

O-222-20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER of Registered Design No. 4009288 in the name of
Peter S. Magee**

and

**APPLICATION TO INVALIDATE (No. 27/18) by BVG Group
Limited**

DECISION

1. This is an appeal from decision O-713-19 dated 22 November 2019 by the Hearing Officer (Mr Mark King) acting for the Registrar of Designs. He upheld an application by BVG Group Ltd to invalidate registered design No. 4009288. The registered proprietor Mr Peter S Magee appeals against that decision.
2. The proprietor is represented on this appeal by McDaniel & Co, solicitors, and the respondent by Mr Richard Halstead, a patent and trade mark attorney, of Richard R. Halstead & Co Ltd. The parties were content for this appeal to be decided on the papers without a hearing, as happened at first instance.
3. The registered design is dated 25 October 2008 and is described as being for “*a display unit for potted plants*”. The design representations, including wording, are as follows:-



Display unit folded flat
No claim is made for the colour or colours shown.



Display unit folding flat
No claim is made for the colour or colours shown



Front view of display unit
No claim is made for the colour or colours shown



Side view of display unit (Wall mounted)
No claim is made for the colour or colours shown



Side view of display unit
No claim is made for the colour or colours shown

1. The appeal

4. The validity of the design was challenged on two grounds. First, that it did not satisfy section 1B of the Registered Designs Act 1949 as amended (“the Act”), in that it does not have individual character compared to other designs which were made available to the public before the filing date. Secondly, that it does not satisfy section 1C(1) of the Act in that its features are solely dictated by the product’s technical function.
5. On the first ground, the Hearing Officer considered four items of prior art, all of which differed in varying degrees from the registered design. He concluded that none of the items of prior art were sufficiently close to deprive the registered design of individual character. There is no cross-appeal against this finding and I do not have to consider it further,

beyond noting that in the course of dealing with this aspect of the case the Hearing Officer considered the various aspects of the registered design in considerable detail.

6. On the second ground, the Hearing Officer concluded that the design is purely functional and that therefore the claim to invalidate it, as contrary to section 1C(1), succeeded.

2. The approach in law: “dictated by technical function”

7. Section 1C’s heading and its first subsection are as follows:-

“1C Designs dictated by their technical function.

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

8. The phrase “*dictated solely by function*” has given rise twice over to what is effectively the same controversy over its correct interpretation. Section 1(3) of the Registered Designs Act 1949 as originally enacted provided that:-

“1. ... (3) In this Act, the expression ‘design’ means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or *features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.*”
[emphasis added]

9. The words “*dictated solely by the function*” contain an ambiguity. If a wholly functional article can be made in a variety of shapes, can it be said that no specific choice of shape is “*dictated*” by the article's function, and therefore that no such specific choice of shape is excluded from

protection because other functional alternatives are available? On this interpretation, the exclusion from design protection would be very narrow, only applying when there is only one shape or configuration which could achieve the function of the article. Many designs for functional articles were registered on the basis of such an interpretation.

10. However, in *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, the House of Lords consider the registration of a design for an electrical spade connector. They held that "*dictated solely by function*" meant "*attributable to or caused or prompted by function*": where a shape is adopted by a designer upon the sole requirement of functional ends, i.e. to make the article work and not to appeal to the eye, then it is excluded from protection. Thus, in relation to the electrical terminals in that case, the fact "*that other shapes of terminals might also be dictated by the function to be performed by them will not alter the fact that the shape of Amp's terminals was dictated only by functional considerations . . .*"

11. The controversy having been settled under the UK's 1949 Act by that decision, it was effectively reopened again following the European harmonisation of registered designs law pursuant to the Designs Directive 98/71/EC. Article 7(1) of the Directive provides that:

"A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function."

12. This substantive provision is further explained by Recital (14) in the Directive's preamble:-

"Whereas technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; whereas it is understood that this does not entail that a

design must have an aesthetic quality; . . . whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection."

