

O-270-10

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

**IN THE MATTER OF REGISTERED DESIGN NO. 4002685**



**IN THE NAME OF EMILY JOHNSON-JONES**

**AND**

**A REQUEST TO INVALIDATE (NO. 12/08)**

**BY MICHELE CHIEFFO**

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

**In the matter of registered design no. 4002685 in the name of Emily Johnson-Jones**

**and**

**a request to invalidate (no. 12/08) by Michele Chieffo**

### **The background and the pleadings**

1. The registered design (4002685) the subject of these proceedings was filed on 25 April 2007 by Ms Emily Johnson-Jones. The design is said (on the form of application) to be a:

“Fabric bag holder with elasticated ends. Holds 6 plastic carrier bags. Cylindrical in shape.”

2. I will set out the design itself later when I come to make the necessary comparisons with the prior art. I note that some of the representations provided with the form of design application contain a coloured pattern (black dots on a pink background). However, Ms Johnson-Jones states on the form of application that such pattern and colour do not form part of the design. It is, therefore, only the shape and configuration of the design which is of importance.

3. On 25 June 2008 Ms Michele Chieffo requested the invalidation of the above referenced design. The grounds of invalidation are based on sections 11ZA and 1B of the Registered Designs Act 1949 (as amended) (“the Act”) which, in combination, mean that a design registration may be declared invalid if it does not meet the Act’s requirements of novelty and individual character. The claim is made on the basis of earlier design registration 4000013, of which Ms Chieffo is a joint proprietor (along with Mr Justin Chieffo).

4. Reference is also made in the pleadings to earlier design 2034539. Although not expressed particularly clearly, I regard the reference to this design to be an alternative form of prior art relied upon by Ms Chieffo. I clarified this by writing to Ms Chieffo and she confirmed that this was the intention (despite mixing up, as Ms Johnson-Jones pointed out, some of the terminology involved, such as using the word “infringement” rather than “invalidity”). For her part, Ms Johnson-Jones (via her legal representatives) responded that no admission to invalidity on the basis of design 2034539 is made. All things considered, design 2034539 will be considered as prior art in these proceedings.

5. There is also a pleading under section 11ZA(2) relating to the proprietor of the design not being the true proprietor of it.

6. Ms Johnson-Jones filed a counterstatement denying the grounds of invalidation. The only evidence filed was on behalf of Ms Chieffo. Neither side requested a hearing or filed written submissions in lieu of attendance. I will take into account, though, any submissions/argument that have been made in the papers that are before me.

### **The evidence**

7. On behalf of Ms Chieffo there are two pieces of evidence. The first is from Mr Justin Chieffo (the other joint proprietor of design 4000013). His evidence is more submission than fact as he makes a comparison between design 4000013 and Ms Johnson-Jones' design. Although I will not summarise his submissions here, they will, of course, be borne in mind. Mr Chieffo also provides a letter from Ms Ann Marie Probert (who he calls an "informed user") but, as Ms Probert provides evidence herself I will come back to what she says later. Mr Chieffo also makes reference to exchanges of correspondence between the proprietors of 4000013 and Ms Johnson-Jones' legal representatives prior to these proceedings being launched; I do not consider it necessary to make further reference to this as it does not really assist the tribunal in making the determinations required of it.

8. As I have already stated, evidence was also provided by Ms Ann Marie Probert. She recounts her presumption that a carrier bag carrier she came across was one of Justin [Chieffo's] bags. I will come back to the relevance of this later.

### **Section 11ZA(2)**

9. Section 11ZA(2) of the Act reads:

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

10. I will deal with this ground briefly. This is because the only basis for the claim by Ms Chieffo that she is the true proprietor of Ms Johnson-Jones design is that the respective designs have the same overall impression. There is no evidence to suggest (or even a claim) that Ms Johnson-Jones has had any form of relationship with Ms Chieffo resulting in Ms Johnson-Jones applying for the design in her name when it should have been made in the name of Ms Chieffo. The claim relating to lack of novelty/individual character will be dealt with below, but there is nothing to support the claim under section 11ZA(2) which appears to me to be misguided.

