

O-533-15

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF:

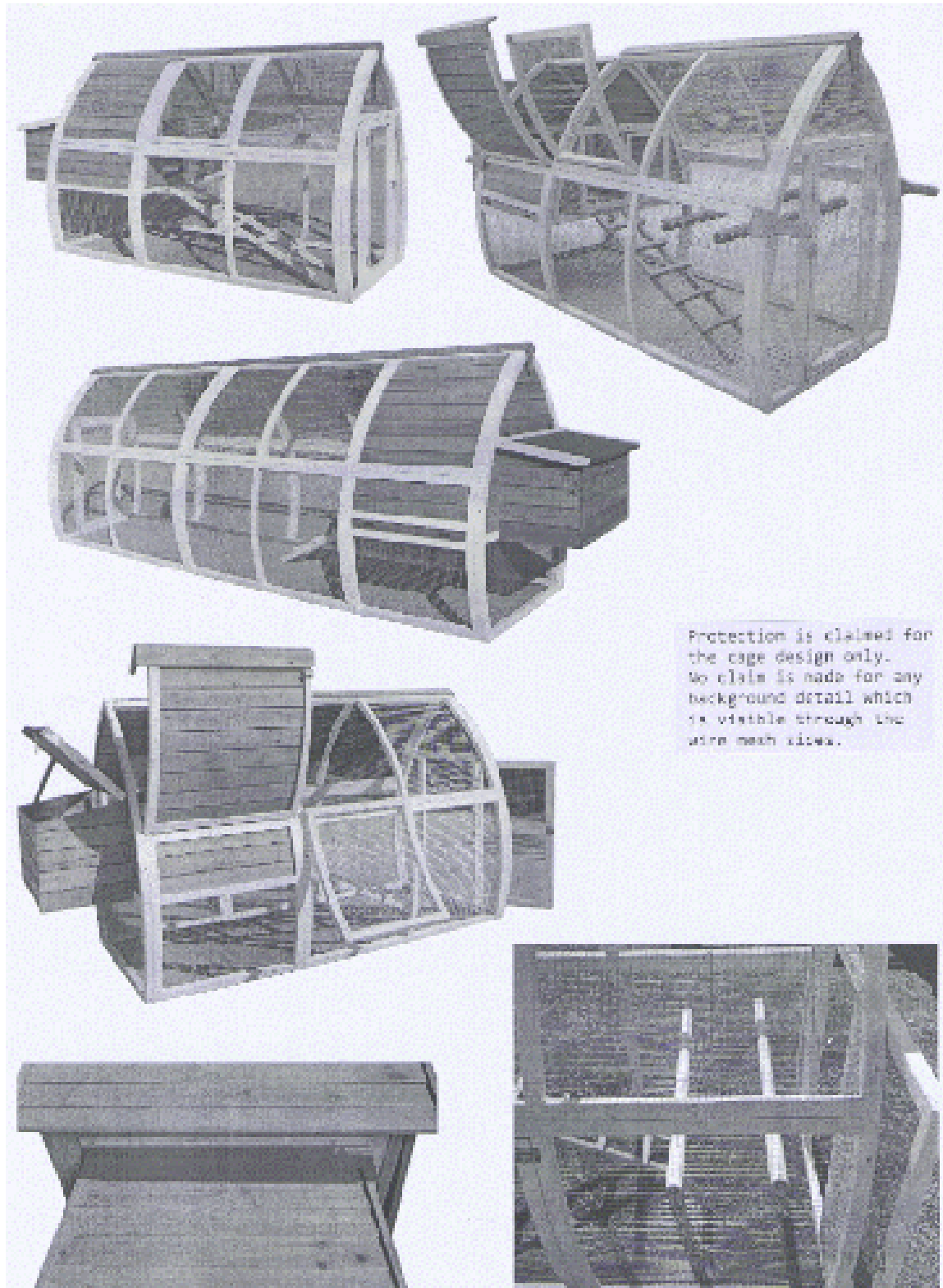
**REGISTERED DESIGN NO 4037011
OWNED BY MELVYN JOHN COLES**

AND

**AN APPLICATION (No. 60/14) BY FRAMEBOW & GREENHILL JOINERY
TO INVALIDATE THE REGISTERED DESIGN**

The background and the claims

1. The registered design the subject of these proceedings was filed by Mr Melvyn John Coles (the proprietor) on 6 September 2014. The design is described as a “Pet home and run” and is depicted below:



2. The application for invalidation is made by Framebow & Greenhill Joinery (the applicant).

3. Both the proprietor and the applicant are self-represented. This led, early on in the proceedings, to a few misunderstandings as to the invalidation claims being made. This is not surprising. The law surrounding registered designs can be complex. Given this, I called a case-management conference (CMC) which took place before me on 13 March 2015. I set the evidence timetable at the CMC, with both parties then subsequently filing evidence in support of their cases. I also discussed the pleaded case. From the discussion I had, it was clear that this case boils down to the novelty of the design and, consequently, I directed that the case be dealt with under section 1B of the Registered Designs Act 1949 (the Act) only. Any other claims were struck-out as being misconceived.

