

O-111-18

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 4012142

OWNED BY MARION GIGLIO

FOR THE FOLLOWING DESIGN:



AND

AN APPLICATION (No. 30/17) FOR INVALIDATION BY STEVIE MACLANE

The background and the claims

1. The registered design the subject of these proceedings was filed by Marion Giglio on 12 August 2009. The design, which is described as “a bag”, looks like this:



2. Ms Giglio included a disclaimer on the form of application reading:

“DISCLAIMER ON COLOUR, COLOURS
PATTERN, PATTERNS, TIES
used for illustration purposes only”

3. The applicant for invalidation is Stevie Maclane. He claims that the design offends section 1B of the Registered Designs Act 1949 (“the Act”). He relies on the fact that the subject design is, in his view, a duplicate of an earlier design that Ms Giglio filed (no 4011912). In addition to the existence of Ms Giglio’s earlier design, he also relies on the evidence that was used to invalidate that design in proceedings instigated by a company called Beechfield Brands.

4. Ms Giglio filed a counterstatement denying the grounds on which the application is made. She states that her design is “a small bag with a flat pull made in the same fabric”. She notes the disclaimer (as above) stating that “It also has a disclaimer as to the colours and patterns and pulls this can be produced in ie ribbon, cord, leather, piping cords, waxed cords, string, tape, metallic cords etc.”. She states that the Beechfield Brands’ product is made in one fabric and only uses a pull with a rope and

is “certainly not the same in anyway”. She states that she can produce the design in any colour, pattern and tie.

5. Both sides have represented themselves in the proceedings. Neither side asked for a substantive hearing on the matter. I will detail later the evidence/submissions that have been filed in these proceedings.

Section 1B of the Act

6. Section 1B of the Act (in so far as it is relevant) 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 conditions 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 period of 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)--”

7. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*¹. The most relevant parts are reproduced below:

¹ [2012] EWHC 1882 (Pat)

“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.

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."

The relevant date

8. The relevant date is the application date of the registered design, namely 12 August 2009.

The informed user

9. The design is of a bag. The informed user is, therefore, a user of bags, albeit one who is a knowledgeable/observant user of bags possessing the type of characteristics set out in the preceding case-law.

The evidence/submissions

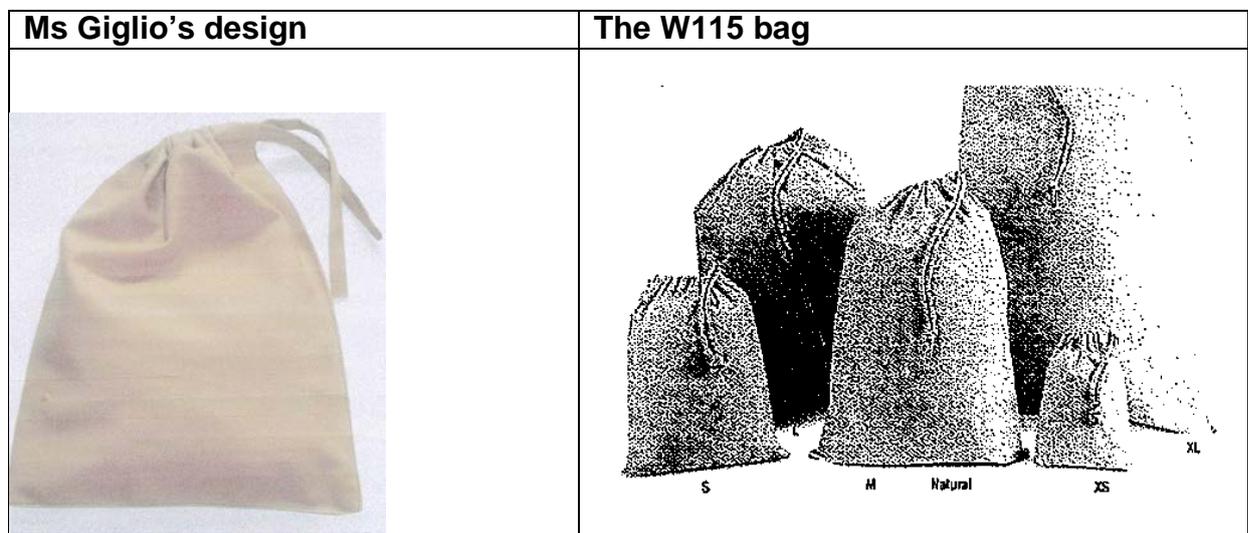
10. Attached to Mr Maclane's statement of case was a copy of the tribunal decision invalidating Ms Giglio's earlier design (no. 4011912). The decision depicts Ms Giglio's design and, also, the prior art that ultimately invalidated Ms Giglio's design, namely the W115 bag (produced by Beechfield Brands), which was held in that decision to have been disclosed in 2008.

