

**O/095/19**

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

**REGISTERED DESIGN NO. 6010384**

**IN THE NAME OF GORGE LTD**

**AND**

**APPLICATION NO. 6/18 BY K670 GMBH**

**TO INVALIDATE THE REGISTERED DESIGN**

## **Background and claims**

1. The registered design the subject of these proceedings was filed by Gorge Ltd (“the proprietor”) on 5 April 2017. The design was subsequently registered with effect from that date. The design is depicted in the following representations, which include the accompanying wording shown in the register:

FRONT VIEW



SIDE VIEWS





#### FOURTH VIEW

Shown in component parts - protection is sought for all parts



#### FIFTH VIEW



2. When filing the design, the proprietor stated “no colour is claimed as part of the design”. The application form also confirms that the design is for an “Altitude training and Fitness Mask”.

3. On 15 February 2018, K670 GmbH (“the applicant”) applied for the registration of the design to be declared invalid. It is claimed that the Chief Design Officer and employee of the applicant, Nicholas Wenger, designed a training mask which appears to have been commercialised under the name “Phantom Training Mask”. The parties have referred to this as “the K670 mask”. I shall do likewise. The applicant states that the K670 mask was publicised on the applicant’s website, [www.phantom-trainingmask.com](http://www.phantom-trainingmask.com), from January 2016, in respect of which it attaches website prints.<sup>1</sup> The applicant claims that the contested design differs from the Phantom mask only in immaterial particulars. Images of the K670 mask are provided as follows:<sup>2</sup>



4. Further, the applicant claims that the contested design shares the same overall impression as the applicant’s two Community design registrations, 003165265-0001 (“the ’01 design”) and 003165265-0002 (“the ’02 design”), the representations of which are in the appendix to this decision. These design registrations were filed and registered on 1 June 2016.

5. The applicant therefore claims that the contested design should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the ground that the contested design did not fulfil the requirements of s. 1B.

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<sup>1</sup> The statement of truth on the form DF19A is not signed by an individual. The attachments are, therefore, not evidence. For reasons which will become apparent, this matters not.

<sup>2</sup> Statement of case, §10.

6. The proprietor filed a counterstatement denying the grounds for invalidation. It claims that the designs are not identical and the differences not immaterial. It does not dispute the applicant's claim that it advertised the K670 mask prior to 5 April 2017 or the filing dates of the earlier registrations but it highlights a number of differences between the designs which, it says, result in the contested design having a different overall impression. In particular, the proprietor claims that the overall impression of the contested design is sleek, efficient and smooth, whilst the earlier designs have an angular and visually aggressive shape. Further, the proprietor claims that the shape and strap of the mask are dictated by technical function and that there is limited design freedom for these elements.

7. The applicant has been represented throughout by Appleyard Lees IP LLP and the proprietor by Pinsent Masons LLP. The applicant filed submissions with its evidence, which I will bear in mind. Neither party requested to be heard or filed submissions in lieu of a hearing.

8. The relevant date for the assessment is the date of application of the contested design, namely 5 April 2017.

## **Evidence**

### Applicant's evidence

9. This consists of two witness statements of Robert William Cumming, each with a single exhibit. Mr Cumming is a partner at the applicant's firm of representatives.

10. Mr Cumming provides "a selection" of images taken from a Google search performed on 3 and 4 June 2018. The search was for "training masks" and the images provided by Mr Cumming are shown below:<sup>3</sup>

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<sup>3</sup> Cummings 1, Annex 1.



11. Mr Cumming also provides a print of a post from the proprietor's *Twitter* profile, dated 5 December 2015. The following image is shown:



### The proprietor's evidence

12. This was filed by Iain Connor of Pinsent Masons LLP with the proprietor's counterstatement.<sup>4</sup>

<sup>4</sup> Rule 21(1) of the Registered Designs Rules permits the filing of evidence by way of statement of case.

13. Mr Connor provides copies of the design registration and side-by-side images of the contested and earlier designs.<sup>5</sup> I do not need to reproduce them here.

