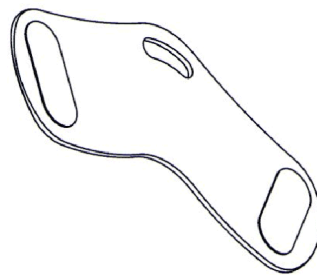


O-162-10

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 3024112



IN THE NAME OF MARIC SYSTEMS LTD

AND

A REQUEST TO INVALIDATE (NO. 24/09)

BY MARTIN JOHN SABINE

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

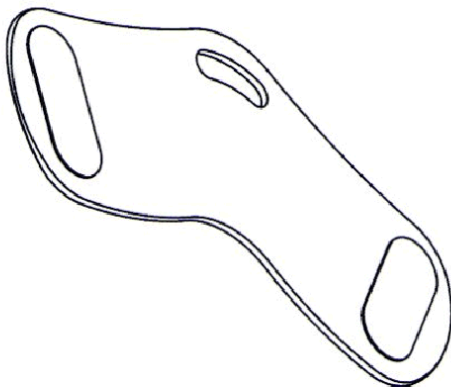
**In the matter of registered design no. 3024112
in the name of Maric Systems Ltd**

and

**a request to invalidate (no. 24/09)
by Martin John Sabine**

Factual background

1. The registered design the subject of these proceedings was filed on 3 March 2006 by Maric Systems Ltd (“Maric”). The design is said (on the form of application) to be the design of a transfer board. Later evidence shows that this is a reference to a board that is used to transport patients or people with disabilities from one thing to another. I will refer to the registered design as “the Maric design”. The Maric design is said to have its novelty reside in its shape and configuration. The register shows eight different views of the Maric design, for the time being, I reproduce just one of them below:



2. On 7 April 2009 Mr Martin John Sabine applied to invalidate the Maric design. Mr Sabine’s grounds are based on sections 11ZA and 1B of the Registered Designs Act 1949 (as amended) (“the Act”) which, in combination, mean that a design registration may be declared invalid if it does not meet the requirements of novelty and individual character set out in the Act. In support of his claim Mr Sabine refers to his own earlier registered design¹. He also refers to the use of designs in the marketplace (he provides two examples) since 1988 by his marketing company, Onward Design Ltd. Even though Mr Sabine may regard the

¹ Design registration 1054216.

marketed products as representing the use of his registered design, there is a slight difference between one of them and his registered design (which I will explain later) so I will consider them all as separate pieces of prior art.

3. Maric filed a counterstatement denying the grounds of invalidation. The counterstatement also provides detailed submissions on the differences between the Maric design and the prior art highlighted by Mr Sabine. Only Mr Sabine filed evidence. The evidence accompanied his request to invalidate and his statement of case. He also filed further evidence under cover of a further statement of case. I will not make a summary of the evidence here, but will refer to the relevant parts of it in the body of this decision. Maric filed written submissions in response to the further evidence; I will refer to these submissions later. Neither side requested a hearing.

The legal background

4. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B 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
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- (6) A disclosure falls within this subsection if-
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- (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.”

5. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked. This means that the material date for my assessment is 3 March 2006. Any prior art must have been made available to the public prior to this date.

6. The approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

- a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.
- b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.
- c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the article in question; imperfect recollection has little role to play.
- d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.
- e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

7. In assessing the attributes of the “informed user”, I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

“First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the

articles and both counsel roundly rejected the candidature of “the man in the street”.

“Informed” to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of “what’s about in the market?” and “what’s been about in the recent past?”. I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any).

In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

8. I also note that the above approach regarding the informed user was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch) and later accepted as appropriate by the Court of Appeal in that case.

