

Case No: HC12B01763

Neutral Citation Number: [2012] EWHC 3453 (Ch)
IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION

Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 5 December 2012

Before :

THE HON MR JUSTICE ARNOLD

Between :

CLINISUPPLIES LIMITED
- and -
(1) KAREN PARK
(2) RICHARDSON HEALTHCARE LIMITED
(3) MAYUR PATEL

Claimant

Defendants

Nicholas Craig (instructed by **Cromwells**) for the **Claimant**
Henry Ward (instructed by **Collyer Bristow LLP**) for the **Second and Third Defendants**
The **First Defendant** did not appear and was not represented

Hearing date: 28 November 2012

Judgment

MR JUSTICE ARNOLD :

Introduction

1. There are two applications before the Court. The first is an application by the Second and Third Defendants (“Richardson” and “Mr Patel” respectively) to strike out part of the Claimant’s claim alternatively for summary judgment dismissing that part. The second is an application by the Claimant (“CliniSupplies”) to amend its Particulars of Claim. Since the latter application was launched, CliniSupplies has proposed additional amendments. I shall consider the final draft supplied by counsel for CliniSupplies with his skeleton argument. The application to amend is not resisted save on the basis that the amendments do not provide an answer to Richardson and Mr Patel’s application. The First Defendant (“Ms Park”) has not participated in these applications, but has agreed to be bound by the outcome.
2. By their application Richardson and Mr Patel originally sought to strike out two parts of CliniSupplies’ claim. The first was the entirety of CliniSupplies’ claims for infringement of United Kingdom design right and Community design right. The day before the hearing, however, CliniSupplies confined this claim to UK design right. The second was CliniSupplies’ claim for an injunction to restrain the continued production and marketing of Richardson’s Cath-It product on the ground of breach of confidence. During the course of his submissions, however, counsel for CliniSupplies abandoned this claim. Accordingly it is only necessary for me to consider the claim for infringement of UK design right.

Background

3. CliniSupplies is a medical devices company which manufactures and markets products for the primary and secondary healthcare sectors. It claims to be a leading supplier of urology products and wound and skin management products. One of its products is a combined urinary catheter removal and insertion procedure pack for use in clinics or the community which it markets under the brand name Vesica (there is also a variant for hospital use, but that can be ignored for present purposes). A “procedure pack” is a pack of equipment for use in a particular medical procedure.
4. Approximately 30% of patients undergoing hospital treatment in the United Kingdom have a urinary catheter inserted at some point in their treatment. Catheter-associated urinary tract infection (“CAUTI”) is by some margin the most commonly reported type of healthcare-associated infection in the UK. One of the main purposes of the Vesica is to help reduce CAUTIs.
5. In early 2009 CliniSupplies assembled a “focus group” of experts to assist it to develop what became the Vesica. This consisted of Thomas Ladds (formerly a Urology Nurse Specialist at Manchester Royal Infirmary and now a freelance consultant), Rose Moran (Continence Advisor, Wigan and Leigh), Diane McNicoll (Continence Advisor, Trafford Primary Care Trust), Courtney Bickerdike (Elderly Care Matron, Blackpool Victoria Hospital) and Steve Duffin (Urology Nurse Specialist). Chris Portis of CliniSupplies attended the focus group’s meetings. The focus group started work in about April 2009. It is CliniSupplies’ case that a key aspect of the focus group’s work was to ensure that the design of the Vesica accorded with best practice aseptic non touch techniques.

6. Aseptic Non Touch Technique or ANTT is a practice framework for aseptic technique originated by Stephen Rowley, Clinical Director of the Association for Safe Aseptic Practice (“ASAP”). It is common ground that ASAP has been publishing ANTT guidelines in general and for specific medical procedures since about 1995. Since about 2003 ANTT has been widely adopted by healthcare organisations including the National Health Service. ASAP provides ANTT guidelines free to healthcare organisations. It also publishes them on the ANTT website located at www.antt.org.uk.
7. It does not appear to be in dispute that ASAP started development of an ANTT Urinary Catheterisation Guideline in May 2009. It is common ground that Mr Ladds contacted Mr Rowley in late October 2009, and thereafter there was an exchange of information between them. Mr Ladds sent Mr Rowley copies of two earlier guidelines on catheterisation and some information about urinary infection, while Mr Rowley gave his opinion about the product which CliniSupplies was developing.
8. Version 1 of the ANTT Urinary Catheterisation Guideline was completed in March 2010, when it was disseminated for peer review. It was published in October 2010, when it was publicised in an article in *Nursing Management* which reproduced part of the Guideline. A slightly revised version was reproduced in full in *Urology News* in September 2011.
9. CliniSupplies organised a marketing launch for the Vesica at Old Trafford football ground on 9 September 2010 at which Mr Rowley spoke. The Vesica went on sale on 1 May 2011.
10. Ms Park was employed by CliniSupplies from 17 May 2010 to 24 July 2011 as a product development manager. There is a dispute as to how senior a role this was, but it is common ground that she was involved with the development of the Vesica. Prior to her employment by CliniSupplies, Ms Park was employed by another medical products company, Rociale, from May 2007 to May 2010. Ms Park resigned from CliniSupplies on 24 June 2011, giving one month’s notice. Accordingly her employment ended on 24 July 2011, but she was on leave from 14 to 24 July 2011. Prior to going on leave, she returned her company laptop on 13 July 2011. On 1 August 2011 she commenced employment with Richardson, but did not actually start work until 22 August 2011.
11. Richardson is a supplier of medical surgical products. It claims to be the leading supplier of procedure packs both to the NHS and to the prescription market. Mr Patel is Richardson’s managing director. In about February 2012 Richardson launched a combined urinary catheter removal and insertion procedure pack which it markets under the brand name Cath-It.
12. CliniSupplies alleges that the Cath-It was copied from the Vesica. Richardson claims to have commenced development of the Cath-It in mid 2008, and to have taken into account the ANTT and other guidelines when deciding what items to include and in what order. Richardson denies that the Cath-It was copied from the Vesica, but it is not clear to me whether it claims to have been wholly uninfluenced by the Vesica.
13. CliniSupplies also alleges that, in developing the Cath-It, Richardson misused information confidential to CliniSupplies which Ms Park disclosed to Richardson in

