

O/260/18

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN No. 5001809

OWNED BY GORGE LIMITED

AND

APPLICATION No. 33/17 BY TRAINING MASK LLC

TO INVALIDATE THE REGISTERED DESIGN

The claims and the counterstatement

1. The registered design the subject of these proceedings was filed by Gorge Limited (“Gorge”) on 29th February 2016. The design was subsequently registered with effect from that date. The design is depicted in the following representations, which include the accompanying wording shown on the register.

FRONT VIEW



SIDE VIEWS



FOURTH VIEW

Shown in component parts - protection is sought for all parts



FIFTH VIEW



3. No colour is claimed as part of the design.

4. The application form confirms that the design is for a "High Altitude Training and Fitness Mask."

5. On 23rd June 2017, Training Mask LLC (“the applicant”) applied for the registration of the design to be declared invalid. It is claimed that the Chief Executive Officer of the applicant, Mr Casey Danford, invented a resistance breathing device that is commercialised under the name ‘Training Mask 2.0’. The Training Mask 2.0 was the subject of a patent application made in the USA in October 2012. The patent, including drawings of the Training Mask 2.0, was published in the USA on 30th June 2015.

6. The applicant says that sales of the Training Mask 2.0 in the UK began in or around 2012.

7. The applicant claims that the contested UK design is a copy of the design for the Training Mask 2.0, other than for the text (branding) printed on the cloth sleeves.

8. Further, the applicant claims that the packaging shown in the contested design is also a copy of the packaging used for the Training Mask 2.0, other than for differences in the text applied to the packaging. The applicant points out that the shape of the packaging is the same and that both designs include the same ‘L’ shaped flap at the front.

9. According to the applicant, the registered design should therefore be declared invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the ground that the contested design did not fulfil the requirements of section 1B (i.e. the contested design was not new when it was registered and/or it did not have the necessary “individual character”).

10. Gorge filed a counterstatement in which it denied the grounds for invalidation. I note, in particular, that Gorge:

- (i) Pointed out that a design may consist of not only a shape, but also the ornamentation applied to the shape;
- (ii) Denied that the publication of the applicant’s US patent would have come to the attention of persons carrying on business in the EEA and specialising in resistance training masks;

- (iii) Claimed that the all the features of shape of the applicant's design are dictated by function and therefore the degree of design freedom is *"very limited"* and *"almost exclusively falls into the category of surface decoration"*;
- (iv) Contended that the 'informed user' of the product at issue would be a consumer who uses resistance training masks who is likely to pay attention to the aesthetics of the masks, rather than their technical operation;
- (v) Claimed that such a user would regard the logos used and surface decoration as a dominant feature within the overall impression created by the design;
- (vi) Pointed out that the applicant itself had identified the importance of the [TRAINING MASK] *"rubber Stamped Rubber Logo for a 3-D effect that is sure to stand out!"*;
- (vii) Denied that the contested design creates the same overall impression as the design shown in the US patent, or the Training Mask 2.0 product as marketed in the EEA.

11. Both sides seek an award of costs.

Representation

12. A hearing took place on 17th April 2018. Gorge was represented by Mr Florian Traub of Pinsent Masons LLP. The applicant was represented by Dr Philip Stephenson of Bailey Walsh & Co. LLP.

The evidence

13. Both sides filed evidence. The applicant's evidence consists of a witness statement by Dr Stephenson with three exhibits, and a brief witness statement by Mr James Neary of Fight Equipment Limited with one exhibit. The proprietor's evidence consist of a witness statement by Ms Emily Swithenbank of Pinsent Masons.

14. There is no dispute that the Training Mask 2.0 was offered for sale in the UK prior to the registration of the contested design. Therefore, there is no need to go into the details of the prior disclosures of the design for the Training Mask 2.0, except to show what that design was. The following extracts from the applicant's evidence are sufficient for this purpose.¹



¹ The first two (shown above) date from 4th January 2016 (i.e. before the date of the contested design). The third (shown below) dates from December 2016 (i.e. after the date of the contested design) but is helpful to show how the Training Mask 2.0 looks from the front when in use.