13. Article 7(1) of the Directive was transposed into UK law by the insertion of section 1C(1) (quoted above) into the Registered Designs Act 1949, as part of the extensive changes to that Act which were made to make UK law conform with the harmonising provisions of the Directive. When the United Kingdom was a Member State of the European Union, our courts and tribunals were under an obligation if possible to interpret provisions of national law passed to implement a Directive in conformity with the relevant provisions of the Directive as interpreted in accordance with EU law. Despite the UK having left the European Union on 31 January of this year, this remains an obligation during the current transition period under the European Union (Withdrawal Agreement) Act 2020.
14. The Hearing Officer in his decision quoted extensively from the judgment of Arnold J (as he then was) in *Dyson Ltd v. Vax Ltd* [2010] FSR 39. In that judgment, Arnold J declined to follow the approach of the Court of Appeal of England and Wales in *Landor & Hawa Intl Ltd v Azure Ltd* [2006] EWCA Civ 1285; [2007] FSR 9. They thought that the phrase "*which are dictated solely by its technical function*" in the Directive and Act (as amended to give effect to the Directive) was to be interpreted differently from the very similar phrase in the previous UK national law as interpreted by the House of Lords in *Amp v Utilux*, and only operated to exclude design protection where the technical function dictated that that shape and no other shape might be used.
15. Arnold J held that that aspect of the Court of Appeal's judgment in

Landor & Hawa was obiter, and preferred to follow the approach of the OHIM Third Board of Appeal in Case R 690/2007-3 *Lindner Recyclingtech GmbH v Franssons Verkstader AB* [2010] ECDR 1. They interpreted Article 8(1) of the Community Designs Regulation (EC) No 6/2002, which corresponds to and is effectively identical to Art.7(1) of the Directive.

16. The Board's decision in *Lindner* contains an extensive survey of the pre-harmonised national laws relating to registered design protection and technical function, considers the pre-legislative and legislative history of the provisions of the Directive and the Regulation, and addresses the question of interpretation both on the basis of their wording and from a purposive or 'teleological' point of view. I will not repeat the lengthy passage from *Lindner* which the Hearing Officer has set out in his decision (within his quotation from Arnold J's judgment in *Dyson*), except for the Board's concluding paragraph 36:

"36 It follows from the above that art.8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen."

17. The correctness of the approach adopted by the Third Board of Appeal in the first sentence of paragraph 36 of *Lindner* has been put beyond doubt by the judgment of the Court of Justice in Case C-395/16 *DOCERAM GmbH v CeramTec GmbH* (Second Chamber, 8 March 2018). In

its answer to the first question from the referring court (the Oberlandesgericht Düsseldorf), the Court rejected the so-called “multiplicity of forms” argument: that the existence of other possible forms which could achieve the technical function prevented the feature(s) being “dictated” by the function. Instead it ruled in its formal answer to Question 1 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”*.

18. This formulation of the test raises a question of whether there is room for consideration of the designer’s subjective thought process or reasons, or whether the test should be based only on objective consideration of the design itself. What happens if, for example, the product looks as if nothing but its technical function played a part in its design, but the designer gives evidence that in fact he chose one particular possible form over other possibilities because to him it had a superior appearance?
19. The Board of Appeal in *Lindner*, as appears from the second and third sentences of paragraph 36 quoted above, were of the view that the question of whether there is a non-functional purpose behind the design or any aspect(s) of it should be considered objectively and without reference to the subjective thought processes of the designer. In *DOCERAM*, the second question of the national court asked whether *“in order to determine whether the relevant features of appearance of a product are exclusively dictated by its technical function, that finding must be based on the perception of the 'objective observer'.”* The Court of Justice’s reasoning and answer to that second question were as follows:-

“35 Furthermore, unlike Article 6(1) and Article 10(1) of Regulation No 6/2002, which expressly provide that, for the purpose of their application, the assessment must be based on the overall impression produced by a design on an 'informed user', Article 8(1) thereof does not require the perception of an 'objective observer' to be taken into account for the purposes of its application.

36 In that connection, having regard to the objective pursued by Regulation No 6/2002, which, as is clear from paragraph 28 of the present judgment, consists, in particular, in creating a Community design directly applicable and protected in all the Member States, it is for the national court, in order to determine whether the relevant features of appearance of a product are covered by Article 8(1) thereof, to take account of all the objective circumstances relevant to each individual case.

37 As the Advocate General stated in essence, in points 66 and 67 of his Opinion, such an assessment must be made, in particular, having regard to the design at issue, 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.

38 Having regard to the foregoing considerations, the answer to the second question is that 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'.”

20. Paragraph 37 above refers to paragraphs 66 and 67 of the Opinion of Advocate General Saugmandsgaard Øe. In order to gain a fuller understand of this aspect of the Court’s ruling, it is helpful to set out those paragraphs from the Opinion (which I have emboldened) and their surrounding context:

“62. The *second problem* raised before the Court is *identifying the elements which must be included in the examination* to be conducted, in my view both objectively and on a case-by-case basis,

by the court hearing a dispute based on Article 8(1) of Regulation No 6/2002. [emphasis in original]

63. I concur with the majority view expressed in the observations submitted to the Court, according to which it is for the national court hearing the dispute to assess objectively and in the light of all the specific circumstances of each case whether different features of appearance of a product are based solely on considerations related to functionality.

