from design right protection.

36. Finally, considering Article 1, namely the overall Alvista 400 Series MkI sliding door wardrobe system, Mr Tasker is claiming design right in the “whole external shape and configuration”. I am satisfied that this does not relate to a method or principle of construction and so is not excluded under Section 213(3)(a) of the Act.

‘Must fit’ aspects

37. Considering now Section 213(3)(b)(i) of the Act, this lays down 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. This is commonly referred to as the ‘must fit’ exclusion. Mr Tasker, in his argument, considered the meaning of “the article” and “another article” in the statute, and

having regard to the definition of “another” in the Oxford English Dictionary (*ie* “a second in effect, a second in likeness of character or attributes, a counterpart to”) concluded that, as the two articles may differ in appearance, the likeness of character lay elsewhere. By referring to Section 213(3)(b)(ii), which also refers to “the article” and “another article” and, he suggested, links them by a common designer, he postulated that a common designer is also the link in Section 213(3)(b)(i). Mr Tasker then went on to conclude, if I understood him correctly, that the exclusion of Section 213(3)(b)(i) did not apply where the designer of “the article” was not also the designer of “another article”. He drew my attention to *Ford Motor Co. Ltd’s Design Applications* [1994] RPC 545 and [1995] RPC 167, which, he suggested, confirmed his interpretation. Mr Edenborough suggested that this analysis was quite wrong.

38. I, too, find this argument flawed for the following reasons. Firstly, as I have already indicated, the mechanistic use of a dictionary to interpret terms used in the statutes is misguided and can, occasionally, lead to absurd conclusions. I can do no better than quote the words of Mummery LJ in *Farmers Build Ltd v Carier Ltd* [1999] RPC 461 where he says on page 478:

“No question of interpretation can be resolved simply by dipping into a dictionary. It is not the function of lexicographers to construe statutes.”

Secondly, as Mr Edenborough pointed out, the *Ford Motor* cases related to Registered Design applications rather than design right. Moreover, they were decided under Section 1(1)(b)(ii) of the Registered Designs Act 1949 (as amended by Section 265 of the CDP Act 1988), commonly known as the “must match” provision. The wording of this sub-section of the Registered Designs Act 1949 (as amended) corresponds exactly with the wording of the design right provisions in Section 213(3)(b)(ii), but there is no sub-section which corresponds to Section 213(3)(b)(i), other than a blanket exclusion of Section 1(1)(b)(i) for any feature of shape or configuration which is dictated solely by the function which the article has to perform. In the *Ford Motor* cases “the article” was a vehicle door panel, and the “another article” was the complete vehicle and it was a matter of fact in those cases that the designer of both were the same. I find nothing to suggest that the exclusion of Section 213(3)(b)(i) only

applies when both articles are designed by the same designer.

39. The purpose of Mr Tasker's reasoning was to support his argument that any aspect of his articles that were for the purpose of attaching to an article which he had not designed did not fall foul of the "must fit" exclusion of Section 213(3)(b)(i). In particular, he put it to me that as he was not the designer of the 4 mm thick mirror panels used in his sliding doors, any aspect of his design that was for connecting to such a mirror panel, namely narrow glazing channels, could not be regarded as a "must fit" feature. As I have said, I reject this reasoning. Mr Tasker seeks design right for the narrow glazing channel in his side stile (Article 2) and in his rail (Article 3). I note that the shape and configuration of the glazing channel in these two components is different; in the side stile, the channel is formed with parallel side walls, whereas in the rail the side walls of the channel converge slightly, and one of the side walls flares outwards at its end. I have to ask myself whether this variation in form points to a design freedom which goes against the concept of the feature of shape or configuration being dictated by the need to connect to another article. I think this question has been succinctly answered by Laddie J in *Ocular Sciences, supra*, where he says on page 424:

"This [*ie* Section 213(3)(b)(i)] is sometimes referred to as the interface provision. Its original purpose was to prevent the designer of a piece of equipment from using design right to prevent others from making parts which fitted his equipment. As I read it, any features of shape or configuration of an article which meet the interface criteria must be excluded even if it performs some other purpose, for example it is attractive. There is also nothing in the provision which requires the feature to be the only one which would achieve the proper interface. If a number of designs are possible each of which enables the two articles to be fitted together in a way which allowed one or other or both to perform its function, each falls within the statutory exclusion."

Thus the mere fact that there is more than one possible design for this channel does not save it.

