

O/652/21

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN 6072654

IN THE NAME OF HENRY SEDGWICK

AND

APPLICATION FOR INVALIDATION (NO. 13/20)

BY MATAS PRANCKEVICIUS

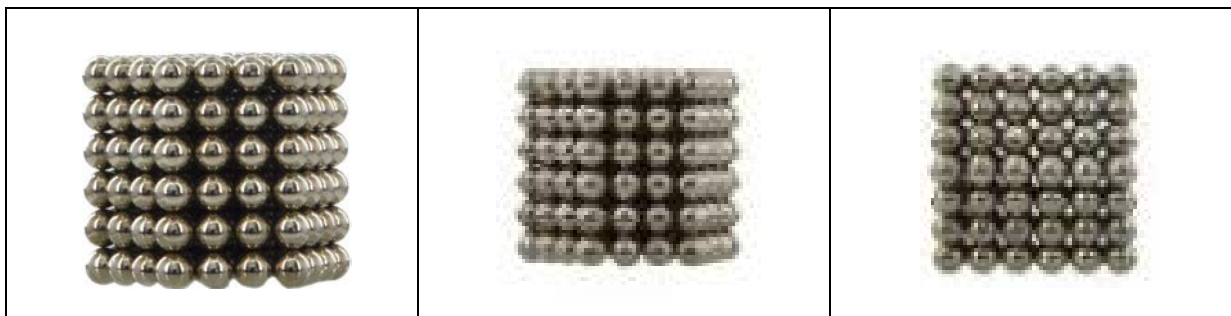
Background and pleadings

1. Henry Sedgwick (“**the proprietor**”) filed application no. 6072654 for a registered design for “3D Multi-colour Magnetic Balls” in Class 21, Sub class 01 of the Locarno Classification (Games and Toys) on 3 October 2019. The design was registered with effect from that date and is depicted in the following representation, which is the only view filed:



2. The registration of this design entails no disclaimer.
3. On 11 March 2020, Matas Pranckevicius (“**the applicant**”) applied for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“**the Act**”), on the grounds that the design did not fulfil the requirements of section 1B of the Act, as it was not new nor did it have individual character compared to other designs that had been made available to the public before the application date of the challenged design.
4. The applicant claims that the challenged design does not differ “substantially” from UK-registered design no. 6072154, which has the earlier application and registration date of 27 September 2019 (“**the earlier registered design**”), and which is owned by Khaleesi Ltd. The earlier registered design is described in the register as “puzzle games” – again registered in Class 21, Sub class 01 of the Locarno Classification (Games and Toys). The register shows six illustrations of the earlier registered design, as shown here:





5. The earlier registered design entails the following disclaimer: “no claim is made for the colour and material shown”. (I explain the significance of this disclaimer later.)
6. On 17 May 2019, the proprietor filed a counterstatement to the application for invalidation, denying the applicant’s claims. In particular, it states that a clear distinction between the designs is the “look” of the designs, since the magnetic balls in the challenged design “are clearly multicoloured and fall within the scope of a distinct, distinguishable design ...”. It concludes that as such, the proprietor believes that the applicant’s is unfounded and that the proprietor’s design “is entirely unique in one clear aspect which warrants its own [UK design registration].”
7. Neither side filed evidence or submissions during the evidence rounds. Neither side requested a hearing and I have taken this decision after a careful consideration of the papers before me. Neither party engaged professional legal representation.

Decision

8. The following pages set out relevant provisions under the Act and extracts from case law, which together provide the context in which to determine the validity of the challenged registered design.
9. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid –

...

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act”.
10. Section 1B of the Act is as follows:

“(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 or no 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 account.

(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 conditions 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 period of 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) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above ‘normal use’ means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

What prior art was available to the public at the relevant date?

11. I shall first consider what, if any, prior art the applicant may rely upon. According to the provisions of section 1B(5) of the Act, the prior art must have been made available to the public before the date of application for the challenged design “**the relevant date**” (here 3 October 2019), and its disclosure must not fall within one of the exceptions set out in section 1B(6) of the Act.
12. As I stated earlier, no evidence was filed during the evidence rounds. The only matter of evidence is therefore what may legitimately be taken from the content of the applicant’s statement of case. The Form DF19A (the application to invalidate a design registration) includes a box (box 7) requiring a declaration by the applicant for invalidation (or by its agent) that they believe the facts in the statement of case are true. The applicant in the present case provided his signature to that end.¹ The significance of a signed statement of truth is that it is enough to satisfy the formality requirements for filed materials to be considered evidence in these proceedings. Moreover, the truthfulness of the *factual*

¹ The signature in fact appeared in the below - box 8, rather than 7 – but the intention is clear.

content of the statement of case is not in issue as it essentially simply flags up an earlier design registration, which is a matter of official public record.