## **Section 11ZA/1B - the legal background**

11. 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);

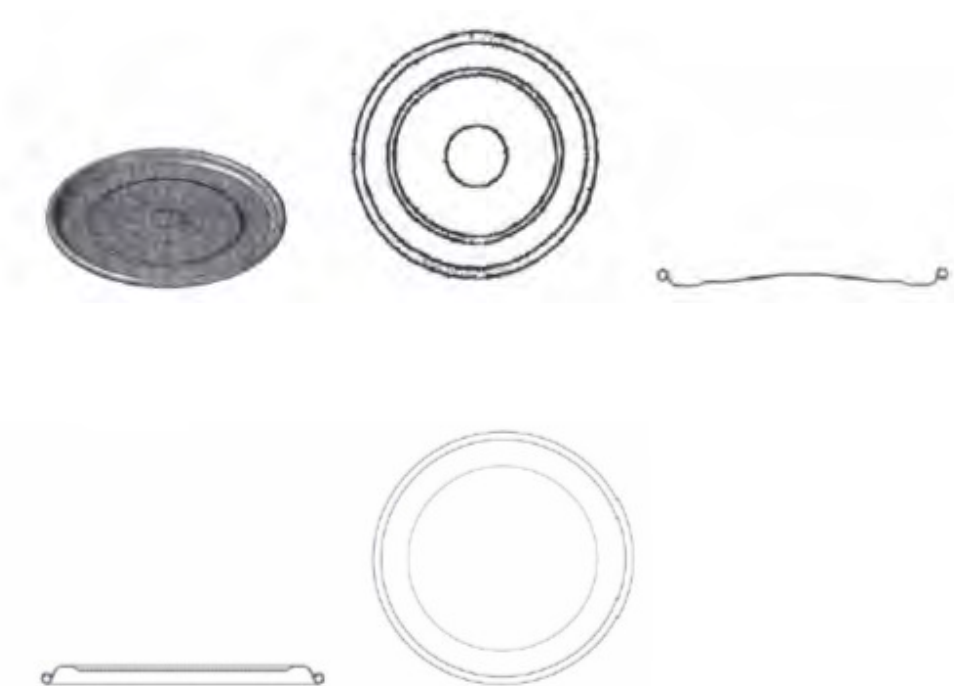
- (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
  - (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date 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.”

12. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked. This means that the material date for my assessment is 25 April 2007. Any prior art must have been made available to the public prior to this date.

13. 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 article in question; imperfect recollection has little role to play.
- d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.
- e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

14. To further guide me in making my determinations, I also note the recent judgment of the General Court in Case T-9/07, *Grupo Promer Mon Graphic SA v (OHIM)* where it was held that the differences between the following two designs were insufficient to produce a different overall impression on the informed user:



15. I accept, though, that each case must be dealt with on its own particular facts and merits.

16. 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).”

17. I also note that the above approach regarding the informed user 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 in that case.