4. The novelty in a registered design can only be destroyed on the basis of something which has already been made available to the public. That “something” is often described as “prior art”. The prior art relied upon by the applicant is as follows:

- i) The applicant’s own registered design, registration number 4020171.
- ii) Articles made to, or based on, that design.

5. Prior art i) is limited to the representation on the register relating to registered design 4020171. Prior art ii) is not so limited, and may be based on whatever has been made available to the public.

6. The proprietor’s main defence is that his design “differs significantly on its integral design aspects”.

The relevant legislation and case-law

7. 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)--”

8. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*¹. 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:

¹ [2012] EWHC 1882 (Pat)

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."

The relevant date

9. The relevant date is the date on which the proprietor applied to register his design i.e. 6 September 2014.

The informed user

10. The application form identifies the product as a “pet run/home”. It follows that the relevant informed user is a user of such items and possesses the characteristics set out in the case-law.

What prior art can be relied upon?

11. Prior art i) is the applicant’s own registered design. The representation on the register looks like this:



12. The above design was filed on 21 June 2011 and it would have been published in the relevant design journal shortly thereafter. This counts as being made available to the public, with such publication having taken place long before the relevant date. Prior art i) may, therefore, be relied upon in these proceedings.

13. I note that in the proprietor’s evidence (which I will discuss in more detail later) it is claimed that the applicant’s registered design should be invalidated because there are arch shaped structures which pre-date it. This, in and of itself, is not relevant. Firstly, if the proprietor wishes to invalidate the applicant’s registered design then it must make a formal application to do so. Secondly, even if the registered design was invalid, this does not prevent the applicant from relying on it as a piece of prior art. These proceedings are not concerned with matters of infringement. Instead, the question at issue is whether the proprietor’s design lacks novelty on the basis of what has gone before.

14. Prior art ii) relates to articles made to, or based on, the above design which the applicant claims have been made available to the public. The applicant must establish what has been made available to the public, and when.

15. The applicant filed evidence with its statement of case and, also, a separate witness statement later in the proceedings. The proprietor also filed evidence, but none of it seeks to counter or challenge the applicant’s evidence as to publication.

16. The applicant’s statement of case was completed (and signed) by Ms Stephanie Ellis. Later evidence shows that she (along with Mr Chris Ellis) is a partner in the applicant’s business. Although her commentary is simply noted on various photographs attached to the statement of case, she states that the following product has been sold by the business since 2011:



17. Also attached to the statement of case are emails from 2011 to customers of the business relating, Ms Ellis states, to the sale of the above. The Ellis' also filed a joint witness statement which contains a print from the applicant's website showing the above product. The print is an archive print demonstrating that it was on the website on 16 September 2011.

18. I have no doubt that prior art ii) was made available to the public prior to the relevant date. The stated facts are clear, there is an archived website print and there are customer emails which support the facts. As already stated, there is nothing in the proprietor's evidence or arguments that attempt to counter any of this. Prior art ii) may, therefore, also be relied upon in these proceedings.

19. It is, in my view, undoubtedly the case that prior art ii) represents the better prospect of success for the applicant. I will, therefore, focus on this form of prior art in the subsequent discussions below.

Design freedom

20. Neither side focus specifically on the issue of design freedom. I do note, though, that the proprietor states in its evidence that the presence of a coup in an enclosure such as this is unsurprising as this is a necessity, as is a door to enter the enclosure. Whilst I do not necessarily disagree with this, and whilst there will be certain aspects of such products which can reasonably be taken to constrain design freedom (such as having a coup of some sort, having a door or some other manner of entry, having areas of mesh to keep the chickens (or other animals in)), there is still a wide degree of freedom in how the resulting structure will look.

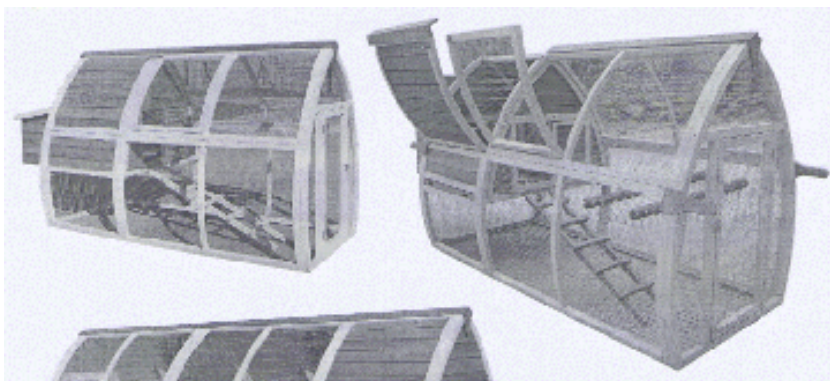
The differences between the earlier design and the design corpus

