

O/504/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NOS 6068115 & 6068116

IN THE NAME OF CRAIG KNIGHTS

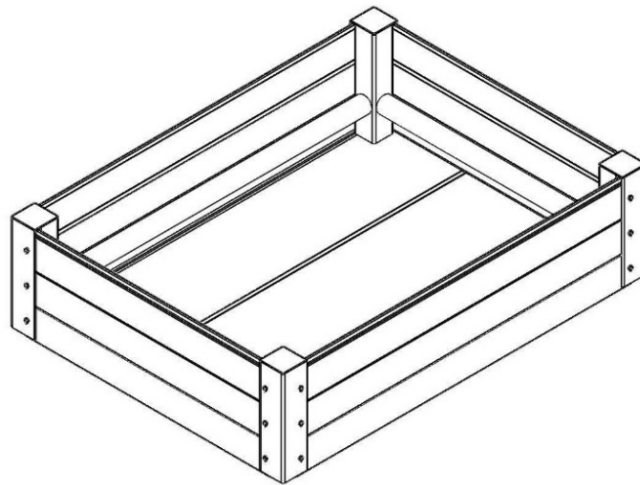
AND

APPLICATIONS FOR INVALIDATION (NO 50/19 & 51/19)

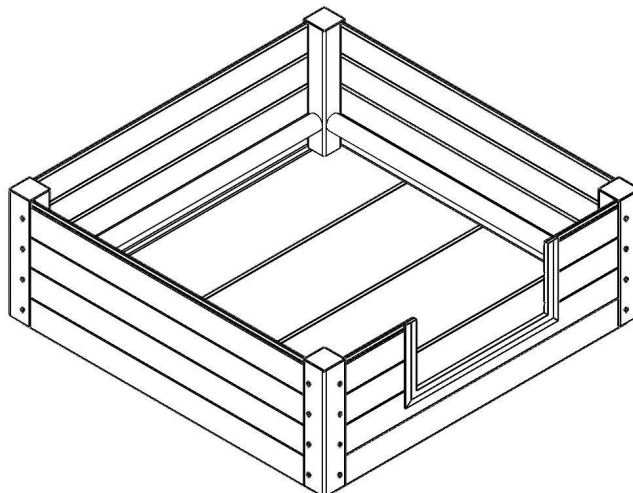
BY DIANE GILLESPIE

Background and pleadings

1. Craig Knights (“the registered proprietor”) filed application no. 6068115 (“the 115 design”) for a registered design for a plastic whelping box in Class 30, Sub class 06 of the Locarno Classification (Beds, nests and furniture for animals) on 11 August 2019. It was registered with effect from that date. The main representation is reproduced below and the remainder in the table in the Annex to this decision.



2. On the same day, the registered proprietor filed application no. 6068116 (“the 116 design”) for a registered design for a plastic whelping box with door in Class 30, Subclass 06 of the Locarno Classification. It was registered with effect from that date and again I have reproduced the main representation below and the remainder in the table in Annex.



3. On 4 September 2019, Diane Gillespie (“the applicant”) made applications for both registered designs to be invalidated under section 11ZA(1A) of the Registered Designs Act 1949 (“the Act”), on the grounds that the contested designs were not new nor did they have individual character compared to Registered Design Nos 4025572 and 4016965 that were made available to the public on or after the application date of the contested designs

4. On 9 October 2019, the Registry wrote to the applicant to inform her that the above ground was not applicable, as the designs had been made available to the public before the application date of the contested designs (in 2012 and 2010 respectively). In such a case, the appropriate ground would be section 11ZA(1)(b), that the contested designs did not fulfil the requirements of section 1B that they should be new and have individual character. On the same day, the applicant requested that the grounds be amended.

5. The registered proprietor filed counterstatements to the applications for invalidation on 18 September 2019, denying the applicant’s claims.

6. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties represent themselves.

Evidence

7. The applicant submitted evidence alongside her applications for invalidation. This consists of the registration details of the contested and prior designs and copies of the following listings from eBay:

Application against the 115 design:

- A plastic whelping box sold by the applicant for £129.99. The listing started on 17 November 2018 and was last updated on 27 August 2019; and

