

Standard for ‘multiple configurations’ articulated in UK design infringement row

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By [Abhishek Kumar](#) and [Melissa Ritti](#)

A UK court last week found Ultimate Tools’ prototype for a locksmith’s tool did not infringe a previously registered design but only because the prototype was not sold or used commercially. Along the way, High Court Judge Richard Hacon addressed a novel question for UK law: whether a design capable of multiple configurations still infringes when it is configured in a way that produces a different overall impression than the original. He turned to an EU treatise and Dutch ruling from 2011 for guidance.

Manufacturers cannot avoid infringing design rights solely by making products capable of configuration in non-infringing ways, a UK High Court judge held on Thursday.

The ruling (see [here](#)) by Judge Richard Hacon comes in a dispute over a prototype locksmith’s tool created by Ultimate Tools and its owners, brothers Simon and Steven Wakefield.

In their defense, the Wakefields said the prototype was capable of multiple configurations, some of which would bear no resemblance to a registered design owned by tool designer and plaintiff Simon Barber.

Unable to locate relevant UK precedent, Hacon turned to the discussion in European Union Design Law, 2nd ed., of a 2011 Dutch ruling in a dispute over kits for building bicycles. Although the bicycles could be configured in such a way as to infringe, consumers following the instructions provided by the defendant would not produce a bicycle similar in appearance to the plaintiff’s design.

As a result, the Dutch court declared the kits non-infringing.

According to Hacon, “basic principles” counsel that defendants should not be able to avoid liability “solely because” their product “could in theory be configured in a different manner for use and in which configuration its design creates a different overall impression to that of the Registered Design.” Instead, Hacon said, “this may be a question of fact and degree” and indicated his agreement with the Dutch court that “directions may be important.”

“I take the view that if the accused design would infringe in a configuration of the accused product likely to be used by the end user, that is sufficient to establish infringement under the Act,” Hacon ruled.

Barber filed suit against Ultimate Tools in 2019, claiming that the prototype did not produce a different overall impression and thus infringed Barber’s UK-registered design number 4028780. The tool is typically placed in a letterbox and used by locksmiths to open doors without using keys to assist people locked out of their homes.

Although finding that the defendants are entitled to the exclusion for non-commercial use set forth in Subsections 7(1) and (2) and 7A(2)(a) of the UK Registered Designs Act, Hacon disagreed with the defendants that their design was dictated by the need to fit through letterboxes. The so-called “must fit” exclusion counsels that there can be no infringement liability for features that must be exactly reproduced to allow mechanical connection between two products.

According to Hacon, the requirements of the letterbox tool did not require the specific shape used by Ultimate Tools for its prototype.

Although Ultimate Tool and Wakefields were cleared of design infringement liability, Hacon awarded Barber injunctive relief.

At a hearing in the case, the judge recalled, Simon Wakefield was asked about his future plans for the prototype; in response, Simon Wakefield informed the court that “he would consider taking it forward” if the prototype was deemed non-infringing, according to Hacon.

“It seems fair for me to assume, as is likely, that Mr. Barber intended to seek an injunction if there was a threat of future infringement. Given what Mr. Wakefield told me, there is a threat — by which I do not imply any sort of criticism of Mr.

Wakefield or his brother. I therefore think that an injunction should be granted,” he wrote.

“The defendants would be wise to ensure that any letter box tool they market in the future looks conspicuously different from the Registered Design. This only applies until the Registered Design expires,” Hacon added.

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