

O-388-16

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF

REGISTERED DESIGN NO 4035208

OWNED BY H STEBBINGS

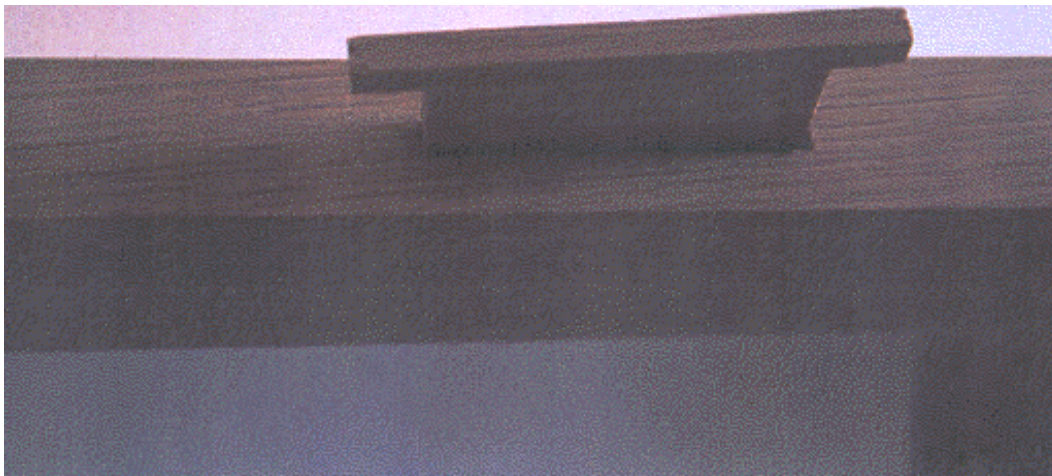
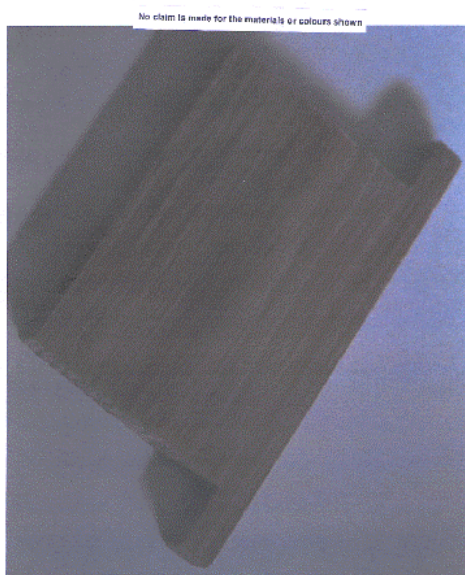
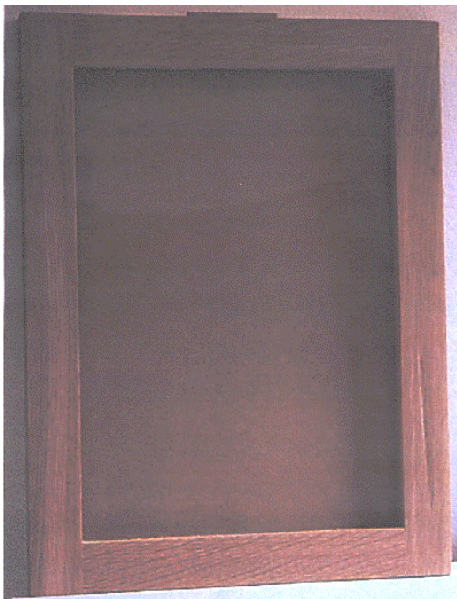
AND

AN APPLICATION (No. 88/15) TO INVALIDATE THE DESIGN

BY ALL LABELS LTD

The background and the claims

1. The registered design the subject of these proceedings was filed by H Stebbings (“the proprietor”) on 16 April 2014, but, given an inadequacy in the representations filed, it was deemed to have been filed on 28 April 2014, the date on which adequate representations were provided. The design is described as a “drop top guest book frame”. Whilst more are provided, the following three representations show what the design looks like.



2. The proprietor made the following disclaimer: “no claim is made for the materials or colours shown”. A certificate of registration was granted on 22 May 2015.

