

**O/378/19**

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

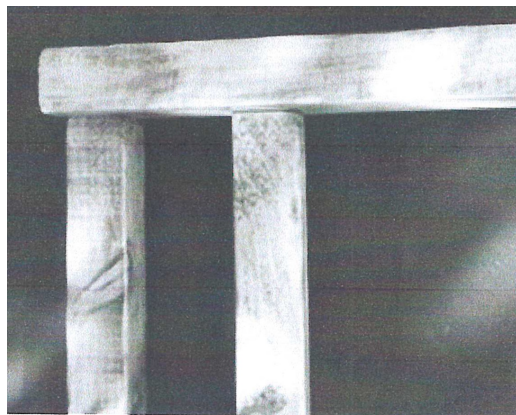
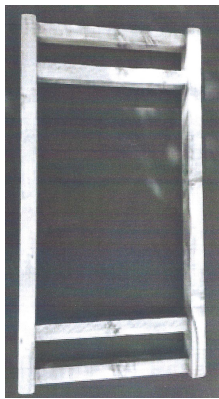
IN THE MATTER OF REGISTERED DESIGN № 6000701  
OWNED BY JAMES POLLOCK

AND

APPLICATION № 35/17 BY KEITH BANKS  
TO INVALIDATE THE REGISTERED DESIGN

## **Introduction**

1. This decision concerns an application to invalidate the registration of a design. It will refer to two registered designs — the ‘earlier design’ belonging to the claimant, and the ‘later design’ belonging to the defendant. The registration dates of the two registered designs are only one week apart.
2. The registered design that is the subject of these proceedings was filed by Mr James Pollock on 19<sup>th</sup> September 2016. The design is for a mirror frame, represented as follows:-



3. Mr Pollock says that he looked through the database of registered designs before submitting his application, to ensure that a design such as this did not already exist. After receiving his certificate of registration, Mr Pollock advertised mirrors made to his design on the auction site eBay. Shortly afterwards, Mr Pollock says that Mr Keith Banks & Ms Elaine Mckenzie advertised their ‘tri-section mirror’ on the same auction site.
4. Mr Banks claims that he has an earlier registration for the same design (№ 6000496) and he has applied to invalidate Mr Pollock’s design registration. Mr Banks’ claim for invalidation relies upon section 11ZA(1A) - ie. an earlier filed design which was made available to the public on or after the application date of the later design (the “relevant date” in these proceedings). According to the official file, Mr Banks’ design (the earlier design) was acknowledged by the Office in a letter dated 28<sup>th</sup> September 2016, and his registration certificate was sent out by post on 30<sup>th</sup> September 2016. It appears from the official file that Mr Bank’s design registration was published by the Office on

30<sup>th</sup> September 2016 — which means that it was made available to the public after the relevant date.<sup>1</sup>

5. Mr Pollock has filed a counter statement, and a witness statement explaining his actions before and after he applied to register his design. Mr Banks has also provided a witness statement identifying his earlier registration, and stating that it was available to the public over 18 months before the registration date of the later design.

6. Mr Banks explains that section 1B of the Registered Designs Act 1949 permits a design to be registered up to 12 months after it was made available to the public. However, this ‘grace period’ is not relevant to the validity of the later registration because subsection (6) of section 1B restricts this provision to disclosures made by the designer or any successor in title of his. So in any event, Mr Pollock would not have been able to benefit from the 12 month grace period which began when Mr Banks’ mirrors were made available to the public.

7. Neither side has asked to be heard before I make a decision, so I have made this decision on the basis of the evidence and other documents on the official file. I did hold a brief CMC via telephone on 22<sup>nd</sup> March 2019, but this was to check that the parties understood the significance of the evidence that Mr Banks’ mirrors were available to the public approximately 18 months before either design was registered.

### **The Law**

8. Section 11ZA(1A) of the Act says:

(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—

(a) Has been made available to the public on or after the relevant date; but

(b) Is protected as from a date prior to the relevant date-

(i) By virtue of registration under this Act or the Community Design Regulation or an application for such registration, or

(ii) By virtue of an international registration (within the meaning of Articles 106a to 106f of that Regulation) designating the Community.

