

# **O-217-20**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER of Registered Designs Nos. 5002463, 5002464,  
6009459 & 5002467 in the name of H&S Alliance Ltd in respect of  
Castor Wheel Designs**

**and**

**APPLICATIONS TO INVALIDATE (Nos. 29-32/18) by GBL UK  
Trading Limited**

## **INTERIM DECISION**

1. This is an appeal from decision O-699-19 dated 18 November 2019 by the Hearing Officer (Mr Oliver Morris) acting for the Registrar of Designs. He allowed an application by GBL UK Trading Ltd to invalidate four registered designs relating to castor wheels. The registered proprietor H&S Alliance Ltd appeals against that decision, in respect of all four of the designs.
2. The proprietor is represented on this appeal by Mr David Harris, chartered patent attorney, of Barker Brettell LLP, while the respondent GBL UK Trading Ltd is represented by its director, Mr Mansour Malik.
3. The hearing of this appeal took place on 3 April 2020. Because of current circumstances it was conducted via video link, rather than in person. The need for this interim decision arises out of the way in which one

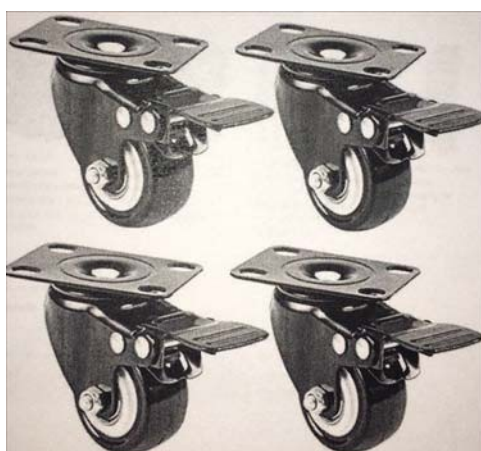
particular question, namely the extent to which a single design registration can protect what is said to be a “set” of articles or items, became increasingly important in the appeal.

### **1. The issue of “sets” on this appeal**

4. I will explain the issue by reference to one of the designs in suit, No. 5002464. Its representations include the following view:-



5. The Hearing Officer held that this design lacked individual character as a result of (inter alia) an item of prior art said to have been disclosed on amazon.co.uk in February 2016. This prior art is illustrated by the following photograph at para 15(vi) of the decision:



6. The Hearing Officer made the following findings with regard to this particular prior art attack:

“27. I note here that the brake is very similar indeed to the brake of the registered design. The other aspects of the design are also very similar. However, a major point taken by Mr Harris was that the prior art comprises only a braked version, whereas the registered design is a set comprising a braked and unbraked version.

28. I have strong reservations as to whether the registered design can be said to be a design, or whether it is actually two designs. That said, as no ground for invalidation is made on this basis, I can say nothing more. However, what I can say is that whilst I agree with Mr Harris that the novelty in the registered design cannot be destroyed by two separate pieces of prior art, one destroying the novelty of the braked version, another the unbraked version, it does not follow that a single braked or unbraked version cannot destroy the novelty in what is effectively some form of composite design. In my view, the informed user will view the registered design as having the same overall impression as the prior art above, the only difference being the inclusion/omission of a largely functional brake. The novelty would, thus, still be destroyed, the overall impression still being the same.”

7. The registered proprietor appeals against this finding. Mr Harris argues that the registered design, which is formally described on the register as a design for a “*Castor wheels set*”, depicts a “set” of two castors, one braked and one unbraked.

8. The way in which Mr Harris puts this point in his appeal skeleton argument is as follows:-

“44. ... [The above] disclosure gives a different overall impression. This Design shows a set of two castors - one braked and one unbraked. As such, whilst there are clearly functional aspects to the difference between braked and unbraked castors, there are also aesthetic differences - notably the presence or lack of a brake pedal.

45. Whilst the Hearing Officer stated that he had reservations whether the Registered Design was a single design, it is settled

practice that a set of components can be the "product" in its own right - see, for example the IPO's Registered Designs Examination Practice guide at paragraph 2.14. The product for this Design is described as a "set" and so it is clear that the protection is for a set of castors.