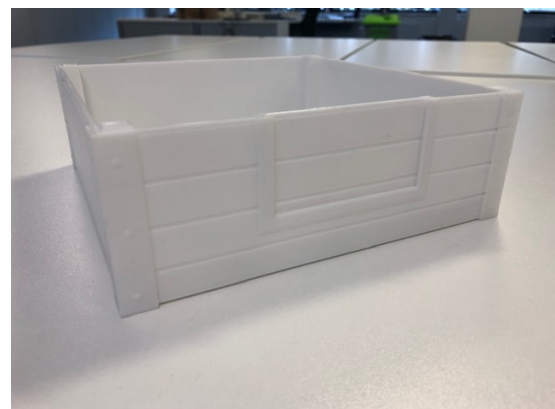
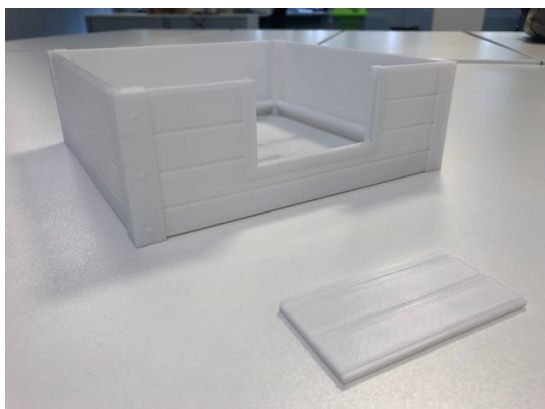
- A plastic (reusable PVC) whelping box sold by the registered proprietor for £105. It is not clear when listing began, but the information was last updated on 3 September 2019.

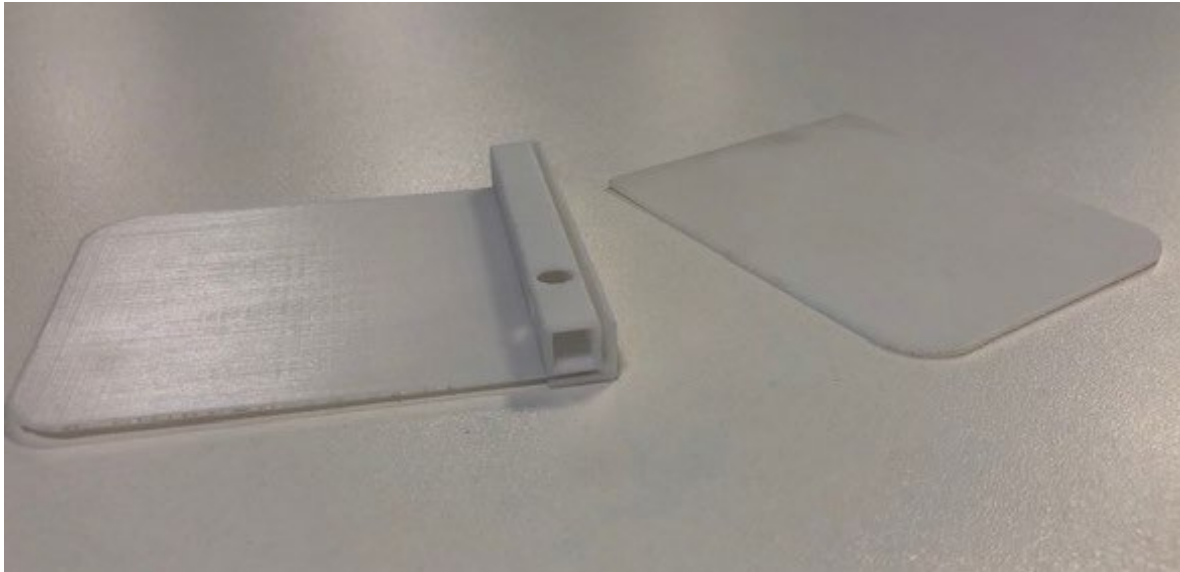
Application against the 116 design:

- A plastic whelping box with slide up door sold by the registered proprietor for £140.00. Again, the date when this was first put on sale is not stated, but the listing was last updated on 3 September 2019;
- A “deluxe” whelping box sold by the applicant for £385. The listing was started on 3 September 2017 and last updated on 27 August 2019; and
- A “deluxe” whelping box sold by the applicant for £275. The listing was started on 1 August 2018 and last updated on 27 August 2019.

8. In addition, the applicant filed with her application against the 116 design an undated print out from her company’s website, showing a range of whelping boxes on sale.

9. The registered proprietor submitted evidence with his defences. These are undated photographs showing details of the boxes, some of the representations from the registration and an image of the logo shown on the box. Mr Knights also filed small models of a whelping box and of one corner post with two side pieces, intended to demonstrate how the box is assembled and the differences between his designs and those of the applicant. The models were filed in support of both defences. They are shown in the images below:





10. The applicant submitted further evidence. In her witness statement, which was signed on 20 December 2019, Ms Gillespie says that she is the creator and proprietor of the prior designs for whelping boxes and has been selling them from a retail store in Sunderland, her website and online marketplaces (eBay and amazon) since 10 July 2012.

