

O/063/12

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

**IN THE MATTER OF REGISTERED DESIGN NO. 4011912  
IN THE NAME OF MARION GIGLIO**

**AND**

**A REQUEST TO INVALIDATE (NO. 01/11)  
BY BEECHFIELD BRANDS LIMITED**

## **The background and the pleadings**

1) Ms Giglio filed registered design no. 411912 on 22 July 2009. The design is of a bag and I note that on the application form it is stated: “Bag with drawstring and without”. It appears from information on the official file that Ms Giglio settled on one design which incorporates a drawstring, namely:



2) I also note from the form of application the entry of a limitation/disclaimer relating to “colour, pattern, drawstring, options” and an entry on the representation itself which reads “colour, pattern used for illustration purpose only”. In view of this, it is the shape and configuration of the above that is protected.

3) Beechfield Brands Limited (“Beechfield”) requests 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. It is stated that drawstring bags of the type registered by Ms Giglio have been used for many decades (or longer). An example is provided from a 2008 brochure of Beechfield. It is stated that further examples may be provided in evidence.

4) A counterstatement was filed by Ms Giglio which included a reference to her design being used (by her business but not by the general public or for resale) before that of Beechfield. Both parties filed evidence and written submissions. Neither side requested a hearing. Rather than provide a piece by piece evidence summary, I will, instead, draw from all the evidence and submissions when I comment on the various issues that are before the tribunal.

## **Section 11ZA/1B - the legislative context**

5) 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.”

### **The relevance of dates**

6) As I noted from Ms Giglio’s counterstatement, she claims that her bag was designed before the use by Beechfield. Whilst this is noted, the question of novelty is not based on who has the earliest use. It is a question of prior (to the relevant date) public disclosure. In terms of such disclosure, the relevant date is the date of application of the registered design being attacked. This means that the relevant date for my assessment is 22 July 2009. Any prior art must have been made available to the public prior to this date. It does not matter, therefore, that Ms Giglio may have produced her design even earlier than any prior art relied upon. There are some exceptions in relation to certain disclosures (as contained in Section 1B(6)) which I will refer to later.

### **The approach to comparison**

7) 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.

8) 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*"). 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 :

"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**

9) 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* [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).”

10) 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.”

11) The case referred to by Mr Justice Arnold above was subsequently appealed to the Court of Justice of the European Union where, now published as Case C-281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA, Office for Harmonisation in the Internal Market* it was stated:

“It should be noted, first, that Regulation No 6/2002 does not define the concept of the ‘informed user’. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.”

12) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user of bags and will possess those characteristics set out in the preceding case-law.

### **Prior Art 1 – The use by Beechfield**

13) I will begin with an assessment of the use of a bag by Beechfield (or its resellers). This is the prior art depicted in its statement of case, which consists of a brochure with a handwritten date of 2008. Further evidence comes from Mr Roger McHugh, the managing director of Beechfield. He explains that he first became aware of Ms Giglio’s design when Ms Giglio used eBay’s VERO programme against one of Beechfield’s resellers, Ms J Hodge, who had been using eBay to sell a “W115” bag. He states that Ms Hodge has been selling such bags since as early as 2009 (the exact date in 2009 is not specified). He adds that such products were first marketed in 2008 and offered for sale from early that year. In support of this, various exhibits are provided including:


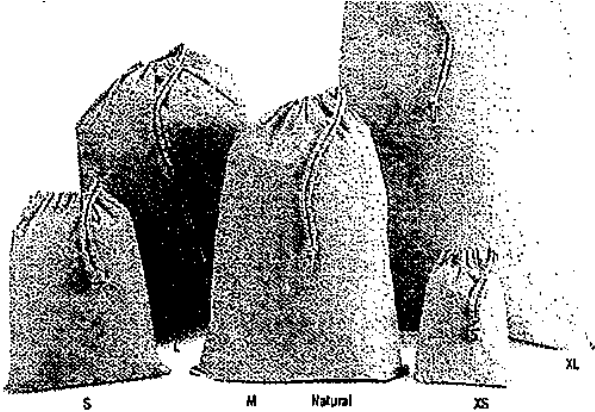
- i) Brochure pages (one is mainly in German) showing the W115 bag, the page also includes the words “making your mark in 08”;
- ii) Another brochure showing the W115 bag with a handwritten date of 2008;
- iii) A brochure for a company called Pencarrie (a reseller of Beechfield’s goods) dated 2008 which also depicts the W115 bag;
- iv) An invoice from Beechfield to Pencarrie from February 2008 which relates to various goods including the W115 bag.