3. The applicant for invalidation is All Labels Ltd. The applicant’s case is pleaded under sections 1B, 1(C)(1) and 1(C)(2) of the Registered Designs Act 1949 (“the Act”). The following is a summary of the grounds:

- Section 1(B) – It is claimed that the “best view” representation and formal representations 1, 2, 7, 8, 9, 10, 11, 12, 13 and 14 are no different to standard picture frames that have been used for many years, and, also, no different from other shadow boxes (which, apparently, are now commonly described as drop-boxes).
- Section 1C(1) – It is claimed that formal representation 6 merely shows a slot through which items can be dropped “much like a coin slot in a money box” and, thus, is a feature solely dictated by technical function.
- Section 1C(2) – It is claimed that formal representation 5 consists of the shape of the plug which is inserted into the slot (in representation 6). It is claimed that this shape must necessarily be reproduced in its exact form and dimension to permit it to be incorporated, mechanically connected, placed in, around or against, another product so that either may perform its function.

Evidence accompanied the application which I will summarise later.

4. The proprietor filed a counterstatement. It is claimed that the design is valid. It appears to be accepted by the proprietor that picture frames and shadow boxes are ubiquitous, but the proprietor argues that this is not pertinent. The claimed absence of pertinence appears to be based on the inclusion in the design of the “slot cover T feature” which the proprietor considers sufficient to provide a different overall impression from other frames/shadow boxes. It is also stated that the slot and cover represents an exercise of design freedom even though they perform functional requirements. It is fair to say that the proprietor appears to have conflated all three grounds together, but it is clear that the claims are denied. I also note that the

proprietor highlights an earlier decision of this tribunal which was issued on 10 December 2015 (BL 0-586-15) in which the registered design was held to be valid, although, that decision related to section 1(B) of the Act only.

5. The applicant is represented by Mayfin IP Limited. The proprietor is self-represented. Only the applicant filed evidence, which was accompanied by some written observations. Neither side asked for a hearing or filed written submissions in lieu.

The evidence

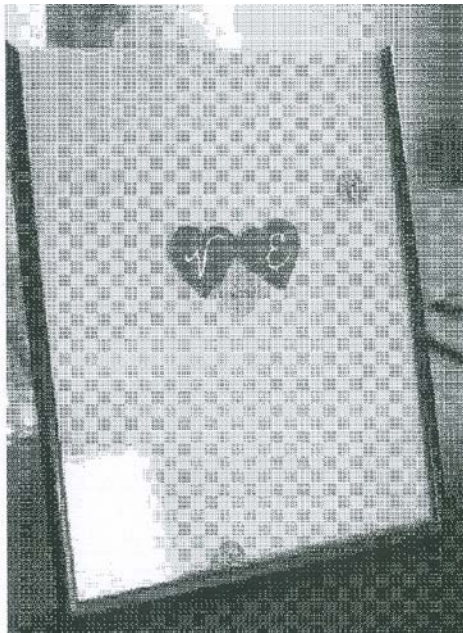
6. Factual material in statements of case can be taken into account as evidence in these proceedings, as per the provisions of rule 21(1)(a) of the Registered Designs Rules 2006. The applicant filed evidence in this manner, which I summarise below. The applicant also filed a witness statement dated 26 February 2016, together with some written submissions. No evidence has been provided by the proprietor.

Applicant's evidence with its statement of case

7. In relation to the section 1B claim, reference is made to two documents: i) a Wikipedia entry for the term, "shadow box" and ii) a blog by someone called Josue Taco. Only the blog was provided, not the Wikipedia entry. If the applicant was expecting the tribunal to simply view the Wikipedia entry on the Internet then it is misguided. The tribunal must be provided with the evidence it is expected to take into account.

8. In relation to the blog, this appears to have been posted on the Internet on 13 September 2013. The blog provides instructions on how to make a drop box guest book in which wedding guests can insert heart shaped tokens. Put simply, the blogger suggests a simple frame construction in which the top horizontal piece is removed (or in the case of the blogger's frame, not added as it was a build your own frame kit) and then put back in place after the guests have dropped in their heart shaped tokens. The evidence is provided to show that the proprietor's representations the subject of the claim are no different from standard picture frames which have been used for many

years, and no different from items described as drop boxes or shadow boxes. I have depicted below the frame used by the blogger, without the top piece in place.



