

O-494-14

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

**IN THE MATTER OF REGISTERED DESIGN NO 4028819  
IN THE NAME OF PAULINE QUIGLEY**

**AND**

**A REQUEST TO INVALIDATE (NO. 49/13)  
BY ANTONIA GARCIA**

## Background and pleadings

1. The registered design which is the subject of this dispute was filed by Pauline Quigley on 26 February 2013. The design is described in the application form as “Cake and chocolate floral arrangement. Arranged in flower pot. Topped with bumble bee”, although there is no representation of a pot in the application form. The representation of the design as registered is shown below:



2. Antonia Garcia has requested the invalidation of the design registration under section 1B(1)<sup>1</sup> 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. The design which Ms Garcia claims destroys the novelty of the registered design is Ms Garcia’s earlier registered design, which is number 4013710, filed on 9 December 2009. The registration certificate for Ms Garcia’s registered design was granted on 4 March 2010.

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<sup>1</sup> Which is relevant in invalidation proceedings due to the provisions of section 11ZA of the Act,



3. Ms Garcia states that the two designs look the same as they both have seven large cupcakes, six small cupcakes in a round configuration and six leaves separating the different sizes of cupcakes. Ms Garcia claims that colour is irrelevant, which was why she registered her design in black and white. She does not believe that Ms Quigley's bumble bee makes a difference to her claim. Ms Garcia states that although cupcake bouquets are not new, it was she who came up with the configuration described above. She states that her design has been featured in The Mail on Sunday, This Morning, Vanessa Show, Evening Standard and Vogue.

4. Ms Quigley filed a counterstatement, the first bullet point of which states:

"We dispute the fact that our design is infringing design number 4013710. This design has infact been in the public domain since 2006 despite Antonia registering the design in 2009."

5. Ms Quigley states that cupcake bouquets have gone ‘viral’. She also states that:

“Our design is just the same as the tutorials we have learned from. However we have added our own twist combining with chocolate and how we present in a pot.”

6. Ms Quigley states that the flavours and colours of her cakes differ from Ms Garcia’s, the rose technique used is different, and that she uses chocolate in her bouquets, as opposed to fondant, which Ms Garcia uses.

7. Both parties filed evidence<sup>2</sup>. Neither party requested a hearing, although they were given the option of a hearing if they wished, prior to this decision being made. Neither party filed written submissions in lieu of a hearing. I make this decision on the basis of all of the papers filed by both parties.

## **Evidence**

8. Ms Quigley’s evidence attached to her counterstatement, dated 3 March 2014, consists of the following:

- Appendices 1-11: prints and screen-shots from third-party websites. Ms Quigley has given the appendices the title “Cupcake Bouquets” with a subtitle of “Currently Selling”. All of the websites show clusters of cupcakes made to look like a posy or a bouquet of flowers. The screen-shots were taken on 10 February 2014.
- Appendix 12: Prints from a website called cakecentral.com entitled “How do I make a cupcake bouquet”, which shows a thread of questions and answers on the topic by people posting from Canada and Kentucky. There is one picture of a cluster of swirly cupcakes made by one of the people in the discussion thread, which took place in October 2006. The first person in the thread says that she found the instructions for cupcake bouquets on a website called wilton.com. Ms Quigley states that Wilton is a worldwide cake delivery brand which launched cupcake tutorials and instructions in 2006.
- Appendix 13: Ms Quigley states that there are over 20,000 video tutorials on Youtube showing how to make a cupcake bouquet. The print showing a list of some of these was taken on 28 February 2014. There are pictures next to some of the video descriptions showing a variety of different types of cupcake bouquet. Some are defined as being roses or hydrangeas.
- Appendix 14: Ms Quigley states that there are over 2,490,000 results on Google when searching for “how to make a cupcake bouquet.” The first page showing the unexpanded results is exhibited, printed on 28 February 2014.

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<sup>2</sup> Documents attached to a statement of case or a counterstatement constitute evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006.

- Appendix 15: Ms Quigley states that Kirsty Alsopp featured making a cupcake bouquet on her Channel 4 programme “Home Style”. This was in episode 4, but it does not say when the programme was broadcast. The print showing the details was taken on 28 February 2014.

9. Ms Quigley states that there are over 200 cupcake bouquet businesses worldwide and that the majority of UK cupcake shops have some form of cupcake bouquet on sale.

10. Ms Quigley states that she delivers only in Glasgow, which is not the same area as Ms Garcia, whose website, according to Ms Quigley, has not been “trading for years”. Her written submissions, dated 26 August 2014, say that she is about to trade nationally.

11. Ms Garcia filed a witness statement dated 24 April 2014. She does not dispute the concept of cupcake bouquets, as in the example of the Wilton tutorials, but she states that Wilton designs are not the same as her registered design. Ms Garcia points out that the fact that Ms Quigley refers to her designs as being the same as the tutorials she learned from but with her own twist demonstrates that Ms Quigley has done extensive research. The twist is both the use of chocolate and the presentation in the pot, and Ms Garcia states that presentation in a pot is key to her own design (see the first representation of Ms Garcia’s earlier design, in paragraph 2).

