

O/494/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6059306

OWNED BY SOURCE FOR ME LTD

AND

APPLICATION NO. 39/19 BY JEREMY TAYLOR

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The contested design which is the subject of the dispute was filed by Source For Me Ltd (“the proprietor”) on 2 April 2019. The registered design is for a “folding grill” and is depicted in the following representations:





2. On 7 June 2019, Jeremy Taylor (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that the registered design should be declared invalid and cancelled under sections 11ZA(1)(b) and 11ZA(2) of the Registered Design Act 1949 (as amended) (“the Act”).

3. Section 11ZA(1)(b) of the Act states:

“(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...”

4. 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. In this regard, the applicant relies upon its own design registration no. 3025388, which was registered on 17 July 2006. The applicant claims that products embodying the design were made available to the public after the registration date of the contested design.

5. The applicant also states as follows:

“We have been selling this product ever since 2006 when it was registered. Amazon and eBay always supported our design registration by removing all copies.

Our product has been copied and successfully defended by us in a number of UK outlets, on all occasions we have successfully defended our design registration.

In the past we have licensed our design to the following stores:

Asda, John Lewis, Tesco's, Morrison's, Outwell, and currently license it to Aldi and Lidl.

We constantly monitor Amazon and eBay for copies of our design and in March 2019 we reported a copy supplied by “Source For Me Ltd” this was deemed to be the same design as our registered design from 2006 and it was removed by Amazon and eBay as confirmed by the seller in his attached letter.

In his letter to me it clearly states that they registered the design of their copy after it had been available for sale which I understand is also not allowable.

As can clearly be seen by the photos of the product it is the same design and look as our product with the only minor variation is that one side is taller than the other. The new design doesn't create a different overall impression on the

informed user. Our patent design lawyers have successfully defended our design since 2006 when we designed and registered the product.”

6. Section 11ZA(2) states:

“(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

7. In this regard, the applicant states: “I registered the design under no: 3025388 on 07/07/2006”.

8. The proprietor filed a counterstatement denying the grounds of invalidation. In particular, the proprietor states as follows:

“It should be noted that all differences summarised below are not of a cosmetic nature, serving as a functional difference between the item sold by Source For Me Ltd presented by UF Designs.

- Size of items: The item presented by Source for me is larger up to the level of the grill, with the additional windbreak panel at the rear of the grill showing further dimensions.
- Materials: The item presented by Source for me is constructed from stainless steel, whereas the item presented by UF Designs is of black coated mild steel.
- Configuration of parts: It should also be noted that the item presented by Source For Me Ltd is constructed differently and utilises a vastly altered array of parts that further separate the two items to the naked eye.
- Support: Due to the softer nature of Mild Steel the item presented by UF Designs requires a supporting V shaped fold in the lower leg where the item presented by Source For Me is of a different material that does not require additional support to be moulded into the stainless steel construction.

Mr Taylor, in his statement, suggests that there is only a minor variation in the design of the item and “Does not create a different overall impression on an informed user”, I would also suggest that the embossed “Lickleys” name on the windbreak panel, whilst only serving as cosmetic branding on said windbreak panel, would massively differentiate between the two items to either informed and uninformed user.”

9. Both parties filed documents with their pleadings, which I shall refer to below.

10. No evidence in chief was filed by the applicant. The proprietor filed evidence in the form of the witness statement of Mark Foreman dated 5 November 2019. No evidence in reply was filed by the applicant. Both parties are unrepresented. This decision is taken following a careful perusal of the papers.

EVIDENCE

Documents filed with the Application for Invalidity

11. As noted above, the applicant filed a number of documents with its Request to Invalidate a Design Registration. In particular, I note as follows:

a) A print out of the applicant’s registered design no. 3025388;

b) An email dated 22 May 2019 from the proprietor to the applicant relating to the removal of its products from Amazon and eBay due to action taken by the applicant. It is clear from this email that the proprietor’s products had already been sold on Amazon and eBay prior to that date, but no date is provided as to when the proprietor started selling its products on these sites.

Documents filed with the Counterstatement

12. Similarly, the proprietor also filed documents with its Notice of Counterstatement. In particular, a number of photographs displaying the parties' respective designs and the measurements for those designs.