breach of express or implied contractual obligations of confidence and good faith and fidelity and of fiduciary duties. It also alleges that Richardson and Mr Patel have participated in an unlawful means conspiracy with Ms Park. Ms Park, Richardson and Mr Patel all deny any misuse of confidential information.

14. The claim has had a slightly unfortunate procedural history. CliniSupplies' solicitors sent Richardson a letter before action on 5 March 2012. After correspondence between CliniSupplies' solicitors, Richardson, Richardson's patent attorney and Richardson's solicitors, the Claim Form was issued on 30 April 2012. The Particulars of Claim were served on 9 May 2012. On 17 June 2012 CliniSupplies alleges that it found certain emails on Ms Park's laptop dating from March – July 2011 evidencing misuse of confidential information by her. On the basis of this evidence CliniSupplies applied without notice for interim injunctions against the Defendants on 22 June 2012. Mann J granted relief against Ms Park, but not against Richardson or Mr Patel. Subsequently CliniSupplies applied for more extensive relief against Ms Park and Ms Park applied to discharge Mann J's order. Following a hearing on 22-24 August 2012 Mark Herbert QC sitting as a Deputy High Court Judge discharged the injunction granted by Mann J and declined to grant CliniSupplies the further relief it sought, albeit on the basis of certain undertakings given by Ms Park and her solicitors, for reasons given in his judgment dated 14 November 2012 ([2012] EWHC 3209 (Ch)).

The Vesica

15. The Vesica comes in a clear polyethylene bag shaped like a large envelope. The bag is rectangular in plan, with approximate dimensions of 37 cm (including the seal at the closed end) x 27 cm. When full, the bag is very roughly 7 cm thick at the thickest point. The bag carries a white adhesive label on its top surface measuring approximately 13.5 cm x 6.5 cm. This label has the brand name and other information printed on it. The bag is closed at one end by means of a flap covered with white paper, measuring approximately 11.5 cm x 27 cm. This is adhesively sealed, again rather like the flap of an envelope, so that the user can peel it back in order to open the bag and extract the contents. The bag contains an instruction leaflet, a catheter removal pack and a catheter insertion pack loose within it. When the bag is the correct way up (i.e. labelled side up), the removal pack lies on top of the insertion pack. The leaflet may lie either on top of both packs or underneath both packs. The bag also has a clear 25 ml sachet of saline solution affixed to the exterior of the bottom surface by means of additional square of polyethylene bonded to the bag at its edges.
16. The removal pack and the insertion pack each come wrapped in a blue polyethylene tissue sterile field measuring 60 cm x 60 cm. Including the wrapper, the removal pack contains the following items:
 - 1 blue polyethylene tissue sterile field 60 cm x 60cm
 - 1 white plastic apron folded
 - 1 white disposal bag folded
 - 1 pair of walled blue cuffed latex-free gloves
 - 3 x non-woven swabs 7.5 cm x 7.5 cm 4 ply
 - 1 x 10 ml luer slip syringe.

