

The UK Supreme Court dismisses Trunki's Registered Community Design appeal

Trunki is the ride-on child's suitcase that has been critically acclaimed and a commercial success. Unfortunately for Trunki, this success did not extend to the Supreme Court.

The makers of Trunki have recently gone through the UK courts pursuing a claim of infringement of its Registered Community (EU) Design. Trunki's journey came to an end when the highest court in the UK, the Supreme Court, handed down its judgement – [PMS International Group Plc v Magmatic Limited](#). The Supreme Court upheld the Court of Appeal's decision that the Trunki Registered Community Design was not infringed. Trunki's experience is a reminder of the care that must be taken when depicting a design for a Registered Community Design application.

The Journey to the Supreme Court

In 2013, Magmatic (the owner of the Trunki Registered Community Design) sought damages and an injunction against PMS International Group for its alleged infringing acts in the UK and Germany. An image from the Magmatic's Registered Community Design is given below.



The alleged infringing products were as follows:



At first instance in the UK High Court, it was decided that the Trunki registration only claimed protection for the shape of the suitcase, making all surface decorations irrelevant. On this basis, the judge considered the registration to be infringed.

This judgement was overturned by the UK Court of Appeal.

The errors at first instance were identified as

- a failure to give proper weight to the registration's horned animal appearance compared to the antennae and ears of the alleged infringing products;
- failure to take account of the lack of ornamentation in the registration that emphasised the horned animal appearance;
- ignoring the colour contrast between the body and the wheels and strap in the registration.

Correcting for these errors, the Court of Appeal considered the overall impression of the alleged infringing product to be different to the registration and decided that there was no infringement of the Registered Community Design.

The Supreme Court's judgement

Magmatic appealed to the UK Supreme Court.

The Supreme Court decided that the Court of Appeal had adopted the correct approach, including the conclusion that the registration was not directed to shape alone. The Supreme Court therefore decided not to interfere with the Court of Appeal's decision and



upheld its finding of no infringement.

The Supreme Court stated that, although the Trunki case was a clever and original idea, the Registered Community Design cannot protect this idea, it can only protect the depicted design.

As part of the proceedings, Magmatic and the Comptroller General of Patents, Designs and Trade Marks argued that there was a significant question of principle that needed addressing: whether the absence of ornamentation can, as a matter of law, be a feature of a registered design, and, if so, whether it was a feature of the Registered Community Design in this case. It was requested that this question be referred to the Court of Justice of the European Union.

The Supreme Court dismissed this request for referral, stating the view that the *"absence of decoration can, as a matter of principle, be a feature of a registered design"*. The Supreme Court cited [Samsung Electronics \(UK\) Ltd v Apple Inc](#) as a demonstration of this. However, it was conceded that *"it may sometimes be hard to decide if absence of ornamentation is a feature of a particular registered design"*.

Considerations for users of Registered Community Designs

As illustrated by this case, the choice of images for a Registered Community Design application is of critical importance to the subsequent effectiveness of the registration. Any feature present in the design depictions is likely to contribute to limiting the scope of protection provided.

The Supreme Court highlighted that *"an applicant is entitled to make any number of applications... it is for an applicant to make clear what is included and what is excluded in a registered design, and he has wide freedom as to the means he uses"*. Following these thoughts, care should be taken in determining a design filing strategy that will ensure that the desired level of protection is achieved.

Despite the Supreme Court's comments that the absence of ornamentation can be a feature of a Registered Community Design, there still remains uncertainty regarding how a design depiction can illustrate a claim to the absence of ornamentation. Approaches to achieve this will have to be considered on a case-by-case basis.

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