

O/0038/23

REGISTERED DESIGNS ACT 1949

REGISTERED DESIGN No. 6171748

IN THE NAME OF ASGHAR AZIZ

AND

AN APPLICATION FOR INVALIDATION No. 24/22

BY STERLING TEXTILES LTD

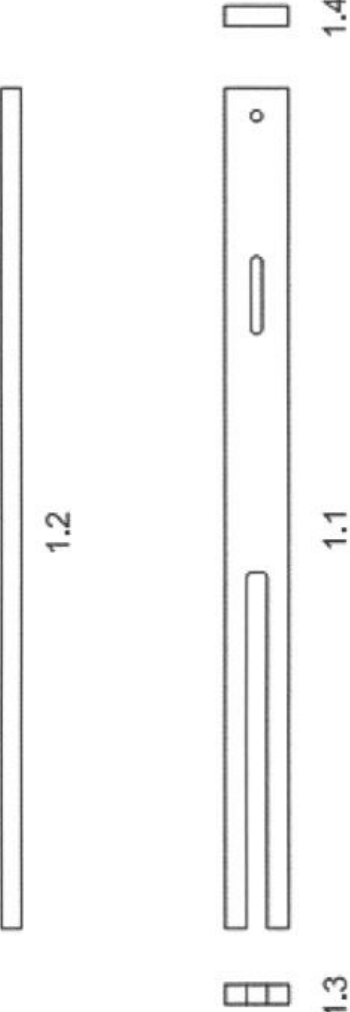
Background and pleadings

1. The design shown below is registered with effect from 22nd October 2021 in the name of Asghar Aziz (“the proprietor”).



2. The design is described as a “*Headboard Strut.*” This is the only view of the design on the register. There are no disclaimers or limitations. However, it appears to be common ground that the wooden floor tiles on which the strut is shown form no part of the design.

3. On 6th April 2022, Sterling Textiles Ltd (“the applicant”) applied for the registration of the design to be invalidated under sections 11ZA(1)(b) and 11ZA(2) of the Registered Designs Act 1949 (“the Act”). The applicant claims that the design is not new and/or does not have individual character compared to three earlier published designs registered in its name and shown below.

Date registered/published	Prior designs
5 th February 2013/26 th February 2013 No. 4028541	<p data-bbox="580 353 785 383">Illustration sheet</p> <p data-bbox="580 412 1206 441">T is the First (for example, first) design out of a total of 2 designs</p> <p data-bbox="1374 398 1471 441">4028</p>  <p data-bbox="580 1939 743 1968">(REV JUN 10)</p>

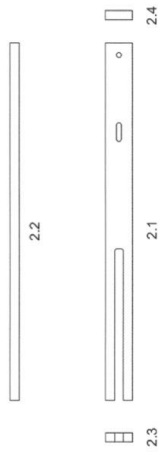
Dates as above

No. 4028542

Illustration sheet

This is the **Second** (for example, first) design out of a total of 2 designs

4028542 #



(REV JUN 10)

Form DF2A

8th March 2021/13th

April 2021

No. 6114407



4. The register indicates that design 6114407 is for a repeating surface pattern. The design is evidently not a repeating pattern, such as might be found in designs for carpets, wallpaper etc. At most, this might mean that the woodgrain appearance of the strut is part of the design. This is consistent with the absence of a disclaimer for this aspect of the appearance of the product. The same applies to the woodgrain appearance of the contested design. However, neither side have made submissions on this point. I therefore assume that neither party considers the woodgrain finish of their struts to be a material feature of either design. I shall proceed accordingly.

5. The applicant claims that the “*particularly significant*” features of the prior designs are:

- (1) a fork at one end;
- (2) a round hole at the opposite end [to the fork]; and
- (3) a rounded slot situated between the fork and the hole.

6. According to the applicant’s pleadings, “*the aesthetic appearance of headboard struts is important, both to manufacturers of beds and end consumers.*” Whilst accepting that each of the three features it identifies serves a technical function (i.e. being fixing points for attaching a headboard to a bed), the applicant claims that “*aesthetic considerations are also relevant to the design of those features, and a reasonable observer would understand that to be the case.*”

7. Registered design No. 6114407 was applied for by Asad Mehmood. Following infringement and cancellation proceedings initiated by the applicant against Mr Mehmood based on the other two prior designs shown above, registered design No. 6114407 was assigned to the applicant on 18th February 2022 pursuant to a settlement agreement.

