

O-210-15

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN No. 4015395

OWNED BY ALPHA FURNISHINGS LIMITED

AND

APPLICATION No. 40/13 BY ROSEHILL FURNITURE LIMITED

TO INVALIDATE THE REGISTERED DESIGN

The claims and the counterstatement

1. The registered design the subject of these proceedings was filed by Alpha Furnishings Limited (“Alpha”) on 23 April 2010. The design was registered on 14th May 2010. The design is depicted in the following representations¹:



¹ There are further representations of the design, but the ones shown above are sufficient for present purposes.

2. The application form confirms that the design is for a chair.

3. The proprietor makes no claim in respect of the colours shown in the representations of the design.

4. On 24 October 2013, Rosehill Furniture Limited (“Rosehill”) applied for the invalidation of the registered design. The applicant claims that the registered design lacks individual character compared to the design for a chair called the Maxim Deluxe which Rosehill sold prior to Alpha’s registration of the registered design. Accordingly, the registered design should be declared invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that the design did not fulfil the requirements of section 1B. The design for the Maxim Deluxe is shown below.



5. Alpha filed a counterstatement in which it claims that:

(i) There are material differences between the registered design and the design for the Maxim Deluxe chair which would individually or collectively produce different overall impressions on an informed user.

(ii) Potential customers’ assessments of the differences between the designs have partly or wholly influenced their decisions to purchase one chair or the other.

6. Both sides seek an award of costs.

The evidence

7. Rosehill’s evidence consists of a witness statement dated 11 June 2014 by Martin Sansum, who is the General Manager at Rosehill. Mr Sansum states that Rosehill has produced a chair called the Maxim Deluxe since at least 2006. He provides brochures from 2007 and 2008 showing this chair being offered for sale to the

public². Mr Sansum confirms that copies of these brochures were distributed to selected customers. He also exhibits invoices showing that his company placed orders for brochures featuring the Maxim Deluxe chair³, and that at least 2345 of such chairs were sold between 2006 and 2008⁴.

8. Alpha's evidence consists of 6 witness statements. The first is by Philip MacInnes. Mr MacInnes was the Chairman of Alpha between 1997 and 10 July 2014. Mr MacInnes previously worked as a sales representative for Rosehill Contract Furnishings Limited between 1989 and 1996. That company was a supplier of chairs to churches. Prior to working for this company, Mr MacInnes was the Pastor of Micklefield Christian Fellowship, a church in High Wycombe. As Pastor Mr MacInnes was involved in the selection of church chairs. Consequently, he has over 25 years experience of the purchasing process for church chairs.

9. Mr MacInnes states that Alpha produces a chair according to the registered design known as the Lewis Deluxe or LDL. Rosehill's Maxim Deluxe chair (the prior art) is also promoted as a church chair.

10. According to Mr MacInnes, the purchase of church chairs is generally funded, or partly funded, by donations from members and supporters of a particular church. He says that such people generally attach high importance to every detail of the operation of their church. Consequently, the groups or committees who select and purchase chairs for a church pay a much higher level of attention to every detail of the price, construction and appearance of church chairs, compared to (say) the attention paid to such matters by the Bursar of a school.

11. Mr MacInnes also makes the following points:

- Customers for church chairs are likely to consider the price, comfort, strength and durability, aesthetic appeal and stackability as important factors affecting the decision to purchase one chair or another. Quite small individual differences of appearance can sometimes affect opinions either for or against a particular chair.
- While he accepts that the chairs at issue have the same shaped back support cushion and the same angle of back support, such features are common in the design of church chairs. In support of this point, Mr MacInnes exhibits pages from the websites of two other furniture sellers, as they looked in 2004 and 2009, respectively, showing that chairs called the 'Staunton' and 'Kilbride Armless Stacking Chair' were available to the public featuring similar shaped back cushions and with a similar back support angle.

² As exhibits MS1 and MS2.

³ See exhibits MS3 and MS4

⁴ See exhibit MS5

- Although the back support cushion of the chairs at issue are similar, the back support cushion of the registered design is slightly deeper than that of the Maxim (prior art) resulting in the gap between the bottom of the back cushion and the top of the seat cushion of the registered design being smaller than the corresponding gap on the Maxim.
- The stretchers or side rails of the registered design are not curved as on the Maxim, but consist of three straight sections joined at clearly defined angles. Further, they are of a wider and deeper section than in the Maxim design and join the front legs at a lower point so as to leave a gap between the top of the stretcher and the bottom of the rail supporting the seat cushion. In his opinion, the differing design of the stretchers is sufficient of itself for the respective designs to create a different overall impression on potential customers.
- The tops of the front legs of the registered design are level with the rail supporting the seat cushion, whereas those of the Maxim protrude significantly above the rail. Further, the front legs of the chair covered by the registered design are vertical, or virtually so, whereas the front legs of the Maxim are raked, sloping backwards.