11. The exhibits are the same for both invalidity applications, except in the case of Exhibit DG-B. I shall not reproduce images here, but will do so if appropriate later in my decision. The exhibits are as follows:

- Exhibit DG-A is a set of undated photographs of the corner post Ms Gillespie says is used in her designs;
- Exhibit DG-B contains undated images of the respective earlier designs. Ms Gillespie states that these show “the Whelping box can produce the same over all appearance by changing component parts which the design is made up from and locking them into place”;
- In Exhibit DG-C, Ms Gillespie provides images comparing the representations of the corner post from the contested registrations and the model submitted by Mr Knights. She submits that these are different;
- Exhibit DG-D contains an undated print-out from her website which appears to be identical to the print-out to which I referred in paragraph 8 above;

- Exhibit DG-E is correspondence dated 9 October 2019 from Humphreys & Co Solicitors, acting for Warwick UPVC Limited and Ms Gillespie, to Cameron Intellectual Property, acting for Mr Knights. It concerns the alleged infringement of Ms Gillespie’s registered designs and refers to a previous decision of this Tribunal involving designs owned by Ms Gillespie (BL O/262/12);
- Exhibit DG-F is an undated print-out from puppylovewhelpingpens.co.uk. Ms Gillespie draws my attention to page 6 which shows instructions for how to assemble the whelping box. She submits that this shows a completely different corner post system from the one shown in the contested designs. The following exhibit, DG-G, is also an extract from that website and shows a contact telephone number. Ms Gillespie says that she has verified that this is the same number as Mr Knights’s;
- Exhibit DG-H is a print-out from www.watchout.com showing an eBay listing for a plastic puppy whelping box sold by the registered proprietor for £75. The listing started on 17 March 2018, which Ms Gillespie notes is 17 months before the application date of the contested designs;
- Exhibit DG-I is an email dated 9 November 2018 from Mr Knights to Warwick Whelping Boxes asking why they approached eBay to have his pens removed from the site. He states that he has not copied the designs and asks what changes Warwick Whelping Boxes would like him to make so he can continue to list his products on eBay; and
- Exhibit DG-J is another undated print-out from puppylovewhelpingpens.co.uk. On this one, the images of the products are visible.

Decision

Legislation

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

“The registration of a design may be declared invalid –

...

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act”.

13. Section 1B of the Act is 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 or no 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 account.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if –

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if –

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons

carrying on business in the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above ‘the relevant date’ means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

...”

The contested designs

14. The applicant has submitted that the whelping boxes sold by the registered proprietor differ from the contested designs, particularly with respect to the corner post. I also note that the model filed by the registered proprietor includes a removeable

panel which is not shown in either registration. I shall therefore begin my decision by considering what is protected by the contested designs.

15. It is the representations of the designs that show what is protected. In *Magmatic Ltd v PMS International Ltd*, [2016] UKCS 12, Lord Neuberger (with whom the rest of the Supreme Court agreed) held that:

“...As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, ‘[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs’. So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.”¹

16. For both contested designs, they consist of line drawings of boxes. In *Procter & Gamble Company v Reckitt Benckiser (UK) Limited*, [2007] EWCA Civ 936, the Court of Appeal determined that, where the representations were black-line-on-white illustrations showing a plain undecorated spray can, the registration was “evidently” for shape and that a comparison should be limited to the respective shapes only.² In my view, the representations of the contested designs show the shape of the products and horizontal lines which suggest a panelled construction.

17. At this point, I note that, although the 116 design is described as a *Plastic whelping box with door*, no door is shown in the representations. In *Procter & Gamble*, Jacob LJ stated that care had to be taken that any physical object is a true reproduction of the design.³ As the model contains a removeable panel not present in the registration, I shall consider it no further.

¹ Paragraph 30.

² Paragraph 40.

³ Paragraph 12.

Prior art

18. The contested designs must be compared with designs that have been made available to the public before the relevant date (11 August 2019), unless those designs have been disclosed in one of the ways set out in section 1B(6) of the Act. The applicant's two registered designs were published before the registered proprietor filed the applications for the contested designs and so they count as prior art. Turning to the rest of the applicant's evidence, I note that much of it is undated. Although there are dates on the eBay print-outs indicating when the products were first listed for sale, the fact that these listings also state that they were last updated after the relevant date means that it is not possible for me to see what had been disclosed to the public before that date. The extent of the amendments to the listings is unknown.

19. The applicant submits that, as shown by Exhibit DG-H, the registered proprietor had been selling whelping boxes on eBay 17 months before the relevant date and that, according to section 1B(6)(c) of the Act, these disclosures are not exempt and the registered proprietor has himself destroyed any claim to novelty and individual character. The image of the box in question is reproduced below. From this angle, there appear to be similarities between the box shown in the image and the contested design. However, only one view has been submitted and it is small and not entirely clear. In addition, it must be noted that the applicant did not plead that the registered proprietor had disclosed the contested design over 12 months before the date of application, and so I can give this no further consideration.



Do the contested designs have novelty and individual character?

