O/387/19

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 5002140

OWNED BY DAWN MCKENNA

AND

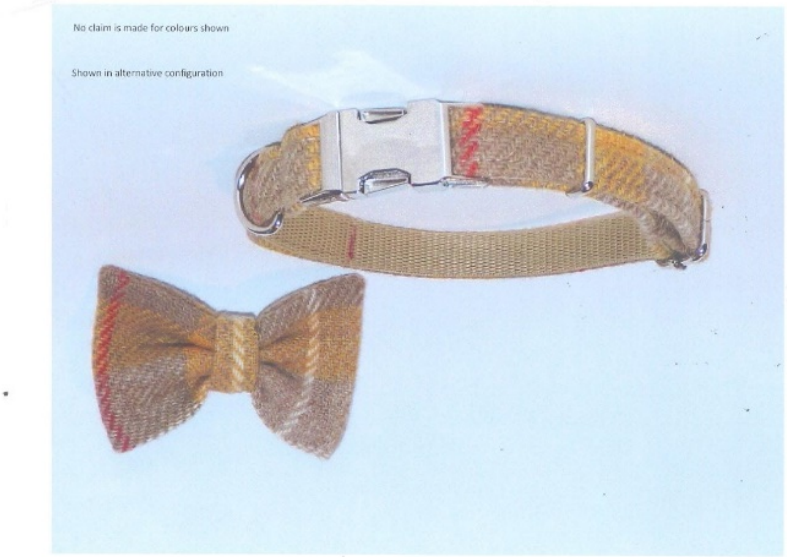
APPLICATION NO. 46/17 BY MARK ARMSTRONG

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The registered design which is the subject of this dispute was filed by Dawn McKenna ("the registered proprietor") on 24 March 2016. The original application included various photographs which the Registry identified as consisting of more than one design. The registered proprietor was asked to limit the application to only one design or to divide the application and file further illustrations to demonstrate the differing designs.

2. The registered proprietor then identified her design by clarifying which illustrations she wished to rely upon and the design was subsequently registered with effect from 24 March 2016. The design is described as "dog collar with detachable bow tie" and is depicted in the following representations:



3. The first picture of the registered design is accompanied by the words “No claim is made for the colours shown”. The third picture is accompanied by the words “No claim is made for the colours shown” and “Shown in alternative configuration”. On the application to register the design, “Harris tweed fabric” was disclaimed.

4. On 21 November 2017, Mark Armstrong (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that:

> a) The concept has been around for years and is not new or the original idea of the registered proprietor; and
>
> b) Tutorials on how to produce such goods are available on the internet and have been for a number of years.

5. Attached to the application for invalidation is a screen shot showing the results of a Google search for videos relating to dog bowties on YouTube. The results show five YouTube videos which provide instructions on how to produce dog bowties. Also attached, are the results of a Google search for ‘2011 dog bowties’. This produced 11 results relating to dog bowties.

6. The applicant claims that the registered design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) ("the Act"). Section 11ZA(1)(b) of the Act reads as follows:

> "(1) The registration of a design may be declared invalid
>
> (a)…
>
> (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act…"

7. The applicant claims that the registered design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

8. The registered proprietor filed a counterstatement denying the grounds of invalidation. In its counterstatement, the registered proprietor states:

> a) The documents attached to the application for invalidation do not show dated results and are the result of searches conducted some time after the filing of the registered design;
>
> b) The registered proprietor's design is made in tweed with "an easy to attach bowtie", which is held on by elastic loops. None of the designs shown in the search results submitted by the applicant are identical or similar to the registered design; and
>
> c) The search results provided by the applicant are not relevant to the present case because they all relate to tutorials for the creation of bowties for dogs and "thus proper to Patent protection which is not the case here".