15. The drawings of the prior art in published US patent 9067086 reflect the appearance of the Training Mask 2.0 in use, as shown above. However, as one would expect in technical drawings, they do not include any text, logos, or contrasts of colour.

16. Gorge draws attention to the following claims in the US patent as support for its claim that all the features of the design are functional.

	Feature of US Patent Design	Functionality as described in US Patent	Reference to Patent Diagrams
1.	The ventilator training mask in the form of a two layer construction	"a depth defining and air impermeable body"	Figure 1, 10-14
2.	An inner rubberized and enclosed perimeter defining layer with a perimeter extending seal	"adapted to overlay the nose and mouth of a wearer in the fashion depicted in FIG. 1."	Figure 3, 16
3.	An outer fabric layer with a pair of straps and a pair of hook and loop fasteners	"affixing the ventilatory mask 10 about the wearers head (again FIG. 1)."	Figures 2 & 3, 18-20 and 22-24
4.	Inner cutout area defining surfaces	"seating around and behind the wearer's ears."	Figures 2 & 3, 26-28
5.	Air admittance valves and use of 3 valves with 'exterior engageable caps' to restrict airflow and offer alternative resistance settings	"constructed to provide multiple resistance settings for affecting a degree of air flow into the mask 10, this in response to inhalation by the wearer when the mask is mounted into the configuration of FIG. 1." "the number of airflow permitting apertures configured in the alternately engageable caps can vary from a single such aperture, shown in selected caps 74 and 80 in FIG. 4, a pair of apertures as depicted in further selected caps 76 and 82, a larger number (by example four) of apertures in further selected caps 78 and 84, up to a largest number of flow permitting apertures associated with further selected (middle valve attaching) cap 72."	Figures 1 & 2, 30-34

17. In response to this claim, Dr Stephenson provided examples of eight other resistance masks with different visual appearances to the contested design. Some of these are made by the parties to these proceedings, others by third parties. Some are designed to cover the whole face. These look very different to the contested design. The rest are designed to cover only the nose and mouth. These look more similar to the contested design, but each such design creates a different overall impression compared to the contested design. To illustrate this point it is sufficient to show another registered design for a resistance training mask owned by Gorge and (below it) a US design patent in the name of the applicant.

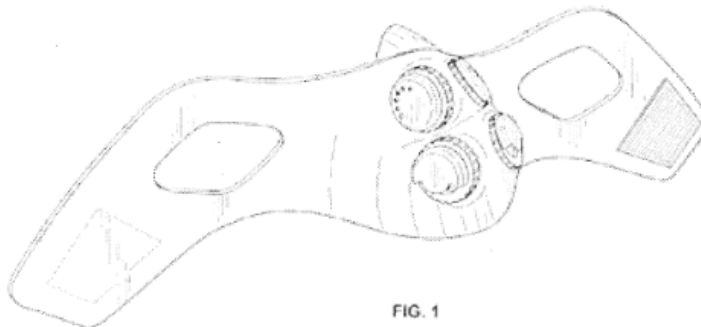
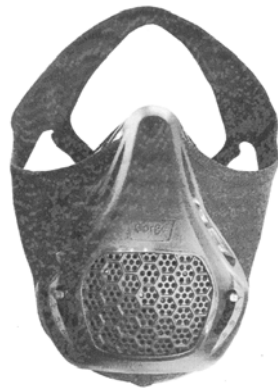


FIG. 1

18. The applicant relies on the fact that the packaging for the Training Mask 2.0 includes the number of the US patent as support for its claim that the publication of the US patent would have come to the attention to those in the relevant trade circles in the EEA prior to the registration of the contested design. In her statement, Ms Swithenbank took issue with this claim, pointing out that the applicant had not been specific as to the territories in which the applicant's packaging had been made available. Mr Neary's statement was filed to reply to this. He confirmed that his [UK] company sells martial arts and training equipment and that he had purchased the Training Mask 2.0 product "*since around 2011.*" Mr Neary also confirmed that, prior to the date of the contested design, his company offered the product for sale in the UK in packaging that showed the US patent number on the rear of the box.