8. The applicant claims that the contested design has been copied from one or more of the prior designs shown above. According to the applicant, the proprietor is a former business partner of Mr Mehmood who knew about the prior designs and the proceedings between the applicant and Mr Mehmood. The applicant claims that the proprietor copied the prior designs to create the contested design, which the applicant says differ only in immaterial respects. Therefore, the applicant claims that it is the true owner of the contested design.

9. The proprietor filed a counterstatement denying the applicant's claims. The proprietor:

- (i) Agrees that all of the features of the prior designs identified by the applicant are functional, but denies that aesthetic considerations were also relevant to the design of those features;
- (ii) Claims that the forked ending and the hole at the opposite end of the strut have been commonplace features of headboard struts for years;
- (iii) Claims there is limited design freedom when it comes to the design of headboard struts;
- (iv) Attaches weight to the second rounded slot in the contested design as a feature which will be noticed by the informed user, being a member of the general public;
- (v) Claims that the contested design has individual character over the earlier designs.

10. As to the applicant's claim that the prior designs were copied and the applicant is the true proprietor of the contested design, the proprietor says that the differences between the designs means that they are different designs. Consequently, the applicant cannot claim to be the proprietor of the contested design and it is irrelevant whether or not the applicant knew about the prior designs.

Representation and evidence

11. The applicant is represented by Strachan IP Ltd. The proprietor is represented by Humphreys & Co.

12. Both sides filed evidence and written submissions. The applicant's evidence consists of two witness statements (the second of which was served in reply to the proprietor's evidence and submissions) by William Humphries. Mr Humphries is the founder and Managing Director of the applicant company. The proprietor's evidence consists of a witness statement by the proprietor himself, Asghar Aziz. Neither party requested a hearing. I have therefore taken this decision from the papers before me.

13. It is convenient to start by examining the applicant's claim that the contested design is not new and/or lacks individual character compared to the prior designs identified in the applicant's statement of case.

The law on novelty

14. 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."

15. 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."

16. Section 1B of the Act (so far as relevant) 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) -

(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) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above ‘normal use’ means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

17. Section 1C of the Act is as follows:

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.

(3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.”

New design?

18. 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*,¹ HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

“‘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.”

19. The representation of the registered design on the register does not show what it looks like from the side or from below. The same applies to prior design No.6114407. Features which cannot be seen on the register are not protected by a registered design and cannot be included in the comparison with the prior art.² However, I consider that it is just about clear from the reflections of light visible on the ends of the forks at the foot of the contested design

¹ [2019] EWHC 3149 (IPEC)

² See *Framery Oy v EUIPO* (Transportable building), T-373/20

that it is has a relatively thin profile, like prior designs 4028541/2. In any event, it is not suggested that there is anything about the depth or underside of struts that affects the identity of the designs or whether they create the same overall impression. I will therefore focus, as the parties have, on the features of design visible from the top down views.

20. It appears to be common ground that headboard struts with a forked opening at one end and two round holes at the opposite end have been commonplace for years³. An example of struts embodying this design are shown below.



21. The applicant claims that the use of a slot opening between the top hole and the fork opening marked a major departure from the prior art, i.e. struts with a second round hole. On the other hand, the applicant denies that the addition of a second, shorter slot opening in the contested design is a material difference from the three prior designs registered in its name. Further, the applicant contends that the proprietor has copied its designs and simply added another banal non-functional feature so as to disguise the fact it has copied.

22. Follow-on designs often take existing designs as their starting point. This does not mean they are the same design. Provided the new design is materially different to the prior art it constitutes a new design. This remains the case even where the new design includes all the main features of an earlier design. Consequently, the issue of copying does not determine whether the contested design is new.

³ See exhibit STE14

23. In my view, the second slot opening in the contested design is not so minor or trivial in visual impact so as not to affect the overall appearance of the product. The contested design must therefore be regarded as a ‘new’ design.

Individual character

24. A design may be ‘new’, but still lack the necessary ‘individual character’ compared to the prior art. This depends on whether the “*overall impression it produces on the informed user differs from the overall impression produced on such a user by [the prior art].*” The correct approach to the assessment of individual character was helpfully set out by HHJ Birss (as he then was) sitting as a deputy Judge of the Patents Court in *Samsung Electronics (UK) Ltd v Apple Inc.*⁴, as follows:

“One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of ‘different overall impression’ is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The informed user

*“33. ... 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]*

⁴ [2012] EWHC 1882 (Pat)

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)."*

"Design freedom

40. *In Dyson Ltd v Vax Ltd, [2010] FSR 39, 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).”

