

O/487/22

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6105174

IN THE NAME OF PICART PRINT & DESIGN LTD

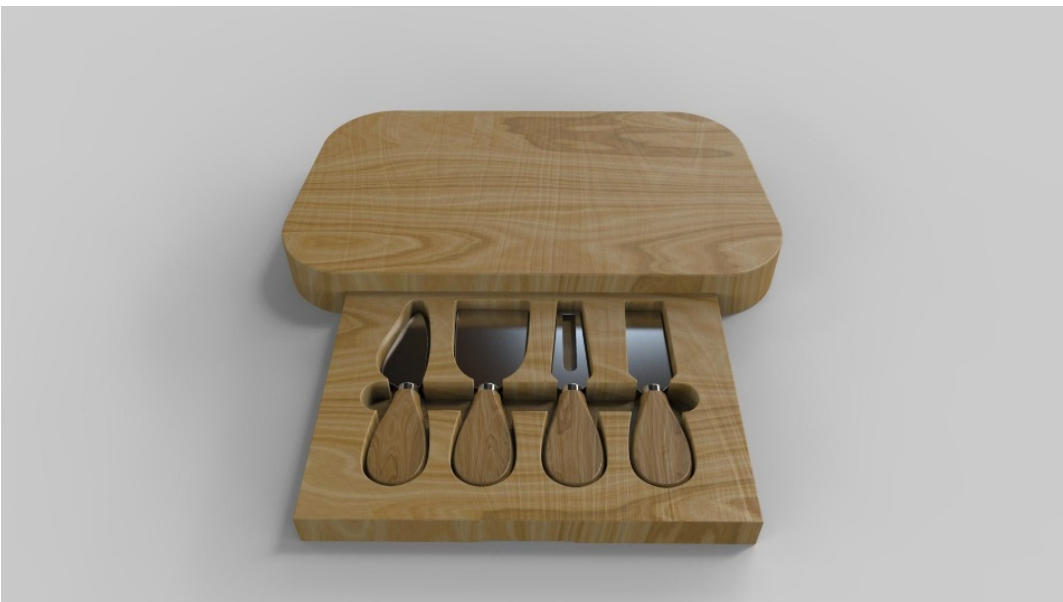
AND

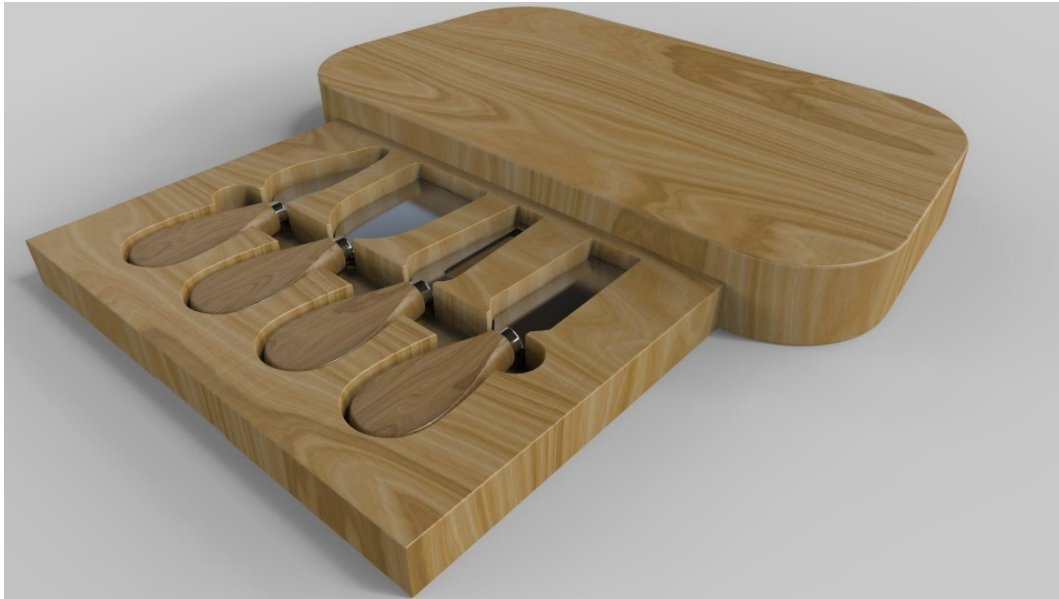
AN APPLICATION FOR INVALIDATION UNDER NO. 55/20

BY DANIEL PLATTEN

Background and pleadings

1. Registered design number 6105174 was filed on 30 October 2020 in the name of PicArt Print & Design Ltd (“the proprietor”) and was registered with effect from the same date. The design consists of six illustrations which are shown in the appendix to this decision but the main features can be seen in these three drawings:





The design is described as a “cheese board” and is registered as “household goods, not elsewhere specified”, specifically “china, glassware dishes and other articles of a similar nature” (i.e. class 7, subclass 1 of the Locarno classification).