17. Other than the sterile field (which is wrapped around all the other items) and the syringe (which lies alongside the remaining items within the sterile field wrapper), the items are stacked on top of each other in the order listed, going from top to bottom.
18. Including the wrapper, the insertion pack contains the following items:
 - 1 blue polyethylene tissue sterile field 60 cm x 60 cm
 - 1 white plastic disposable apron folded
 - 1 white disposal bag folded
 - 1 pair of walled blue cuffed latex-free gloves (medium)
 - 1 blue polyethylene tissue fenestrated drape 50cm x 60cm with 10 cm circular fen folded
 - 1 blue polyethylene tissue sterile field 60 x 60cm folded
 - 1 pair of cuffed and walled latex-free gloves (medium)
 - 1 catheter fixation strip
 - 1 60 ml clear plastic gallipot
 - 5 non-woven balls (placed in the gallipot)
 - 5 non-woven swabs 7.5 cm x 7.5 cm 4 ply
 - 2 straps
 - 1 leg bag 500 ml
 - 1 off-white pulped paper kidney bowl 800 ml.
19. Other than the first sterile field (which is wrapped around the kidney bowl), all of the other items are contained in the kidney bowl. The apron, disposal bag, first pair of gloves, fenestrated drape, second sterile field and second pair of gloves are stacked on top of each other in the order listed. Beneath these are the gallipot (containing the balls), the swabs (stacked in a pile) and the straps, which are next to each other in a single layer. The leg bag lies underneath the swabs and straps, with its tube curled around the gallipot. For the avoidance of doubt, the insertion pack does not include a catheter.
20. The Vesica is assembled on behalf of CliniSupplies by another medical products company, Rociale (part of the Sunlight group), which also supplies the components (except for the leg bag, leg straps and fixation strips, which CliniSupplies sources from elsewhere). CliniSupplies does not claim to have designed any of the components.

The Cath-It

21. The Cath-It comes in what is described by Richardson as a blister pack. This is a package approximately 21 cm long x 11 cm wide x 6 cm deep, although the top surface is approximately 26 cm x 13 cm. The top surface consists of blue and white paper printed with the brand name and other information. In order to open the pack, the user peels off the entire top surface, revealing a shaped transparent polyethylene pouch the entire upper side of which is open. The pouch contains a catheter removal pack lying on top of a catheter insertion pack.
22. The removal pack is contained in a similar blister pack, except that the dimensions are approximately 16.5 cm long x 8.5 cm wide x 2 cm deep with a top surface measuring approximately 21 cm x 10 cm. The removal pack contains the following items:

1 green polyethylene tissue sterile field 35 cm x 35 cm
1 white plastic disposable apron folded
1 white disposal bag folded
1 pair loose green cuffed latex-free gloves
Small leaflet with instructions for use
1 10 ml luer slip syringe
3 non-woven swabs 7.5 cm x 7.5 cm 4-ply.

23. The sterile field is wrapped around the other items. Within the sterile field, the items are stacked in the order I have listed, going top to bottom.

24. The insertion pack comes wrapped in a blue polyethylene tissue sterile field measuring 50 cm x 50 cm. Including the wrapper, the insertion pack contains the following items:

1 blue polyethylene tissue sterile field 50 cm x 50 cm
1 white plastic disposable apron folded
1 white disposal bag folded
1 pair loose green cuffed latex-free gloves
Small leaflet with instructions for use (separating the two gloves)
1 green polyethylene tissue fenestrated drape folded
1 blue polyethylene tissue sterile field folded
1 pair loose green cuffed latex-free gloves
Small leaflet with instructions for use (separating the two gloves)
3 non-woven swabs 10 cm x 10 cm 4-ply
Blue plastic tray with two compartments, one being for use as a gallipot
5 non-woven balls (placed in integral gallipot in tray).

25. Other than the first sterile field (which is wrapped around the plastic tray), all of the other items are contained in the plastic tray. Except for the balls contained in the integral gallipot, they are stacked in the order listed, going from top to bottom.

26. Like the Vesica, the Cath-It insertion pack does not include a catheter. Unlike the Vesica, the Cath-It insertion pack does not include the following items:

Catheter fixation strip
Leg bag
Straps.

Nor does the Cath-It include a sachet of saline solution.

27. Like the Vesica, the Cath-It and its components are supplied to Richardson by a third party supplier, in this case Winner Medical. Richardson claims to have designed the plastic tray, but none of the other items.

Comparison

28. I hope it is clear from my descriptions that, other than at the conceptual level, the Vesica and the Cath-It are quite different. The differences are even clearer in the

comparative photographs produced by both sides, and in particular those exhibited to Mr Patel's second witness statement. Even where the products include functionally similar items, such as aprons and fenestrated drapes, the respective items are different in their design and/or size. Furthermore, even at the conceptual level, there are two clear differences between the products. First, because the Cath-It removal pack is contained in its own blister pack, this will remain sterile even after the main blister pack has been opened. Thus if the user only needs to perform an insertion, the removal pack can be retained for use later. This is not true of the Vesica. Secondly, the Cath-It insertion pack does not include a leg bag and associated items.

29. The principal similarities between the Cath-It and the Vesica relied upon by CliniSupplies are (i) the selection of the items, particularly in the case of the removal packs, (ii) the layering of the items (i.e. the order in which they are stacked in each pack) and (iii) the fact that the removal pack is placed on top of the insertion pack in the combined pack.
30. It is convenient to note at this point that it does not appear to be in dispute that the order of the items in both parties' products accords with the sequence of steps specified in published guidelines such as the ANTT Catheterisation Guideline.