The Proprietor's Evidence in Chief

13. As noted above, the proprietor also filed evidence in the form of the witness statement of Mark Foreman, dated 5 November 2019. Mr Foreman is the Managing Director of the proprietor, a position he has held since 2006.

14. Mr Foreman has filed physical examples of the parties' respective products. I have reviewed these prior to reaching my decision.

15. Mr Foreman has also filed images showing the alleged differences between the parties' respective products and drawings of the components of the proprietor's product. This includes the following side-by-side comparison:



PRELIMINARY ISSUES

16. The application for invalidation was originally based upon section 11ZA(1A) and section 1C of the Act, instead of and/or in addition to those mentioned above.

17. On 4 June 2019, the Registry wrote to the applicant as follows:

“11ZA(1A) is not applicable as your design was published before the disputed trade mark [sic]. You may wish to consider a S.1B claim instead.

S. 1C(1) will be struck out as not appropriate. This section is in relation to technical function not similarity.”

18. An amended Form DF19A was filed on 7 June 2019. The application, therefore, proceeds on the basis of sections 1B and 11ZA(2) only.

19. I note that in its pleadings, the applicant refers to the fact that the proprietor has admitted in correspondence that its design was available on Amazon as early as March 2019. The potential significance of this is that a design can be invalidated by any prior publication which falls within the scope of section 1B of the Act (below), even if that disclosure is made by the designer him/herself. However, section 1B(6)(c) makes it clear that if a disclosure is made by the designer within the 12 months preceding the relevant date, it is an excluded disclosure and cannot be relied upon for the purposes of an invalidation. As the disclosure in question appears to relate to only 1 month prior to the relevant date, this does not impact upon the validity of the contested design.

DECISION

Novelty and Individual Character

20. 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.

(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.

...”

21. 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 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 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

22. The relevant date is the application date for the contested design i.e. 2 April 2019.

The Informed User

23. The contested design is for a folding BBQ grill. The informed user is, therefore, a member of the general public. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

24. No evidence has been filed regarding the type, range or variety of folding BBQ grills that were available at the relevant date. However, I am prepared to take judicial notice of the fact that folding BBQ grills will need to be designed in a way that makes them easily compactable and with a flat grill surface upon which to cook food.

Design Freedom

25. The design freedom with regard to folding BBQ grills will inevitably be limited in terms of construction, to the extent that they will all need to be designed with the ability to fold down into a compacted version. However, there will of course be design freedom in that folding BBQ grills could be configured in any number of ways, with different sizes, multiple grill surfaces, covers or support mechanisms. They can also be presented with different surface patterns.

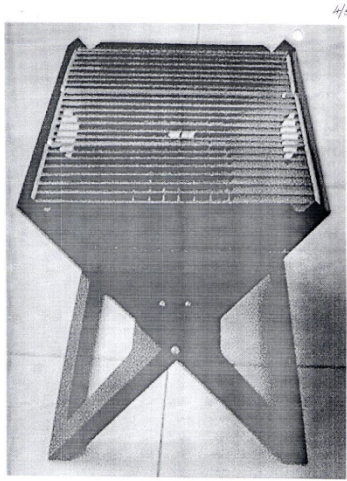
The Comparison

26. 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.

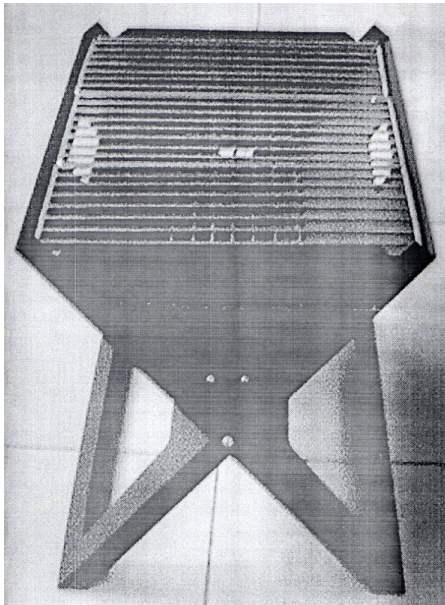
27. In order to be considered prior art, the design relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6). The design relied upon was filed on 7 July 2006. As the design relied upon was published prior to the relevant date it can be considered prior art. It is not an excluded disclosure.