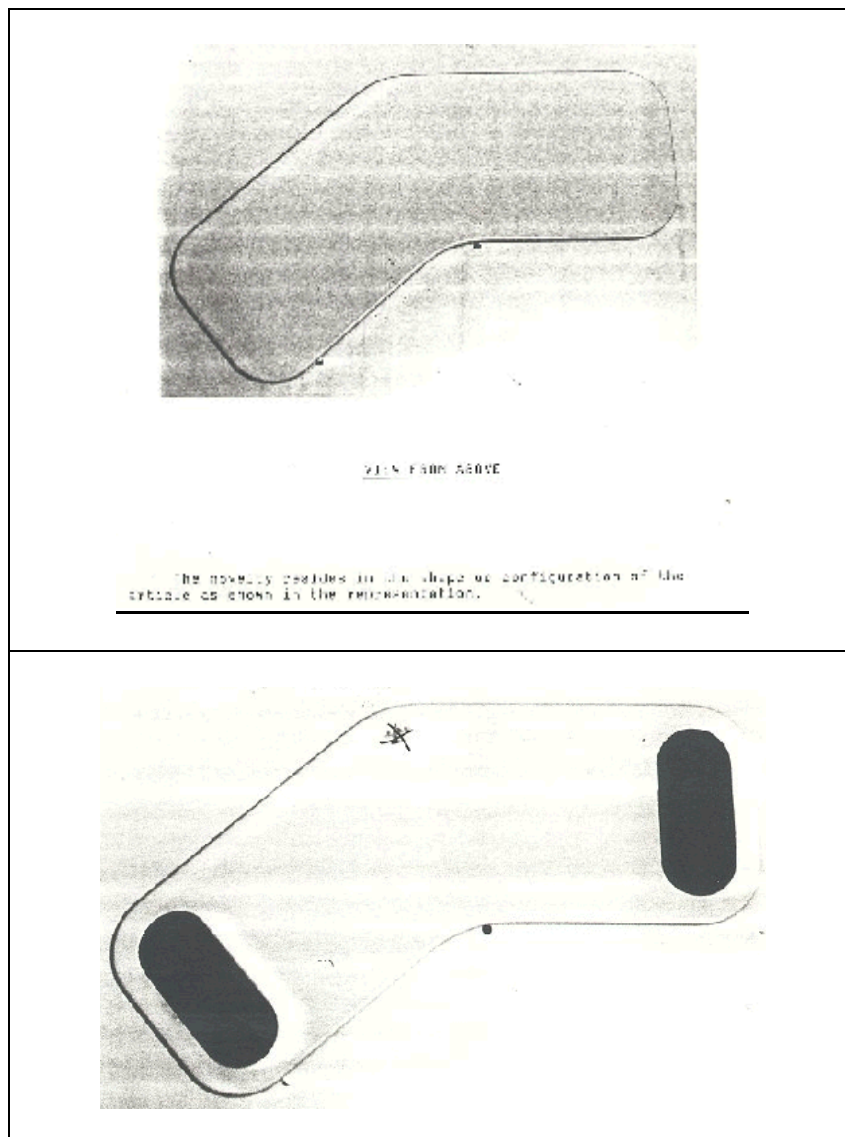
Application of the legal principles

The informed user

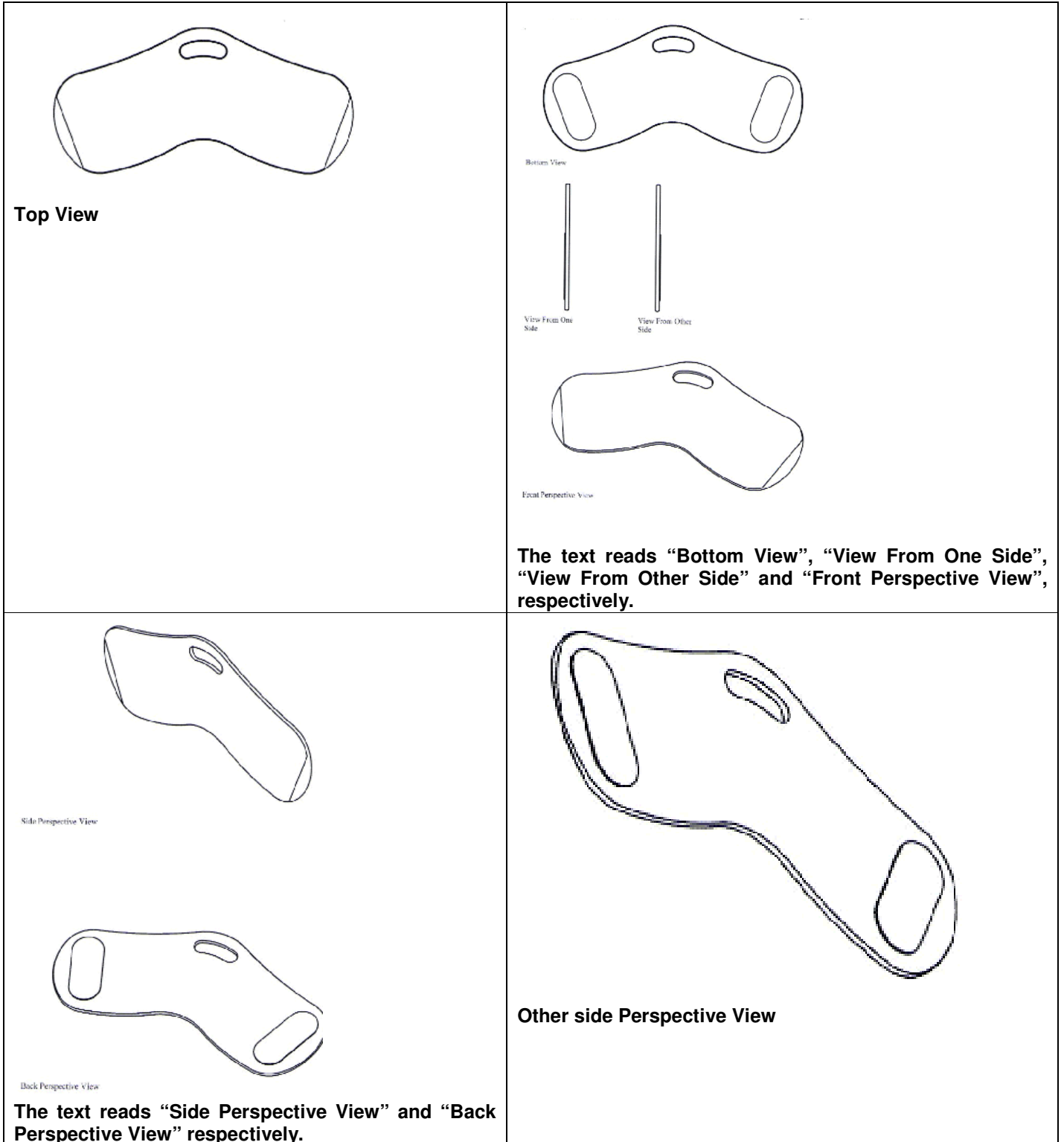
9. Before looking at the Maric design and the prior art in more detail, I must firstly assess who the “informed user” is. The Maric design relates to a transfer board for patients or people with disabilities. As will be seen shortly, the prior art relates to the same. The informed user will not be a designer or these sorts of articles. Instead, the informed user, as the name suggests, will be a user, of some sort, of the article. Mr Sabine’s evidence shows one of the articles in use, it is clear that a transfer board can be used by a patient unassisted or with the help of another person such as a carer (which could be a family member or a healthcare professional). Both these types of persons are users of the article, but they may not, generally speaking, have any particular level of familiarity with other designs for the articles in question. The informed user will, instead, be a type of person who is more familiar with the other types of design on the market. Such a person is likely to know of the other types of product in the market (the “what’s about”/“what’s about in the recent past” test). Such a person will not appreciate a design too generally, but nor will they make a forensic analysis of each and every detail.

Comparison with Mr Sabine's registered design

10. I will firstly consider the matter from the perspective of Mr Sabine's registered design. The first task is to ensure that Mr Sabine's registered design was made available to the public before the relevant date i.e. before the 3 March 2006. The details held on the Intellectual Property Office's designs database show that a certificate of registration was issued in May 1989 (the design was applied for on 12 October 1988). The registered design would have been made available to the public in the relevant design journal at this time. This is well before the material date. Mr Sabine's registered design counts as prior art for the purpose of these proceedings. Mr Sabine's registered design is set out below.



11. Mr Sabine's registered design must be compared to the Maric design which is set out below:



12. In his original statement of case Mr Sabine says that he is a former director of Maric and that:

“they [Maric] are trying to cynically exploit their product by making minor changes in the shape of the transfer board in their design registration, they have also chosen to make their board in the exact same colour”.

13. In its counterstatement, Maric provides a detailed breakdown of the differences and similarities between the respective designs. In terms of similarities, it concedes that both boards are essentially flat and banana shaped but that these are functional requirements – being flat is required so that the patient can sit on the board, being banana shaped is required so that it is easier to transfer patients to cars (where access is often around corners due to the car doors) and that the shape is also useful in cases where the arm of a wheelchair cannot be removed. In terms of differences, which it says contribute to the novelty and individual character of its design, it highlights the generally curvilinear outline of its design compared to the straighter lines on Mr Sabine’s design. It highlights that its board has a handle whereas Mr Sabine’s design has none and it further highlights that the shape of the handle mirrors the curvilinear profile of its design and that it is cut-through the board – it says that the shape, the position and the cut-through nature were design choices. It highlights that the Maric design has tapering ends whereas Mr Sabine’s design does not. It sums up by saying that the Maric board, due to the differences it has highlighted, will create a more visually and aesthetically appealing impression on an informed user.

14. Maric’s submission is that the flatness of the board and the bend in it (the banana shape) are functional. Whilst Mr Sabine has not specifically denied this point, he has not admitted it either. It is, therefore, important that I assess this argument carefully. It is an important argument because if the flatness of the board and the bend in it are completely arbitrary features of the designs in question then the more likely it is that the designs would have the same (or at least not clearly different) overall impression. Maric has filed no independent evidence to support the claim to functionality. This is not, though, fatal to its case because the tribunal can see the designs and appreciate their intended purpose with relative ease. Whilst this is an easier task with consumer articles, it is still possible with the articles in question here. The job is made easier, though, by some of the evidence from Mr Sabine. He provided a document containing a series of illustrations showing a transfer board in use. It shows a person sliding from one thing (such as a wheelchair) to another (such as a car) by using the transfer board. It is clear to me that being flat and, also, being its relative width and length, are features which assist in this process. If it was not flat then the person would have difficulty in getting onto the board. If the board was longer then it may be too weak in the middle and would be unnecessarily long to slide across. If it was shorter then the ability to slide from one thing to another may not be possible. The width of the article is such to facilitate the person sitting on the board and, therefore, supporting the bottom and lower legs of the person using it.

Similarly, the images also illustrate that the bend in the board is a feature which assists in the transfer process, making it easier, in certain circumstances, for the transfer board to be used. The informed user will be aware of these functional aspects of the designs when considering their overall impressions. Whilst they still form part of the overall impressions, their functional aspect will be borne in mind with the result that the informed user will pay more attention to those aspects of the design where there is a greater degree of design freedom.

15. In addition to the point of (functional) similarity identified by Maric, there is a further point of similarity between the designs. Both designs, on their respective bottom views, have a geometric shape (I can only describe it as a rectangle with curved ends) at either end of the board. One of the pieces of evidence relating to Mr Sabine's design as marketed (which also has these shapes) describes them as non-slip pads. I have no reason to assume that they are not also pads on the Maric design. I note that the shapes of these pads and their position are virtually identical. These shapes will form part of the overall impressions of the respective designs. Whilst the design of a non-slip pad provides an additional functional feature, there is nothing that necessarily dictates their exact shape and position and there may, therefore, be some design freedom here. That being said, the shapes fit the general profile of the respective boards and strike me as an obvious shape and position that would be used if non-slip pads were to form part of the design of such an article.

16. Having looked at the similarities between the boards, I must now consider the differences, and, crucially, whether such differences form part of the overall impression of the respective designs. The differences highlighted by Maric relate to the curvilinear (as opposed to straight-line) appearance of the Maric design, the cut-through handle (which is not present in the Sabine design) and the tapered ends. I believe that the curvilinear features of the Maric design will be noticed by the informed user. I agree with Maric that it creates an aesthetically pleasing appearance. Mr Sabine's design will be seen as a more basic, functional looking design with more straight-lines. I also agree with Maric that the tapered ends of its design will also be noticed and adds to its design characteristics as opposed to being seen as a functional characteristic. The handle, whilst it will be noticed by the informed user as part of the overall impression, will strike him or her as functional. Whilst the shape of the cut-through handle mirrors the curvilinear feel of the board, it is still, essentially, functional. Furthermore, whilst I accept Maric's argument that other types of handle could be used and/or used in different positions, the position of the cut-through handle will strike the informed user as the most obvious place for such a functional addition. Furthermore, the fact that it consists of a cut-through will strike the informed user as the most suitable form of handle so as to not interfere with the purpose of the board.

