

O-074-09

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGNS 4002803-4002815**

**IN THE NAME OF WITTAYA ASAWASUWANNAKUL**

**AND**

**APPLICATIONS FOR INVALIDATION (05/07-17/07)**

**BY BLACKBERRY INTERNATIONAL LIMITED**

## **REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF Registered designs 4002803-4002815  
In the name of Wittaya Asawasuwannakul**

**and**

**Applications for invalidation (05/07-17/07)  
By Blackberry International Limited**

### **Background**

1. Applications were made by Blackberry International Limited ("*Blackberry*") in June 2007 to invalidate all of the above registered designs on the grounds that they were not new at the date of their application. Given the nature of the statements of case/counterstatements together with the respective evidence and submissions, I take the cases to also relate to whether the registered designs possess individual character. All of the designs are for some form of ladies clothing and they all stand in the name of Wittaya Asawasuwannakul ("*WA*").

2. *Blackberry* filed evidence in support of its applications. The matter then came to be heard before me on 9 December 2008 where *Blackberry* were represented by Mr N Burrett, its managing director. *WA* did not attend the hearing, nor did he file written submissions in lieu of attendance. However, I will take into account *WA*'s submissions that were made in his counterstatements.

3. Although not formally consolidated, the applications for invalidation have, from a procedural point of view, been dealt with together. I will, therefore, issue one decision covering all thirteen applications for invalidation. However, the decision will be broken down when it comes to my substantive findings.

### **Evidence**

4. Each set of proceedings follows a similar pattern. After the initial claims and counterclaims, *Blackberry* filed evidence<sup>1</sup> to support its claim. In each case, evidence is provided showing an article of clothing (I will refer to this as "the prior art") which is said to have been made available to the public prior to the application date of *WA*'s designs; *Blackberry* considers that the designs disclosed in the prior art are no different from the overall impression of the particular design it seeks to invalidate. I will provide more detail about the prior art later in this decision.

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<sup>1</sup> In each case, *Blackberry*'s evidence (including its reply evidence) is by way of witness statement from its managing director, Mr Burrett.

5. WA did not file any evidence but instead provided further counterstatements aimed at highlighting the differences between his designs and the designs disclosed in the prior art. He also argues that because *Blackberry's* evidence comes from the Internet and that such material is easily altered, there are questions as to the reliability of the dates on which *Blackberry* claims that the relevant prior art was made available to the public.

6. In response to WA, *Blackberry* filed reply evidence, mostly providing submissions on the differences between the respective designs and the relevant prior art. The evidence also confirms the truth and accuracy of the original statements and, in some cases, provides further evidence to corroborate the dates on which the prior art was made available to the public. In three cases, further prior art is provided. WA did not seek to file further evidence or submissions in response to any of this.

7. The prior art and the respective submissions will be summarised in more detail when I give my findings on each of the designs. Nevertheless, I include one comment this stage in order to deal with WA's submission that Internet material can be easily altered. WA has not highlighted any particular part of the evidence which may have been altered, nor has he requested that Mr Burrett be cross-examined in order to test his evidence. In the absence of this, and in the absence of any evidence of doctoring or tampering, I will accept *Blackberry's* evidence for what it is. However, what I can take from the evidence in relation to the grounds for invalidation (both in terms of placing the prior art prior to the application date of the registered designs, and on whether the prior art differs from the overall impression of the designs) is a matter for me to decide based on the parties submissions and the relevant legislation and case-law.

### **The relevant legislation**

8. The application to register the thirteen designs was made on 16 April 2007. This means that the applications were made under the provisions of the Registered Designs Act 1949 as amended by the Registered Design Regulations 2001 ("the Act"). Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B reads:

- "(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.
- (3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user

differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

- (4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.
- (5) For the purposes of this section, a design has been made available to the public before the relevant date if-
  - (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
  - (b) the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
  - (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
  - (b) 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.
- (8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –
  - (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
  - (b) to the extent that those visible features of the component part are in themselves new and have individual character.
- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

### **The legal principles and case-law**

9. The approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

- a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.
- b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.
- c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the product (or products) in question; imperfect recollection has little role to play.
- d) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- e) Functional requirements should also be taken into account when assessing the overall impression created by the designs;
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality;

10. In assessing the attributes of the “informed user”, I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

“First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the articles and both counsel roundly rejected the candidature of “the man in the street”.

“Informed” to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of “what’s about in the market?” and “what’s been about in the recent past?”. I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any).

In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

11. I also note that this approach to the matter was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch) and later accepted as appropriate by the Court of Appeal.

## **Application of the legal principles**

### *The informed user*

12. Before looking at the registered designs and the prior art in more detail, I must firstly assess who the “informed user” is likely to be. All of the registered designs relate to some form of ladies clothing. The informed user must, as the name suggests, be a user of the items. This person must, therefore, be a consumer as opposed to an actual designer or some other expert in the field. However, the informed user is not an average or standard consumer, it is instead someone who is likely to have a keen interest in design matters in this field. Such a person is, therefore, likely to have a keen eye in relation to the design attributes of a particular item of clothing. Such a person will not appreciate a design at a high level of generality, but nor will they make a forensic analysis of each and every detail.

### *The material date*

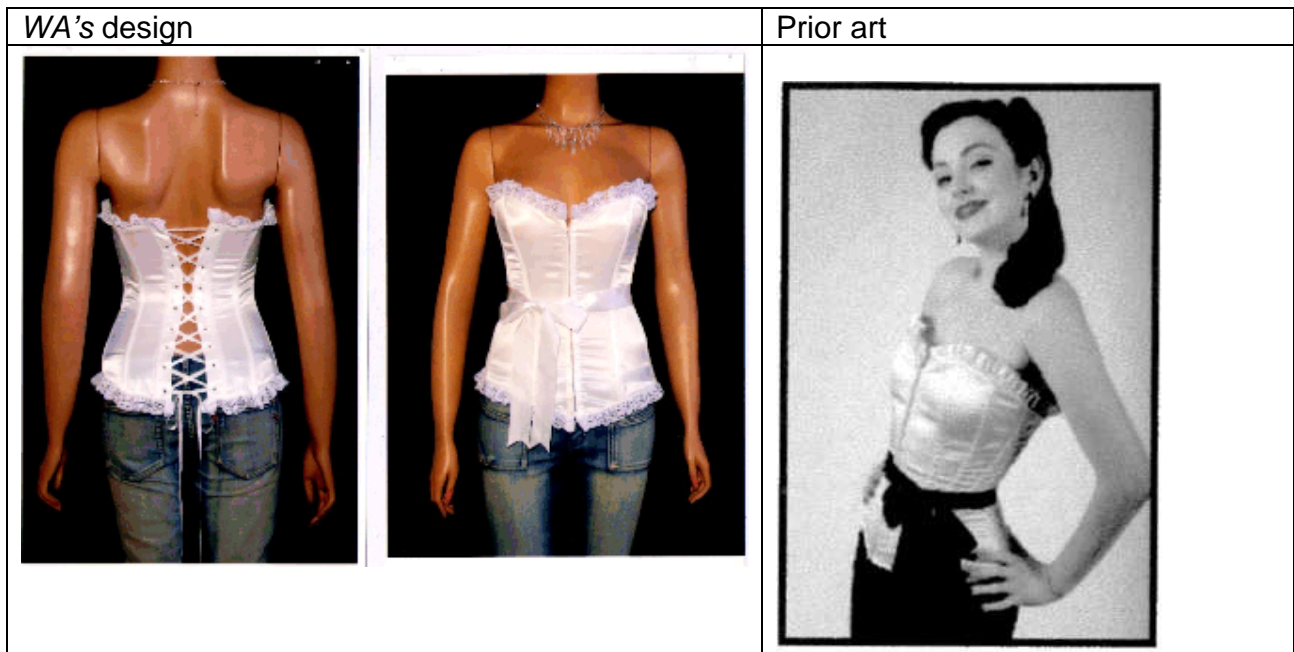
13. According to section 1B(7) of the Act, prior art can only be relied on to invalidate a registered designs if it has been disclosed to the public prior to the application date of the registered design. This means that the material date for my assessment is 16 April 2007; any prior art must have been made available to the public prior to this date.

