

# **O-821-21**

## **REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

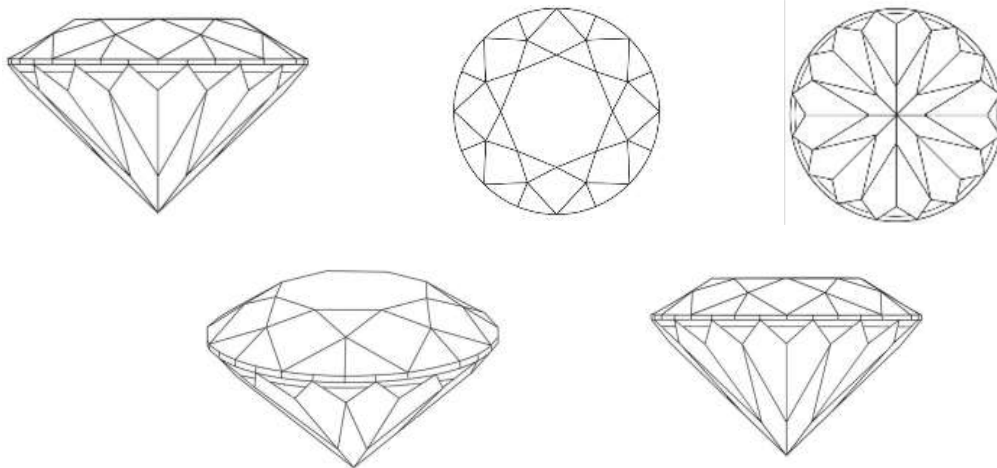
**IN THE MATTER of Registered Design No. 6065216 in the name of  
Schmuel Cohen in respect of a Diamond design**

**and**

**APPLICATION TO INVALIDATE (No. 70/19) by Utopia Diamonds  
Ltd**

### **DECISION**

1. This is an appeal from decision O-265-21 dated 15 April 2021 by the Hearing Officer (Ms Al Skilton) acting for the Registrar of Designs. She dismissed an application by Utopia Diamonds Ltd to invalidate Registered Design No 6065216. Utopia Diamonds Ltd appeals against that dismissal.
2. The Appellant was represented before me by Ms Denise McFarland of counsel, instructed by GAD Legal. The Respondent proprietor was represented both before me and in front of the hearing officer by Mr Jonathan Moss of counsel, instructed by Hansel Henson.
3. In the registered design, the product to which the design is intended to be applied or in which it is intended to be incorporated is stated to be “diamond”. The representations are as follows:-



4. Before the Hearing Officer, the validity of the registered design was attacked both on prior art grounds (lack of novelty or individual character), and proprietorship under section 11ZA(2) of the Registered Designs Act 1949 as amended (“the Act”). The Applicant contended that it, rather than Mr Cohen the registered proprietor, was the true proprietor of the design.

### **1. Proprietorship**

5. The vast majority of time and effort, both at the first instance hearing itself and in the preparation of the evidence, was spent on the proprietorship dispute rather than on the prior art grounds. The proprietorship dispute involved extensive and severe conflicts of primary fact, and the Hearing Officer heard cross examination (via video link) of the parties’ main witnesses over two days.
6. In a careful and detailed part of her decision extending over 29 pages, she analysed the background of the parties’ relationship and the factual disputes between them. These included a central issue about what happened at a meeting held on 3 March 2019 at the factory of the Appellant’s main witness Mr Shilon. Having seen and heard the

witnesses being cross examined, the Hearing Officer made findings on credibility. She found Mr Shilon to be an evasive witness who had changed his story on a number of occasions. She found Mr Cohen, the registered proprietor, to have been evasive at times, but generally consistent in the story he told. She found Mr Benita, a supporting witness for the registered proprietor, to have been believable.

7. Her concluding summary is as follows:

“143. In short, both sides have not been particularly successful when it comes to supporting their accounts with documentary evidence. But, it is Mr Shilon who has changed his version of events several times, while Mr Cohen has kept to his version of events from the beginning. Having said all of this, who I believe at this point is not the test I have to apply in order to reach a conclusion in this matter. The burden is on the applicant to show it is the true proprietor of the design. For all of the reasons already advanced, I find the applicant has not shown that it is the proprietor of the contested design and the application under 11ZA(2) fails.”

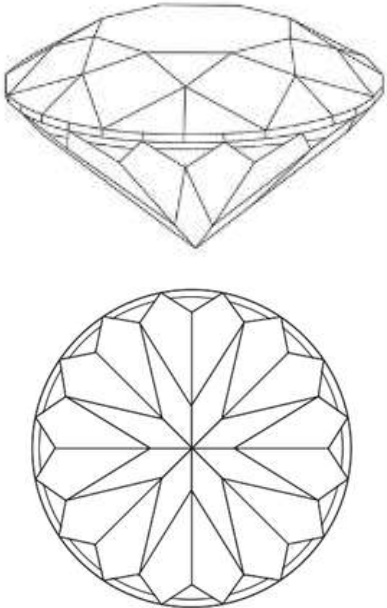
8. It is obvious that an attempt to appeal against this conclusion faces severe difficulties. The Hearing Officer dealt with disputes of primary fact and made findings based on her assessments of the credibility of witnesses whom she had the advantage over an appellate tribunal of having seen and heard. Only serious and demonstrable errors in her factual findings could justify an appellate tribunal in reversing her conclusion.

