

O-153-11

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

**IN THE MATTER OF REGISTERED DESIGN NO 4003571**

**IN THE NAME OF PENELOPE J SMITH**

**AND**

**A REQUEST TO INVALIDATE (NO. 36/09)**

**BY MS NICKY CARTER & MR ROGER CARTER**

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

**In the matter of registered design 4003571 in the name of Penelope J Smith**

**and**

**A request to invalidate (no 36/09) by Ms Nicky Carter & Mr Roger Carter**

### **The background and the pleadings**

1) Ms Smith filed registered design no 4003571 on 7 July 2007. The design is said (on the form of application) to be:

“A duvet cover that opens up completely and zips up to close.”

I will set out the design itself later when I come to make the necessary comparisons with the prior art.

2) Ms Nicky Carter & Mr Roger Carter (I will refer to them as “the Carters”) request the invalidation of the above registered design. The grounds of invalidation 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 Act’s requirements of novelty and individual character. The claim is made on the basis of earlier design registration 3021338 which is jointly owned by the Carters. The Carters’ claim is that their earlier design and Ms Smith’s design are both duvet cover closures which differ only in the length of the zip-closure mechanism, but are identical in appearance. They claim that Ms Smith’s design should be invalidated as it “clearly matches the appearance and ornamentation of our earlier design”.

3) Ms Smith filed a counterstatement denying the grounds of invalidation. She mentions that the duvet cover the subject of her design opens up completely on three sides so enabling the duvet to be easily put into the duvet cover. She says that the Carters’ design does not open completely and, therefore, differs in its functional design.

4) Both parties filed evidence. Neither side requested a hearing or filed written submissions in lieu of attendance. I will take into account, though, any submissions/arguments that have been made in the papers before me.

## The evidence & submissions

5) The Carters filed an “additional statement of case” on 16 August 2010 from which I note the following comments:

- That duvet covers may have, from time to time, incorporated a zip mechanism to assist closure, but the unique feature of their design is that the zip closure mechanism is on three sides of the duvet cover. They add that their design is not about the length of the zip, or the degree of access the mechanism provides, but that it is specifically and clearly designated as a three sided zip closure.
- That Ms Smith’s design copies the three sided zip closure and that the overall appearance is strikingly similar with no discernable difference to the casual observer with the visual emphasis being placed on the continuous zip running along three sides.

6) Ms Smith filed an additional statement of case from which I note the following comments:

- That many duvet covers in the public domain would, to the casual observer, look identical and that all duvet covers on a bed will look similar.
- That there are many ways in which a duvet cover may open and many ways of fastening (buttons, press studs, ties, Velcro® and zips).
- Ms Smith refers to a number of duvet cover designs which are “similar but different”, namely:

i) Patent GB2330302 published 21 April 1999 in respect of:

(54) Abstract Title  
**Duvet cover**

(57) A duvet cover (1) comprises a double-sided fabric shell (4,6) bounded by at least four edges and releasable edge fastening means (18) wherein the edge fastening means (18) extends along one full edge, continuing at least partially along two adjacent edges to so that a side of the shell may be opened as a flap (16) when the edge fastening means (18) is released.

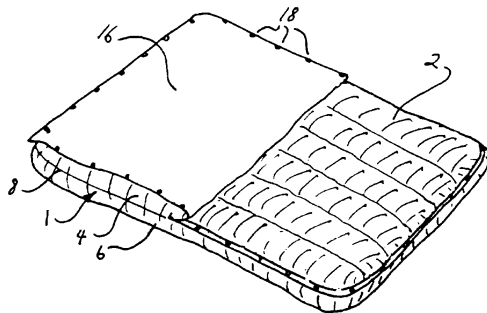


Fig. 2

Ms Smith highlights from the accompanying description that the above duvet cover has: “The releasable edge fastening means may be any convenient means, such as studs, clips, buttons, a zipper or hook and loop fasteners such as those sold under the registered trade mark Velcro.”