14. Mr Connor also exhibits two pages from the phantom-trainingmask.com website.<sup>6</sup> The first is taken from the WayBack Machine archive and is dated 19 May 2016, the second is dated April 2018. They describe the mask as “ergonomically optimized to perfectly fit the shape of your face” and the sleeve as “ergonomically shaped, leaves the mask firmly attached to your face and prevents it from slipping”. Various sports and types of training (from “fitness” to ironman) for which its use might be appropriate are listed.

15. There are, in addition, samples of a “Gorge ultimate training mask” and a “Phantom Athletics training mask”. These are not filed under cover of a witness statement but I note that the proprietor has not disputed that these samples are representative of the designs at issue.

## **Decision**

16. Section 1B of the Act (so far as it is relevant) reads:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

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<sup>5</sup> Annexes A and B.

<sup>6</sup> Annex C.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

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

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

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

(6) A disclosure falls within this subsection if-

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

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

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

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

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



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

(8) [...]”

17. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*.<sup>7</sup> The most relevant parts are reproduced below:

*“The informed user*

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

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

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

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

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<sup>7</sup> [2012] EWHC 1882 (Pat)

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

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

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

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

[...]

#### *Design freedom*

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

#### *Effect of differences between the registered design and the design corpus*

[...]

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

*The correct approach, overall*

[...]

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes

constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

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

18. I should also take into account the judgment in *Doceram GmbH v CeramTec GmbH*, in which the Court of Justice of the European Union held that:

“Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.

Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective

circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an ‘objective observer’”.<sup>8</sup>

19. Given that functionality form part of the basis of the proprietor’s defence, it is important to determine whether (or to what extent) the relevant features of appearance of a product are dictated by its technical function. Having done so, I must factor that into my assessment of the overall impression created by the designs on an informed user of the products at issue.

20. In determining whether technical function is the only factor which determined the features of a particular design, national courts and tribunals must take account of “all the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence”.<sup>9</sup> Accordingly, although the existence of alternative designs for the product does not preclude a finding that the features of a design are dictated by function (and therefore not protectable), the existence of alternative designs may shed some light on whether aspects of appearance play some role in the design.

### My approach

21. The ’01 design was registered on 1 June 2016. It was made publicly available on the EUIPO version of journal 2016/137. The proprietor has not denied that the design was disclosed. The design was clearly made available before the relevant date and may be relied upon as prior art. According to the applicant, the ’01 design is identical to the K670 mask in all respects save the colourways and the absence of a logo. These two factors mean that this registered design represents the applicant’s best case, as its other designs are less similar to the contested design and unlikely to succeed if the

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<sup>8</sup> Case C-395/16

<sup>9</sup> *Doceram*, paragraph 37.

application based upon the '01 design fails. I will, therefore, begin by considering the position in respect of the '01 design.

What does the contested design consist of?

22. The contested design was described on the application form as an “Altitude training and Fitness Mask”. The front and side views are consistent with that description but the fourth and fifth views appear to extend the claim to the packaging of the product. The Act provides the following definitions:

“(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 or materials of the product or its ornamentation.

(3) In this Act—

“complex product” means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and

“product” means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type- faces and parts intended to be assembled into a complex product”.

23. The box is clearly not a replaceable component of the product, whether the product is perceived as the mask alone or the mask and its packaging. In certain cases, such as where the container is specifically adapted for storing multiple items and therefore continues to play a part in the functionality and appearance of the product as a whole, it may be appropriate to regard the container for the goods as part of the product. I am doubtful that the packaging and mask as depicted in the design can be regarded as a “unitary object”, to borrow a term from the case law of the General Court.<sup>10</sup>

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<sup>10</sup> *Ball Beverage Packaging Europe Ltd v EUIPO*, Case T-9/15.

24. However, the applicant accepts that the packaging is part of the design, consistent with the established principle that everything shown in the representations of a registered design is, unless disclaimed or shown in dotted lines, to be treated as part of the protected design. I proceed on that basis.

