

BL O/0299/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN Nos. 6140688, 6140689 and 6140687

IN THE NAME OF SUPER SURPRISE LTD

AND

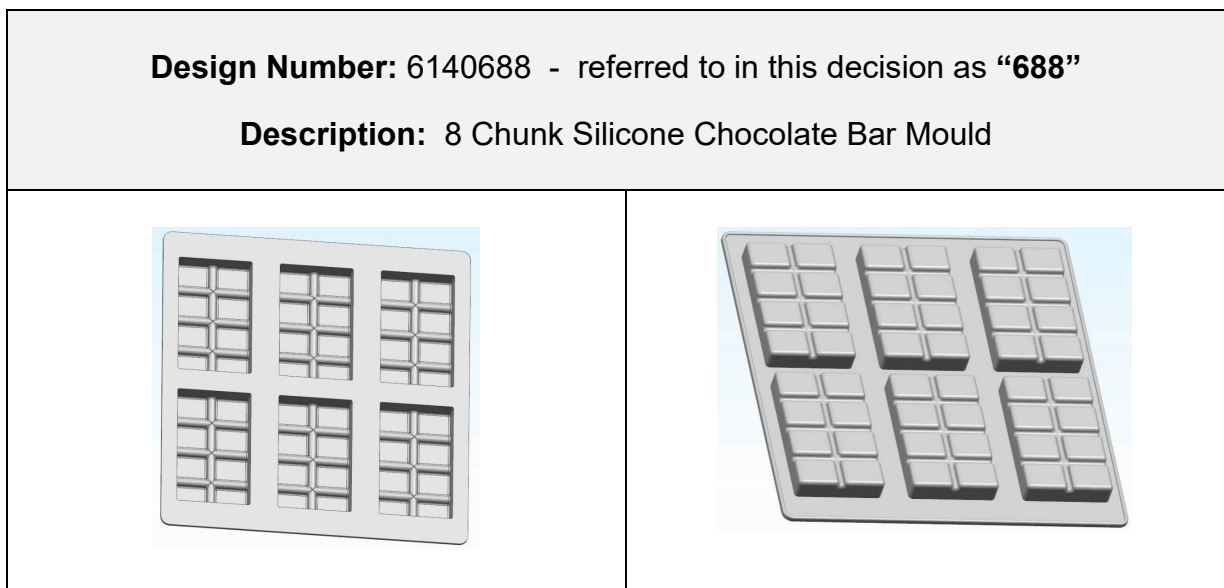
APPLICATIONS FOR INVALIDATION (Nos. 146/21, 147/21 and 149/21)

BY

TEMPLETON TOOLS & MACHINERY LTD

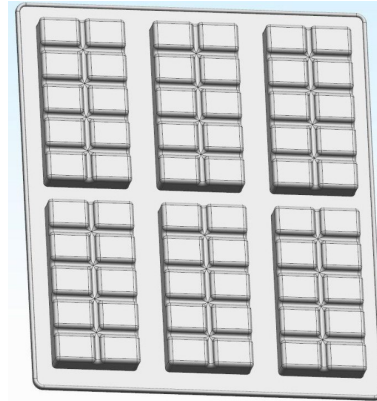
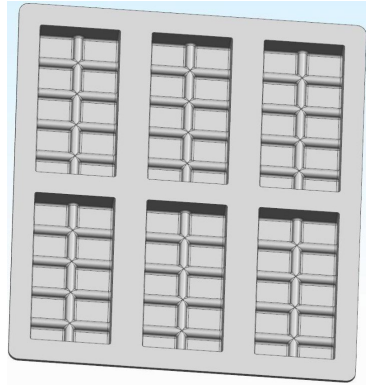
Background and pleadings

1. This decision deals with three requests filed by Templeton Tools Ltd (“**Templeton**”) to invalidate three designs that stand registered in the name of Super Surprise Ltd (“**SSL**”). Given the close overlap of their facts and issues, the invalidation requests have been consolidated to be addressed simultaneously.
2. SSL’s designs are for silicone moulds for chocolate bars in chunks of 8, 10 and 5 (respectively). They were applied for on 3 June 2021 and became registered with effect from that date (“**the relevant date**”) in Class 07, Sub class 02 of the Locarno Classification (Household goods, not elsewhere specified / Cooking appliances, utensils and containers) and in Class 08, Sub class (Tools and hardware / Other tools and implements).
3. SSL’s designs are depicted in the register as shown in the tables below. No claim is made for colour.



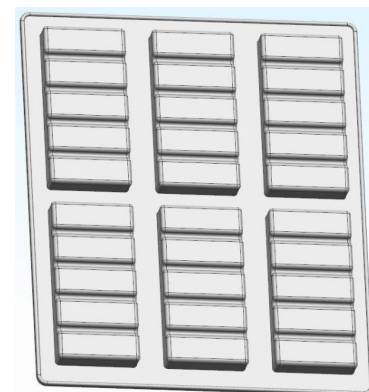
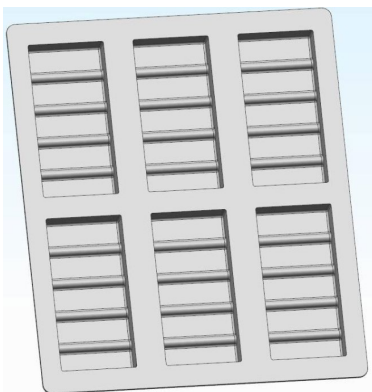
Design Number: 6140689 - referred to in this decision as “689”

Description: 10 Chunk Silicone Chocolate Bar Mould



Design Number: 6140687 - referred to herein as “687”

Description: 5 Chunk Silicone Chocolate Bar Mould



4. In December 2021, Templeton filed 3 x Form DF19A, requesting that SSL’s design registrations be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”). Templeton claims that SSL’s designs did not fulfil the requirements of section 1B of the Act because they were not new and lacked individual character compared to other designs that had been made available to the public before the relevant date.
5. There are some differences in the submissions in the applicant’s statements of grounds in support of each of its invalidation requests, reflecting the detail of the particular attacked designs (for instance the number of chunks involved). However, the consistent point of

comparison for its challenge to SSL's 688 and 689 is UK design No. 4036473, which Templeton registered 6 years earlier. Details of Templeton's 473 registered design are given in the table below:

