

O-291-18

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NOS 6005032, 6007986, 6007987, 6007988 & 6007989
OWNED BY MFP-ENTERPRISES LTD**

AND

**APPLICATIONS FOR INVALIDATION (Nos 29/17, 28/17, 27/17, 26/17 & 25/17)
BY LONDONMAGICSTORE UK LTD**

The background and the claims

1. The details of the five registered designs the subject of these proceedings are as follows¹:

Number	Representation	Filing date
6005032		23 December 2016
6007986		23 February 2017
6007987		23 February 2017
6007988		23 February 2017
6007989		23 February 2017

¹ Illustrations from different perspectives were also provided, but I will set these out later, to the extent required.

2. In each case, the designs were described on the form of application by MFP-Enterprises LTD (“the proprietor”) as a: “Silicon/Gel Cosmetic Applicator Sponge”. In each case, a disclaimer was made with regard to the colour/materials of the designs.

3. The applicant for invalidation is Londonmagicstore UK Ltd (“the applicant”). It believes that the proprietor is engaged in an anti-competitive policy whereby it obtains registered designs in relation to articles that are freely available on the market and then uses them to remove competing products from marketplaces such as eBay, in turn giving the proprietor a competitive advantage over other traders. Its grounds of invalidation are under section 1B of the Registered Designs Act 1949 (“the Act”), which requires that a registered design be new and have individual character. The applicant claims that the designs have previously appeared on websites and in videos. It provided evidence with its statement of case, which I will detail later.

4. The proprietor filed a counterstatement denying the grounds on which the applications were made. The points it makes in defence are that:

- i) Before its designs were registered, they were leaked in China by its manufacturer.
- ii) That the designs shown in the evidence differ from the registered designs.
- iii) That even though the designs in evidence were posted on social media, this does not mean that they have been made available to all of the public. This is because YouTubers are paid to review products and are given them for marketing purposes.
- iv) None of its designs are plain, as those in the evidence are.
- v) The proprietor owns the trade mark SILISPONGE, which confirms that it owns the product.
- vi) Social media images can be manipulated.

5. Neither side filed any further evidence or submissions. Neither side requested a hearing. Both sides have represented themselves throughout the proceedings.

Section 1B of the Act

6. Section 1B of the Act (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) 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)--”

7. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*². The most relevant parts are reproduced below:

“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.

² [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."

The relevant date

8. The relevant dates are the application dates of the registered designs, namely 23 December 2016 for the first design, and 23 February 2017 for the others.

The informed user

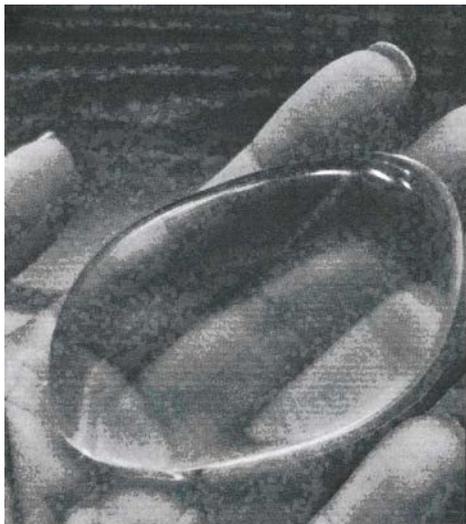
9. Given the purpose of the articles on which the design is to be applied, the informed user will be a user of cosmetic applicators.

The evidence

10. The only evidence in these proceedings was filed by the applicant, alongside its Form DF19A requesting the invalidation of the designs. The form and its accompanying statement of truth were signed on behalf of the applicant by Mr Dario Lopez. The evidence is, therefore, his. He provides ten annexes which consist of website prints and stills from videos on the Internet. I set them out below:

Annex 1) - This contains video stills from the website mollycosmeticsshops.com of two embedded Facebook videos. The first is dated 26 November 2016, the second is undated. The second depicts nothing. The first contains what may be some form of cosmetic applicator, but it is very unclear with the result that the features of the design cannot be made out. Given this, I need make no further comment on this piece of evidence. Whilst the applicant has provided a hyperlink to the webpage, it is for the applicant to produce its evidence not for the tribunal to go looking for it.