#### Informed user

25. The informed user is a user of fitness training masks. Although the registration includes “altitude” training masks, the parties have not submitted that the informed user should be restricted to those who have a specific need to train at altitude, nor can I see a reason why that would be so, particularly in light of the evidence, which suggests that the user may be anyone interested in improving their fitness. As is apparent from the above case law, the informed user is particularly observant and will pay a relatively high degree of attention but will not observe minimal differences in detail.

#### Design corpus

26. The evidence filed by Mr Cumming of the design corpus beyond the prior art is not dated before the relevant date. Moreover, Mr Cumming indicates that the examples provided are his selection from results of the search he carried out. There is thus no way for me to gauge the extent to which the images in evidence are a fair representation of the search return or the design corpus. Therefore, there is no reliable evidence to show what the design corpus was at the relevant date.

#### Features of the design dictated by function

27. The proprietor claims that the shape of the mask relied upon by the applicant is dictated by the anatomy of the human face and that any mask must fit tightly to the face without obstructing the wearer’s vision. It also claims that the strap must be designed to wrap around the wearer’s head, ensuring that it is firmly fixed whilst allowing for anatomical features such as the ears. The applicant claims that there is a large degree of design freedom.

28. I accept that, once a decision has been made to design a mask only covering the nose and mouth, the proportions of the height and width of the mask are dictated by the shape of the human face. The decision to extend the mask around the back of the head is obviously a means of securing the mask to the face and achieving a tight fit. The presence of apertures for air to be inhaled and exhaled are driven by the mask's function of restricting airflow whilst allowing the wearer to breathe in and out. Holes in the sides of the strap are there to accommodate the ears (which would otherwise be compressed against the skull), which also decide their location. For a mask whose airflow can be regulated and altered by the user, the presence of a device to effect that function will be required. I accept that all of these features, including the location of the ear holes, are dictated by the function of the mask.

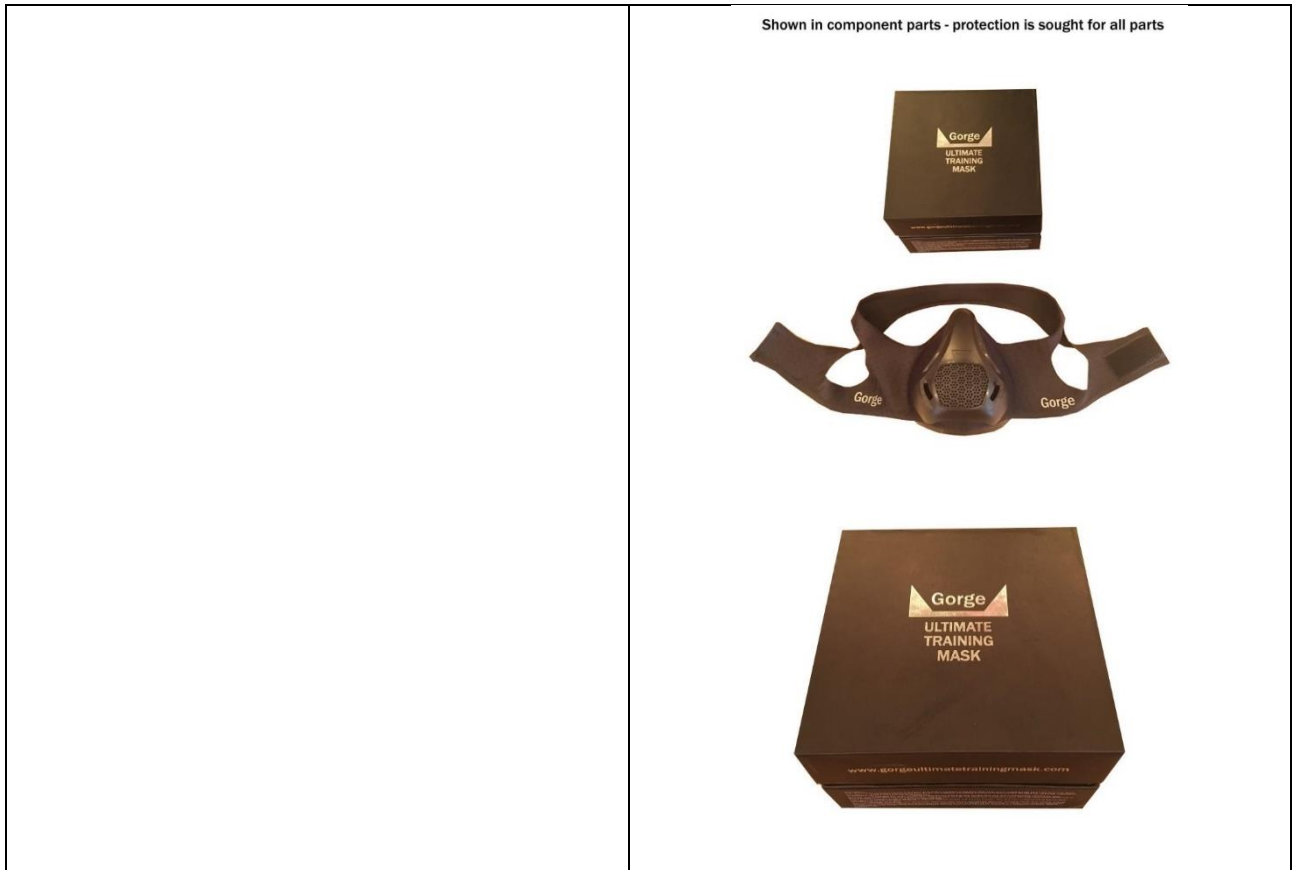
29. However, there are, in my view, design choices in how these features have been arranged and configured. The proprietor identified the number of apertures at the sides of the mask as being a design choice. I accept that submission. There is also some design freedom in the precise position and shape of those apertures. The design and size of the grille on the front of the mask offers some design freedom, whilst the shape, if not the location, of the ear holes and the width of the head strap are matters of choice. The presence of other holes in the strap (such as for the cheeks) may have the function of keeping the face cool but their shape offers some design choice. The shape and position of the devices for regulating air intake also offer design freedom, though their number is dictated by whether the valves are operated as one or independently. Accordingly, I consider that there is a fairly low degree of design freedom in the shape and configuration of the type of mask shown in the contested design.

