O-013-14

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO 4026255
IN THE NAME OF ALL POND SOLUTIONS LIMITED

AND

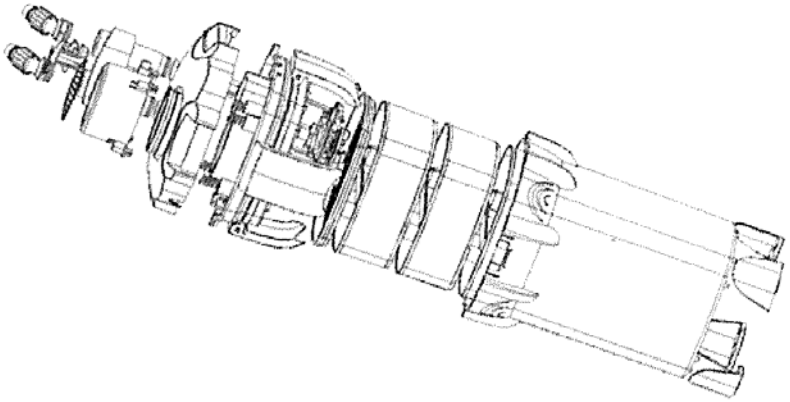
A REQUEST TO INVALIDATE (NO. 5/13)
BY GRAHAM TINKER

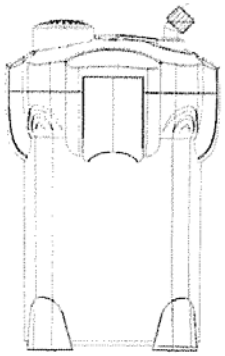
Background and pleadings

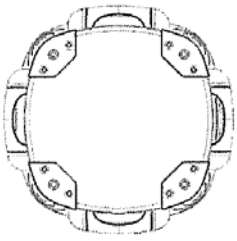
1. The registered design which is the subject of this dispute was filed by All Pond Solutions Limited ("the proprietor") on 7 September 2012. The design is described on the application form as an "external aquarium" and in correspondence with the Designs Registry as an "External Aquarium Canister Filter". The original application form contained both line drawings and a photograph of the design. Following discussions with the Designs Registry, the proprietor amended the application so that the line drawings and photographs were separated; removed all technical detailing from the line drawings; and included the following disclaimer underneath the photograph: "design shown in use for illustration purposes only". The amendments are shown below:

ILLUSTRATION SHEET **FORM DF2A PAGE 3 OF 4**

Here are the designs and images of our External Canister Filter model:







Protection is sought for shape and configuration only

Here are the designs and images of our External Canister Filter model:

Design shown for illustration purposes only

2. The difference between the amendments and the original representation of the design is that there is only one photograph. The line drawings in the amended version are the same as those originally filed, save that there is now no labelling of the various parts in the exploded drawing.

3. Graham Tinker has requested the invalidation of the design registration under section 1B(1)[1] of the Registered Designs Act 1949 (as amended) ("The Act"). This section relates to the requirement that designs must be novel in comparison to others that have been made available to the public. Mr Tinker states that the design is not new and was available for sale to the public prior to the application date of 7 September 2012.

4. In particular, Mr Tinker states that a range of products matching the design were purchased by Aquatix-2u Ltd from Shanghai Luby Pet Industries Co. Ltd in China on 26 May 2011, which was the order shipping date. The goods were delivered to the UK on 23 June 2011 and placed on sale from that date. Mr Tinker states that they were advertised as being for sale on www.aquatix-2u.co.uk and eBay. Exhibit 1, attached to the statement of case, is a screen shot which is from the internet archive, the Wayback Machine, from 19 September 2011, showing Aquatix-2u's website offering an aquarium filter for sale. Model numbers are given as HW302, HW303, HW303B and HW304B:

[1] Which is relevant in invalidation proceedings due to the provisions of section 11ZA of the Act,

Mr Tinker states that the image used on the screen shot for these models is not "significantly different" to the registered design. Exhibit 2 includes copies of a supplier invoice showing evidence of purchase on 26 May 2011 of aquarium filters with the aforementioned model numbers. The invoice is from Shanghai Luby Pet Industries Co. Ltd to Aquatix-2u Ltd, dated 26 May 2011. Exhibit 3 is an invoice from a freight forwarder to Aquatix-2u Ltd showing a shipment from Shanghai Luby International Co Ltd[2] with an arrival date at Felixstowe on 23 June 2011 (the goods left Shanghai on 27 May 2011). Exhibit 4 is a copy of an email to Mr Tinker's company's webmaster dated 26 June 2011, giving instructions for the products to be added to Aquatix-2u's website. The description of the items reads external fish tank aquarium filters and the model numbers match those already mentioned. Exhibit 5 is a report from the Aquatix-2u's database system showing the date that the HW304B External Aquarium product was added to the system. The creation date was 29 June 2011. Exhibit 5b is a screen shot showing the steps in this procedure. Exhibit 6 is a picture which Mr Tinker states is the image supplied by the manufacturer:

[2] The name is not quite the same as Shanghai Luby Pet Industries Co. Ltd.

