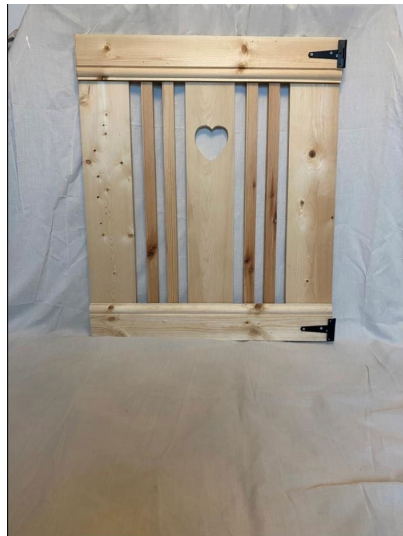


O/0350/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6128068
IN THE NAME OF AMY VICTORIA HARTY
IN RESPECT OF THE FOLLOWING DESIGN**



AND

**AN APPLICATION FOR INVALIDATION (NO 36/21)
BY THE RUSTIC MILL COMPANY LTD**

Background and pleadings

1. Amy Victoria Harty (“the registered proprietor”) filed application no.6128068 for a registered design for an internal wooden gate in Class 25 (Building units and construction elements), Sub class 02 (Prefabricated or pre-assembled building parts) of the Locarno Classification on 1 April 2021. It was registered with effect from that date and is depicted in the representation shown on the cover page of this decision. The following disclaimers were entered on the register: “No claim is made for the colour shown”.

2. On 27 May 2021, The Rustic Mill Company Ltd (“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 meet the requirement of section 1B of the Act that a design must be new and have individual character. The applicant claims that it is the owner of an earlier registered design for a gate consisting of thicker uprights, thinner bars and a wide centre piece, in which there can be seen a heart-shaped cut-out. The applicant claims that the proprietor has copied this design, the number of which is 6104775. It was applied for on 26 October 2020 and published on 10 November 2020 and is depicted in the following representation:



3. The registered proprietor filed a counterstatement to the application for invalidation on 21 March 2022, denying the applicant’s claims.

4. Each side filed a small volume of evidence with their statement of grounds or counterstatement. I shall refer to this as appropriate during the course of my decision. Neither side filed any further evidence or submissions or requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, neither party is professionally represented.

Decision

Legislation

5. 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”.

6. 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.

...”

7. The design relied upon by the applicant was published in the UK before the application date of the contested design as part of its own registration process and the proprietor has not claimed that any of the exemptions set out in section 1B(6) apply. Therefore, I find that the applicant may rely upon it as an earlier design.

8. The applicant has also filed an image posted to its Instagram account on 11 May 2020, which is also before the application date of the contested design. It shows the gate *in situ*, with the fittings necessary to enable the design to be used for its intended purpose.¹



¹ First page of the attachments to the DF19A.

Novelty

9. 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.”²

Comparison of the designs

10. The designs to be compared are shown below. I remind myself that it is those images that identify the nature and extent of any monopoly: see *Magmatic Ltd v PMS International Ltd*, [2016] UKSC 12, paragraph 31. For each of the designs, there is only one representation and I recall that the contested design is subject to a disclaimer as to colour. My analysis will take account of all other features of appearance.

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² Paragraph 26.

Earlier design:



Contested design:



11. The features of the earlier design are as follows:

- i) Four long, narrow rectangular pieces joined together into a square frame. The uprights at the edge of the design are shorter than the top and bottom pieces, so the joins are horizontal;
- ii) The top and bottom of the frame are joined in the centre by a broader rectangle;
- iii) Around three quarters of the way up this broader rectangle is a heart-shaped hole;
- iv) The sides of the heart rise from the base at a roughly 45-degree angle;
- v) On either side of the broader rectangle, two thinner bars spaced equidistantly also join the top of the frame to the bottom;
- vi) These thinner bars have chamfered edges, which can be more easily seen if the image is magnified;

- vii) The frame is topped by a narrow rectangular piece, roughly the same width as the bars in (v), which appears slightly to overhang the front of the gate; and
- viii) The surface of the gate appears smooth.

12. The features of the contested design are as follows:

- i) The overall shape of the gate is more rectangular than square;
- ii) At the bottom of the gate is a rectangular piece that is largely flat but topped with a curved section which the proprietor describes as an “ogee board”;
- iii) At the top of the gate is another rectangular piece that is largely flat but with a symmetrical curved section and then a very narrow flat piece towards the bottom. The proprietor describes this as a torus board;
- iv) The rest of the gate is constructed from three long rectangles which are separated by a gap in which there are two significantly narrower bars;
- v) Around two-thirds of the way up the central piece is a heart-shaped hole;
- vi) The sides of the heart rise from the base at what to my eyes looks like a roughly 30-degree angle. This makes the curve of the sides of the heart appear rounder and less pointed than in the prior art;
- vii) On the right-hand side of the gate there is a hinge at the top and another at the bottom; and
- viii) While I acknowledge that the colour is disclaimed, I note that the wood that the gate is made from is knotted.

13. It will be seen that there are several material differences between the designs, the greater contrast between the different widths of the vertical pieces and the curved features on the horizontal pieces in the contested sign being just two examples that are readily apparent. Consequently, I find that the designs are not identical. I would make the same finding as a result of a comparison between the contested design and the design shown in the Instagram post and reproduced in paragraph 8, which is identical to the earlier design save for the hinges on the right side of the gate and the latch at the top left.

