

BLO/182/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF REQUESTS TO INVALIDATE:

1. REGISTERED DESIGN Nos. 6000670 & 6005547

WHICH STAND IN THE NAME OF ALL FIRED UP LIMITED

AND

2. REGISTERED DESIGN No. 6005714

WHICH STANDS IN THE NAME OF ANGELA PARRIS

The background and the claims

1. These proceedings concern the validity of the following three designs which have been registered under the Registered Designs Act 1949 (“the Act”):

- Registration 6000670, which stands in the name of All Fired Up Limited (“AFU”). The application for registration was filed on 16 September 2016. The design is described as a “Thistle pin”. The design looks like this:



- Registration 6005547, which is also owned by AFU. The application for registration was filed on 11 January 2017, and is, again, described as a “Thistle pin”. The design looks like this:



Colour is disclaimed from the above design.

- Registration 6005714, which stands in the name of Ms Angela Parris. The application for registration was filed on 13 January 2017. The design is described as a “lapel pin”. The design looks like this:



2. Ms Parris requests the invalidation of the two designs owned by AFU. In relation to Ms Parris' registration, the person requesting its invalidation is Ms Aldona Juska, the managing director of AFU. There has been no legal representation in these proceedings, Ms Parris representing herself, and Ms Juska representing herself/AFU.

3. The grounds for invalidation are all based on section 1B of the Act, a provision that requires designs to be novel compared to what has gone before. Ms Juska argues that Ms Parris has copied her/AFU's designs, and that she (Ms Parris) has a track record of doing so. Ms Parris denies that she has copied anything and that, in fact, she independently created her design. In her claims regarding ARU's designs, Ms Parris repeats that she has not copied anything, and, in fact, ARU's designs are duplicates of her work.

4. Both sides filed evidence. In the end of proceedings letter sent to the parties by the Tribunal, the evidence was identified as:

- Witness statement of Ms Parris dated 7 January 2019 (with Exhibits TB1-TB2).
- Witness statement of Ms Parris dated 22 May 2019 (with three exhibits).
- Witness statement of Ms Juska dated 1 March 2019 (with Exhibits AJ1-AJ19).
- Witness statement of Ms Juska dated 23 July 2019 (with Exhibits AJ20-AJ33).
- Witness statement of Ms Juska dated 25 September 2019 (with Exhibit sections 6 and 7, AJ8, AJ9, AJ30, AJ31, AJ32 & AJ33).

5. I will also take into account any evidence filed with the parties' respective statements as case, as per Rule 21(1) of the Registered Designs Rules 2006.

6. The absence of legal representation in these proceedings led to the evidence rounds taking longer than they should have. I held a case-management conference in an attempt to bring greater focus to what was required, which led to something of an improvement (although it was still not perfect). At the case-management conference, I also highlighted to the parties that one of the possible outcomes of the claims being pursued was that both parties' designs might be declared invalid and that they should perhaps reflect on that, potentially via mediation. No renewed attempts to mediate

took place. Neither party requested a hearing in relation to the substantive matters and neither side filed written submissions in lieu.

The relevant law

7. Section 11ZA(1)(b) provides the legal power to declare a registration invalid if it does not fulfil the requirements of section 1B of the Act; it reads as follows:

“(1) The registration of a design may be declared invalid

(a)...

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

8. Section 1B itself deals with the requirement for novelty (being new and having individual character); it 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.”

9. The assessment as to novelty must be based upon what has gone before, before the relevant date. This requires the identification of, and comparison with, earlier design(s), what is often described as “the prior art”. When making a comparison with the identified prior art, a number of factors need to be borne in mind, including: the identification and characteristics of the informed user (through whose eyes matters must be judged), the degree of design freedom a designer has in relation to the articles in question, the effect of differences between the design and the existing design corpus, together with the overall approach to the comparison that has to be made. For guidance on these factors, it is useful to note the summary set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). I have included the text of these paragraphs in the annex to this decision.

Relevant prior art for ARU's registrations

10. The first task is to identify any relevant prior art contained within the evidence. I will begin by identifying and considering any relevant prior art in respect of AFU's design registrations. The designs appear to be exactly the same, save that one (6005547) disclaims colour. They were filed on 16 September 2016 (6000670) and 11 January 2017 (6005547) respectively. To count, the prior art must have been made available to the public before those dates, as per section 1B(5) of the Act.

11. In her witness statement of 7 January 2019, Ms Parris states that her own thistle design was first shown on 24 January 2016 at Scotland's Trade Fair, held in Glasgow. No evidence is provided showing the design. It would be wrong to assume that it corresponds exactly to the design that she filed almost one year later, on 13 January 2017. I bear in mind that the publishing of Ms Parris' registered design when it was filed at the IPO would potentially count as a disclosure, however, this was after the relevant dates of AFU's registrations, so does not count.