5. Mr Tinker states that the proprietor has used its design registration to have his company's products removed from third party websites such as Amazon and eBay, leading to loss of revenue and an inability to sell the large quantities of stock ordered after the initial order in 2011.

6. The proprietor filed a counterstatement, denying that the design fails to meet the requirement of novelty and individual character. The proprietor states that, in relation to the Internet Archive print (Exhibit 1) from 19 September 2011, it demonstrates that the images were put onto the internet no earlier than 19 September 2011, which is within 12 months of the date that the application for the design was made. It requests that Exhibit 1 is struck out on the basis that the UKIPO[3] is not inclined to accept such evidence as definitive evidence of prior disclosure. In relation to Exhibits 2, 3 and 4, the proprietor states that the documents are internal and/or confidential which cannot be considered to amount to prior public disclosure. The proprietor states that the documents in Exhibits 2, 3 and 4 fail to show clearly what was disclosed, to whom and when. It states that the mere reference to product codes does not give any certainty that the product codes correspond to the design shown in Exhibit 6 (said to be the image supplied by the manufacturer). The proprietor highlights the four month gap between the purchase date (26 May 2011) and the "first concrete evidence of internet disclosure". It claims that this gap could indicate that the stock referred to in the supplier invoice (Exhibit 2) is not the same as the stock shown in Exhibits 1 and 6. The proprietor states that, in relation to Exhibit 6, variations routinely occur in the normal run of manufacturing and distribution and that therefore there is a question as to whether Exhibit 6 accurately reflects the products which Mr Tinker actually imported. It states that

[3] Intellectual Property Office

when it orders by product codes, the codes pertain to specifications rather than designs, so that when the product arrives, the look of the product may differ from those previously purchased under the same product codes. This casts doubt, it is claimed, on the veracity of Exhibit 6. The proprietor states that there is no evidence precisely dating and concretely linking the image shown in Exhibit 6 to any of the forms and product codes shown elsewhere in Mr Tinker's evidence. Any alleged link can only be inferred; the proprietor states that inference amounts to neither proof nor evidence. The proprietor also alleges that Mr Tinker's statement of case is defective because it fails to elucidate the design features of the alleged prior art.

7. Mr Tinker filed further evidence and the proprietor filed submissions in reply. The materials filed by Mr Tinker with his statement of case, described above, constitute evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006. Neither side requested a hearing, although they were given the option of a hearing if they wished, prior to this decision being made. Neither side filed written submissions in lieu of a hearing. I made this decision on the basis of all of the papers filed by both parties.

Evidence

8. Mr Tinker states that he is the Managing Director of Aquatix-2u Ltd ("Aquatix"), which is an online mail order company. It has traded since 2000 and, in 2005, it began sourcing products from China. Mr Tinker states that, in May 2011, his company purchased a variety of aquarium products from a company in China, trading as Shanghai Luby International. He states that the products were delivered to his company at the end of June 2011 and were "immediately advertised for sale to the public on our website www.aquatix-2u.co.uk and www.ebay.co.uk under the seller ID aquatics4all." Mr Tinker provides a series of exhibits, as follows:

9. Exhibit 1a is a print of a forum discussion posted on 25 December 2009 on plantedtank.net/forums. The image shown in the posting is:

I note that the person writing the post refers to the items as being a “SunSun ‘Outside Filter’ HW-302”. Mr Tinker states that this is a public forum posted by someone who purchased one in 2009 from a retailer in the US. The writer refers to “many of us have seen these filters popping up on Ebay and other aquatic sites”. The writer says that he bought the item “from someone domestic on Ebay” and that the item was shipped from “N.Cali”, which I assume is an abbreviation for Northern California.

10. Exhibit 2a is another forum post, from aquariacentral.com/forums including customer images from 25 February 2010. Mr Tinker states that the product was purchased in the US. The post is entitled “My review of the SunSun External Filter for 250g Aquariums HW-304A”. The writer refers to a purchase from eBay for $78.99 from kool_goods. Some of the images included by the writer

are:

11. Exhibit 3a contains a review from a forum called the jakearium.com. It refers to reviews of the SunSun HW-302 canister aquarium filter from eBay. The post is dated 5 March 2011 and includes the following pictures:

"SunSun" HW-302 Canister Filter Review – aka Ebay Canister

MAR 5
Posted by ~~riparіumguy~~

(~~http://thejakearium.files.wordpress.com/2011/03/102_21871.jpg~~)

The writer says:

> "Before I tell you about the canister, I need to fill you in on where you can get it, and where it is manufactured. The reason the brand name "SunSun" is in quotes, is because the brand changes. Some people will order the same filter for the same prices as another person, but when they both get them, one will be by "SunSun" or Perfect or a host of others. You still get the same filter, just different "brands". The filter itself is manufactured in Asia, and has about the same design as the Marineland C-series filter and the JBJ filter. It has even been speculated that they are made in the same factories. Though, that is rather far-fetched in my opinion. On to the review!"