“Effect of differences between the registered design and the design corpus

51.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.”

25. In *Cantel Medical (UK) Limited v Arc Medical Design Limited*⁵ HHJ Hacon, sitting as a judge of the High Court, set out a six step approach for use in the assessment of whether a new design has individual character. It is as follows:

⁵ [2018] EWHC 345 (Pat)

“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.”*

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

26. It appears to be common ground that the relevant sector is that of bedroom furniture.

The informed user

27. The applicant submits that the informed user is not a member of the general public, as the proprietor contends. According to the applicant, the relevant informed user is a bulk buyer of the type of headboard strut at issue. This could be a large-scale headboard distributor or, more likely, a headboard manufacturer/supplier or a bedding manufacturer/supplier.

28. This submission does not seem to accord with the case law cited above to the effect that the informed user is an end user of the product in which the design is intended to be incorporated, not a manufacturer or seller. Further, it appears to contradict the applicant's own pleading that the aesthetic appearance of headboard struts is important, both to manufacturers of beds and end consumers⁶. Mr Humphries, for the applicant, appears to accept that a headboard strut is a component⁷. I note that designs for component parts of complex products are only to be treated as having individual character if "*once [the part] has been incorporated into the complex product, [it] remains visible during normal use of the complex product.*" The complex product in this case is a complete headboard. The "*normal use*" envisaged is use of the complete headboard. The informed user of such a product is plainly a member of the general public. I therefore accept the proprietor's submission that the relevant informed user is a member of the general public. Such an informed user is deemed to pay a relatively high degree (but not the highest degree) of attention when using the product.

29. I would add that if I am wrong about this it would not assist the applicant. This is because a manufacturer/supplier of headboard struts is likely to pay a particularly high

⁶ See paragraph 6 above

⁷ See paragraph 4 of his first witness statement

degree of attention to such goods. Consequently, such a user would be more, not less, likely to notice even small differences between designs.

30. According to the applicant's witness, headboard struts with a fork at one end and two round holes were probably the most popular and widely used headboard strut prior to February 2013. The applicant's evidence is that since then it has sold 750k struts per annum embodying the 4028541 or 4028542 designs (it is not clear which). The proprietor does not appear to dispute these claims. It follows that the informed user would be aware of the traditional design for the type of headboard strut at issue, and of the 4028541/4028542 designs.

Design freedom

31. Mr Humphries' evidence for the applicant is that:

"[the 4028541/4028542] designs were so unique -- not only did they improve the functionality of the struts, but they significantly improved their outward visual appearance once installed."

32. As to the way headboard struts are connected, Mr Humphries explains that:

"Generally, headboard struts connect to the headboard by the fixing hole at the top. Struts made to Sterling's Registered Designs then connect further down the headboard via the main slot, which can be adjusted. The struts then connect to the bed base via the fork at the bottom."

33. His evidence is that:

"4. When I set about re-designing and improving the headboard strut, I tried numerous different options for improving the adjustability/versatility of the component. We took photographs of the various iterations and options tried for the design, and these can be seen in Exhibit STE 15.

5. Eventually, after a significant period of trial and error, came up with the

designs of Registered Design nos. 4028541 and 4028542. These designs were selected from the other options primarily because the aesthetic quality of the designs was far superior to the other options I had tried. In other words, they looked much nicer than the other options I tried.”