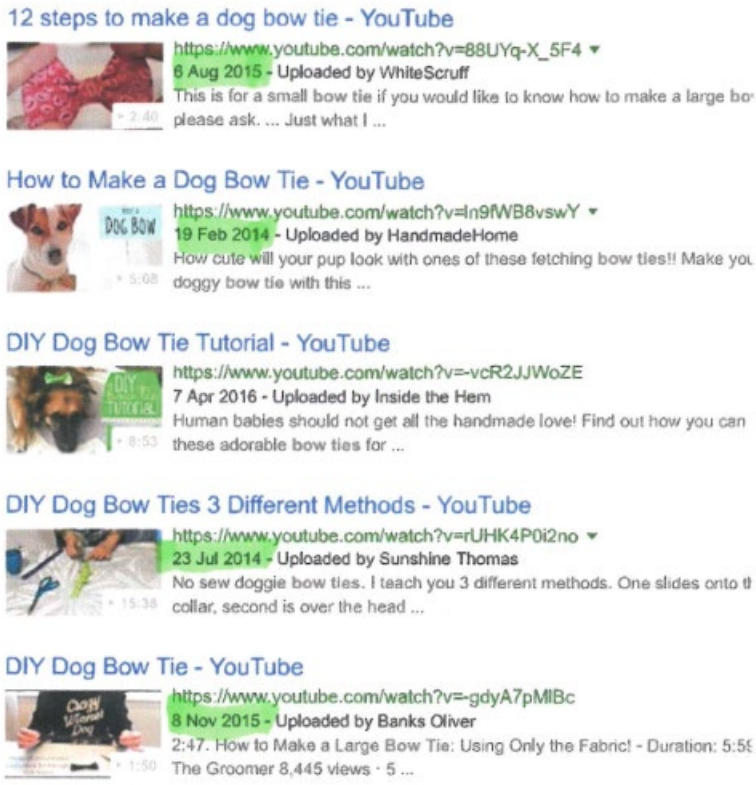
9. The applicant filed evidence in chief in the form of a witness statement prepared by him dated 27 March 2018. The registered proprietor filed evidence in the form of a witness statement prepared by her dated 21 May 2018. The applicant filed evidence

in reply in the form of a witness statement prepared by him dated 11 June 2018. The applicant is unrepresented. The registered proprietor is represented by Johnsons Patent & Trade Mark Attorneys. Neither party requested a hearing. This decision is taken following a careful perusal of the papers.

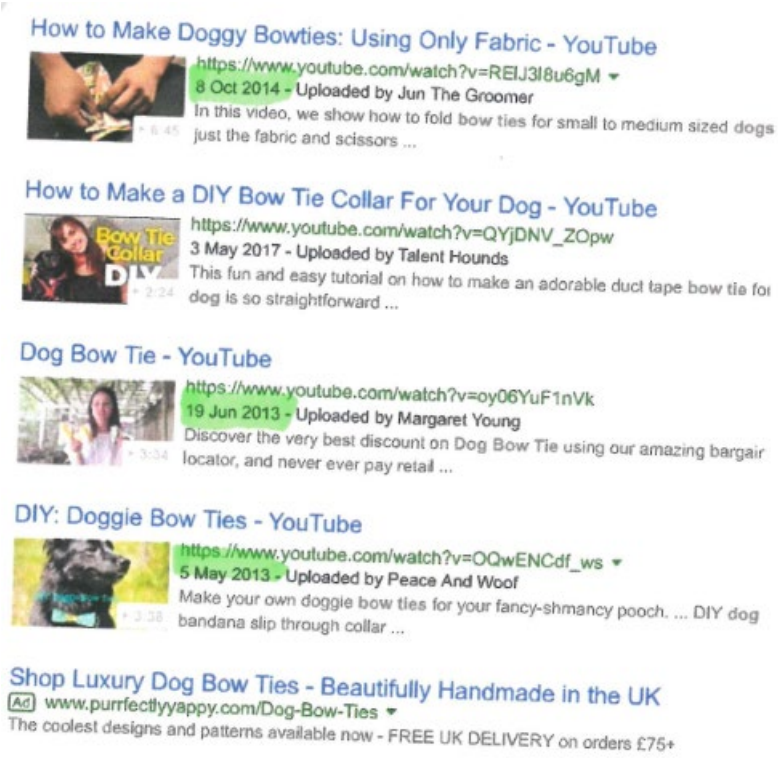
EVIDENCE

Applicant's Evidence in Chief

10. The evidence filed by the applicant accompanying his application for invalidation[1] displayed the results of two internet searches. The first was for "youtube dog bowties". This search yielded the following results:



[1] Rule 21(1)(a) of the Registered Design Rules 2006 confirms that evidence may be filed with a statement of case. The application for invalidation in this case was accompanied by a statement of truth.