### *My approach*

14. I will assess each of the applications for invalidation in turn. In each case, I will detail the registered design itself together with the prior art relied on. I will then give my findings on whether the evidence places the prior art before the material date and then make further findings, if necessary, as to whether the prior art results in the registered design being classed as not new or lacking individual character. When carrying out this latter task, I will state what I believe the informed user will regard as the overall impression of the registered designs and the prior art or, at least, identify what design characteristics contribute to the overall impression of the design from the viewpoint of the informed user. It should also be noted that the representations shown in this decision have been scanned in, therefore, there is an inevitable loss of image quality. I have, however, made my decisions based on the representations on the official file.

**REGISTERED DESIGN 4002803 – INVALIDATION APPLICATION 5/07**

15. The registered design and the prior art are depicted below:



*The prior art*

16. The prior art is said to be part of a collection sold by *Diva Corsets*. The item of clothing is said to have been first made available for sale (by *Diva Corsets*) on 20 January 2006. The prior art consists of an Internet print from the *Diva Corsets* web-site (further images are presented but they are much smaller) but the print carries no date. In response to *WA's* challenge to the reliability of this evidence, further evidence is presented by *Blackberry*. This consists of an exchange of e-mail between Mr Burrett of *Blackberry* and a person called "Nench" from *Diva Corsets*. Mr Burrett asks "Please can you let me know the date that these two corsets were designed and the first date they were made available for sale". The reply given is "20/1/2006".

17. Before comparing the designs, I need to decide whether the evidence is sufficient to prove that the prior art was made available to the public prior to the material date. Mr Burrett's evidence presents a number of problems. Firstly, Mr Burrett, the evidence filer, has no personal knowledge of when the prior art was published. The person who has given Mr Burrett this information has not filed



evidence in the proceedings and the evidence must, therefore, be regarded as hearsay. This means that a lesser degree of weight can be placed upon it.

18. The above problems are compounded by the fact that the answer by Nench to Mr Burrett's question is ambiguous. I say this because Mr Burrett asked two questions, the first relating to the date of design and the second relating to the date of being first placed on sale. However, only one date (albeit a date before the material date) is given in reply. At the hearing, Mr Burrett suggested that a composite answer was given to indicate that the date was the date by which time the garment had been designed and put on sale, in other words, the date was the date of first sale with the design having been created prior to this. Mr Burrett's suggestion may be correct, but the fact remains that this is just a suggestion and the simple answer is that we do not know what Nench meant. Given this ambiguity, and given that the evidence is, in any event, hearsay, I am not prepared to accept that the evidence proves that the prior art was made available to the public prior to the material date. To find otherwise would require me to make a quite significant inference on the basis of hearsay evidence. I am not prepared to do so. A registered design is an intellectual property right protected by statute and owned by WA; it should not be invalidated on the basis of speculation and suggestion. **The application for invalidation fails because it has not been proven that the publication of the prior art took place before the material date.**

#### *Comparison of the design and the prior art*

19. Irrespective of the above, I will still give my views of the competing designs in case I am found to be wrong (on appeal) on the above. WA highlights that the hems of his design are ruffled with lace whereas the prior art is ruffled with satin; that there is more boning in the prior art compared to his own design and that the sash of his design is made from ribbon whereas the prior art is made of satin. *Blackberry* say that a change of material (the ruffle and the bow) cannot change the overall impression nor would adding extra boning; indeed, at the hearing, Mr Burrett argued that the amount of boning in the design is not that clear and they could be the same.



20. On one level, the overall impression could be described as the same in that both designs are for boned corset style tops with a bow at the waist. However, such an analysis would, in my view, have to be made at a very low level for this to constitute the only elements of the designs that would contribute to the overall impression on the informed user. Instead, there are other features that, when assessed properly through the eyes of the informed user, would also be taken into account.

21. The registered design clearly has a full length opening at the back which has cross lacing. This feature forms part of the overall impression of the registered design but does not appear to be a feature of the prior art (it certainly cannot be seen in any of the representations on file). Furthermore, whilst I agree with

*Blackberry* that a mere change of material is unlikely, in itself, to create a difference in overall impression, the change of material in the hems has an impact on design; the registered design having a frilly lacy style at the top and bottom of the garment whereas the prior art has a ruffled effect at least at the top of the garment (the bottom is not clear). Furthermore, whilst the difference in positioning of the bow (left hand side in the registered design/right hand side in the prior art) is unlikely to be significant, nor is any material change, the contrast in colour between bow and top in the prior art against the bow and top being the same colour in the registered design are, again, features that I consider to form part of the overall impressions of the designs on the informed user and, consequently, contributes to create a different overall impression. Overall, I am left with the view that there are clear differences between the respective overall impressions. **The invalidation also fails on this point, in comparison to the prior art, the registered design is new and has individual character**

**REGISTERED DESIGN 4002804 – INVALIDATION APPLICATION 6/07**

22. The registered design and the prior art are depicted below:

WA's design	Prior art
	

*The prior art*

23. The prior art is taken from the front cover of an edition of *Vogue* magazine that is said to have been published in 1995. It depicts the model Kate Moss wearing a black, roll neck jumper. The evidence initially provided does not show the date on the front cover. However, in response to *WA's* challenge to the reliability of this evidence, Mr Burrett provided further evidence consisting of a print from the *Vogue* web-site showing the same front cover, but this time with a clear indication that it was circulated in October 1995. Taking this into account, **the evidence is sufficient to prove that the claimed prior art was made available to the public prior to the material date. It must, therefore, be taken into account.**

*Comparison of the design and the prior art*

24. The differences that *WA* highlights are that the roll neck goes much higher in the prior art compared to his design, that the sleeves are longer in the prior art compared to the design (particularly bearing in mind that the sleeves are ruffled in the prior art) and, finally, that there are differences in the stitching of the respective garments. *Blackberry* argue that these differences are so small that the overall impression is no different and, in any event, the differences in neck height and sleeve length may be more to do with the wearer (having longer or shorter arms) rather than the garments themselves. In relation to the stitching, it is observed that this is not visible in the respective representations. At the hearing, Mr Burrett summarised the position by stating that the overall

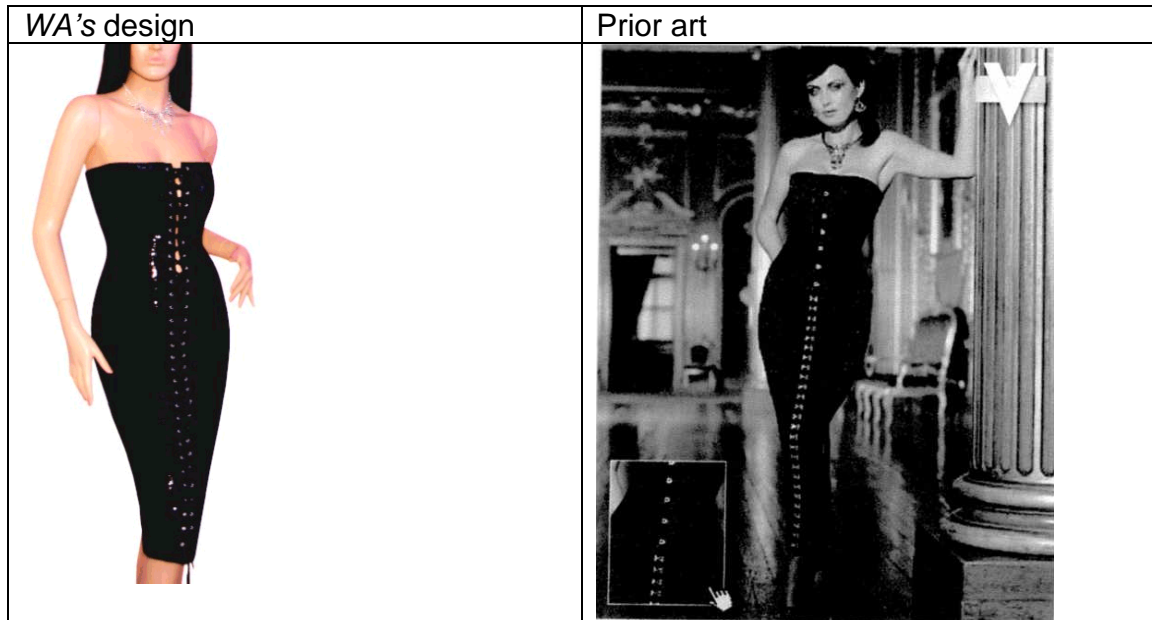
impressions were the same, namely, they are both simple black tops with a roll neck.

