

O/387/18

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 6017609

IN THE NAME OF FURNITURE EXPRESS LTD

AND

THE REQUEST TO INVALIDATE THE REGISTRATION (NO. 44/17)

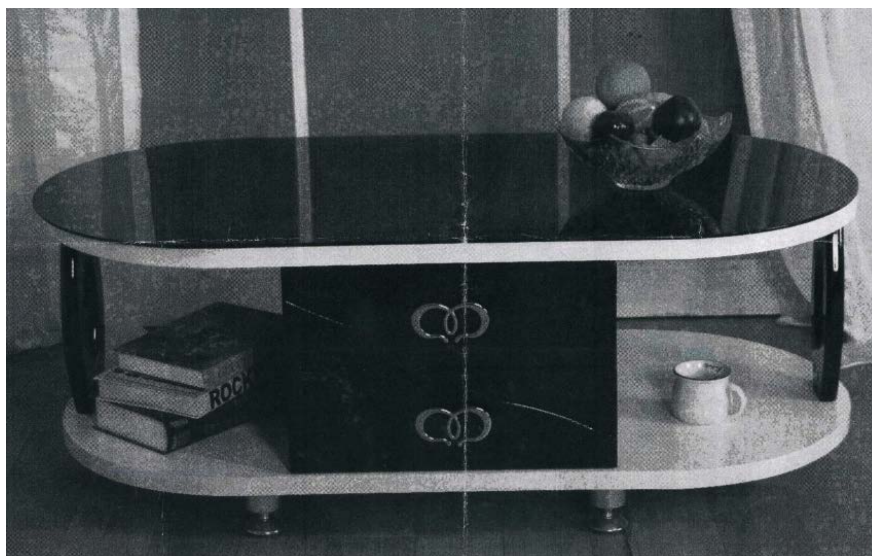
BY MOD FURNISHINGS LONDON LTD

Background and pleadings

1. The registered design which is the subject of this dispute was filed by Furniture Express Ltd (“the registered proprietor”) on 29 August 2017. The design is described on the application form as a “Coffee Table”. There is a single representation of the registered design, which is shown below:



2. On 5 October 2017, ModFurnishings London Ltd (“the applicant”) requested that the design be declared invalid under Section 1B of the Registered Designs Act 1949 (“the Act”), which requires that a registered design be new and have individual character. The applicant claims that it has sold such a table since before the registered design was filed, attaching the following representation of what it claims to be prior art which destroys the novelty of the registered design:



3. The application form includes a statement of truth, signed by Muhammad Mushtaq Danial, meaning that the statement of case qualifies as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (“the Rules”). The applicant states that it has sold its coffee table, which it calls “RAV” in the UK since 2015, having begun to import it on 25 June 2015. It states that the first container of the product arrived in the UK on 30 July 2015 and refers to “Felixstowe Port HMRC VAT Receipt”, but this is not attached. The second container of the product arrived in the UK on 15 April 2016. The applicant claims that the registered proprietor made enquiries about sales volumes of the applicant’s table in the shops where it was sold, during 2016, and then commenced selling its own table.

4. The registered proprietor filed a notice of defence on Form DF19B, which contains a statement of truth, signed by Nazir Karimi. The registered proprietor makes no comment about the applicant's claim that it sold the table prior to 29 August 2017, but does deny the ground brought under section 1B of the Act because it states that its registration has individual character and does not have the same appearance as the alleged prior art. I will summarise the contents of the counterstatement and the attachments thereto in the evidence summary. They constitute evidence under Rule 21(1)(a).

5. Only the applicant took the opportunity to file further evidence (in addition to what was said in the application). The parties were given the choice of being heard or filing written submissions in lieu of a hearing. Neither chose to be heard and neither filed written submissions in lieu of a hearing. Therefore, I make this decision after careful consideration of all the papers.

Evidence

6. The registered proprietor sent a letter to the Tribunal on 9 November 2017, which appears to be a follow-up to the counterstatement (filed on 23 October 2017). The letter and its attached photographs do not contribute to the outcome of this case because a) the factual statements have not been filed in proper evidential form (i.e. there is no statement of truth); and b) the contents of the letter and the photographs were all produced after the relevant date, which is the filing date of the registered design. Therefore, they do not affect the outcome of this decision because the position can only be assessed at the relevant date.

7. Mr Danial has filed evidence for the applicant. Some of his witness statement, dated 20 November 2017, constitutes submissions and opinions. The purpose of filing evidence is to prove facts. Consequently, although I will bear Mr Danial's submissions and opinions in mind when I come to make the decision, this summary is concerned only with the factual statements which he has made.