19. Finally, the applicant filed evidence showing that listings of the Training Mask 2.0 product on eBay and Amazon had been taken down following complaints from Gorge that the product infringed its design rights.² Ms Swithenbank responded to this in her statement. She says that she spoke to Mr Paul Wright, the Managing Director of Gorge, who told her that it had never been Gorge's intention to remove listings of the applicant's Training Mask 2.0 products from online platforms. According to Ms Swithenbank's hearsay account of Mr Wright's explanation, eBay and Amazon had erroneously removed the listings of the applicant's products. Gorge's takedown request had only asked for listings from "*other specified merchants*" to be removed. I do not understand whether this explanation means that Gorge does not object to offers for sale of the Training Mask 2.0 product in the UK without its consent, or that it may object to such offers for sale, depending on who it thinks is responsible for them. However, there is no dispute that offers for sale of the Training Mask 2.0 have been taken down from online platforms following complaints from Gorge about design right violations.

What does the contested registered design consist of?

20. The contested design was described on the application form as a "*High Altitude Training and Fitness Mask.*" The front and side views of the design are consistent

² See PS3 to Dr Stephenson's statement

with this description (and with each other). However, the fourth representation of the design appears to extend the claim to component parts of the product. It also includes a front view of the packaging for the product, despite that clearly not being a component part, or indeed any part, of a high altitude training and fitness mask. The fifth view focuses on the front view (and to a lesser degree the top) of the packaging, more so than on the mask itself, which is only partially visible through the transparent square window in the front of the packaging. When I first looked at the registration I therefore had some difficulty determining whether the design was for the mask or a combination of the mask and the packaging.

21. When I asked Mr Traub about this he submitted that the design was for a complex product made up of more than one thing. Section 1 of the Registered Designs Act 1949 (as amended) is as follows:

“Registration of designs

(1) A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.

(2) In this Act “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

(3) In this Act—

“complex product” means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and

“product” means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type- faces and parts intended to be assembled into a complex product.

22. The packaging for the mask is clearly not a replaceable component part for the product. That is so whether the product is regarded as the mask alone or the mask and its packaging. I do not therefore accept that the combination of elements shown in the representations constitutes a single complex product.

23. “Design” means “*the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.*” In order to regard the contested design as one for a product, one would have to construe the product as the mask and its packaging. In certain cases it may be appropriate to consider the container for goods as part of the ‘product’. That may be so where the container is specifically adapted to store and display multiple contents and therefore contributes to the on-going functionality and appearance of the item as a whole, e.g. a chess or cutlery set in its dedicated box. On the other hand, no one would say that the cardboard box in which (say) a keyboard is sold is part of the product. The function of the cardboard box has nothing to do with the function of the keyboard. It is just packaging for the product inside and will usually be thrown away (or hopefully recycled) once the keyboard has been unpacked. In these circumstances, the packaging and the keyboard cannot be regarded as a “unitary object” (to borrow a term from the case law of the General Court in *Ball Beverage Packaging Europe Ltd v EUIPO*³).

