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ITMA REVIEW

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In the swing

Charlie White covers a case involving an unusual design

The Claimant (“Uwug”) brought a claim against the Defendant for infringement of its UK registered and unregistered design right in a metal frame (the “Frame Design”) and the shape and configuration of various straps on a leather swing designed to fit within the frame – the “Sling Designs” – intended for use in sexual activity.

Sling Designs

The Sling Designs were originally made by Mr Barns, a director of Poleon Limited (“Poleon”). In 2009, the Claimant was assigned all of Poleon’s IP rights in various goods and slings.

Must fit

The Recorder found that the Sling Designs were original within the meaning of section 213 of the Copyright, Designs and Patents Act 1988 and were not excluded by the “must fit” exception given that the Sling Designs were not dictated by the need to fit the user nor connect with the user in any way.

Director/employee

In spite of the above, the Recorder found that although Mr Barns was a director of Poleon there was no evidence that he was also an employee (under a contract of service). Mr Barns may, as a director, have held legal title to the Sling Designs on trust for Poleon, but there was no evidence that such legal title had been assigned to Poleon prior to the assignment to the Claimant in 2009. The Claimant therefore did not have title to bring any claim in relation to the Sling Designs and the claim was dismissed notwithstanding the fact that the Recorder went on to say that they would have been infringed.

Frame Design

The Claimant had a better result in relation to the Frame Design. The Frame Design was originally created by the Defendant. There was no

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argument that the frame the Defendant was then selling replicated the Frame Design, but there was debate as to the ownership of the Frame Design. The Claimant had in any case registered the Frame Design.

The Recorder dismissed the Defendant’s argument that the Claimant merely asked the Defendant to supply it with frames and preferred the Claimant’s argument that it had asked the Defendant to produce new, custom-made frames for use with its swings and to transform the Claimant’s ideas into a design that could be manufactured and sold by the Claimant. The Claimant, as commissioner, therefore owned the Frame Design (which had been infringed by the Defendant’s current frame) and had the right to register it.

Assigning rights

This case highlights the importance of ensuring that all relevant rights in products are properly assigned in good time and certainly before commencing litigation. Companies should be aware that a director is not automatically deemed to be an employee, and they should ensure that their directors are under proper contracts of service and/or that they assign any rights the directors have in relevant designs to the company as and when appropriate.

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