## **Application of the legal principles**

### ***The informed user***

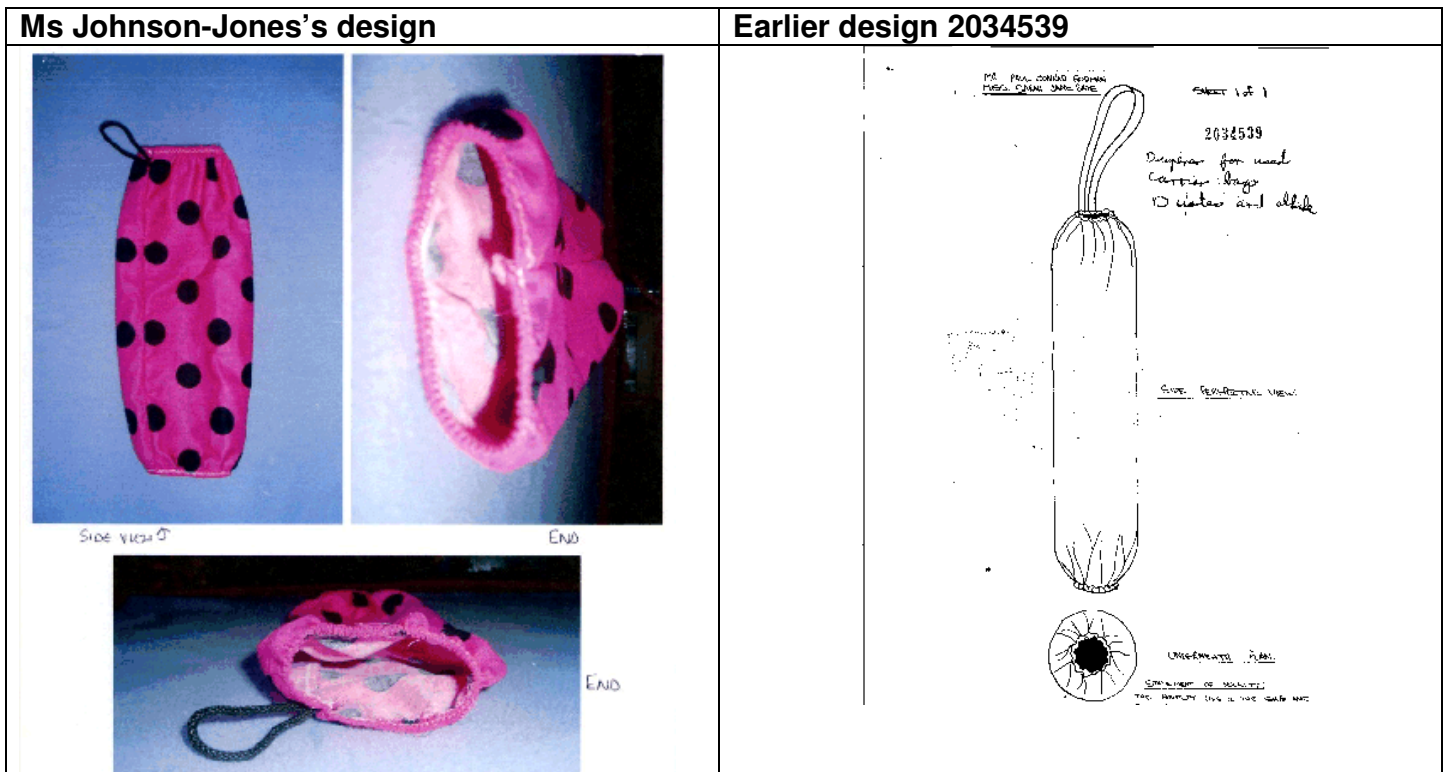
18. Before looking at the competing designs in more detail, I must firstly assess who the “informed user” is. All of the designs relate to a (carrier) bag carrier. The informed user will not be a designer or manufacturer of the product. This is because the informed user, as the name suggests, will be a user, of some sort, of the article. The informed user will, though, have more knowledge of these types of products than an ad-hoc member of the public. The informed user will be a person more familiar with the other types of design on the market. They will know of the other types of product in the market (the “what’s about”/“what’s about in the recent past” test). Such a person will not appreciate a design too generally, but nor will they make a forensic analysis of each and every detail.

### ***Comparison with design 2034539***

19. The earlier design was filed on 19 October 1993. It is not owned by Ms Chieffo but this does not matter. The novelty requirement can be judged upon any form or prior art subject to it being made available to the public prior to the relevant date. I also note from the records of the Intellectual Property Office that the period of design protection has expired. This also does not matter – this is not a case as to whether the earlier design is infringed by Ms Johnson-Jones’ design but, rather, whether Ms Johnson-Jones’ design is novel (as defined by section 1B) compared to what has gone before. The first task is to ensure that the earlier design was made available to the public before the relevant date i.e. before 25 April 2007. The details held on the Intellectual Property Office’s designs database show that a certificate of registration was issued on 29 March 1994. The design would have been made available to the public in the relevant design journal at this time. This is well before the relevant date and it therefore counts as prior art for the purpose of these proceedings.



20. The two designs being compared are set out below:



21. In relation to Ms Johnson-Jones' design, there are other representations on file. Some show the design already filled with carrier bags in order to illustrate the design in use, and some show a hand-drawn version of the design. None of these representations add anything to that depicted above in terms of the comparison to be made here. As stated earlier though, by disclaimer, the colour and pattern shown above do not form part of Ms Johnson-Jones' design.