11. The second was for "2011 dog bowties". This returned a number of links, but the only links that were accompanied by images were as follows (the images themselves were not accompanied by dates):

12. The applicant also filed evidence in the form of the witness statement prepared by him dated 27 March 2018, with six exhibits. In his statement, the applicant states:

> "2. By the date of registration, the design was neither new or exclusively the proprietors property as the methods of producing the item was available through various open source tutorials that were online, see attachments **3.1 to 3.4** (listed below). To find this evidence I conducted a basic search through www.google.co.uk using the following terminology "detachable dog bowtie

tutorials" the results that follow clearly show that the design were on public forums to the 24th March 2016." (original emphasis)

13. The applicant has provided screenshots of three videos posted on the YouTube website by third parties. The first was published on 7 June 2014[2]. No images from the video are provided, although it is entitled "[…] Bow Tie Velcro Attachment". The second was published on 29 November 2014[3]. The video is entitled "(DIY) Dog Bow Ties!". Again, no images from the video are provided. The applicant states that this exhibit shows how to use the "elastic method" so that the bowtie is removable. The third was published on 26 August 2014 and is entitled "NEW! Pet Bow Tie Tutorial Video"[4]. Again, no images from the video are provided. Following all of these videos are links to other related videos, many of which consist of tutorials on how to make a dog bow tie.

14. A number of the screenshots of these links show dogs wearing bow ties and, in some cases, bow ties attached to dog collars. However, because these videos only appear as related links in the screenshots provided by the applicant, the dates on which these images were published are not provided.

15. The applicant has also provided a screenshot from the website "Oh Whimsical Me" which displays an article entitled "DIY Puppy Bow Ties"[5]. This article is taken from the Archive for March 2013. This article displays the following image of a bow tie attached to a dog collar:

[2] Exhibit 3.1 to the First Witness Statement of Mark Armstrong
[3] Exhibit 3.2 to the First Witness Statement of Mark Armstrong
[4] Exhibit 3.3 to the First Witness Statement of Mark Armstrong
[5] Exhibit 3.4 to the First Witness Statement of Mark Armstrong

16. The applicant has produced emails from third parties which confirm that they produce dog bow ties and have done for some time. The first confirms that they have been producing dog bow ties (both detachable and fixed) since well before March 2016[6]. The second states that they have been selling dog collars with detachable bows since 2010[7].

17. The applicant states that dog collars with detachable bow ties are widely available in UK pet shops. The applicant goes on to state:

> "4. The Proprietor states that her design is made in tweed with an easy to attach bowtie. The bowtie is held on the dog collar by virtue of elastic loops.
> The design no. 500 2140 actually records the description as "Dog Collar with detachable bow tie" The supporting pictures do NOT show how the bow tie is attached. (submission **4**.) and the design at no point uses the words "tweed" or "elastic loops" at best the design is vague an unsubstantiated. Collars are available in various forms clip, buckle martingale etc… and novelty items can be attached using a number of different methods from elastic to button to velcro." (original emphasis).

18. The applicant states that he found out about the registered design which is the subject of these proceedings after items he was selling were removed from eBay. He contacted other sellers of dog bowties who were unaware of the registered design. The applicant states that no previous attempts have been made to protect the registered design.

Registered Proprietor's Evidence

19. The registered proprietor's evidence consists of a witness statement by the registered proprietor herself dated 21 May 2018, with two exhibits. The registered proprietor states that she has been running a business called Bowzos, which

[6] Exhibit 3.5.1 to the First Witness Statement of Mark Armstrong
[7] Exhibit 3.5.2 to the First Witness Statement of Mark Armstrong

manufactures and sells dog collars, since 2015. Prior to this, the registered proprietor had been making and selling bow clips for shoes and hair.

20. The registered proprietor has provided a screenshot of her email inbox and photographs of various products produced by her[8]. The emails displayed are sent by eBay and notify the registered proprietor of 'watched' items, items that have been sold and items that are listed for sale. The items that have been listed or sold are various headbands with bows. The photographs of products produced by the registered proprietor include bows for shoes, bows for hair and dog collars with bows. The photographs are undated.

