

O-586-15

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN No. 4035208

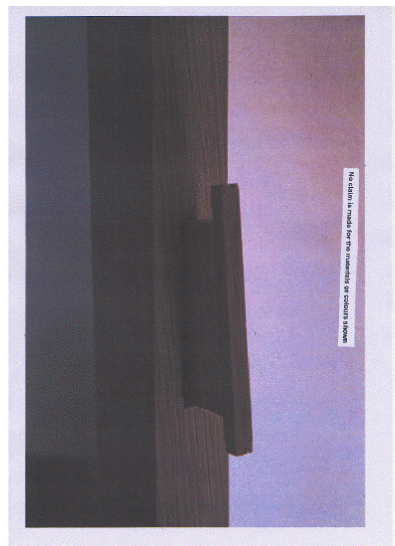
AND

APPLICATION No. 14/15

TO INVALIDATE THE REGISTERED DESIGN

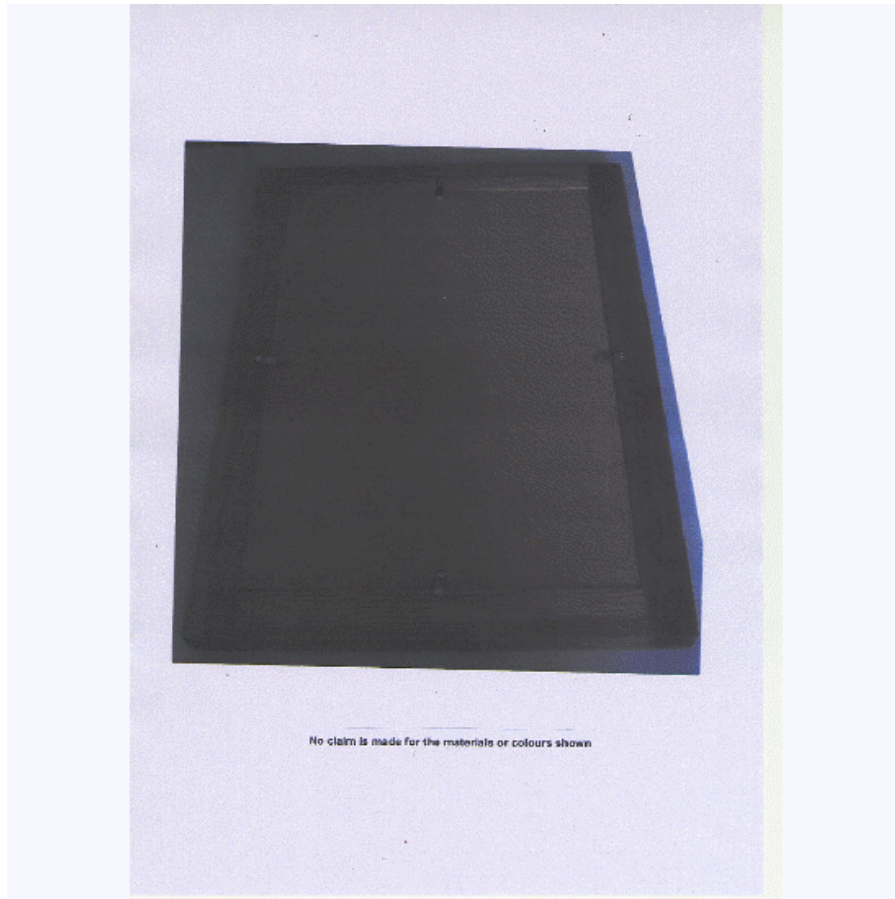
The claims and the counterstatement

1. The registered design the subject of these proceedings was filed by Mr H. Stebbings on 16th April 2014. However, the application to register the design is deemed to have been filed on 28th April 2014¹. The design was registered on 28th July 2014. The design is depicted in the following photographic representations²:



¹ The application was actually filed on 16th April 2014, but the representation of the design was inadequate to disclose it. The application was modified on 28th April to replace the original representation with new representations which showed the design. In accordance with s.3B(2) of the Act, the application is therefore treated as having been filed on the date when subsequent representations were filed disclosing the design.

² There are further representations of the design, but the ones shown here are sufficient for present purposes.



2. The application form confirms that the design is for a “drop top guest book frame”.

3. The proprietor makes no claim in respect of the materials or colours shown in the representations of the design.

4. The application form included the following description of the design:

“Oak frame enclosing acrylic/glass insert to frame card insert with motif retained by backing board & turn clips presenting top slot for token drop within gap presented between acrylic insert and backing board supplied with ‘T’ section slot cover”.

5. On 16th April 2015, Mr Ian Percy of I.P.Joinery Limited applied for the invalidation of the registered design. He claims that the registered design lacks individual character compared to designs made available to the public by third parties prior to the date of the application to register the registered design. Mr Percy says that he is aware of at least one other party, a company called The Wedding Tree Co., having advertised a product with the same shape at least one year prior to the date of Mr Stebbings’ application. Further, Mr Percy points out that a rectangular frame is a ubiquitous shape common to picture frames, mirrors and like goods. Accordingly, he

claims that the registered design should be declared invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that the design did not fulfil the requirements of section 1B.