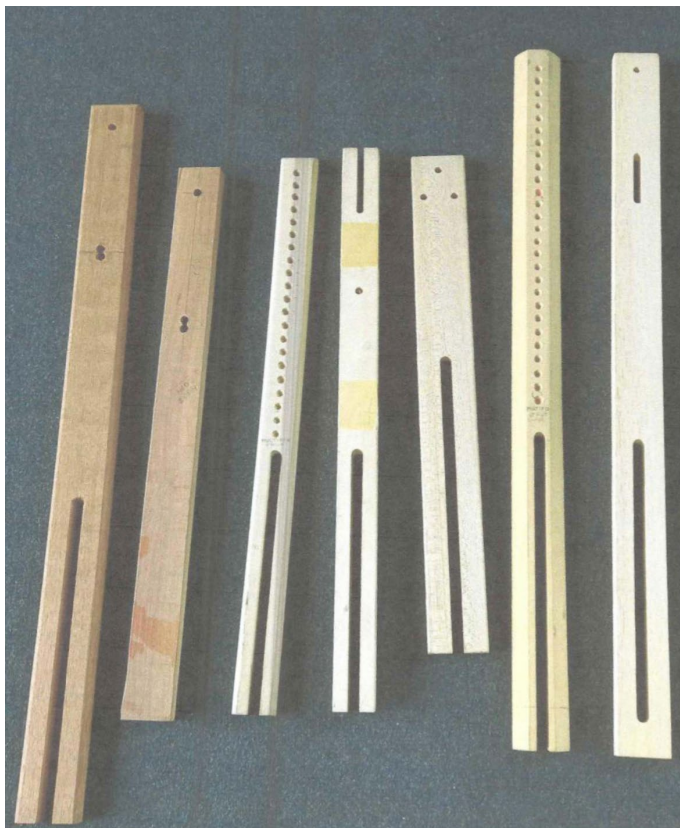
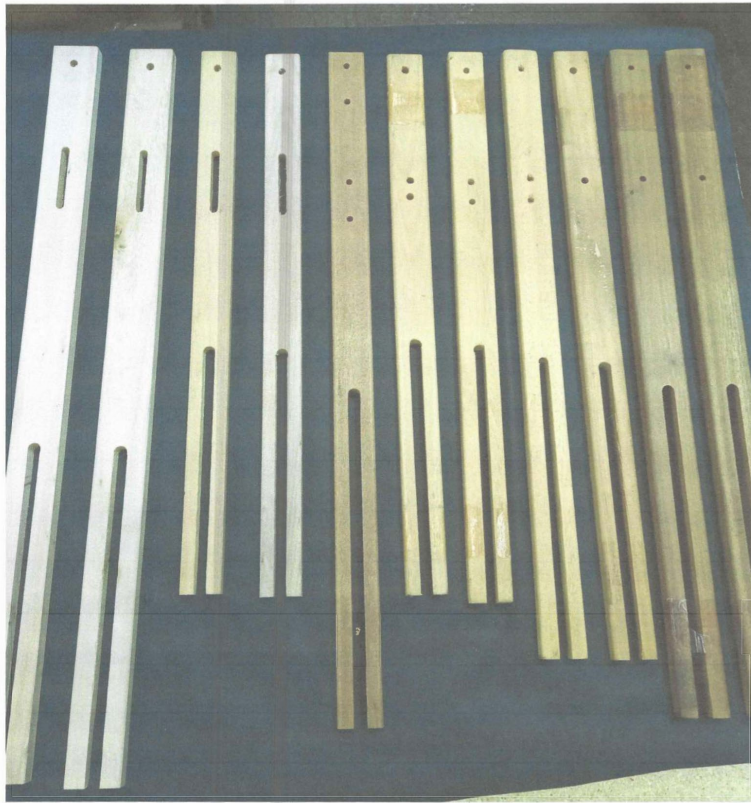
34. Neither party has fully explained or demonstrated how the elongated slot visible as the second opening in the 4028541/4028542 designs, as well as in the 6114407 design and the contested design, serves to improve “*the adjustability/versatility of the component.*” The obvious answer appears to be that it allows the strut to be affixed to the headboard at an adjustable fixing point (as opposed to a second round screw hole at a specific point on the strut). The clearest indication of the practical benefit of such an arrangement is to be found in exhibit STE8 to Mr Humphries witness statement. This consists of a letter dated 18th June 2021 from applicant’s solicitors to a company run by Asghar Aziz called Mr Europa Imports Ltd. It is ‘cease and desist’ letter. Paragraph 3 of the letter states that:

“The [4028541/4028542] Registered Designs created a novel solution to a challenge in the marketplace for beds. The slot between the hole and the fork is engineered to achieve adjustability so that mattresses of different thickness fit different beds and are aesthetically compatible with different headboards.”

35. I understand this to mean that the adjustable slot permits the same strut to be used to fit different headboards to different beds with mattresses of different thickness whilst maintaining aesthetic compatibility between the headboard and the bed/mattress. It is not entirely clear what “*aesthetic compatibility*” means, but it probably means avoiding a gap between the bottom of the headboard and the top of the mattress.