9. Nonetheless, until shortly before the hearing of this appeal it appeared that the main focus of the appeal would be on the proprietorship issue. However, Ms McFarland's skeleton argument indicated that the Appellant's submissions on proprietorship would be limited to relying on the points set out in the Notice of Appeal, while also making the additional point that the Hearing Officer had found both Mr Shilon *and* Mr Cohen to have been evasive.

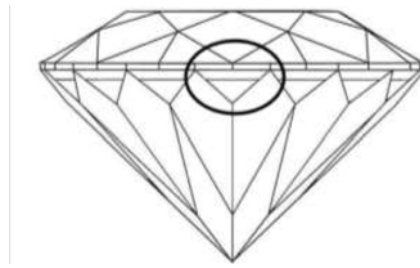
10. At the outset of the hearing I asked Ms McFarland whether she wished to add anything orally on proprietorship to her brief written submissions in her skeleton and the points in the Notice of Appeal. She said that she did not, although she was instructed not to abandon the appeal on proprietorship. I then indicated that I would dismiss the appeal on that ground.
11. The points made in the Notice of Appeal are essentially a series of minor criticisms which, even if taken at face value, come nowhere near establishing demonstrable and serious errors on the part of the Hearing Officer which would lead to a replacement of her finding that the Appellant had failed to discharge the burden of proof with a positive finding that the Appellant had proved that it was the proprietor. As to the point in Ms McFarland's skeleton, it seems to me that the Hearing Officer was fully alive to her finding about the credibility of Mr Cohen, which is why she expressed her overall conclusion in paragraph 143 in the way she did.
12. By contrast with Ms McFarland's skeleton, Mr Moss's skeleton argument contained over 20 paragraphs dealing with the appeal on proprietorship. The Respondent must have expended considerable costs in dealing with the proprietorship aspect of the appeal, and those costs will have been heavier than they might have been if the Respondent had learned of the position to be adopted by the Appellant at an earlier point than exchange of skeletons immediately before the hearing. I will therefore give consideration in due course to any application which the Respondent may make for a special order dealing with the costs of the proprietorship aspect of the appeal.

**2. Prior art ground**

13. Although two other prior art grounds were raised below, only one ground was pursued on appeal: that the registered design in issue does not exhibit individual character when compared with Thai design registration 174784. Like the registration in suit, the Thai registration contains representations consisting of line drawings of the 3-dimensional shape of the product from different perspectives, and is also entitled “Diamond” (in the Thai language).
14. The Hearing Officer helpfully set out a comparison between the designs which is not challenged and which I will adopt into this decision:

Thai prior art registration 174784	Registered design in issue
	

15. The difference between the two designs is difficult to spot but is indicated by the oval on the proprietor’s representation below:



16. The Thai prior art design (referred to as the 'V design' in the proceedings below) has vertical cuts in the corresponding area. By contrast, the design in issue (referred to as the 'H design') has horizontal cuts within the area indicated by the oval (and repeated round the circumference). The Hearing Officer held that these differences in cut were not immaterial, meaning that the design is suit is novel over the Thai prior art. There is no appeal against that finding.

### **3. What are the features of the design?**

17. It is accepted by the parties the Hearing Officer's decision accurately sets out the similarities and differences between the registered design in suit and the Thai prior art design. What is in dispute is how one should go about assessing the impact of those differences on the appearance of the product.
18. Before the Hearing Officer, a suggestion was made in a witness statement (but apparently not pursued by counsel for the Applicant) that the comparison should take place simply on the basis of comparing the three-dimensional shapes depicted in the respective design registrations. It can be seen that if the comparison is carried out on that basis, the differences are slight indeed.

19. The Hearing Officer considered the well known *Trunki* case<sup>1</sup> where the Supreme Court reaffirmed the principle that the registration of a design needs to be interpreted in order to decide what features form part of the design as registered, primarily on the basis of the filed representations. Only the appearance of those features is then taken into account in considering the relationship of the registered design to the prior art or to an alleged infringement.
20. The Supreme Court held that the features covered by the design registration in the *Trunki* case were the shape of the child's suitcase together with limited aspects of its surface appearance, namely that certain parts (strap, strips and wheels) should be in a contrasting colour or shade to the remainder of the product. The Hearing Officer also referred to the earlier *Fabreze* Court of Appeal decision,<sup>2</sup> in which that court held that the registration related to shape alone, rendering comparison of surface colouring or shading irrelevant to comparison for the purpose of infringement.
21. The Hearing Officer distinguished the present registration from the registrations in those two cases by pointing out that the product to which the design in suit is to be applied is described as a "diamond" and that "*a diamond is obviously known to reflect light and that is something that the informed user would take into consideration*".<sup>3</sup>

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1. *Magmatic Ltd v PMS International Ltd* [2016] UKSC 12; [2016] RPC 11.