20. According to section 1B(2) of the Act, a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”⁴

21. Section 1B(3) states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. In *Ball Beverage Packaging Europe Ltd v EUIPO*, Case T-9/15, the General Court (GC) said:

“According to the case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (judgments of 7 November 2013, *Budziewska v OHIM – Puma (Bounding feline)*, T-666/11, not published, EU:T:2013:584, paragraph 29, and of 29 October 2015, *Roca Sanitario v OHIM – Villeroy & Boch (Single control handle faucet)*, T-334/14, not published, EU:T:2015:817, paragraph 16).”⁵

⁴ Paragraph 26.

⁵ Paragraph 78.

22. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court, set out the correct approach to assessing individual character as follows:

“53. The exercise must start with identifying the informed user and the existing design corpus. The overall impression is something produced on the informed user.

54. Although the outcome depends on overall impression, as a practical matter the design must be broken down into features. Each feature needs to be considered in order to give it appropriate significance or weight. Each feature needs to be considered in three respects. A feature dictated solely by function is to be disregarded. As long as it is not disregarded, each feature must be considered against the design corpus and it must be considered from the point of view of design freedom.”

23. Earlier in the same decision, the judge gave the following description of the informed user:

“33. ... 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-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 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);

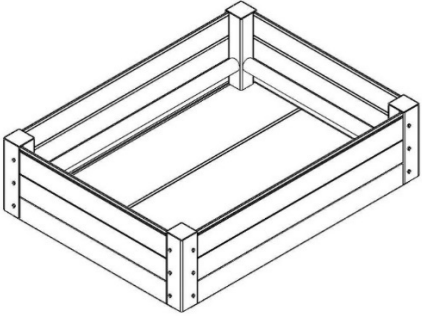

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59)."

The 115 design

24. The contested designs and relevant prior art are shown in the table in the Annex to this decision. It will be seen that the earlier designs appear in a variety of configurations. In my view, they are best seen as complex products, defined in section 1(3) of the Act as "a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product". When making my comparison, I bear in mind how the products would be seen in conditions of normal use and the principal representations that I shall use are shown in the table below. However, I shall also take account of the other representations as appropriate.

25. I shall begin by considering the 115 design.

Contested Design	Prior Art
<p data-bbox="204 253 451 286">The 115 design:</p> 	<p data-bbox="809 253 1294 286">Registered design no. 4025572:</p> 

26. The 115 design has the following features:

- i) a rectangular base constructed from three long panels;⁶
- ii) four straight sides rising at right angles from the base and joined at the corners of the base;
- iii) the appearance that the sides have been constructed from three panels arranged horizontally and with the same appearance outside and inside the box;
- iv) four cuboid posts at each corner with what I take to be a form of fixing aligned with each panel;
- v) cylindrical rails along each internal wall, with each end placed in a hole on one of the inner faces of the corner post;
- vi) the appearance of no, or very little, distance between these rails and the internal walls.

27. The 572 design has the following features:

- i) a rectangular base in a single piece;
- ii) the base protruding beyond the sides of the box;
- iii) four straight sides rising at right angles from the base and joined to make corners;

⁶ This can be seen in the representations in the Annex.

iv) from the outside, the appearance that the sides are constructed from three panels arranged horizontally, with a thinner panel at the top, but looking smooth inside;

v) pieces at the outside of the corners which give the appearance of corner posts and have a squarish piece at the top. There is no inner support. At the bottom of these mock posts are two forms of fixing; at the top, there is one. These fixings are the same colour as the rest of the box;

vi) two thin rails attached to the front and back, with another rail at the back in the form of a crossbar. The position of the fixing suggests that these are bolted onto the front and back of the box;

vii) a small, but noticeable, distance between the rails and the internal walls.

28. In my view, there are more than immaterial differences between the designs. The rails, for instance, are different in size and arrangement in the box, one of which has corner posts while the other does not. I find that the existence of the earlier design does not defeat the contested design's claim to novelty and will go on to consider the question of individual character, which I recall should be assessed through the eyes of the informed user.

29. The applicant submits that the informed user of whelping boxes is a dog breeder. I agree. The informed user will be aware of the features normally included in whelping boxes and of the design corpus. While Ms Gillespie has filed evidence showing a range of boxes, most of these are undated, and so I am unable to find that they made up part of the design corpus at the date of filing of the contested designs. Consequently, this factor can play no part in my decision.

30. I shall begin with the shape of the box. Although it is possible for a box to be another shape (such as circular), they tend to be square or rectangular, with a flat base. Both designs consist of a rectangular box with four straight sides, but in my view this feature does not play a significant role in my assessment of the overall impression of the two designs.