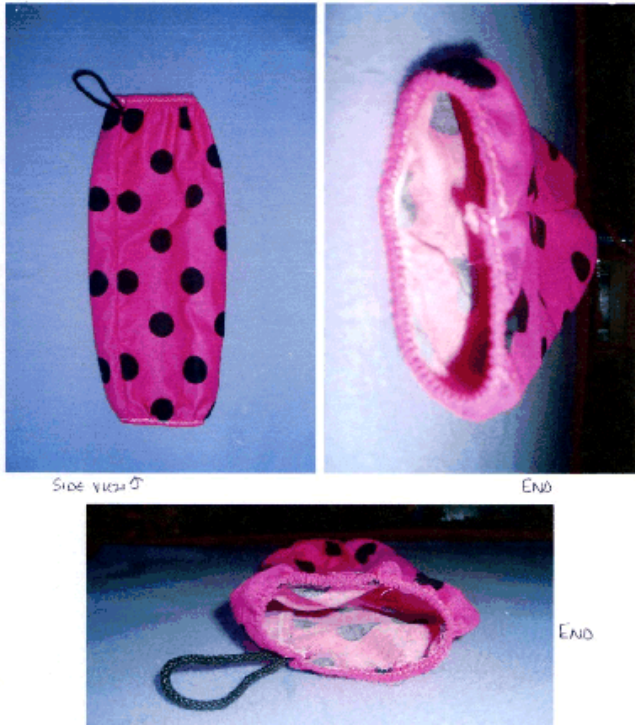

22. Both designs have as part of their overall impressions a non-rigid cylindrical shape which tapers inwards both at the top and at the bottom of the article. The informed user will notice these aspects, and they will also notice that both designs have a looped drawstring handle at the top of each article. In terms of the openings at the top, Ms Johnson-Jones' design would look even more like that of the earlier design when drawn shut and, consequently, the loop would also become longer as per the earlier design.

23. Other than the above, I can see little else that would form part of the overall impression of either design. Compared side by side, it may be picked up that the earlier design has a slightly longer form (compared to its width) than Ms Johnson-Jones' design. However, the margins involved in such a difference are, in my view, quite small. I must, though, consider the degree of design freedom. If there is little design freedom then a small difference may be tolerated and the later

design held to be novel. However, in this case, and whilst there may be some functional design constraints when making a carrier bag carrier, I am sure there would be a number of ways in which a design for a carrier bag carrier could be produced such as, for example, using different shapes. I consider there to be a reasonable degree of design freedom. The consequence of this is that, in my view, the small difference identified above between the respective designs is not sufficient in this case to produce a clearly different overall impression on the informed user. My finding is that Ms Johnson-Jones' design does not produce a clearly different overall impression to design 2034539. **This, alone, is enough for Ms Chieffo's request for invalidation to succeed.** I will, though, go on to consider design 4000013.

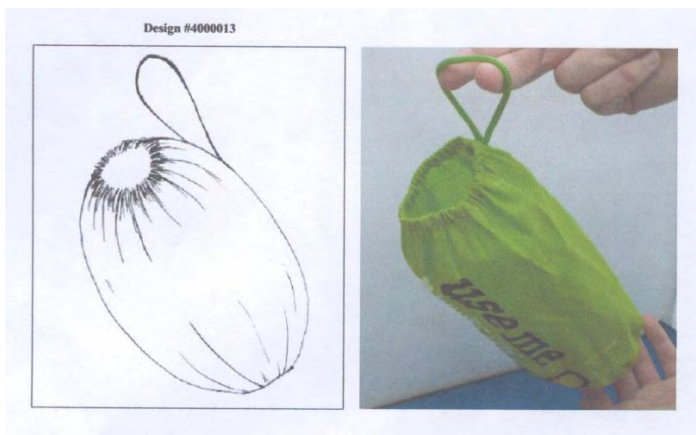
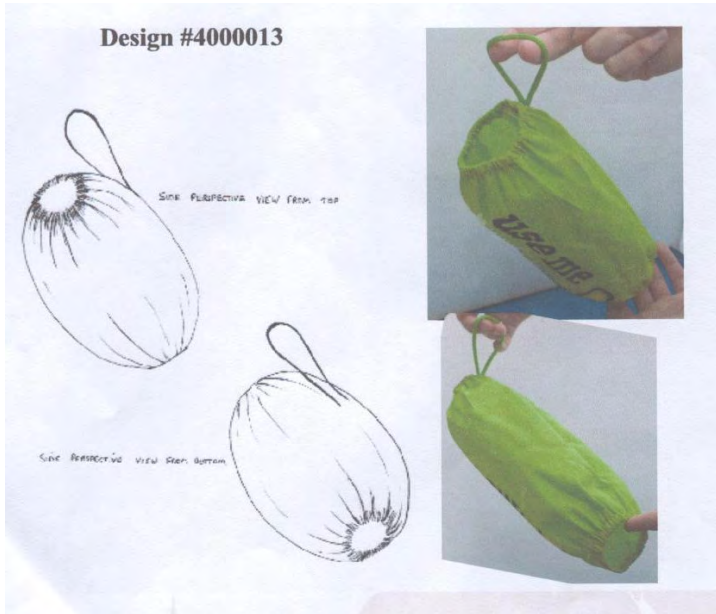
**Comparison with design 4000013**