36. The alternative designs Mr Humphries says were considered before the 4028541/4028542 designs were chosen look like this⁸:

⁸ Per exhibit STE15



37. As can be seen, they mainly involve struts with multiple screw fixing holes in the top end of the strut, or struts with one screw fixing hole towards the very top of the strut and

an elongated slot opening beneath it. Of those with an elongated slot in the upper part of the strut, the main difference between them appears to be in the length of the strut, which is reflected in a longer gap between the bottom of the slot and the top of the fork at the bottom, and also the overall length (with a proportionate increase in the width) of the strut.

38. Although Mr Humphries says that the 4028541/4028542 designs were chosen because the “*aesthetic quality of the designs was far superior*” to the other designs considered, he does not explain why. Given that headboard struts spend most of their time hidden between the back of the bed and a wall or other structure, it seems surprising that the aesthetic quality of the products would be given a great deal of thought⁹. However, as Mr Humphries was not directly challenged or cross examined about the truth of this part of his evidence, I must accept his evidence that the “*aesthetic quality of the designs*” was a factor in the creation of the 4028541/4028542 designs. Accepting this to be the case, it is easy to see why the engineering solution of using multiple screw holes to provide multiple fixing points was rejected because of its crude appearance. It is not clear why the other two possible designs shown in the middle and far right of the second photograph above were considered inferior to the 4028541/4028542 designs from an aesthetic perspective. It is obvious why the design shown on the far right (with a long bottom slot instead of an open-ended fork ending) would have been considered less functionally useful, i.e. because it limits the range of positions for fixing the headboard to the base of the bed more than an open-ended fork design.

39. In my judgment, the designer’s freedom is constrained by the following:

- (i) The long rectangular shape of the strut is determined by its purpose of providing a rigid but visibly unobtrusive connection between the headboard and the bed;

⁹ In order for the designs to have individual character it is sufficient that the designs are visible to end users for some of the time, apart from during maintenance, servicing or repair. See *Pulseon Oy v Garmin (Europe) Ltd* [2019] EWCA Civ 138 at paragraph 9. Bed struts are visible for some of the time, e.g. if end users choose a new headboard for their bed or when the bed is moved from one place to another.

- (ii) The presence of a minimum of three or four potential fixing points for struts retained by screws or bolts is determined by the need to achieve a strong and rigid connection between the headboard and the bed (i.e. at least two connections to the headboard and one, probably two, fixing points to the base of the bed);
- (iii) The important functional advantage of using an open-ended fork at the base of the strut allowing for maximum adjustment in the positioning of the strut to the base of the bed and, by extension, the height of the headboard relative to the height of the top of the bed.

40. To which I would add that designs for struts designed for the specific functional purpose of permitting different headboards to be used with different beds and mattresses of different thickness require additional adjustment in the position of the fixings between the strut and the headboard. At least so far as struts designed to be connected by screws or bolts are concerned, the evidence indicates the fixing options are fairly limited, i.e. pre-drilled round screw holes, open slots in the strut, or an open fork-type ending.

Comparison of earlier designs to contested design

41. As noted in *Samsung Electronics (UK) Ltd v Apple Inc.*, the registered design system is not intended to protect new designs which represent advances in function. That is the purpose of the patent system, which limits the term of protection afforded to new inventions to a maximum of 20 years. Hence Birss L.J.'s (as he is now) observation that *"Things which look the same because they do the same thing are not examples of infringement of design right."* This is taken into account when assessing whether two designs create the same overall impression on an informed user. Specifically, the more a feature of a design appears to be functional, the more a designer's freedom in choosing that aspect of the design will be regarded as constrained by technical requirements, and the less weight an informed user will give it when it comes to forming an overall impression of the design. Or as Floyd L.J. put it in *Pulseon OY v Garmin*¹⁰:

¹⁰ [2019] EWCA Civ 138. See paragraph 23 of the judgment

“The informed user is not impressed by similarities in features where there is little or no design freedom, for example because the feature is to some extent dictated by function.”

42. I will therefore approach the required comparison on the footing that the appearance of highly functional features should be given less weight in the required evaluation than features of the design representing arbitrary design choices. This does not mean that the appearance of highly functional features cannot be given any weight at all. This seems clear from the requirement in section 1B(4) of the Act to take account of the *degree* of freedom of the author in creating the design.