25. I am in full agreement with *Blackberry's* submission regarding the stitching. Neither the representation of the registered design nor the prior art show any form of visible stitching. If stitching (or a pattern of stitching) is to be regarded as a design feature then it must be clearly depicted. It is not. I cannot, therefore, take what *WA* says into account on this point when deciding whether there are differences in overall impression.

26. The other differences, however, require further analysis. I can see what may be a difference in relation to the neck height and sleeve length as highlighted by *WA*, however, I also understand *Blackberry's* submission that this may be more to do with the anatomical qualities of the wearer rather than a difference in design. Regardless of which argument is correct, the question still comes down to whether these differences, if they are differences, are immaterial (not new) or do not clearly differ in overall impression (no individual character). I come to the conclusion that the impact of these differences would be so small on the informed user that they would hardly be noticed at all, as such, I find that the differences are immaterial. Even if the differences were noticed by the informed user, such small details would not contribute to a difference in the overall impression of the respective designs. I am, therefore, left with the overall impression on the informed user of both designs being simple black roll neck jumpers with long sleeves. **Therefore, the ground for invalidation succeeds because the registered design is not new nor does it possess individual character.**

**REGISTERED DESIGN 4002805 - INVALIDATION APPLICATION 7/07**

27. The registered design and the prior art are depicted below:



*The prior art*

28. Mr Burrett states that the design depicted in the prior art has been available for sale by *Vollers* having been first designed in 1899 and published in one of their books prior to the material date. To support his claim he exhibits an extract from *Vollers'* web-site and an extract from the aforementioned book. Neither extract carries any form of date. I find the lack of corroborative information to support the date to be a concern. *WA* challenged the reliability of the date, but no further information has been presented to meet this challenge. At the hearing, Mr Burrett stated that the date was correct to the best of his knowledge, but he also conceded that *Vollers* have been modifying the design over time, although, he also said that the designs were essentially the same.

29. Whilst I have no reason to doubt Mr Burrett's belief, his challenged evidence is not sufficient to prove that the prior art was made available to the public prior to the material date without any form of corroborative evidence. Indeed, even if I accepted that the *Vollers* dress had been available for sale since 1899, it would not be clear whether this relates to the prior art as presented in evidence or to some other form of the *Vollers'* dress; this highlights the problem. **The application for invalidation fails because it has not been proven that the publication of the prior art took place before the material date.**

### *Comparison of the design and the prior art*

30. Irrespective of the above, I will, again, give my views on the competing designs in case I am found to be wrong on the above. *WA* highlights that the fastening on the back of the dresses differs. He also highlights that his design uses ribbon lacing through eyelets on the front and that it is closed tightly at the bottom and more open at the top whereas the prior art has a different fastening mechanism and is closed tightly from top to bottom.

31. *Blackberry* say that the back fastening is irrelevant because this is not depicted in either representation and that the method of fastening on the front does not change the overall impression of the designs. At the hearing, Mr Burrett described the overall impression of both the design and the prior art as a full length corset dress with a full length lace up/eye fastened corset; the difference in fastening being immaterial. Firstly, I must signal my agreement with *Blackberry* regarding the fastening mechanism at the back of the dresses. This feature cannot be seen in either design and I cannot, therefore, consider it to be part of the overall impression of either of them.

32. When comparing the designs of the two dresses, it is clear that the outline shapes are very similar, that they have similar bust lines, and both have a figure hugging characteristic. The question really centres on the difference created by the different fastening mechanisms that run the full length of both dresses and what contribution, if any, this makes to the overall impressions of the designs. It goes without saying that the fastening devices contribute something to the overall impressions of the dresses, they are clearly present and, in fact, form the single most striking design feature about them. But does the difference between the fastening devices create different overall impressions?

33. In my view, the overall impression on the informed user of *WA*'s design is a  $\frac{3}{4}$  length dress with horizontal bust line incorporating a cross laced (through eyelets) fastening mechanism running the full length of the dress; the bottom half of the dress being laced tighter than the top. The overall impression of the prior art on the informed user is likely to be of a full length dress with horizontal bust line that is fastened tightly through its full length with one type of fastening device through the top half and a different type through the bottom half. I do not consider the differences to be immaterial, even though the fastening devices are essentially functional in nature, they nevertheless contribute significantly to the design characteristics of the dresses. I have described the overall impressions differently. The lacing style as opposed to an eye fastening style creates one clear difference with a further difference created by the use of two different fastening mechanisms utilised in the prior art. These factors, on their own, are sufficient to create a clearly different overall impression. However, the differences are strengthened by the looser lacing at the top of *WA*'s design which creates a

slightly opened look. Whilst I note *Blackberry's* argument that this aspect should be ignored because the lacing could be tightened if the wearer so wishes, the design as registered, nevertheless, depicts a loose lacing style and this must be taken to contribute to its design characteristics. **The invalidation fails on this point, in comparison to the prior art, the registered design is new and has individual character.**

**REGISTERED DESIGN 4002806 - INVALIDATION APPLICATION 8/07**

34. The registered design and the prior art are depicted below:



*The prior art*

35. The prior art relates to an article of clothing that *Blackberry* has designed themselves and made available for sale on the Internet auction web-site *eBay.co.uk*. The garment sold is a roll neck “dress/top”. Categorisation as a dress/top does not mean that there are two garments, but that the same garment can be worn as either a dress or a top. The representation above shows it being worn as a dress, further representations appear in the evidence showing it being worn as top together with a pair of jeans. The *eBay* print filed in evidence carries a “sale ended” date of 19 February 2006 which is before the material date. I have no reason to doubt the veracity of this evidence and it **is sufficient to prove that the claimed prior art was made available to the public prior to the material date and it must, therefore, be taken into account**



*Comparison of the design and the prior art*

36. WA highlights (as he did with 4002804) differences in wrist length and stitching. He also highlights that the dress in his design goes to the upper knee whereas the prior art is a mini dress. *Blackberry* highlight that WA's dress does not go to the knee, and, in any event, a difference in dress length would not change the overall impression; *Blackberry* make the same observations in relation to what is says are the very small differences in the length of the sleeves. *Blackberry* also highlight that the stitching is not visible. At the hearing, Mr Burrett repeated these arguments and suggested that both garments would simply be seen by the informed user as roll neck mini dresses.

37. In terms of overall impression, the prior art is likely to be described as a long sleeved roll neck dress with a very short hem line whereas WA's design is likely to be described as a long sleeved roll neck dress with an above the knee hem line. The overall impression is, thus, not the same. Mr Burrett argued at the hearing that adding an extra inch or two does not change the overall impression of a design. I think it likely that the difference in hem line between the designs is more than an inch or two, but regardless of exact quantum, what Mr Burrett submits may be true with some designs, but this cannot be of general application to all designs as the impact and significance of such a difference will inevitably vary between particular designs.