24. The earlier design was filed on 3 October 2006. I note from the records of the Intellectual Property Office that the design was made available to the public in the relevant design journal in December 2006. As this is before the relevant date i.e. before 25 April 2007, it therefore counts as prior art for the purpose of these proceedings. The two designs being compared are set out below:

Ms Johnson-Jones's design	Earlier design 4000013
 <p>Side view</p> <p>END</p> <p>END</p>	 <p>SIDE PERSPECTIVE VIEW FROM TOP</p> <p>SIDE PERSPECTIVE VIEW FROM BOTTOM</p>

25. Before making the comparison, it is useful to consider the representations of the competing designs as set out in Ms Chieffo's statement of case. It includes all of the views of design 4000013 (only two are depicted above) and alongside

them photographs of what she says is an article made to Ms Johnson-Jones design<sup>1</sup> with such photographs being taken from the same perspective as the perspectives of design 4000013. This can be seen below:



26. In terms of overall impression, I have already described what this constitutes in so far as Ms Johnson-Jones' design is concerned. With regard to design 4000013, whilst it is also non-rigid and has ends at the top and the bottom which taper inwards, the overall shape is more spherical than cylindrical. It has a more rounded feel – not fully rounded but almost melon-shaped (of the honeydew variety rather than the watermelon). Furthermore, whilst design 4000013 also has a looped handle, it is further down the article in question and, from the representations provided, it does not appear to form part of a draw-string

<sup>1</sup> There is no denial from Ms Johnson-Jones that this is the case.

mechanism. I note Mr Chieffo's submission (in his evidence) that 4000013 (like Ms Johnson-Jones' design) has a cylindrical shape and a loop attached at a similar point, however, this is not what I see in the representations. All of what I have described will form part of the overall impression the informed user will appreciate of design 4000013.

27. Ms Johnson-Jones design could, though, become more melon-shaped when carrier bags are put into it. However, in the representations supplied on the form of application she usefully provided examples of the design in use (containing carrier bags). As can be seen below the article retains its cylindrical look and does not take on a melon-shaped appearance:



28. I referred earlier to the evidence of Ms Probert. She explains in her evidence that she and her mother had seen Justin Chieffo on a television programme and that her mother had given her one of Justin Chieffo's carrier bag carriers. She then encountered another bag that she presumed was one of his. She states:

“It had the ASDA logo and was a different colour to the one given to me by my mother but apart from that it was identical in design and I believed it was one of Justin's original bags.”

29. Whilst I have borne the above in mind, Ms Probert's evidence lacks objective detail. None of what she says is placed in a particular timeframe. Nor does she identify what she is comparing. She talks about: 1) “Justin's design” and also 2) the design which she confused with Justin's design (with an ASDA logo and a

different colour). In relation to 1), her view on this is based on a design as contained in an actual article given to her by her mother – however she does not provide a representation of it and I cannot be sure how faithful it was to the design the subject of design 4000013. In relation to 2) then, similarly, I do not know how closely the design she subsequently encountered corresponds to the design as set out in Ms Johnson-Jones registration. Whilst it may be the same as the one set out in Ms Chieffo’s statement of case, it would be wrong to make an inference that this is the case. Overall, I can take little account of this evidence.

30. In terms of where all this leaves me, the overall impressions are certainly not the same, but, does Ms Johnson-Jones’ design create a clearly different overall impression? In my view, and whilst bearing in mind the reasonable degree of design freedom (as stated earlier), I consider the differences I have identified to be sufficient to result in a clearly different overall impression given the noticeable difference in shape and the difference resulting from the placement of the loop. **The request for invalidation fails on the basis of design 4000013.**

### **Outcome**

31. Ms Chieffo’s request to invalidate Ms Johnson-Jones’ design succeeds given the outcome in relation to prior art 2034539 .

### **Costs**

32. Ms Chieffo having been successful is entitled to a contribution towards her costs. With regard to costs, although the registrar has a wide discretion in relation to such matters, he nevertheless works from a published scale (as per Tribunal Practice Notice 4/2007). I have borne the scale in mind when determining what award of costs to make. I must, though, also take into account that Ms Chieffo was not legally represented in these proceedings and her costs would not, therefore, have included any professional legal fees. I therefore reduce by 50% (except in relation to expenses) what I would otherwise have awarded. I hereby order Ms Emily Johnson-Jones to pay Ms Michele Chieffo the sum of £500. This sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£200
Filing evidence	£250
Expenses – fee for filing DF19A	£50

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

**Dated this 29 day of July 2010**

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