

O/0326/23

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN NO. 6151534  
IN THE NAME OF LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED  
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 78/21)  
BY LIMAR TRADING LIMITED**

## Background and pleadings

1. The registered design the subject of these proceedings was filed by Lanxi Yichao Electronic Business Company Limited (the proprietor) on 30 July 2021 and was registered with effect from that date. The registered design is described as a 'cash box' and is depicted as follows:



2. The registration includes a disclaimer which reads: "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 an application 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 February 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 a witness statement by Andrew Marsden, dated 14 April 2022. Mr Marsden is a Chartered Trade Mark Attorney with the applicant’s representative, Wilson Gunn LLP. His statement introduces evidence of a search he carried out on Amazon UK. Brief written submissions were filed contemporaneously.

7. The proprietor's counterstatement does not contain a statement of truth, but does address the features of the competing designs and will be considered submissions for the purposes of this decision.

## **Decision**

### Relevant 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 reads:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if-

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if-

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) 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. This comprises a print taken from Amazon UK for a product titled, ‘H&S Money Box Tin 6” Steel Cash Safe Box Petty Cash Deposit Tin with Lock 2 Keys’.<sup>1</sup> The item is shown as first available on 24 February 2015. Eight customer reviews are shown in the exhibit, ranging in date from 5 March 2019 to 7 June 2020.

11. In *Senz Technologies BV v OHIM*, 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.”<sup>2</sup> I accept the Amazon print as proof of disclosure, and the proprietor has not claimed that 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

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<sup>1</sup> See exhibit AM1.

<sup>2</sup> Joined cases T-22/13 and T-23/13, paragraph 26.

relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,<sup>3</sup> 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.”

### Comparison of the designs

13. The applicant provided one image of the prior art in its evidence. Further image thumbnails are shown on the Amazon UK page, but they are too small and indistinct to assist me in the comparison of the competing designs. In its counterstatement, the proprietor filed a different image of the same product as that relied on by the applicant. Given that this has the same product number on Amazon UK and clearly includes the same company logo on the side of the product, as the image provided by Mr Marsden, I will include it as a representative image of the back of the product relied on as prior art by the applicant.

14. The proprietor made no claim for the colour or materials used for the registered design, so this will form no part of the comparison. The competing designs are as follows:

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<sup>3</sup> [2019] EWHC 3149 (IPEC).

Prior art	Contested design
	
	
	





15. The prior art has the following features:

- A round logo of H&S with a bird device – blue on a white circle, positioned at the front of the right hand side of the box.
- It is a rectangular box with the longest side being its length, the second longest being its width and the shortest being its height.
- It has a hinged lid which is approximately  $\frac{2}{5}$  the depth of the whole box.
- The hinge appears to protrude from the back of the box and reaches almost the whole length of one of the longest sides, stopping only when the box corner curves.
- The corners of the box are rounded.
- The lid top is indented in rectangular form with sharply rounded corners.
- A narrow border remains around the indentation.
- A handle rests in the bottom half of the indented area.
- The handle described as an ‘arc handle’ by the proprietor is a rectangular shape (with rounded corners) with a section of its longest edge missing. This enables the handle to connect to two cylindrical pegs which are placed in the middle of the box and are as wide apart as the lowest point of the indentation.

- The front of the box has a cylindrical lock which tapers at the front and protrudes from the front of the box. This can be seen in the bottom elevation (picture four in the table above).

16. The contested design has the following features:

- It is a rectangular box with the longest side being its length, the second longest being its width and the shortest being its height.
- It has a hinged lid which is approximately 2/5 the depth of the whole box.
- The hinge stops short of the rounded corners and has what look to be four or five rivet marks. Two above and three below the hinge.
- The hinge appears to be flush and cannot be seen protruding beyond the back of the box in the side elevation (the fifth image reproduced in the table above).
- The corners of the box are rounded.
- The lid top is indented in rectangular form with rounded corners.
- A fairly wide border remains around the indentation.
- The indented area has a money box slot in the top half of it and the handle rests in the bottom half.
- The handle described as an 'arc handle' by the proprietor is an oval shape with a section missing, which enables the handle to connect to two cylindrical pegs which are placed in the middle of the box and are only slightly wider than the money slot.
- The front of the box has a cylindrical lock which tapers at the front and protrudes from the front of the box. This can be seen in the bottom elevation (picture four in the table above).

17. The logo on the side of the box shown in the prior art, the different shaped handles, the different profiles and lengths of hinges and the fact that only the registered design has a money slot are differences which are more than minor and trivial differences and accordingly, I find that the contested design has novelty when compared with the prior art.

## Individual character

18. 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*.<sup>4</sup> 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.

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<sup>4</sup> [2018] EWHC 345 (Pat).

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. 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.*<sup>5</sup>

“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.”

### The informed user

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

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<sup>5</sup> [2012] EWHC 1882 (Pat).

“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:

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).”

21. The informed user is a member of the general public who will use a cash box in order to store money or other valuable items. They will have an interest in both appearance and functionality.

### The design corpus

22. The applicant's evidence contains two sections headed, 'products related to this item' and 'More items to explore'. Under both of these are images of other cash boxes which can be purchased via the Amazon UK website. However, I cannot be sure that items were available to the public before the relevant date. I therefore have no evidence to show me the design corpus at that date.

### Design freedom

23. In *Dyson Ltd v Vax Ltd*,<sup>6</sup> Arnold J (as he was then) stated that:

“34...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).”

24. A portable cash box will need to be large enough to store money and other valuable items. It will need to lock, for security reasons, and will need to open, most likely by means of a hinged opening in order to access the contents, though other opening options would be possible. It is also likely to need some form of handle in order to move it around. Whilst the designer has some freedom to determine the shape and size, this will be limited by practicality. These goods are portable and the space inside needs to be appropriate to store the required items, so a rectangular or square form of a reasonable but not excessive size would seem the most likely option.

25. That said, the designer has some freedom to decide the proportions and size of the box and the way in which the handle lock and hinges are configured.

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<sup>6</sup> [2010] FSR 39.

26. I have already listed the features of each of the respective designs. In my view, the logo on the side of the prior art, the differences in handle shape and the addition of a money slot in the lid of the contested design, which is absent from the prior art, are elements which make a significant contribution to the overall impressions of both designs. I find that the contested design has individual character over the prior art.

**The invalidation against this design has failed under section 1B of the Act.**

## **COSTS**

27. 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.

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

**Dated this 3<sup>rd</sup> day of April 2023**

**Al Skilton  
For the Registrar,  
The Comptroller-General**