### Comparison of designs

30. The designs to be compared are:



The '01 design	Contested design
 <p>The '01 design is shown through four line drawings. The top drawing is a front view of a helmet with a large, rounded shell and a mesh-covered chin bar. The second drawing is a side profile view, showing the helmet's aerodynamic shape and the placement of the chin bar. The third drawing is another side profile view, possibly from a different angle, highlighting the helmet's contours. The bottom drawing is a top-down view of the helmet, showing the arrangement of the shell and the chin bar.</p>	 <p>The contested design is shown through three photographs. The top photograph is a front view of a helmet with a dark, textured shell and a mesh-covered chin bar. The middle photograph is a side profile view of the helmet, showing its shape and the 'Gorge' brand name printed on the side. The bottom photograph is another side profile view, showing the helmet from a different angle and also featuring the 'Gorge' brand name.</p>



31. Both masks comprise a roughly teardrop shape mask which covers the nose and mouth. Both have a strap which appears to fit between the front and rear portions of the face mask. The strap of both has holes for the ears and is designed to fix around the top and bottom of the head, leaving the crown of the head exposed. Both have apertures at the side of the nose and a grille over the mouth area.

32. However, there are a number of elements which are different. These are:

- (i) Viewed from the front, the contested design has a curved outline, tapering gently out from the nose to the wider part around the mouth. The '01 design is more angular and appears narrower through the nose part, flaring out sharply over the mouth, particularly from the front perspective;
- (ii) The contested design has two resistance levers, one at each side of the mouth grille. The '01 design has one lever, positioned below the mouth grille;
- (iii) The contested design has one aperture at each side of the nose. Each aperture is broadly triangular in shape, with the top half widening at a very shallow angle and the bottom half widening more obviously as it curves backwards towards

the ears. The aperture extends about two thirds of the height of the face panel, finishing just below the top of the grille. The '01 design has three discrete apertures at each side, all of which have a chamfered edge. The top and bottom apertures are quadrilaterals; the central one is a sloping triangle shape. The middle aperture is the longest, whilst the other two occupy a similar portion of the height of the mask. The middle aperture ends just below the top of the grille; the bottom aperture ends just above the base of the grille;

