

O/0257/23

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6132690

IN THE NAME OF

LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED

AND

AN APPLICATION FOR INVALIDATION UNDER NO. 85/21

BY LIMAR TRADING LIMITED

Background and pleadings

1. Registered design number 6132690 was filed on 23 April 2021 in the name of Lanxi Yichao Electronic Business Company Limited (“the proprietor”) and was registered with effect from the same date. The design consists of seven illustrations but the main features can be seen in these drawings:



2. The design is described as a “back massager” and is registered as “pharmaceutical and cosmetic products, toilet articles and apparatus”, specifically “toilet articles and beauty parlour equipment” (i.e. class 28, sub-class 3 of the Locarno classification). The registration includes the disclaimer “no claim is made for the colour shown; no claim is made for the material shown”.

3. On 23 September 2021, Limar Trading Limited (“the applicant”) applied for the registration of the design to be declared invalid. It claims that the contested design lacks novelty and individual character and should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that the contested design did not fulfil the requirements of s. 1B. The applicant claims that the same or a similar design has appeared for sale on a website in the UK since February 2019.

4. The proprietor filed a counterstatement denying the grounds for invalidation. It says that the registered design is different from the prior art. In particular, it says that the “needle density” is different and that the “gears” are designed differently.

5. Both parties filed evidence during the evidence rounds. However, the proprietor’s evidence was not in proper evidential format and, as the proprietor chose not to amend it, was admitted as submissions only. The proprietor’s “evidence” simply repeats the submissions made in the counterstatement.

6. Neither party requested a hearing, nor did they file written submissions in lieu. This decision is made following a careful reading of the papers.

7. The applicant is represented by Wilson Gunn. The proprietor is not professionally represented.

Evidence

Applicant’s evidence

8. This consists of the witness statement of Andrew Marsden, a Chartered Trade mark attorney with the applicant’s professional representatives. Mr Marsden’s evidence consists of a single exhibit containing a print of a web page on www.amazon.co.uk.¹ The print shows the following images:



9. Although the web page was printed on 14 April 2022, it states that the product was first available on 20 February 2019. The product description explains that it is adjustable and that there are three levels.

¹ Exhibit AM1.

10. The earliest UK review for the product was posted on 7 October 2020. There are several references in the reviews to the adjustable arch. The following photographs are shown in the reviews, though the images are not dated:



11. That concludes my summary of the evidence, to the extent I consider necessary.

Decision

12. Section 1(2) of the Act is as follows:

“In this Act ‘design’ means the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.”

13. 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.”

14. Section 1B of the Act, so far as is relevant, reads 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) [...]

(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) [...]

(9) [...].”

15. Section 1C(1) of the Act is as follows:

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.”

Novelty and individual character

16. A design will be new if no other design differing in only “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:

“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.”

17. A design may be “new” but still lack the necessary individual character compared to the prior art. The following guidance was set out by HHJ Birss (as he then was) at [31] to [59] of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc* [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* [*Dyson Ltd v Vax Ltd*, [2010] FSR 39] 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. [...] 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.”

18. In *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat), HHJ Hacon, sitting as a judge of the High Court, set out a six-step approach to the assessment of whether a design has individual character. It is as follows:

“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.”

19. The relevant date for the assessment is the date of application of the contested design, namely 23 April 2021.

20. I am satisfied that the product shown in the applicant’s evidence was available on www.amazon.co.uk from 20 February 2019 and that, consequently, it qualifies as prior art. The images shown among the reviews and reproduced at paragraph 10, above, are not dated but as they all relate to the same product, and there is no evidence that the design of the product has changed over time, my view is that these images may be taken into account to determine the features of the prior art.

21. There are some additional products shown in the applicant’s evidence. However, there is no indication whether these products were made available to the public before the relevant date. They cannot be considered prior art. There is no other evidence relating to the design corpus at the relevant date.

The sector concerned

22. I have no submissions from the parties on the sector concerned. The design is a back massager. The sector therefore appears to be massage equipment.