21. The registered proprietor states that when she acquired a puppy in October 2013 and could not find a suitable collar with bow tie, she decided to design her own. She noticed that there were no collars sold with accompanying bow ties available in Harris Tweed. The registered proprietor states that the exhibits supplied by the applicant are not relevant because they relate to the way in which bow tie collars are produced rather than to the design itself. The registered proprietor states that none of the exhibits shown by the applicant are similar in design to the registered design.

22. The registered proprietor has provided a second screenshot of her email inbox, this time showing an enquiry from a customer about purchasing a dog bow tie, which is dated April 2015[9]. The screenshot is accompanied by various pictures of bow ties which the registered proprietor states show the evolution of her hand-crafted bow ties.

Applicant's Evidence in Reply

23. The applicant's evidence in reply consists of a witness statement prepared by the applicant himself dated 11 June 2018, with one exhibit. The applicant states that bow ties have been around since the 17th century and bow ties for dogs have been around for many years.

[8] Exhibit DMK1
[9] Exhibit DMK2

24. The applicant has provided pictures of two Christmas cards dated 1909 and 1937 which both display dogs with bows tied around their necks (in cartoon form)[10]. The applicant reiterates that dog collars with bowties are available from numerous pet shops across the UK.

DECISION

25. Section 1B reads as follows:

> "(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.

[10] Exhibit 1 to the Second Witness Statement of Mark Armstrong

(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.

…"

26. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EQHC 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; *Shenzhen* 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 the 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 constrains 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 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

27. The relevant date is the application date for the registered design, namely 24 March 2016.

The Informed User

28. The design is of a dog collar with detachable bow tie. The informed user is, therefore, a dog owner who would use a dog collar with detachable bow tie. The informed user is a knowledgeable/observant user, possessing the type of characteristics set out in the preceding case law.

What does the Registered Design consist of?

29. The registered design is described as a "dog collar with detachable bow tie", as displayed in the images above. The pictures provided with the application to register the registered design confirm that no claim is made to colour. The application also disclaimed Harris Tweed fabric.

30. On 12 February 2018, the Tribunal wrote to the parties to note these disclaimers and to query the references made in the proprietor's evidence to the use of Harris Tweed fabric. The Tribunal noted that a preliminary view suggested that the combination of the disclaimer of the fabric and the use of colour would result in the pattern displayed in the images not forming part of the registered design. The parties were both invited to make comments on this view.

31. No comments were received from the applicant. The registered proprietor responded as follows:

> "…We note that the UKIPO has correctly pointed out that colour has been disclaimed in the above registration. With regard to the second disclaimer, HARRIS TWEED is a certification trade mark which covers textile piece goods (tweed) made in a particular fashion from a particular location not tweed per se. Therefore the disclaimer to HARRIS TWEED only relates to the source of the tweed not the tweed pattern per se."

32. Following receipt of this explanation provided by the registered proprietor, the Tribunal wrote to the applicant to invite his submissions on the point. No response was received from the applicant. I accept the registered proprietor's submission on this

point and will proceed on that basis. The surface decoration, to the extent that this consists of the pattern alone, therefore forms part of the registered design.

33. One of the images filed with the registered design displays the made-up word BOWZOS, in a stylised font. This is obviously a trade mark or trade name. This will have some impact on surface decoration in the design. Given that this is a product that is likely to be selected for mainly aesthetic purposes (although I accept that it also performs a function) I consider that the presence of a brand name on the design is likely to have a reasonable impact on the informed user.

Design Corpus

34. It is clear from the evidence filed that there were different dog bow tie designs available at the relevant date which differ from registered design on account of their ornamentation, although they are all have a degree of similarity in respect of the basic bow-tie shape.

Design Freedom

35. There is limited design freedom in terms of the construction of a dog bowtie and collar. The bow tie itself must consist of a piece of material brought together in the middle to create a bow effect. The collar will need to operate within certain constraints to ensure that it meets the requirement of fitting around a dog's neck and having a mechanism to secure it in place. However, there are some elements of the design which do carry a reasonable degree of design freedom such as the surface decoration and the actual mechanism used to secure the collar in place.

The Comparison

36. As noted above, a design will be considered new if "no identical design whose features differ only in immaterial details has been made available to the public before the relevant date" and it will be considered to have 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". For the application to succeed, the registered design must not be new and/or must not have individual character, when compared with the prior art.