Applicant's evidence filed during the evidence rounds

9. The applicant filed a witness statement during the evidence rounds. It should be noted that its evidence was returned twice due to formatting and other irregularities, therefore, what I am considering was the applicant's third attempt. The evidence comes in the form of a witness statement from Debra J.C. Smith, Patent Attorney and Director of Mayfin IP Limited. Her evidence consists of no more than an explanation of what led to the filing of the application for invalidation. In summary, the applicant received a cease and desist letter from the proprietor in relation to a particular item sold on its website. The item is another heart drop-box. The applicant sought advice from Mayfin, who were then duly appointed to represent the applicant. Correspondence was exchanged with the proprietor to which no response was received. The applicant then filed its application for invalidation. Ms Smith concludes by stating that as the applicant has removed the item from sale from its website, this has led to loss of sales and costs being incurred.

Applicant's written submissions

10. I will break this down in the same way the applicant did in its submissions:

11. Response to counterstatement: The applicant states that one of the problems with the design registration is that the majority of the representations (1, 2, 7-14) show nothing more than parts of a picture frame. Representation 3 is said to be unclear and the best view representation also looks just like a picture frame. Further comments are made in this part of the submissions, but none which I consider relevant to the matters that need to be determined.

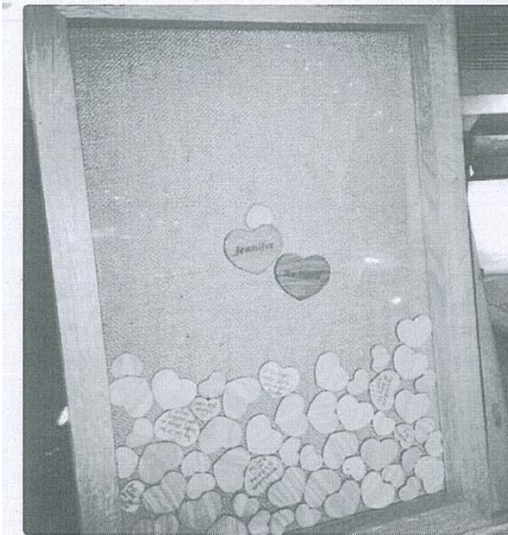
12. Comments on decision O-586-15: This earlier decision relates to an earlier, failed, application to invalidate the proprietor's design. The applicant makes various submissions about the earlier decision:

- i. The applicant agrees with the decision that the basic visual design is of a glazed frame which is banal and commonplace and that the validity of the design rests wholly on the T-section slot cover and whether this imparts individual character.
- ii. The applicant disagrees with the conclusion that the t-slot cover “..has sufficient visual impact for the registered design as a whole to make a different overall impression on an informed user of drop top guest books” [the hearing officer's words]. The applicant states that the t-section slot cover is merely a functional device (see further comments below).
- iii. Whilst the applicant accepts the hearing officer's finding that the inclusion of a slot cover is an exercise of design freedom, it submits that the design freedom should be considered in relation to the slot cover itself as the proprietor had a wide degree of design freedom in developing the slot cover yet chose the minimal functional solution – it therefore considers the slot cover to be no more than the default functional solution, and unworthy of design protection.

- iv. The applicant agrees with the hearing officer that the slot cover is not always visible, but believes matters go further than this. It submits that it is frequently not visible. It states that it is not visible in many photographs on the Internet, when it is wall mounted or when propped on a mantle (normally leaning slightly backwards). It accepts that the slot and the shape of its cover are visible when inserting tokens, but this may be a single occurrence. The applicant considers that the low profile of the slot cover, its small size related to the overall impression, the difficulty in observing its location and shape, together with the infrequency of its use, should all be taken into account when considering how much significance should be placed on the visual impact of the shape of the slot cover on the overall impression created by the design.
- v. The applicant makes a submission that the slot cover could be regarded as a removable part and that third parties may market alternative slot covers to fit the slot. I am not sure what relevance this has, but in my view this seems unlikely.
- vi. The applicant considers that a similar item sold without a slot cover is a commonplace design and would not infringe the proprietor's design. Similarly, a design with a different or more elaborate design would not infringe. It questions whether an identical slot cover sold in isolation (or as part of a discounted bundle) would infringe. Put simply, this is not something I need to determine.
- vii. The applicant asks for clarification of paragraph 27 of the earlier decision. This is not a matter for me.