The informed user

23. The product in question appears to be an aid for stretching a user's back and a product of a type which is freely available to ordinary members of the public, who are the end users. The relevant informed user is therefore a member of the general public who is a user of massage equipment. Such an informed user is deemed to pay a relatively high degree (but not the highest degree) of attention when using the product.

24. The only evidence about the exposure of the informed user to the prior art is that the product has 1,883 ratings on the www.amazon.co.uk print. The informed user is therefore only likely to have had limited exposure to the prior art. However, there do not appear to be any special circumstances which would mean that the informed user does not conduct a direct comparison of the designs, or that more extensive knowledge of the prior art would affect that comparison.

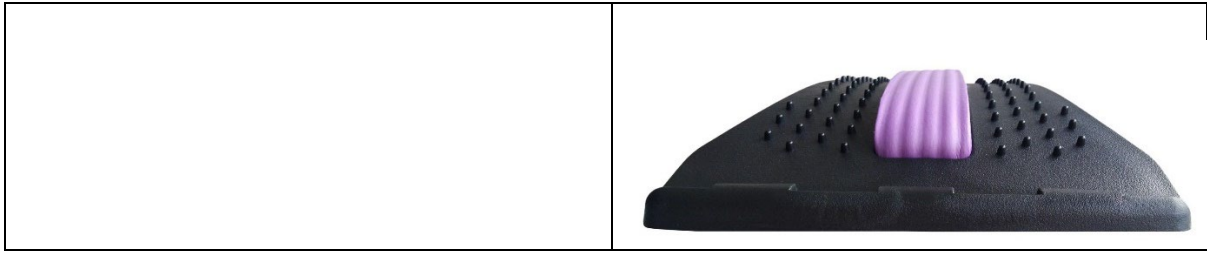
Design freedom

25. There are some constraints on the designer because the shape of the product has to be such that it conforms to the shape of a human's back, both in terms of offering an adequate surface area for supporting the weight of the person using it and in the arch which is available. It is obviously necessary for there to be a means of massaging the back but there is no evidence that "pins" of a particular shape and size are required, apart from that they be large enough not to cause injury and small enough to have a massage effect. There is at least some choice in the precise shape and number of the massage pins, which may be interdependent, and in the pattern. There is some freedom in the number of levels of arch, though this is constrained by the level of flexibility normal for the human back, and indeed whether the design is adjustable or not. The way that the device locks into place or is adjusted offers considerable design freedom. The evidence suggests that the strap in the centre of the product has a cushioning purpose but there is freedom in where and how the strap is fixed to the rest of the device and in its exact shape, including whether it is ribbed or has a different surface texture. Overall, the designer has a reasonable degree of freedom.

Comparison of the designs

26. The designs to be compared are:

Prior art	Contested design
 <p>The prior art section contains three images. The top image is a large, blue, curved lumbar support with a black base, shown from a perspective view. Below it is a small, square inset diagram showing a similar lumbar support with a blue strip and a black base. The bottom image is a close-up of the blue lumbar support on a black base, showing the perforated texture of the black material.</p>	 <p>The contested design section contains five images. The top image is a purple lumbar support on a black base, shown from a perspective view. The second image is a black lumbar support with a purple strip, shown from a perspective view. The third image is a purple lumbar support on a black base, shown from a perspective view. The fourth image is a black lumbar support with a purple strip, shown from a perspective view. The bottom image is a purple lumbar support on a black base, shown from a perspective view.</p>



27. The following attributes are shared by the respective designs:

- A flexible upper part of a relatively thin material which is wider at one end than the other;
- Curved edges at the narrow end of the upper part;
- Small 'pins' of roughly the same size relative to the whole product, spaced evenly along the outer thirds of the upper part in three rows, which are offset;
- A thick, ribbed section in the middle of the upper part;
- A smooth rectangular section at the narrow end of the upper part, at the base of the thick ribbed section and slightly wider than it;
- A base plate which is, at its widest end, very slightly wider than the widest part of the upper part and at its narrowest end narrower than the upper part;
- A slot at the widest end of the base plate to accommodate the upper part. The proportions of this slot appear to be the same in both designs and the edges of the slot are the same curved shape;
- Three protrusions at the widest end of the base plate which overlap the upper part and retain it in place;
- Three protrusions at the narrow end of the base plate, smaller than at the other end, which also appear to be for holding the upper part in place;
- A straight-sided, central section in the base plate narrower than either end;
- Rounded corners where the narrow end of the base plate angles towards the central section;

- Angles which are the same or very similar where the ends of the base plate narrow to meet the central section.

