EIP

No declaration of non-infringement for Oh Polly no matter the colour

Two form of order hearings have taken place in Original Beauty v G4K. In the first one, the Judge heard the Defendants' request for a declaration of non-infringement and at the second the Judge considered additional colourways of five further garments.

Declaration of non-infringement

At the first form of order hearing heard on 1 April 2021 ([2021] EWHC 836 (Ch)) the Defendants, known as Oh Polly, having been found to infringe some of the clothing designs in issue, sought an additional declaration that:

"The Defendants have not infringed the UKUDR or UCD subsisting in each of the designs referred to in the Court's judgment as C3, C7, C9, C17, C21, C47, C49, C63, C66, C77, C81, C93 and C102".

The Defendants argued that there were two useful purposes for the declaration they sought. Firstly, that without such a declaration, the order would give an incomplete picture as to what was decided in the main judgment. Secondly, the omission would give a misleading impression that that issue had not been decided.

The Judge disagreed, stating that the proposed draft order -

"Save as aforesaid, each of the Claimants' claims of infringement of UKUDR and UCD in respect of the Selected Garments is dismissed."

already deals with the Defendants' points, and therefore dismissed the Defendant's request as it did not serve a useful purpose.

Consideration of additional colourways

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At the first form of order hearing, the Judge had given orders for dealing with the remaining 71 garments out of the 91 garments pleaded (20 garments had already been decided on in the main judgement). However, following that hearing the Defendants raised "some perceived lacunae" in the main judgment, arguing that, even though different colourways had been dealt with for garments D4, D61 and D91, different colourways had not been dealt with in relation to D2, D12, D13 and D35.

At the second hearing ([2021] EWHC 953, the Claimants' submitted that additional findings are not necessary which the Judge agreed with on the basis that his findings in relation to UKUDR already prevented sales of all colourways of D2, D12, D13 and D35 in the UK as UKUDR is not reliant on colour, and no pan-European relief was being sought. But as there was still a dispute over the 71 remaining garments, which the Claimants and Defendants were currently trying to resolve by consent, and the Judge maintained a further trial on these 71 would be disproportionate, the Judge decided to consider the different colourways for D2, D12, D13 and D35.

For D2, D12 and D35 the Judge found that the different colourways, although still infringing the Claimants' UKUDRs, did not infringe the Claimants' CUDRs as the different colourway created a different overall impression.

For D13 the different colourway was mocha. The colourway of C13, which D13 was being compared against, was black. The Judge held that the colours were similar and, combined with the other striking aspects of the shapes of the garments, the small difference in shade would not be enough to create a different overall impression. Therefore, D13 was found to infringe both the UKUDR and CUDR of C13.

Costs

The Judge also addressed costs of the trial in a further judgment ([2021] EWHC 953) where he considered CPR 36.17. He held that although liability had been determined in the Claimants' favour, the only course open to him was to reserve costs until after the trial of quantum. The Defendants had made a Part 36 offer and it would not be known until then whether that had been beaten.

Comments

It is unclear what the Defendants gain from the findings that D2, D12 and D35 do not infringe the Claimants CUDRs when they are still found to infringe the UKUDRs and no pan-European relief is being sought. Maybe they were looking to strengthen their hand in

their negotiations with the Claimants about the remaining 71 garments or in relation to costs of the action. In any event, it feels just that Defendants, found to have carried out blatant copying of some designs, should not be granted a declaration of non-infringement on the others.

By Hannah Elam