31. I move on to the panel construction. Here, the designer has a greater degree of freedom. The sides may be constructed from a single piece, giving a smoother

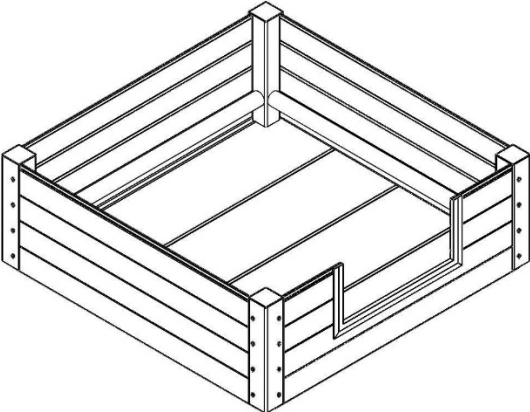
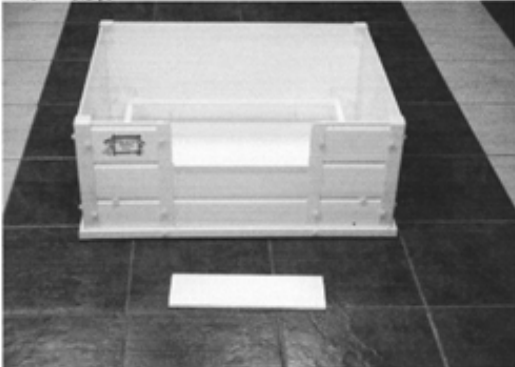
appearance. Indeed, the base of the earlier design is one piece and the sides are smooth internally, panelled externally, in contrast to the 115 design which is panelled on both sides and the base. The protruding base and narrow panel at the top of the earlier design are a further point of difference. The panels are ranged horizontally in both cases. The appearance of the sides of the box is, in my view, be a significant feature.

32. While the 115 design has corner posts, the earlier design possesses what initially appear to be corner posts, but closer inspection reveals that inside the box there is merely a top piece on each corner, with nothing supporting it. The designer has the freedom to decide whether to have posts at all, and, if so, their shape and size. To my mind, they are a significant feature of the 115 design, when compared with the earlier design.

33. Both designs contain cylindrical rails, but their size and positioning are different. The designer has freedom here too. The purpose of the rails is to stop the mother inadvertently crushing the puppies against the sides of the box, but the designer can choose the size of them, their configuration and how they are attached to the box. The rails are a significant feature in whelping boxes.

34. I have found that the designs are similar in some way and different in others. The most important of the similarities is the panelled appearance of the outside of the boxes. The rectangular shape of the box is not particularly significant. However, in terms of the overall impression of the designs, I consider that the similarities would be outweighed by the differences in the corners and the puppy rails. Consequently, I find that the 115 design has individual character in comparison with the 572 design, and shall remain on the register.

The 116 design

Contested Design	Prior Art
<p data-bbox="204 365 448 398">The 116 design:</p> 	<p data-bbox="810 365 1294 398">Registered design no. 4016965:</p> 

35. The 116 design has the following features:

- i) a square base constructed from four long panels;⁷
- ii) four straight sides rising at right angles from the base;
- iii) a rectangle cut out at the top centre of one of the sides;
- iv) the sides appear to be constructed from four panels arranged horizontally and with the same appearance outside and inside the box;
- v) four cuboid posts at each corner with what I take to be a form of fixing aligned with each panel;
- vi) cylindrical rails along each internal wall, with each end placed in a hole on one of the inner faces of the corner post;
- vii) the appearance of no, or very little, distance between these rails and the internal walls.

36. The 965 design has the following features:

- i) what appears to me to be a square base;
- ii) the base protruding beyond the sides of the box;

⁷ This can be seen in the representations in the Annex.

- iii) four straight sides rising at right angles from the base and joined to make corners;
- iv) from the outside, the appearance that the sides are constructed from four panels arranged horizontally with a thinner panel at the top, but looking smooth inside;
- v) the division of the front into three sections, separated vertically by bands. In the larger central section, the top panel is removable. On either side of this section are two narrower columns of three panels;
- vi) pieces at the outside of the corners which give the appearance of corner posts and have a squarish piece at the top. There is no inner support. At the bottom of these mock posts there can be seen fixings at the top and bottom in the same colour as the rest of the box;
- vii) fixings on either side of the front just above the lowest panel;
- viii) two thin rails attached to the front and back, with another rail at the back in the form of a crossbar. The position of the fixings mentioned in (vii) suggests that these are bolted onto the front and back of the box;
- ix) a small, but noticeable, distance between the rails and the internal walls.

37. The points that I made in paragraph 28 above regarding the differences between the 115 and the 572 designs also apply to this comparison: the rails and corners are different. In addition, the external appearance of the designs is not the same. Each side of the contested 116 design appears to be constructed from four equal-sized panels arranged horizontally, while the 965 design has three horizontal panels plus the narrower panel at the top. On the front of the box there are also vertical bands. In my view, these differences are more than immaterial and so the earlier 965 design does not defeat the contested design's claim to novelty.

38. Turning to the assessment of individual character, my findings in paragraphs 30, 32 and 33 above also apply here. In the paragraph above, I noted the differences in the panelled appearances of the designs. Both have chosen panels but the numbers and widths differ, and the vertical bands on the 965 design are another instance of the designer exercising their freedom. While the appearance of the sides of the box is a significant feature, I find that there is a greater degree of difference between the designs than there was in the earlier comparison.