13. The Form DF19A, reflecting the wording of section 1B(5) of the Act, highlights that a design has been “made available to the public” if (subject to certain exceptions) it has been published (whether following registration or otherwise). The rubric in the form states that “publication in the Design Journal counts as being made available to the public.”
14. I must consider therefore, whether the earlier registered design cited by the applicant, filed on 27 September 2019 (which was a Friday), may be considered to have been “made available to the public” before the relevant date in this case, namely, the following Thursday (3 October 2019). Clearly, the application for the cited earlier design was filed six days before the application for the challenged design registration; it is also the case that under section 3C of the Act the earlier design has registered protection as of the date on which it was applied for. However, it does not follow that the act of filing an application for a registered design equates to making that design available to the public. It is making it available to a small team of staff at the registry and more centrally, it is doing so in circumstances engaging conditions of confidentiality (whether express or implied) and is therefore an exempted disclosure under section 1(B)(6)(b) of the Act.
15. Applications as such are not published in the designs journal – rather it is only those applications that have been examined by a member of the small group of registry staff, and have been found acceptable, that are then processed for inclusion in the public-facing online designs journal. Since the applications for the two respective designs in this case are separated by only six days (two days of which were non-working days) it is quite possible that the earlier application would not have been examined and fully processed before the relevant date. In that case, it would not in fact have appeared on the public-facing website – been “made available to the public” – before the relevant date. As such, it would not be considered as prior art. In the absence of evidence of any prior art, there can be no prospect of success for a cancellation application based on a claim that a challenged design is not new or possessed of individual character.
16. The filed DF19A includes no evidence as to when the earlier registered design in fact first appeared in the designs journal. I have looked at what is currently viewable on the website, but this does not assist in revealing on what date the earlier registered design

actually first presented on that site.² This is because the site/designs journal shows its entries by registration date – not truly the date of publication. In other words, the publication date appears backdated to correspond to the application date. Through enquiries with the designs caseworker who processed the earlier registered design and of the IT system to which the designs team have access, I have been able to determine that the application for the earlier design in this case was dealt with on 2 October 2019. It would typically have been uploaded automatically overnight; as such it may have appeared on the designs journal website on – though not necessarily “before” the relevant date (as is required by section 1B(5) of the Act). Nonetheless, while the matter is not straightforwardly clear, I am prepared to proceed on the basis that the earlier registered design, by publication in the designs journal, had (just) been made available to the public before the relevant date and therefore constitutes prior art.

17. Proceeding on that premise, the evidence in this case therefore extends to what information may be gleaned from the publicly accessible official UK register of designs based on the cited reference to the earlier registered design. I must decide whether the challenged design has the required novelty and individual character when compared with that disclosure.
18. The relevant case law was conveniently set out by HHJ Birss (as he then was) in paragraphs 31 to 59 of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc.* [2012] EWHC 1882 (Pat). I have reproduced the most relevant parts below:

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 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:

² The earlier registered design is listed at this link: registered-design.service.gov.uk/view/2019/9/66/572.
Page 7 of 13

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 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.”

Application of the above case-law principles in this case

Informed user

19. The challenged design is described as “3D Multi-colour Magnetic Balls”, classed under Games and Toys (in common with the earlier registered design, which is described simply as “puzzle games”). The informed user of the challenged design is, therefore, a person who uses games and toys and takes a particular interest in their features. They may also be a parent, relative or carer who chooses and buys games and toys to give to children.

Design freedom

20. The nature of the product, being a toy comprised of magnetic balls, is that it may be variously reconfigured. Nonetheless, the designer has some freedom in terms of the shape of the product presented to the informed user, and here both designs are shown as hexagonal stacks. Hexagonal 3D products inevitably require identity in the length of each of the six face sides of the design, but there is no necessity that the designs be hexagons at all. The shape of the components – magnetic balls – specified in the challenged design must necessarily be spherical. However, there is design freedom as to the number and size of these components. The designer may also choose to include surface decoration, and the challenged design involves balls of six different colours. The earlier registered design disclaims the colour and material shown in its illustrations.