12. Exhibit 4a is described by Mr Tinker as linking to the product reviewed in Exhibit 3a (jakearium). The eBay listing is described as new and ended on 5 March 2011. At the end of the product description, it says "Product by PERFECT, same level brand as JEBO or SUNSUN". The seller is kool_goods, which is the name of the eBay seller from which the blogger in Exhibit 2a purchased the product, reviewed on 25 February 2010. Pictures within the eBay listing are:

100 G AQUARIUM CANISTER FILTER EXTERNAL PUMP FILTRATION

See original listing

Item condition:	New
Ended:	05 Mar, 2011 01:52:31 GMT
Winning bid:	US $34.90 [1 bid]
	Approximately £23.10
Postage:	Read item description or contact seller for details.
Item location:	Best Price.Highest Quality.Greatest Service., United States
Seller:	kool_goods (15973) | Seller's other items


①
②


Perfect
OUTSIDE FILTER
Touch the perfection
PERFECT
HW-302
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OUTSIDE FILTER
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OUTSIDE FILTER

13. Exhibit 5a is said to comprise images and a product review posted on 30 December 2009 from aquariacentral.com, although the writing in the print out is so minute that I cannot read it.

14. Exhibit 6a is the screen shot described earlier as Exhibit 1, filed with Mr Tinker's statement of case. Exhibit 7a is the same as Exhibit 2, filed with Mr Tinker's statement of case. Exhibit 8a is the same as Exhibit 3, filed with Mr Tinker's statement of case. Exhibit 9a is the same as Exhibit 4, filed with Mr Tinker's statement of case. Exhibit 10a is the same as Exhibit 5, filed with Mr Tinker's statement of case. Exhibit 10b is the same as Exhibit 5b, filed with Mr Tinker's statement of case.

15. Mr Tinker states that the pictures in the various exhibits appear to be the same as the image represented by the registered design in shape, style and colour:

> "The body of the filter is white in colour and has the same grey trim to the corners. The lids from all the images have the same large blue and grey push button and tap position. Therefore the registration does not represent a unique design. The product has not been designed and manufactured by All Pond Solutions Ltd, it has merely been sourced and marketed by All Pond Solutions Ltd in the same way as it has been by ourselves and many other companies. The product is available from many companies within China."

The proprietor's submissions

16. The proprietor did not file evidence but filed submissions. It is not necessary to record all the submissions, which I have, of course, fully considered, but I highlight those which are of note here, because they are in direct relation to the exhibits I have summarised. The proprietor refers to section 1B6(a) of the Act which relates to disclosures that 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. In this regard, the proprietor submits that Exhibits 1a, 2a, 3a, 4a and 5a all appear on US websites, with the writers having made purchases in the US. It submits:

> "Mr Tinker has provided some apparent evidence of prior use, but only in relation to activities outside the EEA."

A point is also taken with reference to the EEA in that the alleged purchase by the applicant was in China; i.e. not in the EEA, which does not prove that the product was disclosed to entities in the EEA prior to the filing of the design application.

17. The proprietor refers to Exhibit 6a (the same as the Exhibit 1, filed with the statement of case), which is the screen shot from Mr Tinker's company website, dated 19 September 2011. The proprietor points out that this date is less than a year prior to the date on which its design application was made. The proprietor criticises exhibits which are from the Internet archive "(Wayback Machine") because the archive website's own guidance mentions that a mere entry in the website cannot amount to evidence of the actual date of online disclosure. There is no reproduction in the evidence of such guidance, so I cannot ascertain its context.

Decision

18. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B 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.
>
> (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) it 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) ……

(9) ….".

19. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked, unless the exceptions in subsection (6) apply. This means that the relevant date for my assessment is 7 September 2012. Any prior art must have been made available to the public prior to this date. Mr Tinker claims that the design was available to the public prior to this date, because items which were not 'significantly different' to the registered design were being sold on eBay, as well as from his own online shop. The proprietor's defence is based upon whether there was, in fact, prior disclosure of the design. There is no explicit statement from the proprietor about whether the registered design is individual in its character compared to the items shown in Mr Tinker's evidence.

20. In its written submissions, made in reply to Mr Tinker's second set of evidence, the proprietor says this:

> "Mr Tinker has provided some apparent evidence of prior use, but only in relation to activities outside the EEA."

