

O-253-17

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF REGISTERED DESIGNS Nos. 4019752 and 4019267
IN THE NAME OF AHMET EROL**

and

**REQUESTS TO INVALIDATE (Nos. 42/14 AND 43/14)
BY SUMAIRA JAVAID**

DECISION

1. This is appeal from decision O-152-16 dated 23 March 2016 by the Hearing Officer (Mrs Judi Pike) acting for the Registrar of Designs, which declared invalid registered designs Nos. 4019752 and 4019267 belonging to Mr Ahmet Erol.

Designs Appeals to an Appointed Person

2. This is the first decision of an Appointed Person under the new appeal regime for designs created by the Intellectual Property Act 2014. The system of appeals to an Appointed Person, as an alternative to the route of appealing to the High Court in heavier and more complex cases, was intended to mirror the long standing system of appeals to an Appointed Person in trade mark appeals.
3. Both the statutory provisions and the rules (The Appointed Person (Designs) Rules 2015, SI 2015 No 169) are closely modelled on the corresponding statutory provisions and rules relating to appeals in trade mark cases.
4. In addition to the rules themselves, there is a large reservoir of practice and procedure which has built up on appeals to Appointed Persons in trade mark cases. Unless there is a relevant difference between substantive designs law and trade mark law which justifies a different approach, or some other specific and

concrete reason, the Appointed Persons for designs appeals will follow and apply the established practice and procedural decisions of the Appointed Persons in trade mark appeals.

The decision under appeal

5. Requests to invalidate registered designs Nos. 4019752 ('752) and 4019267 ('267) were made by Sumaira Javaid on the ground that they lacked novelty or individual character under section 1B(1) of the Registered Designs Act 1949, as amended ("the Act"). Each of the designs (reproduced later) consists of a garment on the chest of which a somewhat modified Union flag is displayed.
6. Ms Javaid's overall contention was that she and many of the suppliers working in the London souvenir market had been selling similar designs for many years prior to the application dates for these designs (both in the year 2011). She asserted that the proprietor (Mr Ahmet Erol) had not created the designs but instead had registered existing generic designs, hijacking the London souvenir market.
7. Despite the width of these assertions, Ms Javaid did not produce systematic evidence of the pre-application design corpus. The Hearing Officer proceeded on the basis that there was no evidence before her about the design corpus which would allow her to take it into account in reaching her findings. Ms Javaid's evidence however relied upon a large number of individual items of alleged prior art. The hearing officer painstakingly went through the evidence relating to these numerous allegations, and rejected all of them except two, either on the ground that Ms Javaid's evidence did not prove that the material concerned had been made available to the public or that the design which might have been prior published was so different from the designs in suit that it was not relevant.
8. However, she found on the balance of probabilities that two relevant items of prior art had been made available to the public. The first was a photograph (said to have been from a photo shoot conducted by Global Fashion Links) which was placed on Facebook in 2010. Secondly, she was prepared to give "some weight" to witness statements from Nasar Ahmed and T. Piratheepan

which said that garments bearing a Union flag design depicted in the witness statements had been on the market from 2005 or 2006.

9. She went on to compare the designs in suit with these two items of prior art and found that each of the designs in suit did not create a different overall impression compared to those earlier designs which had been made available to the public before the relevant date. Accordingly, she declared the two designs in suit to be invalid.

Representation, and the parties' request to allow the appeal by consent

10. In the proceedings below, Ms Javaid was not represented, but the hearing officer allowed her husband Mr Malik Tanveer to make representations on her behalf in view of her limited command of English. According to paragraph 5 of the hearing officer's, Mr Erol was represented before her "*by Ms Millie Balkan, of Mishcon de Reya LLP.*"
11. When I read that, I understood that to mean that Mr Erol had been represented by a solicitor from that well-known firm appearing in the normal way on behalf of the firm. One assumes that the hearing officer would also have understood Ms Balkan to have been appearing as a solicitor advocate in that capacity.
12. Mr Erol's written grounds of appeal were contained in a document headed "Preliminary Skeleton Argument" running to 79 pages including interspersed documents. The document purports to have been settled by a barrister whose name appears at the end. The grounds contain the following passage:

"11. Further, the Registrar is incorrect to state - para 24 "Mr Erol made no request to cross examine Ms Javaid." The Appellant was a litigant in person assisted by his niece acting as an interpreter. The Registrar did not permit any questions to be put to the Respondent. ..."

13. At the hearing of the appeal Mr Erol was not represented by that barrister or anyone else, but was assisted by a friend who acted as his interpreter when required. I asked Mr Erol to explain the apparent discrepancy between the status of Ms Balkan as understood by the hearing officer and recorded in her decision, and paragraph 11 of his grounds of appeal. He explained that Ms

Balkan was his niece who works, or at least at the time of the hearing worked, for Mishcon de Reya, although she is not a solicitor, but maintained that she was assisting him as interpreter not as a representative. This puzzled me since among the appeal papers is a professional-looking skeleton argument lodged shortly before the hearing in front of the hearing officer which was signed by “Millie Balkan/For the Proprietor”. On this being drawn to his attention, Mr Erol seemed to withdraw his suggestion that the hearing officer had misunderstood the status of Ms Balkan before her, but I was not able to understand from what he said why the suggestion had been made in the first place that Ms Balkan was only an interpreter.