17. The overall impression on the informed user must be assessed at an appropriate level of generality. I would summarise the position as to overall impression thus:

Mr Sabine's registered design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general straight-lined aspect of the board will be noticed as its design characteristic producing a basic, no-frills design.

The Maric design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general curvilinear aspect of the board will be noticed as part of its design characteristics producing an aesthetically pleasing impression. Further, that the design characteristics are enhanced by the tapered ends of the board. The cut-through handle will be noticed, but, this will be regarded as an essentially functional addition.

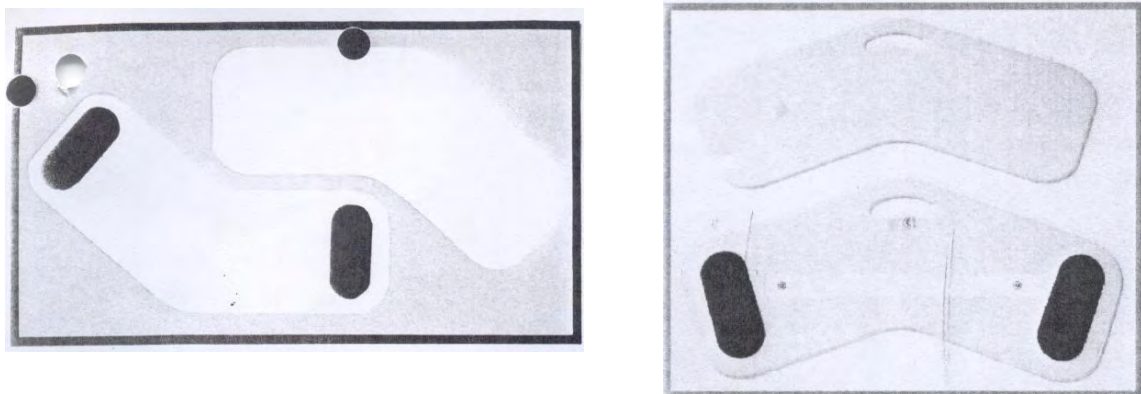
18. The designs are not identical nor do I consider the differences between them to be immaterial. The Maric design is, therefore, a new design in accordance with section 1B(1) and (2) of the Act. The Maric design must, though, have individual character when considering its overall impression (compared to that of Mr Sabine's registered design). To that extent, I have not described the overall impressions of the respective designs in the same way. The overall impression is not the same. But are the differences clear enough? Whilst the overall impression of the general shape and configuration is similar, this, as assessed earlier, relates to functional aspects of the article. If a designer is to produce a transfer board which is flat and which contains a bend in order to reproduce this function, the freedom for design is limited. Nevertheless, the Maric design contains design characteristics in terms of the curvilinear shape and its tapered ends which enhances its overall impression and creates clear differences from the plainer, basic looking design embodied in Mr Sabine's registered design. I place less weight on the addition of the cut-through handle. As identified in *Procter &*

Gamble Co. v Reckitt Benckizer (UK) Ltd, smaller differences may be sufficient when design freedom is limited. This, I believe, is a case in point. The informed user may appreciate that the general shape is similar, but that such a shape is present for the desired function and purpose of the board. The informed user will, therefore, focus more on the smaller details and differences where the designer has more freedom – to that extent, I consider that the differences the informed user will appreciate (as I have set out already) are sufficient. The ground of invalidation fails when considering Mr Sabine’s registered design as prior art.

19. Mr Sabine also claims that his registered design is being infringed and that Maric is guilty of passing-off. I stress that these are not matters for this tribunal. The only matter I can determine is whether the Maric design meets the requirement for novelty in comparison to any prior art that Mr Sabine identifies. I should also stress that Mr Sabine’s reference to the use of the same coloured article does not assist given that colour does not appear to be an aspect of either design. The comparison has been made on the basis of the shape and configuration of the respective designs. I also add that the fact that Mr Sabine previously worked for Maric and that they previously licensed his earlier design has no real relevance. It matters not how they came up with the design, what matters is the overall impression that the informed user takes from the respective designs.

Comparison with Mr Sabine’s marketplace use

20. In addition to his own registered design, Mr Sabine also relies on the use of his design in the marketplace since 1988. With his original statement of case he provided three pieces of evidence showing documents that had been issued to the public. One of these contains a series of illustrations (as described earlier) showing the transfer board in use, but it is not possible from these illustrations to see in any detail the design itself. The other two documents are clearer and contain the following images:



21. The image depicted above left does not appear to be any different to Mr Sabine’s registered design. This cannot, therefore, take him any further forward.

The image above right contains one difference from Mr Sabine's registered design in that it has a cut-through handle, as does the Maric design. There are, though, two reasons why this design does not assist.

- 1) The design is said to have been used in the marketplace since 1998. However, the design in the above right image² is said to be a new design based on one that has been in use since 1998. The document itself is not dated nor does Mr Sabine provide the date on which it was made available to the public. Whilst it may have been made available to the public prior to the relevant date, there is no evidence of this. This means that the design cannot be regarded as prior art and the claim must, therefore, fail on this point.
- 2) Even if I am wrong on the above, I do not regard the addition of the cut-through handle on the design to be a sufficient enough addition to its overall impression so as to significantly affect the analysis I made in relation to Mr Sabine's registered design. The handle may be cut-through and similarly positioned but this, as I assessed earlier, is more functional than design orientated and this will be appreciated by the informed user. The differences highlighted with reference to Mr Sabine's registered design compared to the Maric design, including the curvilinear appearance, are still present and still produce a clearly different overall impression on an informed user.

The Banana Board 100

22. In his further evidence (which is filed under cover of a further document headed "Statement of Case"), which I will consider despite it being filed one week late, Mr Sabine makes reference to another transfer board, namely the Banana Board 100. Mr Sabine refers to this board in response to Maric's counterstatement and their reliance on the Maric design's handle and chamfered edges as contributing to the creation of a different overall impression from Mr Sabine's design. This implies that the Banana Board 100 has a cut-through handle and chamfered edges. However, reference to this design goes beyond the pleaded case, furthermore, there is no documentation to support that the Banana Board 100 was made available to the public before the material date, and, there is nothing showing the design itself³. In any event, I do not see how Mr Sabine would be in any better position because even if the Banana Board 100 has chamfered edges, these are said to be on the bottom of the board whereas the tapered edges of the Maric design are on the top of the board. Furthermore,

² The document describes it as the Banana Board 190, which is also available as the Banana Board 120; the numbers used relate to the weight limit of the boards (in KGs).

³ Whilst Mr Sabine stated that he has a board still in cellophane from the original manufacture (June 2003) available for inspection, nothing has been provided for the tribunal to make its comparison. The onus is on Mr Sabine to provide whatever evidence he relies upon.

whilst it may also have a cut-through handle this is essentially a functional aspect. Finally, and crucially, there is no suggestion that the Banana board 100 has the key curvilinear appearance as per the Maric design which would bring the designs substantially closer to each other. Therefore, the Banana board 100 design would not, based on how Mr Sabine describes it, bring it significantly closer in terms of overall impression so as to reach any different conclusion.

Outcome

23. Mr Sabine's request to invalidate the Maric design fails.

Costs

24. Maric, having been successful, is entitled to a contribution towards its costs⁴. I hereby order Mr Martin John Sabine to pay Maric Systems Ltd the sum of £600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£400
Considering and commenting on the other side's evidence	£200

25. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of May 2010

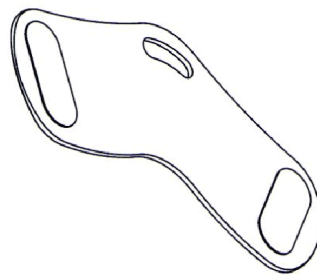
**Oliver Morris
For the Registrar
The Comptroller-General**

⁴ Costs are based on the scale set out in TPN 4/2007

O-162-10

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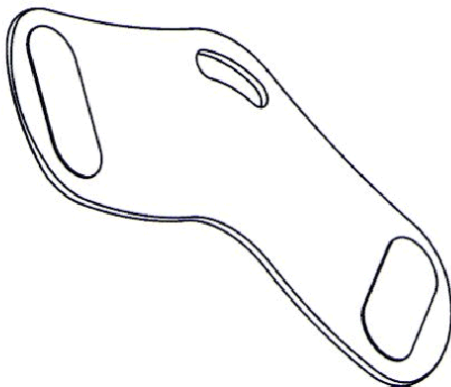
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The legal background

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In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

8. I also note that the above approach regarding the informed user was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch) and later accepted as appropriate by the Court of Appeal in that case.

