

O/409/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6063481

**IN THE NAME OF JAMES BAXTER RICHARDSON
IN RESPECT OF THE FOLLOWING DESIGN**



AND

AN APPLICATION FOR INVALIDATION (NO 55/19)

BY COLIN EDGAR

Background and pleadings

1. James Baxter Richardson (“the registered proprietor”) filed application no. 6063481 for a registered design for a moon and star ornament in Class 11, Sub class 2 of the Locarno Classification (Trinkets, Table, Mantel and Wall Ornaments, Flower Vases and Pots) on 19 June 2019. It was registered with effect from that date and is depicted in the representation shown on the cover of this decision.

2. On 22 September 2019, Colin Edgar (“the applicant”) applied for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design did not fulfil section 1B of the Act as it had been available to the general public since 25 February 2018 and so the application for registration had been made more than twelve months after disclosure. He provided an undated print-out from eBay showing the contested design on sale, along with a revision history for that item. The item was first offered for sale on 25 February 2018. Changes to the pictures were made on 20 August 2018 and 7 July 2019. The extent of those changes is unstated.

3. The registered proprietor filed a counterstatement to the application for invalidation on 5 November 2019, denying the applicant’s claims. He admits that a design was listed on eBay in February 2018, but states that changes were made to it on 23 August 2018.

4. The registered proprietor also filed evidence with his defence. The first page is a screenshot of a computer desktop showing a shortcut to an image entitled “moon and hanging star” and that the image was modified on 23 August 2018. The second page shows the design in the software. The rest of the evidence comprises correspondence with the eBay VeRO Team concerning Mr Richardson’s request to have the following design taken down:



5. On 5 July 2019, eBay wrote to Mr Richardson stating that the items that he was reporting appeared to predate his registered design and so they were not in a position to remove them. On the same day, Mr Richardson said in response:

“I can prove that I have been selling this item as far back as 20th Feb 2018. I was the only seller of this item at that time.

The reported item is identical (not similar) to the item I own the copyright of.”

6. On 7 July 2019, Mr Richardson wrote to eBay:

“hi there when i designed this item on 20th of february 2018 it was my design i was the only seller on ebay of the item until it was copied exactly and also the listing title was copied exactly and the sales were manipulated by this seller to look popular”.

7. After investigation, eBay removed the listing Mr Richardson had reported. The later correspondence suggests that Mr Richardson had some dissatisfaction with the process as he contacted eBay on 2 October 2019 saying:

“this is the fifth time this item has been listed and removed by vero”.

8. eBay replied that there appeared to be a legal dispute between the parties and that it was not able to adjudicate in matters of IP conflicts.

9. The applicant submitted further evidence on 7 January 2020. However, this merely highlights parts of the registered proprietor's evidence, which I have quoted above in paragraphs 5 and 6.

10. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties represent themselves.

Decision

11. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid –

...

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act”.

12. Section 1B of the Act is as follows:

“(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 or no 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 account.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if –

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if –

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of

information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above 'the relevant date' means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

..."

13. The relevant date is the date of application for registration: 19 June 2019. The applicant claims that the design was disclosed before the relevant date and that this disclosure does not fall within the permitted disclosures listed in section 1B(6) of the Act, specifically that it was made more than 12 months before the relevant date.

14. Nowhere in the evidence is there an image of the item that the proprietor listed on eBay on 20 February 2018. However, he states that the design shown in the image reproduced in paragraph 4 was an exact copy of the item listed on 20 February 2018, and that he modified his design in the following August. The applicant has not challenged either of these statements; indeed, it has adduced the first as evidence to support its own claim.

15. I shall therefore proceed by comparing the registered design to the alleged copy to decide whether the registered design has the required novelty and individual character. This earlier design is relevant prior art, as Mr Richardson states that it was available on eBay and so could have reasonably become known to persons specialising in the business sector and was made over 12 months before the date of application for the contested design.

