

O-404-18

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN No 6013510
OWNED BY A LITTLE PRESENT LIMITED
IN RESPECT OF THE FOLLOWING DESIGN:**



AND

**AN APPLICATION FOR INVALIDATION (No 37/17)
BY SANIMAR COMPANY LIMITED**

The background and the claims

1. The details of the registered design the subject of these proceedings are as follows:

Design number: 6013510

Proprietor: A Little Present Ltd

Filing date: 7 June 2017

Article Description: "Mug"

Design (3 illustrations):



2. The applicant for invalidation is Sanimar Company Limited ("the applicant"). Its sole ground for invalidation is 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 it:

"..is the producer of this product since 2011. We have a patent for this product at several countries. A Little Present applied this design registration with bad intentions. Besides product is not new, they stole our idea."

3. Attached to the statement of case are various documents, some of which date back as far as 2015, relating to the manufacture of mugs and glasses with spinning components built into them. On the footer of each document are depictions of various mugs and glasses with spinning components, although, none feature Big Ben. Also provided are copies of emails between the proprietor and the applicant from shortly

before the design was filed. However, as they have not been translated (they seem to be in Turkish), I cannot comment on their content. Also provided are communications between the applicant and the IPO about registering designs and, also, a piece of paper containing a picture of what appears to be the registered design, headed “earlier design” but its context is not clear (it has a China Patent stamp, but no further information is provided).

4. The proprietor filed a counterstatement denying the grounds on which the application was made. It states that its design was conceived after encountering another spinning mug at a friend’s house, which led to the idea of having spinning mugs based on London landmarks. A manufacturer in Turkey was then sought, the manufacturer in question being the applicant. It is stated that:

“I directed her [Ms Oguz, part of the applicant company] with the London iconic symbols on the mug”

5. Ms Oguz subsequently came to the UK with Ms Saribas (also part of the applicant company) to meet Mr Gotkas (of the proprietor company) with product samples. It is stated that a verbal agreement was reached for an order of 5000 mugs. However, unbeknown to Mr Gotkas, the representatives of the applicant also met with a company called Elgate Products Ltd (“Elgate”), who they decided to “go with” because they ordered a higher quantity. Pictures are also provided of spinning mugs dating from 2002.

6. Both sides filed evidence. The applicant provided submissions in reply to the proprietor’s evidence. Neither side requested a hearing. The proprietor has represented itself. The applicant has been represented by Elgate, who, as one will appreciate from the previous paragraph, are not legal representatives.

Section 1B of the Act

7. 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)--”

8. 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:

“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:

¹ [2012] EWHC 1882 (Pat)

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

9. The relevant date is the application date of the registered design, namely 7 June 2017.

The informed user

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

Previous spinning mugs as prior art

11. Both sides' statement of case/counterstatement and evidence are littered with pictures of mugs with spinning components. The components range from footballs,

company logos, London buses, landmarks such as the Eiffel Tower. There is also evidence (from the applicant) of a recessed mug containing the spindle on which the various components spin, registered as a design in India in 2014.

12. What is apparent from the above is that spinning mugs have been made available to the public for a number of years. This is common ground. The dispute between the parties focuses on whether these mugs are those designed by the applicant. However, this does not matter. The question before me is whether the design the subject of this dispute is the same, or has the same overall impression, to what has previously been disclosed, regardless of who designed it.

13. The one point I should make clear is that in all of the evidence relating to the prior disclosure of spinning mugs, there is nothing to show that a Big Ben spinning mug has been disclosed. Therefore, one is left comparing the registered Big Ben mug (with a Big Ben spinning component within its recess and the words Big Ben London written upon its surface together with a pictorial representation of Big Ben) with a mug containing different components (as described earlier), or a blank spinning mug with no spinning component at all.

14. Clearly, none of these designs are the same. In terms of overall impression, I accept that a designer of a mug, whilst having some constraints such as a hollow in which the liquid is to be held, has a reasonably free hand in terms of design, particularly with regard to the decorative elements that appear thereon. Further, in terms of the design corpus, all of the numerous designs set out in the evidence contribute to the design corpus, so the Big Ben spinning mug does not stand out as starkly different from the corpus as it might have done had no other spinning mugs been in existence. In terms of the similarities and differences, whilst the basic outline shape of the mugs are the same or very similar, there are key differences on account of the absence/presence of the Big Ben spinning component and the wording and decorative content. This is a key feature of the registered design. I consider that weighing all these factors, the informed user will regard the registered design as creating a different overall impression to the previous spinning mugs that have been placed on the market. It seems to me that the applicant's claim is based on the designs having the same concept. Designs do not protect concepts, they protect the

appearance of a product. The appearance of the registered design is easily different enough from this type of prior art. The claim based on other types of spinning mugs is hereby dismissed.

Was the registered design disclosed before the relevant date?

