

BL/765/19

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 6015424
IN THE NAME OF IAN TAYLOR
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND
A REQUEST TO INVALIDATE (NO. 28/18)
BY SARAH JONES**

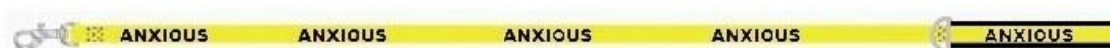
Background and pleadings

1. The registered design the subject of these proceedings was filed by Ian Taylor (the proprietor) on 15 July 2017. The design is described as a 'Lead'.

2. The representation of the design as registered is shown below:



3. Sarah Jones (the applicant) has requested invalidation of the design registration under section 1B¹ of the Registered Designs Act 1949 (the Act), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The prior art which, it is claimed, destroys the novelty of the registered design is registered design number 5004429, described as 'Pet lead/collar', which was registered on 15 August 2016. Ms Jones states that it was available to purchase, from her website, from August 2016. The representation of the design is shown below:



4. I note that in her statement of the case, the applicant makes reference to her, 'My Anxious Dog' trade mark. The applicant has not made a claim under section 11ZA(3) of the Act which enables a design to be declared invalid where it includes an earlier distinctive sign. Consequently, I will say no more about this aspect of the applicant's grounds. The applicant submits that it is her belief that the contested design is a replica of her design and so is not new and does not have individual character.

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

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

“Due to the limited design freedom and constraints of a dog lead the standard lead design is one I have used for many years, the pattern/design on the lead incorporates the combined words ‘Anxious Dog’ as an informative message and the overall impression gives it individual character which is significantly different as it states only the dog is anxious and is a distinctive message. The other design isn’t specific and doesn’t clearly identify who is anxious, the dog, the owner or both. Just the word anxious is devoid of a distinctive message and therefore my item is not a replica...the materials and construction of the leads are also distinctly different and a consumer can easily identify they are both different through the colour, materials, printing methods and informative message. There has been no florescent yellow leads with the combined words ‘Anxious Dog’ available on the market so it’s a new and novel design which creates a different overall impression and cannot be considered as identical or a replica.”

Preliminary issues

6. The applicant, in her statement of case, refers to another design currently registered by the proprietor. On 12 December 2018, the tribunal wrote to the parties to inform them that this invalidation would proceed only against the contested design referred to above, as that was the only design referred to on the applicant’s form to request to invalidate a design registration (DF19A).

7. Attached to the applicant’s form are prints taken from the UK design register. One is her own design, one is the contested design and the other is the design owned by the proprietor which does not form part of these proceedings. To the extent that it is relevant, this additional documentation may be treated as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006.

8. The proprietor filed evidence on 2 May 2019, by email. The material filed did not include a witness statement and was not exhibited correctly. The tribunal wrote to the proprietor on 30 May 2019 providing detailed guidance as to the correct way to file evidence. The proprietor was given until 13 June 2019 by which to file the corrected documents. The last line of the letter read as follows:

“If no amended documents are received, the registry will consider the case complete and ready for a decision.”

9. The proprietor did not respond to that letter and so the documents filed on 2 May 2019 have not been admitted.

10. The applicant filed submissions, neither side requested a hearing. I make this decision following a careful review of the papers before me.

Decision

11. Section 11ZA of the Act provides the capability for a registered design to be invalidated under section 1B of the Act on the ground that it was not new or that it did not have individual character at the relevant date. 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)...

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

“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).

² [2012] EWHC 1882 (Pat)

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.”

13. Prior art can only be relied upon to invalidate a registered design where it has been disclosed to the public prior to the application date of that contested design.³ The relevant date for my assessment in this case is 15 July 2017. The question is therefore whether the registered design was new and possessed of individual character compared to any publicly disclosed designs as at this date. It is therefore irrelevant whether the proprietor's design was created prior to the creation of the applicant's design.

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

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

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

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

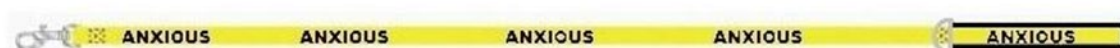
The prior art

17. The prior art relied on in this case is the applicant's lead which is the subject of a design registered on 15 August 2016 and first sold on the applicant's website in August 2016. This is stated in the applicant's statement of case and has not been challenged by the proprietor.

Individual character

18. The competing designs are as follows:

The applicant's design:



The registered design:



20. Both designs take the form of long yellow strips. Both have a trigger clip at one end, which look to be similar sizes in relation to the lead as a whole. The overall shape of the trigger clips looks to be the same. The proprietor's lead has a black lining to the top loop, which looks to be wider than the rest of the lead. The applicant's design is shown from a different point of view but appears to have the same wider area of black on the area where the loop would be located. Both leads are printed with words which are in plain block capital letters. Both include the word 'ANXIOUS'. Both designs have an area of reinforced stitching where the loop attaches to the lead.

21. There are a number of differences between the designs. The applicant's design appears to have an additional link where the lead joins the hand loop. The proprietor's design has the word 'DOG' after the word 'ANXIOUS'. The words appear three times on the lead shown in the proprietor's design, whereas the word 'ANXIOUS' appears four times on the earlier design, on the lead and once on the hand loop. The stitching at the clip end of the earlier design is shown as a square. The proprietor's design does not have any indication of such stitching.

22. The differences in word spacing and the number of repeats of the words, the small differences in stitching and the additional link at the end of the hand loop, are minor differences which are not sufficient to alter the overall impression that the respective designs make on the informed user. I find that the same is true of the additional word 'DOG' which appears on the proprietor's lead. I note that the proprietor submits that, without the word 'dog,' the word 'anxious' could refer to the owner or the dog and its owner. He concludes that these terms differ in their distinctive character. This is not a trade mark case and I am not required to make an assessment of the words in a trade mark sense. The question is whether the proprietor's design has individual character, something which is assessed from the perspective of the informed user. I also bear in mind that whilst the functional aspects of a dog lead have a narrower degree of design

freedom, the colours, patterns and words which appear on the surface can be many and varied. Taking all of these factors into account, I find that the overall impression created by the designs is the same.

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

CONCLUSION

The invalidation against this design has succeeded under section 1B.

COSTS

24. Sarah Jones has been successful and is entitled to a contribution towards her costs. I have taken into account that the applicant was not represented and make the award as follows:

Official fee:	£48
Filing and considering statements of case:	£100
Total:	£148

25. Subject to appeal, the above sum should be paid by Ian Taylor to Sarah Jones within 21 days of the end of the period allowed for appeal or, if there is an unsuccessful appeal, within 21 days of the conclusion of those proceedings.

Dated this 12th day of December 2019

Al Skilton

For the Registrar,

The Comptroller-General