38. What strikes me here is that the difference created by the length of the dresses is quite significant and noticeable. Furthermore, the lengths of the dresses (and thus their differences) do contribute to their design characteristics and what novelty they possess. The differences mean that the overall impression is clearly different. **The invalidation fails, in comparison to the prior art, the registered design is new and has individual character.**

**REGISTERED DESIGN 4002807 – INVALIDATION APPLICATION 9/07**

39. The registered design and the prior art are depicted below:



*The prior art*

40. As with 4002806, the prior art is taken from *Blackberry's* eBay sales page, this time with a sale closed date of 27 March 2007. **This is sufficient to prove that the prior art was made available to the public prior to the material date and it must, therefore, be taken into account**

*Comparison of the design and the prior art*

41. WA highlights the absence of straps in the prior art compared to his design and that his design is laced at the front through eyelets whereas the prior art uses fastening hooks. He points out that his design has an open look to its front lacing whereas the prior art is tightly closed. Further differences highlighted are that the fishtails start below the knee in his design rather than above the knee and that the overall length is different, calf length (his design) opposed to knee length (the prior art). WA makes a final observation that his design is made from one single piece of cloth rather than two. *Blackberry* say that changing the fastening mechanism and adding straps does not change the overall impression and neither does changing the overall length or when the fishtails start. It is further noted that the method of construction (one piece) is not visible and not part of the registered design or the prior art.

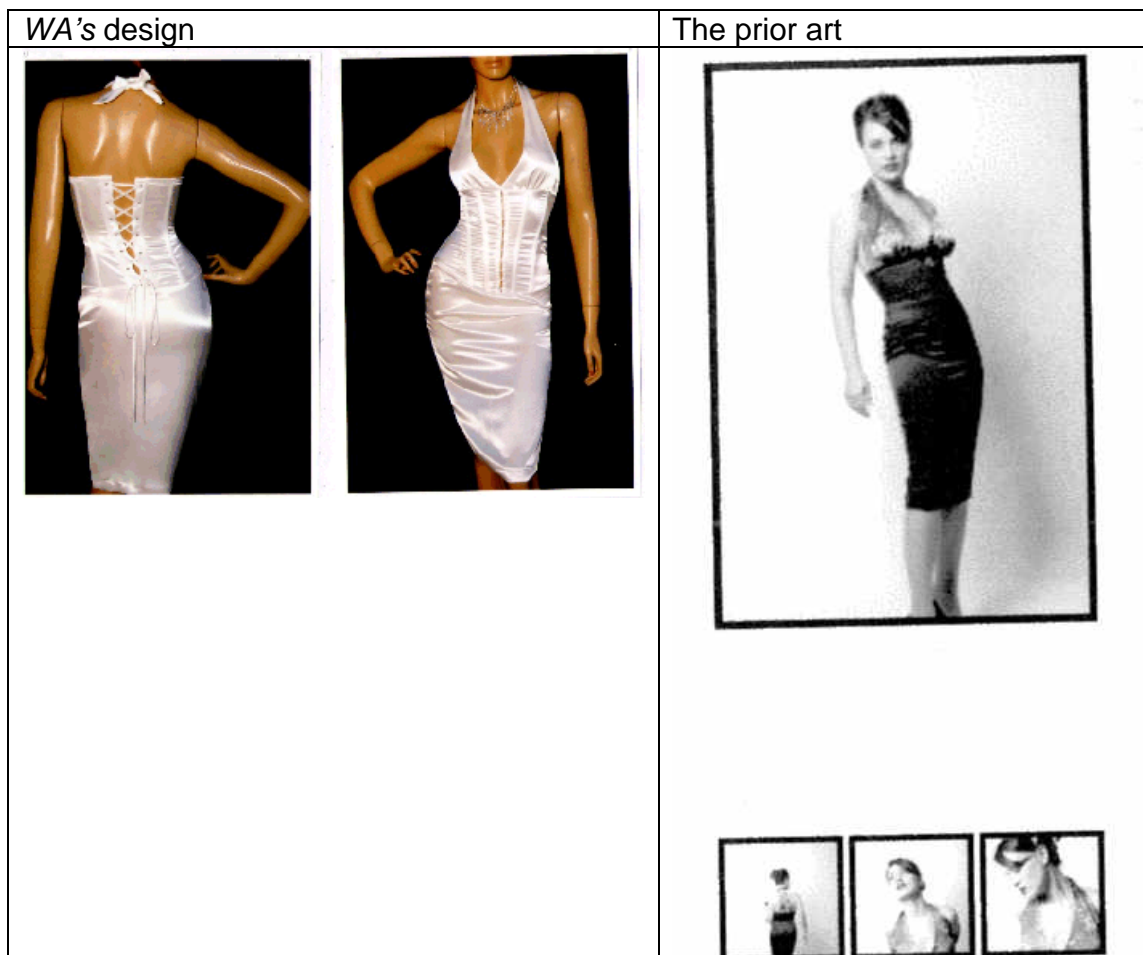
42. I regard two of the highlighted differences as being either immaterial or unlikely to affect the overall impression of the designs. The first is the length of the respective hem-lines, whilst there may be a difference it is not particularly stark, both being around the knee. The second is the method of construction, whilst a difference could be created by one design being an obvious two piece item of clothing (skirt and a top) and the other a one piece item (a dress), I agree with *Blackberry* that this is not an obvious characteristic of the designs, both of which appear to be dresses.

43. The other differences need further consideration. The rear lacing seems to be quite similar, although, this is not, in any event, highlighted as a difference by *WA*. However, what strikes me most is the fact that the front fastening of the prior art, which is said to be a fastening hook mechanism, is not visible in the evidence before me. Even if it were visible, there would, nevertheless, be a noticeable difference between that and the cross-laced front of the registered design that gives the impression of being slightly open. Whilst it may be possible to tighten the laces, the registered design has open lacing and this must be considered to part of the design. The bust shape is also different being much deeper cut in the prior art compared to a more traditional curved shape in the registered design. The deepness of cut in the prior art is said by Mr Burrett to be alterable depending on how much of the fastening is done up, nevertheless, the prior art before me has a deep cut bust line and, again, I must regard this as part of the prior art's design. The shoulder straps also create something of a difference which, at the very least, contributes to an overall difference.

44. I am left with the overall impression of the prior art being a knee length fish tail dress with shoulder straps with a lace up, partially open, front, against a prior art of a knee length fishtail strapless dress with a deep cut bust line and either no front fastening or a tightly fastened hook style front. Regardless of which prior art overall impression that is considered, the differences are sufficient for me to say that the overall impression is clearly different. **The invalidation fails, in comparison to the prior art, the registered design is new and has individual character.**

**REGISTERED DESIGN 4002808 - INVALIDATION APPLICATION 10-07**

45. The registered design and the prior art are depicted below:



*The prior art*

46. This prior art comes from the same source as that filed in 4002803 and the claimed date of public availability also taken from the same source. I have already found this to be insufficient to support the application for invalidation, I am, therefore, bound to make the same finding here. **The application for invalidation fails because it has not been proved that the publication took place before the material date.**

*Comparison of the design and the prior art*

47. Irrespective of the above I will, nevertheless, give my findings on overall impression in case of appeal. WA highlights that his design is boned whilst the

