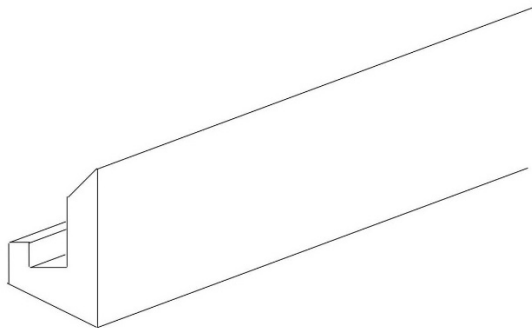


BLO/595/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

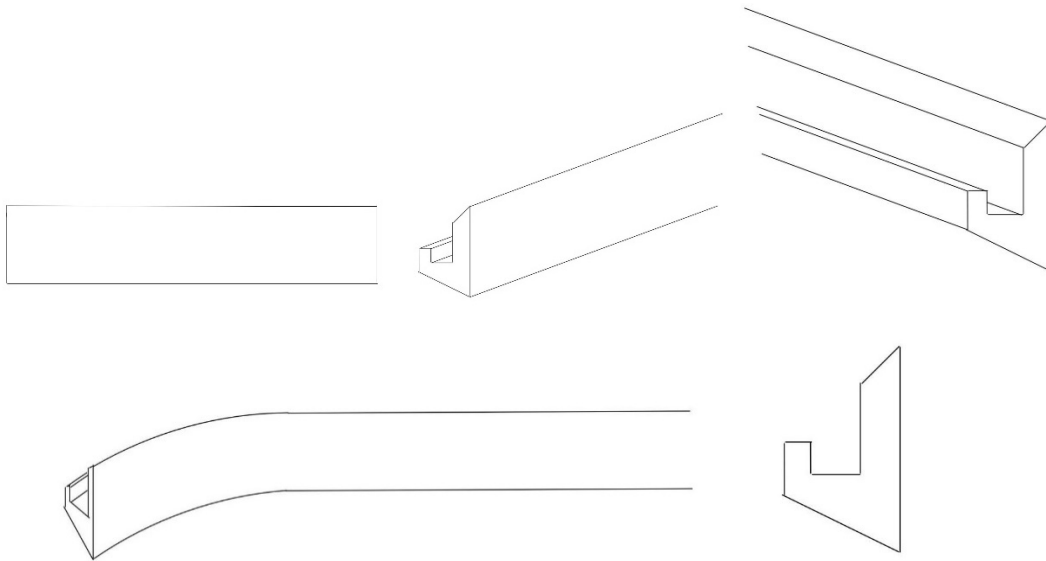
**IN THE MATTER OF REGISTERED DESIGN NO. 6071997
IN THE NAME OF STEVEN PITMAN
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND
A REQUEST TO INVALIDATE (NO. 56/19)
BY RICHARD INGRAM**

Background and pleadings

1. The registered design the subject of these proceedings was filed by Steven Pitman (the proprietor) on 25 September 2019. The registered design is described as a 'Vehicle interior LED enhancement strip'. It includes a disclaimer which reads, 'Article is of indefinite length', and is depicted as follows:



2. On 8 November 2019, Richard Ingram (the applicant) applied for the registration of the design to be declared invalid. The application is based on 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. In this regard, the applicant relies upon its own design registration no. 6048574, which was registered on 19 November 2018. In addition, the applicant relies on section 11ZA(2) of the Act, which concerns ownership of the contested design.

3. Section 11ZA(2) states:

“(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

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

4. The applicant submits (reproduced as written):

“The research and development of my design took many months and at great financial cost, which I sort [sic] protection through the UKIPO, and was awarded certification on 19 November 2018. The proprietor believes he has the right to order and copy my design.”

5. The proprietor filed a counterstatement denying the claims.² He provides the following sequence of events:

- Having noticed that the lighting strips in his car resulted in very dim light, the proprietor purchased LED light strips from the applicant’s company and fitted them to his car.
- He was not satisfied as the strips fell out when the car door was closed firmly.
- He contacted the applicant to explain the problem and suggested some improvements to the design.
- The applicant replied, stating that the design would not be changed and the proprietor could return them if dissatisfied with the product. This he did.
- Following these events, the proprietor decided to design his own lighting strips to solve the dim lighting issue and to create a strip which was fitted securely.

6. The proprietor submits:

“Any suggestion that I simply bought the product from [the applicant] with the intention of copying the design to make my own is complete nonsense and one that I strongly refute.

² The proprietor’s counterstatement also included a response to an invalidation based on technical function. This ground was not claimed by the applicant for invalidation.

You may wish to consider why I would make suggestions to [the applicant] on how to fix the issues with their product if this had been my intent all along?”