Principles applicable to strike out applications

31. Richardson and Mr Patel's application to strike out CliniSupplies' claim for design right infringement is made under CPR r. 3.4(2)(a). This provides that the court may strike out a statement of case if it appears that the statement of case "discloses no reasonable grounds for bringing ... the claim". There is no dispute that for this purpose the court must assume that the facts alleged in the statement of case are true.

Principles applicable to summary judgment applications

32. There is no dispute about these either. They were conveniently summarised by Lewison J (as he then was) in the context of defendants' applications in *Easyair Ltd v Opal Telecom Ltd* [2009] EWHC 339 (Ch) at [15]:

"As Ms Anderson QC rightly reminded me, the court must be careful before giving summary judgment on a claim. The correct approach on applications by defendants is, in my judgment, as follows:

- i) The court must consider whether the claimant has a 'realistic' as opposed to a 'fanciful' prospect of success: *Swain v Hillman* [2001] 2 All ER 91;
- ii) A 'realistic' claim is one that carries some degree of conviction. This means a claim that is more than merely arguable: *ED & F Man Liquid Products v Patel* [2003] EWCA Civ 472 at [8].
- iii) In reaching its conclusion the court must not conduct a 'mini-trial': *Swain v Hillman*.

- iv) This does not mean that the court must take at face value and without analysis everything that a claimant says in his statements before the court. In some cases it may be clear that there is no real substance in factual assertions made, particularly if contradicted by contemporaneous documents: *ED & F Man Liquid Products v Patel* at [10].
- v) However, in reaching its conclusion the court must take into account not only the evidence actually placed before it on the application for summary judgment, but also the evidence that can reasonably be expected to be available at trial: *Royal Brompton Hospital NHS Trust v Hammond (No 5)* [2001] EWCA Civ 550.
- vi) Although a case may turn out at trial not to be really complicated, it does not follow that it should be decided without the fuller investigation into the facts at trial than is possible or permissible on summary judgment. Thus the court should hesitate about making a final decision without a trial, even where there is no obvious conflict of fact at the time of the application, where reasonable grounds exist for believing that a fuller investigation into the facts of the case would add to or alter the evidence available to a trial judge and so affect the outcome of the case: *Doncaster Pharmaceuticals Group Ltd v Bolton Pharmaceutical Co 100 Ltd* [2007] FSR 63.
- vii) On the other hand it is not uncommon for an application under Part 24 to give rise to a short point of law or construction and, if the court is satisfied that it has before it all the evidence necessary for the proper determination of the question and that the parties have had an adequate opportunity to address it in argument, it should grasp the nettle and decide it. The reason is quite simple: if the respondent's case is bad in law, he will in truth have no real prospect of succeeding on his claim or successfully defending the claim against him, as the case may be. Similarly, if the applicant's case is bad in law, the sooner that is determined, the better. If it is possible to show by evidence that although material in the form of documents or oral evidence that would put the documents in another light is not currently before the court, such material is likely to exist and can be expected to be available at trial, it would be wrong to give summary judgment because there would be a real, as opposed to a fanciful, prospect of success. However, it is not enough simply to argue that the case should be allowed to go to trial because

something may turn up which would have a bearing on the question of construction: *ICI Chemicals & Polymers Ltd v TTE Training Ltd* [2007] EWCA Civ 725.”

33. This summary was cited with approval by Etherton LJ (with whom Sullivan LJ and Wilson LJ, as he then was, agreed) in *AC Ward & Son v Catlin (Five) Ltd* [2009] EWCA Civ 1098, [2010] Lloyds Rep IR 301 at [24].

Subsistence of design right: the law

34. Section 213 of the Copyright, Designs and Patents Act 1988 provides, so far as is relevant:

“(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.

...”

Aspect

35. Section 213(2) defines “design” for the purposes of design right as meaning the design of “any aspect” of the “shape or configuration” of an article. “Any aspect” extends to any aspect of the shape or configuration that is discernible or recognisable: see *A. Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] EWCA Civ 1514, [2004] RPC 16 at [31] and *Dyson Ltd v Qualtex (UK) Ltd* [2006] EWCA Civ 166, [2006] RPC 31 at [22].

Configuration

36. In UK registered designs law prior to 2001, “shape” and “configuration” had long been regarded as close to synonymous, and as denoting the form in which in an article

is fashioned in three dimensions, while “pattern” and “ornament” were generally been regarded as denoting two-dimensional surface decoration: see in particular *Kestos v Kempat* (1935) 53 RPC 139 at 152.

37. In *Baby Dan AS v Brevi Srl* [1999] FSR 377 David Young QC sitting as a Deputy High Court Judge rejected the plaintiff’s contention that the relative positioning of certain of the parts of a child safety barrier was an aspect of the “configuration” of the barrier within section 213(2) for reasons which he expressed at 383 as follows:

“I do not believe the word configuration can be given such a broad meaning – to do so would be contrary to section 213(3)(a) which specifically excludes from design right protection a method or principle of construction.