2. *Procter & Gamble Company v Reckitt Benckiser (UK) Limited* [2007] EWCA Civ 936; [2008] FSR 8

3. Paragraph 45.



22. I agree with the Hearing Officer that the aspects of the appearance of the product which arise from it being a shape *applied to a diamond*, as distinct from it being that shape applied to another material such as a lump of charcoal, are to be considered as forming part of the design as registered. At first sight such a conclusion might seem to be contrary to the provisions of rule 5(5) of the Registered Designs Rules 2006:<sup>4</sup>

**“Formal requirements**

5.—(1) An application for the registration of a design shall comply with the first and second requirement.

(2) The first requirement is that the applicant has specified the product to which the design is intended to be applied or in which it is intended to be incorporated.

(5) Nothing done to comply with the first requirement shall be taken to affect the scope of the protection conferred by the registration of a design.”

23. I think however that this apparent difficulty arises from the fact that the phrase “scope of protection” can be used in two different ways. In the rule set out above<sup>5</sup> it is used in the sense of the scope of products which will infringe the exclusive right conferred by the registration. Used in that sense, the scope of protection has two aspects: what kinds of products can infringe the design registration, and how different the design of the product from that of the registered design needs to be to escape infringing.

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4. SI 2006/1975. Art.36 of the Designs Regulation (EC) No 6/2002 is to the same effect in relation to registered Community designs. Art.36(6) states that the indication of product “shall not affect the scope of protection of the design as such”. The concluding words “as such” for some reason have not been incorporated into rule 5(5) above, but that rule surely cannot be intended to have a different meaning from Art.36.

5. And in Art.36 of the Regulation.

24. Rule 5(5) is using the phrase in the sense of the scope of protection against infringement. The rule simply reinforces or reiterates the point that under the European harmonised system of design protection, there is no limitation in the scope of infringement as to what kind of product a design is used on. The product can be of a completely different type from the product indicated in the registration.
25. However, the phrase “scope of protection” can sometimes be used in a rather different sense, and is so used in the Hearing Officer’s decision. In this sense it relates to the question of what are the features whose appearance forms part of the design as registered. The more features whose appearance form part of the design as registered, generally the narrower its scope against infringement - e.g. if surface pattern is made part of the design as registered, then products with the same shape but different surface appearance may escape infringement.<sup>6</sup>
26. Recital (13) of the Designs Directive 98/71/EC states that the assessment by the informed user of whether a design has individual character should be carried out “*taking into consideration the nature of the product to which the design is applied or in which it is incorporated*”. Thus the indication of the product (in this case, “diamond”) should be taken into account in looking at the features of a registered design when it is assessed for individual character against the prior art, even though this might *indirectly* affect the scope of protection against infringement.

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6. Because the two concepts are quite different but can inter-relate in a possibly confusing way, my personal preference is to reserve the phrase “scope of protection” only for the scope of protection as regards infringement.

27. The present registration is very different from the registrations in the *Trunki* or *Fabreze* cases, neither of which specified the materials of which the products were to be made. A cut diamond sparkles because it is a hard transparent material with a high refractive index. Light will pass into it, will be internally reflected off its cut faces, and will then be sent back out in various directions. A diamond has “fire” because the dispersion in its refractive index at different wavelengths of visible light, a property which gives rise to unwanted chromatic aberration in telescope or camera lenses, may cause different colours to be seen as the diamond moves. In my view, these are all parts of the appearance of a cut diamond which are capable in law of forming part of a design as registered according to the definition in s.1(2) of the Act:

"(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 and/or materials of the product itself and/or its ornamentation."

28. In my judgement the way diamonds refract and reflect light are probably the most important aspects of the appearance of diamonds to users. The actual physical shape of a diamond is secondary to the sparkle and fire it produces.

29. On appeal, Ms McFarland did not seek to resurrect the rather crude argument that this registration must be regarded as relating to shape alone, but presented a more subtle argument. She accepted that as a matter of law it would be possible to incorporate features of sparkle or fire into a design registration, but argued that the registration in this case had not done so. By using different grades of clarity or different colours of diamonds, or by polishing or not polishing the cut faces, one would

create products which would have materially different appearances in terms of sparkle, fire and the way in which they would refract and reflect light.<sup>7</sup> While disclaiming any attempt to advise registered design applicants about the right way of registering cut diamond designs, she suggested that it might be necessary to specify the particular characteristics of the diamond - e.g. that it should be of VS1 clarity.

