REPRESENTATIONS OF DESIGN IN A DESIGN APPLICATION

Choosing the Appropriate Format to Represent Design Features

The scope of protection afforded by a registered design will be determined by what has been claimed in the design application. What has been claimed in the design application will in turn be decided by the representations that the applicant has provided in its design application. Whilst the representations form the bedrock of a registered design right, there has been hitherto little guidance from the Singapore courts on the relationship between the representations of design in a design application and the interpretation of such representations. This article discusses a leading UK designs case and highlights certain considerations that should be taken into account with respect to the representations of design prior to the filing of a design application.

I. INTRODUCTION

1. In applying for a registered design, a prospective applicant will have to provide a clear representation(s) of the design in question[1]. In this respect, the representations of the design are not dissimilar to the claims in a patent application. For example, both representations and claims define the monopoly granted over the subject matter by not only what they include but also what they exclude. Whilst there is a wealth of Singapore cases in respect of patent law, there has hitherto been little guidance from the Singapore courts on how representations affect the scope of protection of the eventual registered design.

2. This article aims to shed light on this issue by analysing the seminal UK Supreme Court case of *PMS International Group Plc v Magmatic Limited* [2] ("**Trunki**") and exploring the potential impact of this case in the Singapore context.

II. TRUNKI

[1] See section 11(2)(c) of the *Registered Designs Act* ("RDA"), Rule 14 of the *Registered Designs Rules* ("RDR") and the Registry of Designs "Guidelines for Submitting Representations" at https://www.ipos.gov.sg/AboutIP/TypesofIPWhatisIntellectualProperty/Whatisaregistereddesign/Registereddesignsresources/GuidelinesforSubmittingRepresentations.aspx (accessed 11 November 2016)

[2] [2016] UKSC 12

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3. The claimant-appellant applied for, and obtained registration of, a Community Registered Design[3] in respect of suitcases. The Community Registered Design consisted of six images prepared by a 3D Computer Assisted Design ("**CAD**") program. One of the images is as follows:-

4. Subsequently, the defendant-respondent started selling "Kiddee Cases". Two examples of a Kiddee Case which were cited in the judgment are as follows[4]:-

5. The Kiddee Cases were alleged to have infringed the Community Registered Design.

6. At first instance, the High Court allowed the claimant's claim for design infringement. On appeal, the Court of Appeal reversed the High Court's decision, holding that there was no infringement. A further appeal by the claimant-appellant to the UK Supreme Court was dismissed.

7. In interpreting the CAD images, the UK Supreme Court described the Community Registered Design for suitcases whereby "the horns, and possibly the front and rear clasps ... are the same light grey shade as the rest of the

[3] An industrial design that is registered and valid in all countries of the European Union
[4] *Trunki* at [4]

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body, whereas the wheels and spokes, the strap on the top and the strips in the front and the rear are shaded black"[5]. Because of this, it was held that it was a "natural inference that the components shown in black are intended to be in a contrasting colour to that of the main body"[6]. Further, it was held that the Registered Design "claimed not merely a specific shape, but a shape in two contrasting colours – one presented as grey and the other as black on the images"[7].

8. The Registered Design was thus described as being "a wheeled suitcase in the shape of a horned animal … with a strap, strips and wheels and spokes in a colour (or possibly colours) which contrasted with that of the remainder of the product"[8]. On this footing, the UK Supreme Court upheld the Court of Appeal's reasoning that the Kiddee Case did not infringe the Registered Design:-

   (a) The overall impression given by the Community Registered Design is that of an animal with horns, which was significantly different from the impression made by the Kiddee Case which resembled either an insect with antennae or an animal with ears[9];

   (b) The Community Registered Designed claimed not only the shape of the suitcase but a shape in two contrasting colours[10]. This colouring contrast was found to be a significant difference as the wheels and handles/horns on the Community Registered Design stood out as features whereas the wheels of the Kiddee Case were largely covered and the handles were of the same colour as the main body of the suitcase[11].

III. IMPACT OF TRUNKI ON INDUSTRIAL DESIGNS

9. Whilst the appeal focused on many points, including whether the defendant-respondent's Kiddee Cases infringed the claimant-appellant's registered designs rights, this article will focus solely on the comments made by the UK Supreme Court in relation to the representations/images of the Community Registered Design in question and the implications for the interpretations of such representations /images.