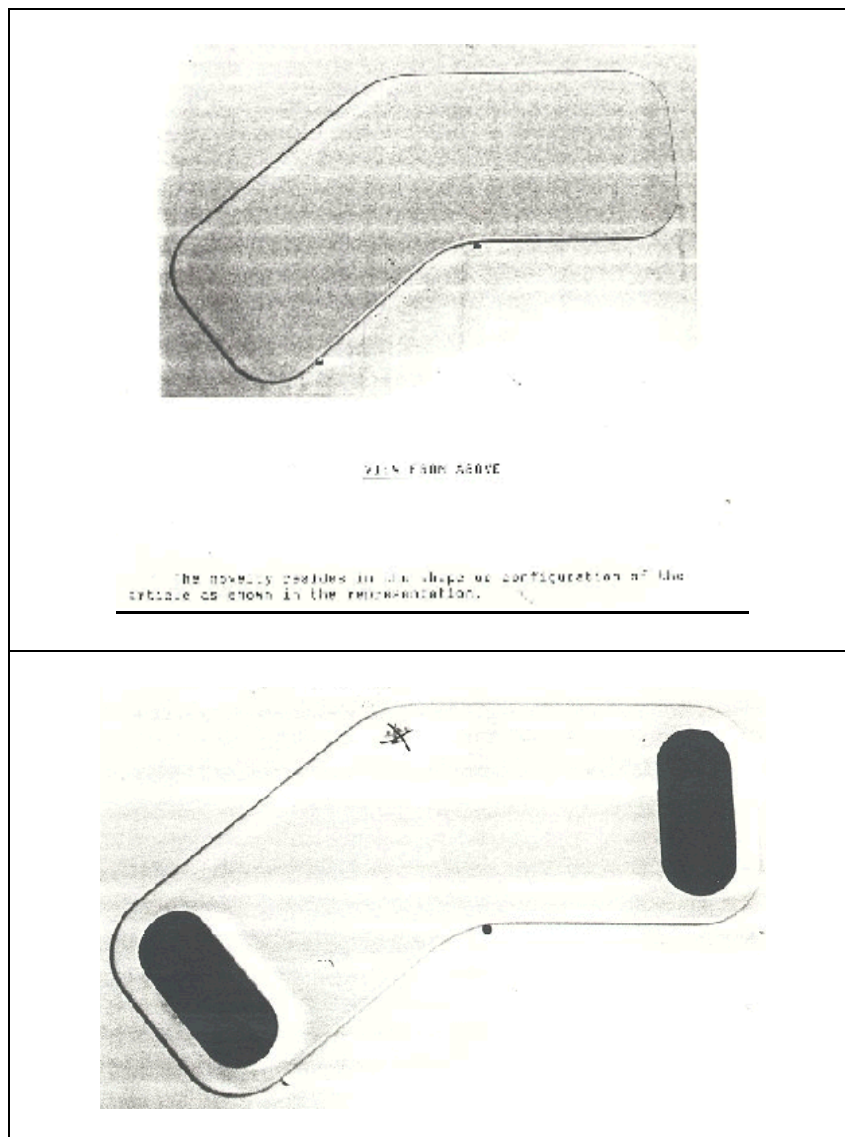
Application of the legal principles

The informed user

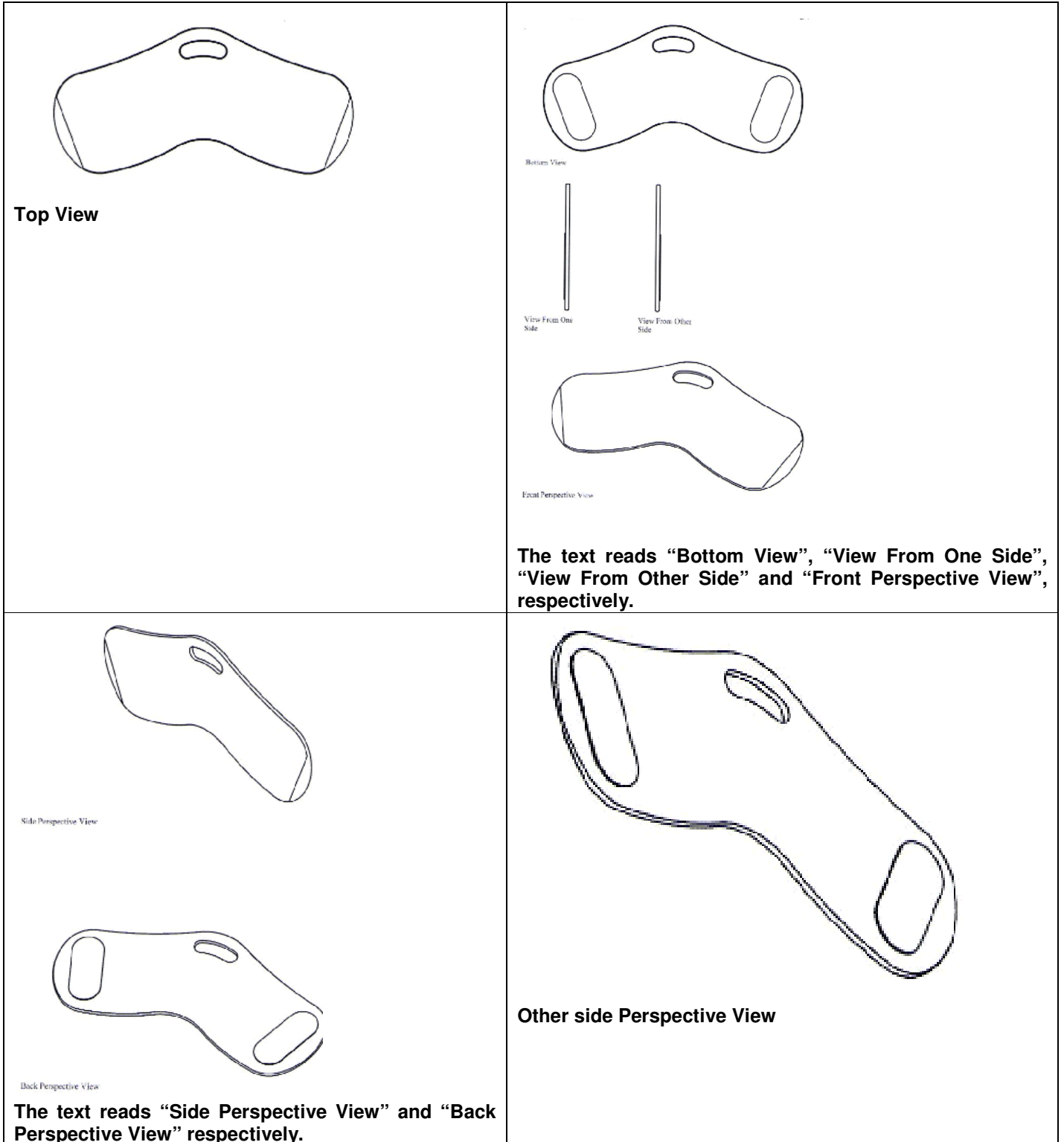
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Comparison with Mr Sabine's registered design

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11. Mr Sabine's registered design must be compared to the Maric design which is set out below:



12. In his original statement of case Mr Sabine says that he is a former director of Maric and that:

“they [Maric] are trying to cynically exploit their product by making minor changes in the shape of the transfer board in their design registration, they have also chosen to make their board in the exact same colour”.

