

**O-525-15**

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

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 4030465  
OWNED BY GEMMA LOCKWOOD**

**AND**

**AN APPLICATION (No. 4/14) BY COOL COLLARS LTD  
TO INVALIDATE THE DESIGN**

## The background and the claims

1. The registered design the subject of these proceedings was filed by Ms Gemma Lockwood (the proprietor) on 18 June 2013. The design is described as a “whelping ID collar”. The “fastened view”, “back view” and “front view” are depicted below:



As noted on the last two images above, colour is not part of the design.

2. The applicant for invalidation is Cool Collars Ltd. The main claims are that:

- i) The applicant has offered (on amazon.co.uk and ebay.co.uk) a near identical whelping collar since November 2011.
- ii) Both the applicant’s design and that of the proprietor are made from “back-to-back, hook loop material”, have the same texture, and are of practically identical dimensions.
- iii) The sole difference is that the ends of the applicant’s collars are finished with a straight edge whereas the proprietor’s design has rounded ends.
- iv) Irrespective of the above differences, rounded ends are not new. It highlights that, since before the relevant date, there have been several manufacturers of die cutting machines (and die cutting service providers) which die cut rounded ends.
- v) That the applicant (specifically its company director Sarah Edwards) has been aware of the possibility to die cut a rounded end on back to back hook loop material and that in April 2013 she initiated emails to procure a machine to do so.
- vi) Given the above, it is claimed that the registered design does not meet the novelty requirements of section 1B of the Registered Designs Act 1949 (“the Act”).

3. It should be noted that the applicant initially pleaded a ground under section 11ZA(1)(a) of the Act. This was struck out by the Tribunal (without objection) as misconceived. This, in my view, was the correct course of action. The ground relates to a design failing to meet the basic definition of what may constitute a design under the Act. It is not about novelty. There was nothing in the pleaded case which goes to a ground under section 11ZA(1)(a).

4. The proprietor filed a counterstatement. It states that the applicant has not proved that its design has been publically disclosed. It additionally denies the section 1B claim on the basis that:

- i) “[T]he substantial change of the shape of both ends of the collar is sufficient for giving the design an individual character”.
- ii) It is the overall appearance that matters, so issues such as material do not matter.
- iii) The existence of die cutting machines/services does not represent any form of prior art; in any event, there is an absence of proof that these things exists.

5. The applicant initially represented itself, but during the proceedings appointed Sanderson & Co. The proprietor was initially represented by Franks & Co, but during the proceedings Ms Lockwood elected to represent herself. The applicant filed evidence together with a set of written submissions. The proprietor filed evidence. Neither side requested a hearing. The applicant filled written submissions in lieu of a hearing, the proprietor did not.

#### **The relevant legislation and case-law**

6. Section 1B of the Act (so far as it is relevant) 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) -

(c) -

(d) -

(e) -

(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)--”

7. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>1</sup>. The most relevant parts are re-produced below.

#### **“The informed user**

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* 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);

---

<sup>1</sup> [2012] EWHC 1882 (Pat)

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).

### **Design freedom**

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In Dyson Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

### **Effect of differences between the registered design and the design corpus**

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is

all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

### **The correct approach, overall**

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of "different overall impression" is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters."

8. The relevant date is the date on which the proprietor applied to register her design i.e. 18 June 2013.

### **The evidence**

9. With the case-law in mind, I now turn to consider the evidence that has been filed. The applicant's evidence consists of two witness statements, one from Ms Edwards and one from her business partner Mr Guy Stewart. Their statements are identical. They both attest to the provision on ebay.co.uk and amazon.co.uk of their whelping collars. They were first made by cutting *Velcro One-Wraps* to the required length with a pair of scissors. They provide documentary evidence of sales made before the relevant date. This evidence is not countered or challenged. Therefore, without detailing the evidence any further, I accept the evidence of Mr Stewart and Ms Edwards that the following product was made available to the public prior to the relevant date:



10. The witness statements of Ms Edwards and Ms Stewart were provided under cover of a document headed SUBMISSION OF EVIDENCE. This document was provided by Mr Thomas Harris of Sanderson & Co. Although not headed as a witness statement, it does contain the following declaration:

“The Applicant believes that the statements contained in this submission of evidence are true to the best of their knowledge.”