12. In the same witness statement, Ms Parris states that there were previous unsuccessful constructions of her design prior to her final design being produced, but no further information is given in this witness statement, so it takes Ms Parris no further forward.

13. In her witness statement of 16 May 2019, Ms Parris gives further information about her designs. She states that her first attempt at a thistle brooch was in June 2015, with a second unsuccessful design a few months later. Her final construction of a thistle brooch was first shown on 24 January 2016. She attaches 3 documents – the first is simply a photograph of a thistle brooch, however it is not dated, nor is an explanation given as to which version of the brooch it is meant to be. The second document is a sales invoice for 15 brooches from October 2016. The third document is a certificate showing Ms Parris registering for VAT on 9 February 2015. Whilst the latter two documents in combination show that Ms Parris intended to trade, and subsequently did, the first document is insufficient to prove what was disclosed and when. This evidence does not, therefore, take Ms Parris any further forward.

14. I note that Mr Parris repeats her claim that she has not copied AFU/Ms Juska's designs, and that her design "was made from my own imagination"; she has no memory of ever meeting Ms Juska. I note that Ms Parris highlights that Ms Juska's own evidence (which I come on to) shows that AFU's designs have been used since 2006, before the one-year grace period (as per section 1B(6) of the Act).

15. In Ms Parris' statement of case, there are two aspects of her evidence which might identify relevant prior art for comparison; i) evidence of her first two designs which she describes as being unsuccessful, and ii) evidence of AFU's designs which were put into the public domain before the relevant dates. I will focus initially on i), coming back to ii) shortly. In relation to i), Ms Parris states that her first attempt looked like a carnation and did not sell well and it was therefore removed. The second version was apparently a little better, but customers told her it looked like a lily (not a thistle), but the pin frequently broke and the green (or other colour) wrap would slide away from the top wires. The pages marked B in her statement of case are said to provide evidence of her earlier designs. Her commentary reads:

"META DATA DATE EVIDENCE. From my laptop showing my older design thistle. Although this thistle was on sale from around July 2015 my first uploaded photo I can find on my laptop is dated 9/8/2015 and was taken at an event in Merchant Square Glasgow. Post from Facebook page is also there to back this date up. Another photo uploaded to my laptop is dated 27/8/2015.

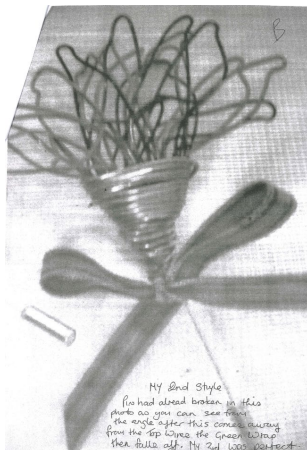
Photo from 19/9/2015 of my stand set up for Scotland's Trade Show at the SECC Glasgow. I do apologise for the blurry image of the close up of the thistle.”

16. The photographs provided in section B of the statement of case are not particularly clear, the same criticism applies to some of the dates said to be depicted. It is also difficult to work out whether the photographs are meant to be design 1 or design 2 (one is marked as design 2). Of the clearer images, I note the following:



17. The file properties show that this photo was taken on 9 August 2015 and Ms Parris states it was taken at an event in Merchant Square, Glasgow. I am prepared to accept this as potentially relevant prior art.

18. I also note:



19. The image above is not dated, and it is difficult to ascertain from the commentary when/where it was disclosed. I do not, therefore, accept this as potentially relevant prior art. None of the other images disclose designs which can be fairly compared to those of AFU.

20. Whilst I note from Ms Juska's evidence that she says Ms Parris' evidence is not clear, she herself provides evidence¹ of something Ms Parris disclosed on 15 July 2015. Given its date, I assume this to be Ms Parris' first design:



21. The above constitutes potentially relevant prior art which I will also take into account.

22. Both parties have referred to disclosures made by Ms Juska/AFU herself/themselves, and their capacity to self-invalidate AFU's designs. There is much discussion about statements made by Ms Juska both as part of these proceedings

¹ This was filed in the context of invalidating Ms Parris' registration, but all of the evidence must be considered when determining the validity of all the designs the subject of this decision.

and part of proceedings at the Sherriff's court in Scotland in relation to when her jewellery items were first sold. Regardless of all this, I am satisfied that there is no statement that the exact same design as those registered by AFU (the subject of these proceedings) have been disclosed in the period more than 12 months before the designs were filed². However, it is clear from the evidence as a whole that some designs have been disclosed by Ms Juska/AFU. I will not depict them all because some are so different to the registered design that a comparison serves no purpose, but I nevertheless note the following:

- Whilst a brochure in Exhibit AJ-1 of Ms Juska's witness statement of 11 March 2019 shows a design very similar to the registered designs, the brochure is said to be used in 2016 (and 2017-2019) and thus it is not clear if the disclosure took place more than one year before the relevant dates of 16 September 2016 and 11 January 2017.
- A brochure in Exhibit AJ-2 is potentially relevant in terms of its date, but it does not disclose something close enough for comparison.
- Various other designs in exhibits AJ12 and 13; whilst some are closer designs (to those the subject of these proceedings), the commentary lacks the required precision to show when/where the designs were disclosed.