14. This matter raises a number of concerns. First, the Hearing Officer appears to have understood that Ms Balkan was appearing in front of her as a representative of the well known firm of solicitors Mishcon de Reya, and would naturally have assumed from that and from the skeleton argument (which looks professionally formatted, beginning with a reading list) that she was appearing as a qualified solicitor. It would seem that she was in fact appearing in her private capacity for her uncle and that she was not a solicitor, although I was not told the nature of her employment.
15. Before the Hearing Officer, Ms Balkan put forward a number of allegations of forgery of documents and perjury. I will deal later with one in particular of these allegations. Solicitors who act as advocates are not permitted to put forward any allegation of fraud, unless “*instructed to do so and you have material which you reasonably believe shows, on the face of it, a case of fraud*” (SRA IB(5.7)(b)). Similar rules apply to the Bar. In consequence, tribunals are entitled to regard allegations of fraud advanced before them by professional advocates as having at least satisfied this threshold test in the professional judgement of the advocate. There is a risk that the hearing officer may have given more weight to these forgery allegations than they were due, under the mistaken impression that they were being advanced by a professional advocate, although fortunately she did not uphold any such allegation.
16. Mr Erol’s attempt to downplay the status and role of Ms Balkan in order to further his present appeal means that I must treat with considerable caution his

allegations about factual matters or about the course of proceedings, particularly where they are not clearly supported by documents.

17. About four weeks before the date fixed for the hearing, which took place before me on 14 February 2017, I was informed that the parties had settled the appeal. I was invited to make an order by consent whose effect would be to set aside the hearing officer's decision and so restore the designs to the register. I declined to make such an order. The hearing officer's decision that the designs are invalid is not simply a transaction between the parties to the proceedings. It is an official act under public law which affects the status of legal rights on the register and so affects the rights of the public at large. Accordingly, such a decision cannot be set aside on appeal, unless the appellate tribunal is satisfied on the merits of the appeal.
18. I then received a letter from Ms Javaid, the successful applicant below and respondent to this appeal, stating that the owner of the registered designs (the appellant Mr Erol) had granted her "*permission to sell these designs no 4019752 and 4019267 fully, without any restrictions and any time period*", and that she had no objection to those designs staying on the register.
19. To my mind this emphasises and reinforces the strong public interest which exists in not permitting the reversal of a first instance decision to invalidate registered intellectual property rights except where that decision is shown to be wrong on the merits. If the decision were to be reversed by consent in the way sought by the parties, the appellant and the respondent would be in a favoured club of traders free to operate within the scope of the monopoly rights which had been restored to the register and could then be asserted to exclude other traders from the market.
20. In view of these events, the respondent Ms Javaid chose not to participate further in the appeal and did not appear at the hearing.

Mr Erol's Application to rely on additional evidence and materials

21. The bulk of Mr Erol's Grounds of Appeal consists of an attempt to rely on what is described as "*Evidence of fabrication discovered subsequent to the hearing*". These

documents indicate that there has been litigation in court and other proceedings at the IPO between Mr Erol and the respondent and her husband relating to designs and other matters, that these proceedings have been acrimonious, and that Mr Erol has made allegations of forgery of documents, falsification of witness statements, and falsification of posting dates of envelopes.

22. Most of these documents seem to be advanced in support of a general suggestion (in paragraph 22 of Mr Erol's Grounds of Appeal) that "*Sumair Javaid is a habitual liar and fabricates evidence in IPO proceedings on a regular basis*". The majority of the documents are dated before the date of the hearing in the Office, which was in January 2016.
23. The principles upon which an Appointed Person will receive fresh evidence on an appeal were considered by Mr Daniel Alexander QC in his decision in *Guccio Gucci SPA's TM* (O-424-14, 1 October 2014). Those principles were set out by the Court of Appeal in *EI Du Pont De Nemours & Co v. S.T. Dupont* [2003] EWCA Civ 1368 at [100] to [104]. In general, the well-known principles originally set out by the Court of Appeal in *Ladd v Marshall* [1954] 1 WLR 1489 should be applied in the same way as they are now applied, as broad discretionary guidelines rather than strict rules, in appeals to the Court of Appeal from a court of first instance. However, in *Du Pont* at [104], the Court of Appeal approved an observation by Pumfrey J in *Wunderkind TM* [2002] RPC 45 at [57]:

"There is no doubt that in a trade mark appeal other factors outside the *Ladd v. Marshall* criteria may well be relevant. Thus in my judgment it is legitimate to take into account such factors as those enumerated by Laddie J in *Hunt-Wesson*, provided always that it is remembered that the factors set out in *Ladd v. Marshall* are basic to the exercise of the discretion to admit fresh evidence and that those factors have peculiar weight when considering whether or not the overriding objective is to be furthered."