This appears to be a concession that there has been prior use (and, therefore that there has been prior art before the relevant date) but that, notwithstanding the prior art, the first exception in subsection 6 of section 1(B) applies:

> "(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;"

21. In *Magmatic Limited v PMS International Limited* [2013] EWHC 1925 (Pat), Arnold J considered the operation of the exception[4]:

> "33 *Article 7(1)*. By virtue of Articles 4, 5 and 6 of the Regulation, a Community registered design must be novel and have individual character having regard to

[4] In the parallel context of the Council Regulation 6/2002/EC of 12 December 2001 on Community designs.

any design "which has been made available to the public". Article 7(1) sets out the ways in which a design may have been made available to the public. In short, any disclosure which makes the design public in any part of the world will suffice. This is subject to two exceptions, however. These may conveniently be labelled "obscure disclosures" and "confidential disclosures". Only the first of these is relevant for present purposes. This applies where "these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community".

34 Although it was not directly in issue, the obscure disclosures exception was considered by the Court of Appeal in *Green Lane Products Ltd v PMS International Group Plc* [2008] EWCA Civ 358, [2008] FSR 28. Jacob LJ, with whom Ward and Rimer LJJ agreed, said:

> "66. … How then did the exception to absolute novelty come about? The *travaux* are clear about this. It came about by reason of a specific piece of lobbying by the textile industry. It was a concern about counterfeiting and nothing to do with an intention that prior art, obscure in the field of intended use, should be discounted.
>
> 67. The Economic and Social Committee opinion of 1994 said this when considering the novelty provision:
>
> > '3.1.2 This provision, as worded, would be difficult to apply in many fields, and particularly in the textiles industry. Sellers of counterfeit products often obtain false certification stating that the disputed design had already been created in a third country.
> >
> > 3.1.3 In these circumstances, the aim should be dissemination to interested parties within the European Community before the date of reference.
> >
> > 3.1.4 In the light of the above considerations, article 5(2) might be worded as follows: "A design shall be deemed to have been made available to the public if it has been published following registration, exhibited, used in trade or otherwise disclosed, unless this could not reasonably be known to specialist circles in the sector in question operating within the Community before the date of reference."'
>
> 68. This is clearly the forerunner of the exception in article 7. The Economic and Social Committee's suggestion was taken up, extended also to the individual character test and became the law. It is worthwhile quoting the Commission's explanation for the proposed exception contained in its 1966 amended proposal:
>
> > '… article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the "safeguard clause". Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in

> use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.'

69. As Mr Hacon observes, for the exception to work as intended the sector concerned had to be that of the cited prior art. His example demonstrates this:

> 'If the registered Community design was in respect of a design for, say, teapots and the alleged prior art was for Columbian textiles, it would be the textiles circles in Europe who would be in a position to know whether the "certification" was genuine. *Ex hypothesi* the teapot circles would never know."

70. Moreover the exception was clearly conceived as narrow - it was aimed at obscure prior art only: it meant that forging this would not help an infringer.

71. Although there were further *travaux* before the ultimate Regulation, there was no significant relevant further change."

35 There is a helpful discussion of this exception, which includes references to some more recent case law elsewhere in Europe, in Stone, *European Union Design Law: A Practitioners' Guide* (OUP) at §§9.22-9.66. As the author comments, the wording of the exception gives rise to a number of questions of interpretation which may require resolution by the Court of Justice of the European Union. In Case C-479/12 *H. Gautzsch Grosshandel GmbH* v. *Münchener Boulevard Möbel Joseph Duna GmbH* the Bundesgerichtshof has referred a question concerning the interpretation of the exception to the CJEU, but neither side suggested that I should defer judgment in the present case until after the CJEU has given its judgment. Nor was it suggested that I should refer questions myself. Accordingly, I must interpret the exception as best I can in the light of the guidance that is currently available. There are a number of points to consider.

36 First, the exception refers to "these events". The "events" are the events constituting disclosure referred to earlier in the first sentence of Article 7(1) – publication, exhibition, etc. Counsel for PMS submitted that the exception did not apply if the relevant event could reasonably have become known, even if the design itself could not reasonably have become known as a result of that event. I do not accept that submission. The purpose of the exception is to prevent obscure designs from being relied upon to attack the novelty and individual character of a Community registered design. If a design could not reasonably have become known, it cannot matter that the event could have become known. In most cases, of course, one will follow from the other.

37 Secondly, what is "the sector concerned"? In *Green Lane* the Court of Appeal held that it was the sector from which the prior design came, not the sector from which the registered design came. The Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) came to the opposite conclusion in Case R 84/2007-3 *Ferrari SpA v Dansk Supermarked A/S*

(unreported, 25 January 2008) and Case R 9/2008-3 *Crocs Inc v Holey Soles Holdings Ltd* [2010] ECDR 11. An appeal to the General Court in the latter case was not pursued. In those circumstances, I am bound by the Court of Appeal's decision in *Green Lane*. Furthermore, I agree with it.

38 Thirdly, who are "the circles specialised in" that sector? In *Green Lane* Lewison J (as he then was) held at first instance that this comprised all individuals who conducted trade in relation to products in that sector, including those who designed, made, advertised, marketed, distributed and sold such products in the Community ([2007] EWHC 1712 (Pat), [2008] FSR 1 at [34]-[35]). This point was not addressed by the Court of Appeal. In Case R 552/2008-3 *Harron SA v THD Acoustics Ltd* (25 July 2009, unreported) the Board of Appeal held that the circles included experts and all businesses involved in the trade including importers. Thus it seems clear that the words are to be broadly interpreted.