40. There is, though, another consideration. In *Baby Dan AS v Brevi SRL* [1999] FSR 377, David Young QC, sitting as a Deputy Judge of the High Court, said, in relation to the

design of a baby barrier made up of a number of component parts, that the plaintiff:

“... is entitled to rely on design rights relating to various parts of a baby barrier as part of a larger article, namely the baby barrier, and hence the effect of section 213(3)(b)(i) is not to exclude the shape or configuration of the various parts necessary to enable such parts to be assembled.

Alternatively, and in addition to such design rights, I consider there will subsist separate design rights in those component parts *per se*. In this case the shape or configuration of the various parts are circumscribed by the “must fit” provisions, so that the subsistence of design rights in such parts *per se* if they subsist at all will be of considerably narrower scope.”

41. Thus if one is considering design right in an article made up of a number of component parts, such as Mr Tasker’s overall wardrobe door system, the exclusion does not apply to the shape or configuration of the various parts necessary to enable those parts to be assembled, but that if one is considering design rights in the component parts *per se*, such as the stile or rails, the must fit exclusion would bite on those features which enable these parts to be assembled with other parts such as the mirror. On this basis, it is clear, I think, that the glazing channel in the side stile (Article 2) and in the rail (Article 3) falls fairly and squarely within the scope of Mr Justice Laddie’s comments in *Ocular Sciences*, taking account also of *Baby Dan*. I conclude that the glazing channel in these Articles is a “must fit” feature and accordingly, insofar as it has not already been excluded under the “method or principle of construction” exclusion, it is excluded from design right protection by the provisions of Section 213(3)(b)(i). However, on the basis of *Baby Dan*, the exclusion does not apply to Article 1, the wardrobe door system as a whole. It would apply to Article 4, the top track, if Mr Tasker were claiming design right in the shape, size or configuration of the double channels, since these are designed to take the sliding doors, but he is not.

‘Must match’ aspects

42. Although the “must match” requirement of Section 213(3)(b)(ii) was referred to in Mr Tasker’s submissions, it was merely in support of his interpretation of the ‘must fit’ requirements of Section 213(3)(b)(i), and I have already dealt with this. In the absence of any other arguments on this issue, I need not consider it any further. Indeed, the requirement is not very relevant in the present case.

Surface decoration

43. Section 213(3)(c) states that design right does not subsist in surface decoration. Although Mr Colley in his counterstatement argues that the MDF moulding located in the channel on the front of the side stile (Article 2) and the two mouldings on the rail (Article 3) amount to no more than surface decoration, at the hearing Mr Edenborough did not address me at all on this point, and Mr Tasker only made a passing reference to the issue, referring me to *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe)* [1998] FSR 63. In that case it was put to Parker J that the term “surface decoration” should be limited to features which were essentially two-dimensional, such as a painted finish. Rejecting this argument, he said:

“I can see no reason to give the expression such a restrictive meaning, nor can I see any reason why what would otherwise be surface decoration should cease to be such merely because it also happens to serve some functional purpose, for example decorative beading which serves to conceal a joint.”

44. Thus Parker J rejected the notion that ‘surface decoration’ excluded three dimensional surface features, and indeed went further to add that such features were not necessarily saved by having some additional functional purpose. I am aware that, as in Parker J’s example, concealment is the purpose of the MDF mouldings in Mr Tasker’s Articles 2, 3 and 4, so one might be tempted to conclude that the MDF mouldings attached to the aluminium extrusions amount to no more than surface decoration with the added purpose of concealment, and as a consequence, that aspect of the design should be denied design right protection. However, I think this is going too far. As Parker J put it just before the above quoted passage, “surface

decoration” can include decorative features of the surface itself, such as beading or engraving. However they must be decorative features of the surface, and in the present case I am satisfied that the addition of mouldings to the aluminium extrusions goes beyond this.

45. So far as the design of the MDF mouldings themselves are concerned, there comes a point when surface contours are on a sufficiently large scale that they cease to be mere surface decoration, although they may still be decorative. In this instance, I would accept that the little semicircular beads running down the smaller mouldings of Articles 2 and the first version of Article 3 are no more than surface decoration and thus excluded from design right, but the same does not, in my view, apply to the contours of the larger mouldings on Articles 2, 3 and 4.

Recording in a design document/article made

46. I will skip subsections (4) and (5) of Section 213 for the moment and jump to subsection (6). This specifies that 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. In his second affidavit, Mr Tasker stated that he designed the Alvista Series 300 and 400 wardrobes in 1988, but then went on to say: “most of my original design work in 1988 is lost except for one prototype drawing”. He has acknowledged that this drawing, which shows in cross-section an aluminium extrusion, does not correspond to any of the extrusions featured in the Articles in which he is now asserting design right. He also states that in February 1991, he demonstrated prototypes to potential customers, however the earliest documentary evidence of any sales is in March 1993.