- (iv) The grille of the contested design comprises circular holes, which are arranged as groups of seven in a hexagonal formation bordered by a raised edge. The effect is of a dotted honeycomb. The '01 design also has circular holes. Six small holes are arranged around a larger, solid circle. Although they form hexagons, the larger, solid circles are more prominent and the overall effect is of the larger circles arranged in lines;
- (v) The contested design has a smooth finish from the bridge of the nose to the grille, only interrupted by a logo. The '01 design, in addition to a logo, has a ridge, which curves over the bridge of the nose and extends down the sides of the mask and around the grille.

33. In addition to the above differences, the contested design has the word “Gorge” stamped on the front of the mask, inside an inverted trapezium, above the grille. “Gorge” is also present in contrasting colour on each side of the strap. The '01 design has no visible branding. However, the branding on the front of the mask is quite faint, whilst the branding on the straps is not visible from the front perspective.<sup>11</sup> I also keep in mind that, whilst the branding is there to be noticed, it is unlikely that the branding of fitness masks will have a disproportionate effect on the informed user compared to the product itself (unlike, for example, fashion items). The user of fitness masks will pay more attention to the design of the mask than to its branding.

34. The contested design also includes, as I indicated above, a representation of its packaging. The proportions of width to depth of the top of the packaging appear to be very similar, i.e. if the box is not a square it is very nearly so. Only a top perspective view of the packaging is provided, so it is difficult to determine the height of the box.

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<sup>11</sup> See the image at paragraph 1, above.

That itself suggests that the packaging is not an important part of the design. The box has some surface decoration, in contrasting colour, the most prominent of which is the word “Gorge” presented in the centre of a device of two triangles connected by a straight line. These elements will make some impact on the informed user. The words “ULTIMATE TRAINING MASK” are also visible but I doubt that they will make much of a contribution to the overall impression of the design, as they simply describe the product. In addition, [www.gorgeultimatetrainingmask.com](http://www.gorgeultimatetrainingmask.com) is visible on the front side of the box; it is likely to be perceived as the site where the mask can be obtained and will have a limited impact. Overall, although the packaging is part of the design and will make an impact on the user, the mask itself has the greater impact.

35. I think that noticing the chamfered edges of the apertures in the '01 design may be bordering on minute scrutiny, which goes too far. However, the other differences outlined at (i) to (v), above, are significant and would be noticed by an informed user. In terms of being new, although this is not limited to identical designs but includes within its scope designs which differ in only immaterial details. It is self-evident that the designs shown above are not identical. Nor, however, are the differences apparent in the above representations immaterial differences. Thus, the registered design is new compared to the '01 design.

36. Turning to individual character, the more rounded shape of the contested design and the angularity of the '01 design are aesthetic choices to be made when choosing a product. The pattern of the grille and the position, shape and number of apertures are all important contributions to the design. Taking into account the freedom of the designer of the contested design, I find that the respective designs will create a different overall impression on the informed user. I should say that the inclusion of packaging in the contested design has had no significant impact on that conclusion.

### **Final remarks**

37. The other designs relied upon by the applicant are less similar than the design considered above. They therefore offer no better a case for the applicant and it is not necessary to consider them.

