

O-110-16

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 4033000
IN THE NAME OF RED KITE PRODUCTS LTD
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND
A REQUEST TO INVALIDATE (NO. 63/14)
BY DAVID CALDER**

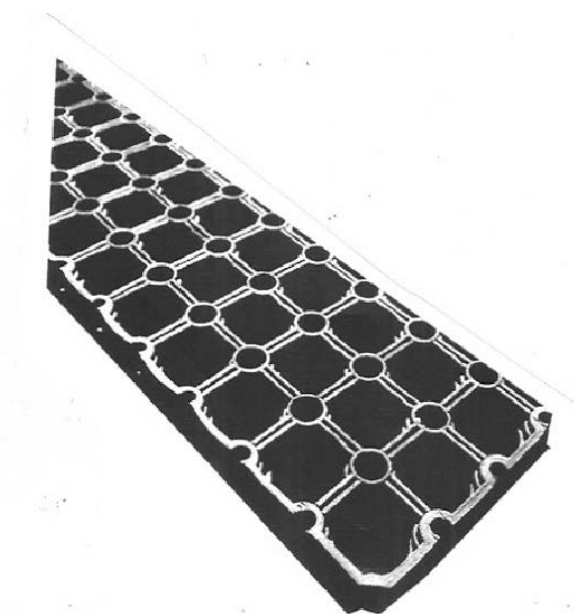
The registered design

1. The registered design the subject of these proceedings was filed by Red Kite Products Ltd (the proprietor) on 25 November 2013. The description of the design was provided in the following terms:

“A grid of squares with a circular hole in the middle and with small holes intersecting the corners of the squares, made from rubber, plastic or silicone that creates a wheel cover that can be fitted to a golf trolley wheel.”

2. A side front perspective view and a plan view were provided with the application, both of which show the circular holes within each square of the product. They also clearly show, along with the description, that the design application was made in respect of a three dimensional product.

3. During the examination process changes were suggested to the applicant, which were accepted. These were duly made and a certificate of registration was granted on 3 April 2014. The registered design is described as a “repeated surface pattern for golf wheel protectors” and is depicted below:



4. The design which has been registered under number 4033000 appears to represent a repeating surface pattern for golf trolley wheels. The representation of the design does not show the circular holes which are visible on the initial application. Furthermore, the registration takes the form of a two dimensional pattern and not the three dimensional design for which design registration was sought.

The invalidation application

5. On 11 December 2014¹ David Calder (the applicant) requested the invalidation of the design under section 1B² of the Registered Designs Act 1949 (the Act), which

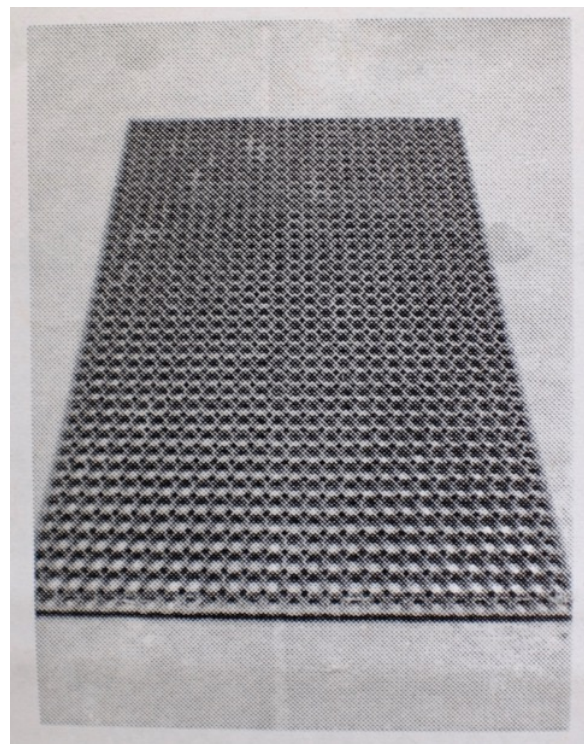
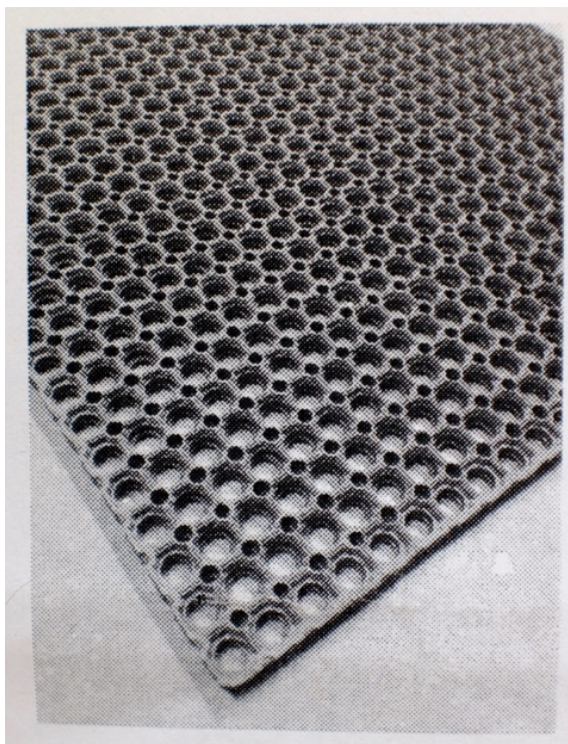
¹ Subsequently amended and re-filed on 19 February 2015.

relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The design which, it is claimed, destroys the novelty of the registered design is “commercially available matting primarily used in grass stabilising arenas, including equestrian ground protection, sporting venues, car parking solutions and child play area protection”.