11. Whilst the above statement is akin to a statement of truth, it is signed by Mr Harris not by anyone working with a position of responsibility in the applicant’s company. Its evidential weight is, therefore, limited. Much of the document simply contains submission, however, there are some factual aspects, as follows:

- i) An extract from the proprietor’s website which is headed “Why Rounded Ends?”. The answer to this questions reads “Our unique rounded end ID collars are designed for the maximum comfort of your pet and the pre-cut rounded ends help eliminate the collars from peeling apart accidentally”.
- ii) A print from Facebook dated January 2010. The page is that of Speedtech International and is headed Speedwrap World. A photograph shows a person wearing multiple straps around the wrist that look extremely similar to those used in the proprietor’s design. Mr Harris states that the ends are rounded. It is difficult to see that this is the case, however, the inner strap on one of the bands is slightly out of line from which I can conclude that the end is indeed rounded.
- iii) A print from the above company’s website (from January 2010) showing pictures of *Velcro* fasteners, one of which (in unfastened mode) has rounded ends.
- iv) A print (with a date from 2011) from DX.com showing “*Velcro* nylon tie organisers” with rounded ends.
- v) A screen shot of a You Tube video showing *Velcro* cable ties with rounded ends. The video was posted in July 2012.
- vi) A screen shot from You Tube about “China *Velcro* cutting machines”. A screen grab from the video depicts cut pieces of *Velcro* with rounded ends.
- vii) A web print from Thomson Machines Ltd from 3 October 2006 showing a *Velcro* cutting machine with depictions of the various ends that can be cut, including rounded ends.

12. The main submissions of Mr Harris are that:

- viii) The applicant's design is almost identical to that of the proprietor.
- ix) In normal use, the ends of the collar have little or no impact because they cannot be seen, particularly if the outer end is located under the animal's chin.
- x) The rounded end is functional.
- xi) Although the other products (the straps etc) are not sold as pet collars, the registered design still lacks novelty compared to such products as they could be used as pet collars without modification.
- xii) The design is dictated by technical function and is therefore contrary to section 1(C)(1) of the Act. I should flag here that no leave has been requested to add this ground so I will say no more about it.

13. The proprietor filed a witness statement. It is from the proprietor herself, Ms Gemma Lockwood. The points she makes are that:

- i) The applicant has not sold collars with rounded ends. The collars they have sold are not identical due to the differences in the ends.
- i) The differences mean that her design has individual character.
- ii) A picture is provided of a puppy wearing a collar in which the rounded end of the collar is clearly visible. The end appears to have peeled back slightly. The end of the collar is towards the back of the puppy's neck.
- iii) The other evidence (*Velcro* straps with rounded ends) is not relevant because the straps do not come from the pet sector.
- iv) Whilst manufacturers have been making products with rounded ends prior to the relevant date, this has not been in the pet sector.
- v) When wishing to buy a whelping collar, a relevant consumer would not look to a different sector to buy one.
- vi) The applicant brought one of the proprietor's round ended collars and then started selling its own version despite the product carrying a statement that the design was registered. The sales continued until eBay and Amazon took steps to remove the listings.
- vii) The proprietor has no objection to the applicant selling collars with straight cut ends.

14. For sake of completeness, I will touch on the submissions of the applicant filed in lieu of a hearing. It submits that:

- i) The proprietor has accepted that identical designs have been disclosed (as per iv above).
- ii) Whilst the informed user may be relevant for the test of individual character, it is not relevant to the test for identity.

- iii) Pet collars (for example of fabric or leather) have for many years had rounded ends.
- iv) The two parties' products differ only in immaterial details, the choice of end being banal and functional.
- v) The ends of the collars are hardly visible in use and the photograph of the puppy showing the collar's rounded end is potentially staged, but, in any event, is not an image which represents the vast majority of situations.

### **Assessment and findings based on the applicant's disclosed product**

15. To survive the invalidity claim under section 1B, the registered design must be new and have individual character. I will begin by assessing whether the registered design passes the newness test. To be a new design, it must not have an identical counterpart that has been made available to the public prior to the relevant date, or, alternatively, a counterpart which differs only in immaterial details.

16. It is common ground that the product the applicant disclosed prior to the relevant date is identical (or virtually so) to the registered design save in one aspect, namely, the straight ends compared to the rounded ends. This is what the respective designs look like when fastened:



17. The applicant submits that the difference is immaterial, whereas the proprietor considers that it represents a significant feature which not only creates a material difference, but also creates a different overall impression. In terms of whether the difference is immaterial or not, I come to the view that it is immaterial. It is easily the sort of difference that could be missed or overlooked. When one considers the designs as a whole (which one must) the way in which the end of either product is finished is insignificant. I accept that it may be possible for the ends to be finished in a more significant manner so as to create a more material difference, but that is not the case here. Given my finding that the difference is immaterial, the designs are to be considered identical with the consequence that the registered design is not new. **This alone means that the claim succeeds and the registered design is deemed invalid.** In reaching this view I have not ignored the photograph of the puppy wearing a collar. However the images I have used above represent a fair way of comparing the respective designs and in my view exemplifies the immateriality of the difference.