Configuration can be considered in the context of the Act as some form of arrangement of elements for example the ribbing arrangement of a hot water bottle (see *Cow (P.B.) Ltd v Cannon Rubber Manufacturers Ltd* [1959] RPC 240 at 243-244; 347 at 350).”

38. In *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [1999] RPC 717 Pumfrey J had to determine whether the circuit diagrams relied on by the plaintiff as recording the design of a piece of electronic equipment were “design documents” within the meaning of section 51(3) of the 1988 Act. That in turn depended on whether they were records of “designs” within the meaning of section 51(3). The definition of “design” in section 51(3) is, so far as relevant for present purposes, the same as that in section 213(2). Pumfrey J held that in this context “configuration” bore a wider meaning than “shape”, and included the relative arrangement of parts or elements of an article. On this basis, he determined that the circuit diagrams were design documents.

39. His reasons for reaching this conclusion are too long to quote in full, but for present purposes the following passages from his judgment at 721-723 are particularly pertinent:

“The configuration of an article includes its relative arrangement of parts or elements. An ‘aspect’ of such an arrangement can be readily identified when encountered. So far as an electric circuit is concerned, the components present and their interconnection are, in my view, plainly an aspect of the structure of the article. Of course they are not the whole story, but they are, in fact, the most important, being that which differentiates one electronic circuit from another in terms of function. ...

Mr Whittle submits that the meaning of the word ‘configuration’ which I have set out above is too wide. He says that it takes its colour from the word ‘shape’ and that it just means ‘physical geometry’. ...

Furthermore, Mr Whittle submits that there must be a single design recorded in a design document. He says, in effect, that a circuit diagram contains many potential designs of articles but says nothing about their shape: or alternatively that it is merely a specification which the circuit board has to achieve. ...

It seems to me that these arguments all depend upon the assumption that 'configuration' means no more than 'shape'. In my view this assumption is not correct. While 'design' is concerned with the configuration of articles, it includes features of that configuration which could not be ascertained without careful and detailed examination. ...

It seems to me that the approach [adopted by Laddie J in *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289 at 422-423] applies with equal force when one is considering that aspect of the design of an article (a printed circuit board) which gives it its particular merit as a piece of electronics, that is, the components present and their interconnection. This aspect of the design does not derive its merit from the particular physical layout of the components, or their appearance, or their colour. It derives its merit from the selection of the components and the manner in which they are to be interconnected. To say that a central feature of a particular piece of electronic circuitry is not an aspect of its design is in my judgment artificial and wrong. ...”

40. It should be noted that *Baby Dan* does not appear to have been cited. Nor does it appear that any argument was addressed to Pumfrey J based on section 213(3)(a) of the 1988 Act.
41. Both *Baby Dan* and *Mackie* were criticised in Laddie, Prescott and Vitoria, *The Modern Law of Copyright Designs* (3rd ed, 2000) (“LPV3”) at §§53.6 - 53.10.
42. In *JCM Seating Solutions Ltd v James Leckey Designs Ltd* [2002] EWHC 3218 (Ch) Pumfrey J had to consider the same issue again, but in a different context. Unfortunately, this decision has never been reported, and it has been very little noticed. Thus, even now, it is not cited in either the current (16th) edition of *Copinger and Skone James on Copyright* or the current (8th) edition of *Russell-Clarke and Howe on Industrial Designs*.
43. The claimant claimed design right in a design consisting of the following aspects of the shape and configuration of a chair for invalids:

“The seat of the chair is split in two longitudinally and the two parts are adjustable so that they can each move back and forth independently of the other. The two parts that move are fixed into position once they have been so adjusted. Each of the two parts of the seat has a foot and a leg support attached thereto. Any foot and leg support can be used with the design and the design is not dependent on any particular type of foot and leg

support. The purpose of the design is to enable the seating system to accommodate comfortably and safely invalids with legs of different lengths or similar disability.”

The claimant provided further information clarifying this claim as follows:

“... the features relied on are the following features: a) the seat is split in two longitudinally, b) the two parts are adjustable so that they can move back and forth independently of each other, c) the two parts may be fixed in position once they have been so adjusted, and d) each of the two parts of the seat have foot and leg supports attached thereto. For the avoidance of doubt, the shape and configuration of the foot and leg supports themselves does not form part of the design in which design right is claimed, save for the feature whereby each foot and leg support is attached to one or other of the two parts of the seat.”

44. As Pumfrey J observed at [9]:

“A large number of articles of differing appearance may correspond to a design defined in this way. Omitting any question of surface decoration, the seat may be any shape provided that it is fairly described as a seat. It may be attached to a base of any shape or description. In fact shape is irrelevant to this design. What matters here is the provision of two seat halves, a mechanical interconnection of the leg and foot supports to each other and to their respective seat parts.”

45. The defendant applied to strike out the claim alternatively for summary judgment dismissing it. This application gave rise to two questions. First, was the design in which the claimant claimed design right a “design” within the meaning of section 213(2), and in particular did it constitute an aspect of the configuration of the chair? Secondly, if so, was the design excluded from protection by section 213(3)(a)? Pumfrey J answered both questions in the affirmative, and accordingly struck out the claim.