46. As such, to give the same overall impression, any prior art needs to show at least one braked castor and one unbraked castor; the informed user would recognise the presence or absence of a brake pedal would give a different impression, given that brake pedals can have aesthetic features.

47. As such, the Hearing Officer is incorrect to say that "[it does not follow that] a single braked or unbraked version cannot destroy the novelty [presumably also the individual character] in what is effectively some form of composite design". The Hearing Officer appears not to appreciate the existence of Registered Designs for sets of components and that to anticipate (or infringe) the Registered Design for such a set, there is a need to show the juxtaposition in a set of components that together give the same overall impression as the Registered Design."

## **2. Current Registry practice and historic protection for “sets of articles”**

9. The paragraph relied on by Mr Harris is from Chapter 2 of the IPO's Registered Designs Examination Practice guide, published on 16 March 2017. I will quote the whole of the subsection within which it lies:-

### **Products consisting of multiple components**

2.14 A set of articles can be a 'product' in its own right, and can be represented in a single design application if the articles making up the set are linked by aesthetic and functional complementarity and are, in normal circumstances, sold together as one single product. Examples would include a chess set consisting of a board, pieces and packaging, or a canteen of cutlery consisting of various knives, forks and spoons, which are specifically adapted to store and display its contents.

2.15 An objection will be raised against applications which are not linked. An example of this would be a toy and its packaging. This is because the function of a cardboard box has nothing to do with the

function of the toy. It is just packaging which will usually be thrown away, or recycled, once the toy has been unpacked. In these circumstances, the packaging and the toy cannot be regarded as a single product.

2.16 Amongst the twelve views permitted in the application form, applicants must submit at least one view showing the set of articles in its entirety (see acceptable and unacceptable examples below).



10. The registrability of a “set of articles” is long established under pre-harmonised UK registered designs law. The practice of accepting registrations for sets goes back at least to the Patents, Designs and Trade Marks Act 1883, where there was special provision for sets of articles within the Comptroller’s fees rules, although I cannot find a reference to sets of articles in the statute itself.
11. Section 1(2) of the Registered Designs Act 1949, in its form before it was amended to adopt European harmonised law, explicitly provided that a design could be registered “*in respect of any article, or set of articles, specified in the application.*” That provision was accompanied by a statutory definition of a “*set of articles*” in s.44(1):

“set of articles” means a number of articles of the same general character ordinarily on sale or intended to be used together, to each

of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

12. However, the statutory basis for the registrability of a set of articles under the current European harmonised law is far less clear. The Designs Directive 98/71/EC contains no express reference to sets of articles. The word “article” itself is a term of art under the UK 1949 Act from pre-harmonisation days. It has been effectively replaced by the word “product” in the Directive. The 1949 Act was extensively amended in order to conform UK domestic law with the provisions of the Directive. As part of those changes, the word “article” was systematically replaced with “product”, and the definition which I have quoted above of a “set of articles” in section 44(1) was explicitly repealed.
13. It seems to me that under the terms of the Act as now amended, a design registration can only contain representations of a single “product”. However, it is possible that in some circumstances, a set of physically separate items might be regarded as being a single “product”, as suggested by the IPO Practice Guide quoted above. (I will deliberately avoid the phrase “set of articles” as used in the Guide since the word “article” is freighted with connotations from the pre-harmonised UK law. I will refer to a “set of items”.)
14. The Commission’s 1991 Green Paper on the Legal Protection of Industrial Designs, which preceded the drafting of the Directive, indicates that the Commission was aware of the UK practice of registering a “set of articles”. At para 8.7.2 it deals with the desirability of including a procedure for multiple applications within the new harmonised system, and notes that *“there should be no limitation of the type [of product] resulting*

*from the present UK legislation, where only designs applied to a given set of articles (e.g. cups, dishes and tea-pot of a tea-set) could benefit from a combined deposit.”* It might be argued from this that the appropriate way of registering what were previously “sets of articles” under UK law is to register each item in the set separately but as part of a multiple application. This however would result in each item in the set giving rise to a legally separate registration.