39 Fourthly, the test is whether the events "could not reasonably have become known in the normal course of business". It is common ground that this is an objective test. Counsel for PMS emphasised that the question was whether the events *could not* have become known, not whether the events *would not* have become known. I accept that, but subject to the qualification that the test is whether the events could not *reasonably* have become known *in the normal course of business*. The wording must be interpreted as a composite whole.

40 It is common ground that the events in question must have occurred prior to the filing or priority date of the registered design. Counsel for PMS accepted that it was theoretically possible for a design to have become sufficiently obscure as a result of the passage of time that it could not reasonably have become known in the normal course of business at the filing or priority date even if it could have become known at the date of the event, although he submitted that this was unlikely to occur in practice.

41 Fifthly, who bears the burden of proof? Counsel for PMS submitted that the burden of proving that the exception applied rested on the party who relied on it, here Magmatic**.** He argued that this interpretation was supported by both the wording and purpose of the exception and by the case law of the Board of Appeal, in particular Case R 1516/2007-3 *Normanplast snc v Castrol Ltd* (unreported, 7 July 2008) at [9]. Counsel for Magmatic submitted that the burden of proving that the disclosure was made available to the public rested on the party challenging the validity of the registered design, and that included proof that the design could reasonably have become known as result of the event relied on. In the alternative he submitted that, if the burden of proof lay on the proprietor of the design, nevertheless the evidential onus could shift if on its face the disclosure was an obscure one. In support of these submissions, he relied on the decision of the Board of Appeal in Case R 1482/2009-3 *Termo Organika Sp. z.o.o. v Austrotherm GmbH* (unreported, 22 March 2012) at [38]-[44]. As counsel for PMS submitted, however, there is no indication in that decision that the question of burden of proof was argued or that the Board of Appeal was addressing its mind to the question. In my judgment the burden of proving that the exception applies rests on the party relying on the exception. I accept,

however, that the evidential onus may shift to the other party once it is shown that the disclosure relied on appears to be an obscure one."

22. The proprietor submits that exhibits 1a, 2a, 3a, 4a and 5a are all alleged prior disclosures, but that they all appear on US websites, in the form of articles written by US citizens, having made purchases in the US. Exhibit 2a refers to the purchase from an eBay seller, kool_goods. This is the same eBay seller as appears in Exhibit 4a. Exhibits 1a and 3a refer to the purchase of the canister filters from eBay (Exhibit 5a is too small to read). Although the purchases were made in the US, they were made from an eBay seller(s). A disclosure to the public can take place anywhere in the world; it is not limited to activities within the EEA. eBay is a vast, globally accessible website, which features online shops and online auction facilities. It is not a remote 'place'. The purchases mentioned by the article/blog writers took place during 2009, 2010 and 2011. It is not as though the disclosure was a one-off incident. The sector involved in the case of both parties is the aquatics sector. It seems to be to be entirely normal for those involved in the sector (as per *Magmatic*, designers, manufacturers, advertisers, importers, distributors and sellers) to be aware of what is being sold on eBay: such an awareness falls within the scope of what would reasonably have become known in the 'normal course of business'.

23. As per paragraph 41 of *Magmatic*, the burden of proving that the exception applies rests upon the proprietor. It shifts to the applicant only if it is shown that the disclosure relied upon is obscure. For the reasons given above, disclosure on the US eBay site, particularly exhibit 4a, counts as a relevant disclosure and the proprietor has not proven otherwise. The proprietor cannot rely upon the exception in section 1B(6)(a).

24. The proprietor has also made the point, in its counterstatement and in its written submissions, that the screen print from the Internet Archive, from the applicant's website, from 19 September 2011, is dated less than a year before the proprietor applied for its design registration. The point has not been expanded; it is a bare statement of its date and that "therefore" the exhibit is irrelevant. I assume that the proprietor has in mind the disclosure exceptions under section 1B(6)(c)(d) or (e):

> (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.

25. The proprietor has not explained why any of these exceptions might apply. The submission does not further the proprietor's case.

26. As I have found that the submission in relation to the US evidence is a concession that there has been prior disclosure, that, effectively disposes of the proceedings because the proprietor has admitted that there was prior disclosure and

I have found that it cannot rely upon the exception in section 1B(6)(a) of the Act. The submission is worded:

> "Mr Tinker has provided some apparent evidence of prior use, but only in relation to activities outside the EEA."

However, in case the proprietor's submission was not a concession, because of the word "apparent" in "apparent evidence of prior use", I will go on to assess whether the registered design was new and had individual character at the relevant date, which is the date of application for the design.

