

O-239-17

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 4019756
OWNED BY HICKS AND HIDES**

AND

**AN APPLICATION (No. 17/16) TO INVALIDATE THE DESIGN
BY MR JAMES BOULT**

The background and the claims

1. The registered design the subject of these proceedings was filed by Hicks and Hides (“the proprietor”) on 8 June 2011. The design is described as a belt. It looks like this:



2. The applicant for invalidation is Mr James Boulton. His case is pleaded under section 1B of the Registered Designs Act 1949 (“the Act”). The basis of his claim is that the registered design was not novel when it was filed because a belt designed by a company called Nocona had been in the public domain for a number of years prior to

the filing of the registered design. A Google Images print is provided in support, something which I return to later.

3. The proprietor filed a counterstatement. The points it makes in defence can be summarised as:

- i) That the registered design was created by a UK resident in which copyright exists and that copyright laws are governed by the national law of each country.
- ii) Nocona is a US company, of which it had no knowledge when the design was filed.
- iii) Registered designs in the UK apply only to the UK and the Isle of Man. No information could be found about Nocona and Nocona does not hold any “patents or copyrights” in relation to the design in the UK.
- iv) In any event, there are differences between the designs on account of the registered design using recycled spent shotgun cartridges, whereas Nocona’s design uses circular studs made to replicate shotgun shells.

Some evidence was attached to the counterstatement which, again, I return to later.

4. Mr Boulton responded to the counterstatement by filing a counterstatement himself, commenting on what the proprietor had stated and filing further evidence. Mr Boulton was informed that if he wished to file evidence in response to the counterstatement then he should do so in proper evidential form during the evidence rounds, which he duly did. The proprietor also filed evidence. Neither side requested a hearing or filed written submissions in lieu. Both sides have represented themselves during the proceedings.

The evidence

5. Beyond the documents filed with the statement of case/counterstatement, both sides also filed a witness statement. In his witness statement Mr Boulton comments on the jurisdictional point raised by the proprietor. He also comments on the difference between the use of real as opposed to replica cartridges and that, in his view, this makes no difference to the outward appearance of the designs. In any event, he also provides evidence of another belt design by a company called Royden which uses real cartridges and which, he says, also pre-dates the registered design. He finally comments on the picture of the registered design used by the proprietor in its counterstatement which, he says, does not match the illustration of the design as registered – he provides a picture of the actual design from the IPO's website for the purpose of a fair comparison.

6. The proprietor's witness statement comes from Ms Bridie Abigail Hicks, a director of the proprietor. She states that she formed the proprietor in 2010 upon leaving school and the design stems from designs used as part of some school projects. It was not until June 2011 that she registered the design at which point she carried out research on the internet to see if it was already in the public domain; she could not find anything. She notes that whilst today plenty of information is available to us, this was not the case in 2011. Ms Hicks also comments on the Google Images search showing the Nocona design and, in short, questions the reliability/probative value of the evidence in terms of its capacity to show that the design was in the public domain before the relevant date. I will come back to this. She also adds that the difference in cartridge (real/replica) does create a clear difference in how the designs look. Ms Hicks comments on the Royden design highlighting differences between it and the proprietor's design.

7. So far I have summarised both sides' evidence only briefly. This is because there are a number of discrete issues to determine in these proceedings and I will return to any evidence/comments made about them in due course.

Section 1B of the Act

8. 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)--”

9. 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 reproduced 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

¹ [2012] EWHC 1882 (Pat)

(*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

10. The relevant date is the date on which the proprietor applied to register the design, namely 8 June 2011.

The geographical issue

11. The proprietor has highlighted, correctly, that a design registered under the Act applies to the UK and the Isle of Man only. It also highlights, again correctly, that copyright in the UK is governed by the national law of the UK (Copyright, Designs and Patents Act 1988). However, irrespective of all this, it does not follow that designs which have been created (and published) outside of the UK have no relevance on the issues that need to be determined.

12. Whether a design is new, or has individual character, is to be measured against what has already been disclosed to the public. Section 1B(5)(a) of the Act specifies what a disclosure is. Even though the rights obtained from a design registered under this Act are enforceable in the UK (and Isle of Man) only, there is no limitation in section 1(B)(5)(a) in terms of the geographical origin of a disclosure. It simply makes reference to something which “has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date. In principal, a UK registered design may have its novelty destroyed by a disclosure anywhere in the world, including the US.

13. The only (geographical) exception to the above relates to what is often referred to as “obscure disclosure”. This occurs when a disclosure (there has to have been one) has taken place in a manner which means that it (the disclosure) “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”².

14. The proprietor has argued that the applicant has failed to establish that any disclosure took place before the relevant date. This is not an obscure disclosure defence. The closest it gets to an obscure disclosure point is that it did not find the Nocona design when it made searches on the internet in 2011 and, also, that information was not as readily available in 2011 as it is today.

Have any disclosures been established?

The Nocona design

15. Mr Boulton relies primarily upon the Nocona design as prior art. I will deal with this first. The only evidence he presents is of a Google Images search. The search term reads “leather belt with shotgun cartridge”. A date range has been entered in the search as between 1 June 2000 and 1 May 2008. The results show a number of belts, but the image highlighted is headed “Nocona Mens Vintage and Traditional Western

² See s.1B(6) of the Act

Fashion [the rest of the text is truncated]”. Entered at the bottom of the print, presumably by Mr Boulton, are the words:

“As can be seen from this search the Nocona belt was in the public domain prior to the registration of 4019756 by Hicks and Hides”

16. It does not appear from anything Mr Boulton stated in his statement of case or evidence that he has any specific knowledge about the Nocona belt and its disclosure, other than via the Google Images search.

