

[Albert Packaging Ltc & Ors v Nampak Cartons & Healthcare Ltd, \[2011\] EWHC 1411 \(TCC\), 2 June](#)

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A recent decision issued by the High Court provided a rare example of circumstances under where it was held that the defendants design was not produced independently, and yet was not considered to infringe.

The case in question related to cartons used for packaging tortilla wraps. In 2005 the claimant (Albert Packaging) designed a new type of carton for wraps consisting of a rectangular box with a sloping front face, with a broadly rectangular window partly on the flat pace and partly on the sloping face (see Figure 1). The claimant considered that a new wrap carton produced by the defendant (Nampak) in 2008 was an infringing copy of the claimant's design (see Figure 2). The defendant denied infringement and also challenged the existence of an unregistered design right.

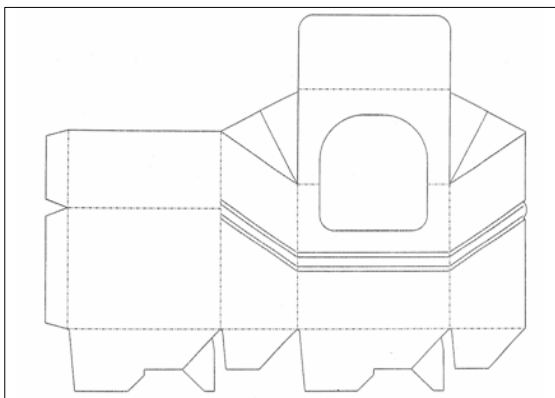


Figure 1: claimant's carton

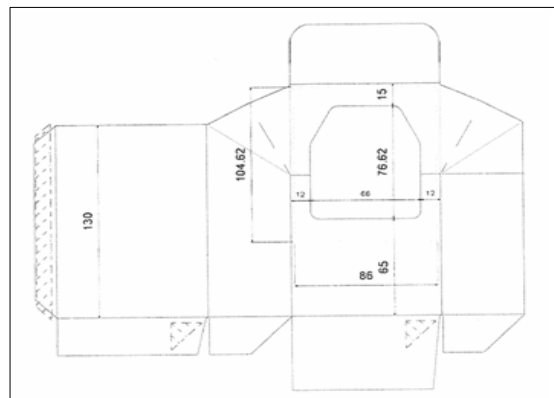


Figure 2: defendant's carton

The claimant defined the design in which they claimed unregistered design right in three ways:

- 1) the shape of the carton in assembled form;
- 2) the generally rectangular box, having a window extending on the sloped face; and
- 3) the distance between the 'shoulder' and top of the box being 35mm, regardless of the remaining dimensions.

The judge first concluded that the claimant was entitled to unregistered design right in the shape of the carton in its assembled form, i.e. definition 1 above, as the particular combination of elements making up the design as defined in this way could not be considered to be commonplace. However, definition 2 was excluded as it was the definition of a concept, and definition 3 was excluded as a designer should not be granted a monopoly relating to a particular dimension.

The judge then raised the issue of copying and noted that: (i) the opportunity for copying clearly existed, and (ii) in broad terms the two cartons were similar but not identical. Without an explanation from the defendant, the judge noted that the conclusion drawn would be that the Nampak products were copied from the claimants design, particularly as the window extending down from the sloping face was striking and was not considered to be the product of a function.

Nambak explained the design history of their product, arguing that it was in fact produced by combining two of their previous products. The first of these (see Figure 3) was clearly designed independently of the claimant's product, as it was designed before 2005. However, the second of these (see Figure 4), referred to as a 'Pizzatilla box', was considered 'more than likely' to have been designed using the claimant's product as a source for the design idea.

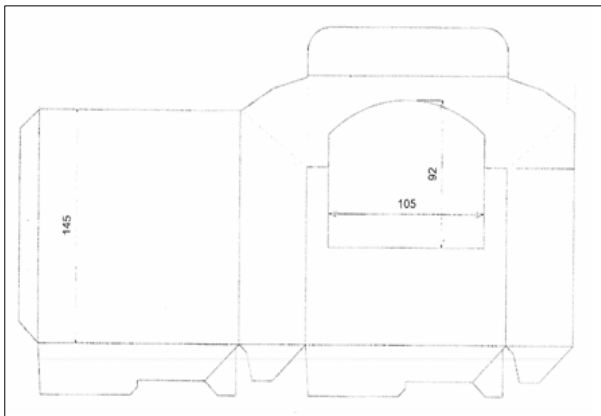


Figure 3: defendant's previous product #1

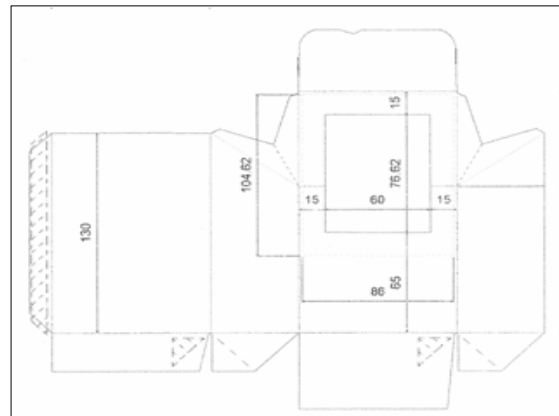


Figure 4: defendant's previous product #2

In view of the above, Nambak's allegedly infringing product was considered not be designed independently of the claimant's product.

The judge then compared the Nambak product with the Albert packaging design. However, by acknowledging that the Nambak previous product #1 (as in Figure 3) was designed independently of the claimant's product, the only feature which the Nambak product could be considered to owe to the claimant's design was the three dimensions, which were not identical. As such, Nambak's cartons were not make "exactly" to the claimant's design. Further, it was decided that the dimensions also could not be considered to be a "substantial" part of the design. The judge concluded that the reason the Nambak product looked like the claimant's product, was because it was based on Nambak's previous product #1, such that the similarities derive from a source independent of the claimant. No infringement was found.

Therefore although the claimants had unregistered design right in the shape of their carton in assembled form, the Nambak products did not infringe that right. This case is a warning that even when you catch a third party infringing your rights, it may not be enough to convince the Courts that a similar article is an infringement.