47. Under cross-examination, when asked about making the designs in 1988, Mr Tasker said:

“when I stated that they were designed in 1988, that was more conceived in my mind. I would not say that there were any final drawings. I do not have the drawings but I would not say that there were any drawings in 1988 for any of these articles. That is

why all my design claims are what I produced and sold in 1991.”

When I sought clarification from Mr Tasker on this issue he maintained that there never were any drawings in 1988 relating to the designs at issue. As I understand him, he is saying that he had his ideas for the design of the 300 and 400 Series in 1988, and whilst he committed to paper some ideas from that time, they were not for the 300 and 400 Series as we now see them, the ideas for the latter never being committed to paper.

48. I find his evidence on this issue deeply unsatisfactory. To put it very bluntly, it suited Mr Tasker to have an early date for conception of the idea in order to strengthen his arguments on originality, which I shall come to shortly. On the other hand, and as Mr Tasker was well aware, it would have killed his case if he had recorded his designs in 1988, because Section 213(7) excludes from design right protection designs which were recorded or made prior to the commencement of Part III of the CDP Act, namely 1 August 1989. If the designs in question were recorded in a design document in 1988, under Section 51 and paragraph 19 of Schedule I of the CDP Act they might have had copyright protection up to 31 July 1999, but they would not now have design right protection. A further consequence would be that I would have no jurisdiction since the issues before me would be matters of copyright and not design right. Thus Mr Edenborough urged me to accept that Mr Tasker recorded his designs in a design document in 1988, whilst Mr Tasker urged me to find that he had not.

49. In my view, I do not think I have been given the full picture of what went on in 1988 and Mr Tasker comes very close to failing on onus on this issue. However, I feel there is just about enough evidence to satisfy me, on the balance of probabilities, that whatever may have been designed and recorded in 1988, it was not the specific aluminium extrusions and MDF mouldings now before us. Before I go on, I should observe that whilst it is clear that the sole 1988 drawing that Mr Tasker has filed does not show a profile from the Alvista Series 400 wardrobe, it does show a narrow glazing channel. This feature has thus been recorded in a design document before the date of commencement of Part III of the CDP Act 1988, and had I not already rejected the claim to design right in this feature, I would now be doing so. Apart from this, no design documents have been shown to exist for the purposes of Section 213(6).

50. The evidence to support Mr Tasker's assertion that prototypes of his Series 400 wardrobe were shown to potential customers in February 1991, is a single letter from a Mr Ladbrook, filed by Mr Tasker with his statement. The letter, written in 1998, states that Mr Ladbrook visited Mr Tasker's house on 12 February 1991 and was shown prototypes of wardrobes that Mr Tasker called his 400 series and which had wood mouldings bonded on to aluminium and stick-on arches, and also "a white 300 series with white stick-on MDF arches". I need hardly say that this is not exactly convincing evidence that what Mr Ladbrook saw was the 400 Series we are considering today. However I am, on the balance of probabilities, prepared to accept Mr Tasker's own evidence that articles to the design were first made in February 1991.

Original

51. Section 213(1) of the CDP Act 1988 sets down that design right protection is available to original designs. Whilst there is no definition of 'original' in the Act, the authorities such as Aldous J in *C & H Engineering v F. Klucznik & Sons Ltd* [1992] FSR 421, at page 427 have all taken it to mean original in a copyright sense, *ie* not copied, but the independent work of the designer, and I shall do the same. This is consistent with Section 226(2) in which infringement is defined in terms of copying the design. But Section 213(4) of the CDP Act 1988 imposes another hurdle that a design must clear if it is to be regarded as original. That Section states that a design is not original if it is commonplace in the design field in question at the time of its creation. There are a number of issues to be determined before I can decide whether or not Mr Tasker's designs pass this second hurdle. Firstly, what was the time of creation of the designs; secondly, what is the relevant design field, and thirdly, were the designs commonplace?

52. The Act does not elaborate on what is meant by the time of creation of the design, but Section 213(6), which I have just dealt with, states that 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. I think the implication of the word "until" is that the design could be created some

time before being recorded in a design document or making an article to the design. As I have said, it was Mr Tasker's case that he had the ideas for his Series 300 and 400 wardrobe doors some time in 1988, that the precise details of the Series 300 and 400 designs evolved later and were not recorded, but that articles to those designs were first made in 1991. In the absence of any convincing evidence from Mr Tasker for an earlier date, I am going to take the date of creation as early 1991.