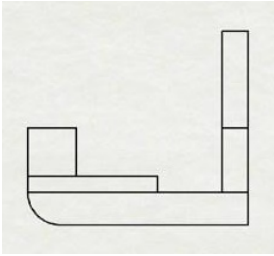
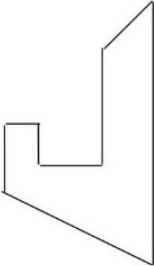
7. With regard to the similarity of the designs, the proprietor has attached two images of the applicant’s product, taken from the UK design register, but these relate to a different design than the one relied on by the applicant, which is 6048574. I will reproduce the proprietor’s comments concerning similarity to the extent that they are relevant to the actual design relied on by the applicant. They are as follows:

“...[the applicant’s] design consists of a simple U shape with one side of the U slightly taller than the other.

There is no further aspect to this shape past the bottom of the U shape design.”

8. The proprietor concludes that his own design consists of a U shape on the top half then past the bottom of the U shape a triangular shape pointing downwards. He submits that it is this triangular shape that he has registered for protection through the IPO.

9. For illustrative purposes, the following two images show the profile of both parties’ designs, described by the proprietor:

The applicant’s design	The proprietor’s design
	

10. Both parties filed documents with their pleadings, to which I will refer below.

Neither party filed evidence in chief. Both sides represent themselves, neither requested a hearing. The decision has been made following a careful assessment of the papers.

Documents filed with the application

11. The applicant filed a number of documents with its Request to Invalidate a Design Registration:

i) An eBay receipt showing that the proprietor purchased an 'Ambient Light Insert Track Mod upgrade' for a BMW on 20 August 2019.

ii) An eBay sales invoice showing sales of the applicant's products between 6 July 2018 and 14 August 2018.

iii) A page which includes two photographs. The first is a picture of the proprietor's design in use and the second is a picture of the applicant's design in use.

iv) A print of the applicant's design no. 6048574.

Documents filed with the counterstatement

12. The proprietor filed:

i) Two images of the applicant's design (but for the wrong design number).

ii) Two images taken from its own design registration.

iii) A print of negative and neutral feedback left for the applicant by its eBay customers. The feedback relates to the product bought by the proprietor from the applicant.

Decision

13. 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)...”

14. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*³. The most relevant parts are as follows (the quotation is lengthy):

³ [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; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59)."

"Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

"design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive)."

Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

"as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements 'that are totally banal and common to all examples of the type of product in issue' and will concentrate on features 'that are arbitrary or different from the norm'."

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely

accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

53. The exercise must start with identifying the informed user and the existing design corpus. The overall impression is something produced on the informed user. 54. Although the outcome depends on overall impression, as a practical matter the design must be broken down into features. Each feature needs to be considered in order to give it appropriate significance or weight. Each feature needs to be considered in three respects. A feature dictated solely by function is to be disregarded. As long as it is not disregarded, each feature must be considered against the design corpus and it must be considered from the point of view of design freedom.”

“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.”

15. As can be seen from paragraph 58 above, the Act requires a design to be both new and to have individual character. A design will fail the newness test if it is identical to a previous design, or one differing only in immaterial differences. Consequently, a design may be new because it differs in material details compared to previous designs but may still fail to create a different overall impression compared to previous designs and therefore to lack the necessary individual character.

The relevant date

16. The relevant date is the application date for the contested design, which is 25 September 2019.

The prior art

17. The prior art relied on in this case is the applicant’s ‘ambient light insert 3 Series 1 piece’ which is the subject of a design registered on 19 November 2018 and first sold via the applicant’s eBay account. Documents attached to the application include eBay receipts dated from 6 July 2018 (fourteen months before the contested design was registered). This has not been challenged by the proprietor who confirms that he purchased the applicant’s design via eBay on 20 August 2019 (a month before his own design was registered).

Does the contested design have novelty and individual character?

18. According to section 1B(2) of the Act, a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,⁴ HHJ Melissa Clarke, sitting as a Judge of the High Court, said, at paragraph 26:

“Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”

19. Section 1B(3) states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. In *Ball Beverage Packaging Europe Ltd v EUIPO*,⁵ the General Court (GC) said:

“78...According to the case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (judgments of 7 November 2013, *Budziewska v OHIM – Puma (Bounding feline)*, T-666/11, not published, EU:T:2013:584, paragraph 29, and of 29 October 2015, *Roca Sanitario v OHIM – Villeroy & Boch (Single control handle faucet)*, T-334/14, not published, EU:T:2015:817, paragraph 16).”