12. Ms Garcia exhibits an extract from *The Scottish Herald* from 1 June 2013 (exhibit 1) in which Ms Quigley is quoted as saying “I have been looking for a packaging solution that would allow me to take the cakes nationwide as we have been bombarded with interest from down south.” Ms Garcia says that this shows that Ms Quigley’s statement that she only delivers in Glasgow cannot be the case. (Ms Quigley confirms in her written submissions of 26 August 2014 that she is about to launch nationwide delivery).

13. Ms Garcia states that her website has been running since 2009, contrary to Ms Quigley’s statement that it hasn’t traded for years.

14. With reference to the third party websites in Ms Quigley’s Appendix 1, Ms Garcia states that she has an agreement with The Boutique Cupcake Company relating to the format of the cakes which the former is able to sell, which does not include the leaves which form part of Ms Garcia’s design. In relation to the other third party websites, Ms Garcia states that none of the companies make a replica of her registered design.

## **Decision**

15. 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) ....”.

16. 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 26 February 2013. Any prior art must have been made available to the public prior to this date. The registration certificate for Ms Garcia’s design was granted on 4 March 2010; the design would have been disclosed to the public by publication in the Designs Journal prior to this date. This is three years before Ms Quigley applied for her design, so qualifies as prior art.

17. 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.

18. Further guidance was given in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”)<sup>3</sup>. Some of the key points from this are that:

- g) 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.

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<sup>3</sup> In reaching his judgment, Mr Justice Arnold referred extensively to a number of other decided cases including the judgment of the Court of Justice of the European’s in *Grupo Promer Mon Graphic SA v OHIM* (T-9/07).

h) 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.

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

“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. ...”

### Informed user

19. 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 the 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).”

20. 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.””

21. When *Grupo Promer Mon Graphic SA v OHIM* was appealed to the Court of Justice of the European Union, the Court stated:

“53 It should be noted, first, that Regulation No 6/2002 does not define the concept of the ‘informed user’. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.

...

59 Third, as regards the informed user’s level of attention, it should be noted that, although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 26), he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier ‘informed’ suggests 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.”

### Comparison of designs

22. Ms Garcia’s design is registered without reference to colour, so the actual colours used are not relevant. The greyscale representations of Ms Garcia’s registration clearly show that, whatever the colours used, there are two contrasting colours. The six larger cupcakes around the outside of the arrangement match the large cupcake in the centre, whilst the six smaller cupcakes interspersed between the larger cakes are of a contrasting, darker, colour. There are also six leaves positioned in between the six smaller cupcakes. The top representation of Ms Garcia’s design shows the cluster of cakes inside a pot, with what looks like florists’ wrapping, to imitate a floral bouquet.

23. This configuration also forms the arrangement of cupcakes in Ms Quigley’s design. Her design is represented in colour, clearly showing the contrasting cake colours. There is only one representation of Ms Quigley’s design, although she states in her application form and her evidence that her ‘bouquet’ also comes in a pot. The representation of her design is an aerial view, easily compared to the second representation of Ms Garcia’s design, which is also an aerial view. Ms Quigley’s cluster of cupcakes also consists of six larger cupcakes around the

outside, with the same size of cupcake in the centre, with six smaller cupcakes interspersed between the larger cupcakes. Her design also has six leaves positioned in between the six smaller cupcakes. An additional feature of Ms Quigley's design is that it incorporates a small bee in between two of the cupcakes in the inner circle. The background upon which Ms Quigley's cluster of cupcakes appears looks like pink florists' wrapping and, as she refers to her design as a cupcake bouquet, it is reasonable to assume that this is what it is meant to represent.

24. The individual cakes in both Ms Garcia's design and Ms Quigley's design are made to represent roses.

#### Design corpus and design freedom

25. The question of the degree of design freedom which Ms Quigley had at the date on which she made her application for a registered design must be assessed with respect to the type of article which her design represents. Her design represents a cupcake bouquet, which the evidence from both sides shows to be a category of cake-making which has existed since (at least) 2006. Cupcake bouquets are intended to mimic real flower bouquets. Real flower bouquets come in all shapes and sizes. The evidence from Ms Quigley shows other cupcake bouquets. Some are in the form of hydrangeas. The picture on The Boutique Cupcake Company website has seven rose cupcakes around the outside, one in the centre, and seven quite different cupcakes in between. The website of Heaven is a Cupcake contains bouquets of cupcakes of different sizes and different flower appearances. The website of Hundreds and Thousands Cupcakes shows bouquets containing six cupcakes with one in the middle (i.e. no inner circle of cupcakes), with leaves scattered across the tops of the cupcakes, rather than uniformly positioned in between. The website of The Cake Mix shows six larger cupcakes as the inner circle (and the centre cake), with the smaller ones for the outside circle, the reverse of the arrangements in Ms Garcia's and Ms Quigley's designs. There is a good deal of what looks like spiky leaves or paper in between all of the cupcakes. Absolutely Cakes has an arrangement of six evenly sized cupcakes and one in the centre which are all different and which are all encased in quite pronounced muffin-style cake cases, which look like mini-florists' wrap around each one. Hey Little Cupcake! sells a bouquet in a pot which has more small sized cupcakes than large cupcakes and has leaves on the cupcakes, rather than in between them. Although I bear in mind that these prints were taken after the relevant date, they at least support the likely position that there were a variety of possible designs of cupcake bouquets. Ms Quigley's evidence from the How do I make a cupcake bouquet?, emanating from 2006, shows that nineteen cupcakes were required in one version: one cake for the centre, six around the centre, and then twelve around those six cakes.