13. In its counterstatement, Maric provides a detailed breakdown of the differences and similarities between the respective designs. In terms of similarities, it concedes that both boards are essentially flat and banana shaped but that these are functional requirements – being flat is required so that the patient can sit on the board, being banana shaped is required so that it is easier to transfer patients to cars (where access is often around corners due to the car doors) and that the shape is also useful in cases where the arm of a wheelchair cannot be removed. In terms of differences, which it says contribute to the novelty and individual character of its design, it highlights the generally curvilinear outline of its design compared to the straighter lines on Mr Sabine’s design. It highlights that its board has a handle whereas Mr Sabine’s design has none and it further highlights that the shape of the handle mirrors the curvilinear profile of its design and that it is cut-through the board – it says that the shape, the position and the cut-through nature were design choices. It highlights that the Maric design has tapering ends whereas Mr Sabine’s design does not. It sums up by saying that the Maric board, due to the differences it has highlighted, will create a more visually and aesthetically appealing impression on an informed user.

14. Maric’s submission is that the flatness of the board and the bend in it (the banana shape) are functional. Whilst Mr Sabine has not specifically denied this point, he has not admitted it either. It is, therefore, important that I assess this argument carefully. It is an important argument because if the flatness of the board and the bend in it are completely arbitrary features of the designs in question then the more likely it is that the designs would have the same (or at least not clearly different) overall impression. Maric has filed no independent evidence to support the claim to functionality. This is not, though, fatal to its case because the tribunal can see the designs and appreciate their intended purpose with relative ease. Whilst this is an easier task with consumer articles, it is still possible with the articles in question here. The job is made easier, though, by some of the evidence from Mr Sabine. He provided a document containing a series of illustrations showing a transfer board in use. It shows a person sliding from one thing (such as a wheelchair) to another (such as a car) by using the transfer board. It is clear to me that being flat and, also, being its relative width and length, are features which assist in this process. If it was not flat then the person would have difficulty in getting onto the board. If the board was longer then it may be too weak in the middle and would be unnecessarily long to slide across. If it was shorter then the ability to slide from one thing to another may not be possible. The width of the article is such to facilitate the person sitting on the board and, therefore, supporting the bottom and lower legs of the person using it.

Similarly, the images also illustrate that the bend in the board is a feature which assists in the transfer process, making it easier, in certain circumstances, for the transfer board to be used. The informed user will be aware of these functional aspects of the designs when considering their overall impressions. Whilst they still form part of the overall impressions, their functional aspect will be borne in mind with the result that the informed user will pay more attention to those aspects of the design where there is a greater degree of design freedom.

15. In addition to the point of (functional) similarity identified by Maric, there is a further point of similarity between the designs. Both designs, on their respective bottom views, have a geometric shape (I can only describe it as a rectangle with curved ends) at either end of the board. One of the pieces of evidence relating to Mr Sabine's design as marketed (which also has these shapes) describes them as non-slip pads. I have no reason to assume that they are not also pads on the Maric design. I note that the shapes of these pads and their position are virtually identical. These shapes will form part of the overall impressions of the respective designs. Whilst the design of a non-slip pad provides an additional functional feature, there is nothing that necessarily dictates their exact shape and position and there may, therefore, be some design freedom here. That being said, the shapes fit the general profile of the respective boards and strike me as an obvious shape and position that would be used if non-slip pads were to form part of the design of such an article.

16. Having looked at the similarities between the boards, I must now consider the differences, and, crucially, whether such differences form part of the overall impression of the respective designs. The differences highlighted by Maric relate to the curvilinear (as opposed to straight-line) appearance of the Maric design, the cut-through handle (which is not present in the Sabine design) and the tapered ends. I believe that the curvilinear features of the Maric design will be noticed by the informed user. I agree with Maric that it creates an aesthetically pleasing appearance. Mr Sabine's design will be seen as a more basic, functional looking design with more straight-lines. I also agree with Maric that the tapered ends of its design will also be noticed and adds to its design characteristics as opposed to being seen as a functional characteristic. The handle, whilst it will be noticed by the informed user as part of the overall impression, will strike him or her as functional. Whilst the shape of the cut-through handle mirrors the curvilinear feel of the board, it is still, essentially, functional. Furthermore, whilst I accept Maric's argument that other types of handle could be used and/or used in different positions, the position of the cut-through handle will strike the informed user as the most obvious place for such a functional addition. Furthermore, the fact that it consists of a cut-through will strike the informed user as the most suitable form of handle so as to not interfere with the purpose of the board.

17. The overall impression on the informed user must be assessed at an appropriate level of generality. I would summarise the position as to overall impression thus:

Mr Sabine's registered design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general straight-lined aspect of the board will be noticed as its design characteristic producing a basic, no-frills design.

The Maric design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general curvilinear aspect of the board will be noticed as part of its design characteristics producing an aesthetically pleasing impression. Further, that the design characteristics are enhanced by the tapered ends of the board. The cut-through handle will be noticed, but, this will be regarded as an essentially functional addition.

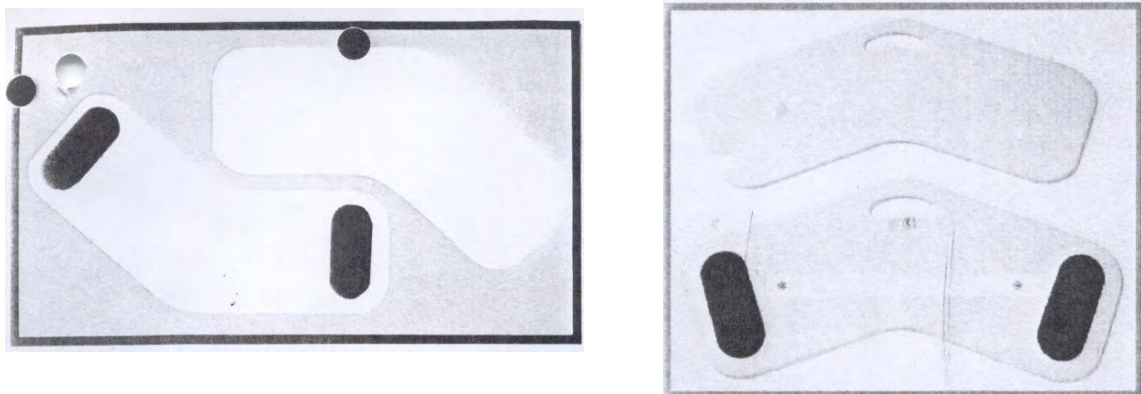
18. The designs are not identical nor do I consider the differences between them to be immaterial. The Maric design is, therefore, a new design in accordance with section 1B(1) and (2) of the Act. The Maric design must, though, have individual character when considering its overall impression (compared to that of Mr Sabine's registered design). To that extent, I have not described the overall impressions of the respective designs in the same way. The overall impression is not the same. But are the differences clear enough? Whilst the overall impression of the general shape and configuration is similar, this, as assessed earlier, relates to functional aspects of the article. If a designer is to produce a transfer board which is flat and which contains a bend in order to reproduce this function, the freedom for design is limited. Nevertheless, the Maric design contains design characteristics in terms of the curvilinear shape and its tapered ends which enhances its overall impression and creates clear differences from the plainer, basic looking design embodied in Mr Sabine's registered design. I place less weight on the addition of the cut-through handle. As identified in *Procter &*

Gamble Co. v Reckitt Benckizer (UK) Ltd, smaller differences may be sufficient when design freedom is limited. This, I believe, is a case in point. The informed user may appreciate that the general shape is similar, but that such a shape is present for the desired function and purpose of the board. The informed user will, therefore, focus more on the smaller details and differences where the designer has more freedom – to that extent, I consider that the differences the informed user will appreciate (as I have set out already) are sufficient. The ground of invalidation fails when considering Mr Sabine’s registered design as prior art.

19. Mr Sabine also claims that his registered design is being infringed and that Maric is guilty of passing-off. I stress that these are not matters for this tribunal. The only matter I can determine is whether the Maric design meets the requirement for novelty in comparison to any prior art that Mr Sabine identifies. I should also stress that Mr Sabine’s reference to the use of the same coloured article does not assist given that colour does not appear to be an aspect of either design. The comparison has been made on the basis of the shape and configuration of the respective designs. I also add that the fact that Mr Sabine previously worked for Maric and that they previously licensed his earlier design has no real relevance. It matters not how they came up with the design, what matters is the overall impression that the informed user takes from the respective designs.

