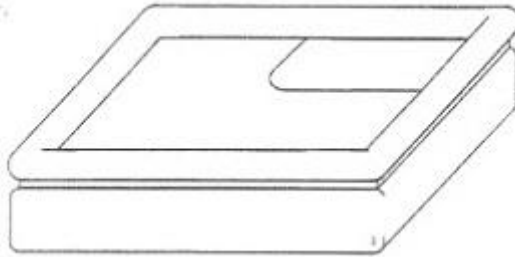


**O-309-17**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 4041949  
OWNED BY JOHN ANTHONY FORTH**

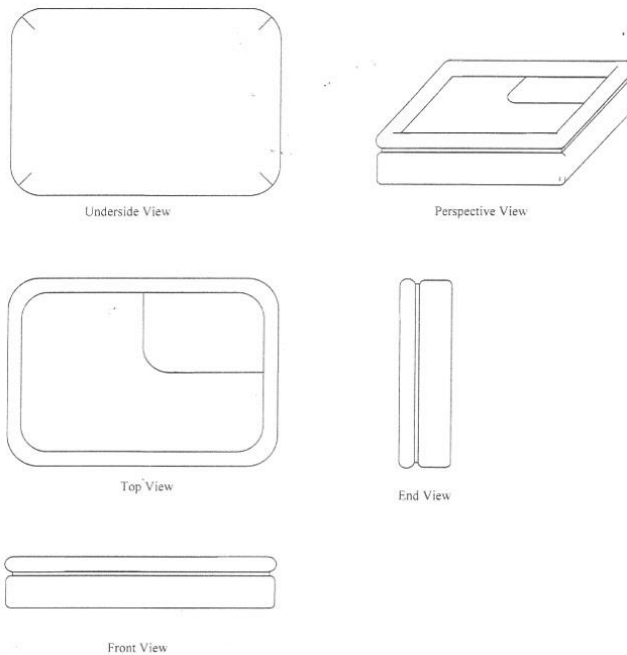


**AND**

**AN APPLICATION (No. 90/15) TO INVALIDATE THE DESIGN  
BY DEIDRE ANN SAM-PYATTE**

## **The background and the claims**

1. The registered design the subject of these proceedings was filed by Mr John Anthony Forth (“the proprietor”) on 30 July 2015<sup>1</sup>. Mr Forth initially represented himself, but during the course of the proceedings he appointed Wynne-Jones Laine & James LLP as his representatives. The design is described as a “beading lap tray set” and looks like this:



2. The applicant for invalidation is Ms Deidre Ann Sam-Pyatte. She also initially represented herself, but she subsequently appointed ip21 Limited to represent her. Ms Sam-Pyatte’s initial attempts at setting out her case were unclear, leading to requests from the tribunal for clarification. This led, on 22 June 2016, to ip21 submitting on Ms Sam-Pyatte’s behalf what was described as “revised grounds for invalidation”. Given what were now much clearer claims, these were accepted by the tribunal and they stand as Ms Sam-Pyatte’s claims in these proceedings; they can be summarised as follows:

- That the design is not new and lacks individual character. This is based on:

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<sup>1</sup> The application from was first submitted on 3 July 2015, but it was allocated a later filing date because of changes made to the representations of the design.

- A design made available to the public by the applicant which is so similar to that of the registered design that the latter does not have individual character. It is added that the proprietor purchased products made to this earlier design and sold them in the UK;
  - Other earlier designs (shown in attachment A to the statement of case);
  - Community registered design 1394696 (“CRD”) which was filed on 18 December 2013.
- That the registered proprietor is not the true proprietor of the design. This claim is based on the applicant having been making and selling highly similar products since 2007, initially in North America, and that such products were sold to a UK distributor from 2011/2012. It is claimed that the proprietor purchased such products and was fully aware of the design. Given this, the applicant claims to be the true proprietor of the design.

The above claims relate to sections 1B and 11ZA(1A) of the Registered Designs Act 1949 (“the Act”) respectively.

3. The proprietor filed a counterstatement. The points it makes in defence can be summarised as:

- i) Some of the designs highlighted by the applicant are food trays or suitcases and are, therefore, not relevant.
- ii) Of the other designs, none are said to be vaguely similar. Earlier in the counterstatement various features of the registered design were listed which, it is claimed, give it its individual character.
- iii) The RCD is in respect of packaging for food with an outline recess and can be discounted.

- iv) That the claimed product disclosed by the applicant is not identified in the annexes to the applicant's statement of case.
- v) That only one product was purchased from the applicant. Whilst it looks similar, various "obvious" differences are said to exist.
- vi) That the proprietor did design the product, from initial drawings produced in August/September 2014.

