

O-185-04

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF AN APPLICATION UNDER SECTION 11(2)  
BY THE SOLID SWIVEL COMPANY LIMITED  
FOR CANCELLATION OF REGISTERED DESIGN No. 2086587  
IN THE NAME OF DUNN & COWE LIMITED**

## **REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF an Application under Section 11(2)  
by The Solid Swivel Company Limited  
for cancellation of registered design No. 2086587  
in the name of Dunn & Cowe Limited**

### **BACKGROUND**

1. On 10 September 1999 Dunn & Crowe Limited applied under The Registered Designs Act 1949 (as amended) to register a design with the Statement of Article “Structural Anchor”. The registration was granted.

2. The statement of novelty for which registration is claimed is as follows:

“Registration is claimed in the shape, configuration, pattern and ornament of the article shown in the accompanying drawings”.

3. A copy of the representation of the design is at Appendix One to this decision.

4. On 10 September 2003 The Solid Swivel Company Limited filed an application under Section 11(2) of the Act to cancel the registered design on the grounds (as amended) that the registered design was shown in one of the registered proprietor’s brochures in 1993.

5. Section 1(2) of the Registered Designs Act 1949, as amended, provides:

“A design which is new may, upon application by the person claiming to be the proprietor, be registered under this Act in respect of any article, or set of articles, specified in the application.”

6. Section 1(4) of the Act goes on to say that a design shall not be regarded as new for the purposes of this Act if it is the same as a design registered in respect of the same or any other article in pursuance of a prior application, or published in the United Kingdom in respect of the same or any other article before the date of application, or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

7. The registered proprietor filed a Counterstatement denying the grounds of cancellation.

### **Applicant’s Evidence**

8. The applicant’s evidence contains the following alleged prior publication or “prior art”-

(i) A “rawplug” shown in the June 1980 catalogue of Kemfix Masonry Anchors – a copy is at Appendix Two to this decision.

- (ii) A structural anchor shown in the 1983 Product Catalogue of Hilti Great Britain Limited – a copy is at Appendix Three to this decision.
- (iii) A structural anchor shown in the Price List No. 1/93 of Upat – a copy is at Appendix Four to this decision.
- (iv) A structural anchor shown in the 1<sup>st</sup> March Price List E219 of Fischer Fixings – a copy is at Appendix Five to this decision.
- (v) A structural anchor shown in a September 1993 Technical Data Sheet of HC Limited – a copy is at Appendix Six to this decision.
- (vi) A structural anchor shown in a January 1994 Product Specification Catalogue of Ramset Fasteners Limited – a copy is at Appendix Seven of this decision.
- (vii) A structural anchor shown in a December 1994 Guidance Note of the Construction Fixings Association – a copy is at Appendix Eight to this decision.
- (viii) A structural anchor shown in September 1995 publication of Centuryan Safety Services Limited – a copy is at Appendix Nine to this decision.
- (ix) A structural anchor shown in a January 1996 Trade Price List of Hilti – a copy is at Appendix Ten to this decision.
- (x) A structural anchor shown in a 1996 Price List of SSR Stainless Steel Reinforcement Limited – a copy is at Appendix Eleven to this decision.
- (xi) A structural anchor shown in a November 1996 Technical Reference Manual of HCL – a copy is at Appendix Twelve to this decision.
- (xii) A structural anchor shown in a September 1997 Chemical Anchoring Systems Guide of Rawl Fixings – a copy is at Appendix Thirteen to this decision.

9. In addition, the applicant states that both the registered proprietor, Dunn & Cowe Limited, and the applicant have supplied ‘structural anchors’ of the designs of the same appearance as the registered design to UK customers prior to the relevant date (10 September 1999). The applicant attaches a Solid Swivel leaflet which, it states is a 1998 leaflet showing a structural anchor of the same appearance as the registered design – see Appendix Fourteen to this decision.

### **Registered Proprietor’s Evidence**

10. The registered proprietor denies that any examples of the alleged prior art illustrate a design which is the same as that shown in the representations of the design registration, or which differ from the design registration in immaterial details or common trade variants.

11. The registered proprietor goes on to provide more detailed submissions on “distinguishing features” of the designs.

12. This completes my summary of the evidence and submissions. I now turn to the decision.

## **DECISION**

13. Before comparing the relevant designs, I turn first to a consideration of whether there has been prior publication.

14. The registered proprietor has not disputed that the prior existence of any of the articles or products referred to in the applicant’s evidence (copied as Appendices Two to Fourteen of this decision).