30. This was advanced as an argument about what is the right way to construe what features of appearance form part of the registration, but in my view it is in substance an attack on its validity. On the Hearing Officer's interpretation of the registration with which I have expressed my agreement, the features which form part of the design registration are defined by the shape in conjunction with the fact that that shape is applied to a diamond with its particular qualities of transparency and refractive index etc which then give rise to a pattern of light reflection and refraction. If it were the case that choosing different grades of clarity of diamonds, or polishing or not polishing the cut surfaces, were to lead to substantially different appearances in terms of the way in which light is refracted and reflected, then it could be said with some force that the design registration does not define or relate to a single design, but instead relates to an uncertain range of different designs.
31. It is clearly established in trade mark law that a registration which relates to a range of different signs (particularly an uncertain range) rather than

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7. She also argued that different ambient light would give rise to different appearances of the product, a point whose relevance I dismiss because many products covered by registered designs will look different under different ambient light conditions.

a single sign is invalid on that ground.<sup>8</sup> I see no reason why the same principle should not apply to registered designs.

32. However, it is essential that such a ground of invalidity should be pleaded. The parties can then focus evidence and argument on it. No such ground was pleaded by the Appellant in this case in its original grounds of invalidity, and nor indeed was it foreshadowed in the Notice of Appeal. Ms McFarland's submission therefore amounted to taking stray passages within the evidence which had been adduced for other purposes in order to build up an argument that different grades or methods of treatment of diamond would lead to differences of appearance of the finished product. To allow this argument to be progressed in this way and on this basis would in my judgement be grossly unfair to the Respondent. I therefore reject it in this appeal.

#### **4. The informed user**

33. Before the Hearing Officer, counsel for the Respondent argued that the informed user in this case would be "*someone with a knowledge of diamonds, and consequently, knowledge of how differences in cut can lead to quite different results when viewed.*" Counsel then representing the Applicant suggested that it would be "*customers buying diamonds*" although he resisted "*jewellers and other experts in the field*" as being too distinguishing. At paragraph 62, the Hearing Officer identified the informed user as follows:

"62. The informed user for these designs is not a customer buying diamonds where those diamonds are mounted in pieces of jewellery. In such a case the design of the particular cut is, at least in part, hidden from view. The informed user will be someone who is at least

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8. See for example *Glaxo Wellcome UK Ltd v Sandoz Ltd* [2017] EWCA Civ 335.

familiar to some degree with unmounted stones since it is the shape of the diamond itself which is the contested design and the earlier registered design in this case. The informed user will be aware of the features of diamonds and of the design corpus.”

34. Unfortunately I have concluded that the Hearing Officer was in error on this point. The primary characteristic of an informed user is that he or she should be an actual user of the product in question, not a designer, technical expert, manufacturer or seller. This is set out in point (i) of the summary of the characteristics of the informed user by HHJ Birss (as he then was) in *Samsung Electronics (UK) Ltd v Apple Inc.*<sup>9</sup>
35. In Case T-10/08 *Kwang Yang Motor Co Ltd v OHIM*,<sup>10</sup> the EU General Court dealt with a design which depicted an engine from a number of different views. The engine was intended to be put into lawnmowers and the Court upheld the Board of Appeal’s assessment that the informed user is a *user of lawnmowers into which the engine is incorporated*, not for example a manufacturer of lawnmowers to whom the engine is supplied by the registered proprietor. It reasoned at [24]:

24 Furthermore, the status of “user” implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (*Shenzhen Taiden Industrial Co Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – Bosch Security Systems (Communications Equipment)* (T-153/08), judgment of June 22, 2010, ... at [46]).

36. If one asks who actually *uses* the product in this case - a cut diamond - in accordance with the purpose for which that product is intended, it must be the actual retail customer of items of jewellery into which the diamond

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9. [2012] EWHC 1882 (Pat); [2013] ECDR 1.

10. [2012] ECDR 2.

has been incorporated. It is that customer who actually uses the diamond for the purpose of providing adornment and in that sense the diamond is useful for, and used by, that customer. The jeweller or jewellery manufacturer who mounts such a diamond into a piece of jewellery is an intermediary and is not using it for its intended purpose, any more than a lawnmower manufacturer is “using” an engine by incorporating it into a lawnmower.

37. The Hearing Officer was influenced by the fact that some features depicted in the representations of the design on the register will be hidden from view when the diamond is in the hands of a retail customer. As indicated by the quotation from *Kwang Yang* above, the process of identifying the informed user involves looking at the nature of *the product*, working out from that its intended use, and then identifying who is the kind of person who actually uses it for that intended purpose.
38. The nature and intended use of the product itself is not affected by what are or are not the features whose appearance the registered proprietor seeks to make part of his design as registered. That is a quite distinct and unrelated issue. The registered Community design in *Kwang Yang* contained multiple views of the engine which would not be visible to the end user once the engine was inside a lawnmower, and this was not regarded by the General Court as indicating that the intermediate lawnmower manufacturer should be treated as the user.
39. Instead, the General Court upheld the Board of Appeal’s assessment that the engine should be treated as a component part of a complex product, with the consequence that only the aspects of it visible in normal use as part of that complex product should be taken into account in assessing

overall impression. Hence, only the view from the top (only one of the multiple representations in the RCD) should be considered.

