

“Trunki Likely to Ride On Despite Supreme Court Setback”

Owen O'Rorke and Michael Patrick | 17 March 2016

Trunki case: PMS International Group Plc (Respondent) v Magmatic Limited (Appellant).

Owen O'Rorke examines the impact PMS International Group Plc (Respondent) v Magmatic Limited (Appellant) may have on designers.

It's not that often that a design case makes the Supreme Court, and it's just as rare that a pure intellectual property law story attracts such mainstream media interest. But then the "Trunki" story has captured the public imagination ever since the concept was showcased, and rejected, on the BBC's *Dragon's Den* in 2006. The brightly-coloured plastic chariots have gone on to become an ubiquitous trip hazard in airports around the world, and are seen as a great British design success story.

Small wonder, then, that our press has by and large expressed disappointment at the [Supreme Court's decision](#) in favour of a Hong Kong based producer (PMS) whose lower-market product Kiddee, as even Lord Neuberger admitted sympathetically, was clearly copied from Trunki.

The decision has been described as an important, even disastrous, one for entrepreneurial designers. It is true that any judgment at the highest domestic level is going to be significant in the relatively limited jurisprudence of Registered Community Design (RCD), the EU-wide registered design system, which offers up to 25 years' protection at a low cost for original designs (those which create a "*different overall impression*" on the informed user to anything available in the prior art). ACID, the anti-copying group for designers, commented: "*The case has plunged design law into an abyss. Why would someone bother registering designs?*" But sentiment aside, has *Magmatic v PMS* changed very much?

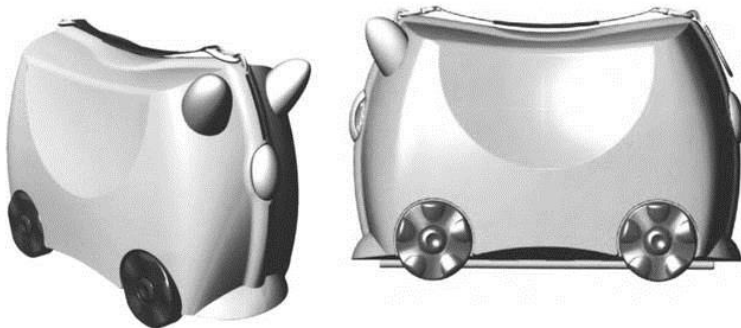
Interestingly, when initially being passed on by the Dragons, one of the key factors for Peter Jones - usually the investor with the keenest eye for an IP question - was that such products were, in his words, "unpatentable" (meaning, in a commercial sense, that anyone could set up a company and start producing knock-offs). History has proved him both right and wrong. Although patent protection for the ride-on suitcase was not realistic, the Trunki's inventor Rob Law had already secured an RCD in 2003, some three years before his TV appearance - a largely unadorned, computer-generated image numbered #43427-0001 which appeared to show some kind of horned animal on wheels. This was to be the basis for the ultimately doomed claim against PMS, despite initially finding favour with Arnold J in the High Court.

Two curious background facts are worthy of mention. First, Mr Law had already won

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awards for an earlier iteration of the Trunki in 1998 - a ride-on named the Rodeo, which was not registered (but had been disclosed to the public). This similar design had the potential to count against Magmatic as forming part of the prior art. However, PMS realised that it would undermine their fundamental position (namely, that the heavily-inspired "Kiddee" design could lawfully co-exist with the Trunki) to claim that, in turn, the existence of the Rodeo design invalidated the registration for Mr Law's substantially-updated Trunki. Hence they only pleaded it in the alternative, as a classic "hedge": namely, should their Kiddee be found to infringe the Trunki, then PMS could argue that surely the registration for Trunki should itself be invalidated on originality grounds given the pre-existing Rodeo.