21. Neither side has filed evidence regarding the design corpus. One would imagine that typical designs in this sector would be dominated by square or rectangular structures due to such configurations being easier to build. Whilst evidence (as mentioned earlier) has been provided showing that oval shapes are not new, there is nothing to suggest that such configurations have been used in the design of the products in question. Having gone to the trouble of finding a couple of arch-like structures in use (for example, as what appears to be a greenhouse), I think I can take it that the proprietor found no other arch-like pet/animal enclosures in use. Thus, the design should be taken to have departed from the norm (the norm for

pet/animal enclosures), although the degree to which it stands out should not be regarded as being of the very highest.

Individual character - analysis and findings

22. The competing designs are shown below:



23. The second image above is from the scan of the design on the register. The proprietor also provided a clearer version in his submissions when highlighting the differences that exist between the designs:



24. The proprietor points to a number of differences between the designs including:
- i) The addition of a nesting box (fig 2.1).
 - ii) The accessible rear side panel (2.2).
 - iii) That the panelling of the housing/coup area goes below the horizontal cross piece to facilitate a slide out tray (2.3).
 - iv) The lower central panel which opens out for access (2.4).
 - v) The registered design has two roosting perches (2.5).
 - vi) The registered design has a sliding door on the inside of the housing operated by a metal arm (2.6).
 - vii) The frame structure has an alternate colour [to the panelling] as part of its overall look (2.7).
 - viii) The designs are different heights and they cost different sums of money.

25. In summary, the proprietor submits that the only similarity is the basic arch configuration and that such shapes have been around for a long time. It does not believe that the informed user will confuse the designs nor will they buy one instead of the other.

26. The applicant submits that the designs have the same basic impression and that all the proprietor has done is to make some minor additions. The applicant feels that the nesting box has been added simply in an attempt to make the proprietor's design different. The applicant provides some traced drawings with one design superimposed over the other to show how similar the basic configurations are.

27. In terms of the eight points listed at paragraph 24 above, some are either not relevant at all, or have little significance. Point viii) relates to a difference in height, but as exact dimensions are not set out in either design this is not relevant. Similarly, the difference in cost does not matter. Points ii), iv) and vi) have little significance. They represent mere functional and fairly minor add-ons enabling, for example, a particular part of the design to swing open – they have little impact upon the look and feel of the design itself. Point v) relates to the addition of a roosting perch, but, again, this is purely functional and has, in my view, no real impact on the overall impression of the design itself.

28. That leaves points i), iii) and vii). Point i) is the addition of a purely functional nesting box, something which is absent from the prior art. Point iii) is the contrasting colours. However, I must observe that the registered design was filed in black and white (not colour) and whilst I accept that the contrast is visible in the design as filed, it is not as stark as the contrast in the example provided by the proprietor. I am left with the view that the degree to which this contributes to the overall impression of the design is limited as it would appear to be more the result of the wood used in the construction and the fact that the panelling is affixed on top of the frame of the prior art as opposed to within the frame of the registered design; it is less likely to be regarded as part of the design characteristics of the enclosure. Point iii) is that the panelled housing goes below the horizontal cross piece in the registered design, however, I do not regard there to be a great deal of significance in this; the decision

to incorporate this appears based on the inclusion of a slide out tray, something which may not even be observed.

29. Contrary to what the proprietor states, the test here is not about the informed user being confused. The test is whether the later design has individual character compared to what has gone before. I accept that the designs are not identical or near identical. However, it does not follow that this means that the later design has individual character. In the *Samsung v Apple* case mentioned earlier, Birss J set out the correct test as to how similar designs need to be for an infringement to occur:

“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.”

Although the above case related to infringement, the same test is applicable.

30. I come to the view that whilst there are differences between the designs, they reside in features which do not impact significantly on the overall impression that the informed user will perceive. The overall impression of both designs will be based on a sectional arch-like curved enclosure with horizontal cross pieces, a rectangular door within the arch at the front of the enclosure and an elevated panelled housing/coup unit matching the shape and form of the arch, with that housing filling the end section of the enclosure, albeit to roughly half the height of the enclosure, the bottom half being empty. Whilst I do not find that there has been any form of copying, the overall impressions of the designs do not differ and, thus, the later design does not have individual character. **The application for invalidation succeeds.**

Costs

31. The application having succeeded, the applicant is entitled to an award of costs. I take into account that as the applicant was not represented it did not incur any legal fees. My assessment is as follows:

Official fee: £50

Filing and considering statements of case: £100

Filing/considering evidence: £300

Filing submissions: £100

32. I therefore order Mr Melvyn Coles to pay Framebow & Greenhill Joinery the sum of £550. 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 16th Day of November 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**