⁴ [2019] EWHC 3149 (IPEC)

⁵ Case T-9/15

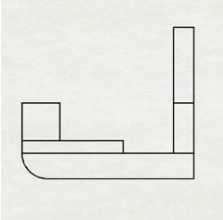
20. Before I consider the competing designs, I find it necessary to clarify the comparison which must be made. This is because the third document attached to the application is a photograph of the parties' designs in use which the applicant files with a view to showing the similarity of the designs attached to the interior of a car door.

21. However, it is important to note that it is the representations of the designs that show what is protected. In *Magmatic Ltd v PMS International Ltd*,⁶ Lord Neuberger (with whom the rest of the Supreme Court agreed) held that:

“30...As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, '[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs'. So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.”

22. In *Procter & Gamble Company v Reckitt Benckiser (UK) Limited*,⁷ the Court of Appeal determined that, where the representations were black-line-on-white illustrations showing a plain undecorated spray can, the registration was 'evidently' for shape and that a comparison should be limited to the respective shapes only.⁸

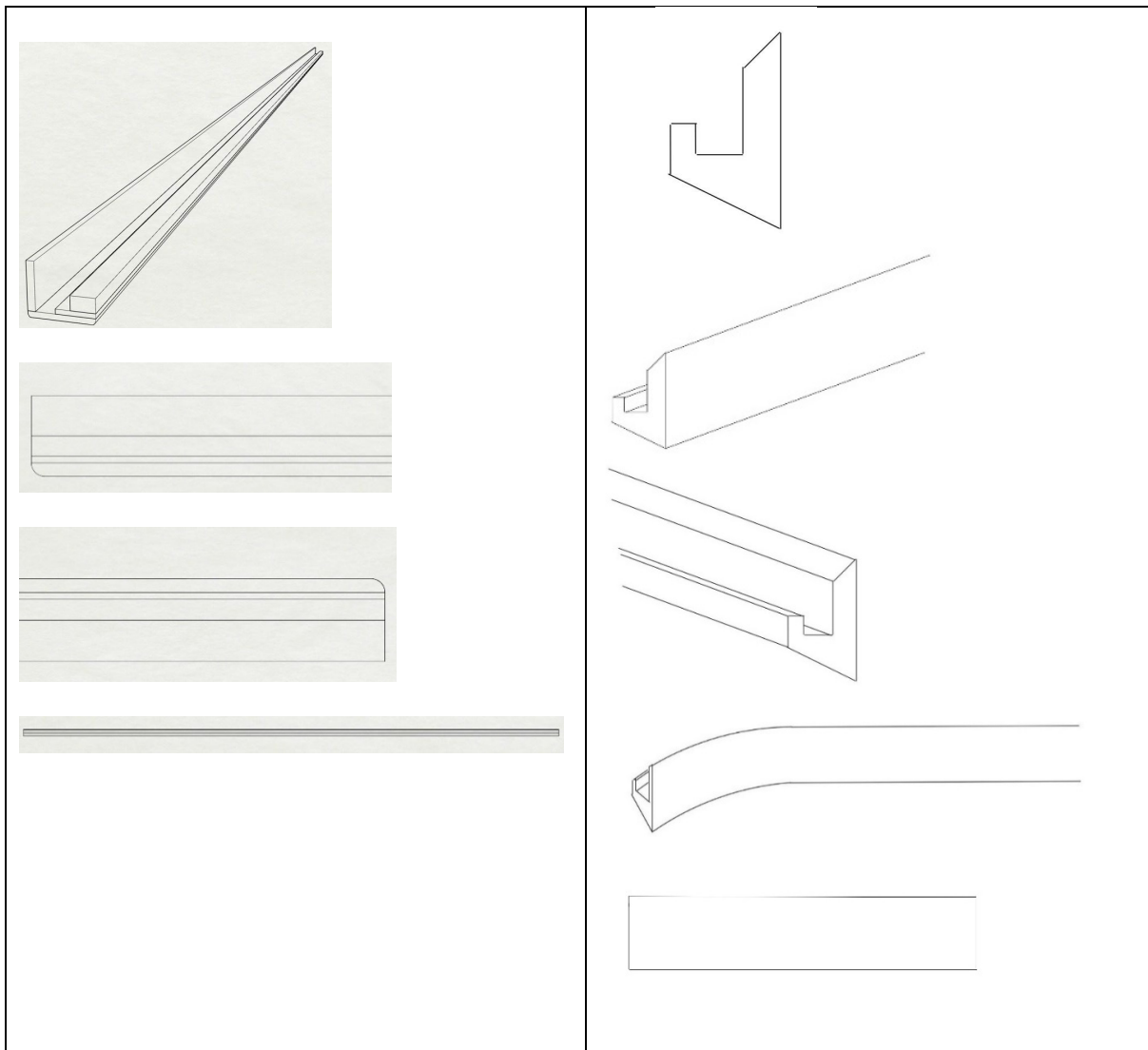
23. The competing designs are as follows:

The applicant's earlier design	The proprietor's registered design
	

⁶ [2016] UKCS 12

⁷ [2007] EWCA Civ 936

⁸ Paragraph 40.