2. On 24 December 2020, Daniel Platten applied for the registration of the design to be declared invalid. He claims that the contested design lacks novelty and individual character and should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that the contested design did not fulfil the requirements of s. 1B. Mr Platten claims that the same or similar designs have appeared for sale on websites since at least December 2017.

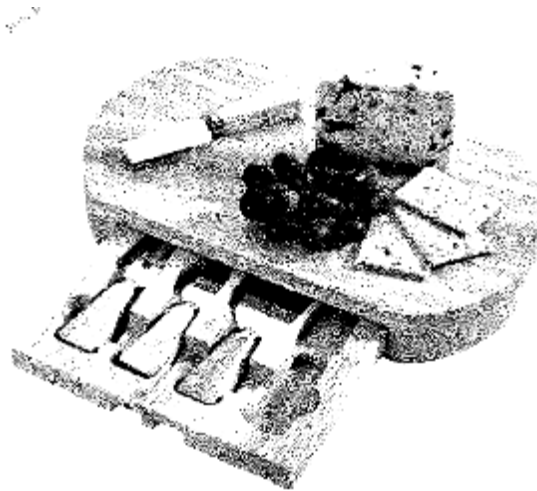
3. The proprietor filed a counterstatement denying the grounds for invalidation. It says that the registered design is substantially different from the prior art.

4. Neither party filed any further evidence, though Mr Platten filed submissions during the evidence rounds, which I will bear in mind. Nor did either party request a hearing or file written submissions in lieu. This decision is made following a careful reading of the papers. Neither party is professionally represented.

Evidence

5. Mr Platten filed evidence with his statement of case.¹ As Mr Platten signed the statement of truth, the evidence is his.

6. The evidence consists of prints from ebay showing a cheeseboard with integrated knife drawer and knives. The item is shown as follows:



7. The prints appear to be dated 22 December 2022, which is shown as the date on which the page was last updated. There are, however, five customer reviews, the earliest of which is dated 31 November 2017.

8. I note that the prints include images of a number of other cheeseboards with integrated knife drawers. The images are poor but, more particularly, there is no indication of whether the cheeseboards were first offered for sale before the date on which the registered design was filed.

9. Although the form DF19B (i.e. the proprietor's counterstatement) indicates that it contains no evidence, several images of the competing designs are included in the proprietor's comments and are intended to signpost the differences between the products. The form contains a statement of truth and was filed by Matthew Peter Clark. The images said to be of the "Occasion cheese board" are as follows:

¹ Rule 21(1)(a) of the Registered Designs Rules 2006 permits evidence to be filed with a statement of case.



10. That concludes my summary of the evidence, to the extent I consider necessary.

Decision

Legislation

11. Section 1(2) of the Act is as follows:

“In this Act ‘design’ means the appearance of the whole or 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”.

12. 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”.

13. Section 1B of the Act, so far as is relevant. reads 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) [...]

(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) [...]

(9) [...]”.

Relevant date

14. The relevant date for the assessment is the date of application of the contested design, namely 30 October 2020.

Novelty

15. Section 1B(2) of the Act states that a design is new if no identical design, or no design differing only in immaterial details, has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said at [26]:

“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be”.

16. The shape of the cheeseboard itself (i.e. the part intended to be used for presentation or cutting, rather than the drawer) is not identical in the respective designs. The registered design is rectangular with rounded corners, whilst the prior art shows a board which has straight parallel sides on the long edges but the short sides are curved. The handles of the knives in the registered design are teardrop-shaped, whilst those in the prior art are more triangular. Consequently, the registered design differs in at least two material respects from the prior art. The registered design must be considered new.

Individual Character

17. A design may be “new” but still lack the necessary individual character compared to the prior art. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

- (1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;
- (2) Identify the informed user and having done so decide
 - (a) the degree of the informed user's awareness of the prior art and
 - (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;
- (3) Decide the designer's degree of freedom in developing his design;
- (4) Assess the outcome of the comparison between the RCD and the contested design, taking into account
 - (a) the sector in question,
 - (b) the designer's degree of freedom, and
 - (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

- (5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.
- (6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters".

18. Further guidance can be found in the comments of HHJ Birss (as he then was) in paragraphs 31 to 59 of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat). The most relevant parts are reproduced below:

“The informed user

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

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

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

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

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

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

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics 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).”

[...]

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”.