43. The look of the struts appears to have played some part in the 4028541/4028542 designs, but the real driver and purpose of the designs appears to have been to provide *“a novel solution to a challenge in the marketplace for beds”*, i.e. to provide a functional solution which is *“engineered to achieve adjustability so that mattresses of different thickness fit different beds and are aesthetically compatible with different headboards.”* An informed user would know that the purpose of the fork at the bottom of the strut is to provide one or more fixing points for securing the headboard to the base of the bed. Armed with that knowledge the informed user would realise that the purpose of an elongated slot higher up the strut is to provide a range of positions at which it can be secured to the headboard. I accept that the use of a rounded slot opening in place of a second fixed-position screw fixing hole may have marked a significant departure from previous designs for headboards struts, as the applicant contends. However, the obviously functional purpose of such a slot will have moderated the visual impact it had on the informed user’s overall impression of the appearance of the design¹¹. The same applies to the presence of an elongated slot in the earlier 6114407 design.

44. Therefore, rather than focussing just on the presence in the contested design of the three *“particularly significant”* features identified by the applicant (see paragraph 5 above), it is necessary to compare the designs as wholes taking account of all the

¹¹ An admittedly clearer cut example of the same thing can be found in the judgment of the EU’s General Court in Case T-84/21 *Jieyang Defa Industry Co. Ltd v EUIPO*, in which the hole in the bottom of a doll’s head design was found not to *“contribute significantly to the overall impression because the informed user knows that the purpose of the hole is to fix the head to the doll’s body.”*

similarities and differences, including the positioning and relative size of the various features of the designs.

45. Turning to the contested design, Asghar Aziz's evidence is that:

“My design includes an upper slot (of different proportions and configuration than any of the sole slots used in any of Sterling's designs) and importantly a secondary smaller slot towards the bottom of the strut which is more aesthetically pleasing than the small round lower hole in the 6114407 design and also adds further flexibility to how users are able to use the strut.”

46. Mr Humphries' evidence in reply stated that:

“Based on my own extensive knowledge of the field and the informed users in that field of headboard struts, I consider that the small slot introduced in the contested Registered Design is functionally useless and makes no material difference to the appearance of the strut.”

47. If Mr Humphries is right that the lower of the two slots visible in the contested design is functionally useless, and the informed use would realise this, the second slot would have to be regarded as an arbitrary feature added just to affect the way the strut looks. On that view of the matter, the lower slot would make a greater visual impression on an informed user that a slot perceived as merely functional. However, I prefer the evidence of Asghar Aziz on this point. He says that although it affects the appearance of the product, the lower slot is also functional. It is intended to add further flexibility in the use of the strut. My reasons for preferring his evidence are (1) there is no objective evidence which contradicts Asghar Aziz's evidence, (2) it is his strut so he should know what the second slot is for, (3) the earlier 6114407 design (now in the applicant's name) has a screw fixing hole in roughly the same place as the lower slot in the contested design, suggesting that the designer of that strut also thought another fixing point midway between the top slot and the top of the fork ending would be functionally useful.

48. Comparing the contested design to the 4028541/4028542 designs, I note that:

- (i) The struts are about the same length relative to their width;
- (ii) They share the three “*particularly significant*” features identified by the applicant;
- (iii) Two of these three features (the top screw hole and the fork at the bottom) appear to be commonplace;
- (iv) The slot in the contested design is, as with the slot opening in the 4028541/4028542 designs, rounded at the top and bottom;
- (v) The first slot opening in the contested design is noticeably longer than the slot in the 4028541/4028542 designs, particularly the latter design;
- (vi) The contested design has a second slot opening positioned midway between the bottom of the first such opening and the top of the fork opening, which is absent from the 4028541/4028542 designs;
- (vii) The second slot opening is noticeably shorter in length than the first slot opening and about the same length as the (only) slot in the 4028542 design;
- (viii) The top of the fork opening in the contested design is rounded whereas the top of the fork opening in the 4028541/4028542 designs is not, or at least not noticeably so.

49. In my view, the differences between the contested design and the prior designs are sufficient for the former to create a different overall impression on the informed use compared to either of the other two designs.

50. Comparing the contested design to the 6114407 design, I note that:

- (i) The struts are about the same length relative to their width;
- (ii) They share the three “*particularly significant*” features identified by the applicant;
- (iii) Two of these three features (the top screw hole and the fork at the bottom) appear to be commonplace;
- (iv) The slot in the contested design is, as with the slot opening in the 6114407 design, rounded at the top and bottom;

- (v) The first slot opening in the contested design is about the same length as the slot in the 6114407 design, but is positioned closer to the top screw hole;
- (vi) The 6114407 design has a second screw hole positioned midway between the bottom of the slot opening and the top of the fork opening;
- (vii) The contested design has a second slot opening positioned midway between the bottom of the first such opening and the top of the fork opening;
- (viii) The second slot opening is noticeably shorter in length than the first slot opening, but is clearly visually distinguishable from a screw hole;
- (ix) The top of the fork opening in the contested design is rounded, as is the top of the fork opening in the 6114407 design.