6. The designs on which Mr Percy relies are shown below.



 **The Wedding Tree Company** added 10 new photos to the album: Heart Drop Guestbook Alternative. -
16 April 2013 · 🇬🇧



I note that only the second picture shows the design as having been made available to the UK public prior to the date of Mr Stebbings’ application to register the registered design. The first (undated) picture of Wedding Tree Company’s design

appears to have been made available to the public via its website. The second picture of one of the company's designs appears to have made available to the public via Facebook.

7. Mr Stebbings filed a counterstatement in which he:

(i) Claims that Mr Percy is a disgruntled eBay trader who has had listings of goods he sells removed under eBay's VERO 'take-down' programme because of Mr Stebbings' design rights.

(ii) Disputes Mr Percy's entitlement to rely on designs shown on undated website pages.

(iii) Claims that the design shown on the undated website page was "launched on or around" 17th April 2014, but says that the webpage showing the design must have been posted after 30th April 2014.

(iv) Denies that the page posted by The Wedding Tree Company in 2013 is not relevant because Facebook is not a sales platform.

(v) Claims that he began to develop the design in 2011 when he produced a prototype³, which he points out pre-dates The Wedding Tree Company's design from 2013.

(vi) Claims that his design is registered on ACID's non-statutory register (but he does not say when it was so registered).

(vii) Relies on the registration of the design on the basis of its visual design features by the IPO's Designs Examination Team.

(viii) Points out that other products, such as a picture frame, may be the same shape but that they do not have the same characteristic as the registered design, i.e. they do not have a slot for tokens.

The evidence

8. Neither side filed any further evidence.

³ Exhibit B2 to the counterstatement shows computer images of frame designs in JPEG files dated October 2011

Representation

9. Neither side is legally represented. Neither side asked to be heard. I will therefore make this decision on the basis of the information provided in the application and the counterstatement, both of which include statements of truth.

The relevant legislation

10. Section 1B of the Act (so far as it is relevant) reads:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if-

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if-

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned.

(b) -

(c) It was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) -

(e) -

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

(a) If the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) To the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

The relevant (and irrelevant) factors

11. The relevant question is whether an identical design, or one which creates the same overall impression as the registered design, was made available to the public before 28th April 2014.

12. Mr Stebbings is correct that the undated webpage in the application for invalidation is irrelevant. This is because it does not show that the design was made available to the public before 28th April 2014.

13. However, it is irrelevant whether an earlier disclosed design was made available to the public by a third party. Further, it is not necessary for products embodying the design to have been sold to the public prior to date of the application to register the design (or at all). The design shown on a Facebook page in 2013 (“the prior art”) is therefore potentially relevant to the novelty of the registered design. This is because it appears that the design in question was thereby “made available” to the public in the UK.

14. Disclosure of the design to the public by the designer himself is sufficient to invalidate a subsequent registration of the design, if it is made more than 12 months before the date of the application to register it. There is no evidence of that having happened in this case. Therefore, what Mr Stebbings says about prototypes having been developed in 2011 and the design having been registered with ACID at some unspecified point in time, is irrelevant.

15. It is also irrelevant that the IPO registered the design. The registrar is not permitted to refuse to register a design on grounds of lack of novelty⁴.

Was the design “new” when it was registered?

16. A design is considered to be new “if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date”. The prior art identified by Mr Percy has the same rectangular shaped frame as the registered design. The materials used for the design have been disclaimed. It cannot therefore make any difference that the prior art has a visible backing board made from a more course-looking material than that shown in the backing board for the registered design. However, the prior art appears to lack the protrusion visible at the top of the product embodying the registered design. That protrusion is the part of the ‘T’ shaped slot cover shown more clearly in the second representation of the design shown above. In my view, the visible appearance of that feature is not an immaterial detail of the registered design. This is because it is not a feature that is likely to go unnoticed in use. I therefore find that the registered design is not identical to the identified prior art.

Does the registered design create a different overall impression to the prior art?

17. The relevant case law in this respect was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*⁵. The most relevant parts are re-produced below.

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

⁴ See section 3A of the Act as amended by the Regulatory Reform (Registered Designs) Order 2006 S.I. 2006/3949

⁵ [2012] EWHC 1882 (Pat)

- ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
- iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);
- iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);
- v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not

think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of "different overall impression" is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters."

Did the registered design have 'individual character' compared to the prior art at the relevant date on 28th April 2014?

18. The informed user will be a user of drop top guest books, typically someone who wants an attractive means of storing messages from friends and family. Such a user will have the attributes described in paragraph 16 above.