Individual Character

14. 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.”

15. 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.”³

The sector to which the designs belong

16. The contested design is described on the register as “*an internal wooden gate*”, while the earlier design is a “*stair and doorway gate*”. They both therefore belong to

³ Paragraph 58.

that part of the building sector that is concerned with fittings for a house or possibly a smaller business unit.

The informed user

17. In *Samsung*, 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:

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).”

18. The informed user is a householder or property owner who wishes to close off access to part of the property, for example they might wish to prevent pets or young children from climbing stairs. They will pay a relatively high degree of attention to the appearance of the products and have an awareness of the designs that are available for household fittings.

The design corpus

19. The proprietor has included with her defence a group of four images of gates decorated with cut-out hearts. I have reproduced these below. As the photographs are undated, there is nothing to tell me whether they were part of the design corpus at the time of the application for the contested mark.



20. Nevertheless, they may be relevant to my consideration of design freedom. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) said:

“Counsel for Dyson also submitted, and I accept, that evidence of design freedom could also come from designs produced after the date of the registered design. If a wide variety of designs was produced after the registered design, that is evidence that the designer of the registered design had not been constrained to design the product in the way that he had.”⁴

Design freedom

21. Earlier in that decision, the judge 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

22. The designer has a reasonable degree of freedom over the shape of the gate. While the various images in this decision show flat gates, this is not a technical requirement: gates could be curved. However, I accept that, practically, flat gates are likely to be more convenient, particularly in a relatively small space. The tops of the gates may be straight, curved or, as in the first image in paragraph 19 above, consist of shapes, for example spearheads. The designer will also be able to choose the width of any panels or bars and their spacing, including whether there should be any gaps between them and, if so, how large these should be. There is a range of different materials that can be chosen, some of which will have an impact on the appearance of the product. For example, the knots in the wood contribute to the look of the contested design, in contrast to the unmarked surface of the earlier design. They may also choose to decorate the gate. Both the contested and the earlier design sport a single heart, while the first and third images in paragraph 19 are decorated with several

⁴ Paragraph 37.

⁵ Paragraph 34.

hearts. In addition, the applicant has on the fifth page of the attachments to its application shown some designs for gates with a paw, star, three hearts, or two bones, instead of the single heart in the centre panel.

Overall impression

23. In its pleadings, the applicant stressed the role of the heart in the centre of the gate, along with thicker uprights, narrower bars and a wider centre piece and claimed that the proprietor had copied these features in the contested design. I have already found that these are features in relation to which the designer has a reasonable amount of freedom.

24. In *Shnuggle Limited*, HHJ Melissa Clarke said that:

“32. The court must take the degree of freedom of the designer in developing the design into consideration both in assessing ‘individual character’ (Article 6(2) of the Regulation) and in assessing the scope of protection (Article 10 of the Regulation). It is important because similarities between products which are attributable to design constraints will be given little significance in the comparison of the overall impressions they produce. Where there is a high level of design freedom, attention is likely to be focused on those parts where there is a greater potential for variability.

33. His Honour Judge Hacon sitting as a Judge of the High Court in *Cantel Medical (UK) Ltd v ARC Medical Design Ltd* [2018] EWHC 345 (Pat) discussed the designer’s degree of design freedom, setting out the key points to consider:

- i) The constraints imposed by the technical function of the product or the statutory requirements;
- ii) Similarities between the designs of corresponding parts of two products which are attributable to design constraints will be given little

significance in the comparison of the overall impressions they produce;

iii) Where there are at least some elements in respect of which the designer had a high level of design freedom, attention is likely to be focused on those parts with their greater potential for variability. Similarities cannot be explained away by design restraints and will tend towards the view that overall impressions do not differ, whereas differences will lead towards the opposite conclusion;

iv) Finally, when comparing the design in question to the design corpus, HHJ Hacon in *Cantel* explains at [169] that:

a) A design which is markedly different will confer a greater scope of protection;

b) Little or no weight should be given to common features.”

25. I accept that these similarities are not explained by design restraints. However, I consider that the top and bottom pieces of the contested design are significant differences that point away from a finding that the designs have the same overall impression. The informed user, being aware of designs used in the sector, which I found to be that part of the building sector concerned with fittings for houses and similar properties, will perceive that the top and bottom boards of the contested design contain curved elements and may even consider that they resemble skirting boards. Even if they do not, the proportions of these boards, the curved features, together with the thicker centre piece and the knotted wood, give the contested design a different overall impression from that of the simpler, more elegant earlier design. I find that the contested design has individual character.

Conclusion

26. The application for invalidation has failed and Registered Design No. 6128068 remains registered.

Costs

27. The proprietor has been successful and would in the circumstances be entitled to a contribution towards the costs of the proceedings. As the proprietor is unrepresented, she was invited to complete a pro-forma with details of the time spent on particular activities associated with the proceedings. She was informed that if the pro-forma were not completed and returned, costs, other than official fees arising from the action, may not be awarded. As no pro-forma was received, and the proprietor has incurred no official fees, I make no award of costs.

Dated this 11th day of April 2023

Clare Boucher

For the Registrar,

The Comptroller-General