- ii) “La redoute system t zipped duvet cover” and “gande duvet covers”. Ms Smith did not, though, provide any representations (despite the Intellectual Property Office informing her that such representations were required if they were to be relied upon) of these duvets nor any information as to when they were in the public domain.
- Ms Smith refers to the fastening of her design as being unique, containing a special webbing that prevents the zip from catching the duvet. She believes that this shows a substantial visual difference in appearance. She believes that in this crowded market both large and small features can distinguish one duvet cover from another.

7) The Carters then filed a final statement of case from which I note the following comments:

- That the patent referred to by Ms Smith describes functionality and that their design is not identical in appearance to any of the figures contained in the patent.
- That Ms Smith’s design is a copy of the Carters’ design. A further reference is made to the copying of the shape and configuration of their design.
- That the claimed “unique fastening” is merely a functional aspect.

### **Section 11ZA/1B - the legal background**

8) 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.”

9) 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 7 July 2007. Any prior art must have been made available to the public prior to this date.

10) 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.

11) In terms of the legal principles, further guidance can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”)<sup>1</sup>. Some of the key points from this are that:

- g) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.
- h) In terms of design freedom, this 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). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.
- i) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.
- j) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

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<sup>1</sup> In reaching his judgment, Mr Justice Arnold referred extensively to a number of other decided cases including the judgment of the European Court of Justice in *Grupo Promer Mon Graphic SA v OHIM* (T-9/07).

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised *similarities* means that the machines give the *same* overall impression. ...”

### **The informed user**

12) Matters must be judged from the perspective of an informed user. In assessing the attributes of such a person 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).”

13) 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. In *Dyson*, Mr Justice Arnold stated:

“19 In *Grupo Promer Mon Graphic SA v OHIM* (T-9/07), judgment of March 18, 2010, the General Court of the European Union held at [62]:

“It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed.”

20 In *Shenzhen Taiden v OHIM* (T-153/08), judgment of June 22, 2010, not yet reported, the General Court held:

“46 With regard to the interpretation of the concept of informed user, the status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended.

47 The qualifier ‘informed’ suggests in addition that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

48 However, contrary to what the applicant claims, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of

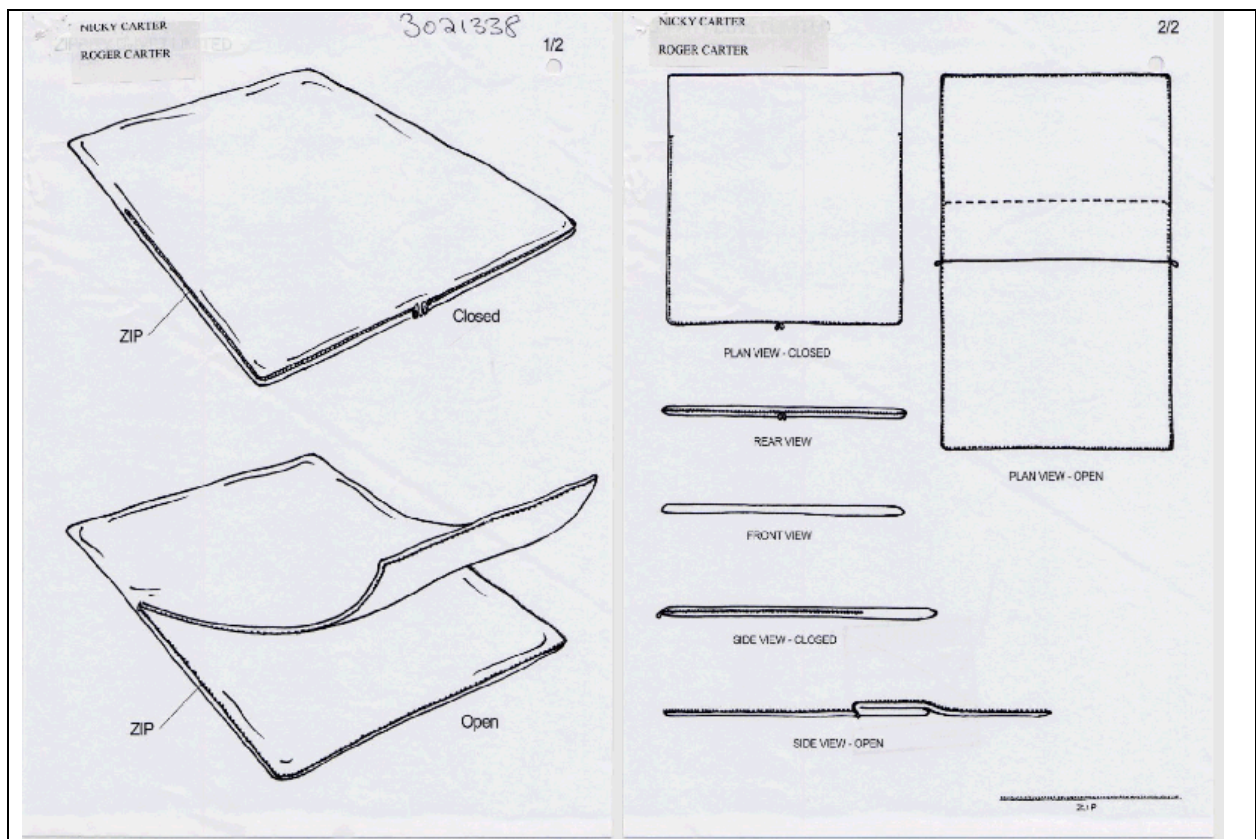
the appearance of the product which are dictated by the product's technical function from those which are arbitrary.”