4. Beyond the statement of case/counterstatement (as summarised above) only the applicant filed any form of further evidence (which I will refer to in the body of this decision). Neither side requested a hearing. The proprietor filed written submissions. Despite being given an extension of time to file them, the applicant did not. I deal first with the ground under section 1B of the Act.

### **SECTION 1B OF THE ACT**

5. 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) -

(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)--”

6. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>2</sup>. The most relevant parts are reproduced below:

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<sup>2</sup> [2012] EWHC 1882 (Pat)

## “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).

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."

### **The relevant date**

7. The relevant date is the application date of the registered design, namely 30 July 2015.



### **The prior art – what can be relied upon?**

8. The applicant has provided prints showing various designs which, it is claimed, destroy the novelty in the registered design. The first task for the tribunal in a case such as this is to assess whether the designs have, as is claimed by the applicant, been made available to the public before the relevant date. Only then can any form of comparison be made. It is for the applicant to show that the designs relied upon were disclosed before the relevant date.

9. Reliance is placed on products that have been sold by the applicant, including a sale to the proprietor. The proprietor accepts that it purchased one of the applicant's products in April 2015 (before the relevant date). Thus, it would be wrong to conclude that the design was not disclosed prior to the relevant date. However, the statement of case does not depict it, nor was it depicted in the applicant's evidence that was subsequently filed (by its representative, Ms Jackie Tolson). I note that in Ms Sam-Pyatte's second attempt at setting out her case (before she appointed ip21 to represent her) she did provide details of an application for a US patent and "original design drawings submitted with it". However, these do not assist because there is nothing to show i) if/when the US patent application was published, and, ii) what the actual product made to the design looks like which is claimed to have been made available to the public (including by way of sale to the proprietor). Without seeing what has actually been disclosed, no comparison can be made.

10. In Annex A of the statement of case there are a series of images upon which the applicant also relies. The same series of images is contained in Annex A of Ms Tolson's witness statement. To all intents and purposes, the witness statement merely repeats the evidence contained in the statement of case. The proprietor made a number of comments in the counterstatement about these designs (that they are not similar), but nowhere is it accepted that the designs were made available before the relevant date. The significance of this relates to the lack of anything in the counterstatement or the witness statement upon which the tribunal can assess the date at which the designs were disclosed. In her witness statement Mr Tolson states:

“I conducted a search of images on the internet for trays, potentially used as lap trays, or alternatively trays that include a “well”. Exhibit JT1 is the examples that I selected from my search, compiled into a single document.”

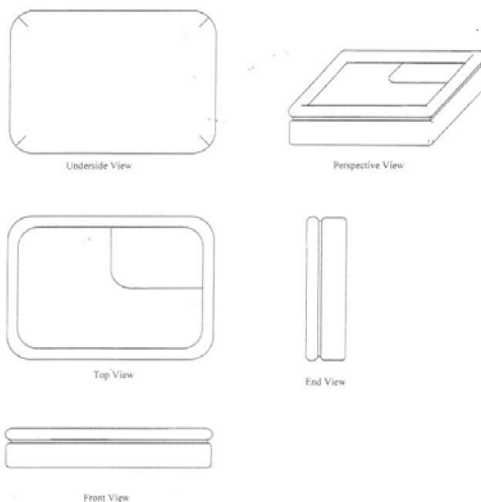
11. In its submissions the proprietor highlighted that none of the image are dated. Ms Tolson does not say when the search was conducted. Nor does she indicate whether the search itself was limited to particular dates. Even if she did, this itself would not necessarily have been strong evidence without supporting material such as internet archive prints. The statement of case gives no better information, containing simply a bare assertion that they are “examples of earlier designs”. Given all this, the designs depicted in Annex A cannot be taken into account as prior art.

12. The final piece of potential prior art is the RCD. Here, the details of the RCD are provided in the form of a print, from which it can be seen that it was published on 27 January 2014. This clearly counts as being made available before the relevant date and the RCD may be relied upon as prior art, something accepted in the proprietor’s submissions.