Annexes 2-5 and 8) - These all contain what appears to be the same photograph, albeit zoomed to different levels of magnification. The clearest image is the following (taken from Annex 5).



The source of these annexes is as follows:

- Annex 2 is from the website of the fashion magazine Cosmopolitan (dated 1 December 2016) which describes the article as the “Silisponge” which, in the view of the writer of the article, looks a lot like a silicone bra insert.
- Annex 3 is an Instagram print from the user Mollycosmetics. The date is not detailed other than that it was posted “24 weeks ago”, which Mr Lopez states places it in November 2016. The accompanying text describes the article as a Silisponge, and describes it as “our latest product”.
- Annex 4 is an extract (dated 2 December 2016) from the website birdie.co.uk entitled “The Weird Beautyblender Alternative Reddit Can’t Stop Talking About”. The article is again identified as the Silisponge, from Hong Kong.
- Annex 5 is a further extract from Cosmopolitan (this time dated 30 November 2016), again about the Silisponge (from Hong Kong) and which, again, notes its resemblance to silicone inserts.
- Annex 8 is a still from a YouTube video posted on 3 December 2016. Although the still depicts the Silisponge, the video itself is about the use of silicone inserts (which are not depicted) as an alternative to the sold out Silisponge.

Annex 6) – This contains a print of a product listing from amazon.co.uk for the Silisponge product. It is dated 7 December 2016. No image is depicted in the print.

Annex 7) - This contains a still from a YouTube video posted on 3 December 2016 entitled “APPLYING FOUNDATION WITH A BRA INSERT/Silisponge DUPE”. The still depicts a person holding an article. Mr Lopez states that she is using “the Silicone Sponge” but it is not clear if she is using the Silisponge

product or, as the title of the video suggests, just a bra insert (its size suggests it is the latter). The still looks like this:



Annex 9) – This contains a further still from a YouTube video, posted on 6 December 2016 (not 3 December as Mr Lopez states). The video is entitled “SILISPONGE VS. BRA INSERT – applying Makeup with Both/Dana”). The still depicts a person holding an article. The image of the article is not altogether clear, and it is also not clear if she is using the Silisponge product or a bra insert. The title of the video suggests it could be either, although its size suggests it is the former. The still looks like this.



Annex 10) – This contains a further still from a YouTube video, published on 8 December 2016. It is entitled “Silisponge Does it really work??/Molly Cosmetics”. The still depicts a person holding an article. The image of the article is not altogether clear but it appears, as the title of the video suggests, that it is the Silisponge. The still looks like this:



What prior art can be considered?

11. To constitute relevant prior art, the designs depicted in the evidence need to have been disclosed before the relevant date(s) and, also, not be excluded disclosures under section 1B(6). As stated earlier, the design in Annex 1 is so unclear that it need not be considered. Annex 6 depicts nothing so does not assist. The remaining annexes depict an article described as the Silisponge (Annexes 2, 3, 4, 5, 8, 9 & 10) and, also, a silicone bra insert (Annex 7). Both have the potential to count as relevant prior art, particularly given that all of the prints are dated before the relevant dates.

12. In its counterstatement the proprietor made a number of points about the disclosures. One relates to the potential for social media images to be manipulated. However, whilst theoretically possible, this is just speculation and there is nothing to suggest that manipulation of the images has taken place. The proprietor could have filed evidence to show manipulation, but has not done so.