15. The definitions of “product” in Art.1(b) and of “complex product” in Art.1(c) of the Directive are as follows:-

(b) 'product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

(c) 'complex product' means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

16. The above definitions have been reproduced into section 1(3) of the Registered Designs Act 1949 with some rearrangement of and other small changes to the wording.

17. At the hearing, I asked Mr Harris whether he was aware of any judicial or Board of Appeal jurisprudence on the relationship between the definition of “product” and the registrability of a set of items as a single product. Mr Harris was not aware of any such authority but understandably had not researched the issue given that the validity of the four designs in suit had not been formally challenged under this head. He suggested that the practice of the EUIPO regarding the registration of sets of articles was similar to that of the UK IPO.

18. I have looked at this myself after the hearing and indeed it does seem to be EUIPO practice to recognise as valid the registration of a “set of articles”. This practice appears from guidance give to applicants that “*At least one view must show a set of articles or a complex product in its entirety*”, which is accompanied by a picture of a backgammon set.<sup>1</sup>
19. Mr Harris raised another point in support of the registrability of the sets of items which are portrayed in the registrations in issue on this appeal. He pointed to the reference in the definition of “product” to “*parts [plural] intended to be assembled into a complex product*”. He argued that a set of castors would be assembled into a complex product, being the trolley or other item to which the castors will be attached, and that the fact that the word “parts” is plural within the definition is significant. He argued that this revealed a legislative intent to permit the registration of a group of parts for a complex product as a single “product”.

### **3. Procedure to be followed**

20. Para 28 of the Hearing Officer’s decision (quoted above) makes clear that he felt constrained to proceed on the basis that the registration was not invalid on the ground of containing multiple product designs, despite his strong doubts on this point. He then went on to treat it as “*effectively some form of composite design*” when comparing it with the prior art.
21. I feel considerable difficulty in pursuing the same course when dealing with this appeal. The way in which the argument on the appeal has developed has given more salience to the “sets” issue than in the

---

1. <https://www.euipo.europa.eu/ohimportal/en/design-filing-tips-best-practices#18>



proceedings below. The argument which Mr Harris has advanced, set out in his skeleton argument quoted above and developed in his oral submissions, requires me to be clear about the approach I should adopt when comparing a “set” of braked and unbraked castors to an item of prior art showing only castors with brakes. If a registration for such a “set” is valid, it seems to me that proper characterisation of the legal basis on which it is valid is essential in order for me to approach the comparison exercise in the correct way and to judge whether or not the Hearing Officer’s comparison exercise is open to reversal on appeal.

22. At my invitation Mr Malik, who represented the Respondent to the appeal, indicated that he would wish to amend his company’s invalidation applications to raise the “sets” issue as a ground of invalidity, if I were of the view that this would be desirable for the proper handling and resolution of the appeal. I will therefore give permission to the Respondent to make such an amendment to each of its applications for invalidation of the four registered designs in issue, all of which relate to “sets” of castors.
23. Given the late stage at which I have allowed this ground of invalidity to be raised, it is necessary for the registered proprietor to be given a full opportunity to respond to this ground with additional legal submissions, and possibly with further evidence directed to whether and how castor wheels are in practice sold in sets. Mr Harris also suggested -- and I accept -- that I should invite the Office (if it wishes to do so) to make submissions regarding its current practice as set out in the Examination Practice Guide and what it believes to be the legal basis for such practice under the current European harmonised legislation.