15. Some of the evidence from the parties is potentially relevant in determining this point. I note from the applicant's evidence (provided by Ms Figen Oguz, its director, on 19 September 2017) that it attended the Hong Kong Gifts and Premium Fair at the end of April 2017, following which it started to work on opening a London office. It is claimed that this is why it opened discussions with Elgate, with the first contact with them being on 9 May, which Ms Oguz states was before the contact with the proprietor (on 16 May 2017). The context of the email exchanges with Elgate are about doing business together in relation to 10 mug designs and that a business meeting was to take place at the end of May in London. At one point in the email exchange, a representative of the applicant asks Elgate to "...discuss with your contact about getting patent in UK for our design mugs". In none of this evidence is there any reference to any particular mug designs, let alone a Big Ben spinning mug.

16. The proprietor filed two witness statements in response, one from Ms Suzan Cicek, who works for the proprietor as a marketing executive, the other from Terap Topkay, a market trader who purchases stock from the proprietor. The thrust of both witnesses' evidence is that on 29 May 2017 Mr Gotkas held meetings with Ms Oguz and that it appeared to them, from the conduct between the two, that some form of business deal (concerning spinning mugs) had been struck. Neither appears to have been at the meetings, so their evidence relates more to causal observations after any agreement was made. They both also attest to having seen the samples that were left with Mr Gotkas, Ms Topkay says this was "later on", Ms Cicek states that they are still in the office today. No specific mention is made of the Big Ben mug. I also note that Ms Cicek states:

"I can not claim that this product Mr Baris Gotkas created but I can claim that Sanimar's owner Mrs. Figen and her one of company staff were here for doing business with A Little Present Ltd purpose only."

17. In a written submission in reply, the applicant states that Elgate is its 11th distributor, and that all the proprietor has done was to act as its tour guide in London.

18. The proprietor filed further evidence consisting of a series of conversations on the WhatsApp platform between Ms Oguz and Mr Gotkas. They start on 16 May 2017 and end on 20 June. They are translated from Turkish. I do not intend to detail them all, but the content demonstrates the following:

- i) Early messages where the two are clearly attempting to undertake some form of business together, with frequent reference to product samples being made.
- ii) Mr Gotkas provides various ideas, many of which are based upon the London souvenir market. There is one mention of Big Ben being one of the better selling products for the souvenir market.
- iii) The two met at the end of May. Whilst one part of the visit was for tourism, it is clear that they also met for business purposes because product samples were provided, some of which were then displayed (and some sold) by the proprietor on 3 June (5 days before the relevant date). There is a picture of the samples on display, but the picture is not clear enough to ascertain what designs they are.
- iv) On 20 June, Mr Gotkas sent a number of messages expressing his dissatisfaction with Ms Oguz, presumably after she had gone and done business with Elgate instead of the proprietor.

19. It is not altogether clear what was going on between the applicant, the proprietor and Elgate. What, though, is reasonably clear is that the applicant was communicating with both Elgate and the proprietor in the lead up to Ms Oguz's visit at the end of May. It is also clear that Ms Oguz met with both Elgate and the proprietor during her visit. It is also clear that Elgate was subsequently selected as the applicant's distributor in the UK, something which the proprietor considers to have been against the agreement it had already reached with the applicant.

20. Regardless of the above, I remind myself that the application for invalidation has been made purely on the basis of prior disclosure. I have already dismissed the application for invalidation in so far as it is based upon other spinning mugs (or the concept of such things). There has been no claim by the applicant under section 11ZA(2) that it is the true proprietor of the actual design as registered. The lack-of novelty claim can only be considered if I am satisfied that there has been a disclosure of the subject design before the relevant date of 7 June 2017. There are only two possibilities for disclosure that I can see, as set out below.

21. The first relates to the prior disclosure of the registered design by the proprietor of its samples after receiving them from the applicant. However, the evidence does not depict (from what I can ascertain) the registered design itself, and whilst the two witnesses of the proprietor refer to seeing the samples, they do not refer to a specific design. In any event, given that the disclosure would have been made by the proprietor, this would be excluded by section 1B(6) on the basis that it was made by the designer or a successor in title (which, given that it applied for the design and no challenge has been made to its proprietorship, must be regarded as being the proprietor) in the 12 month period before the relevant date (see section 1B(6)(C)).

22. The only other potential disclosure could have been the showing of samples of mugs embodying the design by the applicant to Elgate. However, there is insufficient evidence to conclude that the actual registered design was so disclosed. Further, and in any event, this would also be within the 12 month period before the relevant date.

23. I have kept in mind that a picture of the registered design was included within the applicant's statement of case, headed earlier design, but there is no information at all about whether it was disclosed before the relevant date, or where, or how.

Outcome

24. Subject to appeal, my finding is that the application for invalidation fails and the design may remain on the register.

Costs

25. At the end of the proceedings, the parties were sent a letter 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 03rd Day of July 2018

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