39. Finally, the 116 design contains a gap in the top of one of the sides. I can see that this would make access to the box easier, but the designer does have some degree of freedom with regards to the size and position of that gap. In the 965 design, it is slightly shallower, but in the same position, i.e. the centre of one of the sides. However, the applicant has chosen to include a removable piece that would fill the gap. The registered proprietor, on the other hand, has provided no way of filling the gap. In my view, this is a significant difference.

40. The most important similarity between these two designs is that they are both similar-shaped boxes. However, I noted earlier that boxes tend to be four-sided with a flat base, and so this similarity does not outweigh the differences between the designs, most significantly in the corner posts and puppy rails. Consequently, I find that the 116 design has individual character in comparison with the 965 design, and shall remain on the register.

Outcome

41. Registered design numbers 6068115 and 6068116 will remain registered.

Costs

42. The registered proprietor has been successful and would be entitled to a contribution towards his costs. As he is a litigant in person, the Tribunal invited him to complete a proforma detailing the time spent on a series of activities associated with the proceedings. As he did not return this proforma, I make no award of costs.

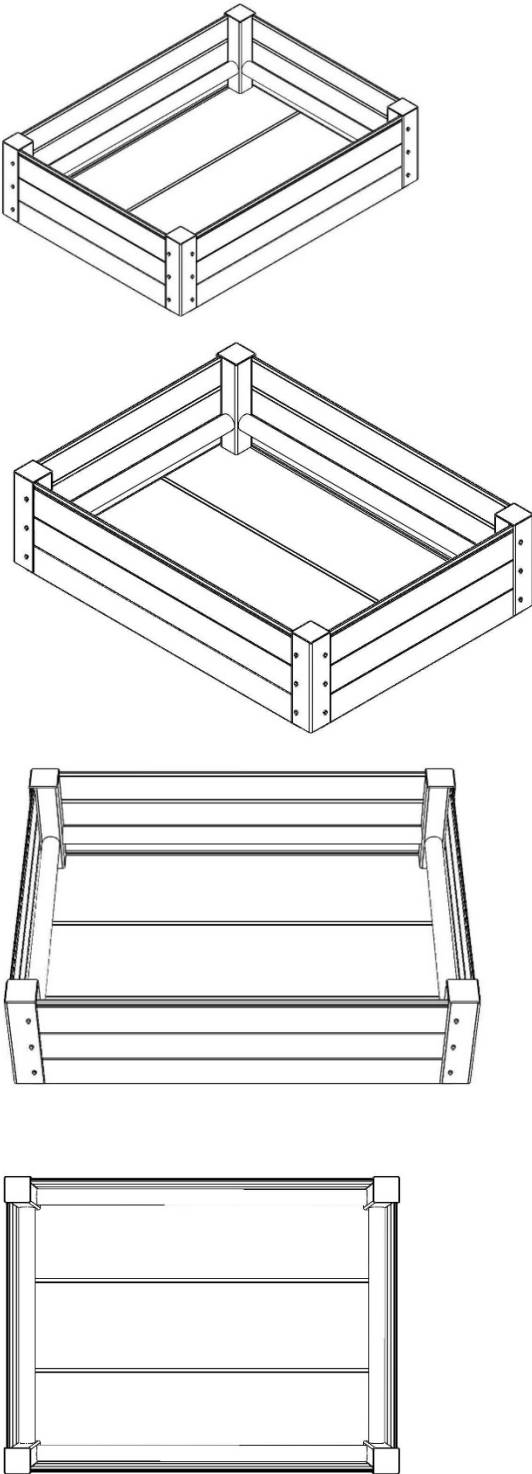

Dated this 12th day of October 2020

Clare Boucher

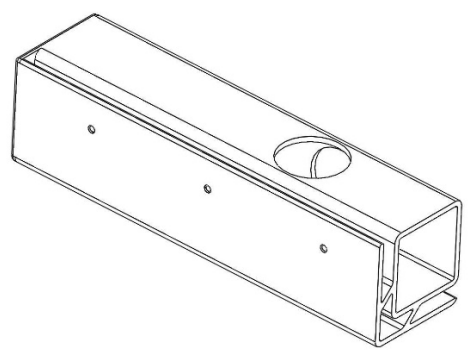
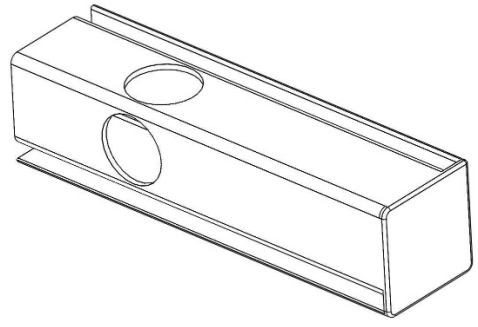
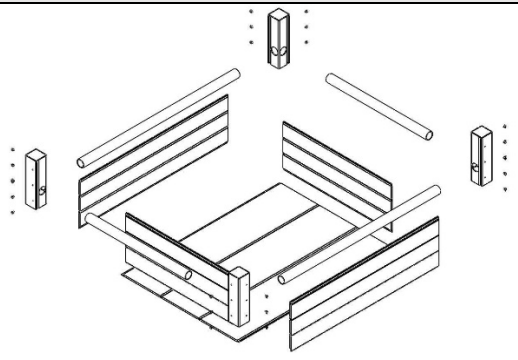
For the Registrar,