37. I will begin by making a comparison with the bowtie shown on the "Oh Whimsical Me" website, returning to the other pieces of claimed prior art to the extent necessary. The prior art shown in the applicant's evidence is shown alongside the registered design in the following table:

The Registered Design	The Prior Art
  	

38. This design was dated prior to the relevant date and is not an excluded disclosure under section 1B(6). It counts, therefore, as prior art.

39. The designs share the following attributes:

a) The bow tie element is similar in shape with the material fanning out to points at each of the four corners and brought together in the middle;

b) The strip of material used to bring the bowtie together in the middle is similar in shape; and

c) The collar element consists of a rectangular band.

40. However, the designs differ in the following ways:

a) The collar itself in the registered design is thicker in width than the collar shown in the prior art;

b) The central strip used to secure the bowtie at the centre is wider in the prior art than it is in the registered design;

c) The registered design is fastened by a clip mechanism and no corresponding fastening mechanism is visible in the prior art;

d) The surface decoration in the registered design consists of a large tartan-style pattern, whereas the surface decoration in the prior art consists of a small, checked pattern;

e) The registered design displays the trade mark or trade name BOWZOS in a stylised font, a feature of the registered design which has no counterpart in the prior art; and

f) The surface decoration in the registered design is applied to both the collar and the bow tie, whereas in the prior art the surface decoration is limited to the bow tie only.

41. A significant part of the similarity between the designs lies in the way in which a bow tie normally looks. That is, that it consists of a piece of material which is drawn together in the middle by another band of material to create a fanned effect. In my view, the differences noted above (particularly, c, d, e & f) are significant and would be noticed by an informed user. In terms of being new, it is self-evident that the

registered design and the prior art are not identical. I also do not consider that the differences listed above can be said to be only immaterial details. In my view, the registered design is, therefore, new compared to the prior art.

42. Turning to individual character, I recognise that the clip used to secure the collar element of the registered design, is clearly dictated by the function of the collar. It is necessary to ensure that the collar can be easily secured around (and removed from) the dog's neck. However, there was, in my view, a design choice as to how this feature was arranged and configured which must have been, in part, driven by the appearance of the product. There are any number of ways in which a collar could be secured such as buttons, buckles, clips or clasps. The decision of the registered proprietor to use this specific type of clip to secure the collar, whilst driven by functional considerations, also represents a design choice which is partly about appearance.

43. The differences regarding thickness of the collar and size of the individual parts of the bow tie, whilst being aesthetic choices, are also affected by functionality and there would have been limited design freedom in these aspects. The surface decoration is an important contribution to the design. Similarly, the branding displayed on the product will also play a role.

44. Taking all of these factors into account, I find the respective designs will create a different overall impression on the informed user. In my view, the registered design does, therefore, have individual character.

Other Prior Art

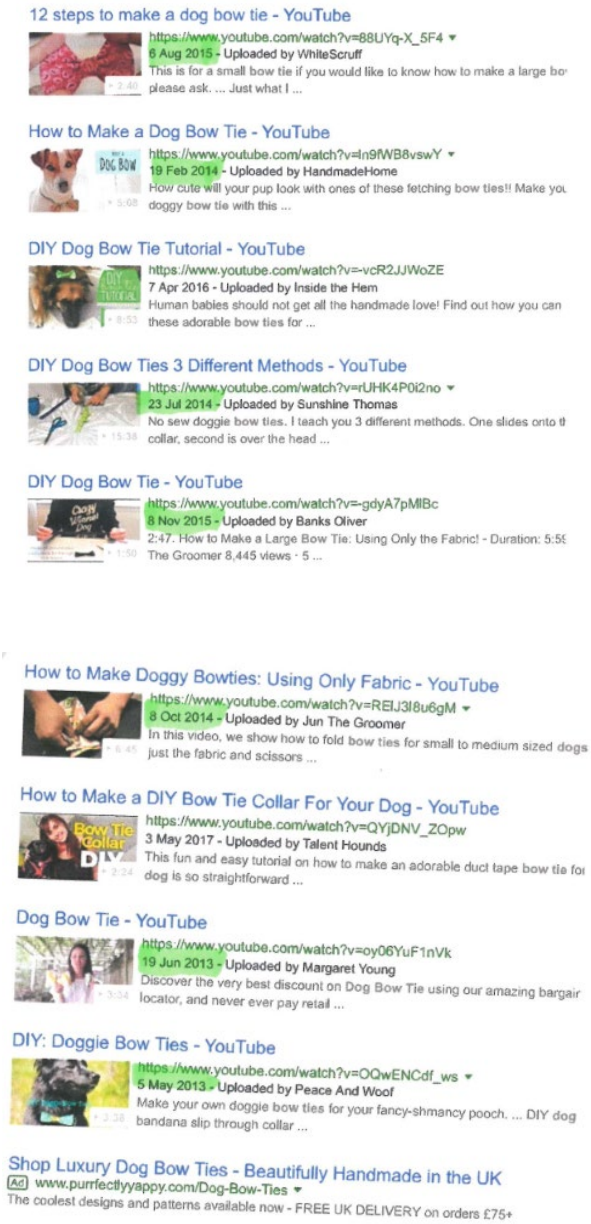
45. The designs depicted in the evidence will need to have been disclosed prior to the relevant date and must not be excluded disclosures under section 1B(6).