46. He considered the first question at [5]-[24]. The following points should be noted. First, he construed section 213(3) as meaning that the matters itemised could constitute designs within section 213(2), but did not attract design right (see [10]). Secondly, he considered the relevant history of copyright and designs law more fully than he had in *Mackie* (see [12]-[21]). Thirdly, he considered the criticism of *Mackie* in LPV3, but did not accept it and adhered to the view that a circuit diagram was a design within the meaning of section 213(2) (see [6], [20]-[22]). Fourthly, there is no reference to *Baby Dan* in the judgment, but I infer that Pumfrey J will have been aware of the decision from the commentary in LPV3. In any event, his reasoning is clearly inconsistent with the reasoning of Mr Young QC in *Baby Dan*, although not necessarily with the conclusion.

47. Pumfrey J expressed his conclusion at [24] as follows:

“This ... brings me to the question of abstract description of designs of the type to be found in the definition in the present case. The words of the definition of design are, ‘any aspect of a shape or configuration of the whole or part of an article.’ The word ‘aspect’ invites generalisation. In the present case, one must ask the question what is special about the three dimensional arrangement of the claimant's chair? The design is given in the terms which I have quoted from the further information. So, it is said, this is an aspect of the design of the article. I think this is probably right and it is right, notwithstanding the fact that this aspect of the shape or configuration of the article can be conveyed in words. ...”

48. In *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886, [2005] RPC 6 a majority of the Court of Appeal (Jacob LJ and Mance LJ (as he then was), Sedley LJ dissenting on this point) held that the colourways applied to an article of clothing did not constitute either “shape” or “configuration”. Jacob LJ noted at [27] that *Mackie* had been criticised, but left open the question whether it was correct since he considered that even the wide meaning adopted by Pumfrey J was not wide enough to cover merely colouring a pre-existing article. *JCM* was not cited.
49. In *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat), [2008] RPC 27 the claimant claimed design right in generalised verbal descriptions of various aspects of its mowers. Mann J rejected these claims for reasons he expressed as follows:
 - “79. ... The Act defines design as ‘any aspect of the shape or configuration ... of the whole or any part of an article’, and the right cannot exist until there is an embodiment of the design in an article or in a design document. This combination of features means that design right is confined to what one can actually see in an article—either the physical article or a drawing. This is what one would naturally expect from the concept of ‘design’ (which is what is protected) which is a physical manifestation of an idea, not some underlying abstraction ...
 80. This means that Mr Alexander's more abstraction-based proposals for design right are not correct. His client is not entitled to claim design right in the abstraction of ideas involving folding over, folding again, and leaning on a stand and so on. Nor is it entitled to claim design right in the concept of a tank between two vertical support stands at the back of a wide area mower. What it is entitled to claim design right in (subject, of course, to matters such as commonplace) is aspects o[f] configuration of the physical manifestation, not some underlying design concept.
 81. ... what is protected from copying in design right cases is the design, meaning the physical manifestation. It is not some underlying abstraction. The test for infringement is set out in s.226 (see above)—if there is to be protection for the

underlying ideas it must come through that, not because the underlying ideas are themselves the design. That, among other things, is probably one of the rationales behind the ‘method or principle of construction’ exception.”

50. It does not appear that either *Mackie* or *JCM* were cited. If Mann J was understood as meaning that the relative arrangement of particular components of the mower could not be an aspect of the configuration of the article, and hence a design within section 213(2), that would be inconsistent with those decisions. I think the better view is that all he meant was that a general design concept could not be an aspect of configuration. That is certainly how this passage appears to have been read by Lewison J (as he then was) in *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group Ltd* [2009] EWHC 26 (Pat), [2009] ECDR 11. Having quoted from *Rolawn* at [79], Lewison J went on at [25]:

“Design right does not therefore protect ideas. Ideas are protected by patent law. It follows, therefore, that Virgin Atlantic are not entitled to claim design right for the general concept of an inward facing herringbone arrangement of seats ...”

51. In any event, as will become clear, Mann J’s conclusion can be justified on the alternative basis that such matters are excluded from protection by section 213(3)(a).
52. In Laddie, Prescott & Vitoria, *The Modern Law of Copyright and Designs* (4th ed, 2011) (“LPV4”) the criticisms of *Baby Dan* and *Mackie* are maintained and extended to *JCM* at §§45.6-45.12. In short, the authors argue that “configuration” means “spatial arrangement”. The author of *Russell-Clarke and Howe* is also critical of *Mackie*: see §5-035. On the other hand, the editors of *Copinger and Skone James* appear to regard *Mackie* as correct: see §13-49.
53. Counsel for Richardson and Mr Patel invited me to hold that the construction of “configuration” adopted by Pumfrey J in *Mackie* and *JCM*, namely that the “configuration” of an article includes the relative arrangement of its parts or elements, was wrong for the reasons given in LPV4. As he accepted, however, I should not depart from the decision of a judge of coordinate jurisdiction unless convinced that that decision is wrong. That is all the more so when that judge has considered the criticisms of his decision in a second judgment and adhered to his view, giving additional reasons for it. While I acknowledge that the matter is not free from doubt, I am not convinced that Pumfrey J was wrong. I consider that his construction should be taken to represent settled law until it is reviewed by the Court of Appeal.