53. The next issue to decide is the relevant design field. Mr Edenborough argued that the field should be all fitted wardrobes regardless of the materials used for their construction because we are considering designs and these are not dependent upon the material. He suggested that one could not go on subdividing the field *ad infinitum* as this would lead to a situation where nothing would ever be found to be commonplace. On the other hand, Mr Tasker argued that the field should be limited to aluminium wardrobe door systems. He referred me to *C & H Engineering v F. Klucznik & Sons Ltd* [1992] FSR 421, in which Aldous J found that design right existed in the incorporation of a 2 inch diameter metal tube to form a roll bar on the top of a piece of agricultural equipment known as a pig fender, when pig fenders with wooden roll bars were known. As I understand him, Mr Tasker was implying that Aldous J, in defining the design in the way he did, was holding that the use of metal for the roll bar merited design right protection even though pig fenders with wooden roll bars were commonplace.

54. I think, in fact, that Mr Tasker is misinterpreting what Aldous J actually said, which is that whilst pig fenders (both in metal and wood) were commonplace, and the use of a wooden roll bar was known, the incorporation of a 2 inch pipe into a commonplace pig fender was an original design. Nevertheless, and contrary to the view put forward by Mr Edenborough, for most aspects of Mr Tasker's designs the appropriate field is, in my view, aluminium sliding mirror wardrobe doors, not all sliding mirror wardrobe doors. This is because, on the evidence before me, the alternatives such as wood and steel are materials with quite different properties and these properties impose totally different design constraints. However, for those design aspects where the nature of the structural material is not important, *eg* the appearance of the whole system from the front, then I think the appropriate field is all wardrobe doors.

55. Although I have not relied on it because it was not argued before me, I observe that the conclusion I have reached seems wholly consistent with the decision in *Scholes Windows Limited v Magnet Limited* [2000] FSR 432 in which Mr N Underhill QC sat as deputy judge in the High Court. In that case the design related to u-PVC casement windows having the appearance of Victorian sash windows by incorporating decorative “horns” projecting from the bottom ends of the stiles. Acknowledging that the various materials from which windows are manufactured have very different characteristics, thus presenting the designer with very different problems leading to very different solutions, Mr Underhill decided that that was not relevant in the case before him where the design of the horns was purely decorative with no functional characteristic, and so could as easily have been made in other materials, and thus the field in question was window design in general.

56. Having decided the time of creation and the design field, I can now consider whether or not any of the designs are original in a copyright sense and whether they are commonplace. In *Farmers Build Ltd v Carrier Ltd* [1999] RPC 461, Mummery LJ set out five points for determining whether a design was original. I reproduce his words here:

“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 begin to satisfy any requirement of novelty in the registered designs legislation.

57. Points (1) and (2) are concerned with determining whether the design is original in a copyright sense, and I will deal with that first. No argument was put to me to suggest that Mr Tasker did not design the articles we are considering in this case. However, I need to consider whether there is any evidence to suggest that Mr Tasker might have copied the designs from another source. In cross examining the witnesses, Mr Tasker went to great lengths to try and prove that others had copied him. He seemed to think that if others had copied him, that would establish he had not copied other people himself. This argument is totally misconceived and is, I think, based on a misreading of point (5) above, which does not say that if the defendant had copied aspects of the plaintiff's design it necessarily follows that the plaintiff cannot have copied. However, the argument fell by the wayside anyway, because Mr Tasker's cross examination did not establish to my satisfaction that others had copied him.

58. Mr Wilson has filed evidence that Britannia disclosed designs for a mirror wardrobe system called Majestic using aluminium extrusions including a side stile with front and side MDF mouldings to customers at a meeting in September 1990. Corroborating evidence has been given by Mr Wilson's son Andrew, by Marcus Carter, a graphic artist who says he carried out design work for marketing brochures for Mr Wilson in the summer of 1990, and by Richard Taylor, a customer of Britannia, who says he attended the meeting, (but says it was "in the early stages of 1990"). In cross-examination, Mr Tasker suggested to Mr Wilson that the meeting might have taken place in 1991 rather than 1990, but Mr Wilson maintained that it took place in 1990. Further support that the Majestic wardrobe was designed in 1990 is provided by a copy of a drawing filed as evidence by Mr Wilson, showing an aluminium side stile in section and several MDF mouldings and dated 9.7.90. On the other hand, further drawings filed by Mr Wilson showing aluminium profiles supposedly for the Majestic wardrobe are not clearly identified as such and in any case have later dates in 1991 and 1993. Mr Wilson explained this by stating that these were not the original drawings but probably

were related to later revisions.