The Comptroller-General

Annex

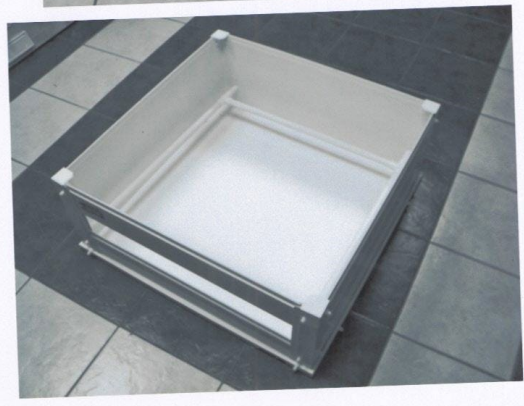
Contested Designs	Prior Art
<p data-bbox="204 374 451 412">The 115 design:</p> 	<p data-bbox="762 374 1246 412">Registered Design No 4025572:</p>  <p data-bbox="879 931 1310 954">SHOWN WITH INTERCHANGEABLE SOLID FRONT PANELS</p>

Contested Designs

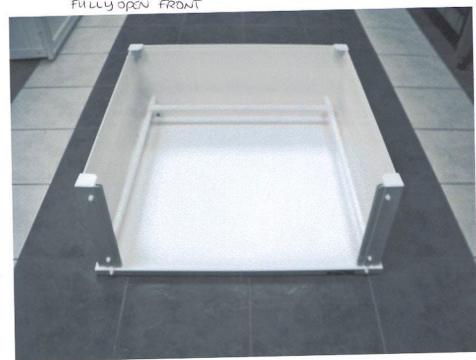


Prior Art

SHOWN WITH INTERCHANGEABLE CLEAR FRONT PANEL 4025572 J

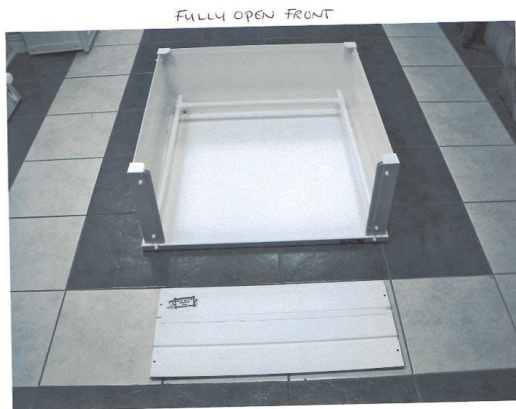


FULLY OPEN FRONT

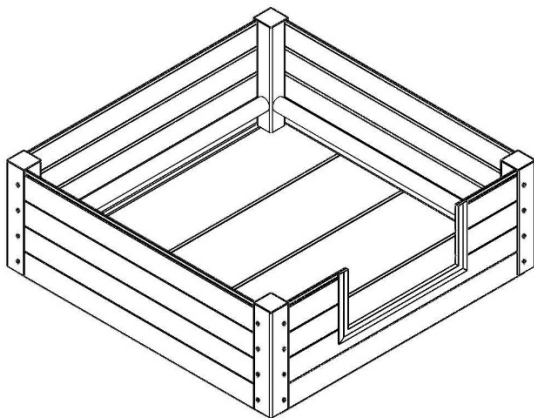


Contested Designs

Prior Art



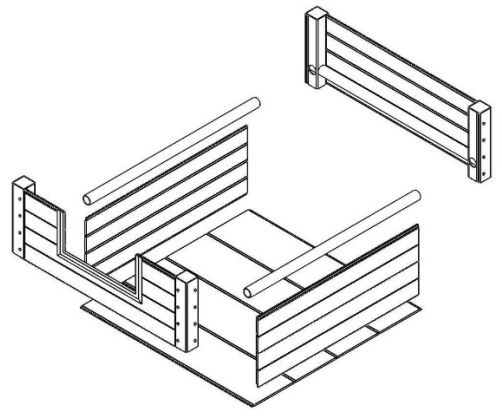
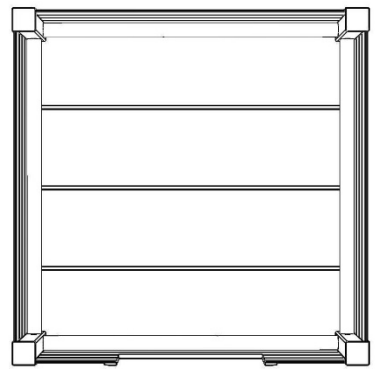
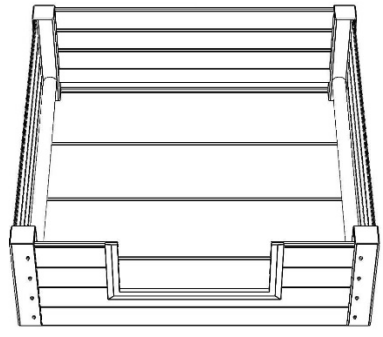
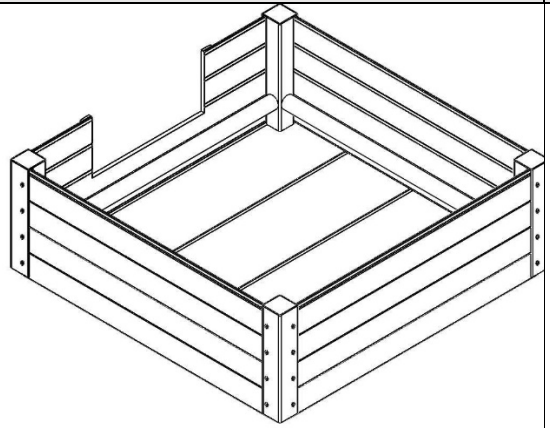