64. In this regard, according to the Commission, the national court should take account of assessment criteria accepted by the Court in the field of trade marks on the basis of which it can be presumed that the shape is not of purely technical value, such as 'the perception ... by the average consumer[, (76)] ... the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question'. (77) The Commission maintains that the court hearing the case should also take into consideration the existence of alternative forms which also fulfil the technical function concerned, as such existence would, as a rule, show that the designer had freedom in developing the features of appearance of the product and that the appearance was not dictated solely by functional contingencies.

65. Similarly, DOCERAM also produces a non-exhaustive list of criteria which could be relevant, namely 'circumstances connected with the design process, advertising, use, etc.' CeramTec asserts that the point of view of the 'informed user', which it proposes — wrongly in my view (78) — be used as the objective assessment criterion, should be determined 'on the basis of an in-depth examination of all the circumstances of each case', (79) in particular 'the specific objective of the manufacturer at the time of design, advertising of the product which focuses on accentuating the design, any distinction or particular reputation of the design among the relevant public and the designer's intention on the creation of the product'. (80)

66. **I would point out in this respect that the assessment in question must be conducted by the court hearing the case, in my view, not only having regard to the design concerned itself, but also in the light of all the circumstances surrounding the choice of its features of appearance, bearing in mind the evidence provided by the parties, regardless of the subject or the nature of that evidence, (81) and bearing in mind any**

measures of inquiry ordered by that court.

67. It is not impossible that criteria which, in my view, cannot in themselves show that features of appearance of a product have been dictated solely by its technical function within the meaning of Article 8(1) of Regulation No 6/2002, such as the subjective intention of the designer or the existence of alternative forms, (82) may nevertheless be included in the body of specific evidence which courts must take into consideration in order to form their own opinion regarding the application of that provision.

68. There is no need, in my view, to make a list of the relevant criteria, even a non-exhaustive one, given that the EU legislature did not envisage recourse to this method and that it would seem that the Court did not consider this appropriate in respect of the assessment, including of the facts, which must, moreover, be conducted pursuant to Articles 4 to 6 of the regulation.

69. However, like the Greek Government, I think that it should be stressed that the court hearing the case will, if necessary, be able to conduct the required evaluation by seeking clarification from an independent expert appointed by it. I note in this regard that the national courts do not possess the sometimes highly technical competences necessary for that purpose and that they commonly order an expert report when faced with complex questions of this kind.

70. Consequently, I consider that the second question should be answered to the effect that, in order to assess whether different features of appearance of a product are based solely on considerations of technical functionality for the purposes of the application of Article 8(1) of Regulation No 6/2002, it is for the court hearing the case to carry out an objective assessment, not from the — theoretical — point of view of an ‘objective observer’, but bearing in mind — in specific terms — all the relevant circumstances of each case.”

21. Paragraph 67 of the Advocate General’s Opinion, cited by the Court at paragraph 37 of its judgment, suggests that the subjective intention of a designer may be relevant and a court should take into account evidence of that intention if proffered, but it will not be conclusive. A court would clearly be entitled, as a normal part of the court’s role of evaluating evidence, to reject self-serving retrospective evidence given by a designer

that non-technical considerations played a part in the design process, if for example such evidence is implausible in the light of the product design itself or in the light of surrounding circumstances or factors.

22. But it is not clear whether a court is entitled to go further and allow objective factors and circumstances to over-ride a finding on the evidence that there was a genuine (if rather surprising) taking into account of non-technical factors within the subjective design process. The Court's admonition in its formal answer to question 2 that the national court "*must take account of all the objective circumstances relevant to each individual case*" leaves much room for debate about that and other aspects of the test which the national court should apply.

3. The challenged part of the Hearing Officer's decision

23. As I have mentioned, the Hearing Officer directed himself in law first by citing and quoting extensively from Arnold J's judgment in *Dyson*. He went on to cite *DOCERAM* at his para 37, and quoted the two formal answers given by the Court of Justice to the national court's questions.
24. He then noted the applicant's contention that the design is "purely functional", and summarised the proprietor's contentions in response in para 39. In the first sentence, he said that the proprietor "*does not deny*" that the Registered Design has no ornamental features. This is not accurate, since the proprietor's counterstatement does in terms deny "*that the Registered Design has no ornamental features*", albeit at no point does it give any details as to what its ornamental features might be.