24. As will be seen below, the unusual hybrid nature of the contested design caused some difficulty when it came to working out what was the most relevant prior art, as well as how it should be compared to the contested design. It should be obvious from what I have already said that I have my doubts whether the face mask and the packaging is a “unitary object”. However, when I asked them about it at the hearing, both sides accepted that the packaging shown in the representations had to be considered to be part of the design (and therefore part of the embodiment of the design). This is consistent with the established principle that everything that can be seen in the representations of the registered design is, unless disclaimed or shown in dotted lines, normally to be regarded as part of the subject matter of the protected design. Therefore, despite my doubts as to whether the contested design is really a

³ Case T-9/15

design for a single product, I have approached the matter on this basis. However, I do not accept Mr Traub's submission that the contested design is properly to be regarded as the mask in its packaging as shown in the fifth view of the contested design (the other four views being said to be 'partial' views of the design shown in the fifth representation). If that were indeed the case one would expect the packaging to be at least visible in the front and side views of the design. It is not. Indeed there would be no need for side views because the sides of the mask are not visible in the fifth view of the 'whole' design. I will therefore treat the design as consisting of the visible features of the face mask (both in and out of its packaging) as well as the visible features of the packaging shown in views 4 and 5 of the contested design.

Was the registered design new and possessed of individual character at the relevant date?

The relevant legislation

25. 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)--”

26. Section 1C(1) states:

“(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.”

27. The thirteenth recital to the Designs Directive 98/71/EC states that:

“(13) Whereas the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design”

28. The relevant date in this case is the date of the application to register the contested design, i.e. 29th February 2016.

Drawings in prior published US patent not disclosed to the public in the EEA

29. Gorge submits that the relevant prior art has not been disclosed to the public in the EEA. Therefore, s.1B(5)(b) applies and the publication of the US patent does not count as prior art. This is right if 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.”

30. In *H. Gautzsch Großhandel GmbH & Co. KG v Münchener Boulevard Möbel Joseph Duna GmbH*⁴ the Court of Justice of the European Union (“CJEU”) was asked the following preliminary questions.

⁴ Case C-479/12

“1. Is Article 11(2) of Regulation ... No 6/2002 to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders?

2. Is the first sentence of Article 7(1) of Regulation ... No 6/2002 to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if:

- (a) it is made available to only one undertaking in the specialised circles, or
- (b) it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?”

31. The CJEU answered these questions as follows:

“..... on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it”.

“... The same is true of the question whether the fact that a design has been disclosed to a single undertaking in the sector concerned within the European Union is sufficient grounds for considering that the design could reasonably have become known in the normal course of business to the circles specialised in that sector: it is quite possible that, in certain circumstances, a disclosure of that kind may indeed be sufficient for that purpose.

In the light of the foregoing, the answer to the second question is that, on a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.”

32. The CJEU's answers mean that disclosure in the EEA is a question of fact for national courts and tribunals to determine. However, it is clear that a single disclosure to a person in the relevant circles in the EEA may, on occasions, be sufficient to prevent article 7(1) of Regulation 6/2002 from applying. Similarly, disclosure only in showrooms in China may be sufficient to disclose the design to the relevant circles in the EEA.

33. The same considerations apply equally to the corresponding (identical) provisions of the EU Designs Directive⁵ and the implementing national legislation, which includes s.1B(5)(b) of the Act. It therefore appears that (a) disclosure outside the EEA may be sufficient to bring the design to the attention of '*the circles specialised in the sector concerned*' within the EEA, (b) the extent of the disclosure required need not involve widespread disclosure to relevant persons in the EEA. This is consistent with the European Commission's 1996 Amended Proposal for the Designs Regulation, which explained the exception as follows:

“...Article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the 'safeguard clause'. Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the

⁵ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.”

34. This is how the provision appears to have been applied in practice. For example, in *Senz Technologies BV v OHIM*⁶ the General Court upheld OHIM’s decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry.

35. Against this background, Gorge’s case under this heading appears weak. The applicant’s evidence is that the Training Mask 2.0 product was sold in the UK prior to the date of the relevant date in packaging bearing the number of the US patent. In these circumstances, I do not see how it can be said that the design shown in the US patent “...*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.*” Consequently, I find that s.1B(5)(b) does not apply and the drawings in the US patent count as prior art.