<p>Design Number: 4036473 - referred to herein as “Templeton’s 473 design”</p> <p>Application / registration date: 17 July 2014</p> <p>Publication date: 22 August 2014</p> <p>Description: 6 cell, 10 section bar silicone mould</p> <p>Colour does not form part of the design</p>	
	
<p>Templeton's 473 design is registered in Class 07, Sub class 02 of the Locarno Classification (Household Goods, Not Elsewhere Specified / Cooking Appliances, Utensils and Containers), and the goods are indicated in the register as being “Moulds eg jelly, lollies”).</p>	

6. As the basis of Templeton's challenge to the validity of SSL's 687 design, Templeton relies on a different one of its earlier design registrations, as follows:

<p>Design Number: 4036474 - referred to herein as “Templeton’s 474 design”</p> <p>Application / registration date: 17 July 2014</p> <p>Publication date: 22 August 2014</p> <p>Description: 6 bar, 5 section bar silicone mould</p> <p>Colour does not form part of the design</p>

6 BAR, 5 SECTION SILICONE MOULD



FRONT VIEW OF MOULD

Colour does not form part of the design



REAR VIEW OF MOULD

Templeton's 474 design is registered in Class 07, Sub class 02 of the Locarno Classification (Household Goods, Not Elsewhere Specified / Cooking Appliances, Utensils and Containers), and the goods are indicated in the register as being "Moulds eg jelly, lollies").

7. Templeton made various claims and allegations across its statements of grounds, including that:
- Templeton's 473 design was first made available for sale online and through distributors in 2014;

- Templeton’s 473 design is “of ‘original thought’” and was created in 2014 by someone who was an employee of Templeton at the time of both its design and registration;
 - SSL’s designs are based on Templeton’s 473 design “in a deliberate and meaningful attempt to recreate without infringement but giving the same overall first impression.”
 - “There are very many lovely colours available in silicone” and Templeton “were first to use brown” ... “Even our signature colour has been plagiarised.” “ ... the colour too contributes to confusion of the informed user.”¹
 - SSL’s 687 design has made “unfair use” of Templeton’s 474 design and has “totally the same overall appearance.”
8. It is unnecessary for this decision to address in detail many aspects of Templeton’s claims and submissions, or indeed parts of the evidence filed on behalf of Templeton (which comprised witness statements from Helen Thomson dated 24 May 2022 and Exhibits A-C). This is because Templeton’s claims depend primarily on my comparing each of SSL’s designs with Templeton’s earlier registered designs, since that is the prior art invoked and focused on in Templeton’s claims. However, inasmuch as the evidence filed on behalf of Templeton features images of other moulds, I shall refer to those to the extent I consider warranted.
9. SSL filed Forms DF19B defending its design registrations, claiming that SSL had not seen any of Templeton moulds or designs when SSL began designing and producing its products in 2013 for a third-party food craft magazine. SSL’s counterstatement was accompanied by a number of supporting images. Although SSL filed no evidence during the evidence rounds, the content of the materials filed as part of the Form DF19B, given under a signed and dated statement of truth, may be afforded a measure of evidential significance. I return to the material filed by SSL later in this decision.
10. Neither party engaged professional legal representation and neither side requested an oral hearing. I make this decision after a careful consideration of the papers before me. I note that Templeton’s submissions accurately referred to relevant aspects of design law, including the nature of the informed user, the overall impression of a design and the

1 Page 7 of Exhibit A referred to in the statement of Helen Thomson 24 May 2022
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assessment of individual character. I shall refer to the parties' submissions only to the extent warranted to determine the requests for invalidation.

Decision

11. 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 designs.

12. 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”.

13. 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.

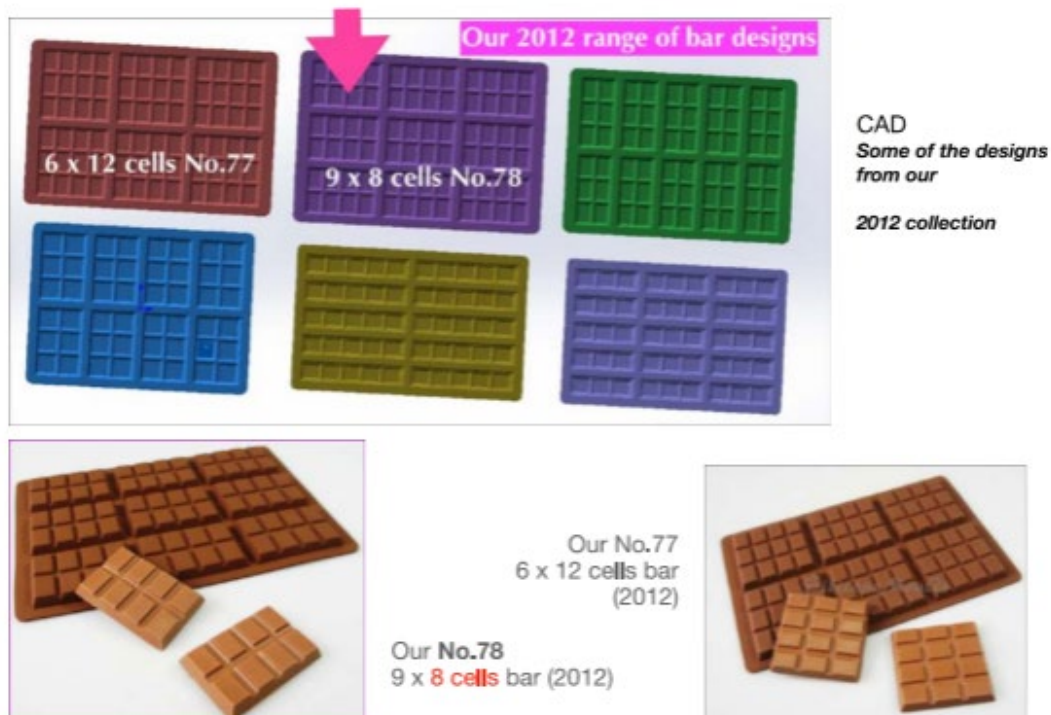
(9) In subsection (8) above 'normal use' means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product."