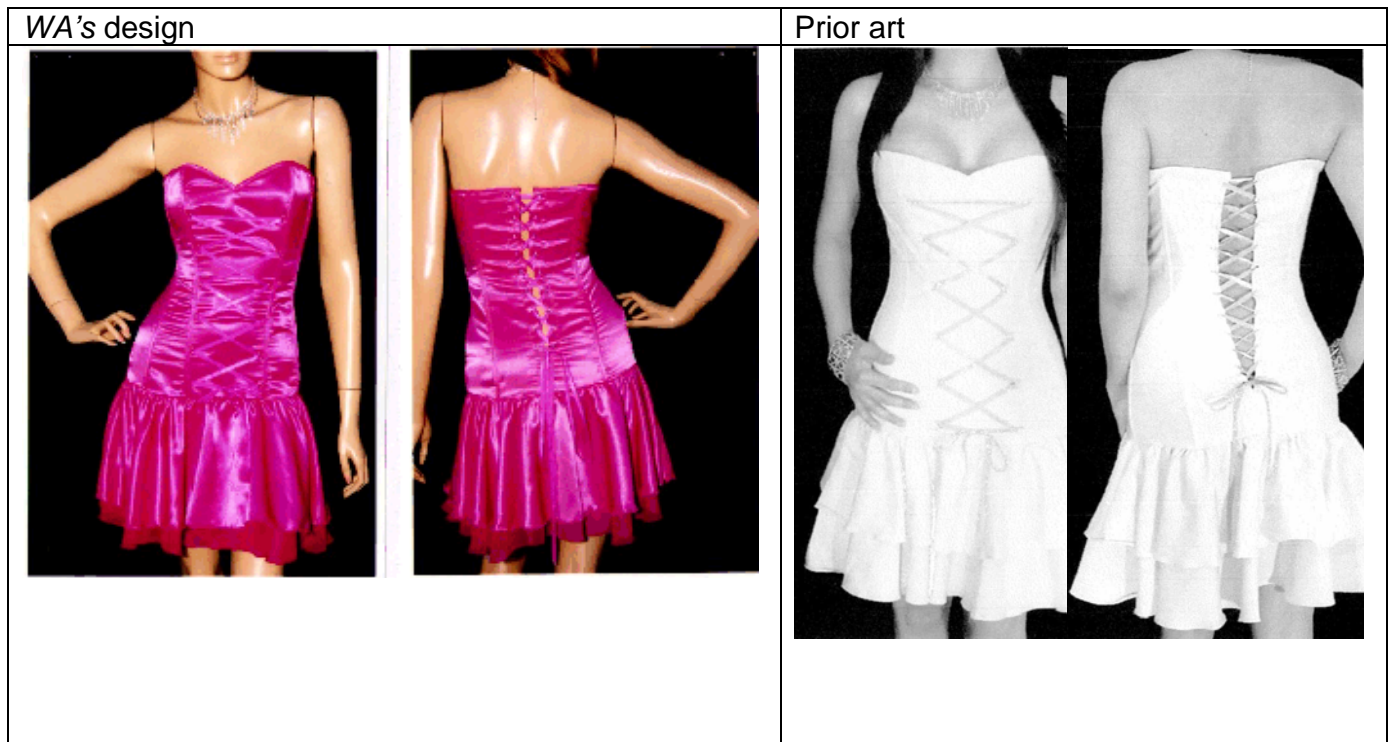
prior art is not, that the back of his design has a lace up feature whereas the prior art is zipped, that the back of his dress is cut much higher than the other, and, that his design is slightly open at the front due to the front fasteners used whereas the prior art is completely closed with no fastening at all. *Blackberry* argue that these differences do not change the overall impression and, for example, inserting bones into the dress would not change the overall impression.

48. In my view, if there is any perception that the respective designs have the same overall impression, such a view can only be achieved by assessing the overall impression at a much too low a level of generality. Pitched at the correct level of generality, namely, that of the informed user, the prior art would be considered as a mid length halter neck style dress with a floral pattern on the halter neck element, against a mid length halter neck dress with no pattern but incorporated boning, with front hook style fastening creating a slightly open effect and lacing at the rear.

49. In relation to the pattern (in the prior art) contributing to a difference in overall impression, it should be noted that the registered design is not limited to shape and configuration only (if it were then only the shape and configuration of the prior art would have been relevant). The registered design's surface decoration (its plain white colour) is, therefore, considered to be part of the design and it is therefore legitimate to consider the surface decoration of the prior art (the floral pattern) as part of the comparison. Taking all things into account, all of this must have the effect of creating a clearly different overall impression on the informed user. **The invalidation fails, in comparison to the prior art, the registered design is new and has individual character.**

**REGISTERED DESIGN 4002809 – INVALIDATION APPLICATION 11/07**

50. The registered design and the prior art are depicted below:



*The prior art*

51. As with 4002806, the prior art is taken from *Blackberry's* eBay sales page, this time with a sale closed date of 7 May 2006. **This is sufficient to prove that the claimed prior art was made available to the public prior to the material date and it must, therefore, be taken into account**

*Comparison of the design and the prior art*

52. *WA* highlights that the bottom of his design consists of an outer layer skirt with a see through inner layer whereas the prior art simply has a double layer of material without an inner lining layer. Also highlighted as a difference is the bust line and that his design has a side zip whereas the prior art does not. *Blackberry* argue that changing the material of the second (bottom) layer does nothing to the overall impression nor does slightly changing the bust line and, furthermore, that the zip does not feature in the design as registered and that this, in any event, is not a new technique to introduce.

53. I agree with *Blackberry* that the zip said to be part of the registered design cannot be taken into account because it is not visible in the representation on file and, therefore, cannot contribute to any difference in overall impression. Furthermore, I also agree that the change of material of the lower layer of the skirt part of the dress is unlikely to have any real impact on overall impression. I am, therefore, left with two designs which are of similar length, have a double layer skirt, have a laced up back, have some form of boning or seaming and have crossed zig zag lacing on the front; both are also strapless. The difference in bust line is not great between these designs and is unlikely to contribute to any difference in description of overall impression.

54. I am left to consider whether the difference in colour is relevant. Colour can form part of a design<sup>2</sup> and, indeed, if a design is filed in colour then that colour is taken to be part of the design in question. However, the prior art depicts a design which in all other respects (save for the colour difference) has the same overall impression. The difference in colour between the registered design and the prior art will, in my view, have a negligible effect of the informed user. The informed user would be aware that dress designs more often than not come in a range of colours and would, therefore, attach no material design importance to the substitution of one single colour for another. Therefore, I do not consider that the colour that forms part of the registered design and its difference from the prior art is sufficient to avoid the overall impression being the same. **The application for invalidation succeeds.**

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<sup>2</sup> See section 1(2) of the Act to that effect.

**REGISTERED DESIGN 4002810 – APPLICATION INVALIDATION 12/07**

55. The registered design (below left) and the prior art are depicted below:



*The prior art*

56. Two pieces of prior art have been provided. I should stress at this point that each piece of prior art must be assessed individually against the registered design, it not a matter of taking elements from each one in order to destroy the novelty of the design.

57. Prior art 1 comes from *Vogue* magazine. Although the date of publication was not shown in initial evidence, further evidence is provided by *Blackberry* which shows the date of publication as September 2001 which is well before the material date. **This prior art may, therefore, be taken into account.**

58. Prior art 2 comes from a brochure published by *Snorbz Corsets Ltd* and was filed as further evidence in the proceedings. This carries a clear copyright date in 2005. This places the document prior to the material date and, therefore, **this prior art may also be taken into account.**



## *Comparison of the design and the prior art*

### Prior art 1

59. *WA* highlights that his design has no lace on the chest rim whereas the prior art does, that the cutting of the chest rim differs in that the underarm is higher than the middle part of the chest in his design but in the prior art there is a higher curve in the middle but lower at the underarm. He also observes that his design has a halter neck strap whereas the prior art has shoulder straps and, finally, that on his design there is a cross laced front but in the prior art the front is fastened hook style with a bow at chest. *Blackberry* highlight that both the prior art and the registered design is a full lace up corset and that the other differences do not change the overall impressions.

60. My first observation is that the prior art is not at all clear in relation to its design characteristics. The mechanism for the front fastening is not visible, *Blackberry* say that it is a laced up corset, but this is not clear. What is clear is that the registered design has a halter neck strap whereas the prior art has a shoulder strap. The other key difference is that the registered design is patterned; this forms part of the registered design given the provisions of section 1(2) of the Act. Given the difficulty in ascertaining the design characteristics of the prior art, together with the easy identification of some key differences (the pattern and the strap) in overall impression, I am not persuaded that the respective designs have the same overall impressions. In my view, they would create clearly different overall impressions on an informed user.