25. The second sentence of para 39 of the decision begins “[*The proprietor*] also argues ...”. In the light of this and in the wider context of the decision, in which the proprietor’s other arguments are set out, it seems to me that the first sentence contains a typographical error, rather than an error of understanding on the part of the Hearing Officer about the posture of the proprietor. In any event, this point is not raised in the Notice of Appeal.
26. The Hearing Officer went on to quote the key points of the proprietor’s arguments as set out in his counterstatement. The major thrust of those arguments was that the shape of the display unit of the registered design was not dictated by its technical function, because the unit could be designed in a variety of ways without hampering the functionality of the design. The proprietor went on to contend that: “*The display unit in question will be targeted towards the public and retail outlets. The units are used to display plants and the user of the goods will be less concerned about the function of the design and more concerned that it can present plants in an attractive way.*”
27. The Hearing Officer accepted evidence from the applicant about the way in which the design of the display unit enables it to unfold from a storage configuration with the frame collapsed and the shelves vertical, into a working configuration with the shelves flat and ready to take plant pots. His finding at para 40 on the basis of this evidence was that the display unit “*is made up of numerous individual elements all of which serve a technical purpose*”.
28. He then went on to consider whether, or to what extent, the relevant features of the appearance of a product are dictated by its technical

function. It is clear from his para 43 that the question he was addressing was whether “*technical function is the only factor which determined the features of a particular design.*” In addressing this question (the formulation of which is drawn from *DOCERAM*), he directed himself to take account of all the matters set out in paragraph 37 of the Judgment in *DOCERAM* which I have quoted above. He went on to say:

“43) ... 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.

44) Taking all of the above into account, all of the individual elements, as described by the applicant, serve a technical function. However, the question is the overall impression created by the design on an informed user of the products at issue. In my view, the design subsists in features of appearance of a product which are solely dictated by the product’s technical function. The proprietor has not provided any plausible argument against this. The design consists of three shelves, all above one another, with the lowest shelf protruding further out from the second highest shelf which also protrudes further to the top shelf. Overall the three shelves are angular which, to my mind, are used since either the top of the pot, or the plant, would be higher than the shelf above it. In other words, if the shelves were placed one above the other then this would significantly alter the height of the pots being placed upon them.”

4. The Appellant’s challenges to the decision

29. The two grounds of appeal are:-

“1.1. The Hearing Officer failed to consider various features of the appearance of the design. He failed to consider whether those features of the appearance of the design had a technical function, and failed to consider whether those features had an appearance that was solely dictated by their technical function.

1.2. Further, having conducted an analysis that led him to conclude that the features of the design that were examined had a technical function, the Hearing Officer failed to consider whether the

appearance of those features was solely dictated by their technical function.”

30. I will deal with the second ground (sub-para 1.2) first. The Hearing Officer first asked whether all the individual elements of the display unit served a technical purpose. He was entitled to and did accept the applicant’s uncontradicted evidence that this was the case. However it is clear from the decision that the Hearing Officer was fully aware that it was not sufficient to invalidate a design on this ground to show that the design or all its elements serve a technical purpose, if they serve some other purpose as well. In paragraph 43 he posed to himself the more stringent question of “*whether technical function is the only factor which determined the features of a particular design*” (my emphasis), and was mindful of the need to consider “*whether aspects of appearance play some role in the design*”.
31. This second ground of appeal has no substance at all and I dismiss it.
32. The first ground of appeal (in sub-para 1.1 above) is amplified by a detailed list of features of the design which the Appellant complains that the Hearing Officer failed to consider. The Respondent complains, in my view with justification, that none of these allegedly overlooked features was alluded to by the proprietor in the first instance proceedings, either in evidence (he filed none), or in submissions.
33. The proprietor was clearly on notice of the applicant’s case (and evidence) that none of the features of the registered design served a non-technical purpose. If his case was that certain specific features of the design did in fact serve a non-technical purpose as well as or instead of a technical purpose, in my view he should have identified those features

in the proceedings at first instance so that the Hearing Officer could have given specific consideration to them. Raising these points for the first time on appeal undermines the proper function of the appeal process which is to review the correctness of the first instance decision, not to re-hear the case de novo.

