

O/288/12

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTERED DESIGN NOS 3015045 & 4018481

IN THE NAME OF REGISTERED DESIGNS LIMITED

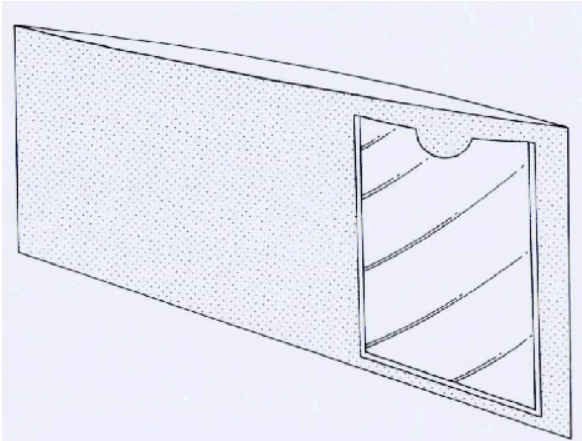
AND

REQUESTS TO INVALIDATE (NOS 03/11 & 4/11) BY DAVID SAVILLE

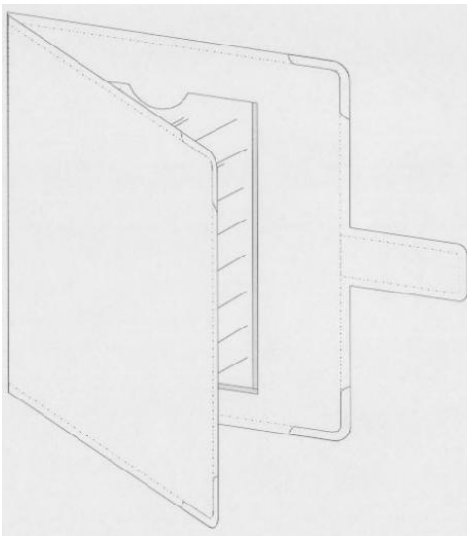
The background and the pleadings

1) The two registered designs the subject of these proceedings relate to wallets for driving licences. Registered design 3015045 was filed on 5 November 2003 by Mr Nahveed Safar, who assigned it to Mr Arshad Mahmood, who assigned it to Mr Adnaan Solomon, who assigned it to RDL (“RDL”). Registered design 4018481 was filed on 21 January 2011 by Mr Adnaan Solomon, who assigned it to RDL. Nothing turns on the dates of the various assignments. The two designs are set out below:

3015045:



4018481:



2) Mr David Saville requests the invalidation of the above registered designs. His 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 Act’s requirements of novelty and individual character. I will set out the exact claims when I discuss each of the registered designs in turn.

3) Counterstatements were filed by Mr Solomon on behalf of RDL. I will set out his response later. Beyond what was filed with the parties’ statements of case and counterstatements (which I will come on to), no further evidence was filed by either

party. Neither party requested a hearing or filed written submissions in lieu of attendance.

Section 11ZA/1B - the legislative context

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.”

The prior art

5) I will come back to the issues relating to the informed user and the overall impression test, but, to begin with, the tribunal must consider the claimed prior art and whether it is established that it has been made available to the public before the relevant date. The relevant date is the date on which the challenged designs were filed. Consequently, the following dates are relevant:

3015045: The claimed prior art must have been made available to the public before 5 November 2003

4018481: The claimed prior art must have been made available to the public before 21 January 2011

Registered design 3015045 – prior art

6) Mr Saville’s statement of case reads:

“The design is of a plastic wallet that is used for the storage of driving licences, both the paper and photographic card parts of the licence. This design was registered as of 5 November 2003, which was the date of application. However, the same product was produced and distributed by the Driver and Vehicle Licensing Agency (DVLA) from 1998 to coincide with the

introduction of the photo card licences. I submit as evidence of this a letter from the DVLA dated 3 February 2011 confirming this. Therefore, the design was in the public domain for around five years before application for registration”

7) Attached to Mr Saville’s statement of case are i) a letter from DVLA and ii) 4 scans/photos of licence wallets, some of which contain driving licences others which do not. There is no suggestion in the letter from DVLA that the scans/photos were provided by it (the DVLA). The letter, which is dated 3 February 2011, comes from Patricia Clark (DVLA Brand Protection Team) and reads:

“Thank you for your letter dated 21 November regarding plastic driving licence holders. I apologise for the delay in replying although I tried to contact you by telephone, but was unable make contact because my number is automatically withheld.