24. The designs are similar in the following ways:

- Both designs take the form of long strips. Each of the side elevations of the proprietor's design is shown without the side view concluding at a particular length. The 'length' of the design has been disclaimed. However, both parties' designs will be long and fairly slim as this is the necessary shape to cover the interior car lights for which the product is designed.
- Both are described by the proprietor as U shapes with the left side shorter than the right. I find this a little simplistic, given the number of elements which make up the profile in the applicant's design, but I will include it here as an area of similarity.

- In profile, the left elevated part of both designs could be considered to be a square.

25. There are a number of differences between the designs:

- The applicant's design is straight along the entire length. The proprietor's design is curved at one end.
- The right elevated side of the proprietor's design is thicker than the applicant's and ends in a point, while the applicant's is flat at the top of the right side.
- The bottom edge of the applicant's design is flat with a short curve up on the left side. The bottom of the profile view of the proprietor's design is angled at approximately 35 degrees, giving the proprietor's design a more angled appearance overall.
- The applicant's design appears to be created from an L shaped strip with a thin flat strip and a deeper, narrower strip added to the flat side to create the overall shape. The proprietor's design appears to be made from a single piece of material.

26. The differences between these designs are not immaterial. In particular, the fact that one is straight and the other is curved at one end makes a significant contribution to the overall impression of the products, as does the use of sharper angles, resulting in a different overall profile in the contested design. I find that the existence of the earlier design does not defeat the contested design's claim to novelty and I will go on to consider the question of individual character.

27. Individual character must be assessed through the eyes of the informed user. The informed user of the designs at issue in this case is a person who uses and is familiar with car accessories and modifications. The informed user is not an 'average' consumer but is someone who will have an interest in such goods. However, they will not examine the design with forensic attention to detail.

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

29. In terms of design freedom, there are some restrictions when one considers the practical elements of the design. The designs are purchased to cover a line of LED lights in a car door panel. On that basis they must be long enough to cover the lights and must include a way of attaching the strip to the car door. However, there are a number of design variations possible which will satisfy these requirements. Overall, there is a reasonable degree of design freedom.

30. That said, the overall length of the product is disclaimed in the contested registration and plays a limited role in the overall impression of these designs. The design freedom rests in the overall profile of the designs and in this regard, there are clear differences between them. The contested design is angled along the bottom edge, creating a slanting profile which has a triangular appearance. The applicant's design has a profile which gives the impression of an 'L' shape, with a flat base and a curve at the bottom left corner. In addition, the applicant's design is straight while the proprietor's is clearly curved at one end. Overall, I find that the similarities between these designs would be outweighed by the differences.

31. Consequently, I find that the proprietor's design did have individual character in comparison with the applicant's registration no. 6048574 at the date on which it was applied for and shall remain on the register.

Ownership of the Registered Design

32. Section 11ZA(2) of the Act states that:

“The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

33. Section 2 of the Act deals with the proprietorship of designs and states as follows:

“(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1A) [...]

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the ‘author’ of a design means the person who creates it.

(4) In the case of a design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made shall be taken to be the author.”

34. The applicant must therefore show that it has created the design. The basis for the applicant’s claim in this regard is that it had registered the design on 19 November 2018 under registration no. 6048574. This is not a case of a dispute concerning ownership of the contested design. The applicant’s case appears to be based upon the proposition that the contested design is the same as (or very similar to) his own design. That is a claim that should be brought under section 1B as already it has been, above. It is not a claim that fundamentally relates to ownership.

35. I note that there is some degree of prior contact between the parties to the extent that the proprietor of the contested design purchased one of the applicant’s designs before filing his own registration. This is not denied. The proprietor was unhappy with the product he received and gave feedback to the applicant. In addition, he suggested

modifications to the applicant's product. In response, the proprietor was given a refund and his suggested changes were refused. Consequently, he decided to embark upon his own design which he subsequently registered.

36. Given that I have found that the designs differ in their overall impressions, I cannot find that the applicant is the owner of the contested design held by the proprietor and this ground must fail.

CONCLUSION

37. The invalidation against this design has failed under section 1B and 11ZA(2) of the Act.

COSTS

38. The proprietor has been successful and is, in principle, entitled to a contribution towards his costs. As the proprietor is unrepresented, at the conclusion of the evidence rounds the Tribunal invited him, in the official letter dated 10 August 2020, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the cancellation application; it was made clear to the proprietor that if the pro-forma was not completed then no costs will be awarded. The proprietor did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 26th day of November 2020

Al Skilton

For the Registrar,

The Comptroller-General