34. The Respondent makes the general point that the Hearing Officer considered many aspects of the design in considerable detail when dealing with the individual character ground, and therefore cannot be assumed to have overlooked the points now raised by the Appellant proprietor even if they are not specifically addressed in the fairly short part of his decision in which he deals with technical function.
35. It is not necessary for me to come to a conclusion on whether I should reject this ground of appeal for procedural reasons alone.
36. The proprietor contends that the user of the goods “*will be less concerned about the function of the design and more concerned that it can present plants in an attractive way.*” It is no doubt correct that a purpose of the product is to present plants in a attractive way, in the sense that the array of plants loaded on the unit will look attractive e.g. to customers browsing for plants in a garden centre. That factor would explain some of the key features of the design, such as that in its unfolded or working configuration the shelves are tiered rather than being vertically above one another, which allows the tops of the plants on the lower shelves to be taller than the shelf height and in front of part of the pots on the row above.

37. But I am concerned with whether or not the appearance of *the unit itself* was designed to be attractive. Presenting plants loaded onto it in an attractive way is part of the technical function of the unit, not an aspect of its own appearance.
38. With these considerations in mind, I shall briefly deal with the points raised in paragraph 2 of the Notice of Appeal:

Selection of dimensions in the unit's unfolded state (2.1): The shelf depth (2.1.1), the different vertical spacings of the shelves (2.1.2), and different horizontal protrusions of the shelves (2.1.3). These are all determined by the unit's function of displaying plants in a desired configuration, as indeed is the overall width of the unit (2.3).

Spacing and width of the shelves in the folded configuration (2.2): The Appellant relies on the fact that when the unit is folded, the shelves form a uniform striped pattern in which each shelf is of the same width and that width is the same as the spacing between each shelf. However, that this resulted from or was influenced by considerations of attractiveness of appearance is unlikely for two reasons relied on by the Respondent:. First, the gaps between the shelves in the unit's folded configuration reveal the rather unattractive cross bracing between the legs of the rear part of the A-frame and looking at the appearance of the folded view as a whole, there is no discernible indication of an attempt to make it look attractive. Secondly, the appearance of the unit in its non-working folded configuration is even less likely to be of interest to the user than in its unfolded working configuration.

Position and manner of attachment (with a butt joint) of the diagonal rear

bracing member (2.4): A diagonal bracing member is a normal technical means of preventing a rectangular structure from lozenging, and I see nothing attractive in the particular positioning of this item which forms part of the rear of the unit. The manner of its jointing is hardly even visible in the representations of the design.

Rounded tops of vertical members of frame (2.5): It is said that these rounded ends serve no functional purpose so must be aesthetic. But as pointed out by the Respondent, rounded ends are common on similar structures like wooden step ladders or unfolding deck chairs, and serve the functional purpose of preventing splinters when handled.

39. The Appellant raises the above points purely by way of submission and has not filed evidence to support the suggestion that any of these aspects of the design were influenced by non-functional considerations. This therefore relieves me in the present case from having to confront the potential difficulties arising from the rejection of the ‘objective observer’ test in *DOCERAM*. Those difficulties will no doubt rear their head in future cases.
40. Apart from considering each of the Appellant’s above points in isolation, it is important to consider these points in the context of looking at the design of the unit overall. There is nothing in these points which displaces the impression gained from looking at the design of the unit as a whole as shown in the representations, which is that, however useful or possibly ingenious it might be as a functional design, non-technical considerations played no part in its creation. I therefore uphold the Hearing Officer’s decision and dismiss the appeal.

5. Costs

41. The appeal having failed, the Respondent would normally be entitled to its scale costs. The Respondent contends that the proprietor failed to file evidence at first instance, and raised this list of detailed points for the first time on appeal after combing through the decision to identify design features which are not mentioned in it. The Respondent submits that the appeal lacks any merit, makes unsubstantiated allegations about the competence of the Hearing Officer and should be dismissed with an award of costs “*which reflects its unreasonably speculative nature.*”
42. Subject to considering any submissions from the Appellant, I am open to making an award of costs in favour of the Respondent which is not restricted to the normal scale but which compensates the Respondent for its reasonable costs actually incurred.
43. The Respondent should within 21 days of the date of this decision submit details of the costs it seeks. The Appellant may within 21 days thereafter lodge submissions regarding the principle of departing from the scale and regarding quantum. Should the current COVID-19 emergency cause difficulties in complying with these time limits I will be open to extending them. The costs order made by the Hearing Officer in any event comes into force and is payable 21 days from the date of this decision, is is not deferred by my continuing consideration of the costs of the appeal.

Martin Howe QC
Appointed Person (Designs Appeals)
9 April 2020