Method or principle of construction

54. This exclusion reproduces an identically worded exclusion in the Registered Designs Act 1949. As the author of *Russell-Clarke and Howe* points out at §4-011, however, it has a greater significance in the context of design right since design right protects functional design features as well as aesthetic ones.
55. In *Pugh v Riley Cycle Company Ltd* (1912) 29 RPC 196, a registered design case, Parker J said at 220:

“A conception or suggestion as to a mode or principle of construction, though in some sense a design, is not registrable under the Act. In as much, 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 or 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 the mode or principle of construction.”

56. In *JCM Pumfrey J* considered the second question I identified above at [24]-[30]. He expressed his conclusion as follows:

“29. There are few clear cases since [*Pugh v Riley*] in the reports concerning ‘method or principle of construction’ but the principle articulated by Parker J seems clear enough. The closer perhaps to a patent claim the description of the design becomes, the more suspicious one has to be.

30. Here I have no doubt whatever that the protection is sought for a design which falls on the wrong side of the line. The words do not define a particular design at all but define, as I have indicated, a large family of designs. Accordingly, in my judgment, the words used in the pleading say nothing about the shape of the article but only define how it is to be constructed. The seat and the leg rests may have any shape, provided they are divided and connected. The purpose of the split seat is described in the literature annexed to the particulars of claim and forms a selling point. While I consider that this may well be a design within the very wide definition of Section 213, I think it is plainly a method or principle of construction and is excluded from protection.”

57. In *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285, [2007] FSR 9 at [13]-[14] the Court of Appeal approved the following passage from the 5th (not, as stated, the 7th) edition of *Russell-Clarke on Copyright in Industrial Designs* as correctly stating the law with regard to section 213(3)(a):

“A method or principle of construction is a process or operation by which a shape is produced, as opposed to the shape itself. To say that a shape is to be denied registration because it amounts to a method 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 method or principle of construction. What he gets is a monopoly for 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 method or principle of construction. In other words, any conception which is so general as to allow several different specific appearances as being made within it is too broad and will be invalid.”

58. As the author of the current edition of *Russell-Clarke and Howe* points out at §4-012, the statements I have quoted above from the judgments of Mann J in *Rolawn* and Lewison J in *Virgin* can be regarded as reflecting this principle.

CliniSupplies’ claim to design right

59. CliniSupplies’ claim to design right is pleaded in the proposed Amended Particulars of Claim as follows:

“CliniSupplies is the owner of ~~the following~~ unregistered design rights in the shape and configuration of the Vesica product and/or its design, pursuant to section 213 of the Copyright, Design and Patents Act 1988 In particular, the Claimant will rely upon the following features and each of them, and any combination thereof, of the design, namely:

- (1) The overall external profile of the Vesica product, comprising two separate layers with each layer separated from the other by a sterile wrapping.
- (2) The overall product comprising a catheter removal pack containing various components sited upon and within a larger catheter insertion pack with each pack wrapped in a sterile field made of polyethylene tissue.
- (3) The larger catheter insertion pack wrapped in a sterile field made of polyethylene tissue which visibly contains a receiver and/or receptacle, which holds the additional components in this pack.
- (4) The catheter removal pack wrapped in a sterile field made of polyethylene tissue which visibly contains various components.
- (5) The overall product packaged in clear plastic packaging so that the overall product is visible.
- (6) A small pouch (25ml) of saline solution attached to the underside of the clear plastic packaging.

- (7) The catheter removal pack and the configuration of its components. In particular, the latter in the following order: a white plastic apron, clinical disposable bag, gloves, syringe, and three 4-ply non-woven swabs.
- (8) The catheter insertion pack and the configuration of its components. In particular, the latter in the following order: a receiver, a white plastic apron, clinical disposable bag, gloves, two procedural drapes, second set of gloves, five cotton balls in a gallipot, a catheter fixation strap, five 4-ply non-woven swabs, a urine drainage leg bag and bag straps.
- (9) The configuration of the component parts of the Vesica product and in particular their positioning relative to one another; this configuration was designed by reference to aseptic non-touch techniques, such techniques not previously being used in any urology product. These aseptic non-touch techniques were developed by clinicians in conjunction with the Claimant and were not publicly available until the Claimant launched the Vesica product in May 2011.”