Assessment based on the prior art claimed by Templeton

- 14. I shall first consider the prior art relied on or referenced by Templeton, before later considering what may be gleaned from the materials that SSL itself filed.
- 15. Templeton's 473 and 474 designs are UK registered designs and publication in the Design Journal counts as being "made available to the public". Templeton's 473 and 474 designs were registered on 17 July 2014 and published on 22 August 2014, several years prior to the relevant date (3 June 2021). It is therefore clear that both 473 and 474 satisfy the provisions of section 1B(5) of the Act.
- 16. During the evidence rounds (presumably in response to references in the defence to SSL's own earlier production of chocolate moulds) Templeton filed images including those below – "Templeton Images 1 and 2":

TEMPLETON IMAGE 1

Our silicone moulds have featured in weekly blogs 'See What's Cooking' by Sarah-Jane since they began in 2010, some also featuring in her YouTube educational tutorials.



(Our 6 x 12 cell No.77 mould is only submitted as evidence that these moulds existed as early as April 2012. Please find proof in the following item)

TEMPLETON IMAGE 2

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SiliconeMoulds.com Blog

Online worldwide cook shop selling of Silicone Bakeware Moulds, for making cakes & bakes, jellies, soap, and many other uses. This E show all our latest ideas, recipes, photos, competitions and news of upcoming products

Sunday, 8 April 2012

Chocolate Tempering (and new mould designs !)



There is a knack to making chocolates and chocolate bars. That is, if you want to get the nice snap when you break it, and glossy finish with a smooth texture throughout.

Had I known a few simple things much earlier about tempering chocolate, I wouldn't have spent a fortune ruining the stuff !

Some of the many disasters include white milky type marks all over the surface (or in patches), crumbly interiors and dull finish.

If you look up chocolate tempering on the net, there are many web pages that tell you how to do this. They all use two classic methods.

The one for best results includes pouring chocolate on to a piece of marble, scraping it back and forward to cool it and then back into a bowl before pouring into moulds. It's tell you now that this seemed like too messy and too much effort. I would also have needed to invest in a big lump of marble. There is so much "stuff" in my little kitchen at the moment that I have nowhere near enough storage space as it is. I therefore admit that this method was instantly put on the sidelines...

The second method is called SEEDING. It seems to be the simplest and will give great results - as long as you get it right...

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Blog Archive

- 2016 (7)
- 2015 (18)
- 2014 (12)
- 2013 (42)
- 2012 (71)
- 2011 (84)
- 2010 (133)

Blog:
Sunday, 8 April 2012



Chocolate Tempering (and new mould designs!)

Screenshots from our blog web page This blog launched our new collection of these bar moulds in April 2012.

17. I also note that, in its evidence, Templeton filed Annexes labelled A – C showing numerous images of other available silicone moulds.² I have included extracts from those Annexes at the end of this decision, but since the images date from 2022 - after the relevant date - they may not be considered reliable prior art in respect of SSL's contested designs, which were filed in June 2021.

² One of the purposes of Templeton's Annexes is to support Templeton's submission that SSL has copied the brown colour choice of Templeton's moulds. However, since Templeton's earlier design disclaims the colour, their protection extends to the feature of shape and look of the design in any colour.

18. I therefore turn to decide whether each of SSL's challenged designs had the required novelty and individual character when compared with 473 or 474 (as the case may be) which are the designs expressly invoked by Templeton. For completeness, I shall also make a brief analysis based on the mould designs discernible in Templeton's Images 1 and 2. Templeton's earlier designs are protected in respect of shape and form, but since both those registrations expressly state that colour does not form part of the design, I will disregard colour for the purposes of my comparison.

Novelty

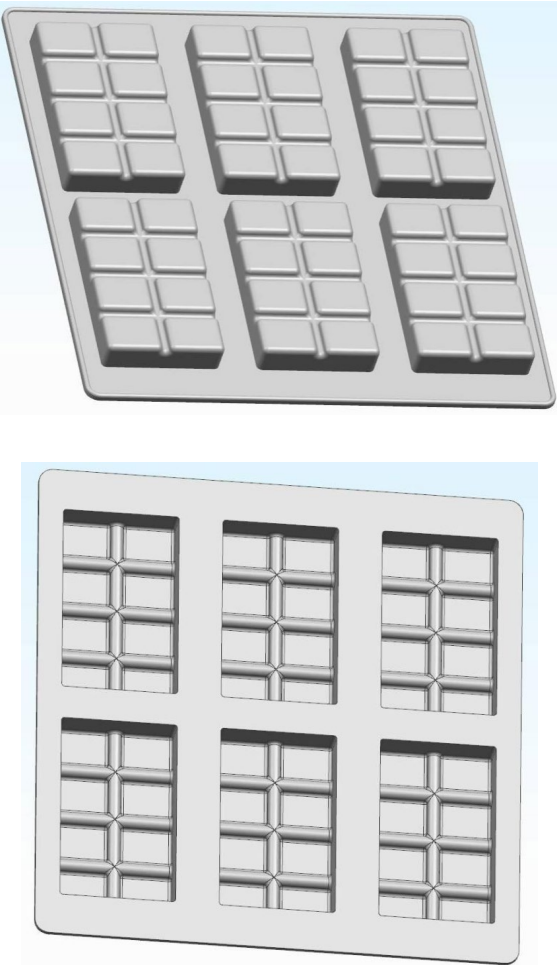
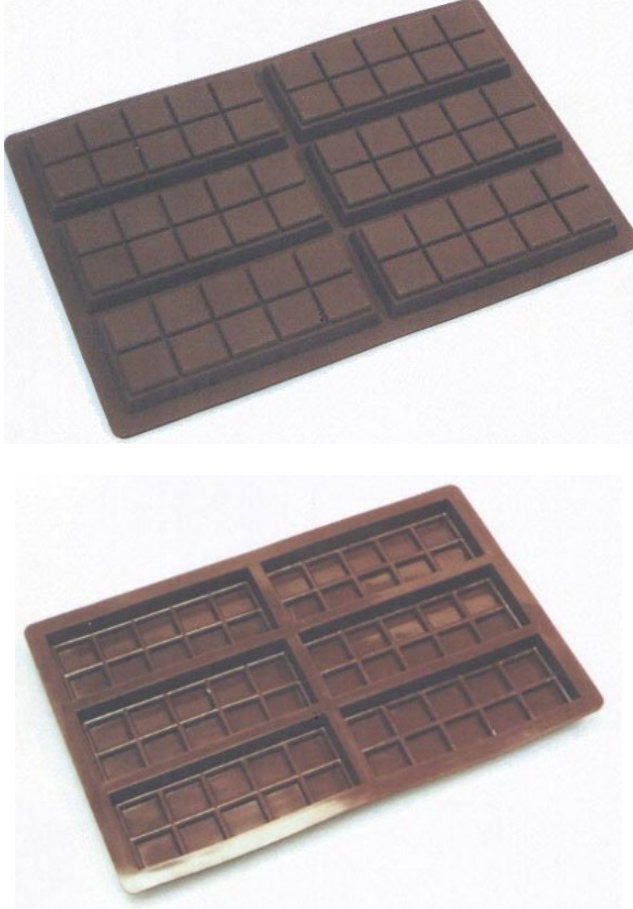
19. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a 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