17. To counter this, Ms Hicks looked into how Google searches operate, specifically when it comes to page dates. She provided with her witness statement a print from Google’s website headed “Using Page Dates”. The first part reads:

“In addition to metadata which you explicitly specify on a page, Google also estimates a page date based on features of the page such as dates in the title and URL.”

18. Ms Hicks states that she also believes that when a specific date is entered on Google the date is linked to the website rather than the specific image that was used at the time and that she was also informed that the image can change on Google if the website is updated. She states that there is no hard evidence to show that these images would have appeared in 2011.

19. I agree with Ms Hicks that the extract from Google creates doubt as to the probative value of the evidence. Google page dates seem to be based on metadata specified on a webpage (as opposed to an individual image within that page) and/or some other form of estimation is made. Working upon the basis of estimations is not helpful. There is nothing to show that the image itself had any searchable metadata. I accept that the additional comments Ms Hicks goes on to make are not attributed to any particular source, and thus have limited weight, however, they do appear to make sense. Even if a website was in existence on a particular date (with date based metadata attributed to it), it does not follow that all of the content on a given page was in existence at that date. Having countered the evidence, Mr Boulton was given an

opportunity to file reply evidence. He choose not to do so. He could easily have filed further evidence to support a pre-relevant date disclosure, most obviously by providing an archived web-print of the website showing its content at a pre-relevant date point in time. Taking all of this in the round, I am not satisfied that Mr Boulton has established that the Nocona design was disclosed prior to the relevant date.

The Royden design

20. In terms of prior disclosure, this design suffers from the same problem as set out above. The only date comes from a Google Images search this time for a period “before 31 December 2010”. Although a page from the website itself is provided (in addition to the Google report), there is nothing in the print which helps to verify the date on which a disclosure of the design first took place. I am not satisfied that Mr Boulton has established that the Royden design was disclosed prior to the relevant date.

Obscure disclosure

21. Given that I have already held that no prior disclosure has been established, it is no longer necessary to consider this point in detail. However, I would say that simply because Ms Hicks did not find the claimed prior art, this is not good evidence in and of itself that the disclosure was obscure. Furthermore, a bare claim that things are easier to search today as compared to 2011 is not a good argument – whilst there have been many technological advances since 2011, the ability to search the Internet is not one of them.

22. That would normally be the end of matter, however, in case of appeal, I will give my view on the novelty of the registered design if, against my finding, it is held on appeal that a pre-relevant date disclosure has been established. In doing so I will focus on the Nocona design.

Novelty

23. The registered design looks like this:



24. The prior art like this:



Newness

25. The registered design must be both new and possess individual character. “New” means that no identical design has been published or one “whose features differ only in immaterial details”. The designs are certainly not identical. The shape of the buckle is slightly different and, furthermore, there is an additional cartridge on the belt loop of the Nocona design, a feature not shared by the registered design. These difference are not immaterial and they, alone, mean that the design is new compared to the prior art.

Individual character

26. 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 the earlier design. There are, though, a number of factors to consider:

The informed user

27. The informed user is a user of belts who possesses the characteristics set out by Mr Birss in paragraph 34 of *Samsung v Apple*.

Design freedom

28. Neither side comment on design freedom. Whilst designers of belts have a degree of constraint on account of the need to adopt an overall shape which is long and narrow (so as to fit around a person’s waist at the top of his/her trousers) and that there should be some form of buckle to secure the belt in place, it strikes me that there is a reasonable degree of design freedom in the outward appearance created by any pattern or other embellishments which contribute to the overall impression of the design.

The differences between the earlier design and the design corpus

29. One would imagine that typical designs in this sector would be dominated by long, narrow belts with a traditional looking belt buckle, most belts, from my own experience, are presented in plain/simple colours. Thus, the inclusion of gun cartridges as a form of ornamentation does seem to stand out to some degree. However, in the absence of better evidence (there is some evidence of other belts which feature cartridges but the dates on them are not clear), I adopt a neutral position on this factor.

Individual character

30. Both the registered design and the prior art feature either real (spent) gun cartridges, or replica ones. A point is made by the proprietor that the difference between real and replica cartridges produces a visual difference. I cannot see this myself when looking at the representations which are to be compared (as above). The degree of detail in the design as registered compared to the prior art produces no meaningful difference in the look of the cartridges themselves. Indeed some informed users may not even recognise them as gun cartridges and may just assume that they are large circular studs, both with an inner and outer circular portion. The proprietor has filed more detailed pictures of the cartridges, from which writing can be seen. However, these cannot be taken into account as such writing is not apparent in the design as registered. What can be taken into account is that the cartridges are evenly spaced along the belts shown in the competing designs, which, therefore, is another point of similarity in the overall impressions.

31. The main differences are: i) the additional cartridge on the belt loop, ii) the slightly different shape of the buckle and, iii) that there appear to be three rivets near the belt buckle on the Nocona design. Taking these in reverse order, the rivets will be seen as a purely functional difference assisting in the construction of the belt and do not, in my view, create a meaningful impact on the overall impression. The difference in the shape of the buckle is small, with neither buckle standing out from the norm. I doubt whether the informed user would even notice this. The final difference is the additional cartridge on the belt loop. Here, the informed user, if they notice the difference at all, will see this as a simple continuation of the regular spacing of the cartridges along the

length of the belt. Individually and in combination, the differences do not create a different overall impression. Thus, if I had been satisfied that the Nocona design had been disclosed prior to the relevant date, I would have invalidated the design.

Outcome

32. My primary finding is that the Nocona design was not disclosed prior to the relevant date. Given this, the application for invalidation fails and the design may remain registered.

Costs

33. Neither party returned the pro-forma sent to them which they were asked to complete if they were minded to request costs in relation to these proceedings. Consequently, I make no award of costs.

Dated this 17TH Day of May 2016

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