13. A point is also made about YouTubers being given products to review and that, therefore, the designs may not have been made available to all the public. It is not clear what the proprietor means by this point. If it is saying that the article itself was not available to the public (to purchase) then this is not pertinent because the act of disclosure is not limited to sales. Disclosure is simply that the design of the article has been put into the public domain. The placing of the designs in YouTube videos and, also, on websites such as Cosmopolitan, clearly constitute relevant disclosures.

14. The applicant also states that its designs were leaked in China by its manufacturer and that it owns the Silisponge trade mark. The proprietor does not explain the potential legal relevance of these points. However, it is clear that the provisions contained in section 1B(6)(c)-(e) of the Act may be applicable. These provisions provide, effectively, a 12 month grace period (before the filing of the designs) for certain disclosures to be made without destroying the novelty of the design(s). However, the provisions only relate to a disclosure if:

“(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.”

15. Section 1B(6)(c) cannot be applicable because the disclosure needs to have been made by the proprietor or its successor in title. This is not claimed by the proprietor.

16. Section 1B(6)(d) has greater potential because if the proprietor’s design was leaked by its manufacturer which, in turn, led to it appearing in the videos and websites set out in the evidence, such disclosures may be excluded from these proceedings as they took place within the 12 month period preceding the relevant dates. However, the problem faced by the proprietor is that it does not accept that the designs shown in the evidence are of its designs, despite them being described as the Silisponge. Indeed, the proprietor states that they are different. Furthermore, the proprietor has merely made bald assertions about the so called leak and has provided nothing in support. The absence of evidence on this point is particularly pertinent given that the proprietor is a UK company based in Leicester, whereas there is reference in the evidence to the product originating in Hong Kong and with the only distributor identified being Molly Cosmetics. There is no evidence to link the disclosures in the evidence to the proprietor, or its claimed manufacturer.

17. The absence of evidence also rules out section 1B(6)(e) because there is nothing to show that the disclosures were the result of any form of abuse in relation to the designer.

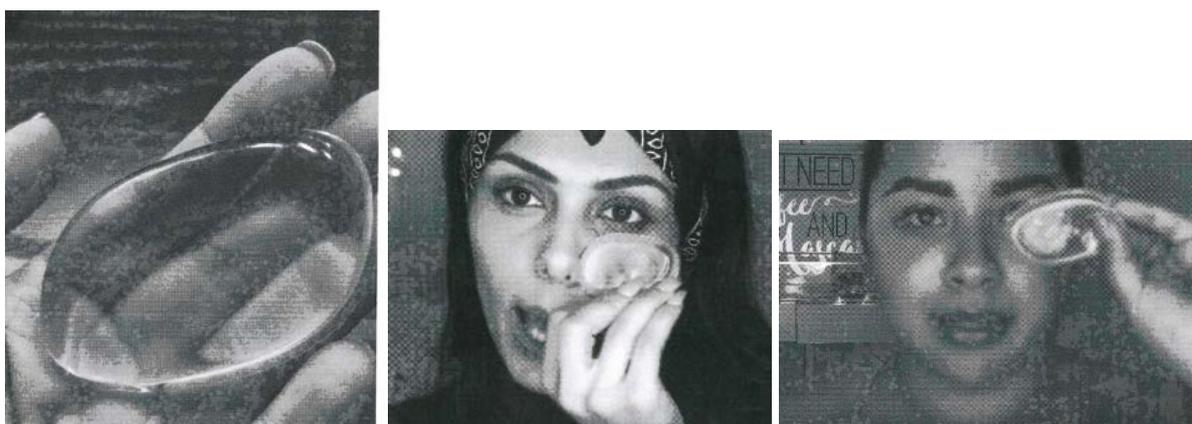
18. In summary, I consider that both the Silisponge design and the bra insert design shown in the evidence constitute valid prior art.