59. Considering all the evidence, I am satisfied that Britannia's Majestic wardrobe system was launched in 1990. Given that I have determined that the time of creation of Mr Tasker's designs is early 1991, it is possible that he could have copied some aspects from the Majestic wardrobe system. However, Mr Tasker was not at the meeting at Britannia in 1990, and according to Mr Wilson, the Majestic wardrobes were not put on the market until mid-1991. On this basis, I am prepared to accept that Mr Tasker was unaware of the details of the Majestic wardrobe system in early 1991. In any case, even if Mr Tasker had been aware of, and tried to copy, the Majestic design, a comparison of the Majestic and Britannia systems quickly shows that the only features he might have copied are features in which I have already found no design right subsists, such as the use of mouldings to hide the aluminium, because when one gets down to the detailed shapes of the aluminium extrusions and the mouldings, the two systems are quite different.

60. Evidence has been given by Mr Gillies, manager of Interstyle Sliding Mirror Robes Limited ("Interstyle") that in 1988 he was also attaching solid timber trims to styles, rails and top tracks of an aluminium system produced by a firm called Hendersons. In cross-examination, Mr Gillies confirmed that his products had been sold only in the Republic of Ireland and in Northern Ireland, and he did not disagree with Mr Tasker when he suggested that they had first met in 1995. I am prepared to accept, therefore, that Mr Tasker had not seen the Interstyle product by early 1991 either. No other prior products were drawn to my attention, and accordingly I conclude that Mr Tasker did not copy other designs and that the designs of the Articles we are considering arose from his independent work. In that sense the designs are 'original'.

61. I will now turn to the question of commonplace. The quotation from *Farmers Build* above suggests I need to determine how similar the designs at issue are to the designs of similar articles in the same field of design. Point (4) directs that the comparison should be made objectively, in the light of the evidence, and point (5) indicates that if there are aspects of the design in question which are not found in any other design in the relevant field, one can

conclude that the design is not commonplace.

62. There is, I regret, rather less evidence to assist me on this issue than I would like. The main evidence in the design field of aluminium doors is that relating to the Majestic wardrobe system produced by Britannia, and the evidence of Mr Gillies relating to the modifications he applied to the aluminium wardrobe systems made by Hendersons. I am satisfied that these two systems taken together are not sufficient to show that the overall appearances of Articles 2 and 3 are commonplace. I am also satisfied that the design feature of the narrow glazing channel in Articles 2 and 3 is not commonplace, bearing in mind that I have determined that the design field in this instance is aluminium doors, and the evidence of the existence of narrow glazing channels at the relevant time was in the field of steel and wood framed doors only. As regards the configuration of the MDF mouldings bonded on to the associated aluminium extrusions, I am satisfied here too, that these designs of Article 2 and of Article 3 with straight moulding are not commonplace. The version of Article 3 with the arch needs a little more comment. In his statutory declaration Mr Gillies says that in 1988 he was attaching timber trims to the face of the aluminium components of sliding door wardrobes and gluing plywood arches directly to the mirror panels, the latter giving an effect similar to German systems being sold in the UK at that time. In addition, in their counterstatement, Britannia identify other manufacturers marketing designs incorporating stick-on arches of timber or MDF. This is sufficient evidence, I believe, to conclude that arched trims in themselves are commonplace, but not to show that the configuration of an arched MDF moulding bonded on to this aluminium extrusion was commonplace.

63. I will pause here for a moment to note that, read literally, point (3) of the five *Farmers Build* points quoted above could be taken to mean I must discount Britannia's Majestic system in assessing what is commonplace, because Mummery LJ referred to comparing with designs "made by persons other than the parties". However, this comment needs to be interpreted in context. *Farmers Build* was an infringement action, and I am sure what Mummery LJ was rightly excluding from the comparison exercise was the designs in dispute and any related designs. I am not dealing with infringement, and I can see no reason for excluding the Majestic design - which, I have found, predates the Tasker designs at the centre of this dispute

- in determining what was commonplace. Even if I am wrong in this, however, in the light of the conclusion I have just reached discounting Majestic would not have made any difference.

64. Continuing now with the remaining Articles, the shortage of evidence in respect of Article 4 causes me a little more concern. On the very limited evidence available, I find it difficult to accept that the double aluminium channel *per se* is anything other than commonplace. The precise dimensions of the channel may or may not be original, but they will vary depending on the “must fit” requirements of the particular door system in question and I would need some persuading that choice of specific dimensions is sufficient to lift the design from “commonplace”. The evidence also suggests that timber trims were being attached to aluminium sections. However we don’t know what they looked like, and there is no evidence that MDF was ever used. I have come to the conclusion that, on balance, that the overall appearance of Article 4 and the configuration of MDF moulding bonded to the aluminium extrusion were not commonplace.