Prior art

19. Although the evidence shows several images of cheeseboards, the web pages themselves are dated after the relevant date. The only product for which there are reviews dating from before the relevant date is the cheeseboard in the main image on the pages, shown at paragraph 6, above. This product qualifies as prior art. None of the other products can be taken into account as the date of their disclosure to the public cannot be established.

Sector to which the products belong

20. Both products are cheeseboards. That is the sector to which they belong.

Informed user

21. The design is described as a “cheese board”. The informed user is a member of the public who requires a cheeseboard for the presentation and serving of cheese; there is nothing in the parties’ evidence or submissions to suggest otherwise. Such an informed user is not a casual user but a knowledgeable or particularly observant user of such items, possessing the characteristics of knowledge and experience set out in the above case law. In the context of cheeseboards, the informed user is likely to pay a reasonable degree of attention when using the product.

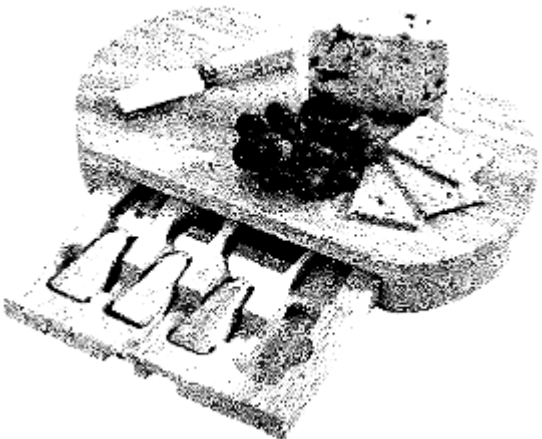

Functionality and design freedom

22. There are limitations on design freedom for a cheeseboard because there must be a flat cutting surface and it must be stable. However, there is considerable design freedom regarding the outline shape of the cutting surface, the proportions of the board (height, width and depth relative to one another) and whether surface decoration is employed. The materials also offer some scope for design freedom. Whilst stability will most obviously be achieved by having a flat base, other choices are available to the designer. The inclusion of a drawer to store cheese knives is a design choice; where a cheeseboard does feature a drawer, as in the designs at issue, there is some design

freedom in the positioning of the drawer relative to the larger part of the board as well as in the way in which the drawer is opened (for example, the nature of any handles). The degree of design freedom in the shape of the drawer is more limited because it must be capable of sliding in and out of the cheeseboard. There is design freedom in the way in which the tools are positioned or held in place, though the shape and size of the tools will have to be accommodated. The shape of the blades of the knives/forks is largely dictated by function, the need for a sharp point or wide cutting/serving blade being dependent on the type of cheese for which the knife is intended to be used. There is, however, some scope for design freedom in, for example, how the blade attaches to the handle and the shape of the blade at that point. The shape of the handles and their proportion relative to the blade are subject to a reasonable degree of design freedom. Overall, there is a good degree of design freedom for the designer of cheeseboards.

Comparison of the designs

23. The designs at issue are as follows:

Prior art	Registered design
	



24. The illustrations of the registered design shown on the register reveal:

- (i) There is one larger part to the design. This is roughly oblong in shape, with rounded corners;
- (ii) A smaller rectangular part, approximately three quarters of the length of the larger part and half its height;
- (iii) Both of these pieces appear to be made of wood;
- (iv) The smaller rectangle has four recesses which hold tools. These recesses have vertical sides and are arranged parallel to one another. A further recess with straight sides along its length and rounded ends bisects the tool-shaped recesses, just under halfway up their height. The ends of the bisecting recess protrude beyond the outermost points of the tool-shaped recesses. The bottom part of each tool recess is roughly teardrop-shaped and is uniform. The upper part is different in each and corresponds in shape to the blade of the tool it is intended to hold. The base of the recess appears to have been routed further to accommodate the handle of the tools;
- (v) There appears to be a very slight recess, at the bottom of the front edge, in the centre, of the smaller part of the design. It is approximately one quarter of the length of the front edge;
- (vi) When placed in the recesses, the handle of the tools is flush with the top of the smaller rectangular part of the design;

(vii) The knives all have a teardrop-shaped handle which is flat on the upper and lower sides. They also all have a metal collar and a metal blade. The handles and collars appear to be identical.

25. I have already indicated that the shape of the blades is largely functional. For completeness, their four shapes are follows:

- (i) Resembling a traditional knife, in that it is wider at the point closest to the handle and tapers to a point, though it is more like an arrowhead than a shark's tooth shape. The lower edge extends further below the collar than the upper edge;
- (ii) A wide flat blade which curves out from the collar equally on both sides. The edges are straight and at a slight angle, widening the further they are from the handle. The blade ends in a wide, straight edge;
- (iii) Two flat prongs which curve out from the collar equally and which narrow along their length. The prongs are joined at the tip by a straight piece of metal, resulting in a flat edge rather than points;
- (iv) A flat, roughly rectangular blade. However, where it narrows to meet the collar, the blade has two short, angled sides.