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[5] *Trunki* at [1]
[6] *Trunki* at [52]
[7] *Trunki* at [53]
[8] *Trunki* at [55]
[9] *Trunki* at [21]
[10] *Trunki* at [52]
[11] *Trunki* at [51]

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10. Also, whilst *Trunki* is a UK case, and whilst there are divergences between Singapore and UK/EU designs law, it is submitted that the points raised by the UK Supreme Court in relation to the interpretation of CAD images and line drawings are fundamental issues of designs law that are applicable in the Singapore context.

11. It will be recalled that the design in question was represented by way of CAD images. In general, representations of design are usually represented in one of three ways. The first is an actual photograph of the product itself, which it is argued, provides the narrowest scope of protection. This is because, as the UK Supreme Court explained, "a photo specifies not only the shape, but the surface structure and the material as well, thereby narrowing the scope of protection accordingly"[12].

12. At the opposite end of the spectrum would be line drawings of the product, which by virtue of its simplicity, often "show a physical shape"[13] only.

13. In between this spectrum are CAD images which, whilst not as simple as line drawings, provide a more accurate and realistic representation of the product that is somewhat akin to an actual photograph. One reason is that CAD images, like photographs, "can easily show subtle shadings and contours, as well as decoration, such as colours and ornamentation"[14].

14. Because of the differences outlined above, the UK Supreme Court was prepared to accept, as a general principle, that "while each Community Registered Design image must be interpreted in its own context, a line drawing is much more likely to be interpreted as not excluding ornamentation than a CAD image"[15]. This has grave implications for potential design applicants as an applicant may unwittingly narrow the scope of protection of his design by the choice of CAD images alone.

15. In the situation where an applicant uses CAD images for representing his design, the absence of ornamentation (whether intended or otherwise) may be construed against him (e.g. where an alleged infringer's inclusion of ornamentation is taken into account such that the court may conclude that based on the ornamentation, design infringement has not taken place). In contrast, if line drawings had been used instead, the focus of the inquiry may

[12] *Trunki* at [46]
[13] *Trunki* at [46]
[14] *Trunki* at [46]
[15] *Trunki* at [46]

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be on the shape or configuration of the design itself and the presence or absence of ornamentation may not necessarily influence the design infringement enquiry as much as in the case of CAD images.

16. To be clear, the foregoing discussion does not mean that line drawings can never be taken to exclude ornamentation in all cases. In *Samsung Electronics (UK) Limited v Apple Inc*.[16], it was concluded, based on the line drawings in that case, that "no other ornamentation was intended, a view supported by the fact that the plainness and transparency of the surface was subtly indicated by a few pairs of short lines suggesting the incidence of light on that surface"[17].

17. Thus, generally speaking, line drawings would, in most cases, be the more appropriate format for protecting the shape of an industrial design. This is important because the absence of ornamentation on a line drawing may not be construed against the applicant. In contrast, where an applicant used CAD images to represent his product, it is possible for a court to find the "absence of ornamentation [to] be a feature of a Registered Design"[18].

18. Where an applicant elects to use CAD images, another potential concern is the colour scheme and shading associated with such images. In *Trunki*, even where the design images were in monochrome, the UK Supreme Court had interpreted the use of black and grey to mean that contrasting colours were intended on the product which adversely impacted the claim for design infringement. From this holding, it would be important for prospective applicants to know the look of their final products to ensure that any form of colour scheme and/or shading used corresponds to the actual visual appearance of the product.

IV. CONCLUSION

19. Ultimately, the choice of format to represent an industrial design would depend on a holistic assessment of the industrial design and in particular, the aspects of the design that are novel.

20. A design applicant also has to ensure that the choice of format not only adequately and accurately represents his product but that the images also do not inadvertently narrow the scope of protection of the design.

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[16] [2013] EWCA Civ 1430
[17] *Samsung Electronics (UK) Limited v Apple Inc.* [2013] EWCA Civ 1430 at [18]
[18] *Trunki* at [50]

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