20. The registered designs are shown side-by-side in the tables below:

³ Paragraph 26.

SSL's challenged design 688	Templeton's 473 design
	

21. The designs are not identical. The respective designs share the following features:

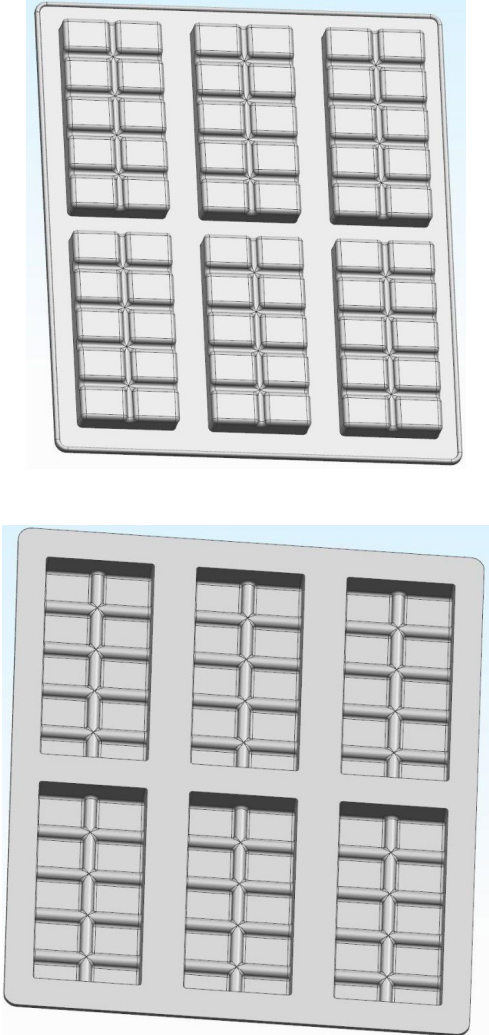
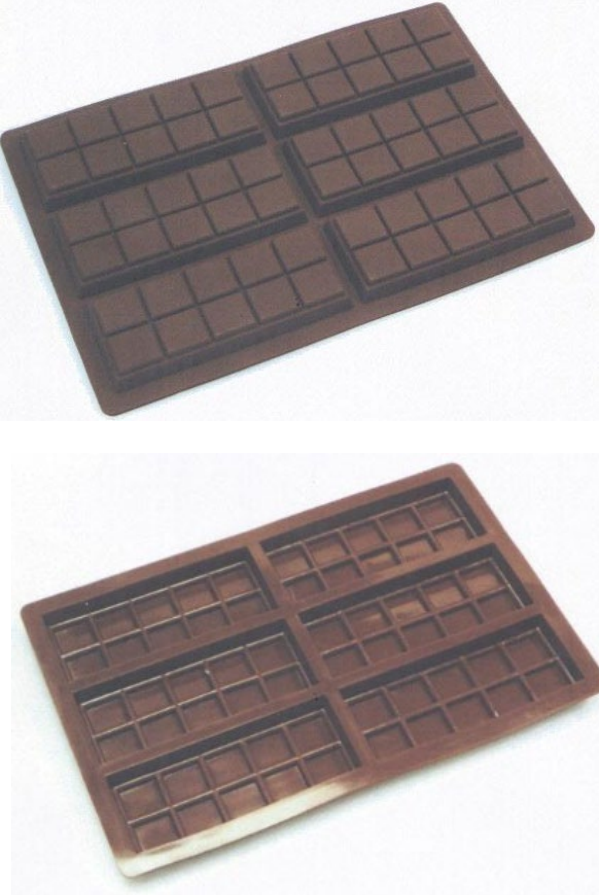
- i. Both feature a base plate made of silicone, set into which are six bars;
- ii. The bars are separated by a border;
- iii. Each bar comprises a number of paired individual cells, in two strips.

22. The differences between the designs are:

- i. The base plate of Templeton's 473 design is rectangular, whereas the base plate of 688 appears more square;
- ii. The borders between the bars are wider in 688.
- iii. Each bar of Templeton's 473 design has 8 cells, whereas 688 has 6 cells;

- iv. The individual cells in Templeton's 473 design appear square with square corners, whereas the cells in 688 appear rectangular with rounder corners;
- v. The individual cells in Templeton's 473 design 'step in' toward their tops, whereas the cells in 688 appear flush with the outside edge of their bar.