65. Finally, I need to consider the claimed design aspect of Article 1, the “whole external shape and configuration” of the wardrobe door system. If one construes this as referring to what one sees looking at the door system, many of the details of the individual components become irrelevant. For example, the aluminium extrusions forming the top and bottom rails, and to a large extent that forming the top track, do not feature in the external shape or configuration of the whole system, because they are concealed by the MDF mouldings. Clearly, the mirror panels are commonplace items as they are an industry standard. Similarly, the arched member at the top of each door I have found to be commonplace. In addition the basic assembly of stiles and rails into a door and fitting the door within a top track is standard within the industry and clearly has been for many years, so this is utterly commonplace. There appears to me to be nothing in the overall assembly that lifts the whole beyond the contribution of the individual parts, and this is confirmed by the rather inadequate photograph which is all I have to make a judgement on Article 1.

66. I am not entirely sure that Mr Tasker is limiting his claim in respect of Article 1 to just what one sees when looking at the wardrobe, but even if he is going deeper than this I would

still be of the view that there is nothing in the overall assembly *per se*. Accordingly I conclude that design right exists in the whole wardrobe door system only to the extent that it exists in the component parts. It does not otherwise exist in any aspects of the whole.

Geographical qualification

67. The last element of Section 213 is the geographical qualification of subsection (5) which, as I indicated earlier, needs to be read in conjunction with Sections 217 to 221. As subsection (5) makes clear, a design may qualify by reference to any one of a number of persons, such as the designer, the employer or the person who markets. In the present case, if the designs qualify, they do so by reference to the designer. Section 218 therefore applies. This specifies that a design qualifies for design right protection if the designer is a “qualifying individual”. The latter is defined in Section 217 as:

“a citizen or subject of, or an individual habitually resident in, a qualifying country”

“Qualifying country” includes *inter alia* the UK.

68. It is not disputed that, assuming the designs were not copied (and I have found they were not), Mr Tasker is the designer of the articles we are considering. However Mr Tasker failed to adduce any evidence to prove his qualification for the purposes of Section 213(5). The issue was not even mentioned in his statement, though equally it was not raised in either of the counterstatements, and I am sure it was overlooked by all the parties until the hearing itself. I was therefore grateful when, at the hearing, Mr Edenborough said that the defendants were happy to admit, for the purposes of these proceedings only, that Mr Tasker is a qualifying individual for the purposes of section 217.

Term

69. In the absence of any design documents, the appropriate date that design right begins under Section 216(1)(a) is when the Series 400 wardrobe was first made, namely February

1991, and lasts for 15 years from the end of that calendar year. However, under Section 216(1)(b), if articles made to the design are made available for sale or hire within five years from the end of year when the articles were first made, then design right ends 10 years from the end of the calendar year in which that first occurred. Mr Tasker has filed evidence in the form of invoices to show that sales were made in March 1993, and in his statement of case, he says that these were the first sales, though not necessarily when the Series 400 wardrobes were first made available for sale.

70. This vagueness in Mr Tasker's written evidence is totally unsatisfactory, given that the onus rests upon him to make his case. However, it is in none of the parties' interests to leave this question unresolved, so I will resolve it on the balance of probabilities. I find it difficult to believe that, having made and demonstrated a prototype in February 1991, Mr Tasker did not offer to sell such a system to anyone until over two years later. As we have no reliable evidence to decide quite when it was first offered, and the onus lies with Mr Tasker, any uncertainty should be resolved against him, which means going for an earlier date rather than a later one. On this basis, I will assume that the 400 Series was offered for sale some time in 1991, probably 12 February, (the date on which Mr Ladbrook says he saw the 400 Series wardrobe), though the actual month and day is immaterial for determining the term. On that basis, any design right will expire on 31 December 2001.

71. As quoted earlier, under cross examination Mr Tasker did actually refer to "what I produced and sold in 1991" (my emphasis). I do not want to attach too much weight to this because it is inconsistent with his written evidence and may just have been a slip of the tongue, but I observe it is consistent with the conclusion I have just reached.

Ownership

72. Section 215 specifies that the designer is the first owner of any design right in a design which is not created in pursuance of a commission or in the course of employment. In his statement Mr Tasker says that he is self-employed, and his company, Alvista Wardrobes is unincorporated. In his second affidavit, he says that he has been in partnership with his wife,

trading as Alvista Windows, since 1985, and he confirmed this under cross-examination. Mr Edenborough put it to me that this pointed in all probability to one of two alternatives; either that Mr Tasker was an employee of the partnership, or he was in the position of a pseudo-director and held any rights in trust for the partnership. In either case, he submitted, the rights would be owned by the partnership, rather than Mr Tasker himself.