24. The judgment of Laddie J in *Hunt-Wesson's TM Appn* [1996] RPC 233 at 241 lines 36-50 illustrates a factor of this kind. If late evidence is excluded from an appeal in opposition proceedings then this may adversely affect members of the trade and public who were not involved in the failure to submit the evidence in a timely manner; further, exclusion of late evidence from such an appeal may simply lead to multiplicity of proceedings since that evidence can then be relied

on in post-grant invalidity proceedings. Mr Alexander's decision in *Guccio Gucci* provides another illustration of circumstances in which evidence was admitted on appeal even though the *Ladd v Marshall* principles were not satisfied. In *Guccio Gucci* they were relaxed in favour of the admission of late evidence by the proprietor, but in a set of circumstances which Mr Alexander described as exceptional. He observed at [79] that "*it should not be thought that, in general, appellate tribunals in trade mark matters will permit a party to remedy an evidential deficiency on whatever terms.*"

25. Similar factors to those in trade mark appeals may be relevant to registered designs appeals and I have no doubt that where they are relevant, a similar approach should be adopted in registered designs appeals which involves to a limited extent the relaxation of the application of the *Ladd v Marshall* principles.
26. Turning to this case, I note that in addition to most of the documents being dated before the hearing at first instance, there is overlap between those documents and the documents which were annexed to Ms Balkan's skeleton argument served shortly before that hearing. The hearing officer refused to admit these documents on case management grounds (as well as excluding late evidence sought to be adduced by the respondent) because they were not introduced into evidence in a timely manner. Her case management decision is not in terms appealed from. In any event it is only in the rarest circumstances that an appellate tribunal would reverse a discretionary case management decision of this kind, in view of the need to maintain the fairness and effectiveness of proceedings by preventing the disorderly introduction of evidence and material at a late stage without good reason. I am not prepared to allow Mr Erol to bypass the Hearing Officer's case management decision to exclude evidence at first instance by seeking to reintroduce that evidence in support of this appeal.
27. The hearing officer also refused to allow Mr Erol to ventilate at the hearing before her his allegations about alleged falsification of posting dates of envelopes, because these had been addressed at a previous hearing. Again, Mr Erol is seeking to circumvent a case management decision and I decline to allow him to ventilate these allegations again on this appeal.

28. I also refuse to allow Mr Erol to introduce other documents which were in his possession before the date of the hearing since he has provided no good reason for not having relied on them in the proceedings below in good time.
29. Mr Erol handed in at the appeal hearing itself a folder containing further documents. This contained a typed document headed "Court Speech", which I was happy to accept as supplementing his oral submissions at the hearing. However the folder also contained 27 exhibits consisting of further documents which were sought to be relied upon on in the appeal in support of Mr Erol's contention that the respondent had produced "fake evidence".
30. Most of these documents were either dated before the first instance hearing or overlapped with or were further copies of documents included in Mr Erol's Grounds of Appeal. There are some isolated documents which post-date the hearing. There is an Order of HH Judge Hacon made in IPEC on 25 November 2016, which is said to lend support to the suggestion that Ms Javaid fakes evidence. This Order indicates that an action commenced by Mr Malik Tanveer (Ms Javaid's husband) was discontinued by consent with costs in favour of the defendant (Mr Erol). While this indicates that Mr Tanveer's claim was withdrawn on unfavourable terms as to costs, it goes nowhere in supporting an allegation of fabrication of evidence.
31. This leaves only some other isolated documents dated after the hearing. There is a letter to the IPO dated 22 June 2016 from a firm of solicitors which gives the results of a VAT number validation query on two VAT numbers said to have been used by Global Fashion Links Ltd on documents which formed part of Ms Javaid's evidence. There is also a letter dated 9 February 2016, i.e. after the hearing but before the decision, from a Mr Tamim Momoni. He is said to be the "Tamim" who signed one of the group of six witness statements referred to by the hearing officer at paragraph 28 of her decision, but not one of the two which she relied upon as having some weight. In my judgement, these documents are the results of trains of inquiry which could and should have been undertaken in advance of the hearing, and in any event are only of indirect relevance to the grounds upon which the hearing officer upheld the invalidation requests.

32. For these reasons, it is clear that Mr Erol's application to adduce additional evidence on the appeal fails to satisfy the *Ladd v Marshall* principles. I do not consider that there are present in this case any additional factors pertaining to the nature of registered designs proceedings which would justify a more relaxed approach to the admission of evidence on appeal. I therefore refuse to allow Mr Erol's additional materials to be introduced into the appeal.

Merits of the appeal - findings on the evidence

33. I now turn to consider the Grounds of Appeal insofar as these are based on criticising the decision itself on the basis of the evidence and materials that were before the Hearing Officer, rather than on the basis of new evidence.

34. Mr Erol's principal criticism in this regard is that having dismissed many allegations of prior publication which were advanced in evidence by Ms Javaid, the hearing officer has failed to give sufficient reasons why the evidence on which she founded her final decision was reliable. Mr Erol contends that this omission is all the more relevant given that Ms Javaid's credibility was very much a live issue during the course of the proceedings.

35. This argument is flawed. It is of course the case that if the evidence of a witness is found to be unreliable, in the sense of untruthful, on numerous matters, then anything else the witness says must be treated with great caution and cannot be assumed to be true just because material is not available to contradict that part of the evidence. But that is not what has happened here. The hearing officer rejected the other allegations not because she found Ms Javaid to be untruthful but because the evidence was not of sufficient quality or completeness satisfactorily to prove the allegations. She made no finding that Ms Javaid was an untruthful or unreliable witness, as distinct from identifying deficiencies within the evidence she had adduced.

