

**O-252-16**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF**

**REGISTERED DESIGN NO 4040424**

**OWNED BY STUART MAGUIRE**

**AND**

**AN APPLICATION (No. 20/15) BY H STEBBINGS**

**TO INVALIDATE THE REGISTERED DESIGN**

## The background and the claims

1. The registered design the subject of these proceedings was filed by Mr Stuart Maguire (the proprietor) on 9 April 2015. The design is described as a “wedding heart box”. Seventeen<sup>1</sup> representations are provided showing the design from various different angles. I will detail more of the representations later, but, for the time being, I depict just one below so as to give a feel for what the registered design looks like:



2. The proprietor made “no claim for the materials, colour, names and date shown”. A certificate of registration was granted on 22 May 2015.

3. The applicant for invalidation is H Stebbings. This appears to be a personal name rather than the name of a business, although, nothing turns on this. The applicant’s claim is made under section 1B the Registered Designs Act 1949 (the Act), a claim that is based upon the proprietor’s design not being new and lacking individual

---

<sup>1</sup> There were initially 16, but a further representation was provided when dealing with a formalities query raised by the IPO.

character. The prior art alleged to give rise to this claim is an earlier registered design owned by the applicant, namely UK registered design 4035208. It is claimed that products made to the design were first sold on a website in March 2014 (with some private sales being made prior to this at local wedding fayres and through friends and family). The applicant's earlier registered design was filed on 29 April 2014 and its certificate of registration granted on 28 July 2014. The applicant's earlier design also contains multiple representations, but, for the time being, I depict just one below:



4. The applicant initially made a further claim under section 11ZA(1A) of the Act, also based on the earlier design mentioned above. This was struck out as misconceived, given that such a claim relates to earlier registered designs published after the design the subject of these proceedings was filed. As I will come on to, that is clearly not the case here.

5. The applicant considers the proprietor (whom he believes to work for Bespoke Lasercutz) to be a supplier to multiple parties who are selling the “drop top guest book item” (a reference to the applicant's design) on ecommerce platforms and that the

applicant has enforced its rights against such sellers. The applicant also refers to potential infringement of its registered design. These matters are not pertinent, so I will say little more about them. The question before this tribunal is straightforward. Is the proprietor's design new, or does it possess individual character, in comparison to the applicant's earlier registered design?

6. The essence of the applicant's complaint is that its design:

“...is a frame surround encasing a clear pane presented with a top slot through which tokens may be dropped: no claim is made for the materials of construction nor the colours in which the item is presented. Personalisation is deliberately excluded as it is the base product rather than the customisation we are protecting. In addition our frame includes a “stopper” to “close” the slot that the tokens are dropped through”

7. The applicant considers the proprietor's design to be identical or too close to its own design.

8. The proprietor filed a counterstatement denying the claims. The proprietor denies that he has been involved in any ecommerce disputes with the applicant. He considers his design to be different in “design and appearance” to the applicant's design. The essence of the defence can be seen in the following statement from the proprietor:

“The idea of the product was created prior to March 2013, evidence shows other creators than H Stebbings. I interpreted the idea and created my own unique design and layout for this product. The overall appearance of my product is substantially different to others that are on the market and I have been given design rights for this.”

9. Both the applicant and the proprietor have represented themselves throughout the proceedings. Neither asked for a hearing or filed written submissions in lieu of a hearing. I therefore make this decision after a perusal of the various documents filed.

## **The evidence**

10. Information from the respective sides' statements of case can be taken into account as evidence in these proceedings, as per the provisions of rule 21(1)(a) of the Registered Designs Rules 2006. The only other evidence in these proceedings came from the applicant, who filed a further written statement dated 9 September 2015. Beyond what I have already set out above, there is nothing in the rest of the evidence that needs to be summarised, as it does not go to matters that are relevant to the question before the tribunal.

## **Validity of the applicant's design**

11. I am aware that a claim has recently been determined in the applicant's favour with regard to an attack on his/her design, a claim which was based on an even earlier design. The applicant's design remains registered. I am also aware of another invalidation claim launched against the applicant's design, but one which has yet to be determined. However, it is not necessary to await the outcome of such proceedings because this case is about public disclosure/novelty, not about the validity of the earlier design.

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

12. 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)--”

13. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>2</sup>. The most relevant parts are reproduced 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);

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

---

<sup>2</sup> [2012] EWHC 1882 (Pat)

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.”