The plastic wallets were first used by DVLA in 1998 to coincide with the introduction of photo card licences. DVLA stopped issuing the wallets some time ago on the basis of costs savings.

The plastic wallet, produced for DVLA by an external supplier, was of a similar design to the one featured in the advertisement you enclosed with your correspondence. I would advise that the Patent Office would be in a better position to assist you with your enquiry regarding the production of a similar product.

Unfortunately, DVLA is not in a position to endorse or approve any company’s products or services.”

8) In his counterstatement, Mr Solomon makes a number of valid criticisms about Mr Saville’s evidence, the most relevant being that the letter from DVLA fails to set forth any particular design that was made available to the public, nor is the “advertisement” sent to DVLA by Mr Saville depicted from which Ms Clark makes her statement that the DVLA one was similar. In any event, even if the tribunal knew what she had seen, this, without a representation of the DVLA licence holder, would have told me little as it is the job of the tribunal to consider the similarities and differences between various designs and to then decide whether the registered design is new and/or has individual character. There is no real commentary in Mr Saville’s evidence beyond that set out above. There is no explanation about the scans/photos. If they are meant to be the DVLA licence holders then not only should this have been made explicit, but the evidence should have clearly tied the designs to the public disclosure by DVLA. Ms Clark’s letter, being solicited for the proceedings is, furthermore, hearsay evidence; this does not improve matters for Mr Saville. **My finding is that Mr Saville’s evidence fails to establish that the scans/photos were publically disclosed before the relevant date. Mr Saville provides no other prior art.**

9) I must, though, deal with one further point. In the counterstatement, Mr Solomon stated that the design was made public by him in 1996. This statement has the potential to count against him as disclosures by anyone (including the

designer/proprietor), subject to certain exclusions, can defeat the novelty in a registered design. This was highlighted by the tribunal to Mr Solomon who responded with a further counterstatement in which he explained that his earlier comments were merely meant to demonstrate that he had been trading for longer than Mr Saville and that previous, but not the same designs, were sold earlier.

10) The only response to this from Mr Saville was when, through his legal representatives at Wake Smith LLP, he indicated that no further evidence was to be filed and that he relied upon his evidence along with Mr Solomon's statement that the design had been made public since the mid 90s.

11) I have already said that Mr Saville's evidence fails to establish any relevant prior art. In terms of Mr Saville's reliance on Mr Solomon's statement, it is to be noted that Mr Saville has not asked for Mr Solomon's statement in his second counterstatement to be disbelieved. There is nothing impossible or implausible in what has been stated. Neither has Mr Saville provided any counter-evidence demonstrating that Mr Solomon had in fact disclosed the actual design the subject of the disputed registration. **Weighing all this up, Mr Solomon's initial statement does not count against him in view of his further explanation.**

12) Given my findings, and given that I have no relevant prior art to consider, the request for invalidation made against registered design 3015045 is dismissed.

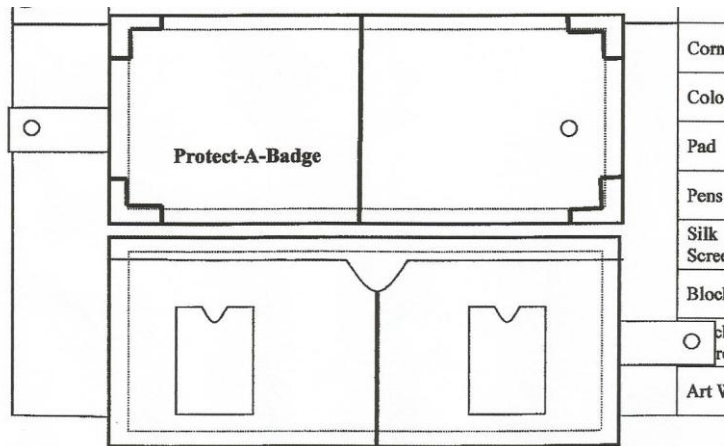
Registered design 4018481 – prior art

13) Mr Saville's statement of case reads:

"The design is of a wallet that is used for the storage of driving licences, both the paper and photographic card parts of the licence. This design was registered as of 21 January 2011, which was the date of application. However, my business, Protect-a-Badge, has been selling a similar product since around 1995 [this date is handwritten the rest is typed]. I enclose copies of marketing materials used by my business which show a similar product to the registered design and I enclose copies of correspondence between my business and Celsur Plastics Limited, who have been engaged by my business to manufacture similar products based on my design. The enclosed correspondence dates from 2008, and therefore, the registered design was in the public domain for well over 12 months before application for registration."

14) Attached to Mr Saville's statement of case are:

- i) An order form for 1000 wallets dated 28 September 2005. It is not clear who the order is between. A picture of a wallet is depicted on the form along with the words "Protect-A-Badge" as shown below:



- ii) Three items of delivery correspondence from Celsur Plastics Limited to Protect-a-badge in respect of driving licence holders/wallets. All three are from January/February 2008.
- iii) An undated laminated sheet advertising a "Licence & Smart Card Protector Wallet" which can be purchased from www.protectabadge.co.uk. The wallet is depicted below:



- iv) A promotional leaflet from Protect-A-Badge which includes various items including the wallet depicted above.

15) In the counterstatement, Mr Solomon makes the following points:

- i) He questions why 1995 was handwritten by Mr Saville. Mr Solomon believes that this was the year RDL disclosed the design to Mr Saville and, thus, the date was chosen for this purpose and demonstrates inappropriate conduct.
- ii) That no evidence of a business has been shown in 1995 and he requests evidence of business activities from 1995-2008.

- iii) That the marketing material could have been produced at any time and Mr Solomon requests an invoice relating to them.
- iv) That Driving Licence Wallet Limited was once operated by Mr Solomon (being formed in 2003) and prior to this he worked for Altex Services Limited; it is added that he can produce website screenshots of what was sold.
- v) That evidence of the sale and marketing of the product can be supplied from 1995, which he says was when the design was made available to the public. However, in his second counterstatement he goes on to say, as with the other registered design, that this is a reference to a different design.

16) On the face of it, Mr Saville's evidence is reasonably compelling. He has produced examples of marketing material showing the design he relies upon as prior art, albeit they are undated. He has produced evidence from 2005 of some form of order which shows a picture of the design. He has produced delivery correspondence from early 2008 with a third party. Mr Saville's statement also sets out a reasonably clear commentary tying the material to the design he says was disclosed. It is, though, necessary to bear Mr Solomon's points in mind. Point i) does not assist. There is no evidence to support that the handwritten date of 1995 represents inappropriate conduct. Mr Solomon adds that this was the year the design was disclosed by RDL to Mr Saville, but Mr Solomon clarified later that this was a different design so his point is somewhat lost. Neither do points iv) or v) assist. No evidence was provided by Mr Solomon or RDL, so there is nothing I can take from this. It is not even clear what relevance Driving Licence Wallet Limited has to these proceedings. Point iii) does not assist. That no evidence of business activity between 1995 and 2008 has been provided does not mean that a disclosure has not occurred; material from 2008 has been provided which is well before the relevant date. That leaves point iii), with Mr Solomon highlighting that the marketing material could have been produced at any time. Whilst this is noted and borne in mind, I must weigh all the available evidence. This includes the document from 2005, the correspondence from 2008 and, of course, Mr Saville's written evidence. Whilst matters would have been clearer had Mr Saville filed further corroborative evidence, his failure to do so, when all the evidence is considered, does not mean that his evidence should be disbelieved. **My finding is that the design claimed as prior art by Mr Saville was made available to the public from at least 2008. The claimed prior art counts as a relevant disclosure.**

The approach to comparison

17) 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.

18) 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.