18. In case I am found to be wrong on my newness finding, I will also consider whether the proprietor's design has a different overall impression from the applicant's collar. There are a number of factors to consider.

## **The informed user**

19. It is clear that the conflict relates to whelping collars. It follows that the relevant informed user is a user of such items and possesses the characteristics set out in the case-law (see paragraph 7 above).

## **Design freedom**

20. In order to function properly, whelping collars will need to be long enough to fit around the neck of the animal, but thin enough to be worn comfortably. Some form of fastening will also be needed. Whilst these factors provide some design constraints, a designer still has freedom in terms of how, exactly, the requirements can be met, and, also, freedom to choose designs incorporating surface decoration. Whilst the potential to use surface decoration will provide a designer with a wide degree of design freedom, this is not pertinent here because this dispute is about the shape and configuration of certain designs. The design freedom in terms of shape and configuration is less, but there is still some.

## **The differences between the earlier design and the design corpus**

21. There is no evidence as to the existing design corpus, so one can only couch this in neutral terms. The submissions by Mr Harris as to the design corpus are not supported in evidence.

## **Conclusion**

22. Even if I was wrong to have concluded that the difference in the collar endings is immaterial, it does not follow that proprietor's design has individual character. To say otherwise would result in the test for individual character serving no purpose. I come to the view that the difference in endings is not sufficient for the informed user to regard the registered design as having individual character compared to the applicant's collar. They are extremely similar in overall look. I also accept that the rounded end is driven more by function than for its design characteristics and this will not be lost on the informed user. Although the functional aspect of the rounded end was mentioned in the "evidence" to which I have accorded little weight, this would, in any event, be fairly obvious to an informed user. Neither has the proprietor disputed that this is the case. One must be careful not to discount features of design simply because they are functional, but in circumstances like the ones here, where the difference is so small (and functional), the informed user is unlikely to place any significance on this as part of the overall impression that will be perceived of that design. Having weighed the various factors, I conclude that the overall impressions are the same. They are both simple, overlapping strips which fasten round the neck of the animal using *Velcro* (or similar material). **The design is invalid for this reason also.**

## **Assessment and findings based on the other products**

23. The applicant has also relied on the publication of articles in different sectors which consist, essentially, of round-ended *Velcro* straps and ties. I reject the claim for two reasons. Firstly, despite the applicant claiming in its submissions that such

prior art was part of its pleaded case, I do not consider this to be so. Whilst the applicant referred to rounded ends and machines for making rounded ends, at no point in the pleading did it refer to the prior disclosure of a product which matched that of the proprietor. The existence of machines for making rounded ends, or that Ms Edwards has enquired about one, does not provide any ammunition for declaring the design invalid. Secondly, the “evidence” filed in support of the claim is not evidence as per rule 21(1) of The Registered Designs Rules 2006 and thus has little weight.

24. Had the issue been properly pleaded and properly evidenced, then I would have found in favour of the applicant. The other designs are clearly identical (or differ only in immaterial detail). Whilst it is not completely clear whether her words can be taken as an express acceptance of this, Ms Lockwood does not appear to greatly dispute the fact. The main point she makes is that the designs come from a different market sector. This argument is not relevant because, as the applicant points out, the informed user (and consequently the market sector with which the informed user is familiar) is not a factor in the assessment of identity between designs. Whilst section 1B(3) introduces the concept of the informed user, this is only to decide whether the design has individual character.

25. The different market sector point could be an argument to say that the disclosure should not count due to the exception contained in section 1B(6)(A) of the Act which reads:

“it [the disclosure] 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.”

26. In other words, the disclosure would not have become known to a person carrying on a business in the EEA who specialised in the whelping collar sector. However, this, according to the current state of the jurisprudence, is not the correct test (see the judgment of Mr Justice Arnold in *Magmatic Limited v Pms International Limited* [2013] EWHC 1925 paragraph 33-41). The correct test is whether the disclosure would be too obscure so that it could not have become known by persons in the sector of the disclosed product. Thus, the arguments of Ms Lockwood would have failed and I would have held the designs to be identical.

27. Regardless of this finding, the design is, in any event, invalid on account of the applicant’s prior art.

### **Costs**

28. The applicant having succeeded, it is entitled to a contribution towards costs. I have taken into account that the applicant was represented, albeit, not for all of the proceedings. My assessment is as follows:

Official fee: £50

Filing and considering statements of case: £150

Filing and considering evidence: £500

Witten submissions: £300

29. I therefore order Ms Gemma Lockwood to pay Cool Collars Ltd the sum of £1000. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

**Dated this 11<sup>th</sup> day of November 2015**

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