#### **4. Further considerations regarding “sets”**

24. Given the course I have decided to adopt, I will refrain from forming any concluded views on issues relating to “sets”. That includes what is the correct way to go about comparing the overall impression of a registered “set” with the prior art. However, I will set out certain points and issues which seem to arise, on the basis that the observations I make below are subject to reconsideration and revision in the light of legal submissions or evidence from the parties or the Office.
25. The evidence in this case was directed to a number of prior art attacks, as well as to a complaint raised by the Respondent about a “take down” notice issued to Amazon by the registered proprietor against one of the Respondent’s product listings. The evidence therefore was not focussed on the issue of “sets” but does cast some incidental light on that issue.
26. There are a number of Amazon listings in the evidence. In addition to showing in each case the product specifically relied upon (whether as alleged prior art or for another purpose), these listings show considerable numbers of other castors offered for sale as “*Sponsored products relating to this item*” or under “*Customers also shopping for*”, or “*What do other customers buy after viewing this item?*” I fully take on board the point forcefully relied upon by Mr Harris as part of another aspect of his appeal that the Amazon listings in the evidence were printed off shortly before the invalidity applications were filed in November 2018, or in some cases later, whereas the filing date of the designs in issue was 22 March 2017 for three of the registrations, and 22 March 2018 for No. 6009459.
27. While it cannot be assumed that these incidentally captured products

were prior art to the designs in suit, in my view they can still be of use in illustrating general usages in the market as regards “sets”, in the absence of any particular reason to suppose that such general usages would have changed over the period between early 2017 and 2018-19.

28. It would appear that the practice of selling castors in sets of four is reasonably common. They are also sold as individual items, although how common this is is not clear from the limited material in the case. It also appears that where braked and unbraked versions are sold within a single set, the designs of the two versions are coordinated, in the sense that the designs are the same or very similar to each other apart from the presence or absence of the brake and its pedal. Mr Harris relied on the fact that this is also the case in the four registered designs in suit, each of which contains a braked and unbraked variant whose designs are coordinated with each other.
29. In the admittedly unscientifically sampled cross section of the market in the evidence, there are many examples of sets of four being sold. Some contain two braked and two unbraked castors, and other sets of four contain either all braked or all unbraked castors. Some castors are sold individually, either braked or unbraked, and there is the odd set of 8 or 10 castors.
30. It is not at all surprising that manufacturers of castor wheels will commonly provide in their range braked and unbraked versions which (apart from the presence or absence of a brake) look similar to each other. Whether or not a brake is needed is a functional requirement relating to the item of furniture to which the castors will be attached. There will be

instances where some but not other castors on the same piece of furniture need brakes. For example, if a cupboard on castors is designed to be regularly used with its back against a wall, one might put brakes on the two front castors which are accessible to the foot, but not on the rear castors. Or a serving trolley might be wheeled into position and have brakes on the side where the serving staff will stand to allow them to lock it in place, with no brakes needed on the customer-facing side. In such instances it would look odd if the braked and unbraked castors were of different design from each other.

31. One possible view is that these are two separate products whose designs are coordinated with each other for understandable reasons, rather than there being a “set” of braked and unbraked castors which is to be regarded as a single product. Each of the registered designs, with the exception of No. 5002463 to which I shall come later, contains a “set” of two, one braked and one unbraked. I have seen nothing in the available evidence which suggests that castors are ever sold in sets of two. There is, as I have already mentioned, evidence that they are sold in sets of four containing two of each variant. But it seems that a customer needing castors for a 4-wheeled trolley will have a choice of sets of all-braked or all-unbraked, or two of each, depending on the customer’s particular functional requirement.
32. In these regards, the “sets” in issue in this case differ from the example of a chess set given in the Practice Guide. Chess sets are generally made and sold as a complete set with a standard array of individual pieces, and the individual pieces are not generally available separately. Whether these differences result in the “sets” in these registered designs not

counting as a single product, assuming that a chess set does, is a matter to be decided.

33. These differences also give rise to possible difficulties in the context of infringement. Mr Harris submitted, as he was bound to since effectively the same “overall impression” test applies to infringement as to comparison with the prior art for validity purposes, that there would be no infringement of the registered designs unless a complete set were sold or offered for sale.