The correct approach to the comparison of the contested design with the prior art

36. Dr Stephenson invited me to compare the design of the mask shown in the contested design with the drawings in the US patent. He thought this might improve the applicant’s case because the drawings in question have no surface decoration. By contrast, the Training Mask 2.0 fitness mask has only been disclosed in the UK bearing the words ‘Training Mask’, as well as a device depicting mountains. It is true that the comparison between a registered design and any relevant prior art must compare like with like. So if the registered design includes surface decoration or colours (or even the absence of surface decoration) then the absence of these features, or the presence of different comparable features, in the prior art must be

⁶ Joined cases T-22/13 & T-23/13

taken into account.⁷ By including the GORGE logo and contrasts of colours in the contested design, Gorge has elected to include these elements of the design in any comparison with allegedly infringing designs. The same must apply to any comparison with prior art. The logo-free drawings of the design shown in the US patent may therefore be closer to the contested design than the design disclosed by the commercialisation of the Training Mask 2.0 itself in one respect. This is because the latter includes the applicant's (different) word mark and mountain device.

37. On the other hand, the design shown in the drawings in the US patent does not include any packaging. The applicant has accepted that the packaging shown in the contested design is part of the design and must be taken into account in the comparison between that design and the prior art. Further, part of the applicant's case is that the packaging shown in the contested design copies elements of the packaging disclosed in the commercialisation of the Training Mask 2.0 product. This suggests that the applicant's best case might be to compare the contested design with the Training Mask 2.0, including its packaging.

38. When I put this to Dr Stephenson, he appeared to invite me to (1) compare the design for the fitness mask shown in the contested design with the drawings from the US patent, and (2) compare the design for the packaging shown in the contested design with the packaging for the Training Mask 2.0. However, in *Karen Millen Fashions Ltd v Dunnes Stores*,⁸ the CJEU ruled that:

“Article 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs is to 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.”

⁷ See *PMS International Group Plc v Magmatic Limited* [2014] EWCA Civ 181 at paragraphs 37 and 41.

⁸ Case C-345/13

39. It is not therefore appropriate to take features from different disclosures and mosaic them together for the purposes of the required comparison with the protected design. I understood Dr Stephenson to accept that this was the correct approach, but he suggested that it might not apply in this case because of the hybrid nature of the contested design. However, that is akin to saying that the contested design is actually two designs (one for the mask and for its packaging). That is not what the applicant has pleaded. In these circumstances, the applicant is stuck with the consequences of its approach to the proceedings, which is that the contested design must be regarded as a single design and compared with each individual disclosure of prior art.

40. Looked at this way, the applicant's best case is based on the prior disclosure of the Training Mask 2.0, including its packaging. I will therefore proceed with that comparison.

41. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*⁹. 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:

⁹ [2012] EWHC 1882 (Pat)

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 (or she) is particularly observant (*PepsiCo* paragraph 53);

iii) He (or she) 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 (or she) is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He (or she) 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."

42. Given that functionality is a prominent part of Gorge's defence of the contested design, I should also take account of the recent judgment of the CJEU in *Doceram GmbH v CeramTec GmbH*¹⁰ in which the CJEU held that:

"Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only

¹⁰ Case C-395/16

factor which determined those features, the existence of alternative designs not being decisive in that regard.

Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an ‘objective observer’.”

43. It is therefore the job of this tribunal to determine whether (or to what extent) the relevant features of appearance of a product are dictated by its technical function. Having done so I must factor that into my assessment of the overall impression created by the designs on an informed user of the products at issue.

44. In determining whether technical function is the only factor which determined the features of a particular design, national courts and tribunals must take account of *“all the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.”*¹¹ Accordingly, although the existence of alternative designs for the product does not preclude a finding that the features of a design are dictated by function (and therefore not protectable), the existence of alternative designs may shed some light on whether aspects of appearance play some role in the design.