9. There is no doubt that Mr Bank’s design was protected from a date prior to the relevant date; it was protected from a date one week prior to the relevant date. As stated earlier, I am satisfied that it was made available to the public on or after the relevant date.

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<sup>1</sup> Although section 11ZA does not provide a definition of “made available to the public”, the definition given in section 1B(5)(a) clearly indicates that it should be taken to include the publication that takes place following registration of the design.

10. The relevant case-law was conveniently set out by HHJ Birss (as he then was) in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>2</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);
  - 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).”

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<sup>2</sup> *Samsung Electronics (UK) Ltd v Apple Inc.* [2012] EWHC 1882 (Pat)

*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.”

### The earlier design

11. The earlier design registration that Mr Banks relies upon is № 6000496 for a mirror frame as shown below:



12. This registration is dated 12<sup>th</sup> September 2016, one week earlier than the registration date of Mr Pollock's design. Mr Banks says in his statement of grounds that his design was available to the public on the relevant date (19<sup>th</sup> September 2016), as required by Section 11ZA(1A)(a). Mr Pollock confirms this in his witness statement at paragraph 6:

*“When I was informed that K Banks was disputing my design and attempting to invalidate my design certificate I withdrew the design 6000701 from the auction site to await a satisfactory conclusion. **K Banks has advertised his design 6000496 throughout the period.**”*  
(My emphasis)

13. Mr Pollock also says in his witness statement that after he received his design registration certificate, he observed similar mirror designs (ie. three mirrors within a rectangular frame) in a historical building in Scotland, Laura Ashley Balmoral collection and another two sellers on eBay. Exhibit JP3 to his witness statement shows three images of mirror frames, each with three mirrors in a rectangular frame. However, the images are not dated, and Mr Pollock's evidence in relation to them seems to put them all after the relevant date. That means that I cannot take account of them when considering the design corpus.

14. Mr Banks has provided the following photograph of one of his mirror frames that he says was made according to his design (the earlier design).



15. Mr Pollock has also provided a photograph of one of his mirror frames (the later design) - see right.

### **Landscape or portrait**

16. It is not clear to me whether the orientation of the mirror frames is an issue between the parties. The main illustration on the registration certificate of Mr Pollock's design<sup>3</sup> shows the mirror frame in portrait orientation (ie. long side vertical), but a second illustration shows it in landscape orientation (ie. long side horizontal). In any event, I do not believe that



most people who purchase or hang framed mirrors would consider that the orientation of the frame (when hung on a wall) is a feature of this particular design — although I accept that frame orientation may be a feature of the design in other cases.

17. The aspect ratio of the mirror frame — ie. the ratio between the horizontal and vertical dimensions of the frame — is a significant feature in this case. The main illustration on the registration certificate of Mr Banks' design<sup>4</sup> shows a long narrow frame having a horizontal width that is approximately four times that of the vertical height — ie. an aspect ratio of 4. But the photograph supplied by Mr Banks of one of the mirrors that he has sold (see

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<sup>3</sup> See paragraph 4 above.

<sup>4</sup> See paragraph 12 above.

paragraph 15 above) appears to have an aspect ratio less than 2. I did not need to use a measuring rule to notice the difference between the aspect ratio of these two rectangles, although I did use one to calculate the aspect ratios.

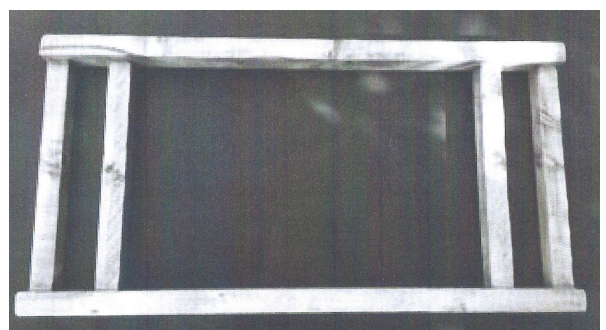
18. A small variation in the aspect ratio of a rectangular frame might not be significant, but when it is as noticeable as it is here, I cannot overlook it. Thus although both Mr Banks and Mr Pollock appear to agree that the photograph of Mr Banks' mirror corresponds to his design registration, I find as a matter of fact that it does not.