### **The relevant date**

14. The relevant date is the date on which the proprietor applied to register his design i.e. 9 April 2015.

### **The prior art**

15. The novelty in a registered design can only be destroyed if the alleged prior art has been made available to the public before the relevant date. The prior art the applicant relies on is his/her own registered design. The applicant’s design was filed on 28 April 2014 and its certificate of registration granted on 28 July 2014. The design would have appeared in the Designs Journal around this time and would also have been on the UK designs register. It is clear that the applicant’s design was made available to the public before the relevant date of 9 April 2015. In such circumstances, it is not necessary to also establish whether the design has been sold to the public, therefore, the evidence relating to the first sales of products made to the design on a website in May 2014 takes the applicant no further forward.

### **Scope of the earlier design and the relevant comparison**

16. Before making the comparison, it is important to decide what the correct comparison should be. The applicant highlights that the earlier design is for the base product, the frame with the top slot through which tokens are passed. The proprietor’s design also contains a frame, but tokens are already present and depicted within the frame (the tokens are in the shape of hearts). It is not clear whether the proprietor is contending that the presence/absence of the heart shaped tokens creates a difference from the earlier design. He simply says that his product creates a unique design and layout and differs substantially. I will, therefore, countenance the possibility that the proprietor considers that the absence/presence of heart shaped tokens is at least part of the substantial difference being referred to. In contrast, the point the applicant

appears to be making is that his/her base product has been copied and, so, it does not matter that the proprietor's design has this extra feature.

17. In *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat) (11 July 2013) ("*Trunki*"), Arnold J dealt with a similar issue. The case involved designs for children's suitcases, with the claimed infringing design having additional graphics not contained in the earlier registered design. Arnold J stated:

"67. A similar issue arose in *Procter & Gamble*, where Jacob LJ said at [40]:

"... I should record that [counsel for the defendant], under a little pressure from the Court, abandoned his point about decoration, rejected by the judge at [71]–[73]. He was right to do so. The registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant."

68. Against this, counsel for PMS relied on what Jacob LJ had said in *Samsung v Apple* at [15]–[20]. As counsel for Magmatic pointed out, however, in that case Apple contended, and it was common ground, that an important feature of the registered design was the absence of ornamentation. In those circumstances Judge Birss held, and the Court of Appeal agreed, that the informed user would take the presence of Samsung's trade mark on the alleged infringement into account, but would only give it slight weight.

69. In my judgment, the position in the present case is the same as in *Procter & Gamble*. The CRD is evidently for the shape of the suitcase, and the proper comparison is with the shape of the Kiddee Case."

18. The *Trunki* case was appealed to the Court of Appeal<sup>3</sup>. The leading judgment was given by Lord Justice Kitchen. I note the following guidance:

---

<sup>3</sup> *Magmatic Ltd v PMS International Ltd* [2014] EWCA Civ 181

"36. On appeal to this court (*Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8), the defendant abandoned the point, as recorded by Jacob LJ:

"40. Before going on to consider this argument in detail, I should record that Mr Carr, under a little pressure from the Court, abandoned his point about decoration, rejected by the Judge at [71-73]. He was right to do so. The registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant."

37. If I might respectfully say so, this observation of Jacob LJ seems to me to be entirely right in the context in which it was made. Before carrying out any comparison of the registered design with an earlier design or with the design of an alleged infringement, it is necessary to ascertain which features are actually protected by the design and so are relevant to the comparison. If a registered design comprises line drawings in monochrome and colour is not a feature of it, then it cannot avail a defendant to say that he is using the same design but in a colour or in a number of colours. As Lewison J observed, were it otherwise, the practical effect of not claiming a colour would be to limit the scope of protection to the colour white, and that would defeat the purpose of not claiming colour in the first place."

19. The Court of Appeal overturned the judgment of Arnold J, principally because his assessment as to the scope of the earlier registered design did not include two aspects: i) that it was intended to represent a horned animal and, ii) that although colour was not a feature of the earlier design, its colour contrast was. Both these factors contributed to the overall impression of the earlier registered design and, thus, it was wrong to have conducted the comparison purely on the basis of the outline shape of the earlier registered design (compared to the outline shape of the alleged infringing design).

