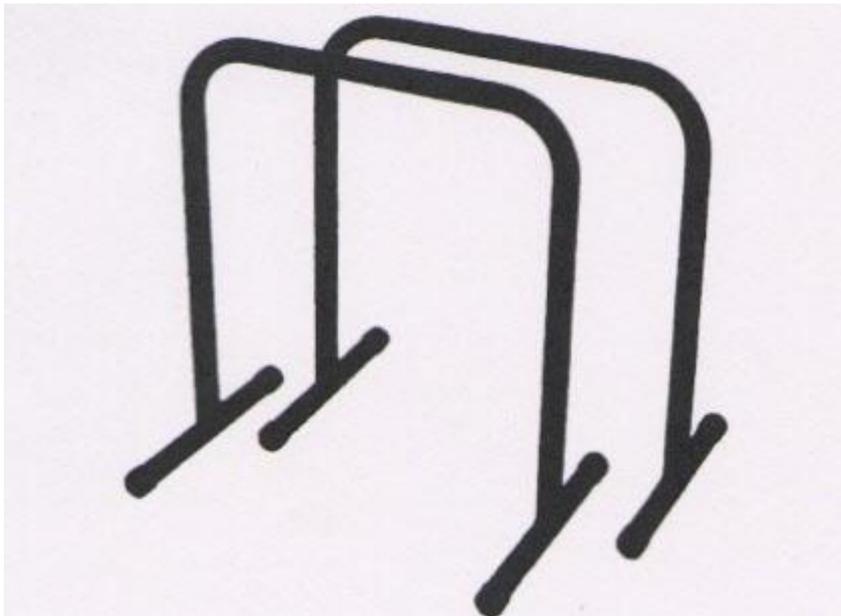


BLO/101/18

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 4036045  
IN THE NAME OF DAVID GENTLEMAN  
IN RESPECT OF THE FOLLOWING DESIGN:

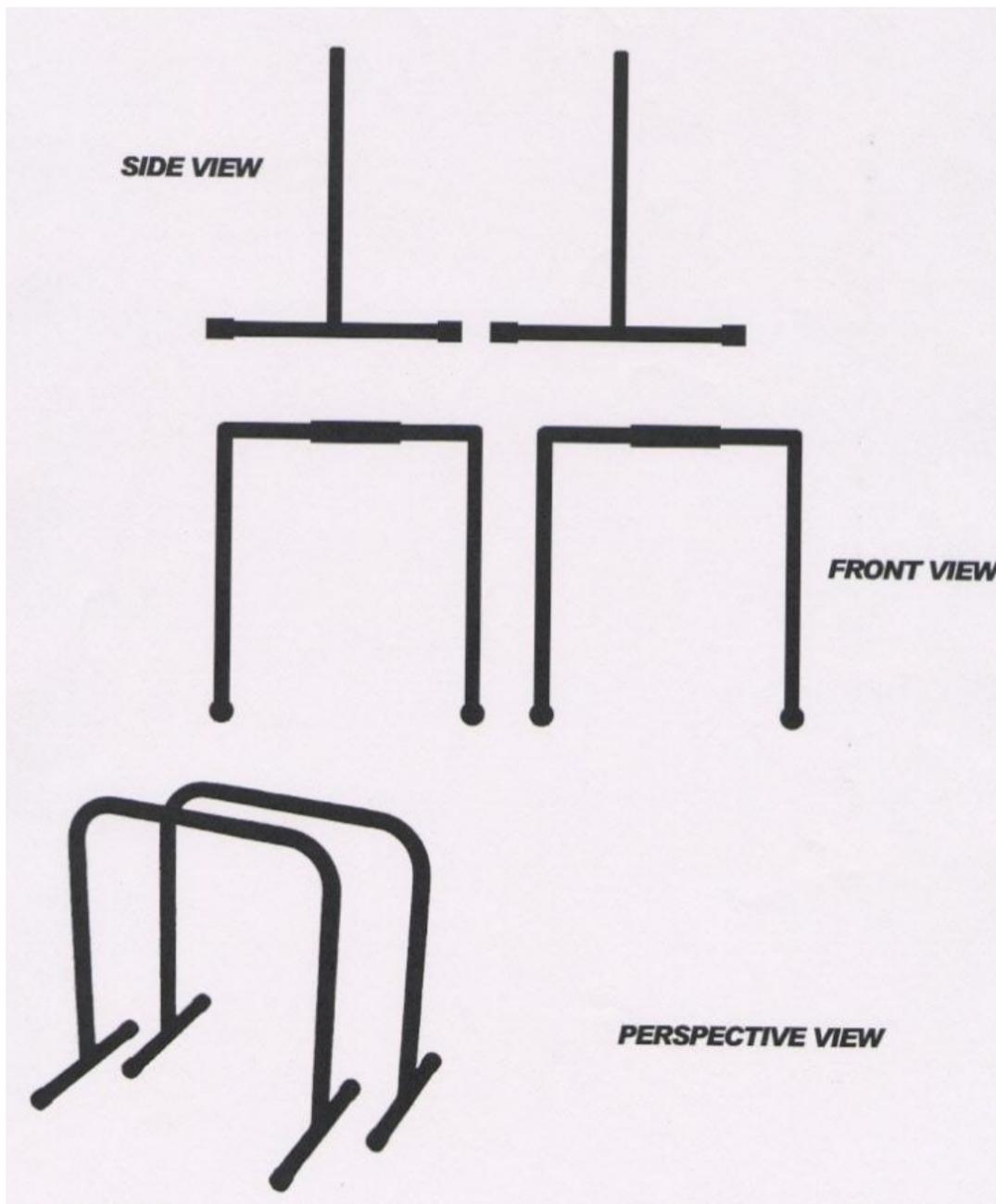


AND

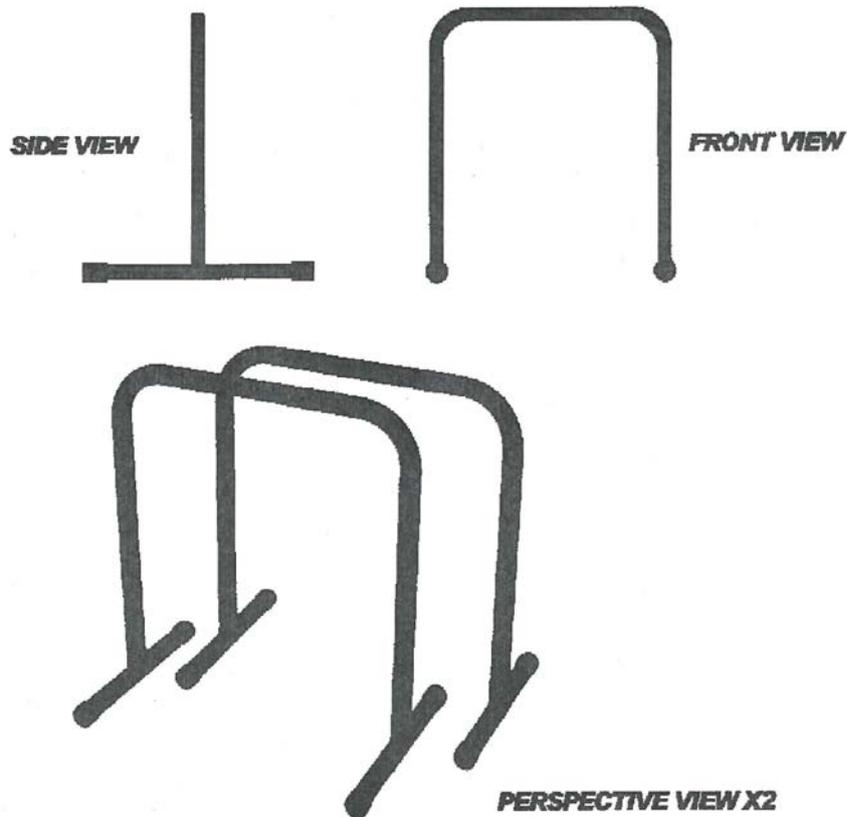
A REQUEST TO INVALIDATE (NO. 23/17)  
BY ASIF MOHAMMED

## THE BACKGROUND AND PLEADINGS

1. The registered design the subject of these proceedings was filed by David Gentleman (the proprietor) on 23 June 2014 and was subsequently registered. The design is described as a “Design of parallel exercise units” and is currently depicted on the UK register as below:



2. The design drawings currently on the register are not the same as those originally filed by Mr Gentleman in his design application, which are as follows:



3. On 2 July 2014 the examiner wrote to Mr Gentleman asking for replacement drawings because:

*“The illustrations are not in conformity. You have shown two products in the lower perspective view”.*

4. The replacement drawings filed by the proprietor are different to those originally filed. In particular, the front view of the original drawings shows the ends of the horizontal bar to curve to meet the uprights at either side. On the replacement drawings the front view shows the corners to be at right angles, which clearly does not match the perspective view on the same sheet of illustrations and is not the same design. The replacement drawings also show a thicker portion in the middle of the horizontal bar, in the front view, which does not feature on the original drawings.