Comparison with Mr Sabine’s marketplace use

20. In addition to his own registered design, Mr Sabine also relies on the use of his design in the marketplace since 1988. With his original statement of case he provided three pieces of evidence showing documents that had been issued to the public. One of these contains a series of illustrations (as described earlier) showing the transfer board in use, but it is not possible from these illustrations to see in any detail the design itself. The other two documents are clearer and contain the following images:



21. The image depicted above left does not appear to be any different to Mr Sabine’s registered design. This cannot, therefore, take him any further forward.

The image above right contains one difference from Mr Sabine's registered design in that it has a cut-through handle, as does the Maric design. There are, though, two reasons why this design does not assist.

- 1) The design is said to have been used in the marketplace since 1998. However, the design in the above right image² is said to be a new design based on one that has been in use since 1998. The document itself is not dated nor does Mr Sabine provide the date on which it was made available to the public. Whilst it may have been made available to the public prior to the relevant date, there is no evidence of this. This means that the design cannot be regarded as prior art and the claim must, therefore, fail on this point.
- 2) Even if I am wrong on the above, I do not regard the addition of the cut-through handle on the design to be a sufficient enough addition to its overall impression so as to significantly affect the analysis I made in relation to Mr Sabine's registered design. The handle may be cut-through and similarly positioned but this, as I assessed earlier, is more functional than design orientated and this will be appreciated by the informed user. The differences highlighted with reference to Mr Sabine's registered design compared to the Maric design, including the curvilinear appearance, are still present and still produce a clearly different overall impression on an informed user.

The Banana Board 100

22. In his further evidence (which is filed under cover of a further document headed "Statement of Case"), which I will consider despite it being filed one week late, Mr Sabine makes reference to another transfer board, namely the Banana Board 100. Mr Sabine refers to this board in response to Maric's counterstatement and their reliance on the Maric design's handle and chamfered edges as contributing to the creation of a different overall impression from Mr Sabine's design. This implies that the Banana Board 100 has a cut-through handle and chamfered edges. However, reference to this design goes beyond the pleaded case, furthermore, there is no documentation to support that the Banana Board 100 was made available to the public before the material date, and, there is nothing showing the design itself³. In any event, I do not see how Mr Sabine would be in any better position because even if the Banana Board 100 has chamfered edges, these are said to be on the bottom of the board whereas the tapered edges of the Maric design are on the top of the board. Furthermore,

² The document describes it as the Banana Board 190, which is also available as the Banana Board 120; the numbers used relate to the weight limit of the boards (in KGs).

³ Whilst Mr Sabine stated that he has a board still in cellophane from the original manufacture (June 2003) available for inspection, nothing has been provided for the tribunal to make its comparison. The onus is on Mr Sabine to provide whatever evidence he relies upon.

whilst it may also have a cut-through handle this is essentially a functional aspect. Finally, and crucially, there is no suggestion that the Banana board 100 has the key curvilinear appearance as per the Maric design which would bring the designs substantially closer to each other. Therefore, the Banana board 100 design would not, based on how Mr Sabine describes it, bring it significantly closer in terms of overall impression so as to reach any different conclusion.

Outcome

23. Mr Sabine's request to invalidate the Maric design fails.

Costs

24. Maric, having been successful, is entitled to a contribution towards its costs⁴. I hereby order Mr Martin John Sabine to pay Maric Systems Ltd the sum of £600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£400
Considering and commenting on the other side's evidence	£200

25. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of May 2010

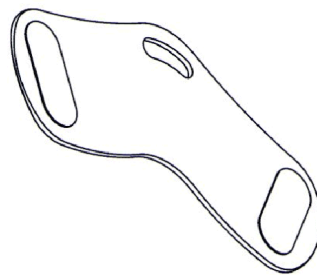
**Oliver Morris
For the Registrar
The Comptroller-General**

⁴ Costs are based on the scale set out in TPN 4/2007

O-162-10

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 3024112



IN THE NAME OF MARIC SYSTEMS LTD

AND

A REQUEST TO INVALIDATE (NO. 24/09)

BY MARTIN JOHN SABINE

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

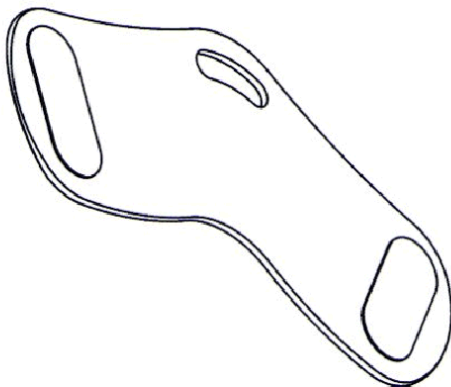
**In the matter of registered design no. 3024112
in the name of Maric Systems Ltd**

and

**a request to invalidate (no. 24/09)
by Martin John Sabine**

Factual background

1. The registered design the subject of these proceedings was filed on 3 March 2006 by Maric Systems Ltd (“Maric”). The design is said (on the form of application) to be the design of a transfer board. Later evidence shows that this is a reference to a board that is used to transport patients or people with disabilities from one thing to another. I will refer to the registered design as “the Maric design”. The Maric design is said to have its novelty reside in its shape and configuration. The register shows eight different views of the Maric design, for the time being, I reproduce just one of them below:



2. On 7 April 2009 Mr Martin John Sabine applied to invalidate the Maric design. Mr Sabine’s grounds are based on sections 11ZA and 1B of the Registered Designs Act 1949 (as amended) (“the Act”) which, in combination, mean that a design registration may be declared invalid if it does not meet the requirements of novelty and individual character set out in the Act. In support of his claim Mr Sabine refers to his own earlier registered design¹. He also refers to the use of designs in the marketplace (he provides two examples) since 1988 by his marketing company, Onward Design Ltd. Even though Mr Sabine may regard the

¹ Design registration 1054216.

marketed products as representing the use of his registered design, there is a slight difference between one of them and his registered design (which I will explain later) so I will consider them all as separate pieces of prior art.

3. Maric filed a counterstatement denying the grounds of invalidation. The counterstatement also provides detailed submissions on the differences between the Maric design and the prior art highlighted by Mr Sabine. Only Mr Sabine filed evidence. The evidence accompanied his request to invalidate and his statement of case. He also filed further evidence under cover of a further statement of case. I will not make a summary of the evidence here, but will refer to the relevant parts of it in the body of this decision. Maric filed written submissions in response to the further evidence; I will refer to these submissions later. Neither side requested a hearing.

The legal background

4. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B 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) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);
 - (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) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
 - (e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.
- (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 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.”

5. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked. This means that the material date for my assessment is 3 March 2006. Any prior art must have been made available to the public prior to this date.

6. The approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

- a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.
- b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.
- c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the article in question; imperfect recollection has little role to play.
- d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.
- e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

7. In assessing the attributes of the “informed user”, I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

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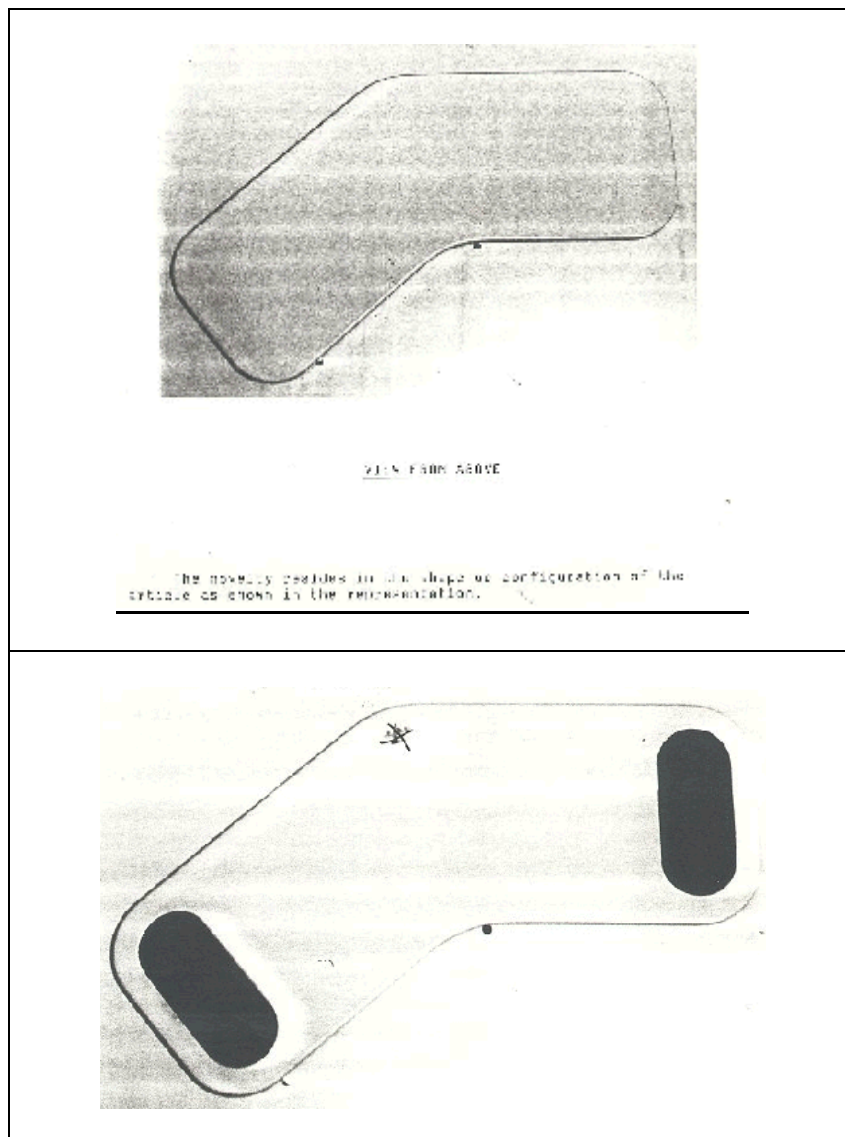
Application of the legal principles