27. The proprietor criticises the weight and probity of Mr Tinker's evidence. It criticises the individual pieces for not adding up to proof of prior disclosure. It uses words such as "sure", "concretely". This is the thrust of its attack; there is little said about comparison of the designs themselves. The proprietor submits that the links between the exhibits which Mr Tinker states relate to the placing of the product on his company website can only be inferred, and that inference amounts to neither proof nor evidence. In *Jones v Great Western Railway Company* (1930) 144 LT194 at page 202, Lord Macmillan held that

> "[t]he dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess. An inference in the legal sense, on the other hand, is a deduction from the evidence, and if it is a reasonable deduction it may have the validity of legal proof".

I may rely upon inference if it is a reasonable deduction from the evidence which Mr Tinker has provided. Whilst individual exhibits may not be 'killer' pieces, if parts of the evidence corroborate each other, they may add up to proof, as a reasonable deduction. In relation to his own use of the product, Mr Tinker has provided a paper trail. The proprietor has submitted that the exhibits are "circumstantial" and "internal".

28. The proprietor criticises Mr Tinkers Internet archive evidence:

> "We would like to add in passing that the UKIPO (Patents or Designs Directorate) is not usually inclined to accept "Wayback Machine" excerpts as definitive evidence of prior public disclosure, and on that basis, we would expect the Registrar to direct that Exhibit #1 be struck out of these proceedings".

29. Leaving aside for the moment the actual comparison of the designs, in terms of how the evidence has been put together, I consider that the individual pieces do combine to form a credible paper trail in terms of designs and dates. They corroborate each other, applying the civil standard of proof; I do not need to be 'sure', to use a word from the proprietor's submissions. I include within that the Wayback Machine evidence. The proprietor submits that:

> "Wayback Machine evidence is unreliable and should not be relied upon, especially in the context of the seriousness of cancellation of a Registered

> Intellectual Property Right. Wayback Machine evidence is susceptible to tampering and "glitches" of, for example .php scripting, which can give rise to differently-dated content being mosaicked into what appears, on the face of it, to be a single web site even though, in reality, the different parts of the page are created using database content which may have different dates."

This is not a basis for disbelieving Mr Tinker's Wayback Machine evidence; if the proprietor suspects tampering, it could have cross-examined Mr Tinker or produced counter-evidence. I note that Wayback Machine evidence has been relied upon without adverse comment in the Courts; for example in the Patents County Court, His Honour Judge Birss, in *National Guild of Removers & Storers Ltd v. Silveria* [2011] F.S.R. 9, said, at paragraph 33:

> "33 Mr Hill submitted and I accept that the fair way to assess the damages appropriate in this case is again to consider the fees due under the rules and use them to gauge an appropriate level of damages. The first question arising is the period of infringing use/passing off. To assess this Mr Sheahan used a website called the "Internet Archive" which is run by a not for profit organisation in the United States. This has a service called the "Wayback Machine" which allows a user to find snapshots of how websites appeared in the past. The Wayback Machine is commonly used in intellectual property cases to see what old websites looked like even when the operators of the websites have changed them or removed them altogether."

30. Mr Tinker has exhibited his company's sale/disclosure of the design on its website, dated 19 September 2011. The model numbers are HW302, HW303B and HW304B. The different US websites, dated from 2009 to 2011, also refer to model numbers HW-302 (Exhibit 1a), HW-304A (Exhibit 2a) and HW-302 (Exhibit 3a). The packaging pictures in the eBay listing (Exhibit 4a) refer to HW-302. The eBay seller in the listing showing in Exhibit 4a is kool_goods, which is the name of the eBay seller from which the blogger in Exhibit 2a purchased the product. Each exhibit helps to build up a consistent evidential picture of the sale of a product (I will come on to say what the design is) over a period of time which the sellers referred to using corresponding model numbers. Added to that, is Mr Tinker's paper trail. Again, none of the exhibits, by themselves, provide irrefutable proof of prior disclosure. I agree that exhibit 6 does not help much; it is just a picture, with no dating or provenance. However, I do not accept the proprietor's submission that the other exhibits are "circumstantial". Exhibit 1 is corroborated by:

- Exhibit 2, which is dated 26 May 2011 and shows a supplier invoice, from China, for aquarium filters with the model numbers HW302, HW303B and HW304B;

- Exhibit 3 shows that goods ordered from the Chinese supplier left Shanghai on 27 May 2011 and reached Felixstowe on 23 June 2011;

- Exhibit 4 shows that, on 26 June 2011, instructions were given to Mr Tinkers' company's webmaster to place the goods on the website, with descriptions as external aquarium filters and model numbers HW302, HW303B and HW304B.