Identification of the relevant informed user

45. The designs as wholes are plainly not the same. The real question is whether they would create the same overall impression on an informed user. It is common ground that the informed user is a user of fitness training masks. Despite the

¹¹ See paragraph 37 of the judgment

reference to *High Altitude Training* in the product statement, neither side argued that the informed user should be limited to mountaineers or those with a specific need to train for high altitude exposure. This is consistent with the evidence which indicates that users are people of all sorts with a keen interest in a high level of fitness.

Design Corpus

46. I have only limited evidence of the design corpus (see paragraph 17 above). In deciding what weight to attach to this evidence in my assessment of the novelty of the contested design at the relevant date, I have kept in mind that some of the material is not clearly dated prior to the relevant date, i.e. not all of it is necessarily prior art.

Features of the designs dictated by function

47. Considering the shape and configuration of the fitness mask shown in the contested design (and, as this has the same shape and configuration, also the shape of the Training Mask 2.0), I start with Gorge's arguments and evidence that all the visible features of the mask are wholly functional. Once a decision was taken to design a mask that covers only the nose and mouth, the proportions of the height to the width of the mask are driven by the shape of the corresponding part of the human face. The decision to extend the mask around, and secure it behind, the back of the head is obviously a means of achieving a tight fit over the nose and mouth. The presence of valves is driven by the mask's function of restricting airflow whilst allowing the wearer to breath in and out. The visible appearance of the valves follows their function. The holes in the side of the mask, and their location, are there to accommodate the ears, which would otherwise be forced back against the side of the skull by the force required to create a seal around the nose and mouth. I therefore accept that all of these features (and in the case of the ear holes, their location) is dictated by the function of the mask.

48. However, there are, in my view, design choices in how these features have been arranged and configured which are partly driven by the appearance of the product. Dr Stephenson identified the number and the arrangement of the valves on the front

of the mask as being a design choice. I accept that submission. The decision to leave the valves visible is another such choice. And even if the use of three valves (as opposed to two or four) is driven by functional considerations, the precise position and triangular arrangement of those valves on the front of the mask represents another design choice which is partly about appearance. Similarly, even though the ear holes are functional, the shape of those holes is a matter of choice. There is also design freedom when it comes to the width of the mask where it goes around the back of the head.¹² I therefore conclude that there is some, albeit a low degree, of design freedom when it comes to the shape and configuration of the type of mask shown in the contested design.

49. Gorge's position appears to be that little weight should be attached to the identity or near identity of the designs for the shape and configuration of the masks because the design freedom "*almost exclusively falls into the category of surface decoration.*" In my view, this understates the degree of design freedom available for the shape and configuration of the respective masks. It therefore also understates the importance to be attached to the identical, or near identical, design for the shape and configuration of the respective masks in my assessment of the overall impressions created by the designs as wholes.

Impact of contrasting colours

50. There is a further point of similarity between the mask depicted in the contested design and the pictures in evidence of the Training Mask 2.0 product; namely, that the mask shown in the contested design has a high degree of contrast between the dark colour of the body of the mask and the light colour of the valves. This colour contrast is also present in the depictions of the Training Mask 2.0 in evidence. Even though no colours are claimed as a feature of the designs, the contrast shown in the representations of the registered designs between a dark colour for the body of the mask and a light colour for the valves (and the branding) is a relevant factor which I

¹² See Gorge's other design at paragraph 17 above, which has a noticeably thinner strap at the back.

must take it into account in my assessment of the overall impressions the designs create on an informed user.¹³

Impact of the branding on the masks

51. Turning to the branding present on the masks themselves, and its effect on the overall impressions created by the designs, Mr Traub submitted that the informed user was generally alert to the use of branding on sports equipment. In this connection he pointed out that on one of the screen shots from the applicant's website in evidence, a representation of the Training Mask 2.0 is shown overlaid with various captions, one of which is "*Stamped Rubber Logo for a 3-D effect that is sure to stand out.*"

52. The 'stamped rubber' nature of the logo and its supposed '3-D effect' is difficult to appreciate from the pictures in evidence because the background to the Training Mask 2.0 logo is represented in black, and so is the mask on which it appears. I cannot give weight to an effect that I cannot see.