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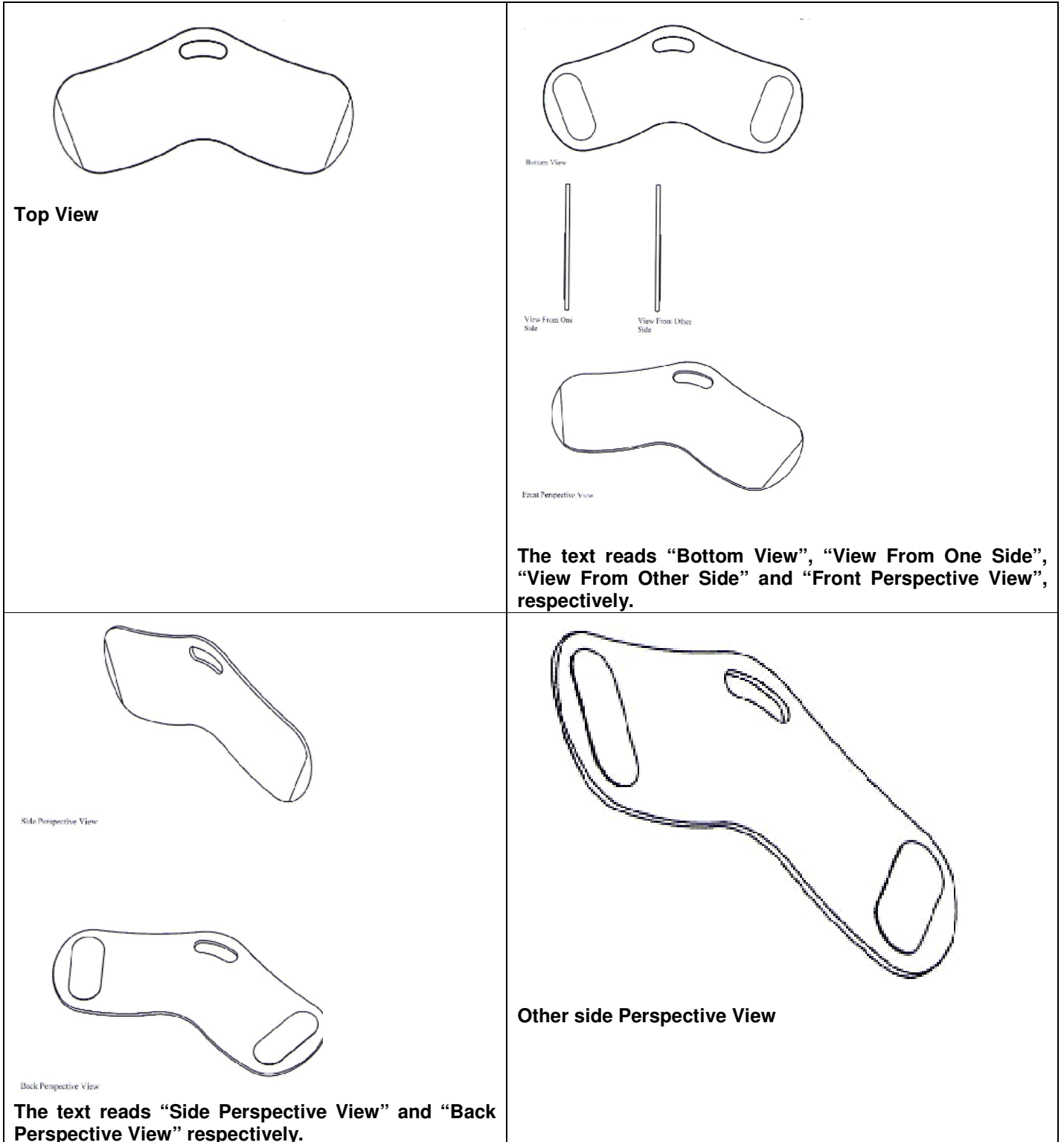
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14. Maric’s submission is that the flatness of the board and the bend in it (the banana shape) are functional. Whilst Mr Sabine has not specifically denied this point, he has not admitted it either. It is, therefore, important that I assess this argument carefully. It is an important argument because if the flatness of the board and the bend in it are completely arbitrary features of the designs in question then the more likely it is that the designs would have the same (or at least not clearly different) overall impression. Maric has filed no independent evidence to support the claim to functionality. This is not, though, fatal to its case because the tribunal can see the designs and appreciate their intended purpose with relative ease. Whilst this is an easier task with consumer articles, it is still possible with the articles in question here. The job is made easier, though, by some of the evidence from Mr Sabine. He provided a document containing a series of illustrations showing a transfer board in use. It shows a person sliding from one thing (such as a wheelchair) to another (such as a car) by using the transfer board. It is clear to me that being flat and, also, being its relative width and length, are features which assist in this process. If it was not flat then the person would have difficulty in getting onto the board. If the board was longer then it may be too weak in the middle and would be unnecessarily long to slide across. If it was shorter then the ability to slide from one thing to another may not be possible. The width of the article is such to facilitate the person sitting on the board and, therefore, supporting the bottom and lower legs of the person using it.

Similarly, the images also illustrate that the bend in the board is a feature which assists in the transfer process, making it easier, in certain circumstances, for the transfer board to be used. The informed user will be aware of these functional aspects of the designs when considering their overall impressions. Whilst they still form part of the overall impressions, their functional aspect will be borne in mind with the result that the informed user will pay more attention to those aspects of the design where there is a greater degree of design freedom.

15. In addition to the point of (functional) similarity identified by Maric, there is a further point of similarity between the designs. Both designs, on their respective bottom views, have a geometric shape (I can only describe it as a rectangle with curved ends) at either end of the board. One of the pieces of evidence relating to Mr Sabine's design as marketed (which also has these shapes) describes them as non-slip pads. I have no reason to assume that they are not also pads on the Maric design. I note that the shapes of these pads and their position are virtually identical. These shapes will form part of the overall impressions of the respective designs. Whilst the design of a non-slip pad provides an additional functional feature, there is nothing that necessarily dictates their exact shape and position and there may, therefore, be some design freedom here. That being said, the shapes fit the general profile of the respective boards and strike me as an obvious shape and position that would be used if non-slip pads were to form part of the design of such an article.

16. Having looked at the similarities between the boards, I must now consider the differences, and, crucially, whether such differences form part of the overall impression of the respective designs. The differences highlighted by Maric relate to the curvilinear (as opposed to straight-line) appearance of the Maric design, the cut-through handle (which is not present in the Sabine design) and the tapered ends. I believe that the curvilinear features of the Maric design will be noticed by the informed user. I agree with Maric that it creates an aesthetically pleasing appearance. Mr Sabine's design will be seen as a more basic, functional looking design with more straight-lines. I also agree with Maric that the tapered ends of its design will also be noticed and adds to its design characteristics as opposed to being seen as a functional characteristic. The handle, whilst it will be noticed by the informed user as part of the overall impression, will strike him or her as functional. Whilst the shape of the cut-through handle mirrors the curvilinear feel of the board, it is still, essentially, functional. Furthermore, whilst I accept Maric's argument that other types of handle could be used and/or used in different positions, the position of the cut-through handle will strike the informed user as the most obvious place for such a functional addition. Furthermore, the fact that it consists of a cut-through will strike the informed user as the most suitable form of handle so as to not interfere with the purpose of the board.