Novelty

16. The designs to be compared are as follows:

Registered design:



Earlier design:



17. Both designs consist of a crescent moon decorated with four-pointed stars and the words “Twinkle Twinkle Little Star Do You Know How Loved You Are?” in similar font placed round the larger curve of the moon. The placement of these smaller stars is not identical. The inner curve has been cut at the middle to give the effect of a nose, mouth and chin, and a triangular shape has been cut out of the moon giving the appearance of an eye. At the top right of the crescent a hole has been cut, through which is hung a ribbon with a five-pointed star attached. In the registered design, the ribbon is white, while in the earlier design it is the same colour as the moon and star.

The star is decorated with smaller four-pointed stars and a name is written at the centre. The base of the ornament is an oval, the top of which is the same or a slightly different shade of the colour of the moon, with dark sides. The moon and star appear to share the same proportions.

18. In the registered design, the moon is joined to the oval base by a rectangle on which is written a date and weight (presumably a baby's birth weight). In the earlier design, there is a white cloud in front of the moon. This contains either a date and weight or a message. In my view, this difference is more than immaterial. The claim that the contested design is not new therefore fails and I must go on to consider whether it has individual character.

Individual character

19. In *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-9/07, the General Court stated:

“In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer's degree of freedom in developing the contested design must be taken into account. Thus, as the Board of Appeal pointed out in paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. In addition, the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.”¹

¹ Paragraph 72.

The informed user

20. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), HHJ Birss (as he then was) described the informed user in the following terms:

“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-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 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, *Shenzhen* paragraph 46);

ii) however, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) he has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

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

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).”

21. The informed user of moon and star ornaments is a member of the general public. When considering such ornaments, they will take account of size, shape, colour, style, texture and materials. While they may not have a detailed knowledge of the applied arts, they will have an interest in the appearance of their home or other environment and a level of aesthetic engagement with the objects they choose.

Design freedom

22. In *Dyson Ltd v Vax Ltd*, [2010] EWHC 1923 (Pat), Arnold J (as he was then) stated that:

“... 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).”²

22. The designer of moon and star ornaments will to some extent be constrained as to the size of the product and there will also need to be a means of supporting the ornament on a vertical or horizontal surface. Even within those constraints, there is a significant amount of design freedom as to size and shape, colour, decoration, texture, contours or materials. The designer also can choose whether the moon and star are attached to each other, and, if so, how.

² Paragraph 34.

The design corpus

23. The parties have provided no evidence of any other designs for moon and star ornaments. It is therefore difficult to make an assessment of the extent to which the designs at issue compare to other ornaments available in the public domain at the relevant date. This factor is therefore neutral.

Comparison of the designs

24. I shall not repeat the comparison between the designs that I made earlier in this decision when I considered the issue of novelty. There is a large number of similarities between the designs, but I remind myself that it is overall impression that I must consider here. In *Samsung*, Birss HHJ set out the correct approach to the comparison in an infringement case. The same approach also applies to invalidity. He said:

“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.”³

25. The overall impression of the two designs rests in the moon and star. I can see that the way that the moon is attached to the oval base differs. In the earlier design it sits on the base, behind a cloud, while in the contested design it is attached to the base by a rectangle. Nevertheless, it is my view that the two designs give the same

³ Paragraph 58.

overall impression. They are identically-shaped crescent moons, to which are attached, in the same way, identical stars. The contested design does not have individual character.

Conclusions

26. Registered design no. 6063481 is declared invalid under section 11ZA(1)(b) of the Act.

Costs

27. The application for invalidity has been successful and the applicant is entitled to a contribution towards the costs of the proceedings. As he is unrepresented, the Registry invited him to complete and return a proforma with an estimate of the number of hours spent on activities associated with the action. No such proforma was received, so the award only consists of the official fee of £48.

28. I order James Baxter Richardson to pay Colin Edgar £48. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 27th day of August 2020

Clare Boucher
For the Registrar,
The Comptroller-General