73. Neither counterstatement raised any objection to Mr Tasker's assertion that, assuming he was the designer, ownership of any design right vested in him personally. (In saying this, I am ignoring the blanket denial in the first sentence of Mr Colley's counterstatement which says, in effect, that he contests everything in Mr Tasker's statement that the counterstatement does not expressly mention. Blanket denials like this do not help identify the issues in dispute and therefore to not deserve to be paid any attention.) On that basis, I am not prepared to countenance Mr Edenborough's submission on this point. If the defendants wanted to argue that design right might vest in the partnership, they should have said so earlier so that Mr Tasker could have submitted evidence on the matter.

74. I find, therefore, that the design right vests in Mr Tasker. I observe in passing that whether it vests in Mr Tasker or in the partnership of Mr Tasker and his wife would probably make very little practical difference so far as the present defendants are concerned. For the sake of completeness, I also observe that had I found Mr Tasker was an employee of the partnership, I would have had to look again at whether the designs met the geographical qualification of section 213(5), but I do not now need to do that.

Conclusions

75. It will be helpful to summarise my conclusions. I have determined that design right subsists in the following aspects claimed by Mr Tasker:

- (a) "The overall external appearance of the 400 Series side stile" (Article 2).
- (b) "The overall external appearance of the 400 Series rail with straight (wood) or

arched (MDF) mouldings” (Article 3).

- (c) “The overall external appearance of the 400 Series top track” (Article 4).

I have determined that the term of these design rights runs to 31 December 2001. This means that the rights are now in the licence of right period under Section 237. Finally, I have determined that the ownership of the design rights rests with Mr Tasker.

76. On the other side of the coin, I must record that I have determined that design right does not subsist in the following aspects:

- (a) “The whole external shape and configuration of the 400 Series Mk I system” (Article 1), save for the extent that it exists in Articles 2, 3 and 4 (commonplace).
- (b) “The configuration of MDF mouldings bonded on to the aluminium extrusion with the objective of concealing the aluminium” (Articles 2, 3 and 4), which I have construed as the general concept of using MDF (or wood in the first version of Article 3) mouldings to conceal the aluminium extrusions of a sliding wardrobe mirror door system (method or principle of construction).
- (c) “The narrow internal channel in the aluminium extrusion” (Articles 2 and 3), which I have construed as the broad concept of a narrow glazing channel in aluminium (method or principle of construction, too early to qualify), extending beyond that so far as Articles 2 and 3 (but not Article 1) are concerned to the glazing channel in any form (must-fit).

77. Whilst it is not my task to deal with any issues of infringement, it may be helpful to point out that the effect of these findings is that other manufacturers are free to make sliding aluminium wardrobe mirror doors with MDF mouldings concealing the aluminium and/or with narrow glazing channels. The only thing they cannot do is copy Mr Tasker’s specific, detailed designs to produce articles exactly or substantially to those designs.

Costs

78. I now need to consider the matter of costs. Whilst Mr Tasker has succeeded in his reference insofar as I have found some design right exists in some of the aspects specified in his letter of 22 March 1999, he has failed insofar as I have found design right does not subsist in other aspects - mainly those that are based on features expressed more generally. In his counterstatement, Mr Wilson did not oppose design right in the aspects in which I have found design right subsists - he only opposed the more general claims made by Mr Tasker. It is true that his counterstatement concludes with the comment that “there appears to be nothing in the design right claims present in the Statement of Case by Mr Tasker which is clearly entitled to design right protection”, but of course this was a comment on Mr Tasker’s original claims, before the clarification that came with his letter of 22 March 1999. If one looks at the details of the counterstatement, what Mr Wilson was objecting to were the more general claims that I have rejected. He has therefore been wholly successful in his opposition. Indeed, I strongly suspect that if Mr Tasker had not attempted to claim design right in these general features, Mr Wilson would never have opposed his claim.

79. On the other hand, Mr Colley’s amended counterstatement was submitted after Mr Tasker’s revised claims were submitted, and in it he opposed design right in all aspects of Mr Tasker’s designs including the aspects in which I have found in Mr Tasker’s favour. It may be that the aspects in which I have found design right does not subsist will turn out to be the more important ones so far as assertion of infringement is concerned, but the fact is Mr Colley has only been partially successful.