60. Two initial points that I would make about this pleading is that a number of sub-paragraphs (1)-(9) are both lacking in clarity and repetitive. In his oral submissions counsel for CliniSupplies focussed on two key matters which he contended were aspects of the design of the Vesica in which CliniSupplies was entitled to claim design right, namely (i) the selection of the items and (ii) the layering of the items. I shall address these before turning to consider the individual sub-paragraphs.
61. So far as (i) is concerned, I do not accept that, even on Pumfrey J’s construction of “configuration”, the mere selection of components forming a composite article can amount to an aspect of “configuration”, and hence a “design”, within section 213(2). It is true that Pumfrey J said in *Mackie* that the merit of an electronic design lay in “the selection of the components and the manner in which they are to be interconnected”, but that statement depends on the inclusion of the interconnections between the components, that is to say, their relative arrangement.
62. As to (ii), counsel for Richardson and Mr Patel submitted that the layering of the items did not amount to an aspect of “configuration”, and hence a “design”, within section 213(2). I do not accept this. Applying Pumfrey J’s construction, I consider that the layering of the items (and to that extent, the selection of the items) does amount to an aspect of the configuration of the Vesica. It is immaterial that the items are merely placed on top of one another, rather than joined together in some way.
63. Counsel for Richardson and Mr Patel submitted in the alternative that, even if the layering of the items amounted to an aspect of “configuration”, and hence “design”, within section 213(2), it was a method or principle of construction, and hence excluded from protection by section 213(3)(a). Counsel for CliniSupplies had no coherent argument to the contrary. In my judgment counsel for Richardson and Mr Patel is correct. As will become clear when I consider the individual sub-paragraphs,

Pumfrey J's reasoning in *JCM* is directly applicable to CliniSupplies' claim to design right in the present case since it amounts to a series of patent-style claims which would cover products of widely varying appearance. In other words, to use the language of Mann and Lewison JJ, the claim is to a series of concepts.

64. (1). It is not at all clear what is meant by "the overall external profile", but the amendment indicates that this sub-paragraph is directed to that aspect of the arrangement of Vesica which consists of the fact it comprises two layers (i.e. the removal pack and the insertion pack), each of which includes a sterile field wrapper. (It is not accurate to say that "each layer [is] separated from the other by a sterile wrapping".) This is clearly a method or principle of construction.
65. (2). Following the amendment to sub-paragraph (1), sub-paragraph (2) is simply a more detailed repetition of the same aspect (except that the words "and within" are both contradictory and inaccurate). Again, this is clearly a method or principle of construction.
66. (3). The inclusion of the word "visibly" in this sub-paragraph is baffling. When the insertion pack is wrapped in the sterile field, the contents are not visible. The "receiver and/or receptacle" is the kidney bowl. Thus this sub-paragraph is directed to that aspect of the arrangement of Vesica which consists of the fact that the items comprising the insertion pack other than the bowl and wrapper are placed in the bowl and then wrapped in the wrapper. Again, this is clearly a method or principle of construction.
67. (4). Again, the inclusion of the word "visibly" in this sub-paragraph is baffling. This sub-paragraph is directed to that aspect of the arrangement of Vesica which consists of the fact that the items comprising the removal pack are wrapped in the wrapper. Again, this is clearly a method or principle of construction.
68. (5). This is directed to that aspect of the Vesica which consists of the fact that the packs are contained in a clear plastic envelope. I am dubious whether this amounts to an aspect of configuration even applying Pumfrey J's construction; but even if it is, it is clearly a method or principle of construction.
69. (6). As counsel for Richardson and Mr Patel pointed out, this is a bizarre claim given that the Cath-It does not include a sachet of saline solution at all. In any event, the way in which the sachet is attached to the Vesica is plainly a method or principle of construction.
70. (7). This is directed to that aspect of the Vesica which consists of layering of the specified items in the removal pack. It is inaccurate in so far as it implies that the syringe is underneath the other items. In any event, the layering of the items is clearly a method or principle of construction. This becomes clearer still once it is appreciated that it is CliniSupplies' case that the sequence of the items reflects best practice aseptic non touch technique. In effect, therefore, this is a claim to the concept of putting the items in the order which best facilitates aseptic non touch technique.
71. (8). This is inaccurate in so far as it implies that the receiver (kidney bowl) is on top of the other items and in so far as it implies that the straps are underneath the leg bag.

Otherwise, my comments on sub-paragraph (7) are equally applicable to this sub-paragraph.

72. (9). This is simply a repetition of (7) and (8) except that it explicitly claims the concept of positioning the items so as to facilitate aseptic non touch technique.
73. Finally, I would add that it is clear why CliniSupplies seeks to pitch its claims to design right at this conceptual level, namely that, as I have already pointed out, it is only at that level that it can be said that there is any similarity between the Vesica and the Cath-It.

Conclusion

74. Even as proposed to be amended, the Particulars of Claim do not disclose grounds for claiming that design right subsists in any of the aspects of the design of the Vesica particularised under paragraph 19. Accordingly, I will strike out CliniSupplies' claim for infringement of design right. In the alternative, if necessary, I would grant Richardson and Mr Patel summary judgment dismissing the claim since CliniSupplies has no real prospect of successfully claiming design right in any of those aspects.