19. Such a user will be aware that rectangular frames are ubiquitous, at least in the field of frames for pictures, photographs and mirrors, and therefore banal in terms of design novelty. Mr Stebbings argues that this well known fact is irrelevant because the registered design is for drop top guest book frames. However, the requirement is for the registered to create a different overall impression of an informed user compared to "any design which has been made available to the public before the

relevant date” (emphasis added). Although it may be true that an informed user of the product identified in a registered design application may be less familiar, or not familiar at all, with designs for products in different fields⁶, there can be little doubt that an informed user of drop top guest book frames would be familiar with designs for everyday items such as frames for pictures, photographs and mirrors. The rectangular shape of the frame shown in the registered design was therefore banal and lacking in individual character at the relevant date, both compared to the design published in 2013 by the Wedding Tree Company for a drop top guest book frame, and also countless other rectangular shaped frames for pictures, photographs and mirrors.

20. The registered design also includes a transparent insert. However, for reasons which are obvious, that feature does not make any visual impression (or at least not one that can be seen in the registered design).

21. One of the representations of the registered design shows what the back of it looks like. Components parts that are not visible to users in normal use of the product are not relevant to the assessment of individual character. I note that the back of the registered design has visible turn clips, indicating that the backing board is easily removable (so that tokens can be removed and board re-used). Therefore although the back of the product embodying the design will not be seen when the product is used for display purposes, normal use would appear to include removal and replacement of the backing board. I therefore find that the visual appearance of the back of the design is potentially relevant. However, the visible features concerned – the back of the banal rectangular frame, the backing board (which has to be the same shape as the frame so as to fit within it) and the turn clips to retain/release the backing board in/from the frame - are either banal or purely functional. Consequently, none of the visible features on the back of the registered design will make any material contribution to the overall impression the design creates on an informed user.

22. The registered design also includes a ‘T’ section which fits into a slot at the top of the rectangular frame. This is the slot through which people are intended to drop tokens bearing messages which can then be viewed through the transparent insert at the front of the frame. The rectangular shape of the slot itself is therefore also purely functional. However, apart from having to fit into the rectangular slot, the shape of the ‘T’ section cover appears to be an arbitrary choice. Indeed, as the identified prior art does not appear to have a slot cover, the decision to include a slot cover in the registered design appears to be an exercise of design freedom.

⁶ See the judgment of the General Court in Case T-15/13, *Group Nivelles v OHIM* (see paragraph 124 of the judgment). This point is currently the subject of a further appeal to the CJEU. See Case C-361/15.

23. It is true that the shape of the ‘T’ section slot cover is not always fully visible to users in all the uses of the product in which the design is embodied. However, the shape of the ‘T’ section is fully visible in one of the normal uses of the product – when the cover is removed and replaced. Further, the top part of the cover remains visible when the product is used for display purposes. Therefore the visual impact created by the inclusion and shape of the ‘T’ section cover is a relevant feature of the registered design⁷.

24. I have carefully considered what weight should be attached to the visual impact of the ‘T’ section slot cover on the overall impression the registered design will create on an informed user. If the answer is that this feature is insufficient for the registered design to create a different overall impression on an informed user of the product compared to the impression created by the identified prior art (or the design for countless other goods, such as rectangular frames for pictures etc.) then the registered design is invalid. If, on the other hand, the feature under consideration means that the registered design creates a different overall impression compared to any earlier designs, then the registered design is valid.

25. I note that in *Grupo Promer*⁸ the General Court held that:

“...as the Board of Appeal pointed out.....in so far as similarities between the designs at issue relate to common features.....those similarities will have only minor importance in the overall impression produced by those designs on the informed user....”

26. All of the features of the registered design are either banal or purely functional, except for the ‘T’ section slot cover. In my view, that feature has sufficient visual impact for the registered design as a whole to make a different overall impression on an informed user of drop top guest books - who shows a relatively high degree of attention when he uses them - compared to the identified prior art. The registered design is therefore valid.

27. I note that Recital 13 of the Designs Directive indicates that a registered design should receive a broad scope of protection where it differs markedly to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. It follows that if I am right in holding that the registered design is validly registered, the use of a design corresponding to the identified prior art will not infringe the registered design. If I am wrong about that then the registered design is invalid.

⁷ See, by analogy, the judgment of the General Court in Case T-153/08, *Shenzhen Taiden Industrial Co. Ltd v OHIM* at paragraph 66.

⁸ Case T-9/07, see paragraph 72 of the judgment

Outcome

28. The application to invalidate the registered design fails.

Costs

29. Neither side has appointed legal representatives or filed any evidence beyond the contents of their initial statements. Therefore although the registered proprietor is entitled to a contribution towards his costs, these should be minimal. I therefore order Mr Ian Percy to pay Mr H. Stebbings the sum of £100 towards the cost of these proceedings. This is made up of £50 to cover the official filing fee for Form DF19A and £50 to cover the time taken out of Mr Stebbings' business for him to consider the application and complete his counterstatement.

30. The costs should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

Dated this 10th Day of December 2015

**Allan James
For the Registrar**