23. In my view, the different number of cells identified at (iii) above is especially significant. I also consider the other differences more than minor and trivial, especially points (iv) and (v). These are not immaterial differences and so I find that 688 has novelty when compared with the prior art of Templeton's 473 design.

SSL's challenged design 689	Templeton's 473 design
	

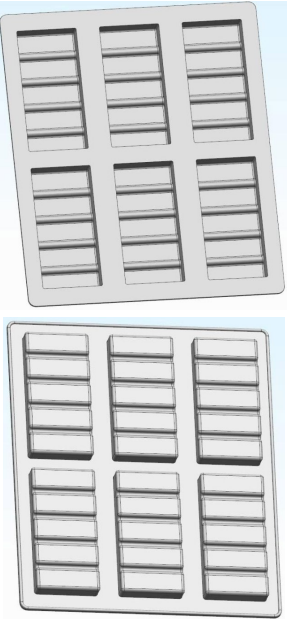
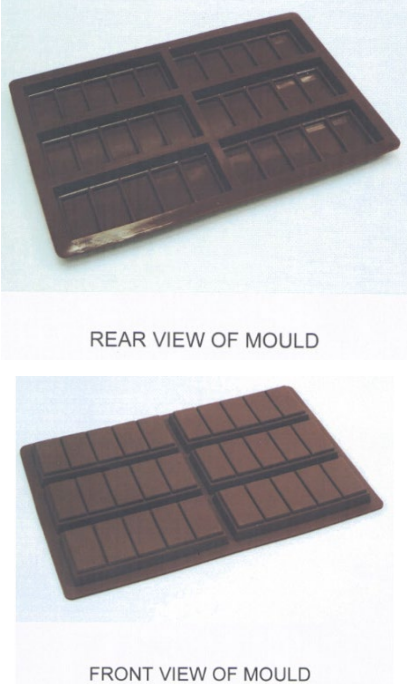
24. The designs are not identical. The respective designs share the following attributes:

- i. Both feature a base plate made of silicone, set into which are six bars;
- ii. The bars are separated by a border;
- iii. Each bar is comprised of ten individual cells, paired in two strips.

25. The differences between the designs are:

- i. The base plate of Templeton's 473 design is rectangular, whereas the base plate of 689 appears more square;
- ii. The borders between the bars are wider in 689;
- iii. The individual cells in Templeton's 473 design appear square, whereas the cells in 689 appear rectangular.
- iv. The individual cells in Templeton's 473 design 'step in' toward their tops, whereas the cells in 688 appear flush with the outside edge of their bar.

26. In my view, the differently shaped cells identified at (iii) above is especially significant and nor am I satisfied that the other differences are minor and trivial. Since the differences are not immaterial, I find that 689 has novelty when compared with the prior art of Templeton's 473 design.

SSL's challenged design 687	Templeton's 474 design
	 <p data-bbox="991 600 1222 624">REAR VIEW OF MOULD</p> <p data-bbox="991 936 1214 960">FRONT VIEW OF MOULD</p>

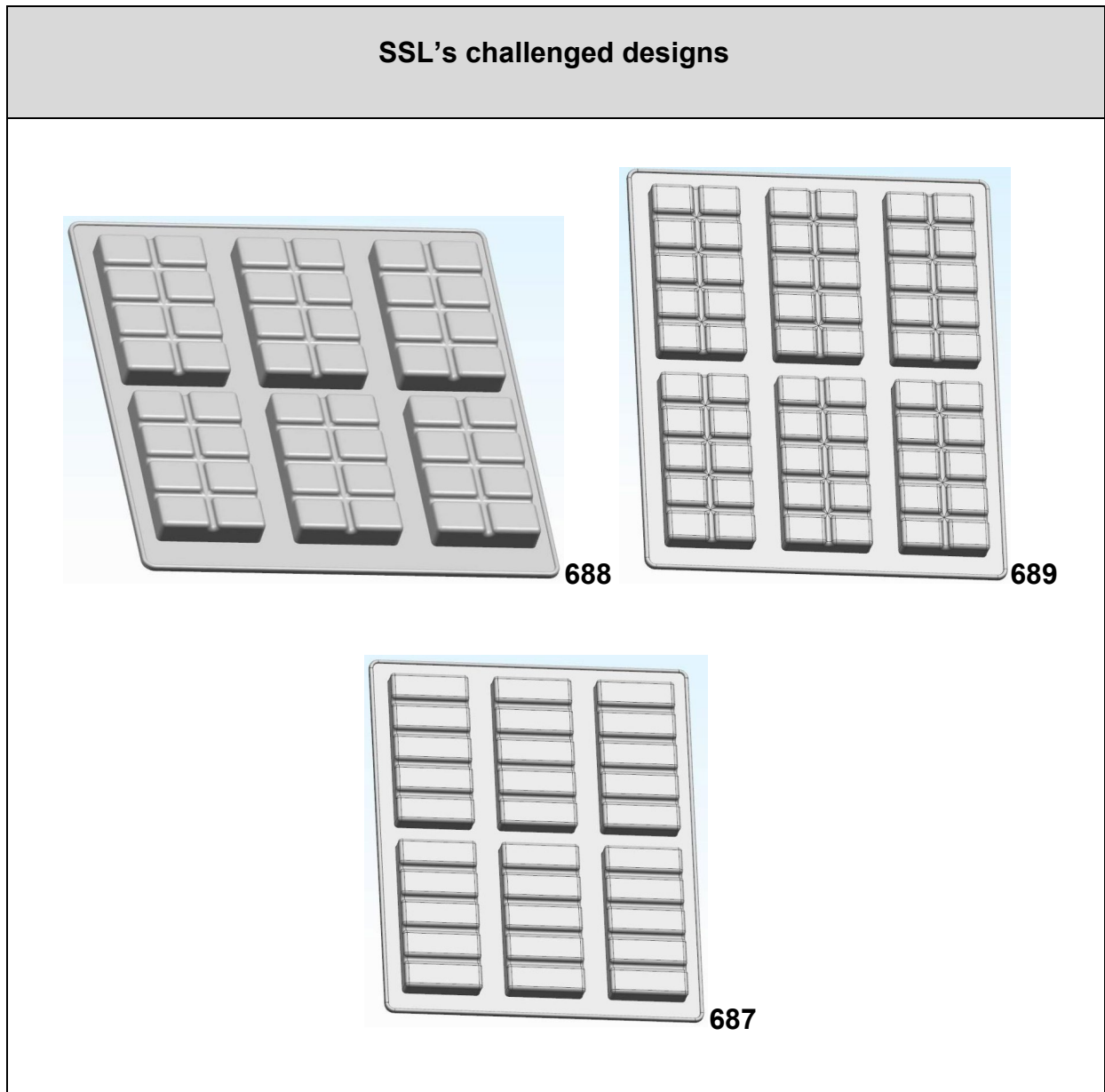
27. The designs are not identical; they share the following features:

- i. Both feature a rectangular base plate made of silicone, set into which are six bars;
- ii. The bars are separated by a border;
- iii. Each bar is comprised of five individual cells, rectangular in shape.

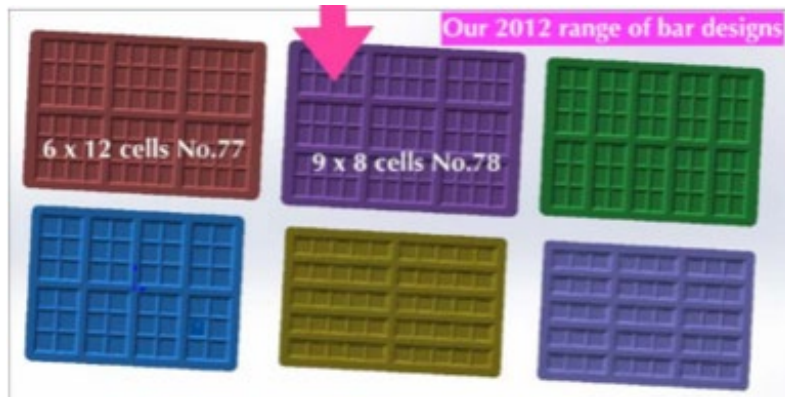
28. The differences between the designs are:

- i. The longer side of the base plate in Templeton's 474 design appears slightly longer in proportion to its shorter side than does the longer side of the base plate of 687 in proportion to 687's shorter side – which is to say, the base plate of 687 is slightly squarer than the base plate in Templeton's 474 design;
- ii. The borders between the bars are wider in 687;
- iii. The longer side of the individual cells in Templeton's 474 design is longer in proportion to its shorter side than is the case for of each cell in 687 – which is to say, the cells in 687 are longer rectangles than those in Templeton's 474 design.
- iv. The individual cells in Templeton's 474 design 'step in' toward their tops, whereas the cells in 688 appear flush with the outside edge of their bar.

29. In my view, the differently shaped cells identified at (iii) above is especially significant and nor am I satisfied that the other differences are minor and trivial. Since the differences are not immaterial, I find that 687 has novelty when compared with the prior art of Templeton's 474 design.
30. As I mentioned earlier, for the sake of completeness, I consider below the impact of the 2012 evidence from Templeton.



Templeton's evidence in Image 1



Our No.78
9 x 8 cells bar (2012)

Our No.77
6 x 12 cells bar
(2012)



Templeton's evidence in Image 2



31. There are clear differences between the designs that are not immaterial. In particular, whereas each of SSL's designs features a base plate for six bars, the same is true only in respect of "No. 77" in Templeton's evidence, but No. 77 involves 12 cells, arranged 3 by 4, which SSL's designs do not. This evidence does not therefore disturb my earlier findings of novelty.

Individual Character

32. 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 [earlier design] 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.”

33. 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

34. 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-

⁴ Paragraph 58.

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:

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)."

35. SSL's designs are silicone chocolate bar moulds, which are registered in the same class and sub class as Templeton's earlier design, covering household goods/cooking utensils and containers. The informed user of the challenged designs is likely to a person – whether a member of the public or a small business - who uses silicone moulds to make chocolate bars, which may be given away as gifts or sold as artisan produce. The informed user would have an understanding of the products available in this sector. They would be able to make direct side by side comparisons and would have an aesthetic interest in what the mould would produce, so would pay a reasonable degree of attention.

The design corpus

36. Again, in the *Samsung Electronics (UK) Ltd v Apple* case cited above, Judge Birss said the following:

“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.”

And

“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.”

37. In the present case, the evidence included numerous images of silicone moulds, all of which are presumably offered for sale or have at least been published.⁵ Some are shown for sale on eBay (Ms Thomson’s Exhibit C). However, the evidence does not establish *when* those designs were published or offered for sale, so it is not clear whether these were available to the public before the relevant date. Consequently, they do not reliably form part of the prior art in this field. I give them no further consideration as such – not as prior art serving as points of comparison against the challenged designs, nor were they invoked as such by Templeton.

Design freedom

38. 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).”⁶

39. Even without regard to the examples in Templeton’s evidence (such as annexed at the end of this decision), as member of the general public, I am aware (and can take judicial notice of the fact) that chocolate is apt to be moulded in a wide variety of shapes, forms and sizes, from animal shapes to coins. Moreover, it is also entirely commonplace for chocolate to be made in bars, such as would be produced by the moulds at issue. The nature of the chocolate bar moulds is informed by their purpose, which is to produce bars of chocolate, which would naturally need to be of a sensible and manageable size. While a bar of chocolate may be a single slab, it is common for a bar to be comprised of a grid of chunks. A chocolate bar mould will commonly feature channels for thinner chocolate, separating the chunks and enabling chunks to be snapped off in small numbers or individually. Another relevant consideration is that the moulds would need to include a

5 Such as the extracts in the Annexes shown at the end of this decision.

6 Paragraph 34.

sensible and manageable number of bars, so that the moulds may be moved from a counter to the fridge for example, without a heightened risk of the melted chocolate spilling from the flexible silicone.