14) Both parties have referred in their submissions to the “casual observer”. In view of the above case-law this is clearly wrong. The informed user cannot be a casual observer but must instead be deemed to be a knowledgeable user of duvet covers and will possess those characteristics set out in the preceding case-law.

### The prior art

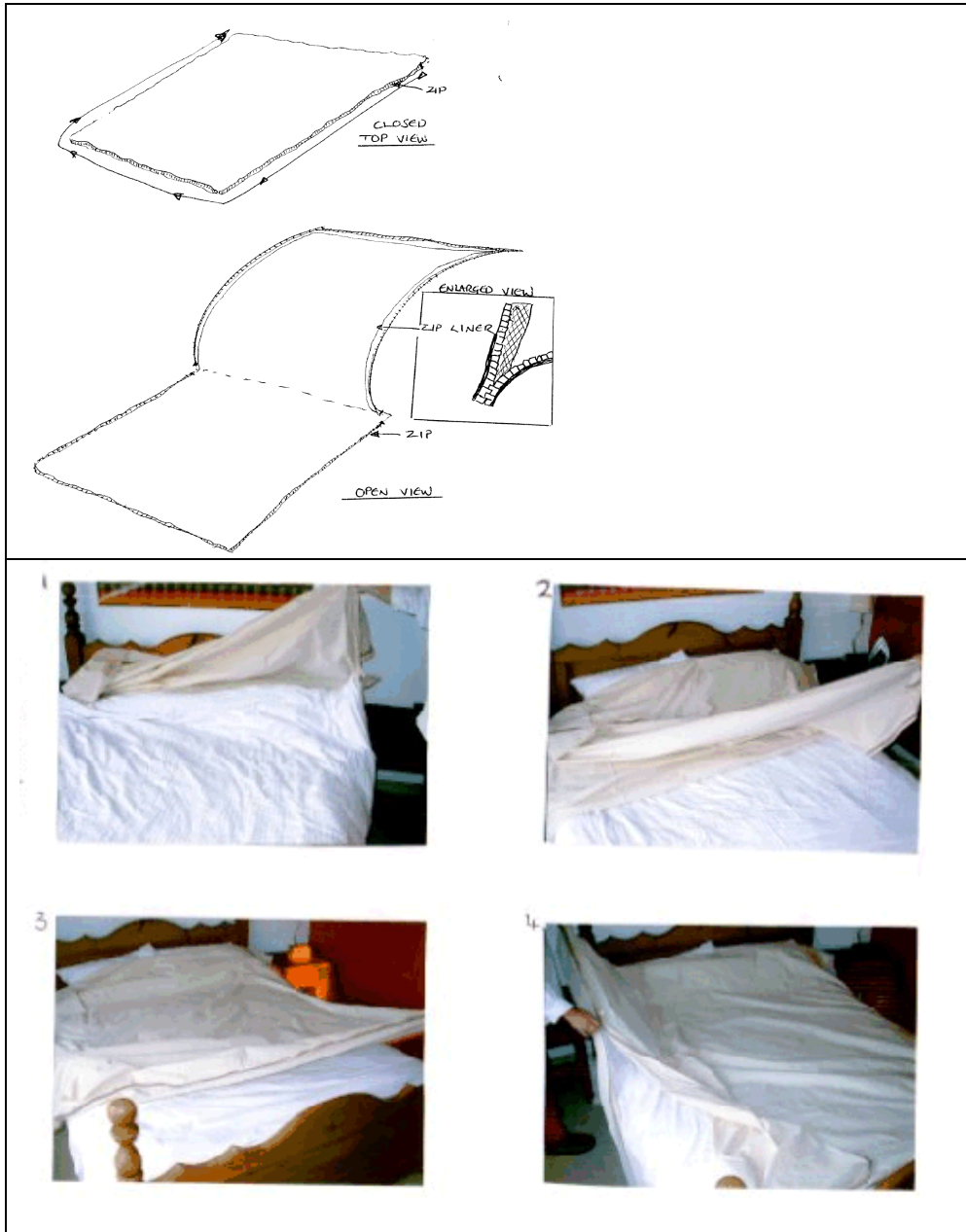
15) The Carters rely on their own registered design as the relevant prior art in these proceedings. For it to be relevant it must have been made available to the public before 7 July 2007. The Carters' design was filed on 21 May 2005. The details held on the Intellectual Property Office's designs database show that a certificate of registration was issued on 6 July 2005. The design would have been made available to the public in the relevant design journal at this time. This is well before the relevant date and it therefore counts as prior art for the purpose of these proceedings.