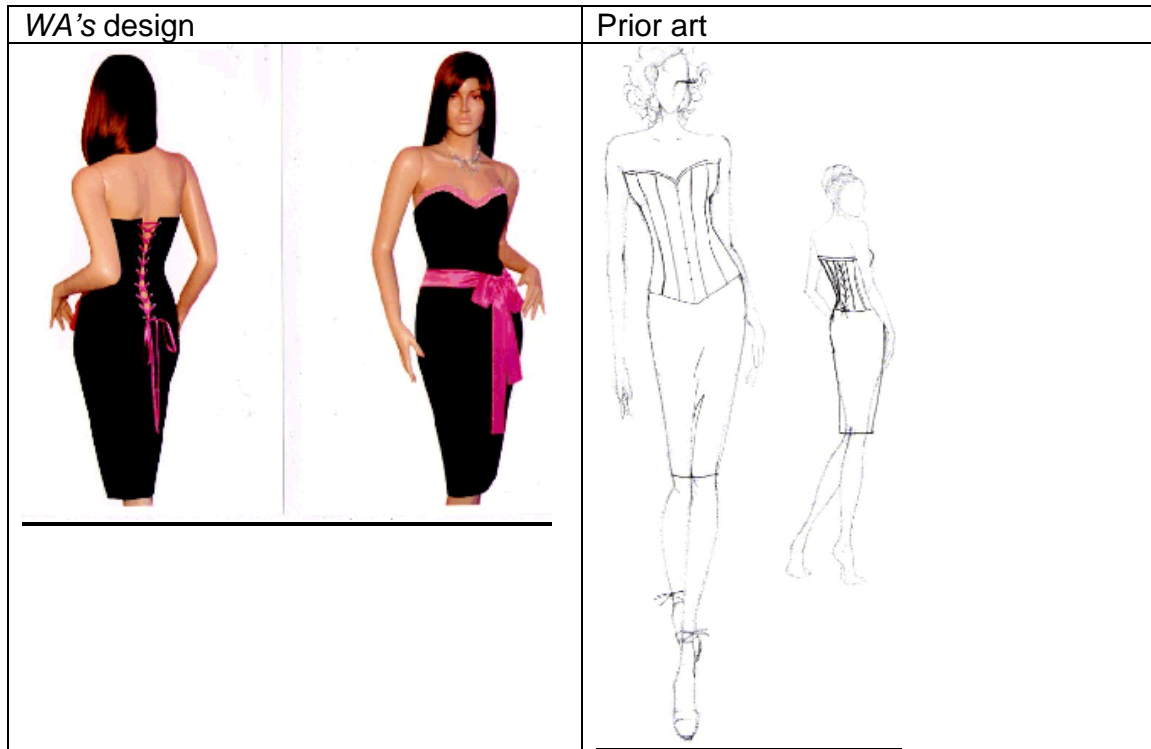
### Prior art 2

61. *WA* did not make submissions in relation to this prior art. *Blackberry* say that the overall shape and outline is very similar, the only difference being the fastening mechanism down the front of the garments.

62. I make the same observation as I made above in relation to pattern in the registered design; this contributes to the overall impression of the registered design and, therefore, constitutes a difference with the prior art as there is no such pattern on it. Furthermore, the fastening mechanism does play a part in the overall impression of the designs and, thus, this creates a further difference. *Blackberry* stating that the overall shape and outline is similar highlights the problem, the outline shape of many garments will, inevitably, have a degree of similarity given the function and requirements that a top of this nature performs. It is the finer design characteristics that need to be considered here. When looking at these, I am left with the overall impression of the registered design being a floral patterned front laced (slightly open) halter neck top whereas the prior art is a plain, tightly fastened halter neck top. The overall impression is, therefore

clearly different. **The invalidation fails, in comparison to both examples of prior art, the registered design is new and has individual character**  
**REGISTERED DESIGN 4002811 – APPLICATION INVALIDATION 13/07**

63. The registered design and the prior art are depicted below:



*The prior art*

64. The prior art consists of *Blackberry's* own registered design, namely: design registration 4000415 filed on 6 November 2006. As this has a filing date prior to *WA's* registered design **it must, therefore, be taken into account in these proceedings.**

*Comparison of the design and the prior art*

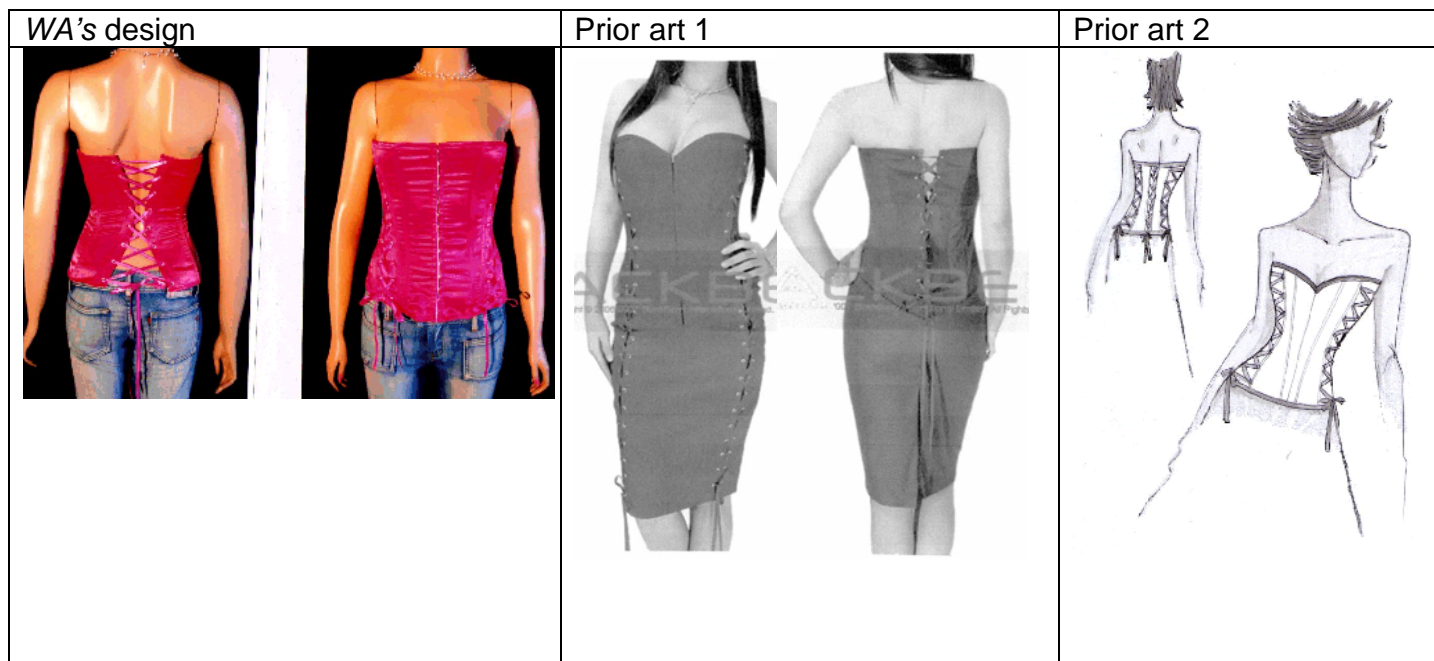
65. *WA* highlights a number of differences. Firstly, that his design has lace on its bust whereas the prior art has a hemmed rim; that the prior art is boned whereas his is not; that his design has a bow but the prior art does not; that there is a difference in bust shape; that the rear opening on his design goes lower than the prior art's rear opening; that his has no front opening at all whereas the prior art has an opening fastened with hooks; that his is a one piece dress whereas the prior art is two pieces sewn together. *Blackberry* argue that all these differences do not alter the overall shape or impression and that the method of construction is not clear in either design and that his design does not open at the front.