20. What is being referred to above represents what is often called the “like for like” test. It should be noted that the *Trunki* case was appealed to the Supreme Court<sup>4</sup>. Its judgment casts no doubt on the “like for like” test. The judgment was more about how the earlier design in that case was to be interpreted (it agreed with the Court of Appeal that the earlier design was for more than just shape and configuration).

21. In my view, the correct comparison in these proceedings is to compare the shape and configuration of the frames themselves, and to ignore the added embellishment created by the heart shaped tokens in the proprietor’s design. The earlier design, unlike the eventual outcome in the *Trunki* case, is for nothing more than the shape and configuration of the frame. Thus, the respective shapes and configurations of the frames are what must be compared. I appreciate that the *Trunki* case was in the context of infringement, not validity. However, the test to be applied is the same (newness and individual character). It would be odd if one were left with a situation in which a later design may infringe an earlier design, but was nevertheless valid, even though the same test is meant to be applied.

### **The key representations of the competing designs**

22. For the purpose of both the newness test, and the test for individual character, I set out below various representation of the competing designs. As stated earlier, there are many more representations, but those I set out below are sufficient for the comparisons that must be made.

---

<sup>4</sup> [2016] UKSC 12

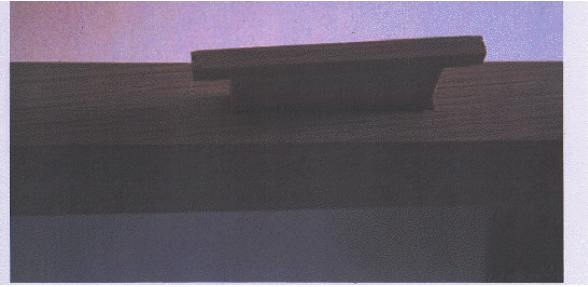
**Prior Art (front view)**



**Proprietor's design (front view)**



**Top view**



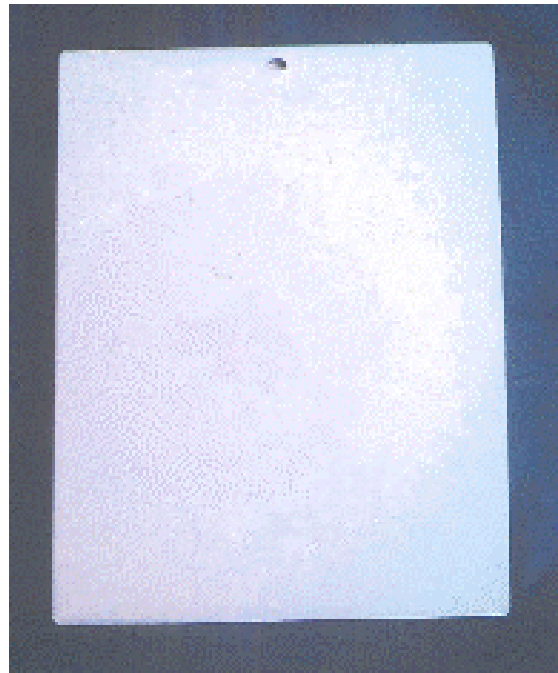
**Top view**



**Back view**



**Back view**



### **Is the proprietor's design new in comparison to the prior art?**

23. According to section 1B(2) of the Act, 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”.

24. The materials/colours used for the designs have been disclaimed so cannot make a difference. The applicant's prior art (its earlier registered design) has a rectangular shaped frame, as does the proprietor's design. However, as I will come on to say in more detail later, they are clearly not identical; the proprietor's design has a more rounded, fluid feel. There is a difference in the backs of the designs too; the earlier design has clips to hold a backing board in place, whereas the proprietor's design does not appear to have clips and has no apparent removable backing board. Furthermore, the respective designers have designed the token insertion mechanisms in very different ways. The earlier design has a T shaped slot cover (best seen in the second of the representations) whereas the proprietor's design has a much longer slot cover, not T shaped but instead with two angled cut-outs (best seen in the first and second representations). The difference in the slot covers is certainly not immaterial. This is enough to mean that the proprietor's design passes the newness test. The same applies to the differing shapes of the rectangular frame and, also, the different back designs.

25. I therefore find that the registered design is not identical to the identified prior art. They differ in more than immaterial differences.