26. The registered design does not show what the design looks like from below. Nor does it show the rear edge of the smaller part: the illustrations all show the smaller rectangular part abutting the larger rectangle and in the same position relative to it. However, the parties appear to agree that the smaller rectangle is a drawer which slides into the larger part, and I proceed on that basis. The base of the drawer is flush with the base of the larger piece of the board.

27. The registered design appears to be made from wood. Although using this material is a design choice, the precise pattern is likely to be perceived as the variations inherent in a natural material. I note that the illustrations show differing wood grain.

28. I have identified the most obvious differences between the designs at paragraph 16, above. They are that the prior art has two straight sides and two curved sides,

whereas the registered design is roughly rectangular with curved corners and that the handles of the tools are pear-shaped on the one hand and almost triangular on the other. Additionally, the prior art has two recesses in the centre of the drawer front. The registered design has one, far less obvious, recess. The proprietor has argued that there is a difference in position in the drawer in the prior art, which is positioned centrally in the larger part of the board rather than flush with its base. There are some difficulties with the evidence provided by the proprietor. It is not dated and there is no indication of where the images were obtained. Further, in the image showing a close-up of the drawer, the sides of the cheeseboard slope outwards from top to bottom. Although the image of the prior art provided by Mr Platten is not of high quality, it is clear enough that there is no obvious slope to the sides of the prior art relied upon. The proprietor has also provided an image of the prior art shown from above, which does not show sloping sides. I am therefore doubtful that all of the images provided by the proprietor are of the prior art. However, Mr Platten appears to accept in his submissions that the images in the counterstatement show at least one of the products visible in the prior art, though he does not specify which. Most pertinently, although he had the opportunity to do so, including by filing evidence to rebut the assertion, he has not denied or otherwise called into question the proprietor's assertion that the drawer in the prior art is enclosed within the cheeseboard rather than having a base which is flush with the bottom edge, as in the registered design. In view of the proprietor's assertions, I have looked at the image of the prior art under enlargement and, whilst I cannot say with absolute certainty that the drawer placement is different, I agree with the proprietor that the 'slot' does not appear to extend to the bottom of the image. When the height of the drawer is looked at relative to the part of the board above the slot and the height of the cheeseboard as a whole, it appears that the drawer is not deep enough to extend to the base of the board. It therefore seems to me more likely than not that the drawer of the prior art is encapsulated, whereas the drawer in the registered design is not.

29. The proprietor has also argued that the drawers have different features because the prior art has a supporting bar which prevents the removal of the drawer whilst the drawer in the registered design is completely removable. There is nothing in any of the illustrations to show these features, which cannot be taken into account.

30. Turning to the recess which runs across the spaces for tools in the drawers of the respective cheeseboards, it is in both designs straight with parallel sides, ending in a curved edge which appears to be intended to allow the user to hook the tool out of the recess with a finger. The opening thus needs to be big enough to accommodate a finger but the prior art features a shallower curve than the registered design, where the curve is more pronounced. Additionally, the recess is, in the prior art, positioned across the middle of the handles rather than almost in the middle of the tools, as in the registered design. The recess in the prior art also appears to be wider relative to the size of the tools than the recess in the registered design.

31. As I have indicated, the similarities between the blades are only of relevance where they are not functional; the shape of the cutting edge, whether it is pointed, flat or forked, is dictated by function. The shape of three of the blades where they meet the handles is, however, curved and they attach to a metal collar in both designs. The fact that the blades attach directly to the handles (i.e. there is no extension of the blade) is likely to be to ensure maximum strength of the knife and is therefore a functional feature.

32. Both designs are made from wood; the precise variations in wood grain are likely to be perceived as natural differences in the material rather than specific features of the designs.

33. Although there are obvious similarities between the designs, my view is that the differences are sufficient that the informed user will both notice them and form a different overall impression of the respective designs. The application for invalidation under s. 11ZA(1)(b) of the Act fails.

Conclusion

34. The application for invalidation has failed. The design will remain registered.

Costs

35. The proprietor has been successful and would ordinarily be entitled to an award of costs. However, as the proprietor is not professionally represented, the tribunal advised it on 2 March 2022 that if it sought an award of costs it would need to complete

a costs pro forma itemising its costs and that, if it did not do so, no costs other than official fees would be awarded. The proprietor has not filed a costs pro forma. It has incurred no official fees. Accordingly, I order that the parties bear their own costs.

Dated this 7th day of June 2022

Heather Harrison

For the Registrar,

The Comptroller-General

Appendix

Registered design number 6105174





