

O-034-17

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 5000131
IN THE NAME OF SARAH JONES
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND
A REQUEST TO INVALIDATE (NO. 89/15)
BY YELLOW DOG UK**

Background and pleadings

1. The registered design the subject of these proceedings was filed by Sarah Jones (the proprietor) on 19 October 2015. The design is described as a 'Dog lead'.
2. The representation of the design as registered is shown below:



3. Yellow Dog UK (the applicant) has requested invalidation of the design registration under section 1B¹ of the Registered Designs Act 1949 (the Act), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The prior art which, it is claimed, destroys the novelty of the registered design is "The Yellow Dog Lead", which it submits was first made available to the public in February 2014, the first sale being made on 19th of that month. The lead is shown below:



4. The applicant also relies on section 11ZA(3) of the Act which enables a design to be declared invalid where it includes an earlier distinctive sign. In support of this ground the applicant states:

"7. Yellow Dog is the holder of UK trade mark number [2650552] for 'I NEED SPACE' (the 'Trade Mark') which was registered on 10 May 2013 in respect of Class 18: Clothing (Bandanas) For Dogs and dog leads/collars and in

¹ This is relevant in invalidation proceedings due to the provisions of 11ZA which gives the grounds for invalidation of a registered design.

Class 26: Ribbons. The Trade Mark is distinctive in relation to the goods for which it is registered. The design incorporates the Trade Mark in its entirety six times and thus involves the use of an earlier distinctive design.”

5. The proprietor filed a counterstatement denying the claims. She states (reproduced as written):

“On 10 January 2014 was my first initial inquiry for my design for a dog lead to my contact in China. Yellow dog at the time did not sell leads then only lead covers which I didn’t like for my own personal use. The process of quotations, drawings, samples, manufacturing & delivery took approx. 10 months before my stock came in. They have I NEED SPACE PLEASE DO NOT TOUCH ME embroidered into them.

Not all dog owners liked the words as PLEASE DO NOT TOUCH ME as some dogs only have issues with other dogs so I dropped the same writing on 1 lead and applied for a design licence I NEED SPACE & PLEASE DO NOT TOUCH ME.”

6. Attached to her defence is a photograph and copies of two design registration certificates (one of which is the design which is the subject of these proceedings). This additional documentation may be treated as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006.

7. The applicant filed additional evidence. Neither side requested a hearing. I make this decision on the basis of the papers filed by both parties.

The applicant’s evidence

8. Mr David Lewis filed a witness statement dated 2 April 2016. He is the Manager of Yellow Dog UK (the applicant).

9. The main points arising from his statement are as follows:

- Yellow Dog UK was established in 2012 and was registered as a charity on 23 July 2013. Yellow Dog is a not for profit pet organisation campaigning for greater public awareness when it comes to giving canines the space they need while training, recovering from surgery or being rehabilitated.
- The Yellow Dog programme aims to promote the use of yellow ribbons which are donated by the charity or can be purchased from them. The yellow sign is a signal to other dog owners and the general public that the dog requires space or needs time to get out of their way. The campaign is promoted among local authorities, vets and schools.
- Yellow Dog is funded by donations received from sales of a number of products including, 'but not limited to', leads, lead slips, dog vests, dog bandanas, ribbons and sponsorship packages. The products are sold through an online store and at exhibitions including 'Discover Dogs', 'Paws in the Park' and 'Crufts 2013'.

10. In his witness statement Mr Lewis states:

"4. One of the products we developed in January 2014 was a yellow dog lead with large wording 'I NEED SPACE' embroidered in black lettering. This was advertised in February 2014 and we began selling the leads on pre-order on 19 February 2014."

11. Copies of two invoices are attached to Mr Lewis's statement. They are printed from my.ecwid.com and are dated 19 February 2014 and 18 March 2014. The item purchased on each is described as, 'I NEED SPACE' Lead PRE-ORDER (Due in March).

12. Mr Lewis confirms that the following photograph is the lead sold on the Yellow Dog website from February 2014 and describes it as, "a yellow dog lead with a trigger hook clip, with the words I NEED SPACE written repeatedly along the length of the lead."



13. He states that since the first sale 471 leads have been sold on the website www.yellowdog.co.uk and a further 130 have been sold at shows, on eBay or donated to charities and vet surgeries.

14. The proprietor's evidence comprises a photograph of a lead with the words 'I NEED SPACE DO NOT TOUCH ME' shown repeated along the length of the lead. This is not the design which is the subject of these proceedings and I will say no more about it. The other two attachments do not add anything to the evidence, they are prints of design registrations from the UK register.

Decision

15. Section 11ZA of the Act provides the capability for a registered design to be invalidated under section 1B of the Act on the ground 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)...

16. 11ZA(3) of the Act states:

The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.