31. Although the writers of the US blog postings are not witnesses to the proceedings, the evidence is not without weight merely because it is hearsay. Hearsay evidence takes many forms. Its weight has to be assessed according to the various factors set out in section 4 of the Civil Evidence Act 1995:

> "4.— Considerations relevant to weighing of hearsay evidence.
>
> (1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.
>
> (2) Regard may be had, in particular, to the following—
>
> (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
>
> (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
>
> (c) whether the evidence involves multiple hearsay;
>
> (d) whether any person involved had any motive to conceal or misrepresent matters;
>
> (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
>
> (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

32. The exhibits are historical documents. They were not solicited for, or created for, the proceedings. It would not have been practicable to have produced the US blog writers or the eBay seller kool_goods as witnesses and there is no hint that the exhibits were adduced in circumstances which suggest there was an attempt to prevent proper evaluation of their weight. I attach weight to the US internet evidence, noting that, in addition to the dates and pictures, the model numbers correspond to those in Mr Tinker's paper trail. If the design comparison stands up in Mr Tinker's favour, I draw the inference from his evidence that there was prior disclosure.

33. As I said earlier, the main thrust of the proprietor's defence is an (erroneous) reliance on the disclosure exceptions in section 1B(6) and an attack on the probity of the evidence. It says little about whether the comparison of the designs. Submissions are limited to being that Mr Tinker's use of the phrase "not significantly different" does not indicate prior disclosure of the same design, and that the invoice and freight forwarding document do not show the design for comparison. The

approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.

b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.

c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the article in question; imperfect recollection has little role to play.

d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.

e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.

f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

34. In terms of the legal principles, further guidance can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 ("*Dyson")*[5]. Some of the key points from this are that:

g) In terms of functional aspects, the fact that there may be another way of realising the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.

h) In terms of design freedom, this 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). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.

i) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.

j) In terms of overall impression Mr Justice Arnold stated:

[5] In reaching his judgment, Mr Justice Arnold referred extensively to a number of other decided cases including the ECJ's judgment in *Grupo Promer Mon Graphic SA v OHIM* (T-9/07).

"46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

> "123. … A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.
>
> 125 … As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of 'overall impression' - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as 'a canister fitted with a trigger spray device on the top', in the present case it is too general to describe either product as 'a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point', and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. …
>
> 126 … In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised *similarities* means that the machines give the *same* overall impression. …""

35) Matters must be judged from the perspective of an informed user. In assessing the attributes of such a person I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

> "First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the articles and both counsel roundly rejected the candidature of "the man in the street".
>
> "Informed" to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of "what's about in the market?" and "what's been about in the recent past?". I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any).

> In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any)."

36) This approach regarding the informed user was followed by Lewison J. in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch) and later accepted as appropriate by the Court of Appeal in that case. In *Dyson*, Mr Justice Arnold stated:

> "19 In *Grupo Promer Mon Graphic SA v OHIM* (T-9/07), judgment of March 18, 2010, the General Court of the European Union held at [62]:
>
> > "It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed."
>
> 20 In *Shenzhen Taiden v OHIM* (T-153/08), judgment of June 22, 2010, not yet reported, the General Court held:
>
> > "46 With regard to the interpretation of the concept of informed user, the status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended.
> >
> > 47 The qualifier 'informed' suggests in addition that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.
> >
> > 48 However, contrary to what the applicant claims, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product's technical function from those which are arbitrary.""