66. In my view, the differences are significant here. The fact that there may be a similar outline shape, although this is debatable in itself, is not enough in terms of overall impression (see my comments in paragraph 62 above). The other design features contribute to the overall impression on the informed user. At the hearing, Mr Burrett said that in his prior art the lines could be bones or seams and that this was not set in stone. Nevertheless, whether they are bones or seams they form part of the overall impression of the prior art design which are clearly absent from WA's design. Furthermore, there does appear to me to be some form of front fastening in the prior art design but, again, none in WA's design. The bow in WA's design also contributes to its overall impression. Taking all this into account, I consider the designs to be clearly different in overall impression. **The invalidation fails, in comparison to the prior art, the registered design is new and has individual character.**

67. In coming to this conclusion, I have not taken into account the colour scheme of the registered design. This is because the registered prior art covers the shape and configuration of the dress. Consequently, if the registered design created the same overall impression as the prior art as regards shape and configuration, the fact that it also includes a colour scheme would not have saved it.

**REGISTERED DESIGN 4002812 – INVALIDATION APPLICATION 14-07**

68. The registered design and the prior art are depicted below:



*The prior art*

69. As with 4002806, prior art 1 is taken from *Blackberry's* eBay sales page, this time with a sale closed date of 26 February 2007. **This is sufficient to prove that the prior art was made available to the public prior to the material date and it must, therefore, be taken into account**

70. Prior art 2 consists of *Blackberry's* own registered design, namely: design 4000417 filed on 6 November 2006. As this has a filing date prior to *WA's* registered design **it must, therefore, be taken into account in these proceedings.**

*Comparison of the design and the prior art*

Prior art 1

71. *WA* highlights that his design is for a blouse whereas the prior art is a dress. He also highlights differences in the bust shape and the lower part of his design with the comparative part of the prior art and also the configuration of the boning. *Blackberry* highlight that both have identical side lacing (which is considered to be the significant design feature), front fastening and rear fastening and that the

positioning of the bones has also been copied; it is summarised that all that has happened is that the bottom of the dress depicted in the prior art has been cut off. It is further stated that even if there are some minor differences, these do not make the registered design unique.

72. The biggest difference here is that, as *WA* has highlighted, one is a blouse and one is a dress. Even if it was true that the dress in the prior art had simply been cut off to form a blouse, the overall impressions the informed user will take is still the key factor to consider. Here, the fact that one design is a blouse or top and the other is a dress must, undoubtedly, form part of the respective overall impression. Having said that, the other differences highlighted by *WA* also contribute to a difference in overall impression. Whilst there may be nothing significant in the boning configurations, the straightness of the bust line in the registered design against the curved bust line in the prior art is of significance to the overall impression as is the style and configuration of the rear lacing. Taking the above into account, whilst there may be some similarities, the overall impression of the respective designs are different.

#### Prior art 2

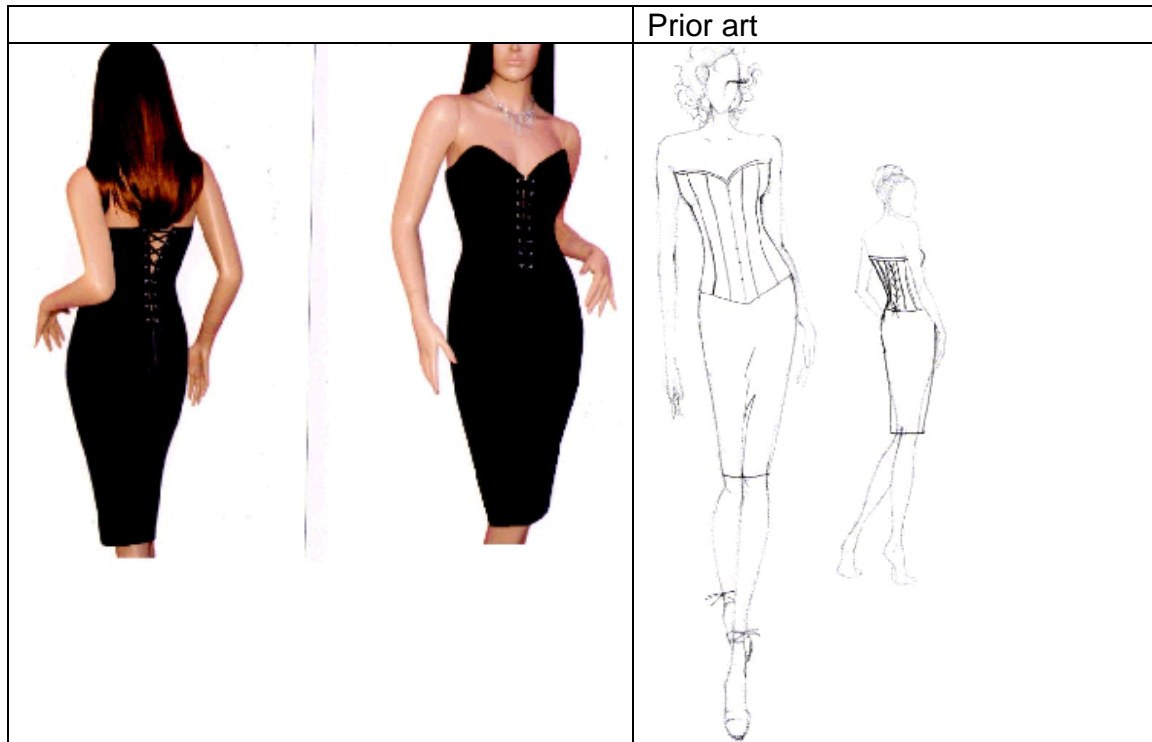
73. *WA* did not make submissions in relation to this prior art. *Blackberry* say that the designs are very similar showing the same side lacing and general appearance/shape.

74. Whilst I agree that there is a similarity between the designs in that they are both corset tops with side and rear lacing with both tops incorporating some form of boning, there are other features which contribute to their respective overall impressions. Firstly, the registered design has a very straight bust line rather than a curved v shaped bust line depicted in the prior art. The registered design also has a front fastening mechanism of a slightly open style which is absent in the prior art. Whilst the prior art depicts a line running through the centre of the garment it does not appear to be a fastening mechanism but simply part of the boning structure. All the features described form part of the overall impressions and, overall, the designs will create a clearly different impression on an informed user.

**75. The invalidation fails, in comparison to both examples of prior art, the registered design is new and has individual character**

**REGISTERED DESIGN 4002813 – INVALIDATION APPLICATION 15/07**

76. The registered design and the prior art are depicted below:



*The prior art*

77. The prior art consists of *Blackberry's* own registered design, namely: design 4000415 filed on 6 November 2006. As this has a filing date prior to *WA's* registered design **it must, therefore, be taken into account in these proceedings.**

*Comparison of the design and the prior art*

78. *WA* highlights a difference in bust line including a difference to the cut in the underarms (lower in his registered design but close to the underarm in the prior art), that his design is for a one piece dress whereas the prior art is more of a two piece affair, that his design incorporates a lace up front using eyelets (which is slightly open) whereas the prior art is tightly fastened using hooks. He also states that his design is open at the side whereas the prior art is not.

79. *Blackberry* argue that the differences in the bust line do not change the overall appearance neither does changing the fastening method at the front. He

states that the method of construction (one piece/two piece) is not part of either design and that the side opening is not visible in *WA's* design.