12. Alpha's second witness statement is from Peter Vanlint, who is the Deacon of Quorn Baptist Church in Leicestershire. Since 2008, Mr Vanlint has been looking after "*the fabric of the church*" as Fabric Deacon. This includes the seating and furniture.

13. In 2010 the church decided on a refurbishment, which included buying some new chairs. Mr Vanlint started looking for new chairs in May 2010. The criteria adopted for the initial sift covered:

- Looks
- Stack height and stability of stack
- Weight
- Sufficient width of seat
- Whether variants with arms were available.

14. Rosehill's Maxim was considered as an option. After viewing some samples of chairs from Alpha, which did not include the Lewis chair (the subject of the registered design), Mr Vanlint viewed Alpha's website and catalogue. He says that he thinks that he "*had possibly already discounted [the Lewis] by comparing catalogue pictures [of it] with the [Rosehill] Maxim Deluxe*". On 23 March 2011 he sent an email to Alpha explaining why his church was considering purchasing the Maxim but not the Lewis. This is in evidence⁵. The email makes it clear that the church was

⁵ As exhibit PV01

considering buying either the Maxim (the prior art) or another Alpha chair called the HB1WS, but not the Lewis (the subject of the registered design). This was because *“The Maxim we feel is just much prettier than the Lewis version....”*.

15. Mr Vanlint states that, in his opinion, the Maxim is more stylish than the chair the subject of the registered design. The designs for the front legs and the stretchers or side rails are particular features which set them apart. He recalls the design for the side rails of the chair covered by the registered design as being a key reason for his unwillingness to consider it.

16. Alpha’s third witness statement is from Nina de Salis Young, who is a Church Administrator at the Church of the Martyrs in Leicester. Ms Salis Young says that in 2011 she was asked to identify some new chairs for the church. She browsed the websites of potential suppliers and obtained catalogues from those she felt offered suitable chairs. This included Alpha and Rosehill. The chair the subject of the registered design and the Maxim (prior art) were considered. Sample chairs were obtained and put on display in the church. Members of the congregation were encouraged to try them and complete a questionnaire. 63 people did so. Ms Salis Young states that a majority preferred Alpha’s chair (the registered design) to the Maxim (prior art). She recalls that respondents mentioned that Alpha’s chair was more comfortable, had thicker padding, thicker wooden sections, and that the back support of Alpha’s chair extended further down than that of the Maxim. This feature was also of particular significance to Ms Salis Young because she suffers from back pain. She also noticed the different designs for the side rails or stretchers.

17. Alpha’s fourth witness statement comes from Richard Barber, who is a Property Steward at Bicester Methodist Church. Mr Barber is responsible for the contents of the building, including seating. Between 1976 and 1986 he worked as shop fitter making furniture. He is a time served joiner which he says gives him additional expertise in assessing the design of furniture.

18. Around 2010 the church was refurbished and new chairs were bought. A committee of around 20 people, including Mr Barber, decided on the new chairs. Mr Barber undertook the initial enquiries. He obtained samples of about 10 chairs, including the Maxim and the chair the subject of the registered design. Based on his experience as a joiner, it was obvious to Mr Barber from the thicker-section pieces used in the frame that the Alpha’s chair was better made and likely to be more resilient. It was subsequently chosen. Mr Barber recalls that the committee first conducted a close examination of the chairs, viewing them from every angle.

19. Alpha’s fifth and sixth statements come from Paul Tomlinson. Mr Tomlinson works for Alpha as Sales Manager. He visits potential customers with sample chairs and later collects them. He estimates that he has done this 1700 times. When the Alpha product is not chosen, Mr Tomlinson tries to find out which other chair was

chosen, and why. The look of the chair is often a reason for choosing it, or not. He says that there have been five instances of customers choosing between the chair the subject of the registered design and the Maxim. When contacted, four of these five customers told him that they had noticed visual differences between the chairs. Mr Tomlinson cites a customer in Burscough who noted two visual differences between the chairs, and another in Bicester who noticed three.

Representation

20. Alpha is represented by Graham Coles & Co. Rosehill is represented by Harrison IP. Both are Chartered and European Patent Attorneys. Neither side asked to be heard, but I have had the benefit of written submissions from both sides.

The relevant legislation

21. Section 1B of the Act (so far as it is relevant) 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) -
- (c) -
- (d) -
- (e) -

(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)--”

22. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*⁶. The most relevant parts are re-produced below.