23. I have read all the evidence but can find nothing further which advances either sides' case.

Relevant prior art for Ms Parris' registration

24. The relevant prior art here includes AFU's registrations which were filed and published before the relevant date of Ms Parris' registration. The prior art depicted at paragraphs 16 and 20 above are also relevant. Whilst they are things Ms Parris has

² If a disclosure by the proprietor took place in the one year prior to the relevant date, this would be excluded as relevant prior art, as per section 1B(6) of the Act, often viewed as the one year grace period to file a design after first disclosure.

disclosed, the disclosures were more than 12 months before the relevant date and can, therefore, be counted.

The comparisons

25. In relation to AFU's designs, the comparison is between:



and



26. The prior art was disclosed in July and August 2015, respectively. For the purpose of these proceedings, I do not need to consider the claim that Ms Parris' disclosures were copies of something designed by AFU. This is because whilst certain disclosures can be excluded from comparison if they resulted from an abuse of the designer (such as copying), this only applies in the 12 months before the relevant dates; the two pieces of prior art were disclosed more than 12 months before either of the relevant dates at issue (16 September 2016 and 11 January 2017).

27. The informed user is a knowledgeable user of the items at issue, possessing the type of characteristics outlined in the case-law shown in the annex to this decision. In terms of design freedom, whilst a thistle brooch will need to incorporate thistle like characteristics, there is still a reasonable degree of design freedom in terms of how this is carried out. Whilst the parties have provided evidence of their own designs, which potentially form part of the design corpus, much of the evidence lacks specificity in terms of when they were disclosed. Further, there is little by way of evidence showing the designs of other traders in the field. Thus, I cannot place any weight on the designs either standing out from the field or being typical looking designs in the field; this part of the assessment is neutral.

28. In terms of comparison, and focusing on the left hand prior art, both contain the following features:

- i) A stick or pin-like item, with a very similar looking cover covering over the bottom of the pin; on top of which is:
- ii) A basket/woven like feature which is narrower at the bottom than the top; out of which are:
- iii) A number of irregularly shaped extrusions which, overall, form the flower head – the extrusions have a similar height and width (relative to the basket) as each other.
- iv) Both designs also have a tartan bow positioned just below the basket.

29. The main differences are that:

- i) The pin is shorter in the prior art.
- ii) The basket is wider at the top (flares out more) in the prior art compared to the registered design(s).
- iii) The extrusions are slighter looser in the prior art compared to the registered design.
- iv) The basket is green in the prior art, silver in the registered design(s).
- v) The bow's tartan appears darker in the prior art.

30. The difference in pin length is almost immaterial, but in any event such a difference will not play heavily in the informed user's appreciation of the design characteristics of the designs. The differences in basket and extrusions are not immaterial, however, the differences will be seen as quite small and accountable more by way of construction as opposed to having a particularly different design. The colour of the basket/darkness of tartan is not relevant to the registered design which disclaims colour, but even for the other design, will be seen as a minor cosmetic difference. In my view, having regard to the similarities and differences, the informed user will regard these designs, whilst not identical, as having the same overall impression. Consequently, both registered designs are invalid.

31. Strictly speaking, it is not necessary to consider the prior art on the right, however, my view is that this also has the same overall impression to the registered designs, for the reasons I have given, notwithstanding that the extrusions appear to have a looser again construction.

32. In relation to Ms Parris' registered design, the comparison is between:



and



33. Looking at the prior art on the right (ARU's earlier design registration), although the comparison is slightly different to the one already made, the same similarities and differences apply. Notwithstanding the (slight) further differences, such as the extrusions in the registered design being more tightly packed, I come to the same view that the informed user will regard the designs as having the same overall impression. The registered design is invalid. I come to the same view in relation to the other items of prior art, the earlier incarnations of Ms Parris's designs.

Outcome

34. Subject to appeal, all three registered designs are hereby declared invalid.

Costs

35. Both parties claims have succeeded. Therefore, I make no award of costs.

Dated this 19th day of March 2020

Oliver Morris

For the Registrar,

the Comptroller-General

Annex – extracts from *Samsung v Apple* [2012] EWHC 1882 (Pat)

“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; *Shenzhen* 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 the 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 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."