### **Does the proprietor's design have individual character compared to the prior art**

#### **The informed user**

26. The informed user is a user of the type of products to which these designs relate. Both parties describe their designs differently. However, the real essence of both is that they are frames with the capacity to insert tokens for display purposes. The

informed user of such items will possess the characteristics set out in the case-law (paragraph 13 above).

### **Design freedom**

27. Neither side focus specifically on the issue of design freedom. The requirement of the items to have some form of frame to hold the tokens provides an aspect of design constraint. The most suitable way of achieving that feature, at least in order to achieve a more economic manufacturing process, will be rectangular or square. The articles will also need some mechanism to allow insertion, retention and possibly removal of the tokens, which adds a further design constraint. However, I would not pitch such constraints at a significant level because design freedom can be exercised in terms of how these features are built into the frame itself.

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


28. Neither side has filed evidence regarding the design corpus. One would imagine that typical designs in this sector would be dominated by square or rectangular frames given the propensity of such structures in the picture/photo/mirror frame field. That said, the degree to which the other features (particularly the token slot cover) stands out from the norm is not known. Without evidence, I must take a neutral position on this.

### **Does the later design have individual character?**

29. This question must be answered with reference to the overall impression of the respective designs on the informed user. To possess individual character the overall impression of the proprietor's design must differ from that of the identified prior art.

30. The basic outline shape of the proprietor's design comprises a rectangular frame. A rectangular shape is present in the prior art and, it is fair to say, present in many other articles in the field of picture/photo/mirror frames. The basic shape of the frame is not, though, the same. To illustrate the point, the following two images show a close up of the designs.



Prior art	Proprietor's design
	

31. As can be seen, the shape of the prior art is squared off at right angles, no doubt the result of the method of construction involving the jointing of the vertical and horizontal pieces that comprise the frame. The method of construction *pe se* is not relevant, but the resulting appearance is. In contrast, the proprietor's design has a more rounded, fluid feel. It may be that the method of construction is different, but, again, the resulting appearance is what matters.

32. As already observed, there is also a difference in the token slot covers, best seen in the second representations at paragraph 22 above. Whilst when on display the slot covers may not be fully apparent, they will nevertheless be clearly apparent when the slot covers are removed and put back in place. This is part of the normal use of the products and can, therefore, be taken into account in view of the provisions of section 1B(8)(a). It is self-evident that this aspect of the competing designs is very different.

33. In terms of the backs of the designs (see the third representations at paragraph 22 above) they are also different, as I have already described in paragraph 24.

34. In terms of what significance these features have on the informed user's perception of the overall impression, I come to the view that both the slot covers and the basic frame shapes (and the differences that exist between them) will be noted by the informed user. Whilst both frames are very simple, and they perform a function, the shape is nevertheless one of the key features of the designs. Similarly, the token slot covers, which, again, perform functional roles, still contribute to the overall impressions. Although these two features serve largely functional roles, the exact shapes and configurations used are likely to be considered by the informed user to

represent some degree of design choice. Consequently, these differences, in combination, indicate that the overall impression of the proprietor's design is different from the overall impression of the identified prior art.

35. I should also add that even if I am wrong to have held that either the exact frame shape or the slot covers should not have materially contributed to the respective designs' overall impression, I would have reached the same conclusion on the basis of just one or other of the differences *per se*. In other words, the outcome does not rely on the combination of differences, either one would have done.

36. For the sake of completeness, I should indicate that I am less convinced that the back of the respective designs has any material impact on the competing overall impressions. I say this for two reasons. First, the back of the proprietor's design is not something which should be considered as part of its normal use. In contrast to the prior art, the back of the proprietor's design does not appear to have a removable backing board and, thus, its back has no real impact in use and will, for obvious reasons, not be seen when it is being displayed. Consequently, the back of the design cannot make a difference and is not to be counted. Nevertheless, for the reasons already given, the other differences are enough.

### **Conclusion**

37. The application for invalidation fails. The proprietor's design is new and has individual character compared to the identified prior art. The proprietor's design may remain registered.

### **Costs**

38. The application having failed, the proprietor is entitled to an award of costs. I take into account that the proprietor was not represented so did not incur any legal fees. Further, the proprietor has played very little role in the proceedings beyond filing his counterstatement. My assessment is as follows:

Filing and considering statements of case: £150

Considering evidence: £50

39. I therefore order H Stebbings to pay Mr Stuart Maguire the sum of £200. 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 19<sup>TH</sup> Day of May 2016**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**