A second point to note is that Magmatic went on to make several more registrations based around Trunkis, each detailing surface pattern such as colour, stripes and spots and so on. However, the offending Kiddee products - while similarly decorated - were sufficiently distinct as to create a different overall impression once ornamentation was factored in. That the original Trunki RCD was relatively plain and lacking (for the most part) surface pattern was crucial to any claim brought under the argument that what was being protected, and by extension infringed, was the 3D shape of the suitcase



Neither fish nor fowl

Unfortunately for Magmatic, the manner of Trunki's registration – half decorated, in essence – ultimately left it insufficiently protected in both shape and ornamentation. There were sufficient differences in the shape of the Kiddee – antennae (not horns), wheel guards, a somewhat chubbier seat, and so on – that, when considered purely in terms of the overall impression of the two objects, it was plainly distinguishable from the 'horned animal on wheels' which appeared on the RCD register.

Moreover, whether by an accident of shading or deliberate choice, the computer-generated 3D model of the Trunki did record some – very basic, but nonetheless aesthetic – surface or coloration decisions (namely, the darker wheels and strap). Given that simple, binary contrasts are often held up as staples of good design, both the Court of Appeal and Supreme Court felt it was not open to them to decide that these were mere accidents: in short, they had to assume that part of what Magmatic were seeking to protect was a Spartan, simple surface decoration.

By extension it was not open to Magmatic to claim, as they had wished to, that any differences in surface pattern (such as eyes and stripes or spots) were to be disregarded in the court's analysis of whether the Kiddee would create a different overall impression on the informed, if no doubt stressed, parent at the Easyjet queue in

Gatwick.

This was perhaps the more controversial part of the decision, so perhaps wisely the Supreme Court played down its relevance to the final decision. Ultimately, they felt, the Trunki was a clever idea; but whether or not the Kiddee was riding too much on the back of its rival, the purpose and effect of the RCD was not to protect an idea. In that sense, Peter Jones – the original “Dragon” – was right: albeit, to his public regret, more than 2 million unit sales later.

A more practical lesson for companies and designers is to think carefully about what element(s) of their product it is that they are hoping to protect, and give clear expression to that on the register. The system does not allow for any explicatory wording on the illustrations, unlike patents, except simply to state which side is the “TOP”. Hence it must be obvious from the picture(s) on the page. A simple line drawing might have better protected the Trunki here than a more nuanced, shaded, life-realistic 3D model.

Conversely, Magmatic’s more detailed later registrations of Trunki variants – showing the characteristic features of the intended animal – would have been helpful only in protecting against more direct imitations of those particular creatures. So while more detailed registrations offer stronger recourse for claimants against specific types of knock-off, more basic registrations offer more general (but less certain) protection. Hence registrants are faced with the dilemma of having to register more and more variations in order to build a fuller portfolio of protection around the original idea, if they want to achieve any great certainty.

Taking the other view, of course, entrepreneurs and businesses could simply step back from a policy of protectionism – which it not after all what IP law is intended to facilitate – and focus on building their brand so that the name (and any registered trade mark) becomes a recognised mark of quality, and their orders and distribution are locked in with the right partners. The qualified monopolies offered by a combination of trade marks, copyright and species of protected design are there to assist innovators in giving them this head start, but the marketplace will always catch up in the end: so the message is to make as much headway as possible while the road is clear. Something Trunki’s creators, before we feel too sorry for them, have undoubtedly done.

So when the dust settles on the freeway, where does this leave Registered Community Design? RCD has been growing in both popularity and credibility in recent times as a means of protecting either innovative or simply attractive designs, including both 3D shapes and surface pattern (and sometimes a combination of the two). While this decision sounds a clear note of caution about its limitations, which may see the recent growth in registrations checked somewhat, it does not mean the system will not continue to give excellent value if properly used.

However, designers ought to think carefully and tactically at registration about what elements are to be captured by the illustration; and (just as importantly) what less critical or characteristic elements are best left out. This is because ultimately it will be that selected image, and not the underlying concept, against which courts will test the “overall impression” that any offending product makes on the informed user.

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