

O/0251/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6151532

**IN THE NAME OF LANXI YICHAO ELECTRONIC BUSINESS
COMPANY LIMITED**

IN RESPECT OF THE FOLLOWING DESIGN



AND

**AN APPLICATION FOR INVALIDATION (NO 77/21)
BY LIMAR TRADING LIMITED**

Background and pleadings

1. Lanxi Yichao Electronic Business Company Limited (“the proprietor”) filed application no.6151532 for a registered design for a folding table in Class 06, Sub class 03 of the Locarno Classification (Furnishing/Tables and Similar Furniture) on 30 July 2021. It was registered with effect from that date and is depicted in the following representations:



2. The following disclaimers were entered on the register: *“No claim is made for the colour shown; no claim is made for the material shown.”*

3. On 22 September 2021, Limar Trading Limited (“the applicant”) made applications 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 satisfy the requirements of section 1B of the Act that a design should be new and have individual character compared to the following design that was made available to the public on the Amazon marketplace in December 2015:



4. The proprietor filed a counterstatement to the application for invalidation, in which it denied the applicant’s claims.

5. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Wilson Gunn LLP and the registered proprietor is unrepresented.

Evidence and Submissions

6. The applicant filed evidence in the form of a witness statement from Andrew Marsden, a Chartered Trade Mark Attorney with the applicant’s representative, Wilson Gunn LLP. It is dated 14 April 2022 and is a vehicle for exhibiting the results of a search carried out by Mr Marsden on the Amazon UK website. The applicant also filed brief written submissions on the same day.

7. The proprietor filed written submissions on 15 July 2022.

Decision

Legislation

8. 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”.

9. 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 geographical area comprising the United Kingdom and 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.”

Prior Art

10. The alleged prior art is described on the Amazon printout as “Marko Outdoor 4FT Folding Portable Camping Table Party BBQ Parasol Hole” and was first available on 24 December 2015. The printout also shows 8 reviews of the product by UK users from 11 September 2018 to 11 July 2021.¹

11. In *Senz Technologies BV v OHIM*, Joined cases T-22/13 and T-23/13, the General Court (“GC”) held that “A design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure.”² I accept the Amazon print out as proof of disclosure, and the proprietor has not claimed that

¹ Exhibit AM1.

² Paragraph 26.

any of the exceptions set out in section 1B(6) apply. Consequently, I find that this design is disclosed prior art.

Novelty

12. Section 1B(2) of the Act states that 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* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

“‘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.”³

Comparison of the designs

13. I show below the main illustration for the registered design alongside the prior art upon which the applicant may rely. Further representations are shown in paragraph 1 above and I shall keep them in mind during my comparison. As no claim is made for the colour or the material used in the design, I shall ignore these features in the prior art.

³ Paragraph 26.



14. The features of the registered design are as follows:

- a) a smooth, one-piece rectangular table top with rounded corners;
- b) the edge of the table top is surrounded by a rim which folds over the surface of the table top;
- c) in the centre of the narrow edges of the table top there are two holes;
- d) in the centre of one of the longer edges is a handle;
- e) the handle appears to be of three parts, with the larger central part having finger shaped indentations on the side nearest to the table. It is clear to me that this part can be pulled out to enable the product to be carried;
- f) the table has a tubular leg at each of the corners;
- g) each leg separates into two parts;
- h) at the bottom of the top part there is a ring surrounding the leg;
- i) the detachable bottom part has a round covering on the part that would touch the floor;
- j) the top of the bottom piece is slightly narrower to allow it to be inserted into the upper leg;
- k) the top part of each leg is attached by a straight hinge to the long sides of the table;
- l) on the short sides of the table, the top parts of the legs are joined by a shallow U-shaped tube;

- m) the upper parts of the legs can be folded under the table top; and
- n) under the table top there are clips in which the lower legs may be stored.

15. The features of the prior art are as follows:

- a) a smooth, two-piece rectangular table top with rounded corners;
- b) there is what appears to be a hole in the centre of the split between the two halves of the table top. This can be seen in the magnification below and is also remarked upon by one of the reviewers of the product;



- c) in the centre of one of the longer edges is a handle. In the image above, it can be seen that this consists of a strip attached to what appears to be a rectangular plate, with a half-oval extending below the table top;
- d) slender legs at each corner of the table;
- e) the legs have a ring at just under half the way up, so it is possible that they may be separated;
- f) a round piece on the bottom of each leg. I cannot tell whether this is wider or narrower than the leg itself;
- g) the top part of each leg is attached by a straight hinge to the long sides of the table;
- h) on the short sides of the table, the legs are joined at the bottom by a vertical piece that appears to be a very shallow U shape;
- i) there is also a square that appears to be on one of the short sides of the table and is shown in the magnification below. This suggests that there is a panel between the legs on that side of the table. I note that the thumbnails reproduced below also give this impression.



16. It will also be seen that the proportions of the tables are different, with the prior art being longer in relation to its width than the contested design. This, the two-piece construction of the prior art and the side piece discussed in (i) above, are more than minor and trivial differences, and so I find that the contested design has novelty when compared with the prior art.

Individual Character

17. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user's awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer's degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

(a) the sector in question,

(b) the designer's degree of freedom, and

(c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

18. I also bear in mind the comments of HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“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.”⁴

The informed user

19. Earlier in the same decision, the judge gave the following description of the informed user:

“33. ... 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:

⁴ Paragraph 58.

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)."

20. The informed user is a member of the public who uses folding tables for a variety of different purposes, but will be interested in their appearance as well as their functional attributes.

The design corpus

21. Although the applicant's evidence contains images of other folding tables that can be bought on the Amazon website, it is not clear whether these were available to the

public before the relevant date. I therefore have no evidence to show me the design corpus at this date.

Design freedom

22. In *Dyson Ltd v Vax Ltd*, [2010] FSR 39, Arnold J (as he was then) stated that:

“... 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).”⁵

23. Given the uses to which a folding table is put, it will need a top and legs, and features, such as hinges, that allow the table to be folded. The configuration of the table support should not impede this objective. In my view, this is likely to mean that the table will have legs rather than a central pillar. I also consider it likely that there will be a mechanism for carrying the table to where it is to be used. That said, the designer has some freedom to decide the proportions and size of the table and whether the table top consists of a single or multiple pieces.

Overall impression

24. I have already listed the features of each of the respective designs. In my view, the proportions of the table make a significant contribution to the overall impressions of both designs, as does the end panel in the prior design. I find that the contested design has individual character over the prior art.

Conclusions

25. The application for invalidation has failed and the design will remain registered.

⁵ Paragraph 34.

Costs

26. The proprietor has been successful and is entitled to a contribution towards the costs of the proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice 2/2016. As the proprietor is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a proforma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the defence of the action. It was made clear to the proprietor that if the proforma was not completed, no costs other than official fees arising from the action and paid by the successful party would be awarded.

27. The proprietor did not respond to that invitation. As it has not incurred any official fees in defending its design registration, I make no order as to costs.

Dated this 7th day of March 2023

Clare Boucher

For the Registrar,

The Comptroller-General