5. Since the later drawings do not match those originally filed and as no new filing date was given for the second drawings, I will compare the prior art to the design application

as it was originally made, i.e. with the horizontal bar curved to meet the upright part of the design. Although, I will continue to bear in mind that the design is for a pair of parallel bars, as has always been depicted in the perspective view. Indeed, it is possible to make the relevant comparisons from the perspective view only, views which are consistent between that originally filed and that filed later.

6. The proprietor filed a further representation of the design which it describes as the design in use. It was attached to a letter received on 23 November 2017. The image attached to the letter was not filed as evidence and, in any case, I must make the necessary comparisons based on the registered design, subject to my caveat in the preceding paragraph.

7. On 27 April 2017 Asif Mohammed (the applicant) requested the invalidation of the design under section 1B<sup>1</sup> of the Registered Designs Act 1949 (the Act), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The design which, it is claimed, destroys the novelty of the registered design is *“a publicly available product known as the ‘Lebert Equalizer’.”*

8. The applicant provides some evidence with its statement of case<sup>2</sup> including an example of the product taken from [www.lebertfitness.com](http://www.lebertfitness.com), shown below:



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<sup>1</sup> This is relevant in invalidation proceedings due to the provisions of section 11ZA which gives the grounds for invalidation of a registered design.

<sup>2</sup> Such evidence is acceptable, see rule 21(1)(a), *The Registered Designs Rules 2006*

9. It is stated that the earlier design has been in the public domain since “*at least 2011*”.

10. The proprietor filed a counterstatement denying the claims. It maintains that the design referenced in the application is not the same as the registered design and submits:

*“The product given in the applicant’s evidence (not their own design) is not the same as my design”.*

11. A second page is attached to the counterstatement and has a later filing date of 7 July 2017. It submits:

*“Our design is a far smaller product, it is hand held for doing press ups.”*

12. These two statements represent the totality of submissions from the proprietor.

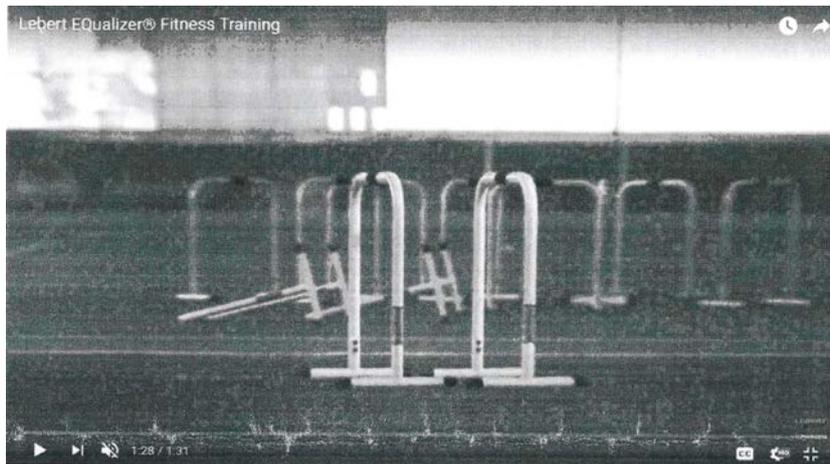
13. The applicant filed evidence, the proprietor did not. Neither side filed written submissions or requested a hearing.