53. The applicant appears to regard the words 'Training Mask 2.0' as its trade mark. However, I do not think it likely that the words 'Training Mask' as such would strike an informed user of fitness or training masks as anything other than an indication of the type of product. Even assuming that such words count as 'lines' or 'ornamentation' for the purposes of design law, they are so banal as to be either immaterial (or virtually so) to the overall impression created by the design as a whole. It is true that the logo applied to the Training Mask 2.0 also includes a mountain scene. This will make some impact on an informed user. However, in deciding how much weight to attach to the pictorial element of the logo, I note that it is a relatively subtle feature of the overall design which appears on the lower side of the face mask.

54. I do not dissent from the general proposition that the branding on any product is meant to be noticed. However, fitness or training masks are not fashion items where

¹³ See *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12

branding may have a disproportionate importance to users compared to the appearance of the product itself. In my view, the informed user of a fitness mask is more likely to be concerned about its utility and how the mask itself looks and fits when worn. Therefore, I find that the informed user of the Training Mask 2.0 will pay more attention to the design of the mask itself than to the branding. Indeed, from a front-on perspective the branding on the mask is not even visible.¹⁴ This plainly limits the capacity of the branding to “*dominate*” the overall impression created by design of the Training Mask 2.0 product.

55. Turning to the contested design, the word GORGE is obviously a trade mark or trade name and, therefore, not simply a banal indication of the product or what it does. It will therefore have some impact as surface decoration in the design for Gorge’s fitness mask. However, I again note that the branding is barely visible when the mask is viewed from the front.

56. I also note that, as in the contested design, the words Training Mask 2.0 and the mountain device appear in the light colour with a high degree of contrast to the dark colour of the body of the mask. As with the similar colour contrast between the bodies of the masks and their valves, the high degree of contrast between the light colour used for the branding on the masks and the dark colour used for the bodies of the masks, is a point of similarity that should be taken into account in determining the overall impression created by the designs as wholes.

Shape and configuration of the packaging for the face marks

57. Turning next to the shape and configuration of the packaging depicted in the registration of the contested design and the prior art, I note that the respective packaging appears to have very similar proportions of height to width, i.e. the front of the packaging is virtually a square. It is more difficult to compare the designs for the depth of the packaging from the limited representations of it on the register. This very fact indicates that the depth of the packaging is not an important part of the contested design when it comes to a comparison with the prior art.

¹⁴ See the third image in paragraph 14 above.

58. The designs for the front of the respective packaging each show a square see-through 'window'. In both designs, the 'window is also square in shape, is centrally positioned, and occupies a similar proportion of the front of the box.

59. Although there is no evidence of the design corpus in relation to designs for packaging, I doubt that it will be controversial to say that a square box with a central square 'window' is very unlikely to have been a novel design for packaging at the relevant date. The most striking feature of the shape and configuration of the contested design is therefore the large 'L' shape opening flap on the left hand side of the design when the product is viewed from the front. I find that the absence of evidence of the design corpus is more significant in this respect, i.e. there is no evidence that this feature was not novel, or was banal, at the relevant date. Even if it was not entirely novel, it is very unlikely that an informed user of fitness masks would have regarded it as a banal feature of the design for the packaging. On the contrary, it appears to be the most striking aspect of the design for the shape and configuration of the packaging.

60. The design for the packaging for the Training Mask 2.0 product features an identical (or virtually identical) 'L' shaped opening flap. In both cases (when closed), the bottom half of the flap extends half way across the front of the box, and a quarter of the way across the top half. Further, in both cases, the horizontal bar of the 'L' shape starts half way down the length of the flap.