8. Most of the factual content of Mr Danial's witness statement concerns the applicant's approach to designing its table and modifying the design; and to the

allegation that the register proprietor has copied the applicant's table. However, what the applicant is required to show in its evidence is that prior art existed before the contested design was filed. The applicant's evidence is very short on this sort of detail. In its statement of case, the applicant refers to two shipments to the UK in July 2015 and April 2016. In his witness statement, Mr Danial states:

“Actually He [the registered proprietor] applied for the registration of this copy design in August 2017. I received the modified model of our original design RAV coffee table on 17 July 2017 Container No. 3567771 VAT Invoice No. 145910, HMRC record. (Evidence available. Being sensitive business secret, will be provided later).”

There is no exhibit showing any documents relating to the shipment.

9. The only attachments to the witness statement are reproduced below.

RAV COFFEE TABLE ORIGINAL MODEL TO MODIFIED RAV COFFEE TABLE



IMG_5598.JPG



RAV COFFEE TABLE CURRENT MODIFIED MODEL JUST CHANGED LEG AS PER CUSTOMER
REQUIRMENT AND WHITE COLOR SIDES ADDED TO DRAWERS



COMPARISON OF OUR ORIGINAL RAV COFFEE TABLE WITH COPIED FURNITURE EXPRESS MODEL

RAV ORIGINAL MODEL

FULLY COPIED OF RAV MODIFIED MODEL



SHAPE OF COFFEE TABLE SAME OVAL WITH BLACK AND WHITE COMBINATION AND DRAWERS IN THE MIDDLE.

- 1) **SAME SIDE SUPPORT SAME SHAPE, SAME COLOR.**
- 2) **SAME BASE COLOR WHITE**
- 3) **DRAWERS IN THE MIDDLE 2 DRAWERS EACH SIDE BLACK COLOR**
- 4) **TOP GLASS BLACK SAME OVAL SHAPE**

IF YOU COMPARE WITH MODIFIED RAV COFFEE TABLE SECOND PICTURE ITS 100% SAME ONLY HANDLES CHANGED.

Decision

10. 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)”.

11. 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 29 August 2017.

12. I will focus on whether the registered design has individual character (rather than whether it was new; if it does not have individual character, it cannot be new). The registered proprietor’s defence relies upon the design having individual character. The relevant case law in this respect was conveniently set out by Birss J. in paragraphs 31

to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). The parts which are most relevant to these proceedings 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, BAILII: [2010] EUECJ 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 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.”

13. Coffee tables are items of domestic furniture. The informed user of coffee tables is a consumer who occupies accommodation, as opposed to a designer or some other expert in the field. The informed user is not an average or standard consumer, it is instead someone who is likely to have an interest in domestic furniture design. They will be particularly observant and pay attention to detail, but they will not observe in detail minimal differences.

14. The designer of coffee tables has a very free hand in what design is actually used in terms of e.g. proportions, storage features and decoration. There is a wide degree of design freedom.

15. There is no evidence about design corpus. However, I know from my own experience that the coffee table design corpus includes a wide variation of designs. Even where the normal features are concerned, such as legs and table tops, there is a wide degree of variation.

16. The applicant’s evidence of fact is extremely scant. When seeking to prove that a design was disclosed earlier than the relevant date, the importance of solid, specific, dated evidence cannot be overstated. Since what the applicant seeks to prove is based on dates, if the evidence lacks dated content, the applicant will face an uphill struggle in its task. The applicant is clearly in the best position to file evidence of its importation of the coffee table which it alleges pre-dates the filing of the registered design. The only factual statements in terms of prior art are as follows:

i) in the statement of case: that there were two shipments to the UK, one on 30 July 2015 and the other on 15 April 2016. The applicant refers to “Felixstowe Port HMRC VAT Receipt” in connection with the 30 July shipment but provides no documentary support.

ii) a reference in the witness statement to the modified model of the original design which was received on 17 July 2017, container number 356771, VAT invoice number 145910, but with no supporting documentary evidence.

With regard to (i), the mere fact that the goods were imported does not mean that they could have reasonably become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area (which includes the UK) and specialising in the sector concerned (see section 1B(6)(a) of the Act); i.e. have been disclosed. With regard to (ii), the applicant states that the information is a sensitive business secret and that the evidence will be provided 'later'. No further evidence was filed, or sought to be filed.

17. In its statement of case, the applicant states that it can provide witness statements from retail shops. Even without such evidence from third party retailers, the applicant could have filed dated evidence, for example, of retailers ordering the tables from the applicant. However, no such evidence has been filed.

18. Further, there are two fundamental problems with the statement in relation to the 17 July 2017 import. The first is that it relates to what the applicant refers to as its own modified RAV coffee table. It identifies this particular table in the photographs which I have reproduced above in paragraph 9: the second image with the solid base. The original model of the table is identified as the first image (with feet). The photographs attached to the application form are of the original model (with feet). This means that the pleading, or allegation, which the applicant has made, and which the registered proprietor has answered in its counterstatement, is that the original model is the alleged prior art. The applicant has not requested permission to amend its pleadings to include its modified RAV coffee table design.