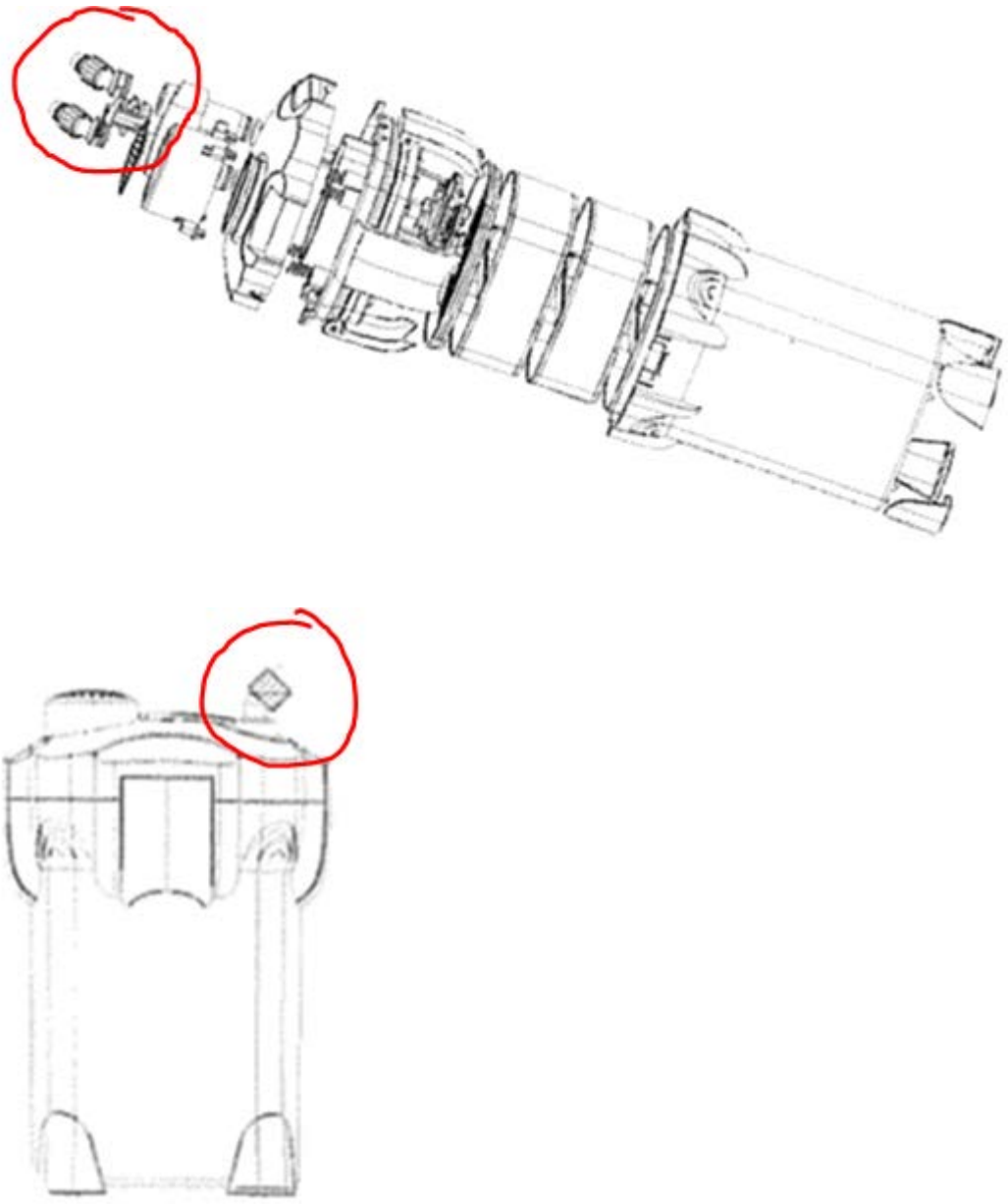
37. In the present case, Mr Tinker's US internet evidence reveals the paradigm informed users discussing the merits of using the filters: the writer in Exhibit 1a says "many of us have seen these filters popping up on Ebay and other aquatic sites", revealing an awareness of "what's about in the market?" and "what's been about in the recent past?"

38. One issue in this case is the scope of the registered design itself. As set out in paragraph 1 of this decision, the application was amended so that the design which

became registered is the exploded drawing, the vertical view (unexploded) and the end view. The photograph bears a disclaimer that it is for illustration purposes only. I will include the photograph in my comparison as it provides “real life” context for the line drawing. I note that Mr Tinker’s pictures all show two protrusions present at the top of the product which are absent from the proprietor’s photograph:

Proprietor’s photograph:

However, both the exploded drawing and the vertical line drawing in the design registration show the protrusions:



I conclude that the registered design includes the protrusions. The other features present in the proprietor's photograph match those in the design on Mr Tinker's website and the pictures shown by bloggers in the US; e.g.

and kool_goods in its eBay listing:

.

Those features include the shape of the canister, the four dark locking clips on each side, the dark ‘feet’, the indentations between the four dark locking clips, the raised oval blue button at the top, and all the moulding, e.g.

This may account for the lack of submissions about design comparison from the proprietor.

39. The proprietor has been silent about technical function and design freedom; consequently, I do not know whether it felt constrained by technical features. It has not made that case. However, bearing in mind the identical moulding shown in the image above, which would not appear to be technical, and all the other identical features, it is clear to me, on the evidence provided, that at the date of application for the design, there had already been, on several occasions, disclosure of the same design. Designs can be considered identical if the differences between them are immaterial. In the present case, there are not even any immaterial differences: there are no differences between the prior art and the registered design. Even if I am wrong about that, any differences which have escaped my attention are so small that the informed user will not consider the respective designs to differ in overall impression. The application for invalidation succeeds. The proprietor's registration of the design is invalid because, at the date of application, it was not new.

Outcome

40. The registered design is hereby declared invalid.

Costs

41. Mr Tinker has been successful and is entitled to a contribution towards his costs. Although the registrar has a wide discretion in relation to costs, he nevertheless works from a published scale (Tribunal Practice Notice 4/2007). I have borne the

scale in mind when determining what award of costs to make. I must, though, also take into account that Mr Tinker has not been legally represented in these proceedings and that his costs would not, therefore, have included any professional legal fees. I therefore reduce (except in relation to expenses) what I would otherwise have awarded. I hereby order All Pond Solutions Limited to pay Graham Tinker the sum of **£600**. This sum is calculated as follows:

Preparing a statement and considering the proprietor's statement	£300
Filing evidence	£250
Expenses – fee for filing Form DF19A	£50
Total	**£600**

42. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of January 2014

Judi Pike
For the Registrar,
The Comptroller-General