61. I conclude that the designs for the shape and configuration of the packaging would strike an informed user of fitness masks as being the same, or substantially so, and the most striking feature of the shape and configuration for the packaging is the 'L' shaped opening flap.

Surface decoration on the packaging

62. Both designs show the words "*Simulates Training at High Altitude*" and "*Simulates High Altitude Training*" on the top right hand corner of the boxes for the masks. The text is in an everyday font. Although very similar, these words simply say

what the product does. They are completely banal. I therefore doubt whether they will make much of a contribution to the overall impression created by the respective designs on an informed user of fitness or training masks. The same applies to the words *“Intensify your workout”* as these appear on the packaging of the prior art, and the words *“FITNESS MASK”* *“TRAINING MASK”* as these appear on the respective products.

63. The contested design also includes the word GORGE on the front opening flap of the packaging and a geometrical device reminiscent of two peaks. Higher up the flap is a silhouette of a runner. These elements of the design will make some impact on the informed user’s overall impression of the contested design.

64. The design for the packaging of the Training Mask 2.0 product includes the brand name ELEVATION on the opening flap of the packaging (which, as in the contested design, also appears on the top of the box) and a device of a clock on the bottom right hand corner of the front of the box. Again these elements of surface decoration will make some impact on an informed user of the masks, although neither feature has a striking impact in the context of the design as a whole.

65. The design for the prior art also includes a relatively subtle honeycomb pattern in a lighter colour (compared to the dark background colour for the box) which ‘fades in’ over the top right hand corner of the box and again across the bottom of the opening ‘L’ shape opening flap in the left hand corner of the packaging. Despite this pattern, the impression persists of dark colour packaging with contrasting light colour words and device.

Comparison of overall impressions created by designs

66. In my view, the features of the respective designs that will contribute the most to the overall impressions the designs make on an informed user of fitness or training masks are:

- (i) The identical shape and configuration of the masks;

- (ii) The contrast between the dark shade of colour used for the body of the masks and the light colour used for the visible valves;
- (iii) The same 'L' shape opening flap used on the packaging for the products.

67. I find that the following features will contribute rather less to the overall impressions created by the designs:

- (i) The different words used on the face masks;
- (ii) The device of a mountain scene on the Training Mask 2.0;
- (i) The different brand names and devices used on the packaging;
- (ii) The same basic square shape used for the boxes;
- (iii) The same square shaped 'window' used for the boxes;
- (iv) The same contrast between the dark background colour used for the packaging and the lighter colour used for the words and devices on it;
- (v) The subtle honeycomb pattern on parts of the box for the Training Mask 2.0.

68. Where the contested design consists of more than the shape and configuration of a product, the presence or absence of ornamentation, or different ornamentation, must be taken into account. However, it does not preclude two designs with different ornamentation creating the same overall impression on a relevant informed user.¹⁵ Moreover, that may be so even where the prior art "*can be distinguished to some degree from the registration.*"

69. Taking account of the freedom of the designer of the contested design, I find that it will create the same overall impression on an informed user of fitness/training masks as the design for the Training Mask 2.0 and its packaging, as shown in the applicant's evidence. Consequently, the contested design did not have individual character over the identified prior art at the relevant date.

¹⁵ See *See PMS International Group Plc v Magmatic Limited* [2016] UKSC 12, at paragraph 45

Outcome

70. The contested design is invalid and will be cancelled.

Costs

71. The application has succeeded and the applicant is therefore entitled to a contribution towards its costs. I calculate these as follows:

- (i) £48 for the official fee for filing an application for invalidation;
- (ii) £300 for the cost of preparing the application and considering the counterstatement;
- (iii) £600 for filing evidence and written submissions;
- (iv) £600 for attending a hearing and filing a skeleton argument.

72. I therefore order Gorge Limited to pay Training Mask LLC the sum of £1548. This sum to 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 end of the appeal proceedings (subject to any order of the appellant tribunal).

Dated this 26th Day of April 2018

**Allan James
For the Registrar**