51. In my view, the differences between the contested design and the prior design are sufficient for the former to create a different overall impression on the informed use compared to the 6114407 design.

52. It follows that the grounds for invalidation under sections 11ZA(1)(b) of the Act fail.

Is the applicant the true proprietor of the contested design?

53. Section 11ZA(2) of the Act states that:

“The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

54. The gist of the applicant’s position is that Asghar Aziz copied the earlier designs and he cannot therefore claim to be the proprietor of the contested design. Rather, the applicant must be considered to be the proprietor.

55. Mr Humphries explains that in June 2021 the applicant became aware that a company called All Bedding Components Ltd was importing headboard struts embodying the 6114407 design and that a director of the company, Asad Mehmood,

had registered the design. The applicant subsequently initiated infringement and cancellation proceedings, which resulted in a settlement and the assignment of the 6114407 design to the applicant. Mr Humphries also states:

“11. It was brought to our attention, by one of our trusted network of business associates, that the Proprietor of the contested Registered design, Asghar Aziz, was planning to sell forked headboard struts including the rounded elongate slot in the UK. We therefore instructed our solicitor to write to Mr Asghar in June 2021, advising him of our IP rights. A copy of that letter is attached as Exhibit STE8.

12. I knew that Mr Mehmood and Mr Asghar had previously been co-founders of a company called Europa Imports Ltd (see Exhibit STE2), and were therefore clearly known to each other. Although Mr Mehmood resigned from Europa Imports Ltd in 2019, I believe that they remained business associates for a significant period of time after that, and that belief was confirmed when Mr Asghar stated in a telephone conversation noted in Exhibit STE 3 (referenced below) that they only 'fell out' relatively recently over Mr Mehmood's commercial plans in relation to [the 6114407 design].

13. Following the sending of his notification letter (Exhibit STE 8), our solicitor subsequently telephoned Mr Asghar, and a copy of the associated telephone note is attached as Exhibit STE3. It is abundantly clear to me, from that telephone conversation, that Mr Asghar believed and understood that a forked headboard strut including an elongate rounded slot was "Sterling's strut". This also confirmed my belief that Mr Asghar knew of Mr Mehmood's business activity, including that in relation to the design pictured in Exhibit STE6, and considered that to be "Sterling's strut", insisting that he only sells struts "with two holes in it" (i.e. the prior art forked strut discussed above). He even claims to recognise the work that we (Sterling) put into the original design.

14. That being the case, I cannot understand how Mr Asghar can now claim that Registered Design no. 6171748 (Exhibit STE5) is his original design, rather than a copy of our design with a small inconsequential difference that has no functional

or aesthetic purpose and nor does it change the overall visual impression of the design, especially in relation to Registered Design No. 6114407 (Exhibit STE4). Looking at the designs of Exhibits STE4 and STE5 side by side, if Mr Asghar understood that the design of STE4 would infringe Sterling Textiles' IP rights, it seems clear that he would have understood that the same is true of the contested Registered Design.”

56. Exhibit STE3 consists of a note of a telephone conversation that occurred on 1st July 2021 between someone at the applicant's solicitors with the initials GG, and Mr Asghar. Mr Humphries does not specifically identify the author of the note. Whoever it was has not filed a witness statement attesting to its accuracy. However, it appears to be a contemporaneous note of the call recording 'GG's' understanding of what was said.

57. The note says:

“Mr Asghar said he has received our letter and wants to know who told Sterling that Europa were making struts like theirs. He said it is a lie. He said he does sell struts but only with the two holes in it. He knows that Sterling has put a lot of work into the design and wouldn't be able to out of conscience sell their strut. He is making his own design which he is hoping to patent. He is waiting for a letter back about that but it is different from sterling's design and he doesn't sell Sterling's design.

He said he does know someone who at least used to sell the strut that Sterling sell. His old business partner.

I asked if this was Asad Mehmood of All Bedding? He said yes. Asghar said he fell out with Asad as a result of Asad wanting to sell Sterling's struts amongst other things. Mr Asghar said he couldn't agree to sell Sterling's strut. It was wrong.

Anyway, Asad doesn't work for Europa anymore and Asghar doesn't have anything to do with him.