19. The comparison I need to make is between the two registered designs, because the claim before me is made under Section 11ZA(1A) — so the issue is whether the later design registration should be declared invalid (not new or having no individual character) having regard to the earlier design registration. Neither can I have regard to the photograph of Mr Banks' mirror because it does not match his design registration.

20. For the purposes of comparison, and having regard to my decision in relation to portrait and landscape orientation, I have rotated the main illustration of the later design. Therefore the comparison is between:—



The earlier design



The later design

21. There are clearly some similarities between these two designs. Both are rectangular frames in three sections, with a central section that is significantly larger than the outer two sections. There are however, some significant differences between the two designs. The three that stand out most to me are:-

- i. the aspect ratio. The earlier design has a much larger aspect ratio; ie. it is much narrower than the later design. <sup>5</sup>

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<sup>5</sup> The aspect ratio of Mr Banks' mirrors (as shown in the photograph he has provided) is closer to the later design, but I need say no more about this because no claim relating to section 1B has been made.

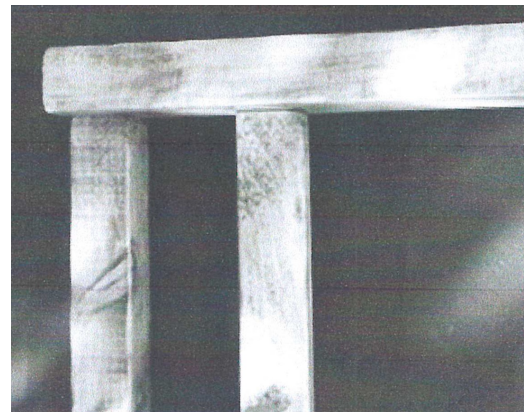


- ii. the horizontal frame members of the later design extend horizontally outwards beyond the outer vertical frame members, whereas the corresponding frame members of the earlier design are aligned.
- iii. the vertical frame members of the later design are not as deep as the horizontal frame members. I.e. they do not stand out from the wall as much as the horizontal frame members.

22. I have considered whether these differences are insignificant, particularly in light of the guidance given by Birss J in *Samsung v Apple* - eg. are they 'minimal differences'? Or are they differences that the informed user, being 'particularly observant' would notice? In this regard, I note that each of the registrations also shows a second illustration of the design that zooms in on the ends of the respective mirror frames, and appears to draw attention to the latter two differences that I have picked out in the paragraph above. I have therefore also made a direct comparison of the two designs with reference to these two 'detail' illustrations from the respective registrations:—



The earlier design



The later design

23. From this comparison it is clear that these designs are not identical, and the differences between them are far from immaterial. As such, the later design must be new in comparison to the earlier design. The question then is whether the later design creates a different overall impression.

24. As HHJ Birss expressed it, 'attention to detail matters', and I believe this is particularly the case where the detail in question is deliberately emphasised by close-up illustrations in

the two design registrations. I do not rely purely on the fact that the parties have emphasised this aspect in the design drawings, but I also consider that this is something that the informed user would notice. This then would not be the kind of 'minute scrutiny' which HHJ Birss specifically disapproved. On this basis, I have concluded that there are differences of detail between the two designs that cannot be characterised as 'minimal'. The designs are different, and the overall impressions they create are sufficiently different that the informed user would regard the later design as having individual character compared to the earlier design.

### **Summary**

25. On the basis of my direct comparison of these two designs, and particularly having regard to my comparison of the close-up illustrations of both designs, I do not consider that the later design has been shown to be 'not new' or lacking in 'individual character' having regard to the earlier registered design.

26. The application for invalidation fails.

### **Costs**

27. Neither party has requested costs, and in any event the costs incurred by the successful party in this case must be *de minimis*. I therefore make no order as to costs.

**Dated this 10<sup>th</sup> Day of July 2019**

**Stephen Probert  
For the Registrar**