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

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

- i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).
- ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
- iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);
- iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

⁶ [2012] EWHC 1882 (Pat)

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."

Was the registered design new and possessed of individual character at the relevant date?

23. The relevant date is the date of the application to register Alpha's design, i.e. 23 April 2010.

24. The application form identifies the product as "a chair". However, it seems to be common ground that the relevant product is a church chair. It follows that the relevant informed user is a user of church chairs.

Comparison with the prior art

25. The respective designs are set out below.



Maxim Deluxe



Registered Design



Maxim Deluxe



(REV AUG07)

Form 2A

Registered Design



Maxim Deluxe



(REV AUG07)

Form 2B

Registered Design

Analysis

26. I accept that the design for the Maxim chair was available to the public for several years prior to the relevant date. It is therefore capable of destroying the novelty of later designs, including the registered design.

27. According to the written submissions filed on behalf of Rosehill, the respective designs are “almost identical”. These submissions draw particular attention to the design of the back support cushion, the angle of the back support, and the design for the side rails or stretchers of the chairs.

28. It is obvious that there are similarities between the registered design and the design for the Maxim chair. The question is whether the similarities outweigh the differences to the extent that the designs would create the same overall impression on an informed user of church chairs.

29. Turning to the evidence, I note that Mr Barber is a qualified joiner and has made furniture. Consequently, as he says in his statement, he is more than just an ‘informed user’ of church chairs. I can therefore attach little weight to his evidence about the differences he noticed between the chair covered by the registered design and the Maxim chair. I do, however, take note of his evidence as to the degree of attention paid by those on the committee of his Church (who are closer to the notional informed user than he is) when selecting such products. Indeed this is a common theme in the evidence of all of Alpha’s witnesses and is not really contested by Rosehill. I therefore accept that the informed user of church chairs pays a high degree of attention to the design of the products.

30. Mr MacInnes’ evidence is that although the chairs at issue have the same shaped back support cushion and the same angle of back support, such features are common in the design of church chairs. He provides two relevant examples. I do not consider that two examples are sufficient to establish that such features were common, but I accept that it shows that they were not novel at the relevant date. In my view, an informed user would know this.

31. Mr MacInnes draws attention, in particular, to:

- The difference in the gap between the bottom of the back support cushion and the top of the seat cushion (which was also noticed by Ms Nina de Salis Young);
- The difference between the shape and positioning of the side rails or stretchers (which was also noticed by Ms Nina de Salis Young and Mr Vanlint);

- The difference between the angle of the front legs of the respective chairs and that the front legs protrude above the seat rail in the Maxim, but not in the registered design (which also appears to have been noticed by Mr Vanlint).

32. Mr Barber's evidence is more general (and hearsay), but supports the other evidence that potential users noticed differences between the designs at issue.

33. Considering the extent of design freedom, a church chair has to have legs, a seat and a back support of some kind, so there are some constraints. The requirement for the chairs to be stackable may also impose some constraints on the angles of the legs and of the backrest. However, there is, in my view, still considerable design freedom in this field.

34. Nevertheless, I find that an informed user would notice the differences described in paragraph 31 above and that the combination of those differences is sufficient for the registered design to create a different overall impression on such a user compared to the design for the Maxim. Although the differences are relatively subtle, they are noticeable without minute inspection and together they make a significant difference to the overall designs. Further, the elements of the design which are common, including the design of the back seat cushion and back support angle, were not novel at the time of the application and do not contribute strongly to the overall design of the chairs.

35. In the light of these findings, there is no need for me to consider the effects created by other smaller or less material differences between the designs, which are also relied on by Alpha. These include differences between the depth and positioning of the seat cushions, the difference in the depth of the cross rails at the back of the chairs, and the presence of a book box in the design for the Maxim, which obscures most of the rear cross rail of that chair.

36. Nor is it necessary for me to consider the effect of the absence from the registered design of the metal protrusion visible at the top of the front legs of the Maxim chair, which appears to be a purely functional device for joining the chairs together with minimal significance to the overall design of the chair.

Conclusion

37. The registered design is valid and, subject to appeal, the application for invalidation is rejected.

Costs

38. The application having failed, Alpha is entitled to an award of costs. I therefore order Rosehill Furniture Limited to pay Alpha Furnishings Limited the sum of £1500 as a contribution towards its costs. This is made of:

£250 for considering the application for invalidation and filing a counterstatement;

£1000 for considering Rosehill's evidence and filing evidence in support of the registration;

£250 for filing written submissions in lieu of a hearing.

39. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

Dated this 6th Day of May 2015

**Allan James
For the Registrar**