He does sell a number of furniture components but isn't infringing the design right. He doesn't appreciate receiving these letters and said he doesn't want to receive any more."

58. In his evidence in response, Mr Asghar stated:

"12. In or around June 2021, I received a letter dated 18 June 2021 addressed to Europa Imports Limited. The letter was sent by George Green solicitors on behalf of Sterling and contained non-specific threats of infringement on my part.

13. I recall later speaking with someone from George Green solicitors by telephone. I told them that I was not selling Sterling's products and that I no longer had anything to do with Mr Mehmood. I also said that I would be registering my own design and when it had been approved I will then start selling it on the open market place.

14. I note that in the telephone note at Exhibit STE3 filed by Sterling, I am recorded as saying that I only sold struts with 2 holes in them. I do not recall the entire conversation but that would have been correct because at that point in time, I only sold struts with a fork at one end and a small hole at the other.

15. I also note that in the telephone note I am recorded as saying that I "...know someone who at least used to sell the strut that Sterling sell" (meaning Mr Mehmood) and that I "...fell out with Asad as a result of Asad wanting to sell Sterling's struts amongst other things...". I do not believe that I would have said that I knew that Mr Mehmood used to actually sell struts the same as those sold by Sterling. Until I was contacted by George Green solicitors, I was not aware that he had actually been selling such struts. However, I accept that I would have said that part of the reason that I fell out with Mr Mehmood was because of his expressed desire to copy the designs of others such as Sterling.

16. –

17. By 22 October 2021, I had designed a new strut and filed UK design registration no. 6171748.

18. I have been trading in the bed and furniture business since 1995. I consider that my headboard strut design (as reflected in UK design registration no. 6171748) represents a material deviation from all prior designs, including those relied on by Sterling.”

59. In circumstances where the person who created the telephone note has not provided a witness statement, or even been formally identified, and no request has been made to cross examine Mr Asghar about the truth of his account of the telephone conversation, I accept that Mr Asghar’s evidence setting out his recollection of the telephone conversation. I do not accept the applicant’s contention that the note shows that Mr Asghar agreed that selling products embodying the design registered under 6114407 infringed the applicant’s rights in the 4028541/2 designs. In this connection, I note that the applicant’s solicitor’s letter dated 18th June 2021, which led to the telephone conversation at issue, did not identify the 6114407 design as an infringing design. Consequently, the evidence does not show that this is the design Mr Asghar had in mind when he said that he knew Mr Mehmood wanted to copy the applicant’s strut designs.

60. More importantly, both sides’ account of the conversation show that Mr Asghar was working on his own design for a headboard strut, which he did not consider infringed the applicant’s design rights. If my findings on novelty are correct, Mr Asghar was correct to think that the contested design was a new design, not simply a copy of the 4028541/2 designs, or of the 6114407 design which was in Mr Mehmood’s name at the time.

61. In his evidence in reply, Mr Humphries provided evidence that in April 2019 someone calling himself ‘Mr Oscar’ emailed him asking for samples of the applicant’s struts to be sent to an address in Batley¹². Records from Companies House show that the address concerned was also the residential address of Mr Asghar. The applicant says that this is further evidence that Asghar Aziz copied the applicant’s earlier designs. The

¹² See exhibit STE13

proprietor's position is that whether or not Mr Asghar knew about the applicant's designs, the evidence shows that Mr Asghar was developing his own design.

62. I have little doubt that Asghar Aziz knew about the 4028541/2 designs when he developed the contested design. It seems likely that these designs were used as the basis for his own design. However, the applicant has not shown that Mr Asghar wanted to copy the appearance of these designs (as opposed to further developing the *engineering solution* they provided for adjustable struts). In any event, as I have found that the contested design is new and has its own individual character, it follows that the applicant is not the proprietor of the contested design.

63. Therefore, the ground for invalidation under Section 11ZA(2) of the Act also fails.

Overall result

64. The application for invalidation fails and is rejected.

Costs

65. The application has failed; the proprietor is therefore entitled to a contribution towards his costs. I assess these as follows:

£250 for considering the application and filing a counterstatement;

£1400 for considering the applicant's evidence and filing evidence and submissions in response;

£300 for filing written submissions in lieu of a hearing.

66. I therefore order Sterling Textiles Ltd to pay Asghar Aziz the sum of £1950. 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 or withdrawn.

Dated this 16th day of January 2023

Allan James
For the Registrar