28. The designs to be compared are as follows:

The Prior Art

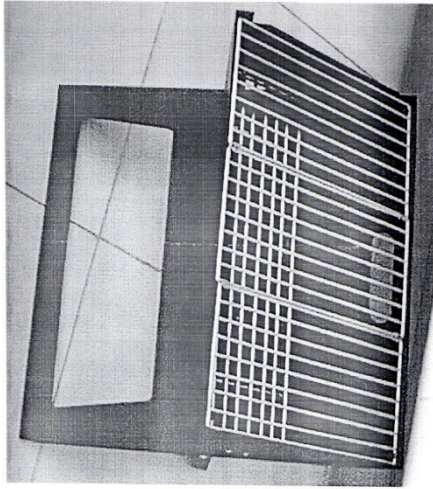


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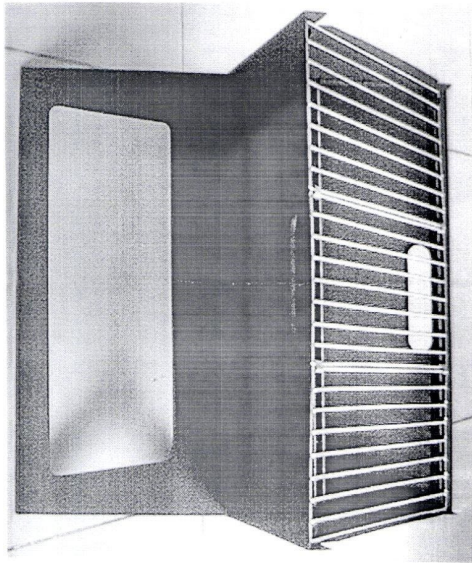