80. I agree with *Blackberry* in relation to the claimed side opening of *WA's* design; it is not visible in the representation on file so it cannot contribute to any difference in overall impression. I also agree that the shape of the bust line, although slightly different, does not create a much different impression. However, the manner of fastening at the front is noticeably different and the different fastening mechanisms do contribute to the overall impressions on the informed user. Furthermore, it is not clear whether *WA's* design has any boning at all whereas there is clearly boning, or at the least very noticeable seams in the prior art. Whilst I agree with *Blackberry* that the method of construction *per se* is irrelevant, the fact remains that *WA's* design gives the impression of a simple knee length front laced (slightly open) dress compared to a knee length dress incorporating a boned and tightly fastened front corset top. This to my mind, and as I have described, creates overall impressions that will clearly differ in the eyes of the informed user. **The invalidation fails, in comparison to the prior art, the registered design is new and has individual character.**

**REGISTERED DESIGN 4002814 – INVALIDATION APPLICATION 16/07**

81. The registered design and the prior art are depicted below:



*The prior art*

82. As with 4002806, prior art 1 is taken from *Blackberry's* eBay sales page, this time with a sale closed date of 27 March 2007. **This is sufficient to prove that the claimed prior art was made available to the public prior to the material date and it must, therefore, be taken into account**

83. Prior art 2 consists of *Blackberry's* own registered design, namely: design 4000416 filed on 6 November 2006. As this has a filing date prior to *WA's* registered design **it must, therefore, also be taken into account in these proceedings.**

*Comparison of the design and the prior art*

Prior art 1



84. WA highlights that his design incorporates a halter neck strap whereas the prior art is strapless, that the bust shape is different and that the fishtails start at a different place and that this follows through to a difference in overall length. *Blackberry* argue that the addition of the strap does not change the overall impression nor does the bust shape; on this latter point he also observes that the front of the dress in the prior art is not done up all the way and that it is this that creates the deep-cut, but when done up this will create less of a difference. Similarly, it is argued that the difference in length is minor and will not create any difference in overall impression.

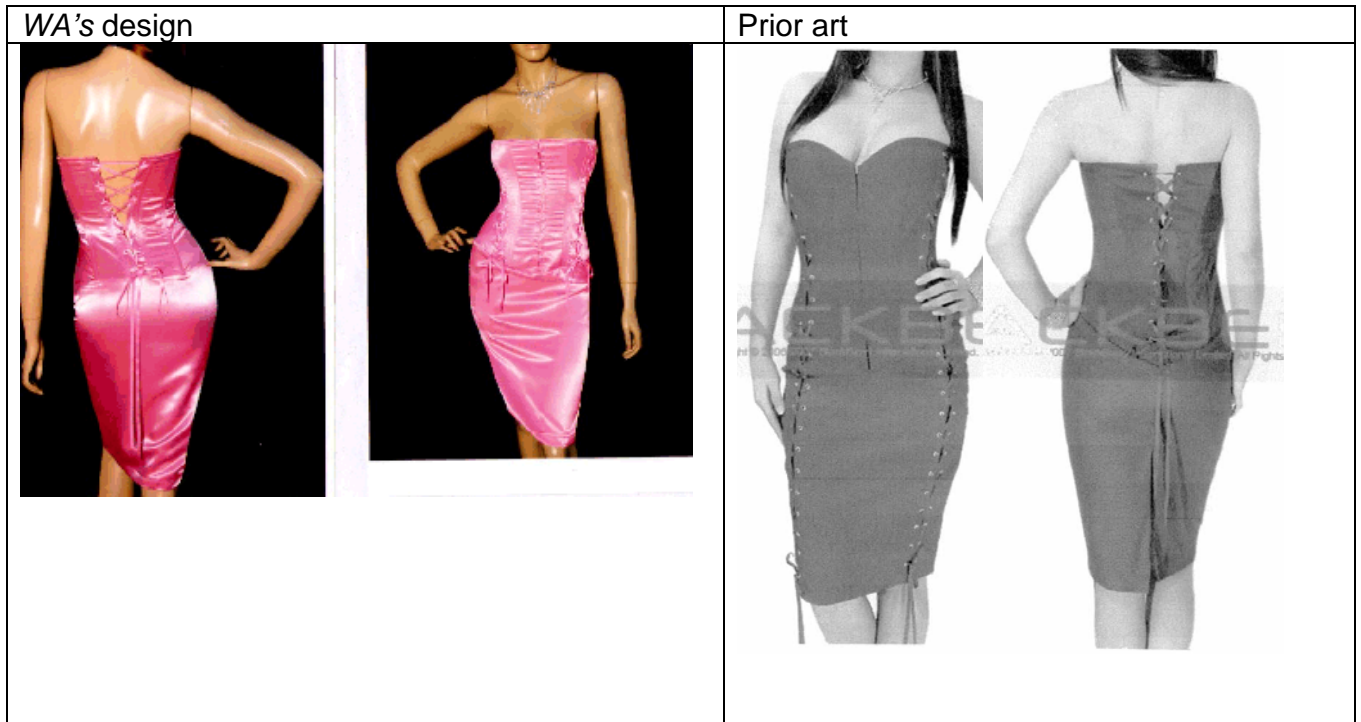
85. This is the same prior art relied upon in relation to 4002807. I found there that the overall impression was of a strapless knee length dress with a deep cut bust line with lacing at the rear in the top half of the garment. Whilst I agree that the difference in length starting point of the fishtails is hardly noticeable and, as such, the registered design will also be regarded as a knee length fishtail dress, the other differences, such as the deep cut bust line opposed to a more horizontal one, are more significant. Furthermore, the representations of the prior art are very unclear, the fastening device (if there is one) is not visible neither is any boning visible. Although the *eBay* extract refers to the garment as being “fully boned” I cannot assess whether this affects overall impression if I cannot see it. Taking all of this into account, the overall impressions are clearly different. **The application for invalidation fails in relation to this prior art.**

#### Prior art 2

86. The prior art here also consists of a knee length fishtail dress that appears to have a centre fastening, is certainly boned (or at least heavily seemed) and also has a rear lacing feature through the top half of the garment. So far the overall impressions are the same. However, the differences to consider are the bust line and the strap (or the lack of one in the prior art). Whilst the bust lines are not identical, they are not far apart either, neither do they contribute greatly to the design characteristics of the garment. The halterneck strap is slightly more significant, but the sharing of overall impression in all the other features I have identified results, in my view, in the overall impressions on the informed user not being clearly different. **The application for invalidation succeeds.**

**REGISTERED DESIGN 4002815 – INVALIDATION APPLICATION 17/07**

87. The registered design and the prior art are depicted below:



*The prior art*

88. As with 4002806, the prior is taken from *Blackberry's* eBay sales page, this time with a sale closed date of 26 February 2007. **This is sufficient to prove that the prior art was made available to the public prior to the material date and it must, therefore, be taken into account**

*Comparison of the design and the prior art*

89. WA highlights a difference in bust line and blouse shape; a difference in the form (and number) of boning; that the side lacing only appears in the top part of his design but goes the full length in the prior art; that his design has a opening at the side which does not appear in the prior art. *Blackberry* argue that the shortening of the lacing does not change the overall impression and that the other differences are so small that they do not change the overall impression; it is also observed that the split in the side of the registered design is not visible and cannot, therefore, create a difference.

90. I agree that the side split is not relevant as it is not visible in the registered design. The other features are more relevant as I consider that whilst both designs will be seen by the informed user as knee length dresses, one will be seen as having a straight bust line and the other a curved and one as a half side laced dress and the other as a full side laced dress. The bodice on the registered design also has a different look despite it being difficult to vocabularise. Overall, this results in the respective overall impressions, as described, being clearly different.

**91. The invalidation fails, in comparison to the prior art, the registered design is new and has individual character**

## **Conclusions**

92. The applications for invalidation succeed in relation to registered designs 4002804, 4002809 and 4002814. As such, and in accordance with section 11ZC(4) of the Act, I declare these designs invalid.

93. The applications for invalidation in relation to the other ten registered designs fail.

## **Costs**

94. On the three cases where the invalidation has succeeded, *Blackberry* is entitled to a contribution towards its costs, it having filed a statement of case, paid an official fee (£50), filed evidence and submissions and attended a hearing. I consider that a contribution towards costs of £300 per case would be appropriate.

95. On the ten cases where the invalidation has failed, *WA* is entitled to a contribution towards his costs. He has filed counter-statements (including submissions) but no further evidence or submissions. I consider it appropriate that a contribution towards costs would be £100 per case.

96. A balance of the above sums means that *WA* is entitled to an award of costs to the amount of £100. I hereby order Blackberry International Limited to pay Wittaya Asawasuwannakul the sum of £100.

97. The above sum should be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of March 2009**

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