40. By the same logic, the diamond which is the subject of this registration is a component part of a complex product within section 1B(9) of the Act and its appearance should be assessed when mounted in a piece of jewellery. This does not mean that the parts of the external shape (or “cut”) which will not be visible when the diamond is mounted are irrelevant to its appearance, since those facets may influence the way in which light is refracted and reflected internally and therefore affect the appearance of the mounted diamond when viewed from the upper side.

**5. Need the informed user be aware that changes to the ‘cut’ may affect the appearance?**

41. This leads on to a further point. A retail customer of jewellery, even a well informed one, would be expected to have much less expertise, if any at all, in how differences or changes in the ‘cut’ of a diamond may lead to differences in the dazzle or its other optical qualities.
42. In paragraph 78, the Hearing Officer said that *“The informed user will be someone who is at least familiar to some degree with unmounted stones since it is the shape of the diamond itself which is the contested design and the earlier registered design in this case.”* But the statutory definition of “design” in s.1(2) of the Act<sup>11</sup> is that it is ***“the appearance of the whole or a part of a product resulting from the features of, in particular, ... shape, ... and/or materials of the product ...”*** This is definitely not a case where the registered design relates to shape alone, but rather one where the design

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11. Quoted in full above.



arises from shape in combination with the material used, as the Hearing Officer herself held and with which I agree.

43. Further, it is important to note that the design itself is not and can never be the shape itself, nor in this case is the design the combination of the shape with the material as such; strictly, the design itself is the *appearance of the product resulting from those features*. In most design cases this distinction can be easily overlooked, but it is of critical importance in the present case where the most important aspects of the appearance of the product - resulting from the way in which it refracts and reflects light - cannot be seen from the face of the representations in the design registration, and require either expert interpretation or physical embodiment in an actual product to be perceived.
44. In this regard this appeal relates to a very unusual kind of design. In almost all design cases, the appearance can be seen directly from looking at the representations of the design. This particular kind of design therefore calls for an out-of-the-ordinary approach to the methodology of determining its overall impression and comparing that with the prior art (or indeed with an alleged infringement in an infringement action).
45. The hearing below was very much focussed on the proprietorship battle with the result that this prior art ground - now central to the appeal - received comparatively little attention from the parties. The Hearing Officer was able to deal with it only briefly, and without the degree of assistance from the parties which would have been expected if this invalidity ground had been the main focus of the hearing below.
46. The Hearing Officer appears to have been led by the arguments presented

to her to assume that the question of whether or not a change in cut will lead to a change in appearance is to be assessed by the notional informed user. Indeed this was the position of Mr Moss on the appeal until I questioned its correctness and invited him to withdraw what seemed to me to be an unnecessary concession against his client's interest, which he did.

47. The informed user is given a clearly defined role by s.1B(3) of the Act (my emphasis added):

“(3) ... 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.”

48. As I have pointed out, the “design” is defined in s.1(2) as meaning “*the appearance of the whole or part of a product resulting from the features of, etc*”. The informed user is required notionally to look at the *design*, i.e. the actual *appearance* of the product which will be created when the features in the design registration are applied to the product. The informed user is not required to be, and in my view is therefore not allowed to be, involved in the logically prior step of interpreting the registration and its representations in order to derive what are or are not the features which form part of the design registration or what is the appearance to which the application of those features to the product will give rise.

49. In *Trunki*, Lord Neuberger pointed out at [31] to [32] that representations in design registrations need to be interpreted *inter alia* in the light of conventions established by OHIM - such as disclaiming auxiliary features through the use of broken lines, which “*may be said is a matter of practice*

*rather than law.*” Informed users in many fields would not be expected to have knowledge of the drawing conventions used in OHIM or in the UK Designs Registry. This is a further and complementary reason for excluding the informed user from the step of interpreting the registration in order to derive from it the nature of the design which it protects.

50. In most cases it may make no practical difference whether one considers the informed user looking at the abstract design extracted from a registration or looking directly at the representations. However in the present case it does. I would not expect an informed user of jewellery products containing diamonds to be able to look at the line drawings of the shape of the stone and derive from that the features of appearance of the “dazzle” which may result as a matter of optics from changes to that shape. In my view the correct course for the court or tribunal faced with a case such as this is to determine as best it can on the available evidence - which could be extremely technical and beyond the comprehension of the informed user - what will be the appearance of the finished product made according to the design, and thereafter notionally apply the informed user’s eye to that appearance.
51. This same point carries over to the assessment of paper prior art. Where the prior art is an actual product bearing a design, then one can directly place that product in front of the informed user and ask the informed user what overall impression it produces. Where the prior art is not an actual product but is in effect instructions for creating a product, then other evidence may be needed in order to get to the stage where its appearance can be properly identified in order for the informed user to start assessing its overall impression.