34. This is all very well, but gives rise to serious potential difficulties. What if a website offers castor wheels for sale, allowing the customer to click on “with brake” or “without brake” according to customer choice, so that customers mix and match their own sets as required? And I do not think that I am being unduly cynical in believing that some registered design owners with granted registrations in their hands for such “sets” may not be totally scrupulous in strictly limiting the assertion of the registrations to cases where both variants are being offered together by the same seller.

35. Registered design No. 5002463 raises the “sets” issue in even more acute form. I set out below two of its representations, both described as “standing view”:-



**Standing view**



**Standing view**

36. It can be seen that in addition to showing braked and unbraked variants, this registration shows variants in the attachment mechanisms. In the first picture, the castors have screw threads to be attached to the furniture above by being screwed into a threaded socket. In the second picture, the castors have flat rectangular plates with four holes drilled through them to attach the castor to the furniture above with bolts or screws.

37. In relation to this design, Mr Harris argues that:

“53. ... in order to show a lack of novelty or individual character, the Respondent would need to provide evidence of a set of castors having mounting flanges and mounting threads, and braked and unbraked castors, in order to provide the same overall impression. Whilst in each case these are largely functional features, they do add to the overall impression, and given the Appellant has included them in the representations, clearly some limitation is intended by their presence (especially given that the Appellant also chose to file design 5002464 without the threaded versions).”

38. The fixing means are functional, and also they will be almost out of sight once the castors are assembled into a piece of furniture. Further, both the presence and the shape and dimensions of the screw thread are prima facie dictated by the need to connect the castor mechanically to the

furniture, so giving rise to an exclusion of these features from the scope of registered design right under section 1C(2) of the Act. Whether and to what extent Mr Harris is entitled rely on the difference in appearance of the different fixing means in this “set” compared to the prior art when viewed in the unassembled state gives rise to questions which I shall not attempt to resolve at this stage. This reinforces my view that answering such questions correctly depends upon properly understanding the nature of and legal basis for the subsistence of registered design right in this “set”, if the registration is valid.

39. It seems to me that this design raises additional questions regarding its validity, over and above the questions which apply to the other three registrations which have two-item “sets”. There is nothing in the evidence I have looked at which suggests that anyone is offering for sale a “set” consisting of one each of the four types of castors as shown in this registration. While sets are offered with the flat plate fixings, and sets with a screw thread fixing, I could see no set within which different fixings are offered. Nor is it easy to think of what kind of furniture would give rise to a demand for such a set: the furniture would need to have two screw attachments and two flat plate attachments, with braked and unbraked variants needed for each type of attachment.
40. The observations I have set out in this section are intended to assist the parties (and the Office if it chooses to make submissions) to focus their submissions or evidence on points which seem to me to be of concern. I repeat that nothing I have said in this section amounts to a concluded view.

## **5. Directions given**

41. For the reasons I have explained, I now give the following directions for the further conduct of the appeal:-
- (1) The Respondent has permission to amend each of its four Forms DF19A to add the following additional ground of invalidity: “*Under section 11ZA(1)(a): the registration does not relate to a design for a product as defined in section 1(2) because it contains designs for more than one product.*”
  - (2) The requirement to formally amend and re-lodge the Forms DF19A is dispensed with and they shall stand as if formally amended and re-lodged as of the date of this decision.
  - (3) The UK Intellectual Property Office is invited to make submissions, if it so desires, on Registry practice relating to “sets of articles” as explained in paragraphs 2.14-16 of the Registered Designs Examination Practice guide and on the legal basis for that practice.
42. I am minded to allow the registered proprietor to make legal submissions and (if so advised) to adduce evidence relating to whether the sets of castors shown in the registrations are “*in normal circumstances, sold together as one single product*” (as per para 2.14 of the guide), and to allow the Respondent to respond if it so wishes with submissions and/or evidence. In view of the current COVID-19 emergency I will not at present set a timetable. I would then wish to decide the appeal on the basis of the written materials without involving the parties in the expense of a further hearing if feasible, but this will depend upon the complexity



of any further material which is submitted by the parties or by the Office and the views of the parties.

Martin Howe QC

Appointed Person (Designs Appeals)

8 April 2020