36. One important example was a brochure for Global Fashion Links (Annex 2-B) showing a number of designs, which was said to date from 2003. However, as pointed out by the hearing officer, Ms Javaid's evidence provided no information as to whether this brochure was ever sent to customers, or how

many were printed. A tribunal cannot simply assume or infer that such a document was communicated to the public in the absence of some positive evidence that this happened. As I have mentioned, Ms Javaid was not professionally represented in the proceedings, and this is the kind of obvious lacuna in the evidence which a professional representative should point out and correct. However, the fact that Ms Javaid's evidence on this part of the case failed to prove a relevant prior publication does not of itself lead to an inference that another piece of evidence, if cogent on its face, should be disregarded because Ms Javaid's evidence is generally unreliable.

37. This brochure was subject to an attack at the hearing by Ms Balkan, who alleged that it was a forgery because of a discrepancy in the formatting of the telephone numbers printed on the document. At paragraph 25 of her decision, the hearing officer described as "unacceptable" the way in which this challenge to the genuineness of the document had been raised for the first time at the hearing, referring to Tribunal Practice Notice 5/2007 which in turn refers to the decision of Mr Richard Arnold QC as an Appointed Person in *EXTREME Trade Mark* BL O/161/07. She said that: "*It is wrong to hijack both the [opposing] party and the decision-taker at the hearing, when there is no opportunity to address the challenge in evidence.*"
38. I fully agree with the hearing officer's observation. The reason why prior notice and/or cross examination of a witness is normally a prerequisite for advancing this kind of allegation is twofold. First, as a matter of principle, it is wrong that a witness or party should stand at risk of being condemned as having engaged in perjury or forgery without being given a fair opportunity to be heard in answer to the allegation. Secondly, as a matter of practicality, an allegation that a document is forged may greatly widen the categories of evidence upon which the accused party may wish to rely in answering the allegation: for example, it may require the introduction of expert evidence or other corroborative evidence external to the document which assists in proving that it is genuine, whose potential need would not have been apparent until the allegation of forgery is raised.
39. Further, the basis upon which Ms Balkan raised the allegation of forgery is

flimsy indeed. It was based upon the discrepancy between the format of one outer London telephone number which was printed as +44(0)20 8XXX XXXX and another (the printer's own number) which was printed as 0044 208 XXX XXXX. The grouping of the second of these telephone numbers is strictly speaking incorrect because 20 replaced the previously separate inner and outer London area codes of 207 and 208 many years ago. Nonetheless to this day many people continue to print telephone numbers as if the superseded separate area codes for inner and outer London still exist. Similarly, some people may choose to print the international access code as + and others as 00; some may choose to insert parentheses round the (0) prefix which need not be dialled when calling from abroad.

40. For a printer to print the client's telephone number in the client's preferred format and to print its own telephone number in its own usual format does not strike me as in any way unusual or raising any ground for suspicion. Quite apart from and in addition to the procedural impropriety of seeking to raise this forgery allegation at the hearing without prior warning, in my judgement this format discrepancy did not give raise to any credible or arguable basis for raising a serious allegation of this kind in the first place.
41. This brings me to Mr Erol's ground of appeal relating to the first item of relevant prior art relied on by the hearing officer. This is a photo shoot photograph on Facebook, which appears as part of a screen shot which bears on its face the date of April 7, 2010. In his appeal grounds, Mr Erol introduced a series of photographs showing how, in his contention, the date on this screen shot could have been forged, and argued that the screen shot produced in evidence should be disregarded as having no evidential weight.
42. In my view, the arguments against parties being permitted to raise allegations of forgery for the first time at first instance hearings apply with redoubled force to attempts to raise forgery allegations for the first time on an appeal. I reject Mr Erol's attempt to rely on this allegation at this stage both as procedurally improper and also as having no credible or proper basis. There is no positive evidence which contradicts the fact that this photograph was made available on the internet from 7 April 2010; his contention is merely that it could have been

technically possible to forge the date. Accordingly I uphold the hearing officer's finding that this Facebook photo formed part of the relevant prior art.

43. Mr Erol also challenges the hearing officer's reliance on the two witness statements. The hearing officer rightly approached these witness statements with caution, since they formed part of a series of six witness statements said to be from customers of Global Fashion Links which were in common form. The hearing officer rightly referred to the well known observation of Lord Esher MR in *Re Christiansen's Trade Mark* (1885) 3 RPC 54 at 60 about the caution that a court should exercise in placing weight on a series of affidavits which are in common form. She declined to place any weight on the majority of these witness statements because they omitted necessary information such as the full name of the person signing them. However, she accepted the statements of Nasar Ahmed and T.Piratheepan as carrying "some weight" because they were properly signed and dated.
44. Although the witness statements are largely pre-printed in common format, they do allow for the insertion of some information (in addition to the names and addresses of the deponents) by hand. In particular, space is left on the pre-printed sheets for the deponents to insert the date when they first began trading with Global Fashion links, and space is left under each of twelve depicted designs of garments for the deponent to insert a date after the words "*Buying since ...*" On Mr Ahmed's statement a date in March 2006 has been inserted as the date when he first began trading with Global Fashion Links, and '2006' has been filled in under each of the garment designs including the one of relevance. On Mr Piratheepan's statement, the starting date has been filled in as 01.08.2005 and the date under each design after "*Buying since*" is given as '2005'.
45. In my judgement the hearing officer properly considered the potential deficiencies of these common form witness statements with appropriate caution, and was entitled to reach the conclusion she did, which was that "some weight" could properly be placed on them. Given the fact that there is nothing particularly implausible or surprising in such garments having been on the market, and the absence of any evidence directly contradicting them, I consider

that the hearing officer was entitled to treat as forming part of the prior art the relevant design to which these witness statements related.