80. In addressing me on costs, Mr Edenborough made reference to the manner in which Mr Tasker has conducted this case. He suggested that as a result of unclear pleadings, voluminous correspondence, and largely pointless cross-examination, his clients’ costs had been increased substantially. Much of this is clearly because Mr Tasker has decided to litigate in person, despite repeated recommendations to get help. I have to strike a difficult balance between not penalising someone for choosing to act in person and not penalising the other side by failing to recognise the extra work created. In the present case, the fact that Mr Tasker is defending what are essentially his business, rather than his private, interests makes me less

inclined to make generous allowances for litigating in person. I should also add that shortcomings in the conduct of the case did not lie wholly with Mr Tasker; both opposing parties were responsible for filing deficient statutory declarations or affidavits, and evidence that was of little or no probative value, being undated or amounting to hearsay. I am also aware, of course, that there has been a related entitlement action between Mr Tasker and Mr Colley, and much of the early correspondence in this case related jointly to the two cases. I have already awarded costs in the other case, and must take care not to double count.

81. When it came to actual amounts spent by the parties, I did not find the figures submitted by Mr Edenborough very helpful. He suggested Mr Colley's costs were £11,500 and Mr Wilson's were £5,000, both excluding VAT. He subsequently corrected himself, indicating that the latter figure covered only patent agents' fees. He also pointed out that both parties had used the same counsel to save on costs, but it was not explained whether Mr Colley's costs included all, some or none of counsel's fees. I find the figures somewhat surprising. Mr Colley, it seems to me, has adopted what I might call a minimalist approach to the case so far as evidence and correspondence is concerned. For example, originally his only evidence was a single two paragraph statutory declaration from his solicitor with a bundle of unsworn documents and some samples in support, though subsequently, on the day before the hearing, he did file a short statutory declaration himself. Against this, I note that he did avail himself of the opportunity of filing an amended counterstatement after Mr Tasker had clarified his claims. Mr Wilson on the other hand generally took a more active part and, for example, filed eight statutory declarations with supporting exhibits as evidence. I am also aware that Mr Tasker had insisted on one of Mr Wilson's witnesses, Mr Gillies, being brought over from Northern Ireland for what proved to be rather pointless cross examination.

82. Taking all these matters into account I decide costs as follows. As between Mr Tasker and Mr Colley, having regard to the fact that both sides were partially successful, I make no order for costs. As between Mr Tasker and Mr Wilson, as I have said, Mr Wilson has been wholly successful in those aspects he opposed and he is therefore entitled to his costs. These should, though, be based on the comptroller's normal scale and should reflect the fact that he shared counsel with Mr Colley. I therefore order that Mr Tasker makes a contribution of

£1400 towards Mr Wilson's costs, to be paid within seven weeks from today unless an appeal is lodged in the meantime.

Appeal

83. Under Section 251(4) of the CDP Act 1988, any appeal against this decision is to the High Court. I regret that it is not immediately clear to me from the Civil Procedure Rules 1998 what is the period within which an appeal may be lodged. Proceedings under the CDP Act are expressly included in Part 49, but Practice Direction 49E does not appear to make any mention of appeals under section 251(4). If any of the parties wish to appeal, therefore, they would be advised to contact the High Court for information.

84. I observe that under the previous rules, as amended by The Rules of the Supreme Court (Amendment) 1998, the appeal period for appeals under section 251(4) was the same as for appeals under the Patents Act 1977, and it is likely that the High Court will assume the same still applies. Since the present decision does not relate to a matter of procedure, that means the appeal period would be six weeks..

Dated this 25th day of May 2000

P HAYWARD

Divisional Director, acting for the comptroller

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IN THE MATTER OF references under
Section 246(1) by Christopher Ronald Tasker
for determination of subsistence, term and
ownership of design right in certain designs,
and oppositions thereto by (1) Raymond
Wilson and (2) Victor J Colley

ADDENDUM TO DECISION

At the end of my decision dated 25 May 2000 in the above matter I explained that the period within which any appeal would have to be lodged under the Civil Procedure Rules 1998 and its associated Practice Directions was not clear to me, because there appeared to be a lacuna in Practice Direction 49E. I suggested, though, that the High Court would probably assume the appeal period was six weeks.

Since issuing that decision I have become aware of the newly-introduced Part 52 of the Civil Procedure Rules, and it seems possible that in the absence of any specific provision elsewhere, Rule 52.4(2) may apply. That sets the appeal period at 14 days unless I direct otherwise. To avoid uncertainty and prevent any party being caught by surprise, I hereby direct that if Rule 52.4(2) applies, the period within which any appeal against my decision of 25 May 2000 must be lodged is six weeks from the date of that decision.

Dated this 5th day of June 2000

P HAYWARD

Divisional Director, acting for the comptroller

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