13. Section 1B prior art: The applicant provides submissions and documents showing what it says is prior art. The difficulty the applicant has here is that none of this has been provided as evidence. As I stated earlier, the documents before me represent the third attempt by the applicant to file its evidence yet what is obviously intended to be factual prior art has not been filed in evidence. I give the evidence no weight. However, in case of appeal, it is useful to record what was provided:

- i) Annex A shows two examples of other drop top guest books. The slot insertion mechanisms cannot be seen. They all have a basic mundane framed configuration. They are all said to have been disclosed prior to the filing of the design in question. By way of example, one of them looks like this:

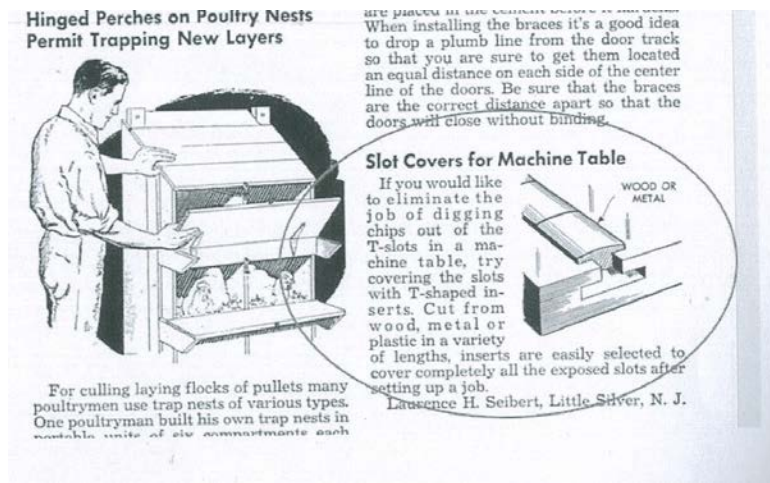


- ii) Also provided in Exhibit A is a picture of a vintage penny drop machine from which one of the originators of the prior art apparently took inspiration. This can be seen below:



Whilst there is an insertion slot, encased in metal which creates a semi-circle on the top front of the article, there does not appear to be a slot cover.

- iii) Annex B shows designs of t-slot covers, although they are not used in relation to frames or drop boxes. The first is a t-shape slot cover for a machine table and the second is a sim/memory card slot cover into which cards are placed and then inserted into an appropriate electronic device. They are shown below:



14. Comments on the t-section slot cover relating to section 1C (technical function):

The applicant provides submissions on the t-section slot cover which it says needs to meet three requirements in order to fulfil its function: i) the need to fit into the slot, ii) the need to be removable from the slot, and iii) that it must not fall through the slot. I note the following further comments:

- i) That whilst there are many possible designs that could meet the requirement of the slot cover, the applicant submits that the proprietor's slot cover, consisting of a small piece of material that fits into the slot, forming a t-section with a piece of material that is larger than the slot it covers and which stands proud of the slot, represents "the minimal functional solution".
- ii) That the t-section slot cover only fulfils the minimum functional requirements and is no different to covers provided with countless everyday objects which have some form of slot, hole or opening. Examples are given of storage jars, bottle or open top boxes. It is stated that, as such, the design is commonplace, meets only functional requirements, and cannot create an original visual appearance. Reference is made to the stoppers on bottles as a further example of a plug that fills a hole and which overhangs for ease of removal.

SECTION 1B OF THE ACT

The relevant legislation and case-law

15. 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)--”

16. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*¹. 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);

¹ [2012] EWHC 1882 (Pat)

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.”

The relevant date

17. The relevant date is the date on which the proprietor applied to register the design (or in this case was deemed to have applied), namely 28 April 2014.