The Hearing Officer's approach to the nature of the designs in suit

46. Before proceeding to compare them with the prior art in order to assess whether they have individual character, the hearing officer addressed the nature of the two designs in suit in the following passage:

"Scope of the registered designs

21. Mr Erol's design application forms state that the products for which the design applications were made included t shirts, hoodies (and umbrellas). The design was applied for as part of a multiple design application, which also includes hoodies and umbrellas. These are all different items. It is clear that the design the subject of these proceedings is a Union Jack flag applied to the top half of a garment. Secondly, the attachments to the counterstatements, intended to support Mr Erol's claim to have originated the designs, show Union Jacks without depicting any garments. The tick/swoosh is present in the attachment to the counterstatement for 4019267, but not the letters NAS. The scope of the design registrations is therefore:

4019752: a Union flag applied to the top half of a garment;

4019267: a Union flag including a tick/swoosh applied to the top half of a garment.

The letters NAS at the bottom of the jacket in 4019267 do not form part of the design, either as attached to the counterstatements, or in the scope of the design as applied for."

47. This passage of the decision raises two problems. The first is the reference made to the multiple design application and the other applications which were included in it. Secondly, the way in which the hearing officer has characterised the 'scope' of the designs calls for analysis.

Multiple design applications and the products for which the designs are registered

48. The hearing officer refers to "the design" as having been applied for as part of a multiple design application. This information was not contained anywhere within the appeal papers, nor can it be ascertained from the website entry for

the '752 or '267 designs. I therefore made inquiries of the Office in advance of the appeal hearing about the information upon which this passage in the decision was based and was provided with a multiple design application which had been filed by Mr Erol, which application resulted in the registration of designs Nos. 4019751 to 755 inclusive, i.e. including the '752 design. The Office also confirmed, as I suspected, that it is not possible for members of the public to ascertain from the IPO website whether a design was applied for as part of a multiple application or what are the other designs which were included in that multiple application.

49. I consider that a hearing officer is entitled to take account of information from the files of the Office in order to reach a decision on contested proceedings, even if that information was not included in the papers which were considered at the hearing. Clearly, there will be occasions when the potential relevance of materials in the Office files may become apparent only after a hearing in the course of deliberating on the contents of the decision. But it is essential in such a case that the parties are notified of such material and given a fair opportunity to comment on it before reliance is placed upon it in reaching a decision. That was apparently not done in this case.
50. In consequence I directed that the materials which the Office supplied to me in response to my request should also be provided to the parties to the appeal in advance of the appeal hearing in order that they should have the opportunity to make any comments they wished on the materials and on the way in which they are relied upon in the decision. Mr Erol did make certain comments at the hearing which I record below.
51. Under rule 4(1) of the Registered Designs Rules 2006 (SI 2006/1975), a single application may be submitted on statutory form DF2A seeking the registration of multiple designs. This has advantages of administrative convenience and in reduced fees compared with filing a succession of applications for one design each, but has no legal effect on the designs which are registered. These are and remain legally completely independent of each other. This is quite unlike, for example, the registration of trade marks in series, where the marks in the series are legally linked together.

52. The filed representation of the '752 design is as follows:-



53. Of the five designs in the multiple application, two ('752 and '755) depict t-shirts, one ('751) depicts a hoodie, and the remaining two depict umbrellas. The representation of '753, one of the umbrella designs, is as follows:-



54. If form DF2A is completed correctly, there should be an individual continuation sheet for each design upon which should be inserted, among other information, the product or products which the design is for -- the applicant should separately specify the product(s) for each individual design. In this case it seems that a single continuation sheet labelled at the top "*this is the 1 ... design out of a total of 5 designs*" was replicated and associated with each of the five design representations. That sheet specifies the product or products as "Hoodies, t shirts, umbrellas".
55. It might at first appear that this portmanteau list of products was used because the multiple application contains designs respectively for hoodies, t-shirts and umbrellas, and each design was intended only to be relevant to the individual product shown in its representation. However Mr Erol at the hearing told me that this was not his intention. These are the kinds of goods which he regularly sells and therefore it is his general practice to apply for a design registration in relation to this list of products regardless of which kind of product the filed representation relates to.
56. One can see how some of the principal features of the '752 design could be abstracted and then applied to a hoodie rather than a t-shirt. With slightly more imagination, one can see that the Union flag style theme on the upper chest of the t-shirt in the '752 design could be replicated onto the umbrella in the '753 design. But that does not mean that the '752 design as such is capable of being applied to either a hoodie or an umbrella.
57. The question then is how all this bears on the interpretation of the 'scope' of the '752 design, as the hearing officer's reference to the multiple application suggests it might. In my judgement the fact that the application which led to the grant of '752 was a multiple application, or the nature of the other designs included in that multiple application, can have no bearing on the interpretation of the design as it stands on the register. For reasons of legal certainty, it should not be interpreted by reference to material which is not readily available to the public, in particular to competing economic operators. (In this regard, see Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] ECR I-6129 at [30]: a trade mark case but the principle must equally apply to design registrations).