16) The Carters' registered design (which I will refer to as “the prior art”) is of the following duvet cover:



**Comparison of the prior art and Ms Smith's registered design**

17) Ms Smith's registered design is for the following duvet cover:





18) The first point to note is that the registered design has no pattern or ornamentation. It is for the depicted shape and configuration only. The prior art also only depicts shape and configuration. The significance of this is that whilst a designer may have large degree of design freedom viz a viz the pattern/ornamentation of a duvet cover, this is not relevant to these proceedings given that pattern/ornamentation plays no part in the registered design. It is, therefore, the degree of design freedom viz a viz the shape and configuration of duvet covers that is of importance. To that extent, it is inevitable that designs for duvet covers will look broadly similar. They have to be shaped in a way for the duvet (which is almost universally rectangular) to fit inside and there must be an opening for the duvet to fit through and for that opening to be fastened in some way. In terms of fastening, this can be achieved through a variety of functional methods such as poppers, buttons, zips etc. In view of this, the degree of (shape/configuration) design freedom in the field of duvet covers is not high.

19) I must also bear in mind the design corpus and whether the Carters' design stands out from the crowd in terms of its design attributes. If it stands out from the crowd then the less likely it is that small differences between the designs in question will create a different overall impression. I have touched on some of this in the preceding paragraph in terms of the common characteristics that duvet covers will, generally speaking, possess. I consider it a notorious fact that, in terms of shape and configuration, the design corpus will predominantly be made up of rectangular duvet covers with an opening into which the duvet is inserted. The opening may be fastened through a variety of means. The informed user will certainly be aware of this predomination. The informed user is deemed to be aware of the existing design corpus. Whilst it may not be common for duvet

covers to open on three sides (Ms Smith's evidence shows only one) this aspect is a functional characteristic. I can see nothing in the Carters' design to suggest that it was designed with both aesthetics and function in mind. If the aspect of the Carters' design which is claimed to stand out from the crowd is purely functional then the informed user will appreciate this and will make an allowance when assessing the similarities between the designs.

20) The net effect of my assessment of design freedom and the design corpus is that it is more likely that small differences between the designs may be tolerated in terms of whether a different overall impression is created.