The prior art

18. The only prior art that constitutes evidence in these proceedings is the frame shown in the applicant’s statement of case, from the blog posted by Josue Taco. The other documents showing drop top boxes and slots covers were filed only in submissions and should not be taken into account. However, this does not matter for the following reasons:

- i) The proprietor accepts in the counterstatement that the basic frame shape of the registered design is ubiquitous, thus, it is not necessary, in my view, for the applicant to show that basic frames of the type used in the registered design have been disclosed prior to the relevant date. I will take it that they have.
- ii) The examples showing alternate t-shape slot covers for other products (the work bench and the sim card holder) would not have assisted the applicant, at least not in terms as a piece of prior art because they look nothing like the registered design as a whole (due to it not being used with a frame as per the registered design). In assessing individual character, the design must be compared with a single design as opposed to features from separate designs. This was confirmed by the CJEU in *Karen Millen Fashions Ltd v Dunnes Stores, Dunnes Stores (Limerick) Ltd*, C-345/13 where it was stated:

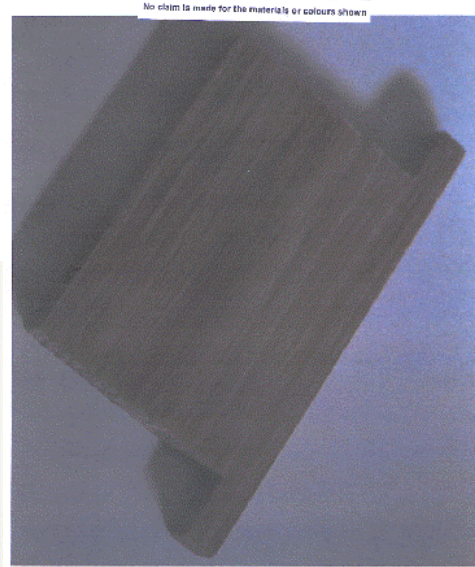
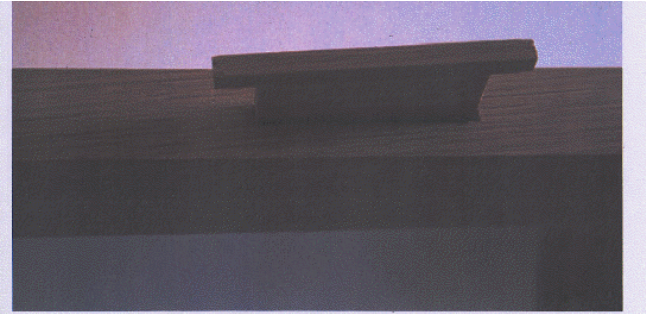
“In those circumstances, the answer to the first question is that Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.”

- iii) Similarly, the vintage penny drop machine which was also depicted in submissions (as opposed to evidence) would not have assisted as a piece of prior art because, again, it looks quite different from the registered design as a whole.

Is the proprietor’s design new?

19. As already stated, I will work on the basis that the basic frame shape of the registered design is not new. However, there is more to the design than that. The following images show some of its other features:





20. 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”.

21. There is, in my view, a fundamental problem with the applicant’s pleaded case. The claim is that the “best view” representation and formal representations 1, 2, 7, 8, 9, 10, 11, 12, 13 and 14 are no different to standard picture frames which have been used for many years, and, also, no different from other shadow boxes. Even if that were accepted, the absence of any claim in relation to the other representations means that they must be taken as novel, or at least the contribution those representations make to the design as whole creates a novel design in totality. Section 1B of the Act relates to a design as a whole, not just parts of it. This, in and of itself, is sufficient reason for the applicant’s claim to be dismissed. In case of appeal, I should add that in terms of the newness test, the t-slot cover is not an immaterial detail and, therefore, the design is new compared to what is in the public domain already.

Does the design have individual character?

The informed user

22. The informed user is a user of drop boxes. The informed user of such items will possess the characteristics set out in the case-law (paragraph 16 above), including being particularly observant and paying a high degree of attention when using the item.

Design freedom

23. The applicant states that the proprietor has a wide degree of design freedom, albeit these comments were made in relation to the shape of the t-slot cover. In terms of the design as a whole, the requirement for a drop box to have some form of frame to hold the tokens constitutes a 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. I would not say that the design freedom is high, but it is nonetheless reasonable.