58. It is understandable that having seen an anomaly when comparing the the '752 and '267 designs with the lists of products to which they relate, the hearing officer should have wanted to get to the bottom of it. However for the reasons I have explained, the fact that the '752 design was applied for as part of a multiple application can have no bearing on the interpretation of the design which has been registered. Nor, obviously, can the applicant's subjective intentions when applying to register.

What is meant by "scope" of the registered designs?

59. The subheading above paragraph 21 of the hearing officer's decision (quoted at my paragraph 46 above) refers to the "scope" of the registered designs in suit. Article 10 of the Community Designs Regulation (EC) No 6/2002 defines the "scope of protection" of a Community design as including "any design which does not produce on the informed user a different overall impression." Section 7(1) of the Act, which does not use the word "scope" but which corresponds to Article 10 of the Regulation, grants to the proprietor of a national registered design "the exclusive right to use the design and any design which does not produce on the informed user a different overall impression." This wording makes quite clear the distinction between the design which is registered itself, and a penumbra of other designs which may differ to a lesser and greater degree from the registered design but still produce the same overall impression, and therefore fall within the scope of protection conferred by the registered design.
60. But in paragraph 21, the hearing officer is not using the word "scope" as referring to the scope of protection. Rather, she considers that each of the registered designs itself has a scope, which in the case of the '752 design is defined by the verbal formula "a Union flag applied to the top half of a garment". It seems to me that this is treating a design registration as analogous to a patent claim, which can cover a large or indeed infinite number of different embodiments which possess the features of the claim. Thus, the class of products to which the design as so defined could be applied would include a garment of any shape, or a garment of any colour outside the top front area to which the Union flag is applied.

61. This approach is not correct in law. A design registration is not like a patent and it relates only to a single design. It may be necessary to interpret the representation in order to decide what are the features which form part of the design as registered. For example, the applicant may choose, by making it appropriately clear, whether the design as registered consists only of the shape of a product, or consists also of features of surface appearance. (Lack of clarity in this regard caused much of the difficulty in the *Trunki* case: *PMS International v Magmatic Ltd* [2016] UKSC 12; [2016] RPC 11, and has led to new guidance notes to applicants DPN 1/16 published by the Office on 1 June 2016). Or an applicant is entitled to choose that his registration relates to only a part of a product.
62. But the exercise conducted in paragraph 21 of the decision is different in kind from either of the above. It amounts to abstracting certain features only from those shown in the representations, and treating the design as registered as consisting only of those features in a generalised form rather than in the form as shown in the representations.
63. The representations of both the '752 and '267 designs show the complete garments and indeed show both the front and back views. There is nothing to indicate that any of the features of either shape or surface appearance visible in the representations are excluded from forming part of the designs as registered. For example, there is nothing to exclude the stylised letters NAS which are visible at the bottom front of the shirt in the '267 design from being a feature of the design as registered. Of course, a minor feature like this may in the end play little or no part when assessing the "overall impression" of the design for the purposes of comparison with the prior art or an alleged infringement, but that is a quite different exercise which should not be muddled up with the question of what is the design as registered.
64. In paragraph 21, the hearing officer makes reference to the attachments to Mr Erol's counterstatements, which she describes as "*showing Union jacks without depicting any garments.*" These attachments in fact show CAD drawings of the red and white elements which are subsequently embroidered on to a dark blue base garment in order to form the Union flag motifs. One can readily see that

once created these logos could then be applied without difficulty to a range of different base garments. However, the subjective process by which these designs were created does not provide a basis for the hearing officer's treatment of the designs as registered as consisting only of the logos in combination with a generalised base garment of indeterminate nature. In general, the subjective process by which a particular applicant created a design must be irrelevant to and inadmissible in the interpretation of the design on the register, which must be objective.

Comparison

65. An assessment at first instance of whether a registered design produces the same overall impression as the prior art should normally be accorded considerable respect on appeal. However in the present instance the comparison carried out by the hearing officer is flawed, since she has compared the prior art with her set of abstracted features from the two registered designs rather than with the registered designs themselves. This has led her to disregard ab initio a number of differences between the designs as registered and the prior art which, whether or not they are in the end determinative, should have been taken into account in assessing whether or not the same overall impression is produced.
66. I therefore need to carry out the comparison myself de novo.
67. In my view, both the designs in suit are new when compared with the prior art, i.e. they are not identical and they differ in more than "*immaterial details*" (section 1B(2) of the Act). I will therefore consider whether they have "*individual character*", i.e. whether in each case "*the overall impression it produces on the informed user differs from the overall impression produced on such a user*" by the prior art (section 1B(3) of the Act).
68. The hearing officer quoted HHJ Birss QC (sitting in the High Court) in *Samsung v Apple* [2012] EWHC 1882 (Pat); [2013] ECDR 1 at [33]-[35] for a description of the characteristics of the informed user. Basing herself on those principles, she set out the characteristics of the informed user in this case at paragraph 33 of her decision, with which I agree:-

“33. The informed user of clothing is a consumer as opposed to an actual designer or some other expert in the field. However, the informed user is not an average or standard consumer, it is instead someone who is likely to have an interest in clothing design. Such a person is, therefore, likely to have a keen eye in relation to the design attributes of a particular item of clothing. They will not, however, make a forensic analysis of each and every detail.”