21) A detailed analysis of the respective designs show three key differences between them: i) that Ms Smith's design has webbing that sits behind the zip so as to prevent catching, the prior art does not disclose this aspect, ii) that the zip in Ms Smith's design forms one continuous zip that operates along all three of the sides of the duvet cover that open whereas the prior art appears to have two zips which, when zipped up, come together to meet in middle at the bottom side of the duvet cover, and iii) that the three sides of Ms Smith's duvet cover open completely whereas in the prior art the bottom side opens completely but the longitudinal sides of the cover only open approximately  $\frac{3}{4}$  of the way.

22) The overall impression must be assessed from the perspective of the informed user. In terms of the webbing, this only has capacity for any significance at all when the duvet cover is being opened. When the duvet cover is in its packaging or when it is in use on a bed then this feature will not be apparent. Nevertheless, this aspect should not be ignored for this reason alone because the opening and closing of a duvet cover would fall within the category of "normal use"<sup>2</sup> by the end user – it is not simply seen when being maintained or repaired. However, the webbing, as the Carters submit, is merely functional. There is nothing to suggest that the webbing aspect has been designed for aesthetic reasons as well as function. Being purely functional, I do not consider that the informed user will pay any real regard to this in terms of the overall impression of the design.

23) In terms of the zips, neither party have made any real play on the differences between them. They are, to my mind, purely functional. The fact that the zipping functions of the duvet covers have been realized in slightly different ways, neither way introducing any obvious aesthetic qualities, is not, therefore, a difference that the informed user will appreciate when considering the overall impression.

24) That leaves the difference created by the degree to which the respective duvet covers open. The Carters say that their design is not about the degree to which the cover opens but more about the three sided nature of it per se. Overall impression is not, though, about intent. The Carters design must be appreciated for what it looks like and not for any underlying concept. It is the look of a design

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<sup>2</sup> As per section 1B(8) of the Act.

that is of paramount importance. Ms Smith highlights the difference in opening, which she referred to in her initial statement of case as a difference in functional design. It is interesting that Ms Smith used the words “functional design”. It is clear that both designs have function in mind with the three sided opening aspect assisting with the ease in which the duvet can be put into the duvet cover. I have already stated that this means that small differences in the way that this functional characteristic has been incorporated into the designs may be sufficient to produce a different overall impression.

25) The difference between the designs only comes into play when the duvet covers are open. The result of Ms Smith’s design is that when it is open the duvet cover will be completely flat like one very large rectangular sheet. The Carters’ design, whilst still rectangular, retains a degree of fold-over as opposed to opening completely flat and will retain a mouth-like opening into which the end of the duvet may be inserted. Bearing in mind my finding in paragraph 20, this difference is sufficient to produce a different overall impression on the informed user. As stated earlier, design is not about underlying concepts or functional inventions. It is about the visual appearance of the finished article. The informed user will appreciate that the degree of design freedom is small and that the later design has incorporated a similar functional aspect to the earlier design but in a different way to the way in which the Carters have incorporated that functional aspect into their design. In this case, this is enough for the designs to create different overall impressions. The Carters’ application for invalidation fails.

### **Costs**

26) Ms Smith having been successful, she is entitled to a contribution towards her costs. With regard to costs, although the registrar has a wide discretion in relation to such matters, he nevertheless works from a published scale (as per Tribunal Practice Notice 4/2007). I have borne the scale in mind when determining what award of costs to make. I must, though, also take into account that Ms Smith was not legally represented in these proceedings and her costs would not, therefore, have included any professional legal fees. I therefore reduce by 50% what I would otherwise have awarded. I hereby order Ms Nicky Carter and Mr Roger Carter (being jointly and severally liable) to pay Ms Penelope J Smith the sum of £250. This sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£100
Filing evidence and considering the Carters’ evidence	£150

27) Whilst the sum for evidence would equate to being below the scale minimum, this reflects the very small amount of factual evidence filed by Ms Smith and, furthermore, there was little evidence from the Carters that needed to be considered.

28) 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 06 day of May 2011**

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