46. As noted above, the applicant has referred to various YouTube videos which he states are tutorials on how to make dog bow ties. However, no images from the videos are provided and it is not, therefore, possible to use these for the purposes of a comparison with the registered design. The links to related videos do display images

of bow ties on dog collars. However, these videos are undated and I cannot, therefore, confirm that they are prior art.

47. The applicant also provided copies of emails from individuals confirming that they have been making bow ties for dog collars for a number of years, but no images are provided as examples of the goods produced to enable a comparison.

48. The applicant provided the results of two internet searches, as noted above. These appear as follows:



49. Those searches which are highlighted in green are dated prior to the relevant date and, therefore, qualify as prior art. However, I consider that these are further away from the prior art used for the purposes of my comparison above because:

a) The first image shows a bow tie but not a collar. The registered design is for a dog bow tie with detachable collar and, consequently, the presence of the collar is a fundamental part of the registered design which is absence from this prior art. Similarly, the ornamentation shown on this design is further away than that shown on the prior art used for my comparison above.

b) The second image shows a bow tie with collar attached, but the image is very small and it is not possible to identify the precise ornamentation on the design. However, the pattern doesn't appear to have any noticeable similarity to the pattern shown in the registered design. Further, the clasp used for the collar is not visible.

c) The third, fourth, fifth and sixth images do not show completed bow ties at all and do not show dog collars.

d) The final image shows a dog wearing a bow tie but it is not clear how this has been fastened. There is no visible collar or clasp. The bow tie itself differs in ornamentation from that shown on the registered design.

50. Consequently, I do not consider that any of these images put the applicant in a stronger position than the prior art used for the purposes of my comparison shown above. Thus, compared to these various pieces of prior art, the registered design is new and has individual character.

51. The opponent has also provided the search results for the term "2011 dog bowties". However, although "2011" was included in the search criteria, the images themselves are undated. It is not, therefore, clear whether these images were actually dated prior to the relevant date or more recently. I do not, therefore, consider them to be prior art as there is no evidence that they were disclosed prior to the relevant date. In any event, the images shown all have differing ornamentation and, for the reasons set out

above, this alone would prevent the images from destroying the novelty in the registered design.

52. The cartoon images provided by the applicant are dated 1909 and 1937. They, therefore, are capable of being considered prior art. However, in my view, the images show dogs with bows tied around their necks using ribbon rather than dogs wearing collars with bow ties attached. In any event, the design of the bows displayed in the cartoon images differ in shape and surface ornamentation to the bow tie in the registered design and are, therefore, further removed from the registered design than the prior art used for the purposes of my comparison above. Consequently, these images do not put the applicant in a better position than the comparison above with the consequence that they do not destroy the novelty in the registered design.

CONCLUSION

53. The application for invalidity has failed.

COSTS

54. The registered proprietor has been successful and is entitled to a contribution towards her costs. In the circumstances, I award the registered proprietor the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the statement of case and filing a counterstatement	£300
Filing evidence and considering the applicant's evidence in chief and evidence in reply	£500
Total	**£800**

55. I order Mark Armstrong to pay Dawn McKenna the sum of £800. This sum is to be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 10th day of July 2019

S WILSON
For the Registrar