28. At the narrow end of the base plate, the contested design has three roughly triangular notches, into which the flexible upper part slots. Only two slots are visible in the earlier design. However, it is clear from the evidence that the earlier design has three different positions. There is no reason to think that the mechanism is any different for one of the three positions or that there are significant differences in the design of these slots. Taking the evidence in the round, I consider it a reasonable inference that there is a third slot also featuring three protrusions of the same type and that the reason it is not visible is because the upper part protrudes from the side of the product, concealing the third slot because of the angle of the image. I also note that the top edges of the second and third slots in the contested design are not visible. However, the proprietor has not argued that there is any difference between these and the slot which is shown. I infer that these slots also have three protrusions like the slot shown. The edges of this part of the base plate are rounded in both designs.

29. I have indicated that the central part of the base plate is narrower than at either end. I can only see one side of the earlier design but there is no reason to believe, and there is no evidence to show, that the side not shown is different from that visible.

30. The differences between the designs are:

- The contested design has an additional pin at each side of the narrow end of the design and an extra three pins at each side of the wider end;
- The top of the notches in the earlier design is pointed; in the contested design it is squared off;
- In the contested design, the widest part of the base plate is only very slightly wider than the upper part. The earlier design appears to have a larger overlap, though it is very difficult to make it out.

31. At the widest end of the contested design, the edges of the upper part are straightened. It is not easy to make out the exact features of that part of the earlier

design. The final image in the table at paragraph 26, above, appears to show a slightly rounded edge. I proceed on that basis.

32. The three retaining protrusions at each end of the respective designs are of the same or very similar length relative to the width of the product. At the wider end of the contested design, the two outermost of these lips are slightly angled towards the outer edge, so that they are not rectangular like the remainder. The reflection of light in the final image above suggests that the earlier design has the same feature but it is not possible to make out it out clearly.

33. In the main images in evidence, the earlier design is shown as having a deeper arch than the contested design. The images appear to be of the product in its middle position, unlike the contested design which is at its lowest setting. The small thumbnail image shows that the earlier design may be positioned at a lower angle and the proprietor has not pointed to this as a material difference. I attach no particular weight to the difference in the depth of the arch.

34. The earlier design has a tail visible underneath, from the thick rubber part in the centre of the upper piece. It is not possible to make out how the equivalent part of the contested design is fixed (i.e. whether it is the same) or if a tail is present. I also bear in mind that the underside of the contested design is included in the illustrations and is part of the design. There is no equivalent image of the earlier design. However, whilst the user may see the underside when positioning or storing the product, it will have a lesser impact than the other parts of the design.

35. I acknowledge that there are some differences between the respective designs. The applicant's evidence could certainly have been much better. In my view, the differences between the designs are more than immaterial. Consequently, the claim that the design is not new fails. However, the differences between the designs are, in my view, too slight to create a different overall impression. The overall shape of the product (upper and lower parts), the patterning of the massage pins, the placement and features of the thick strap in the centre and the mechanism for fixing the upper part in place are all very similar, if not identical. The differences are not sufficient to give rise to a different overall impression. The contested design does not have individual character and is therefore invalid.

Conclusion

36. The application for invalidation has succeeded.

Costs

37. The applicant has been successful and is entitled to an award of costs. I award costs to the applicant as follows, bearing in mind that the evidence was very light:

Official fee:	£48
Filing the application and considering the counterstatement:	£300
Filing evidence:	£400
Total:	£748

38. I order Lanxi Yichao Electronic Business Company Limited to pay Limar Trading Limited the sum of £748. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of March 2023

Heather Harrison

For the Registrar,

The Comptroller-General