The design corpus

21. Beyond the six illustrations filed with the earlier registered design, which are shown at paragraph 4 above, no other evidence of the design corpus has been provided. It is, therefore, difficult to make an assessment of the degree to which the features of these designs may be common in the design corpus - how far the designs stand out from other

products in the public domain at the relevant date. Consequently, the design corpus can play no significant role in this decision.

Comparison of the designs

22. The table below shows the registered designs side-by-side:

The challenged design	The earlier registered design (the prior art)
	

23. Both designs are made up of spheres, layered in 3 concentric hexagons, the larger outer hexagonal frame featuring 4 balls to each side of the hexagon. Each layer involves 36 spheres in the hexagonal face and there are six layers. The total number of component balls thus appears to be the same (216). It is difficult to be confident as to scale, but the size of the component balls appears to be same in both designs. To the extent that I have so far described the products in this paragraph, the designs may be considered identical.

24. The Supreme Court confirmed in *Magmatic Limited v PMS International Limited* [2016] UKSC 12, that an applicant for a design may – within broad limits – submit any images they choose to represent the design, and it will almost always be those images that determine the scope of the protection. So what then is the significance of the colouring readily apparent in this instance? The challenged registered design is described as multi-coloured and is shown to comprise hexagonal layers of balls that are orange, red, yellow, green, blue and purple. In contrast, in the earlier registered design, the balls appear uniform in colour - likely metallic grey or silver, although the colour is not obvious. However, the registration of the earlier design expressly limits the scope of its protection by disclaiming any colour features or material. Rule 6 of the Registered Designs Rules 2006 (SI 2006/1975) provides that:

“An application for the registration of a design may be accompanied by a disclaimer which –

(a) limits the scope or extent of protection being applied for in relation to the design; or

(b) ...”

25. Since, in the present case, the colour aspect of the earlier registered design is disclaimed, along with the (apparently shiny) material shown in the design illustrations, I must disregard whatever the particular colour shown in the illustrations of the earlier registered design – or, for that matter, in the challenged design registration. The protection afforded to the earlier registered design is limited to its shape and configuration.³ Consequently, although the colourful aspects of the challenged design registration are obvious, the comparison task in these proceedings is confined to the shape and configuration of the design. In line with my findings at paragraph 23 above, I find that the respective designs are identical (or that their features differ only in immaterial details). In these circumstances, the challenged design lacks novelty and as such fails to satisfy the requirements of section 1B(1) of the Act.
26. For completeness, I also note the other requisite of section 1B(1) of the Act that a design must have individual character. Assessing whether the challenged design has individual character, must take account of the factors considered above - the informed user, the degree of design freedom and the design corpus - as well as an analysis of the overall impression of the designs. Since there is, in this case, no evidence at all of the design corpus beyond the single earlier design registration, the disclaimer attaching to the earlier registered design is once again key. The protection claimed by the earlier registered design is limited to its shape and configuration, and the colour and material play no role in the assessment. Comparing only the shape and configuration aspects of the challenged registration, the overall impression produced on the informed user will be the same. The challenged design for “3D Multi-colour Magnetic Balls” entails aspects of design freedom in the shape and configuration – for instance, as noted previously, there is no necessity that the design entail hexagons at all. On the evidence before me, the challenged design, which is identical to the shape and configuration of the earlier registered design, cannot be said to have individual character and thus again fails to fulfil the requirements of section 1B of the Act.

3 The point is well illustrated in the guidance on disclaimers on the design registry website, where it gives the example “You want to register a design for a bike. The bike in your illustrations is pink. Add a line explaining you’re registering the shape of the bike, not the colour, to protect your right to use any colour.”

27. **Outcome:** The application for invalidation of registered design no. 6072654 succeeds under section 11ZA(1)(b) of the Act.

Costs

28. Neither party completed and returned a pro-forma requesting costs.⁴ The Applicant is nonetheless entitled to recoup the cost of his payment of the official fee for filing the Form DF19A Request to invalidate a design registration. I therefore order Henry Sedgwick to pay Matas Pranckevicius the sum of £48. This sum is to be paid within 21 days of the expiry of the appeal period, or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 8th day of September 2021

Matthew Williams

For the Registrar,

The Comptroller-General

4 A letter from the registry sent on 20 May 2021 informed the parties of this requirement.