14) Ms Giglio’s evidence and submissions relating to Beechfield’s bag have been fully considered. She highlights that some of the brochures have handwritten dates and that the goods are imported from the far-east and are an American product. She highlights, again, that Beechfield’s use was after her own personal use and that Ms

Hodge did not sell her first bag until April 2009. Whilst all of this noted, Ms Giglio's comments do little to call into question the capacity of Mr McHugh's evidence to be relied upon. I have already commented on the relevance of dates and that even if Ms Giglio produced her design earlier to that of Beechfield (which I have no reason to disbelieve) this does not mean that the prior (to the relevant date) public disclosures by Beechfield or its resellers should be dismissed. Nor does it matter that the goods are imported or that Beechfield may produce American products. What matters is what has been disclosed to the public. The evidence of Mr McHugh is compelling. Although it contains some handwritten dates, some of the brochures are clearly marked as coming from 2008.

15) I mentioned earlier that there were exceptions to certain public disclosures (section 1B(6)). I can, though, see nothing in the evidence of either party that would give rise to the exclusion of the disclosures. There is no reason, or even argument, why the disclosures "could not reasonably have become known in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned". I particularly note that Pencarrie appear to be a UK business and it is reasonable to assume that its brochure was issued in the UK. In any event, Ms Giglio admits in her evidence that Ms Hodge sold a bag in April 2009 which is also before the relevant date. The other exceptions relate to disclosures which have been made by (as applied to this case) Ms Giglio herself or that was they were disclosed, in some way, via Ms Giglio. Ms Giglio has stated that her use was not made available to anyone else. Therefore, it cannot be assumed that the disclosure of the Beechfield design has anything to do with her. The W115 bag counts as duly disclosed to the public before the relevant date.

16) I next compare the respective designs, which are set out below. The W115 has not reproduced well, but I have made the comparison from the papers filed which are clearer:

<b>Ms Giglio's design</b>	<b>The W115 bag<sup>1</sup></b>
	

17) Both designs are simple in nature. They are both rectangular in nature, with a drawstring closure. As the drawstrings close, the tops of both bags narrow

<sup>1</sup> All of the bags depicted appear to be of the same design; they differ only in size and the way in which the drawstring is laying.



somewhat. I struggle to put into words any real noticeable differences between the bags. It could be that Ms Giglio's design is slightly wider than the W115 bag (in comparison to their respective heights), but this is extremely marginal. If there are any other differences they must be of a very negligible nature, unlikely to impact on the overall impression on the informed user. Thus, there will be no difference in terms of overall impression. Whilst I bear in mind that smaller differences may be tolerated when there is a limited degree of design freedom, this has little bearing here as there is virtually no difference in overall impression. In any event, whilst a bag has certain functional aspects, a designer is free to choose a variety of shapes so the degree of design freedom is not that limited. All things considered, I have little hesitation in concluding that the designs do not differ in overall impression.

### **Other prior art**

18) Other prior art is provided in Beechfield's evidence. Ms Giglio, for various reasons, calls much of this into question. For sake of procedural economy, it is unnecessary to probe the matter further. Ms Giglio's design is already deemed invalid and I am clear in that view. The other grounds do not improve Beechfield's position.

### **Costs**

19) Beechfield, having been successful, is entitled to a contribution towards its 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 hereby order Ms Giglio to pay Beechfield Brands Limited the sum of £1350. This sum is calculated as follows:

Official fee  
£50

Preparing a statement and considering the other side's statement  
£300

Filing evidence and considering evidence  
£600

Various written submissions  
£400

20) 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 15<sup>th</sup> day of February 2012**

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