The comparison – registered design 6005032

19. The registered design is set out below, with six illustrations from different perspectives being provided by the proprietor:



20. In respect of the Silisponge prior art, they are depicted below:



21. The designs share the following attributes:

- They are all transparent.
- They all have a roughly curvilinear shape, albeit not one which forms an obvious geometric shape.
- The depth of the design is much narrower than its length and width.
- The designs have a recessed aspect, forming a lip around the edges. Whilst this is not particularly apparent in the Silisponge, it is clearer upon close inspection of the evidence filed.
- There is a very thin element of a film-like characteristic running around the perimeters of the designs.

22. The designs differ in that the outline shape is not exactly the same.

23. There is no evidence about the existing design corpus. I cannot therefore determine the degree to which the designs stand out from the crowd. Nor is there any evidence as to the degree of design freedom. Whilst cosmetic applicators will need to have certain attributes to make them easy to handle and to apply make-up, there is still some freedom of design as to the specific shape of the article and, also, freedom in terms of any ornamentation etc.

24. It is arguable whether the difference in the outline shape of the designs is an immaterial one. Therefore, I will focus my assessment on whether the overall impressions of the designs are the same or whether they differ. In my view, the difference in outline shape does not create a different overall impression. The overall impression of both designs will be characterised as a transparent article, with the same (or very similar) height/depth/width ratio, both with a concave aspect, with a curvilinear outline shape. I have not mentioned the film-like element around the perimeter because it is so insignificant in the overall impressions. As the registered design does not have a different overall impression to the earlier design, it does not possess individual character and is consequently invalid.

The comparison – registered design 6007986

25. The registered design is set out below, with six illustrations from different perspectives being provided by the proprietor:



26. The same points regarding the design corpus and design freedom as expressed above are applicable.

27. In comparison to the Silisponge prior art, the same analysis as above is applicable except that: i) the outline shape of the above design is very close (if not identical) to the Silisponge, and ii) the above design contains surface decoration of a large number of contrastingly coloured stars. The key question is whether the surface decoration gives the registered design individual character. I consider that they do. The star pattern will be perceived by the informed user as an integral part of the overall design of the article. It provides the design with individual character because the overall impressions differ enough. This design is valid. The applicant is in no better position from the perspective of the bra insert prior art. This is because this likewise has no star pattern and is, in any event, further away from the Silisponge in terms of its shape and configuration.

The comparison – registered design 6007987/8/0

28. I can deal with these three designs in one. This is because they appear to be identical designs other than their colour. However, as the proprietor disclaimed colour from the designs, the colour can make no difference to the assessment. I will therefore depict only the non-coloured registered design:



29. In terms of similarities in the designs (compared to the Silisponge prior art), they are, again, transparent, concave and have a thin film like element around the perimeter. The primary difference is that the outline shapes are different, with the registered design having a distinct teardrop shape. The base is, therefore, much wider than it's tip, with the prior art having no recognisable base or tip or at. In my view, this difference in shape will not only be noticed by the informed user, but it will strike them as creating a different overall impression. The informed user may assume that the teardrop shape introduces some functional benefit to the design, but its overall impact compared to the unspecific (but curved) shape of the prior art is still sufficient a difference. The registered design(s) are valid compared to the Silisponge prior art.

30. I must also compare the registered design to the bra insert. However, the differences are even greater here. It is not clear from the representation of the prior art whether it is concave. It does not have a tear drop shape and, instead, is thinner at both ends. There is sufficient difference between these designs also. The registered design(s) are valid compared to the bra insert prior art.

Outcome

31. Subject to appeal, the following findings are made:

- i) Registered design 6005032 is invalid and shall be removed from the register.
- ii) Registered designs 6007986, 6007987, 6007988 & 6007989 are valid and may remain registered.

Costs

32. At the end of the proceedings the parties were sent a letter (on 24 January 2018) indicating that if they wanted to claim costs they should complete a costs pro-forma, setting out the hours expended in dealing with the proceedings, otherwise no costs would be awarded. Neither side responded. I therefore make no award of costs.

Dated this 15th day of May 2018

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