19. The second problem with the statement in relation to the 17 July 2017 shipment is that this took place only six weeks before the contested design was filed. Again, the mere fact that the goods were imported does not mean that they could have reasonably become known before the relevant date. There is no evidence to show that the coffee tables were placed on the market, showing that the design had been disclosed.

20. For both these reasons, and because the assertion that there was an importation on 17 July 2017 has not been supported by any documentary evidence, the modified RAV table design cannot be relied upon as prior art.

21. The references in the statement of case in relation to imports on 30 July 2015 and 15 April 2016 are even vaguer. There are no container or VAT receipt numbers provided, let alone documentary evidence of such. The photographs of the alleged prior art attached to the application form are not accompanied by any corroborating evidence which might have dated them to before the relevant date.

22. If evidence is not extensive, it must be at least solid. Having carefully analysed what the applicant's evidence amounts to, I find that it is very flimsy and inconclusive. The evidence is nowhere near sufficiently solid or specific to present a basis upon which to invalidate the registered design. The applicant has failed to establish that the registered design was not new or did not have individual character at the relevant date. The application fails.

23. For the sake of completeness, I will go on to consider, if I had been able to decide that the photographs attached to the application form constituted prior art, whether the registered design should be declared invalid under section 1B of the Act.

24. The prior art and the registered design are shown below. As both prior art photographs filed with the application show the same features, I have only shown the first of the prior art photographs for ease of comparison. The cup, bowl of fruit and books clearly are for display purposes and do not form part of the prior art.

Prior art:



Registered design:



25. The shapes of the coffee tables both comprise elongated ovals with straight sides. They both have a top comprising of a black surface at the very top, with a lower white piece. They both have black circular structures at either end of the table between the top and the base. They both incorporate a black two-drawer unit in the centre of the table between the top and the base which extends across the entire the table. I note that the registered proprietor claims that its drawer unit has four drawers (two either side). However, this cannot be taken into account as this cannot be seen from the

design representation as it appears on the register¹: only features which are visible can be compared.

26. There are a number of details which are different. These are:

(i) The drawer handles. The prior art handles are curved and reminiscent of a heart shape, whereas the registered design handles are straight with a taper to either end, and appear faceted along their length.

(ii) The drawer unit in the prior art is completely black. The drawer unit in the registered design has black drawers which are flanked by a thick white casing.

(iii) The prior art table is raised from the floor, being supported by legs which are cylindrical with the addition of a circular foot, protruding from the leg by means of a narrow cylinder or metal. The legs appear to be in a matt finish (it is unclear whether they are wooden or metal), whilst the feet are of a shiny metal. In contrast, there are no legs or feet in the registered design: the coffee table base sits on, and overhangs, a black base which matches the shape of the white base.

(iv) The white part of the table top in the prior art appears thicker than the white part of the table top in the registered design.

(v) The proportion of the white table base between the drawers and the black end structures is different in that there is more, or a wider, space in the prior art than there is in the registered design.

(vi) The white base in the registered design appears chamfered (sloping), whilst the white base in the prior art is not.

27. I think that noticing the presence or lack of chamfer in the white base and the thicker/thinner white part to the table top may border on minute scrutiny, which goes

¹ See the decision of the General Court of the European Union in Case T-494/12 *Biscuits Poult SAS v Office for Harmonisation in the Internal Market* [now the European Union Intellectual Property Office].

too far. However, the other differences are significant. The style of drawer handles and whether there are legs instead of a solid base are all aesthetic choices to be made when choosing one design of table over another. The drawer handles are completely different and the absence of legs/the solid base are major differences. In addition, a table such as this is meant not only to support whatever one wishes to put on the top, but is also meant to store or display items at either end, as shown in the prior art photographs. There is less space for this purpose in the registered design than in the prior art. Again, this will form part of the appraisal of the coffee table design during purchase. The white casing flanking the drawers in the registered design, which is absent from the drawer unit in the prior art, is also noticeable.

28. In conclusion, if I had been able to find that the applicant could rely upon the alleged prior art, the application would have failed. There are sufficient differences between the alleged prior art and the registered design, meaning that the registered design has individual character.

Outcome

29. The application for invalidation fails. The registered design remains validly registered.

Costs

30. The registered proprietor has been successful and is entitled to a contribution towards its costs, as per Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. As the registered proprietor is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the registered proprietor that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”. Since the registered proprietor did not respond to that invitation within the timescale allowed (nor has any response been received from the registered proprietor prior to

the date of the issuing of this decision), and as the registered proprietor has not incurred any official fees in defending its registration, I make no order as to costs.

Dated this 26th day of June 2018

Judi Pike

For the Registrar,

The Comptroller-General