52. For example, a verbal set of instructions on how to make a particular product may be readily understood by a manufacturer of that type of product, who may be able to give evidence that following these instructions will lead to a product having particular features of appearance. That evidence then provides the starting point for the informed user's assessment of the overall impression. In my view there is no requirement that the informed user should himself or herself be able to understand the verbal instructions.
53. Thus in the present case, technical evidence (or at least more expert evidence than could be provided by the informed user) is required in order to identify the features of appearance of the product which will be created by following the paper instructions in the prior art registration – those instructions in effect being to cut a diamond to the shape depicted in the representations.
54. It is tempting to view the informed user of design law as an analogue of the person skilled in the art in patent law, whose role routinely involves reading and interpreting prior art documents and reading and interpreting at least the description and figures (if not the claims) of the patent in issue. However, on a close look, the function of the informed user in design law is much narrower and more limited than that of the person skilled in the art in patent law.

## **6. Comparison of overall impression of the designs**

55. The Hearing Officer dealt with the comparison of the registered design with the Thai prior art design as follows:-

“73. In my view, the informed user of diamonds would know that differences in the cut of a diamond will alter the overall impression of that diamond. In this case, the differences between horizontal and vertical cuts which I have identified above are sufficient for me to find that the proprietor’s design did have individual character in comparison with the applicant’s earlier Thai registration for the V design at the date on which it was applied for. ...”

56. The first sentence appears (at least at first sight) to suggest that it was the Hearing Officer’s view that *any* difference in cut will alter the overall impression of a diamond (“differences in the cut *will* alter the overall impression...”). If so, it calls into question whether, and if so on what basis, she identified and assessed the differences in appearance which arise from the *particular differences* in this case (between the horizontal and vertical cuts).
57. Mr Moss submitted that notwithstanding the way the first sentence of paragraph 73 is worded, the Hearing Officer was directing her mind to whether or not the *particular differences* between the H and V cuts would result in a different overall impression, and that there was never any suggestion in the case that any change of cut at all would automatically lead to a different overall impression.
58. Paragraph 73 appears to follow reasonably closely a submission from Mr Moss’s skeleton which the Hearing Officer sets out at paragraph 54 of her decision. This submission includes the sentences:

“34. In the V Design the circled area has a vertical cut running through that area, the effect of which is to significantly change the visual appearance of the design. This is because the informed user would know that, to put it simply, a diamond cut a different way is going to look different to another diamond. ... “

59. It may therefore be that the first sentence of paragraph 73 is simply an infelicity of expression arising from the particular way in which the case was put to the Hearing Officer by counsel.
60. However, for more fundamental reasons I cannot simply accept the assessment of the Hearing Officer on the question of the overall impression made on the informed user as Mr Moss would urge me to do. The Hearing Officer had a very different informed user in mind from the informed user whom I have identified above. A purchaser of unmounted diamonds for trade or for manufacture into jewellery would have markedly different knowledge and characteristics, which could affect how he or she would regard the appearance of a diamond.
61. Therefore I need to assess for myself on the available evidence whether or not the differences in cut between the registration in issue and the Thai prior art registration will give rise to the same or a different overall impression for the informed user, bearing in mind that the onus lies on the Appellant to prove on the balance of probabilities that the overall impressions are the same. It does not lie on the Respondent to prove that they are different.
62. In an ideal world, the court or tribunal should be in a position to assess the respective overall impressions, putting itself in the place of the informed user. This is what happens in most ordinary design cases, at least where the product is one sold to ordinary consumers. In principle, this could be achieved in a case such as the present, if the parties were to make available actual diamonds cut to the respective shapes in the two design registrations.

63. That has not been done in the present case. Nor does the evidence contain much in the way of coherent sections dealing in clear terms with the respective appearances of the two diamond designs, of the kind one would expect given that there was a distinct pleaded ground of lack of individual character based on the Thai registration. Instead, there is a certain amount of evidence bearing directly or indirectly on the respective appearances and optical qualities of the two designs, but given almost incidentally in the context of the parties' hard-fought battle over who originated the design which is the subject of the registration, and its historical relationship with the development of the Thai design.
64. Ms McFarland (upon whose clients the onus lies) argued that the Hearing Officer had no proper basis for concluding that the registration and the prior art would give rise to a different overall impression. She relied particularly on a passage in the registered proprietor Mr Cohen's evidence where he said:
- “ ... I created a viewer, which allows people to better visualise otherwise difficult to perceive designs, emphasising the light reflection and scintillation of my cut ... When seen under the viewer, the new changes mean that the light reflections are maximised.”
65. Ms McFarland argued that the informed user carrying out the comparison exercise should not be deemed to be in possession of a special non-standard item of equipment such as this viewer, and argued that without such special aids the informed user would be unable to perceive any differences sufficiently to form a different overall impression.
66. Mr Moss submitted, in my view correctly, that I should exercise great caution in assessing passages in the written or oral evidence which could bear on the respective appearances of the two designs, since those

passages appear within a large body of evidence directed to the hotly contested proprietorship dispute. Subject to those words of caution, he identified a number of points in the evidence which he relied upon as supporting the conclusion that the overall impressions were different.