### **The applicant’s submissions and evidence**

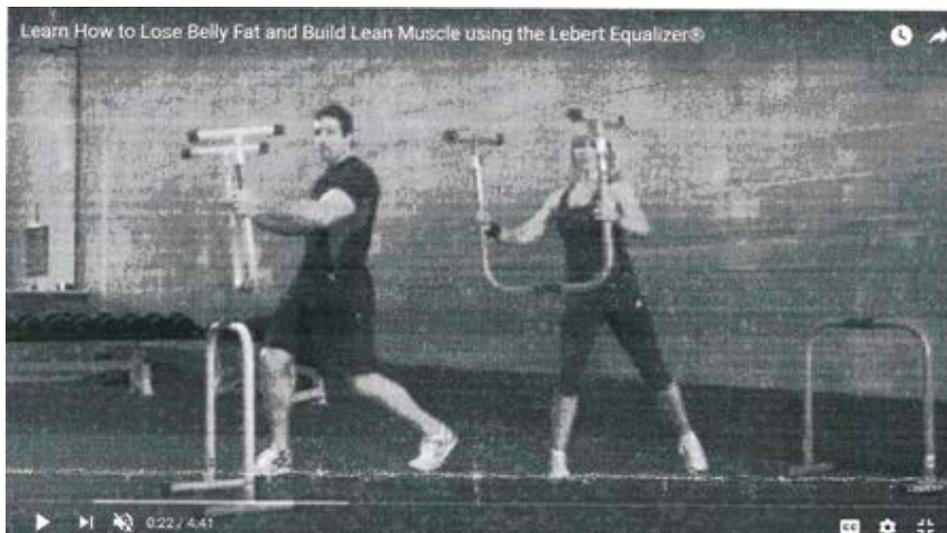
14. The applicant filed a witness statement on 11 September 2017. The statement is provided by Mr Richard Lock, the applicant’s attorney. The relevant points are as follows:

- A product known as the ‘Lebert Equalizer’ has been on sale to the public since at least 2011.
- The ‘Lebert Equalizer’ is shown in two videos (provided on a USB stick attached to the witness statement). They are titled:

Lebert EQualizer® Fitness Training – first published on YouTube 1 February 2011.



Learn how to lose belly fat and build lean muscle using Lebert Equalizer® - first published on YouTube 28 May 2012.



- The applicant concludes that the Lebert Equalizer shown in the videos appears identical to that shown in the design representations of the contested design 4036045. Therefore, the subject matter of design 4036045 as at the date of filing was clearly publicly known.

## The legal background

15. Section 1B of the Act 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)...

16. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>3</sup>. The most relevant parts are as follows:

#### **“The informed user**

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

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<sup>3</sup> [2012] EWHC 1882 (Pat)

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

### **Design freedom**

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom 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).”

## **Effect of differences between the registered design and the design corpus**

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

### **The correct approach, overall**

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of “different overall impression” is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

17. As can be seen from paragraph 58 of *Samsung v Apple* above, the Act requires a design to be both new and to have individual character. A design is new if it differs in material details from previous designs. However, even if it is new it may still fail to create a different overall impression compared to previous designs and therefore to lack the necessary individual character.

### **The design corpus**

18. No evidence was filed by either party that indicates what other designs contribute to the overall design corpus, other than the ‘Lebert Equalizer’ which is referred to by the applicant in its statement of case and evidence. The lack of evidence means that this factor is neutral between the parties.

### **Prior art**

19. 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, unless the exceptions in subsection (6) apply. This means that the relevant date for my assessment is 23 June 2014. Any prior art must have been made available to the public prior to this date.

20. In its witness statement the applicant states:

*“3. A product known as the ‘Lebert Equalizer’ has been on sale to the public since at least 2011.”*

21. This statement has not been challenged.

22. I must first assess whether the designs have, as is claimed by the applicant, been made available to the public before the relevant date. Only then can any form of comparison be made. It is for the applicant to show that the designs relied upon were disclosed before the relevant date.

23. The two videos provided by the applicant, and referred to above, were published on YouTube on 1 February 2011 and 28 May 2012. Both videos promote a fitness regime using the product described as the Lebert Equalizer and shown at paragraph 8 above. Whilst that particular image is not dated I note that it was taken from the website which is shown at the start of both *YouTube* videos. It is clear from the videos that the exercise product known as the Lebert Equalizer were available to purchase in 2011 when the fitness method was being promoted. The product shown in the image at paragraph 8 is the same as the products shown in the video (albeit in a different colour) and I am content that the product referred to by the applicant as the Lebert Equalizer has been available to the public since, at least, February 2011.