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

19) 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

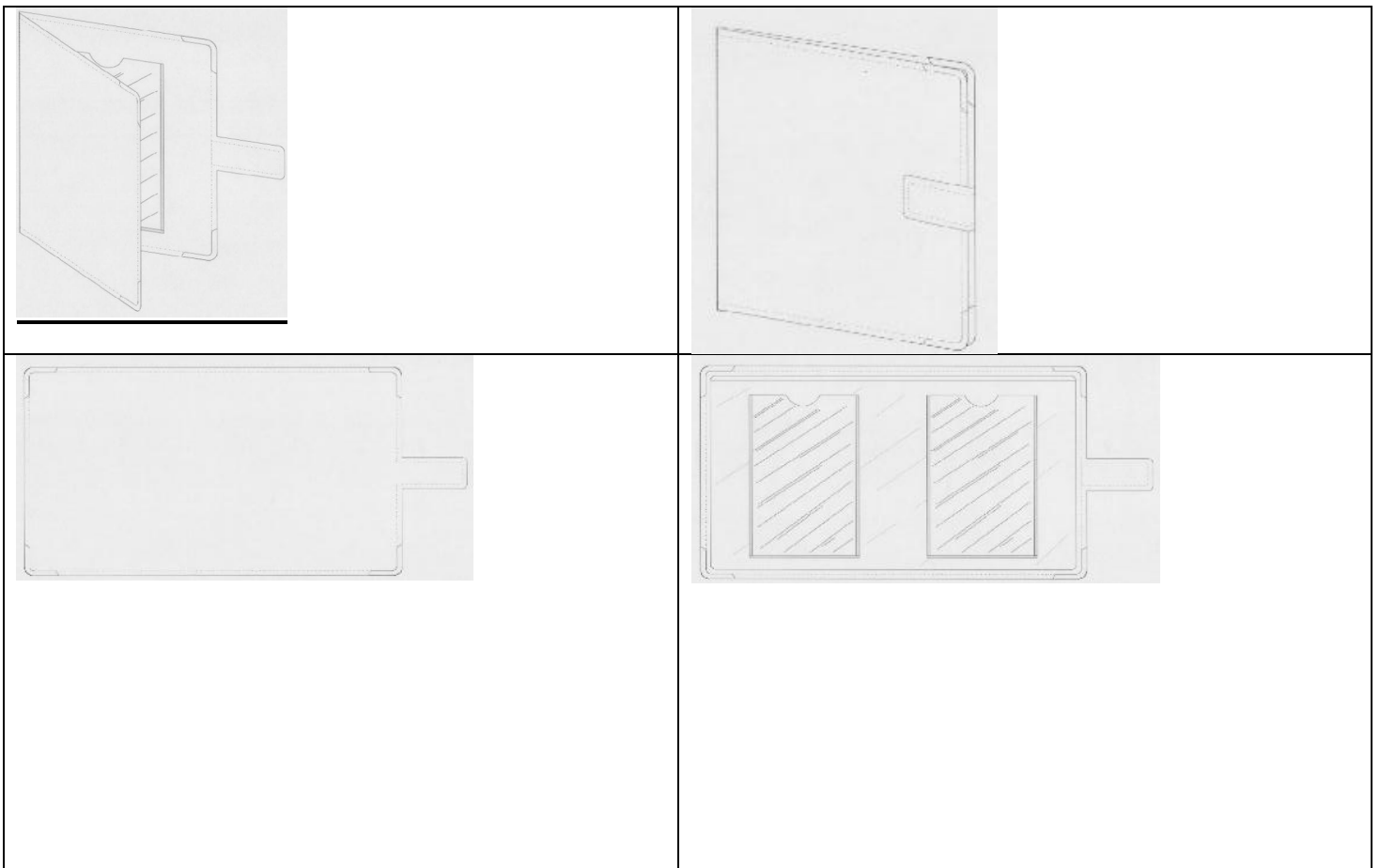
designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

20) 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:

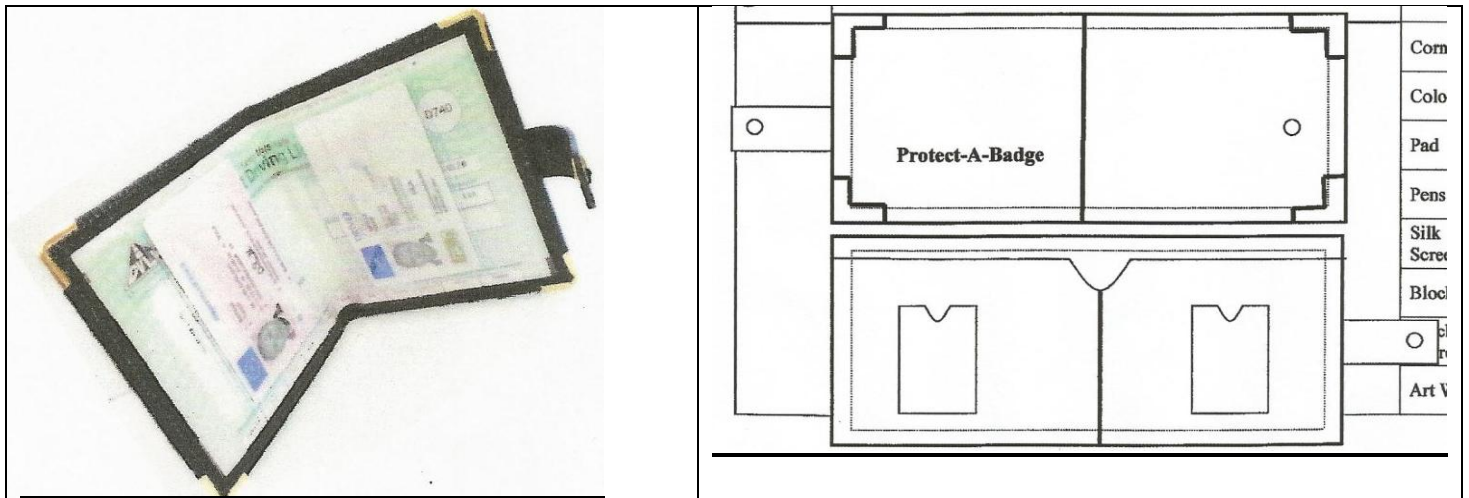
“19 In *Grupo Promer Mon Graphic SA v OHIM (T-9/07)*, judgment of March 18, 2010, the General Court of the European Union held at [62]: “It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which 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.”

The designs compared

21) The representations filed in respect of RDL’s design are set out below:



22) The prior art provided by Mr Saville is depicted below (the 2005 version shown on the right, the version shown in the marketing material is on the left):



23) The only difference that I can see between the two pieces of prior art provided by Mr Saville are that the two card holding elements are slightly smaller in the right hand version compared to the left hand version. However, the overall impressions of both focus on i) the rectangular overall shape that is foldable through its centre, ii) that the four corners of the wallet have additional corner elements, presumably performing a protective and decorative role, iii) that on the inside of the wallet each half has a space for the display of a card of some type, iv) that there is space behind these card spaces for another document (it is designed for the paper part of a driving licence) running almost the full width and height of the wallet, v) that the wallet is secured by an additional element which, when the wallet is closed, will secure its closing via a stud. The question, though, is whether the prior art destroys the novelty of the registered design.

24) The novelty of a registered design can be destroyed either if it is not new (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) or if it lacks individual character. In terms of the not new test, the clearest difference between the features of the prior art and the features of RDL's design is that RDL's design lacks the stud element which secures the wallet when closed. There may also be minor differences in the exact proportions of the two card displays. In my view, these differences are so small in the scheme of things that they ought to be regarded as immaterial. I come to the conclusion that RDL's design is not new in comparison to the prior art. Even if I am wrong on that then such minor differences result in the designs having the same overall impressions. **Either way, RDL's design lacks novelty. The ground for invalidation succeeds.**

Summary of outcomes

25) The claim against design 3015045 fails but the claim against 4018481 succeeds.

Costs

26) Both sides have won one and lost one. In the circumstances, I do not propose to favour either party with an award of costs.

Dated this 27th day of July 2012

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