67. It is clear from the evidence that there are differences between the appearances of the two designs in the pattern in which light emerges from the respective shapes of diamond. The most concrete evidence of these differences is from images produced from Mr Cohen's viewer. He created this viewer for the purpose of allowing him to differentiate his designs of his diamonds from other cut diamonds. The respective images produced by that viewer of the two designs when viewed from the top<sup>12</sup> are as follows (from Exhibit SC25):

**V design (Thai prior art)**



**H design (registration in issue)**



68. In his evidence, Mr Cohen commented as follows:

“49. What perhaps cannot be seen in the design drawings is the remarkably different visual *effect* the different cuts create, in terms of from which side of the diamond the ‘heart shapes’ can be viewed. The overall impression created by diamonds cut to the two separate designs is therefore very different ...”

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12. The evidence also includes viewer images of the two designs from below, i.e. from the pointed end, but I consider that these images are less relevant to the informed user's comparison exercise because the diamond will normally be mounted in jewellery which does not permit of a view from that direction.



69. A tribunal cannot of course abdicate to a witness the ultimate question of judgement as to whether or not there is a difference of overall impression. However, this evidence appears to demonstrate quite clearly that there are indeed objective differences in the patterns in which light is refracted and reflected from the two different shapes of diamond. What seems to be a very small difference between the actual shapes of the stones appears to produce a much bigger difference in the patterns of light emerging from the stones.
70. However the real difficulty is in translating these differences as seen through Mr Cohen's viewer into how different the actual diamonds will look to an end user.
71. Mr Moss relied upon an exhibited leaflet from Goldsmiths, the retail jewellery chain, extolling the virtues of the design in issue as "*Introducing one of the most brilliant cut diamonds in the world*" and saying that "*The 88 facets give spectacular scintillation and sparkle.*" This provides support for the proposition that those features of the design are sufficiently visible and attractive to end users to be of value to them, albeit it does not provide a basis for comparison with the Thai prior art design.
72. Neither counsel referred me to any authority on the question of whether an informed user is entitled to perform the notional comparison exercise using a visual aid. I am not aware of any such authority under European harmonised designs law, although there is limited authority under the previous law that in order for it to be validly registrable, the features of a design need to be visible to the naked eye: *Stenor Ltd v Whitesides*

*(Clitheroe) Ltd*,<sup>13</sup> where Romer J held that if a design were so small that its features could not be properly discerned or appreciated by the naked eye, there could be no design within the meaning of the (then) definition.

73. One possibility is that it is permissible for the informed user to compare the appearances of the two diamonds using a magnifying glass or jeweller's loupe, because it could be expected that retail jewellers would use such devices to show the appearance of their products to retail customers. Mr Moss told me on instructions that Mr Cohen's viewer was distributed to a substantial retail jewellery chain for this purpose. He submitted that this is a matter that could have been dealt with in the evidence had the Appellant squarely put the case now advanced by Ms McFarland on the appeal in its pleadings and evidence at first instance. I consider that there is force in this submission.
74. Fortunately I do not think that it is necessary for me to resolve the question of law as to whether the informed user is entitled to use a visual aid, in order to decide this appeal. Like the House of Lords in the *Stenor* case, I think that this question should be resolved in a case where it is necessary to do so and preferably with the benefit of more extensive argument on the point than has been possible on this appeal.
75. The first reason why I think this is unnecessary is that both the

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13. (1946) 63 R.P.C. 81. The case went on appeal to Court of Appeal and the House of Lords, but the House expressly reserved for future decision "*the question of how far, if at all, minuteness of the object to which a design is applied affects the registrability of the design*": see *Stenor Ltd v Whitesides* (1948) 65 R.P.C. 1, at p4 line 46 to p5 line 4 per Viscount Simon. See further Russell-Clarke and Howe on Industrial Design, 10<sup>th</sup> Ed, para

3-053 and footnote  
108.

registration in suit and the Thai prior art registration contain drawings which are not scaled. This would allow these respective designs to be applied for the purposes of comparison to diamonds big enough for differences in reflections and scintillations to be seen without difficulty by the naked eye. It may be that in practice and for reasons of economics and the rarity of larger stones these respective designs would normally be used on small diamonds; but I cannot see that those factors require the products used in the notional comparison to be (notionally) fabricated on a small scale.

76. Secondly, I consider that Mr Cohen's evidence when fairly read is not saying that the differences between the optical qualities of the two cuts, or between those cuts and other third-party cuts, will be invisible or imperceptible to retail customers. Rather, he is saying that the purpose of his viewer is to bring out more clearly and explicitly differences which are present and which retail customers will find of value and attractive.
77. Finally, I return to the fundamental question of onus. I do not consider that I am quite in a position to make a positive finding that the respective overall impressions are different because the evidence has not directly addressed that question (apart from Mr Cohen's assertion), nor does it provide a clear basis on which this tribunal is able to assess and compare the respective overall impressions for itself. However, the evidence clearly demonstrates that there are objective differences between the appearances produced by the respective shapes and tends to suggest that those differences in appearance are capable of being noticed by end customers and are capable of being attractive to them.
78. In these circumstances it is quite impossible to make the finding which

the Appellant needs, which is a positive finding that the respective overall impressions are the same. I therefore dismiss the appeal on the prior art ground, as well as on the proprietorship ground.