26. The evidence shows that it is possible to make a wide variety of configurations of cupcake bouquets, in terms of number, size and arrangements of cupcakes and leaves, quite apart from the look of the individual cupcakes themselves. The fact that there are, as Ms Quigley states, 20,000 Youtube tutorials and 2,490,000 results on Google indicates that there is a considerable number of variations on the theme of cupcake bouquets, as does her statement that the majority of UK cupcake shops have some form of cupcake bouquet on sale. I consider that the degree of design

freedom in terms of the shape of a cupcake bouquet is large and that, as a result of this large degree of design freedom, small differences between the overall impressions of the design are less tolerable (*Dyson Ltd v Vax Ltd*).

27. My analysis of the two designs shows them to be highly similar:

- (i) all the cupcakes in both designs look like roses;
- (ii) the designs both have six larger cupcakes, plus one of the same size in the middle, and six smaller cupcakes as the inner circle;
- (iii) the position of the interspersed leaves is the same in both designs;
- (iv) in both designs, the colour of the outside circle of cupcakes and the centre cupcake contrasts with the colour of the inner circle of smaller cupcakes;
- (v) both designs appear inside florists' wrapping paper (or something like it);
- (vi) according to Ms Quigley's application form and her evidence, her design also incorporates a pot; a pot is visible in Ms Garcia's design. Whilst Ms Quigley's pot is not depicted, the description of the design in the application form says that there is a pot, so it would not be appropriate to place weight on the absence of a pot from Ms Quigley's design.

29. The primary difference between the designs is the presence of a small bee in Ms Quigley's design. I consider the reversal of the colour contrast would make no more than a minimal impact on even an informed user. Ms Quigley also refers to the use of chocolate in her design. Designs are about appearance. The taste of materials used cannot form part of the assessment because taste is a non-visible characteristic of the product, which does not relate to its appearance<sup>4</sup>.

30. The informed user in this case is not a casual user but must be deemed to be a knowledgeable and particularly observant user of cupcakes (although not a manufacturer of such products). The informed user will possess the characteristics set out in the case-law above. The informed user does not observe in detail the minimal differences that may exist between the designs in conflict. Designs can be considered identical if the differences between them are immaterial. I consider the presence of the bee and the colour contrast reversal to be immaterial features in designs which are otherwise identical. This means that Ms Quigley's design is not new. In case I am wrong about that, I will approach the matter from the perspective of overall impression. The degree of design freedom which Ms Quigley had was large, meaning that small differences between her design and Ms Garcia's prior art are less tolerable. The differences between the designs (the bee and the colour contrast reversal) are so small that Ms Quigley's design does not create a different overall impression on the informed user. It does not have individual character and is invalid.

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<sup>4</sup> See, by analogy, the decision of the General Court in Case T-494/12 *Biscuits Poult SAS v OHIM, Banketbakkerij Merba BV*.

31. There is one further point to be made. Ms Quigley said in her counterstatement:

“Our design is just the same as the tutorials we have learned from”.

32. That could be an admission that her design is not new because if it is the same as a design she has seen in a tutorial, the design had been disclosed before she made her application. However, even without this, my analysis of the designs means that Ms Quigley’s design is invalid.

### **Outcome**

33. The registration of the design is invalid because, at the date of application, it was not new and/or lacked individual character.

**34. The registered design is hereby declared invalid.**

### **Costs**

35. Ms Garcia has been successful and is entitled to a contribution towards her 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 Ms Garcia has not been legally represented in these proceedings and that her costs would not, therefore, have included any professional legal fees. I therefore reduce by a half (except in relation to expenses) what I would otherwise have awarded. The amount of the award is calculated as follows:

Preparing a statement and considering the proprietor’s statement	£100
Filing evidence and considering Ms Quigley’s evidence	£250
Expenses – fee for filing Form DF19A	£50
<b>Total</b>	<b>£400</b>

36. I hereby order Pauline Quigley to pay Antonia Garcia the sum of **£400** which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

**Dated this 21st day of November 2014**

**Judi Pike**  
**For the Registrar,**  
**The Comptroller-General**