69. Implicit in the above is that one is talking about an informed user of clothing in general (or at least of garments like t-shirts and hoodies in general) rather than garments specifically for the souvenir market. There is nothing to stop the garments subject of the registrations being sold in the clothing market generally, and in any event an informed user of souvenir clothing seems too narrow - who would use or wear only souvenir clothing?
70. The main feature in common to both registered designs and both items of prior art is the presence of versions of Union flags, modified in various ways. There is no evidence in this case about the extent to which Union flag motifs may have appeared on garments prior to the application dates for these designs, but I am entitled to assume that the informed user in relation to these UK-registered designs would be reasonably familiar with the national flag. Accordingly the informed user would recognise that the two registered designs and the two items of prior art bear versions of the Union flag and would be struck by this fact; but also would probably tend to notice features which differ from those in the conventional representation of the flag.
71. The present form of the Union flag (sometimes called the Union jack) was adopted following the Union with Ireland Act 1801, and in conventional form appears as follows:



72. One fairly subtle feature is that the red diagonal bars which form the arms of the cross of St Patrick are offset anticlockwise from the centre lines of the diagonals of the flag. This is because the white diagonal bars of the cross of St Andrew also have to be represented within the flag. However the flag is not infrequently represented in informal contexts without this particular feature, i.e. with the red diagonal bars centred on the diagonal lines of the flag.

The '752 design

73. The representation of this design appears at paragraph 52 above.
74. It shows front and back views of a t-shirt. It is not easy to be certain owing to the vagaries of colour reproduction, but it appears that the base colour is either a very dark blue or possibly black. It has a white collar, and white cuffs where the sleeves end on the upper arms.
75. Easily the most prominent visual feature is the Union flag motif on the chest area. This is prominent both because of its intrinsic nature and because of its position, where it immediately strikes the eye of someone encountering another person wearing it or seeing the t-shirt as it would typically be displayed for sale. It differs from the official version of the flag, first because the bars of St Patrick's cross are centred on the diagonals rather than offset, and secondly because the ends of the bars of St Patrick's and St George's crosses have a white margin which has no counterpart on the flag. In addition there is a V-shaped gap in the upper centre within the red vertical bar of the cross of St George when the neck opening is ajar.

76. The photo shoot placed on Facebook in 2010 is as follows:



77. The garment in the photo is a hoodie as indicated by the presence of the visible red draw strings. It should be borne in mind that the relevant comparison is between the garment which is shown in the Facebook photo and the garment the subject of the registration, rather than with the photo as such. The hood of the Facebook garment can be worn either in the up or the down position, and both possibilities should be taken into account. The neck opening in both cases can be either open or closed, so superficial differences of appearance flowing from the fact that the neck openings are fastened at different heights in the prior art photo and the registered representation should be discounted.

78. The garments share the very dark blue or black base colour. They share the very prominent Union flag motifs in which the red bars of the cross of St Patrick are centred on the diagonals, but the relative proportions of white to red are different with the white areas being narrower on the Facebook hoodie than on the registered design. The bottom of the vertical bar of the cross of St George has a white margin. It is not possible to see on the Facebook

photograph whether the other bars have a similar feature and in the absence of evidence I will assume that they do not.

79. The most prominent difference between the Facebook garment and the registered design is that it is a hoodie and not a t-shirt. This difference will become more apparent if the Facebook garment is worn with the hood up. Further, it has long sleeves and lacks the white collar and cuffs on the registered design.
80. Having listed the differences and similarities in words, I need to make an assessment. As HHJ Birss QC pointed out in *Apple v Samsung* (ibid) at [31]-[32]:-

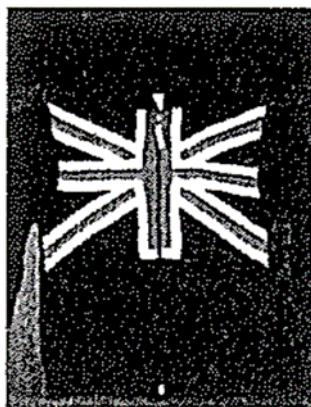
31 I start by reminding myself that what really matters is what the court can see with its own eyes (per Jacob L.J. in *Dyson Ltd v Vax Ltd* [2011] EWCA Civ 1206 at [8] and [9], emphasising a passage from his judgment in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936; [2008] E.C.D.R. 3; [2008] F.S.R. 8 (at [3] and [4])). The most important things are the registered design, the accused object and the prior art and the most important thing about each of these is what they look like.

32 I also remind myself that while the exercise is a visual one, judgments have to be written and reasons necessarily expressed in words. However I must bear in mind that it is the overall impression which counts and not a verbalised list of features, see [46] of the judgment of Arnold J. at first instance in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat); [2010] E.C.D.R. 18; [2010] F.S.R. 39 and his reference there to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] E.C.D.R. 13 (at [123], [125] and [126]). As Mann J. said,

“one of the problems with words is that it is hard to use them in this sphere in a way which avoids generalization. But what matters is visual appearance, and that is not really about generalities”.