24. There is no suggestion that the exceptions in subsection 6 apply.

### **The informed user**

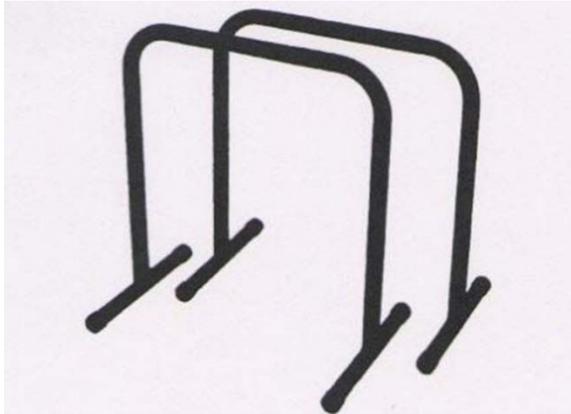
25. The informed user is not a casual user but must instead be deemed to be a knowledgeable/particularly observant user of exercise apparatus of the type shown in the design and will possess those characteristics (knowledge/experience) set out in the preceding case-law.

### **Design freedom**

26. The registered design is for parallel exercise units, which take the form of ‘bars’. It is possible for such exercise equipment to come in a number of shapes and sizes. The

top horizontal bar could overhang the legs or finish at right angles to the legs, rather than curving to meet the legs. The stabilising feet which prevent the bars from tipping in use could take the form of a triangular A frame, they could be curved, or finish higher up the leg section of the individual bars. That said, the bars will share particular characteristics. They must be freestanding, tall enough to allow for the particular type of exercise to be carried out and must include features which prevent them from sliding or tipping whilst being used. Within these parameters there is still a degree of design freedom.

### Comparison of designs

The registered design	The prior art
	

27. The applicant for invalidation states that the prior art and the registered design are identical. The designs are not identical. The prior art has a short section in the centre of the top bar which is thicker than the rest of it and is not present in the registered design. The exercise bars shown in the prior art have legs which are longer than the horizontal bar at the top, whereas, the registered design appears to have legs and top bar of the same length. However, designs can be considered identical where the differences between them are immaterial. The proprietor has not advanced any reasons as to why

the designs are different other than the fact that the designs are different sizes. The design shown on the UK register does not give any indication of size and it is not so limited. Taking all of these factors into account, I find that the small differences between these designs are immaterial and that they are therefore identical.

28. If I am found to be wrong with regard to the identity of the competing designs, in terms of overall impression, the prior art is a tubular shaped frame with the top bar horizontal and curving down to the sides. In the centre of the bar is a thicker portion which looks to be a type of hand grip. Each side or 'leg' terminates at a stabilising bar which is shorter and at a right angle to the 'legs'. Each end of the stabilising bar ends with a slightly thicker portion, presumably to provide a degree of grip, though I have no evidence or submissions to that effect.

29. The overall impression of the registered design is a tubular shaped frame where the top bar is horizontal and curves down to the sides. Each side terminates at a stabilising bar which is shorter, and at a right angle to the 'legs'. Each end of the stabilising bar ends with a slightly thicker portion, presumably to provide a degree of grip, though, again, I have no evidence or submissions to that effect.

30. The differences between the designs are that: i) the sides of the tubular frame are a little shorter in comparison to the top bar in the registered design, compared to the prior art and ii) the registered design does not have the slightly thicker portion in the middle of the top bar.

31. These differences are minor differences which are not sufficient to alter the overall impression that the respective designs make on the informed user. Accordingly, I find that the overall impression created by the registered design does not differ from the prior art.

32. Consequently, I find that the proprietor's design did not have individual character at the date on which it was applied for and the application for the invalidation of this design under section 1B of the Act succeeds.

## CONCLUSION

**33. The invalidation against this design has succeeded under sections 1B. The design will be struck from the register.**

## COSTS

34. Asif Mohammed has been successful and is entitled to a contribution towards his costs. I make the award as follows:

Official fee:	£48
Filing and considering statements of case:	£200
Filing evidence:	£200
<b>Total:</b>	<b>£448</b>

35. Subject to appeal, the above sum should be paid by David Gentleman to Asif Mohammed within 14 days of the end of the period allowed for appeal or, if there is an unsuccessful appeal, within 14 days of the conclusion of those proceedings.

**Dated this 15<sup>th</sup> day of February 2018**

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**