## **Conclusion**

38. The application for invalidity has failed.

## **Costs**

39. The proprietor has been successful and is entitled to an award of costs. The evidence filed by the proprietor with its counterstatement and by the applicant during the evidence rounds amounted to only a handful of pages, and the award is reduced accordingly. I award costs to the proprietor as follows:

Considering the statement of case and filing a counterstatement:	£300
Filing evidence and considering the other party's evidence and submissions:	£300
Total:	£600

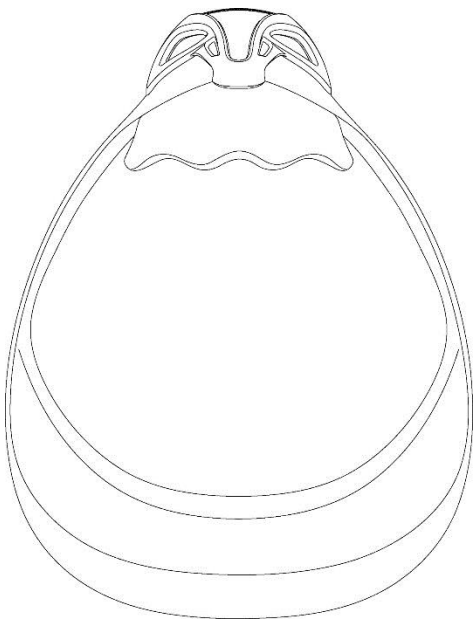
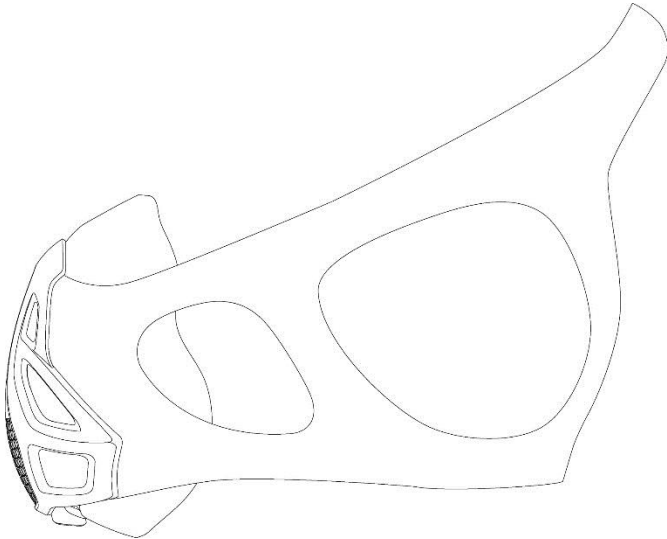
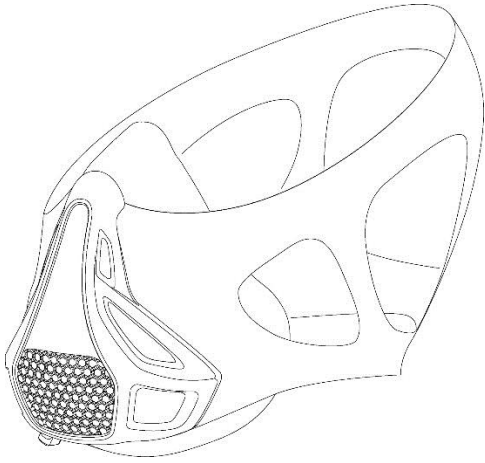
40. I order K670 GmbH to pay Gorge Ltd the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

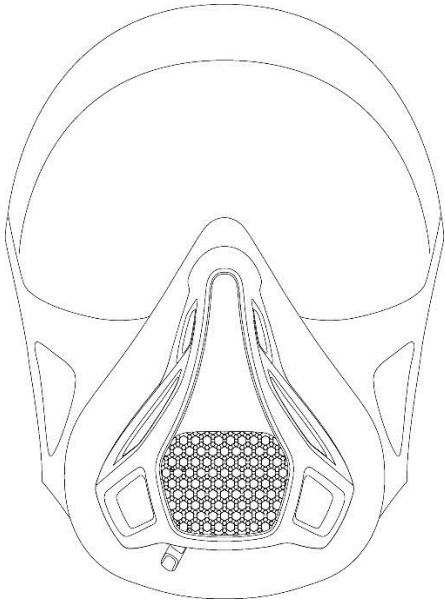
**Dated this 18th day of February 2019**

**Heather Harrison  
For the Registrar**

**Appendix**

**RCD 003165265-0001**





RCD 0031565265-0002