81. HHJ Birss QC then went on to summarise the law relating to the informed user and to the various aspects of the comparison exercise relating to overall impression at [33]-[58]: the hearing officer’s decision sets out the key paragraphs. That was of course an infringement case rather than a case of comparison with the prior art. Judge Birss’s approach was affirmed when that case went to the Court of Appeal at [2012] EWCA Civ 1339; [2013] FRS 9.

82. In forming my view I have borne in mind both his observation (quoted in [32] above) that *"it is the overall impression which counts and not a verbalised list of features"*, and his final observation in [58] (quoted in the hearing officer's decision) that *"Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters."* Standing back, the Union flag motif on the upper front of both garments remains easily the most striking feature on each garment. It is executed in a similar way on each garment with centred red diagonal bars and includes a white margin at the ends of the bars of the registered design, and on the Facebook photo at the end of the most visually prominent of the bars, at the bottom front. Having regard to my view about the nature of the informed user, the impression formed by these respective designs should be assessed against the background of clothing or t-shirts and hoodies generally; it is not appropriate to assess this from the viewpoint of an informed user focussed specifically on the souvenir market with whom detailed differences between Union flag themed designs might weigh more heavily. I have considered also the other differences identified above, but do not consider that they are sufficient to produce a different overall impression.
83. Next I shall compare the '752 design with the garment shown in the two witness statements. The witness statements show the garment in question in the form of a reduced size monochrome picture. It should be borne in mind that the comparison is with the garment which the witness statements attest to having been on the market from 2005 or 2006, not with the picture itself.



Buying Since 2006

84. The Union flag motif on the garment attested to by the witness statements is similar to that in the Facebook picture, in that the St Patrick's cross bars are central to the diagonals and there is a white margin at the bottom of the vertical bar of the St George's cross. The ratio of the red to the white seems closer to the '752 design than to the Facebook picture. It is not possible to see the precise background colour from the monochrome picture but it is clear that it is very dark or black. The garment has long sleeves and a zip-up the front which might be characteristic of a hoodie. It is not possible to see whether or not it has a hood, but for the purposes of comparison with the '752 design I shall assume that it does have a hood in the absence of positive evidence that it does not. It lacks the white cuffs and collar of the '752 design.
85. Despite the differences between it and the '752 design, I consider that it creates the same overall impression. If anything it is closer than the Facebook photo.

Comparison of the '267 design with the prior art

86. I will now carry out a similar exercise in relation to the '267 design, but I will state my conclusions more briefly.



87. The '267 design is long sleeve high neck garment, whose base colour is very dark blue. No hood is visible in the rear view, nor are there drawstrings on the front view, but it has a zip all the way up the front. It has visible zip pockets on the front. A logo, which appears to consist of the stylised letters NaS, is visible on the front on the wearer's left hand side at the bottom.
88. The Union flag motif, like all the ones considered so far, has red St. Patrick's cross bars which are centred on the diagonals. It has a white margin at the bottom of the vertical bar of the St George's cross, but not at the end of the other bars. A particular feature which Mr Erol relied upon as being important is a white stylised tick or "whoosh" on the (wearer's) right side of the horizontal bar of the cross of St George. In addition, Mr Erol pointed out a feature not easily seen until attention is drawn to it, which is that the white pull on the zipper at the neckline is shaped like the "whoosh".
89. Comparing first with the Facebook photo hoodie, this design is more similar to it than the '752 design in that the design of garment is more similar, both being long sleeved zip fronted garments, albeit the Facebook garment has a hood and the '267 design does not. The Facebook garment lacks anything like the 'NaS' logo but this, despite forming part of the design as registered, is not prominent enough to make more than a negligible difference to the overall impression.
90. The 'whoosh' is of some significance, in that the informed user would recognise it as being an unusual feature which does not normally appear on Union flags. If this feature is sufficient to give rise to individual character in the '267 design in comparison with the Facebook prior art, it would imply that the monopoly right conferred by the '267 design must be correspondingly narrow and only infringed by a garment bearing a Union flag device with the "whoosh" or something similar in it.
91. However the statutory test of validity depends upon looking at the overall impression created by the design as registered and small features may not succeed in altering the overall impression, even if they are significant if looked at in isolation. As I have pointed out, what has been registered as a design in this case is all the features of shape and surface appearance of the garment as a whole, and any particular feature such as the "whoosh" must be assessed in

this context. In my judgement the 'whoosh' is too insignificant, even when taken together with the other differences I have identified, to result in the overall impression of the '267 design being different from that of the prior art.

92. I reach a similar conclusion in relation to the prior art garment in the witness statements. That garment is if anything closer to the '267 design than the Facebook hoodie.

Conclusion and disposition

93. For the reasons I have explained, I reject the Appellant's request to introduce voluminous additional materials into the appeal together with his attempt to raise on appeal a new allegation of fraud and forgery against the publication date of the Facebook photo. I uphold the hearing officer's findings on the evidence that the Facebook photo and the garment identified in the two witness statements of Nasar Ahmed and T. Piratheepan were prior art as against the two registered designs in suit.
94. I find that the hearing officer's comparison of the designs in suit to the prior art is vitiated by an error of law in characterising the features of the designs in suit, but having carried out the comparison myself I come to the same conclusion that the two registered designs lack individual character in the light of the above prior art.
95. The appeal is dismissed.

Martin Howe QC
Appointed Person (Designs)
18 May 2017