The Contested Design



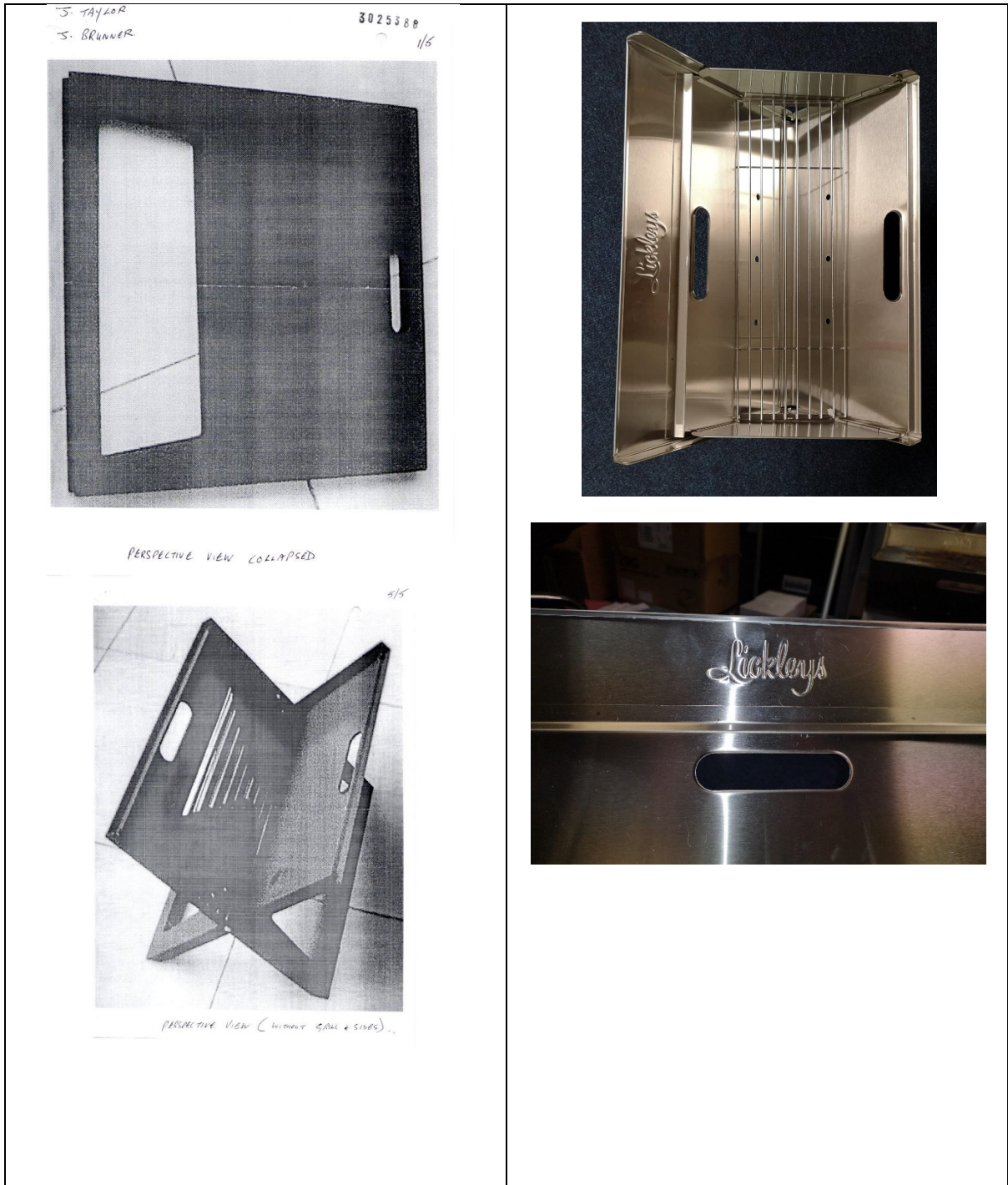


FRONT PERSPECTIVE VIEW



FRONT PERSPECTIVE (2)





29. In my view, the designs share the following attributes:

- a) They are both supported by two panels with trapezium-shaped cut outs;
- b) Both grills have cut outs beneath the top grill area to create hand holds;

- c) Both have a triangular shaped support for the grills, with one smaller grill at the narrower end of the triangle and one larger grill at the top;
- d) Both have a visible screw at the point where the two panels cross.

30. However, they differ in the following ways:

- a) The top grill in the contested design runs length ways, whereas in the prior art its runs along the width of the folding grill;
- b) One side panel of the prior art displays a series of horizontal cut outs, which gradually get shorter to create a triangular shape. This part of the design is likely to be for ventilation purposes but is not replicated in the contested design;
- c) The contested design has small three circular cut outs in each of its side panels which, again, are likely to be for ventilation purposes but which are absent from the prior art;
- d) The top grill in the contested design has a handle which protrudes from the folding grill when assembled, which has no counterpart in the prior art;
- e) The panels of the contested design are unequal in length, with one side protruding higher than the other, whereas the sides of the prior art are equal in length;
- f) The contested design is a bright gold colour, whereas the prior art is registered in a dark shade;
- g) The contested design has the word "Lickleys" embossed along the top of the protruding panel, which has no counterpart in the prior art.

31. I recognise that some of the features of the designs are dictated by the function of the product. For example, the cut outs beneath the grill in both designs (being three horizontal lines forming a triangular shape in the contested design and three small

circles in the prior art) are likely to be included in order to allow the necessary flow of air through the design in order for it to function. Similarly, the visible screw in both designs is located in that position in order to enable the products to fold. However, there are clearly also design choices associated with these aspects; both designs have chosen to enable ventilation by using different shaped cut outs and the designer could have elected to cover the screw rather than leave it visible. These represent design choices which are, at least partly, about appearance.

32. I recognise that the embossed word “Lickleys” on the contested design is likely to be recognised as a trade mark or trade name. This will have some impact on the surface decoration of the contested design. Whilst this product will mainly be selected for functionality, I consider that there will still be an aesthetic component to the purchase. Consequently, the presence of the embossed name on the design is likely to have at least some impact on the informed user.

33. I note that the prior art is registered in a dark shade, whereas the contested design is registered in bright gold. This difference in surface decoration will clearly represent a significant difference between the designs. I do, of course, recognise that the prior art is registered in the form of a black and white image; it is not, therefore, possible to identify the exact colour of the design. However, it is clear to me from this image that it is dark in colour, which is a clear contrast to the bright gold of the contested design. If the applicant intended to protect its design in any colour then it could (and should) have included a disclaimer in its registration. Alternatively, it could have registered the design as a line drawing. In this regard, I note the judgment of the Supreme Court in *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12 in which it was stated:

“46. Two domestic cases are worth mentioning in this connection. In *Proctor & Gamble*, the registered design was illustrated by line drawings, which were clearly concerned purely with external shape. Both Lewison J ([2007] FSR 13) and the Court of Appeal held, as Jacob LJ put it at [2008] FSR 8, para 40, that “[t]he registration is evidently for a shape. Graphics on that (or on the physical embodiment of the design) are irrelevant.” Many line drawings simply show a physical shape, as in *Proctor & Gamble*, but while they can show colouring and

decoration, they are generally less appropriate for that purpose than photographs or CAD images, which can easily show subtle shadings and contours, as well as decoration, such as colours and ornamentation. Accordingly, while each Community Registered Design image must be interpreted in its own context, a line drawing is much more likely to be interpreted as not excluding ornamentation than a CAD image. That is consistent with what Dr Schlötelburg wrote in the article from which I have already quoted namely that “[b]asically, the broadest claims can be achieved by drawings showing only the contours of the design. In contrast, a photo specifies not only the shape, but the surface structure and the material as well, thereby narrowing the scope of protection accordingly” – [2003] EIPR 383, 385.”

I consider it, therefore, appropriate to take the shading displayed in the prior art into account for the purposes of my assessment.

34. There are clearly some similarities between the designs. For example, both have elected to use panels with trapezium-shaped cut outs to support the grills. However, as set out above, there are clearly also differences. The different presentation of the top grills as well as the asymmetrical panels used in the contested design are sufficient to prevent the designs from being identical. I also consider that the differences listed above cannot be considered immaterial. I consider that the contested design and the prior art will create different overall impressions on the average consumer. In my view, the contested design is, therefore, new and does have individual character.

35. Consequently, the applicant’s claim for invalidation based upon this ground is unsuccessful.

36. For the avoidance of doubt, even if I am wrong in my finding that the contrast between the dark shading in the prior art and the bright gold colour used in the contested design can be taken into account for the purposes of my assessment, I still consider that the remaining differences between the designs are sufficient to support a finding that the contested design is new and does have individual character. My overall finding would, therefore, remain the same.

Ownership of the Registered Design

37. Section 11ZA(2) of the Act states that:

“The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

38. Section 2 of the Act deals with the proprietorship of designs and states as follows:

“(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1A) [...]

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the ‘author’ of a design means the person who creates it.

(4) In the case of a design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made shall be taken to be the author.”

39. The applicant must therefore show that it has created the design. The basis for the applicant’s claim in this regard is that it had registered the design on 7 July 2006 under registration no. 3025388. To my mind, this is not a case of a dispute as regards to

ownership of the contested design. The applicant's case appears to be based upon the proposition that the contested design is the same as (or very similar to) his own design. That is a claim that should be brought under section 1B as already dealt with above. It is not a claim that fundamentally relates to ownership. In these proceedings, there is no evidence of any prior relationship between the parties so as to give rise to the suggestion that ownership of the contested design might properly rest with the applicant.

40. Consequently, the applicant's claim for invalidation based upon on this ground is unsuccessful.

CONCLUSION

41. The application for invalidity has failed.

COSTS

42. The proprietor has been successful and is entitled to a contribution towards its costs. The proprietor is unrepresented and has submitted a costs proforma outlining the number of hours spent in these proceedings.

43. The proprietor has claimed 2 hours in respect of "considering forms filed by the other party". I consider this amount to be reasonable.

44. The proprietor has claimed 10 hours in respect of "1st rounds of evidence" and 6 hours in respect of "2nd round of evidence". I assume that this time relates to documents filed with the proprietor's counterstatement and documents filed as evidence in chief. However, there is overlap in terms of the documents filed at both of these stages. Consequently, I consider 12 hours to be reasonable for the total amount of time spent on the preparation of evidence by the proprietor.

45. The proprietor has also claimed £30 in relation to courier fees. It appears that this is likely to relate to courier fees for providing Physical examples of the parties' respective products. I will, therefore, award £30 for the courier fees claimed.

46. In relation to the hours spent on these proceedings, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the proprietor the sum of £266 (14 hours at £19 per hour) plus £30 courier fees.

47. I hereby order Jeremy Taylor to pay Source For Me Ltd the sum of £296. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 6th day of October 2020

S WILSON

For the Registrar