



Letter of Claim: *Infringement of Design Right*

Dear Sirs,

Our Client: ABC Ltd. Alleged Infringement of Design Right

We act for ABC Ltd. which carries on business from [The Factory, Mill Street, Gaskell, GZ1 1ZZ]¹. Our client has evidence that you have infringed its design rights in the design of two of its [trundlehumpers]² by making (or authorizing another or others to make) [trundlehumpers]³ to those designs without our client's licence.⁴ Our client requires you to stop such infringement immediately and to compensate it for any loss or damage that it may have sustained from that infringement.⁵

1. The Practice Direction and Code

This is a "letter before claim" within the meaning of paragraph 7.1 of the *Practice Direction – Pre-Action Conduct* ("the Practice Direction") a copy of which you will find at Tab A of the enclosed bundle ("the Bundle"). The courts expect parties to comply with the Practice Direction and penalize non-compliance with such sanctions as ordering the party at fault to pay more in costs than it otherwise would or disallowing costs to which that party would otherwise be entitled (see paragraphs 4.5 and 4.6).⁶ We believe that we have complied with that Practice Direction and require you to do the same. We also enclose at Tab B the *Code of Practice for pre-action conduct in intellectual property disputes* ("the Code") which was drawn up some years ago by a panel of intellectual property experts from several professions. Though strict compliance with the Code is not obligatory it is probably in your interests to do so. We have followed the Code as well as the Practice Direction in this case and hope that you will do so too.⁷

2. The Designs

Our client is the owner of the design rights in the design of the following [trundlehumpers]:

1. The "*Humpmover*" a photograph of which you will find at page 1 of Tab C of the Bundle; and
2. The "*Humpdinger*" a photograph of which you will find at page 2 of the same tab.⁸

3. The Designer

Both [trundlehumpers] were designed by our client's designer *Frederick Bloggs* ("the designer") in England in the course of his employment by our client company. Our client is, and at all material times has been a, private company incorporated and carrying on business in England and Wales and is therefore a "*qualifying person*" within the meaning of s.217 (1) of the Copyright, Designs and Patents Act 1988 ("CDPA"). The designer is and was at all material times a British citizen resident and domiciled in England and Wales and thus a "*qualifying individual*" as defined by the same section.⁹

¹ Para 2.1 (1) of Annex A to PD Pre-Action Conduct requires the letter before claim to state the claimant's full name and address.

² Substitute the name of the article.

³ Substitute the name of the article.

⁴ Para 2.1 (2) of Annex A to PD Pre-Action Conduct requires the letter before claim to state the basis on which the claim is made (i.e. why the claimant says the defendant is liable).

⁵ Para 2.1 (4) of Annex A to PD Pre-Action Conduct requires the letter before claim to state what the claimant wants from the defendant..

⁶ Unless the defendant is known to be legally represented, paragraph 2.3 of the Practice Direction requires the letter to –

- (1) refer the defendant to this Practice Direction and in particular draw attention to paragraph 4 concerning the court's powers to impose sanctions for failure to comply with the Practice Direction; and
- (2) inform the defendant that ignoring the letter before claim may lead to the claimant starting proceedings and may increase the defendant's liability for costs."

It is good practice to enclose a copy of the Practice Direction with the letter before claim.

⁷ Para 3.2 (b) of the Code advises sending a copy of the Code with the letter before claim.

⁸ Para 3.2.B (f) of the Code advises claimants to

"provide sufficient information to identify the work or design ("the claimant's work") in which copyright, moral right, database right or unregistered design right subsists and where possible include a copy of the claimant's work, and, in the case of a copyright work, identify the type of work according to the descriptions set out in sections 1(1) and 3-8 inclusive of the Copyright, Designs and Patents Act 1988;"

⁹ Para 3.2.B (h) of the Code advises claimants to

"explain how the claimant's work was created and by whom, and in the case of assertion of a moral right identify the author/director (as appropriate) and how the paternity right, where relevant, was asserted."

4. Originality

In designing those [trundlehumpers] the designer applied his independent skill and labour and recorded those designs in design drawings in or about [.....]¹⁰. The designs of both [trundlehumpers]s are therefore original designs in which design right subsists pursuant to s.213 (1) of the CDPA and our client is entitled to those design rights by virtue of s.215 (3) of the CDPA.

5. First Marketing

[Trumblehumpers] made to both sets of designs were first made available for purchase in [.....]¹¹ It follows that design right subsists in those designs until [.....]¹²

6. Documents and Material Evidence

Copies of the design drawings referred to in paragraph 4 appear on pages 3 to 19 of Tab C. Our client made patterns and jigs from those drawings. If you, your legal representatives or expert wish to inspect those items at our client's premises during normal office hours, we shall be glad to make an appointment for you to do so.¹³

7. The Infringements

You have infringed (or threaten to infringe) our client's design right by making (or authorizing another or others to make) the ["*Trunlite*"] and the ["*TrunPro*"] [trundlehumpers] and by selling (or offering those [trundlehumpers] for sale) in the knowledge or having reason to believe that their manufacture infringes our client's design rights. Particulars of the ["*Trunlite*"] including a photograph and dimensions that have been downloaded from your website appear on page 1 of Tab D and a copy of page [287] of your latest brochure with a photograph of the ["*TrunPro*"] appears on page 2 of the same tab. We have compared every feature and dimension of those two [trundlehumpers] with those in Tab C and find that they are similar in every regard. The few differences that we have been able to detect are trivial. Since you distributed our client's [trundlehumpers] until [.....]¹⁴ you had every opportunity to copy our client's products. The most probable explanation for the similarities between your [trundlehumpers] and our client's is that yours are copies of our client's. By making copies of our client's [trundlehumpers] you have made articles to its designs contrary to s.226 (1) of the CDPA.

8. What we require from you

S.229 (2) of the CDPA entitles our client to an injunction (that is to say an order of the court to stop your infringement, disobedience to which can be punished by a fine or imprisonment), damages, accounts and other relief that is available for the infringement of a property right. S.229 (3) enables the court to grant additional damages where the justice of the case so requires. We have instructions to issue proceedings to claim such relief with costs if this matter cannot be resolved in any other way. Our client is, however, willing to compromise its claim if you promise in writing not to make or market the ["*Trunlite*"] and the ["*TrunPro*"] [trundlehumpers] or infringe any of our client's other unregistered design rights and pay its costs of £..... A draft compromise agreement to that effect appears in Tab E of the Bundle.

9. What you must do next

Paragraph 7.1 (2) if the Practice Direction requires you to reply to this letter in full within a "reasonable period". We regard 14 days as a reasonable time and look forward to hearing before 17:00 on [.....]¹⁵. If you wish to take legal advice and cannot obtain it within such time we require you to acknowledge receipt before that time. Such acknowledgement must contain the particulars set out in paragraph 3 of Annex A to the Practice Direction. If you wish to challenge our client's claim, your response must contain the particulars set out in paragraph 4 of the Annex and paragraphs 4 and 4.2B of the Code. Such full response must arrive before [.....]¹⁶.

We ask you note that we shall carry out our instructions to issue proceedings without further recourse to you If we do not receive your acknowledgement and full response within those time limits.

Yours faithfully,

Para 2.B (i) requires details of the claimant's ownership of the work

¹⁰ Insert date.

¹¹ Insert date.

¹² Insert date. Para 3.2.B (g) of the Code requires the letter to state the date of first marketing.

¹³ Para 2.2 (1) of the Practice Direction requires the claimant to list all the documents on which it relies.

¹⁴ Insert date.

¹⁵ Insert date.

¹⁶ Insert date.