17. I will deal first with the invalidation based on section 1B grounds.

18. If a registered design does not have individual character it cannot be new. Consequently, I will focus on whether the proprietor’s design had individual character at the relevant date. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*². The most relevant parts are as follows:

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v*

² [2012] EWHC 1882 (Pat)

OHIM [2010] EC DR 7, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

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

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

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

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

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

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

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

Design freedom

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

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

Effect of differences between the registered design and the design corpus

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

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

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the

prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

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

19. Prior art can only be relied upon to invalidate a registered design where it has been disclosed to the public prior to the application date of that contested design.³ The relevant date for my assessment in this case is 19 October 2015. The question is therefore whether the registered design was new and possessed of individual character compared to any publicly disclosed designs as at this date. It is therefore irrelevant whether the proprietor's design was created prior to the creation of the applicant's design.

20. The informed user of dog leads is a consumer such as a dog owner, dog-walker or someone who cares for dogs. The informed user is not an 'average' consumer but is someone who will have an interest in leads. However, they will not examine the design with forensic attention to detail.

21. In terms of pattern and decoration the designer of dog leads will have considerable freedom. There are more restrictions when one considers the practical elements of the design. There must be a way of attaching the lead to the dog's collar and there must be a way for the person walking the dog to keep firm hold of the lead. However, there are a number of design variations possible which will satisfy these requirements. Overall, there is a reasonable degree of design freedom.

22. No evidence has been provided in respect of the design corpus so this will not be a factor in the conclusion I reach.

The prior art

23. The prior art relied on in this case is the applicant's lead which was first sold on 19 February 2014. This is stated in Mr Lewis's witness statement and supported by a print of an invoice for that date. The applicant's evidence has not been challenged by the proprietor.

³ *Unless the exceptions in subsection (6) apply, which they do not in this case.*

Individual character

24. The competing designs are as follows:

The applicant's design:



The registered design:



25. Both designs take the form of long yellow strips. Both have a trigger clip at one end, which look to be similar sizes in relation to the lead as a whole. Both have the words I NEED SPACE repeated along the length in black capital letters. The prior art clearly has a loop at the top which is lined in black and has a square of stitching with a cross through it in front of the loop. The proprietor's design is shown from a different point of view but appears to have the same pattern of a square and a cross in a similar position near the end of the lead that a dog walker would hold. In any event, the handle section of both leads would seem to be thicker/wider than the rest. Both designs have the square and cross lines repeated at the other end of the lead where it joins the trigger clip.

26. There are a number of differences between the designs. The shape at the base of the trigger clip, where it joins the lead, is angular in the applicant's design and curved in the proprietor's registered design. In addition the words I NEED SPACE appear 6 times along the lead which is the subject of the registration, including at the end where

the lead would be held. The words only appear 3 times on the lead which represents the prior art and there are no words present on the hand loop. It also has a small, narrow, black rectangle between the trigger clip and the beginning of the words.

27. The differences in word spacing and the number of repeats of the words, the small black rectangle before the wording on the applicant's lead, and the shape of the base of an otherwise very similar trigger clip, are minor differences which are not sufficient to alter the overall impression that the respective designs make on the informed user. Taking all of these factors into account, I find that the overall impression created by the designs is the same.

28. Consequently, I find that the proprietor's design did not have individual character at the date on which it was applied for and the application for the invalidation of this design under section 1B of the Act succeeds.

29. For the sake of completeness I will consider the applicant's claim under 11ZA(3) in brief. This section of the Act prevents the registration of a design involving the use of an earlier distinctive sign (in this case, a trade mark) on the ground of an objection by the holder of rights to the sign which includes the right to prohibit use of the sign in the United Kingdom.

30. The applicant is the proprietor of UK trade mark registration number 2650552 for the words I NEED SPACE. It stands registered for goods in classes 18 and 26:

Class 18 - Clothing (Bandanas) For Dogs and dog leads/collars.

Class 26 – Ribbons

31. A trade mark on the UK trade mark register is presumed to be valid. Section 72 of the Trade Marks Act 1994 states:

"72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the

original registration and of any subsequent assignment or other transmission of it.”

32. Section 10 of the same act relates to infringement of a registered trade mark and reads as follows:

(1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.

33. The proprietor of the contested design has used the applicant’s trade mark I NEED SPACE, which is registered for dog leads, on its own registered design for a dog lead. The applicant’s trade mark must be considered as a distinctive sign for the purpose of these proceedings. The applicant is the holder of trade mark rights and has a right to prevent the use of its mark for the goods for which it is registered.

34. I therefore find the ground for invalidation under section 11ZA(3) also succeeds.

CONCLUSION

35. The invalidation against this design has succeeded under sections 1B and 11ZA(3).

COSTS

36. Yellow Dog UK has been successful and is entitled to a contribution towards his costs. I have taken into account that the applicant was not represented and make the award as follows:

Official fee:	£50
Filing and considering statements of case:	£100
Filing evidence:	£150
Total:	£300

37. Subject to appeal, the above sum should be paid by Sarah Jones to Yellow Dog UK within 14 days of the end of the period allowed for appeal or, if there is an unsuccessful appeal, within 14 days of the conclusion of those proceedings.

Dated this 30th day of January 2017



Al Skilton

For the Registrar,

The Comptroller-General