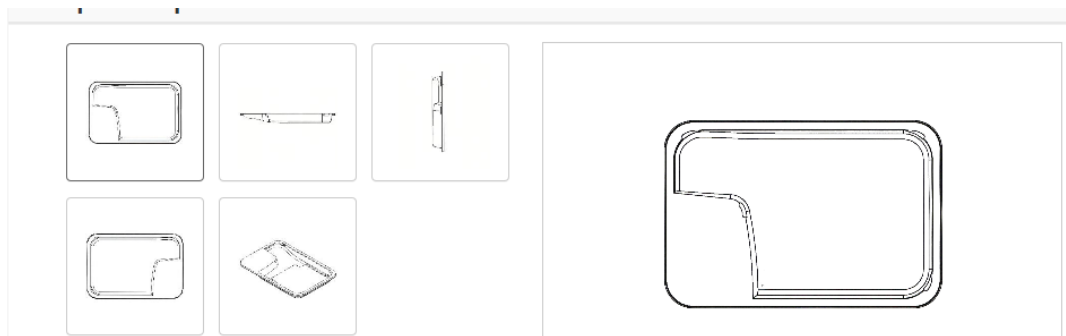
### **The competing designs**

13. Given the above findings, only one piece of prior art needs to be compared. The competing designs are, therefore:

#### *Registered design*



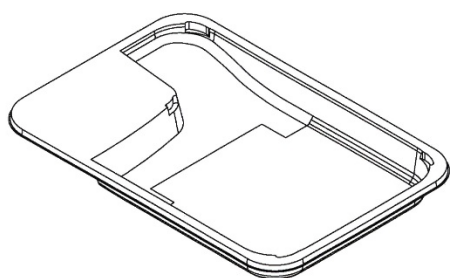
*Prior art*



14. In terms of being new, whilst this is not limited to identical designs, and includes within its scope designs which differ only in immaterial details, it is self-evident that the differences apparent in the above representations are not immaterial differences. Thus, the registered design is new compared to the prior art.

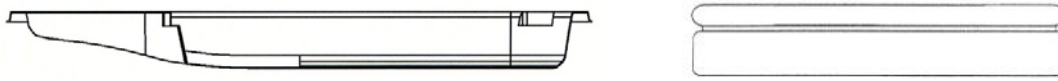
15. A design has individual character if the overall impression it produces on the informed user differs from the overall impression of the earlier design.

16. Whilst the designs have some similarities resulting from the overall rectangular shape, the relatively shallow depth of the items, and the additional shape in one corner apparent from the respective plan views, there are also some clear differences; most notably the steep recessing within the upper part of the tray of the prior art, seen most clearly in the following representation:



and the very different shape and configuration of the lower portions which, in the prior art, consists of a single construction with an irregular shape with a very thin lip, compared to a two piece construction of regular shape joined in some way. The method of construction is not, of course, relevant, but the resulting look is. The

difference can best be observed in the following representations, the prior art on the left, the registered design on the right:



17. In terms of design freedom, whilst designers of trays have a degree of constraint on account of the need to adopt a flat overall shape (for ease of use) with some form of lip to retain the contents, it strikes me that there is a reasonable degree of design freedom in the outward appearance created not only by the exact shape and configuration but also by any pattern or other embellishments which add to it. In terms of the design corpus, whilst Annex A of the applicant's evidence shows various examples, the issue mentioned earlier with regard to dates means that no real weight can be placed on this. I must, therefore, adopt a neutral position on this factor.

18. I have touched on the key similarities and differences already. In my view, the informed user making the comparison will see the designs for what they are – quite different products underpinned by quite different designs. They do not have the same overall impression. The claim fails.

### **Section 11ZA(2) of the Act**

19. Section 11ZA(2) of the Act reads as follows:

“2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

20. The relevant parts of section 2 of the Act are as follows:

“The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1A) [Repealed]

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) -

(3) In this Act the “author” of a design means the person who creates it.”

21. 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.”

22. Clearly, if Ms Sam-Pyatte’s design was the same as the registered design then there is potential for a claim based upon the proprietor not being the true proprietor of the design. I stress, though, the use of the word potential. The same potential may also apply in circumstances where the differences between the designs are immaterial. All of this, of course, is dependent on the factual circumstances relating to the creation of the designs.

23. There are, in my view, some fundamental problems with the claim. First, there is nothing to suggest that the proprietor ever saw the original design drawings mentioned earlier. Although the proprietor accepts that it purchased one of the applicant’s products, there is nothing showing that product and what exactly it looked like (and whether it was the same or differed only in immaterial details). Further, in its counterstatement the proprietor explained that its design was designed in August/September 2014, before the date on which the proprietor purchased one of the applicant’s products. There is nothing implausible in the explanation per se. Neither is that plausibility called into doubt because of its similarity to the purchased product

(because it has not been provided). The claim fails as there is nothing to show that the applicant is to be regarded as the proprietor of the registered design.

### **Outcome**

24. The grounds have failed. Therefore, subject to appeal, the design may remain registered.

### **Costs**

25. The proprietor has been successful and is entitled to a contribution towards costs. My assessment is as follows:

*Considering the statement of case and preparing the counterstatement – £300*

*Considering evidence – £250*

*Written submissions - £300*

***Total – £850***

26. I order Ms Deidre Ann Sam-Pyatte to pay Mr John Anthony Forth the sum of £850 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> Day of July 2017**

**Oliver Morris,  
For the Registrar  
The Comptroller-General**