

EIP

Albert Packaging v Nampak Cartons: we didn't copy your design, right?

The Patents County Court has handed down judgment ([\[2011 EWPC 15\]](#)) in a dispute between Albert Packaging Limited (“Albert”) and Nampak Cartons & Healthcare Limited (“Nampak”), regarding alleged infringement by Nampak of unregistered design right in cartons designed by Albert. The case emphasises the need to show copying when relying on unregistered design right and the importance of maintaining detailed and accurate records that document how you designed a particular product, especially when being faced with an accusation of copying someone else’s design.

By way of background, Albert claimed that they had an unregistered design right in a carton (for the now ubiquitous filled, rolled tortilla wraps) that they designed in 2005. Albert began manufacturing the cartons in 2006, and supplied the cartons to a large supermarket chain via an intermediary. In 2008, the intermediary decided to change supplier to Nampak, who began supplying their own wrap cartons that were similar to Albert’s design. Although Albert alleged that Nampak had copied the carton in which they argued that unregistered design right subsisted, Nampak provided evidence showing that they had developed their carton, independently of the Albert carton, from a carton that was designed before Albert’s carton was made available to the public. As is common when faced with an accusation of infringement, Nampak challenged the subsistence of unregistered design right in Albert’s carton on the grounds that its design was commonplace in the design field in question.

The Judge indicated that since Albert’s carton was in the public domain at the time the Nampak carton replaced it there was clearly an opportunity to copy. As the two carton

designs were very similar, although not identical, there was an assumption of copying that Nampak would have to overcome. Nampak produced evidence of two of its own carton designs. One carton was designed in 2005 (which predated Albert's 2006 design) and was not put on the market or put to any use, and the other was created in 2007 and formed the basis for the creation of the carton in dispute in 2009.

Albert defined the design in which they claimed unregistered design rights in three different ways, each of varying breadth. After careful consideration, the Judge decided that two of the definitions of the designs were so broad that such designs would be excluded from protection as being methods of construction and would also be commonplace having regard to other cartons that were in the public domain at the time of their creation. This left only one definition of the design on which the issues of infringement and subsistence of unregistered design right were to be decided.

The Court held that the characterising features of Albert's allegedly copied carton design were "the sloping top face with the window partly on the slope and extending onto the front". Although Nampak's cartons shared these features, they were found to be based on Nampak's own 2005 carton. The only feature that could be said to have been copied from Albert's carton was the specific dimensions of the side panel of Albert's carton, but this feature was not considered to be a substantial part of the design of Albert's carton.

Another important point to note is that since Albert did not have a registered design for their carton, they had to rely on unregistered design right and, therefore, had to prove that Nampak had actually copied the design of their carton. If Albert had formally registered a design for their carton in the UK, infringement may have been found since Nampak's 2005 carton was not in the public domain at the relevant time and because Albert would not have needed to prove copying. By the same token, if Nampak had registered its original 2005 carton design, they may have had grounds to pursue a registered design right infringement action against Albert.

The take-home message for those involved in design is that while unregistered design right offers some protection against those who copy your design, registered design can provide a much stronger form of (monopoly) protection. This case also serves as a reminder of the importance of sound record-keeping practices, especially from a defensive perspective.