11. On 17 August 2017, Mr Maclane provided a set of written submissions in which he expressed his view that he need only rely on the existence of Ms Giglio's earlier design. Upon my direction, the tribunal responded to this, informing Mr Maclane that if this was so then Ms Giglio may have a *prima facie* defence because her earlier design was published only a few weeks before the relevant date and, as such, the exception to disclosure in section 1(B)(6)(d) of the Act would be applicable. In response, Mr Maclane provided a copy of the evidence filed by the applicant for invalidation in the earlier proceedings, so as to form part of his case. The tribunal wrote to Ms Giglio to inform her that it was minded to accept that earlier evidence into these proceedings given that it was clear that the content of the earlier invalidation case formed part of the grounds for invalidation in this case. Ms Giglio was given a period of time in which to respond and make comment; no reply was received.

12. Ms Giglio, beyond what she stated in her counterstatement, has made no further submission and has provided no evidence.

Decision

13. As alluded to already, given the proximity in time (to the relevant date) of the disclosure of Ms Giglio's earlier design, I will focus, instead, on the prior art that was relied upon to invalidate Ms Giglio's earlier design. The prior art that invalidated the earlier design was the W115 bag. I accept that the evidence is, essentially, hearsay, as it is not direct evidence from Mr Maclane but, instead, evidence that he has taken from someone else. However, given that such evidence has already been accepted in earlier legal proceedings before this tribunal, and given that Ms Giglio has raised no concerns about the inclusion of the evidence itself, it may be considered. I depict below the subject design alongside the W115 bag.



14. There is no evidence about design freedom or the design corpus. In terms of the former, whilst there may be some design constraints in relation to the design of a bag (such as the need for it to hold something, together with some mechanism for closure) it seems to me that there is still likely to be a reasonable degree of design freedom around those constraints. This follows through to the design corpus. The market is likely to be filled with many and various designs, with the designs here not standing out to any great extent.

15. Both designs are simplistic. Both bags are square at the bottom and have similar proportions. They both taper towards the top of the bags in very similar ways as a result of the drawing together of the closure. Any difference in ruffling is immaterial, as

this is simply a feature of how tightly the user draws the top together. There is a difference in the pull cords. The W115 has a drawstring whereas Ms Giglio's design depicts a flat piece of material. However, that aspect of the design is disclaimed. Indeed, Ms Giglio stated herself in her counterstatement that her design could be produced using a variety of pulls, including string. Thus, this does not constitute any form of difference. The only difference I can really make out is that Ms Giglio's design has a wider channel through which the pull is fed (in order, presumably, to facilitate the flatter pull that is depicted). Whilst this may prevent the designs from being identical, it does not, in my view, create a difference in the overall impression of the designs. The design is invalid and will be struck from the register.

Costs

16. Mr Maclane has been successful and is entitled to a contribution toward his costs. I bear in mind, though, that he has represented himself (and, so, has not incurred legal fees). Further, whilst he has done enough to succeed, his statement of case was limited and his evidence consisted of a copy of an earlier decision and a copy of the evidence filed in those proceedings. I reflect all this in the costs I award below:

Official fee - £48

Preparing a statement of case and considering counterstatement - £75

Filing evidence - £75

17. I therefore order Marion Giglio to pay Stevie Maclane the sum of £198. The above sum should be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of February 2018

Oliver Morris

For the Registrar,

The Comptroller General