40. Nonetheless, a designer of silicone moulds for chocolate bars has some freedom in the design of the product presented to the informed user. Notably, there is freedom in the number, configuration, size and shape of the composite cells (such as ‘chunks’) and any embellishments thereto (such as an image, emblem or word). There is also freedom in the number of bars that each mould may make and the size, shapes and positioning of the same.

Overall impression

41. I have already listed the features of each of the respective designs. In my view, the differences arising in particular from the number and/or shape of the cells, and the “step-in” refinement present in the Templeton designs, make a significant contribution to their overall impressions in the eyes of the informed user, especially taking into account the degree of freedom of the author of the design. I find that each of the contested designs has individual character over the prior art that I have so far considered.

Comparison based on materials filed by SSL

42. Having considered the challenges to SSL’s registrations based on Templeton’s evidence, particularly the comparison with its earlier registrations, I return to consider the implications of the content of the materials filed by SSL as part of its Forms DF19B. Richard Fincher, signing the Forms DF19B under a statement of truth, made the following counterstatement, dated 24 February 2022:

*“An assortment of 40 designs for chocolates, lollypops, cake toppers, shapes and stars were designed and manufactured for a magazine publication called **Something Sweet** made by Comag and DeAgostini publishing.*

Launched 8 January 2014, the issues were produced fortnightly as a partwork publication with a baking product with each issue to build a complete set of 200 issues.

We designed and manufactured 40 designs which were produced in China during 2013 and 2014 ready for each fortnightly publication.

We had not seen any moulds or designs by Templeton Tools when designing or producing these products in 2013. In fact, our manufacture and design was before their design.

After complaints by Templeton Tools via Vero through eBay (which were dismissed due to differences) we registered a small number of our designs.

Our designs of the 5, 8 and 10 chunk mould are all based on the 2013 design, now produced in the UK and China in PET plastic and silicone. (my underlining)

43. Points were made in near identical terms in the counterstatement in defence of 149/21 in defence of 687, also dated 24 February 2022, and in very similar terms in the counterstatement dated 30 August 2022 in defence of SSL's ten-chunk mould (689) challenged under proceedings 147/21, where SSL's own emphasis was as follows:

Our designs of the 5 and 10 chunk mould are all based on the 2013 design of the 8 chunk mould, now produced in the UK and China in PET plastic and silicone.

44. SSL enclosed with its counterstatement materials that included the images below:

Photo No. 1



Photo No. 2 – filed in DF19B 146/21 in defence of 688



Orchard Moulds 8 chunk
Overall size 17 x 18 x 0.9cm
Bar size 7 x 4 x 0.7cm
30g weight

Designed for DeAgostini in
2013

Photo No. 3– filed in DF19B 147/21 in defence of 689



Orchard
Moulds 10
chunk

17.5 x 21 x 0.9cm.
Bar weight 35g.
Individual bar
size 8.5 x 4 x
0.7cm

Photo No. 4 149/21 in defence of 687.



Orchard
Moulds 5
Chunk

17.5 x 18cm x 0.9cm height, 35g bar
size 7 x 4cm x height 0.8cm

45. Photo No. 1 shows a copy of the **Something Sweet** magazine, which appears to date back to 2015 (according to the copyright notice highlighted in the magnified circle). The magazine is in English and shows UK address information. Mr Fincher's statement attests that "the moulds were produced in China during 2013 and 2014 ready for each fortnightly publication." Photo No. 1 also shows a mould in cellophane which appears to be a gift included with the magazine. The cellophane compromises the clarity of the image, but the mould appears to comprise two rows of three bars, each bar comprising 8 small break-apart cells in four rows of two. A reasonable inference is that the design of

that mould was made available to the public (disclosed) around 2014 / 2015. It is therefore a piece of prior art against which I may compare the designs challenged in these proceedings, notwithstanding that the material was introduced on behalf of SSL.

46. Likewise, Photo No. 2, filed as part of the DF19B in 146/21 in defence of 688 8-chunk chocolate mould shows an image which is stated to have been designed for De Agostini in 2013. It is therefore a further piece of prior art against which I may compare the designs challenged in these proceedings.

47. I note that in the counterstatement in 147/21, Mr Fincher states that Orchard Moulds is SSL's new brand.

SSL's challenged design 688	SSL's Photo No.1	
		
	<th data-bbox="756 1482 1417 1588">SSL's Photo No.2</th> 	SSL's Photo No.2

48. The respective designs share the following attributes:
- i. Both feature a base plate made of silicone, set into which are six bars;
 - ii. The bars are separated by a border;
 - iii. Each bar comprises eight paired individual cells, in two strips.
49. To my eye, certainly the mould shown in Photo No. 2 appears identical to SSL's 688 design. It follows therefore that on the proprietor's own admission 688 was not new at the relevant date. It does not appear to me that the overall impression produced on the informed user by SSL's 688 design differs from that produced by the 2013 design that had been made available to the public before the relevant date. 688 thus lacked individual character at the relevant date.

Outcome: 688 is invalid under section 11ZA(1)(b) of the Act, because, when SSL applied to register the design, it did not fulfil the requirements of section 1B of the Act.

50. Comparing what may be gleaned from Photo No.1 and No. 2 with the contested designs 689 and 687 results in no different outcome than I found previously in this decision, based on a comparison with Templeton's earlier design. The number of rows and cells (and the much longer cells in 687) are material differences and produce a different overall impression on the informed user.
51. With regard to the moulds shown in Photo No. 3, filed in DF19B 147/21 in defence of SSL's 689 ten-chunk mould and in Photo No. 4 149/21 in defence of 687 five-chunk mould, although the images appear to be identical designs, it is not clear that these were made available to the public before the relevant date. Unlike Mr Fincher's evidence relating to his eight-cell mould, the ten- and five-chunk moulds are not shown on any copy of the De Agostini magazine (cf. Photo No. 1), nor, unlike in Photo No. 2, are they stated to have been "Designed for DeAgostini in 2013". Rather, Mr Fincher merely states that the contested 5 and 10 chunk moulds are "based on the 2013 design of the 8 chunk mould". It is not clear from this statement that the contested 5 and 10 chunk moulds were produced in 2013. Rather, it seems to me that Mr Fincher made this statement to counter Templeton's claims that the contested moulds were copied from Templeton's designs. The images in Photo No. 3 and No. 4 are therefore not further prior art against which I may compare the designs challenged in these proceedings.