The 116 design:



Registered design no. 4016965:



Contested Designs



Prior Art

WHELPING BOX PAGE 2 OF 5



FRONT VIEW OF WHELPING BOX WITH SECTIONS REMOVED



OVERVIEW - ABOVE VIEW SHOWING TOP SECTIONS AND RAILS

WHELPING BOX PAGE 4 OF 5

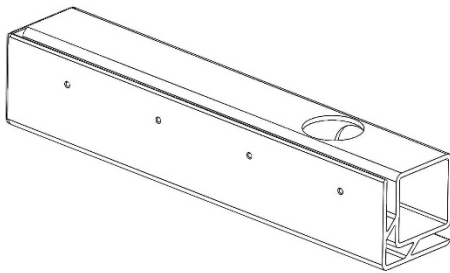
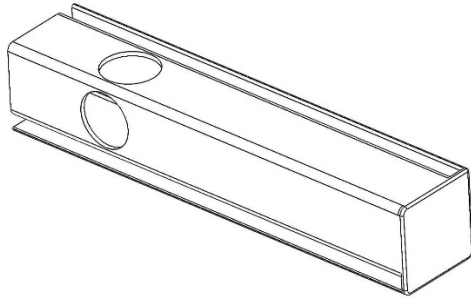


REAR VIEW



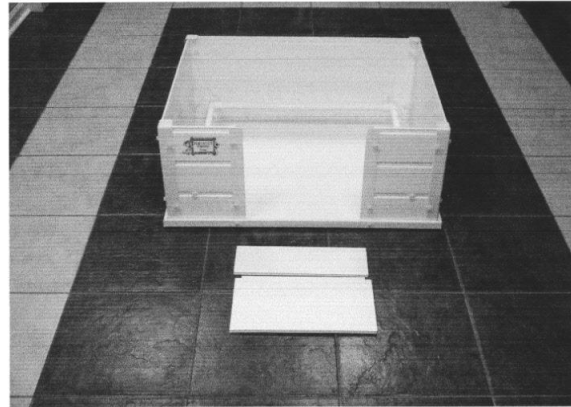
FRONT VIEW 1 SECTION INSTALLED

Contested Designs



Prior Art

WHELPING BOX PAGE 3 OF 5

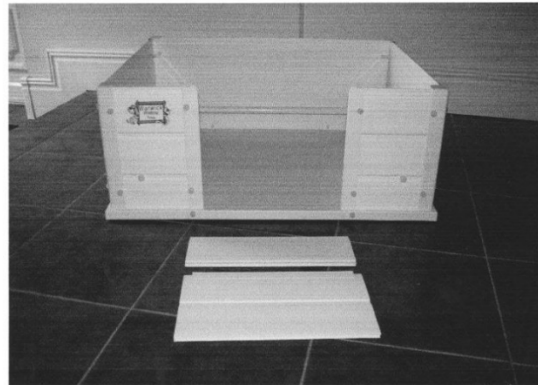


FRONT VIEW WITH REMOVEABLE SECTIONS SHOWN



FRONT OVERVIEW WITH DOOR SECTIONS REMOVED
RAILS INSTALLED

WHELPING BOX PAGE 5 OF 5



FRONT VIEW DETAILING REMOVEABLE DOOR SECTIONS