6. The applicant does not provide a specific date at which the earlier design entered the public domain but submits the following in his statement of case:

“Scotplay are a supplier of this matting in the UK and Mr Campbell has indicated that his company have been supplying this matting for 14 years...Enquiries have also revealed that Fieldguard Ltd...have confirmed that they supply Red Kite Products with similar rubber matting and have further confirmed that they have been supplying this matting for many years.”

7. The applicant provides examples of matting supplied by Scotplay as follows:



8. He says of these images:

“The photographs...show the matting supplied by Scotplay (Dimensions 1.5m x 1m) highlighting the repeated surface pattern, which [the proprietor] has laid claim to in their registration.”

9. He also provides the following description and images of products available from Fieldguard³:

² This is relevant in invalidation proceedings due to the provisions of IZA which gives the grounds for invalidation of a registered design.

³ The image quality of these examples is poor and I am unable to read the description of the products below each image.

“Fieldguard Grass Re-inforcement and Gravel Containment Mats – Honeycomb Mats

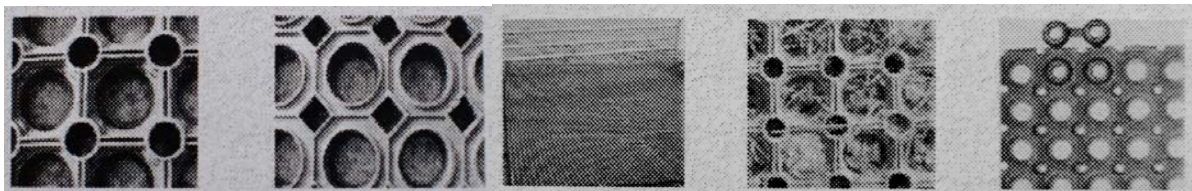
The M5 mat is a series of holes surrounded by fully vulcanized latex, or latex/Nitrile mix. It is flexible, hardwearing and long lasting. The holey mats (Or ring mats, honeycomb grass protection mats) come in two thickness’, three sizes and three grades. The honeycomb mats are ideal for allowing new grass growth on poached areas, reducing mud in heavily used gateways, creating slip free pathways, grass protection, or for containing gravel. Because the honeycomb grass protection mats (Ring mats) are flexible, they can be laid straight onto existing grass, or hard standing with no pre-preparation. They are totally non slip in any weather making them ideal for use as muddy gateway mats.

The thickness of the following honeycomb mats: M522/M52L/M52LO are 7/8" (22mm). Honeycomb Grass Protection Mats can be locked together with inter-locks or electricians cable ties.

The smaller honeycomb mats are ideal for muddy gateways or poached ground and can be re-sited easily. The larger ones, once laid, are difficult to move as earth builds up inside the holes and makes the mat very heavy indeed. The heavy duty mats are less flexible and should be laid where the earth is very soft, or when regularly used by vehicles.

An alternate method of laying mats on very muddy ground is to level the area and lay turfs then lay the mats on top. The mats will protect the newly laid turf and allow it to take while the turfs will support the mats.”

10. Examples are provided of the surface of the mats, as follows:



11. The applicant states that Fieldguard have confirmed that they supply the proprietor with similar rubber matting of the type shown in the pictures above and have confirmed that they have been a trading in such matting for many years.

12. Attached to the applicant’s statement of grounds is an email from Fieldguard confirming that they have sold a number of different mats for almost 30 years and that the proprietor is one of their customers.

13. The proprietor filed a counterstatement denying the claims. It states:

“Whether we make these wheel covers from our own mouldings, or by adapting other products or from existing suitable materials or matting is not relevant – it is the unique design of the surface pattern of golf wheels where we have been first on the market to design and successfully sell

this type of pattern golf trolley wheel product to golfers. Both our product, which we market as 'Gliders' and our competitor's product 'Hedgehogs' are accepted products recommended by golf professionals and golf courses."

14. During the period allowed for filing his evidence, the applicant filed a document titled 'Statement of Applicant'. The registered proprietor filed evidence in the form of a witness statement, with two exhibits. The applicant filed submissions in reply.