Outcome: There is no evidence to show 689 and 687 lacked novelty or individual character at the relevant date. Those designs remain validly registered.

Costs

52. Two of the applications for invalidity have failed; one has succeeded. Successful parties are entitled to a contribution towards the costs of the proceedings. As the parties are unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate whether they intended to make a request for an award of costs and, if so, to complete a proforma indicating a breakdown of their 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 that if the proforma was not completed, no costs other than official fees arising paid by the successful party would be awarded.
53. Neither party responded to that invitation. As the proprietor (SSL) has not incurred any official fees in defending its design registrations, I make no order as to costs in its favour. However, since the applicant (Templeton) has succeeded in one of its invalidation requests, it is entitled to be reimbursed the official fee for filing DF19A in respect of 146/21.
54. I order Super Surprise Ltd to pay Templeton Tools & Machinery Ltd the sum of £48. 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 24th day of March 2023

Matthew Williams
For the Registrar

Extracts from Templeton's Annexes

EXHIBIT A - Ebay moulds listings by SUPER SURPRISE
222 results for moulds 10 April 2022 **They are not 90% BROWN**
These are all the moulds for sale by Super Surprise claiming that 90% are brown.

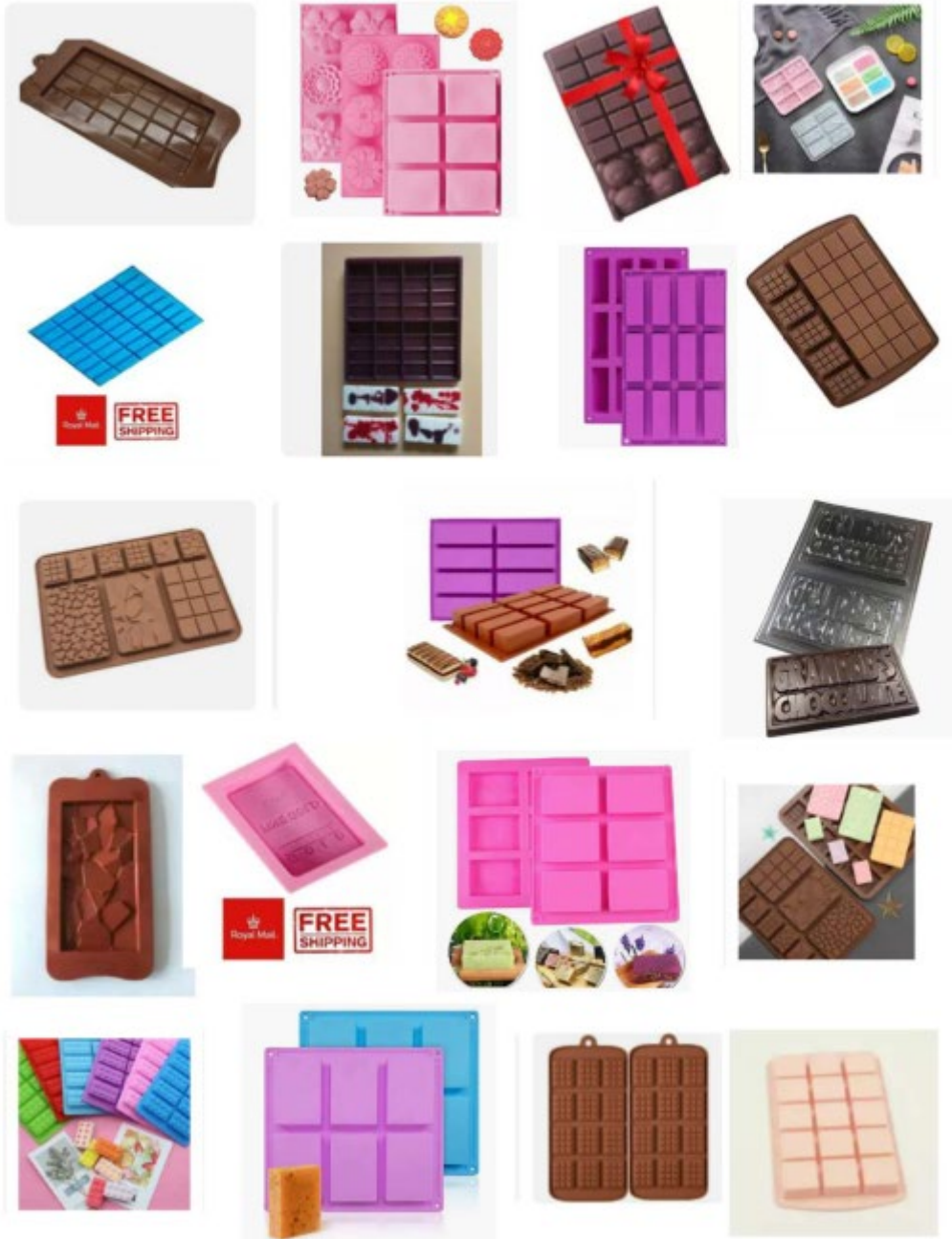
Fewer than 20% of their moulds are brown





EXHIBIT B - OTHER BAR MOULDS - NOT OUR DESIGN

These are just a few of other available bar type moulds, demonstrating the many alternative variations possible - without having any resemblance to any of our own bar mould designs.



Large Hearts Chocolate Bar Silicone mould
UK Seller , Fast Shipping