The differences between the earlier design and the design corpus

24. 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. An example is given in the statement of case, two further examples are shown in the submissions (although I accept that this has no evidential weight). That said, the degree to which the other features (particularly the slot cover) stands out from the norm is not known. The drop box shown in the evidence does not have a slot or a slot cover as the tokens were inserted before the top of the frame was put in place. Without better evidence from either side, I must take a neutral position on this.

Individual character

25. I begin by observing that the applicant's case suffers from the same fundamental problem as I highlighted in paragraph 21 above. The claim does not relate to the design as a whole and, consequently, this, in and of itself, is sufficient reason for the claim to be dismissed. However, I will go on to give my views as if the claim had been made against the design as a whole, from which it is apparent that the applicant's position is that the t-slot cover does not provide individual character. Given my finding that the basic shape of the frame is ubiquitous, something which appears to be accepted by the proprietor, the key question, which also seems to be accepted by both sides, is the impact of the t-slot cover - whether its presence in the registered design and absence in the prior art, is sufficient to give the registered design individual character.

26. The applicant's main points are that the t-slot cover is functional and represents little by way of exercise of design freedom, and that the t-slot cover will rarely be seen as in most normal uses (such as hanging on a wall or tilted slightly backwards on a mantelpiece) the cover will be inserted and that the low profile (when the slot cover is inserted) is not particularly noticeable. I accept that the t-slot cover (and the way in which it inserts into the hole in the drop box) will be visible far less frequently than its other forms of use (when on display for example). However, this does not make that feature negligible. This is particularly so bearing in mind that the assessment must be made through the eyes of the informed user. The informed user is particularly attentive. I come to the view that the informed user will have regard to the type of slot insertion method and slot cover being used in particular drop boxes. That is so despite the infrequency of use, thus, the shape of the slot cover represents a potential feature that could impart individual character. Furthermore, when one is dealing with a type of design where one of its main features (the frame) is ubiquitous, more attention is likely to be placed by the informed user on its other features. Whilst I accept that the slot cover performs a functional role, and whilst I also accept that the proprietor has not exercised a significant degree of the design freedom open to him/her, I nevertheless come to the conclusion that the t-slot cover plays a sufficiently important role in the overall impression of the design that it will be seen and appreciated by the informed user and that it will mark it out over other drop boxes without that feature. This, in my

view, means that the proprietor's design has individual character compared to other frames/drop boxes (for example, the one shown in evidence from the blogger, or even those shown in the applicant's submissions).

27. The applicant has questioned what may or may not infringe the proprietor's design. This is not a matter for me, but it is nevertheless clear from the way in which I have reached this decision that the absence in other drop boxes of the feature that gives the registered design individual character would mean that such articles would not infringe.

28. The claim under section 1B fails.

Sections 1(C)(1) and 1(C)(2) of the Act

29. The relevant legislation reads:

"IC - Designs dictated by their technical function

- (1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product's technical function.
- (2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.
- (3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system."

30. It will be apparent from the above that the objection relates to the registered design as a whole. It does not matter that part (or parts) of the registered design may fall foul of one or other of the sections. I highlight this because the applicant's pleaded case is that the section 1C(1) ground relates to representation 6 (the hole) and the section 1C(2) ground to representation 5 (the t slot cover). Consequently, I dismiss the claims as they do not relate to the design as a whole. Further, it is not as if, even in submission (see paragraph 14 above), that the applicant has attempted to argue the grounds on the basis of the design a whole. Even if the claim had been predicated upon the basis that the only part of the design which could potentially create novelty was a functional feature (and thus the ground(s) are applicable as pleaded), I would add that the t-slot cover is not dictated purely by function. This is because, whilst the part of the cover which is inserted into the slot is of its shape to allow for insertion, the shape of the handle could potentially be any shape and is not solely dictated by function nor does it necessarily have to be of the shape shown in the relevant representation.

31. The claims under section 1C(1) and (2) fail.

Conclusion

32. The application for invalidation fails and the design may remain registered.

Costs

33. 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 a counterstatement. My assessment is as follows:

Considering statement of case and filing counterstatement: £50

Considering evidence: £50

34. I therefore order All Labels Ltd to pay H Stebbings the sum of £100. 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 12th Day of August 2016

Oliver Morris

For the Registrar,

The Comptroller-General