The applicant's submissions

15. The applicant filed a document on 27 May 2015 which is titled, 'Statement of Applicant David Calder'. The document does not include a statement of truth and the signature is not dated. The relevant points arising from this submission are as follows:

- "...the photograph in the registered design merely shows a screen shot of a piece of mat."
- This type of matting has been available for a number of years.

16. At the bottom of the first page of his submissions the applicant states:

"It is a great leap to suggest that what they have registered is anything to do with Golf Wheel Protection.

Surely the time for an accurate description of his product should have been at the time of the registration.

It is only now during this invalidation process that Colin Aitkenhead refers to his product as Golf Trolley Wheel Protectors.

It would appear to me that what Colin Aitkenhead thinks he has designed and what he has registered are two different things."

The proprietor's evidence

Witness Statement of Dr Colin Aikenhead

17. Mr Aikenhead states that he is the Director of Red Kite Products Limited, a position he has held since the company was formed in November 2013.

18. The main points arising from his statement are as follows:

- The product, called 'GLIDERS', to which this design registration is applied, was first launched in 2013 and has been continuously sold via eBay, Amazon and to golf shops and golf courses since that year.
- Mr Aikenhead has not heard of 'Scotplay and Sports' and does not use any of their products.

- Mr Aikenhead is familiar with 'Fieldguard' who he states DO NOT supply the mouldings that are the subject of this design registration but do supply mouldings used for a different product supplied by the proprietor.

19. At page 2 of his witness statement Mr Aikenhead states:

"We have several suppliers who supply us with relevant mouldings and components that are suitable for different golf trolley wheels which vary significantly in their size, shape and performance which require different designs to satisfy fitting, assembly and performance requirements. We second source also to ensure security of basic mouldings to meet our requirements. Again, we emphasise that the material bears zero relevance to this case, it is the LOOK of trolley wheels that we are claiming..."

Was the 'Gliders' type of product on the market before, being used by thousands of golfers? NO. That's because no-one had thought of it. Is it now – YES. That's because Red Kite Products Ltd, thought of it, designed it and marketed it with a lot of effort and [the applicant] tried to copy us..."

20. On page 3 of his statement, Mr Aikenhead states:

"[The applicant] also seems to want to put into doubt our design capabilities. I have a PhD in Chemical Engineering, over 50 years experience in industry – a good part of it involved in plastics and rubber manufacturing, processing and moulding techniques. My son, who has been materially involved in the company, is highly qualified with a degree in Product Design and again many years experience in such industries. We brought our expertise to bear to research, design and produce our product to compete with the only product on the market at that time called 'Hedgehogs'."

The legal background

21. Section 1B of the Act 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)...

22. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*⁴. The most relevant parts are as follows:

⁴ [2012] EWHC 1882 (Pat)

“The informed user

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

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

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

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.”

23. As can be seen from paragraph 58 above, the Act requires a design to be both new and to have individual character. A design will fail the newness test if it is identical to a previous design, or one differing only in immaterial differences. Thus a design may be new because it differs in material details compared to previous designs, but may still fail to create a different overall impression compared to previous designs and therefore to lack the necessary individual character.

24. The relevant date is the date on which the proprietor applied to register his design, in this case, 25 November 2013.

The prior art

25. 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, unless the exceptions in subsection (6) apply. This means that the relevant date for my assessment is 25 November 2013. Any prior art must have been made available to the public prior to this date.

26. In his statement of grounds the applicant does not give a specific date in respect of the prior art he has provided. He does give details from the two companies which provide the products on which he relies. Mr Campbell at *Scotplay* indicates that sales of matting have been made by his company for 14 years. Mr Matthews at *Fieldguard* states that his company have been selling such matting for ‘nearly 30 years’.

27. There are a number of different mat designs shown by the applicant in his statement of case. The moulding patterns include, inter alia, circles, squares, octagons and straight lines. It is not clear from the comments of either Mr Campbell at *Scotplay* or Mr Matthews at *Fieldguard* which of the mats in their product ranges were available before the relevant date, nor is it clear where these mats were made available and to whom. The mats offered by Mr Campbell and Mr Matthews before the relevant date may be those depicted in the applicant’s statement of case or, they may not.

28. Taking account of all of the material provided in support of this application, I cannot establish the nature and scope of the prior art. Consequently, I cannot go on to consider whether the contested design is new and, if necessary, if it has a different overall impression, as I cannot determine what it should be compared to. Having reached such a conclusion the request for invalidation fails at the first hurdle.

CONCLUSION

29. I have found that the invalidation against this design has failed.

COSTS

30. The registered proprietor has been successful and is entitled to a contribution towards his costs. I have taken into account that he was not represented and make the award as follows:

Filing and considering statements of case: £150

Filing and considering evidence: £300

Total: £450

31. Subject to appeal, the above sum should be paid by David Calder to Red Kite Productions Limited within 14 days of the end of the period allowed for appeal or, if there is an unsuccessful appeal, within 14 days of the conclusion of those proceedings.

Dated this 30th day of March 2016

**Al Skilton
For the Registrar,
The Comptroller-General**