## **7. Procedural matters**

79. Following the Hearing Officer's decision, the Appellant decided to dispense with the services of the solicitors and counsel who had represented it at first instance. I make no criticism of this decision which is one which a party is entitled to make. It is not unknown for parties to take this step when a hearing has not gone well for them.
80. Counsel who represented the Appellant at first instance was asked to settle the notice of appeal. The section of the notice relating to the prior art ground was extremely short, and was severely but justifiably criticised by Mr Moss for failing to set out anything more than a contention that the Hearing Officer's decision was wrong in its result and a criticism that her reasoning was "conclusionary". I infer that this Notice of Appeal was put in very much as a holding operation, at least as regards the prior art ground. Had the Appellant then promptly appointed replacement solicitors and counsel, no doubt the notice would have been reviewed and an application could have been made to amend it to raise a more coherent set of grounds in good time before the hearing.
81. However that is not what happened. Instead of appointing new representation, the Appellant resisted the listing of the appeal hearing until some time in the indefinite future since the relevant director suggested that the demands on his time were such that he would not be able to appoint replacement representation for some months.

82. It is clearly unacceptable for a party to initiate an appeal which creates inevitable uncertainty as regards the rights of the respondent and of the public at large, and then to seek to use its own failure to replace its representation in a timely way as an excuse to defer the hearing. I therefore rejected the Appellant's attempt to defer the appeal hearing indefinitely, although I granted the maximum possible indulgence to the Appellant by setting the hearing date as the last of the available dates for the Respondent's counsel. I rejected two further attempts on behalf of the Appellant to defer the hearing date, since I considered that it was likely to be possible for the Appellant to obtain competent representation for that hearing, and even if I were wrong on that assessment the Appellant would be the author of its own misfortune.
83. The upshot was that Ms McFarland was instructed to represent the Appellant at the hearing but clearly at such a late stage that revising the inadequate notice of appeal would not have been possible. Further, the preparation of the hearing bundle was late, as a result of which the skeletons were delivered late and/or without references to the hearing bundle. I do not attach any blame to Ms McFarland or her instructing solicitor personally for these problems since they were doing their best after being instructed at a late stage, but I do lay these problems at the door of the Appellant itself.
84. When I belatedly read through the skeleton arguments and other papers before the hearing, it struck me that the hearing officer's reasoning identifying the informed user was difficult to reconcile with the General Court's decision in *Kwang Yang*. I therefore sent a message to counsel asking them to be ready to deal with this point and to address me on that

case, but regrettably only on the morning of the hearing itself.

85. At the hearing I indicated that in view of the late stage at which I raised this point, I would allow the parties a full opportunity to deal with the *Kwang Yang* case by way of further written submissions after the hearing or if appropriate at a further oral hearing. Mr Moss argued that it was not open to me to disturb this aspect of the Hearing Officer's decision given that her identification of the informed user had not been challenged in the notice of appeal.
86. I can understand why the respondent to an appeal can feel aggrieved if the appeal tribunal itself raises a ground of possible error in the decision under appeal which has not been raised by the appellant. However, the function of Appointed Persons is not only to do justice between the parties - which of course must be the paramount consideration - but also to provide correct guidance on matters of law and practice to the Office to the best of our ability. I was told during the hearing that there are substantial numbers of this kind of cut diamond design on the register, so the correct approach to identifying the informed user and the other points I have covered above are of wider importance than just to the parties to this appeal.
87. An appellate tribunal has wide powers to permit amendments to the grounds of appeal, or indeed to the pleadings, at a late stage, although it must take care in exercising such a power that it does not unfairly prejudice a party which is affected by the late raising of a new ground.
88. Mr Moss suggested as a possible intermediate course that I could potentially comment on this aspect of the Hearing Officer's decision

without that forming part of the reasoning on the basis of which I actually dispose of the appeal. This suggestion has its own problems, since it could lead to a scenario where a registered design is left on the register, but the Appointed Person has made a comment on the Hearing Officer's decision which if followed through would result in invalidity. This would be a highly unsatisfactory situation both for the registered design owner and the general public, for obvious reasons.

89. Towards the end of the hearing I enquired of Mr Moss whether, if I were to decide that the Hearing Officer was wrong in her identification of the informed user but that it would not result in the registered design being invalid, he and his clients would still wish to put in the further submissions which I had invited. On instructions he indicated that in those circumstances his clients would not feel the need to put in further submissions. I therefore retired to consider my decision on the basis that I would notify the parties and invite further submissions on the issue of identity of the informed user, and on the procedural permissibility of taking this point when it was not in the notice of appeal, if it were potentially to affect the overall result of the appeal. In the end it does not, for the reasons I have explained above.



## **8. Conclusion**

90. In the result:

1. I dismiss the appeal on both grounds (proprietaryship and individual character).
2. I invite the parties to make submissions on the costs of the appeal.

*Martin Howe*

Martin Howe QC  
Appointed Person (Designs Appeals)  
8 November 2021