17. The overall impression on the informed user must be assessed at an appropriate level of generality. I would summarise the position as to overall impression thus:

Mr Sabine's registered design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general straight-lined aspect of the board will be noticed as its design characteristic producing a basic, no-frills design.

The Maric design

As part of the overall impression, the informed user will notice the flat bended shape of the board, together with its relative width and length, but that this is, effectively, a shape with a function in mind. The non-slip pads will be noticed, but that these will also appear as being, essentially, functional in nature. Even though the informed user will appreciate that different shaped pads could have been used, the shapes/position used will strike him/her as the most obvious. The general curvilinear aspect of the board will be noticed as part of its design characteristics producing an aesthetically pleasing impression. Further, that the design characteristics are enhanced by the tapered ends of the board. The cut-through handle will be noticed, but, this will be regarded as an essentially functional addition.

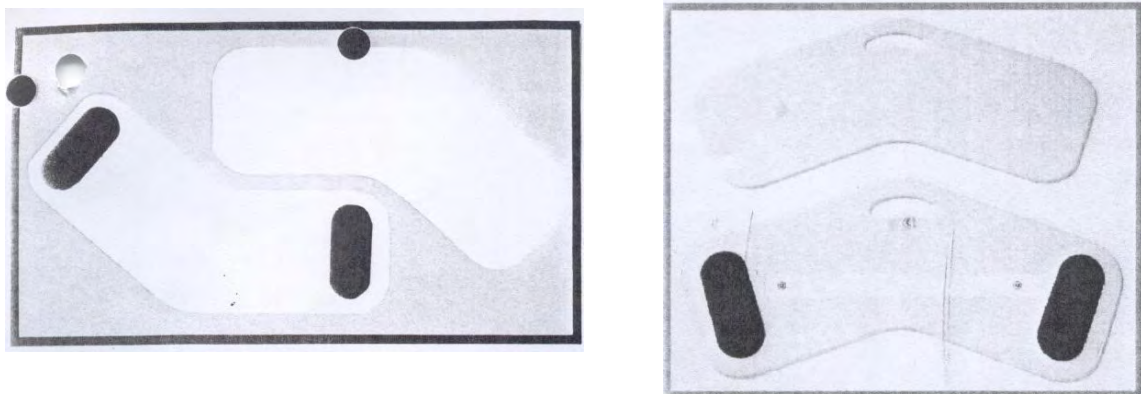
18. The designs are not identical nor do I consider the differences between them to be immaterial. The Maric design is, therefore, a new design in accordance with section 1B(1) and (2) of the Act. The Maric design must, though, have individual character when considering its overall impression (compared to that of Mr Sabine's registered design). To that extent, I have not described the overall impressions of the respective designs in the same way. The overall impression is not the same. But are the differences clear enough? Whilst the overall impression of the general shape and configuration is similar, this, as assessed earlier, relates to functional aspects of the article. If a designer is to produce a transfer board which is flat and which contains a bend in order to reproduce this function, the freedom for design is limited. Nevertheless, the Maric design contains design characteristics in terms of the curvilinear shape and its tapered ends which enhances its overall impression and creates clear differences from the plainer, basic looking design embodied in Mr Sabine's registered design. I place less weight on the addition of the cut-through handle. As identified in *Procter &*

Gamble Co. v Reckitt Benckizer (UK) Ltd, smaller differences may be sufficient when design freedom is limited. This, I believe, is a case in point. The informed user may appreciate that the general shape is similar, but that such a shape is present for the desired function and purpose of the board. The informed user will, therefore, focus more on the smaller details and differences where the designer has more freedom – to that extent, I consider that the differences the informed user will appreciate (as I have set out already) are sufficient. The ground of invalidation fails when considering Mr Sabine’s registered design as prior art.

19. Mr Sabine also claims that his registered design is being infringed and that Maric is guilty of passing-off. I stress that these are not matters for this tribunal. The only matter I can determine is whether the Maric design meets the requirement for novelty in comparison to any prior art that Mr Sabine identifies. I should also stress that Mr Sabine’s reference to the use of the same coloured article does not assist given that colour does not appear to be an aspect of either design. The comparison has been made on the basis of the shape and configuration of the respective designs. I also add that the fact that Mr Sabine previously worked for Maric and that they previously licensed his earlier design has no real relevance. It matters not how they came up with the design, what matters is the overall impression that the informed user takes from the respective designs.

Comparison with Mr Sabine’s marketplace use

20. In addition to his own registered design, Mr Sabine also relies on the use of his design in the marketplace since 1988. With his original statement of case he provided three pieces of evidence showing documents that had been issued to the public. One of these contains a series of illustrations (as described earlier) showing the transfer board in use, but it is not possible from these illustrations to see in any detail the design itself. The other two documents are clearer and contain the following images:



21. The image depicted above left does not appear to be any different to Mr Sabine’s registered design. This cannot, therefore, take him any further forward.

The image above right contains one difference from Mr Sabine's registered design in that it has a cut-through handle, as does the Maric design. There are, though, two reasons why this design does not assist.

- 1) The design is said to have been used in the marketplace since 1998. However, the design in the above right image² is said to be a new design based on one that has been in use since 1998. The document itself is not dated nor does Mr Sabine provide the date on which it was made available to the public. Whilst it may have been made available to the public prior to the relevant date, there is no evidence of this. This means that the design cannot be regarded as prior art and the claim must, therefore, fail on this point.
- 2) Even if I am wrong on the above, I do not regard the addition of the cut-through handle on the design to be a sufficient enough addition to its overall impression so as to significantly affect the analysis I made in relation to Mr Sabine's registered design. The handle may be cut-through and similarly positioned but this, as I assessed earlier, is more functional than design orientated and this will be appreciated by the informed user. The differences highlighted with reference to Mr Sabine's registered design compared to the Maric design, including the curvilinear appearance, are still present and still produce a clearly different overall impression on an informed user.

The Banana Board 100

22. In his further evidence (which is filed under cover of a further document headed "Statement of Case"), which I will consider despite it being filed one week late, Mr Sabine makes reference to another transfer board, namely the Banana Board 100. Mr Sabine refers to this board in response to Maric's counterstatement and their reliance on the Maric design's handle and chamfered edges as contributing to the creation of a different overall impression from Mr Sabine's design. This implies that the Banana Board 100 has a cut-through handle and chamfered edges. However, reference to this design goes beyond the pleaded case, furthermore, there is no documentation to support that the Banana Board 100 was made available to the public before the material date, and, there is nothing showing the design itself³. In any event, I do not see how Mr Sabine would be in any better position because even if the Banana Board 100 has chamfered edges, these are said to be on the bottom of the board whereas the tapered edges of the Maric design are on the top of the board. Furthermore,

² The document describes it as the Banana Board 190, which is also available as the Banana Board 120; the numbers used relate to the weight limit of the boards (in KGs).

³ Whilst Mr Sabine stated that he has a board still in cellophane from the original manufacture (June 2003) available for inspection, nothing has been provided for the tribunal to make its comparison. The onus is on Mr Sabine to provide whatever evidence he relies upon.

whilst it may also have a cut-through handle this is essentially a functional aspect. Finally, and crucially, there is no suggestion that the Banana board 100 has the key curvilinear appearance as per the Maric design which would bring the designs substantially closer to each other. Therefore, the Banana board 100 design would not, based on how Mr Sabine describes it, bring it significantly closer in terms of overall impression so as to reach any different conclusion.

Outcome

23. Mr Sabine's request to invalidate the Maric design fails.

Costs

24. Maric, having been successful, is entitled to a contribution towards its costs⁴. I hereby order Mr Martin John Sabine to pay Maric Systems Ltd the sum of £600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£400
Considering and commenting on the other side's evidence	£200

25. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of May 2010

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

⁴ Costs are based on the scale set out in TPN 4/2007