15. While there is no definition of “published” in the Registered Designs Act 1949 (as amended), it has long been accepted that, in practice, it has the same meaning as when used in the Patents Act 1949 and its predecessors. Any design which has been made available to any person in the United Kingdom, who is free to use or disclose it, is treated as published. There is no requirement to prove that the publication is commonplace or even that it needs to be for commercial purposes. Indeed, in *Vredenburg’s Design* (1934) 52 RPC 7 it was held that the use of a single example of a new tennis racket at a tennis club amounted to publication of its design.

16. The alleged prior art submitted by the applicant is all dated prior to 10 September 1999 (the date of application for the design in suit) and it is apparent or can be readily inferred that it was available to the UK trade and in many instances the public at large. Upon consideration of the prior art I have no hesitation in finding that the articles referred to therein were published within the meaning of Section 1(4) of the Act.

17. I must now turn to a comparison of the relevant designs and decide whether the differences are only in immaterial details or are in features which are variants commonly used in the trade.

18. In considering the respective arguments relating to Section 1(4) I have borne in mind that the representations of the design in suit and the prior art must be viewed through the eye of a notional customer which, in this case, not only involves the trade, professional builders and engineers, but ordinary members of the public looking to utilise structural anchors in “do-it-yourself” projects e.g. fixing sanitary ware to masonry.

19. Registered designs are concerned with appeal to the eye and comparisons should be of the designs as a whole. In this particular case I pay regard to the fact that the proprietor’s statement of novelty is widely framed and consists of the following:

“registration is claimed in the shape, configuration, pattern and ornament of the article shown in the accompanying drawings”.

20. All the relevant designs consist of articles which perform identical functions in essentially the same manner. In such a close field of goods it is necessary to consider the features which are important for design purposes.

21. The design in suit consists of two parts of an anchor of cylindrical shape with “male” and “female” attachment features utilising a threaded projection and bore respectively. Both of the parts of the registered proprietor’s anchor include a pattern on the main body which runs down a major portion of its length.

22. In my considerations I am guided by the following comments of Laddie J in the matter of *Household Article Ltd’s* Registered Design No. 2044802 [1998] FSR 685-686, paragraphs 26 and 27:

“The purpose of Section 1(4) is to ensure that any designer is free to take a piece of prior art and to apply to it well known and commonly used design features or visually immaterial modifications of a mixture of both without fear of falling foul of a registered design. Even if the result of his work is visually pleasing and different it cannot fall within the scope of a valid design registration. If on the other hand the design in suit contains some features which are neither immaterial nor common trade variants then it must be looked at as a whole and the question answered whether, taking all the features together, it is sufficiently different to the prior art to warrant a monopoly of up to 25 years duration. In the latter case the fact, if it be one, that many of the features are either immaterial when taken by themselves or are common trade variants is likely to make it more difficult to show novelty.

The words “commonly used” in Section 1(4) must be given effect. This statutory provision does not mean that all features which are known and in the palette of alternatives available to a designer can be used with impunity. Were it so, as Mr Hacon emphasized, any design made up solely by blending together known design features would always be invalid. There is authority going back over a century showing that that has never been the law. A design can be novel even if it is made up entirely by blending together a number of old designs provided the resulting combination itself has a sufficiently distinctive appearance. It is only where all the features have been used before, and used commonly, (or are immaterial) that the Act deems them to be novelty-destroying.”

23. While much of the prior art in this case involves designs which are essentially cylindrical in shape, this is hardly surprising given the function of the product.

24. Registered designs are concerned with appeal to the eye and my first impression on viewing the respective designs was despite the obvious similarity between them, largely stemming from their functionality and relatively simplistic nature, there was an obvious important difference in that in particular, the application of the pattern onto the shape of the design in suit gave the registered proprietor’s design a different overall appearance to the prior art, as the registered proprietor’s pattern clearly differs from any pattern shown on the prior art. As a result, the respective designs look different.

25. When, after considering the evidence and submissions, I returned to compare the designs again, my opinion did not alter. The designs in their totality appear different. To qualify for design registration a design is not required to possess striking novelty and there are many precedents to show that a design can be legitimately registered even when it is quite close to the prior art. This is particularly true of designs in such a close field as the one in question.

26. No evidence has been filed in relation to variants commonly used in the trade and in my view, the differences in the respective designs are significant enough to give the registered design a different overall impression from the prior art. The designs differ in material details.

### **CONCLUSION**

27. In light of the reasons given above I have decided that the mark in suit meets the requirements of Section 1(2) of the Act. The application for cancellation, based upon Section 1(4) of the Act; is therefore refused.

### **COSTS**

28. As the application has failed the registered proprietor is entitled to a contribution towards costs. I accordingly order the applicant to pay the registered proprietor the sum of £700, which takes account of the fact that no hearing took place in this case. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28th day of June 2004**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**