

BL O/0539/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN No. 6104929

IN THE NAME OF PAUL CARDY

AND

APPLICATION FOR INVALIDATION No. 59/21

BY

HELEN THOMSON

(ON BEHALF OF TEMPLETON TOOLS & MACHINERY LTD)

Background and pleadings

1. This decision deals with the request filed by Helen Thomson (“**the Applicant**”) to invalidate Design Number: 6104929 (“**the contested design**”) that stands registered in the name of Paul Cardy (“**Mr Cardy**”). The Applicant makes her request on behalf of Templeton Tools and Machinery Ltd.
2. The contested design was applied for on 28 October 2020 and became registered with effect from that date (“**the relevant date**”) in Class 08, Sub class 05 (Tools and hardware / Other tools and implements).¹ The registration includes the disclaimer that “no claim is made for material shown”. The design is shown below.



3. In October 2021, the Applicant filed a Form DF19A, requesting that the contested design registration be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“**the Act**”). The Applicant claims that the contested design did not fulfil the requirements of section 1B of the Act because it was not new and lacked individual character compared to other designs that had been made available to the public before the relevant date.²
4. As the point of comparison in support of its invalidation request, the Applicant’s statement of grounds identifies UK design No. 4036474, which was registered 6 years before the contested design. Details of that earlier registered design are given in the table below:

¹ The registration was published on 12 November 2020.

² The Applicant made amendments to the Form DF19A originally filed, removing other grounds initially claimed.

Design Number: 4036474 - referred to herein as “the 474 design”

Application / registration date: 17 July 2014

Publication date: 22 August 2014

Description: 6 cell, 5 section bar silicone mould

Colour does not form part of the design

FRONT VIEW OF MOULD



REAR VIEW OF MOULD



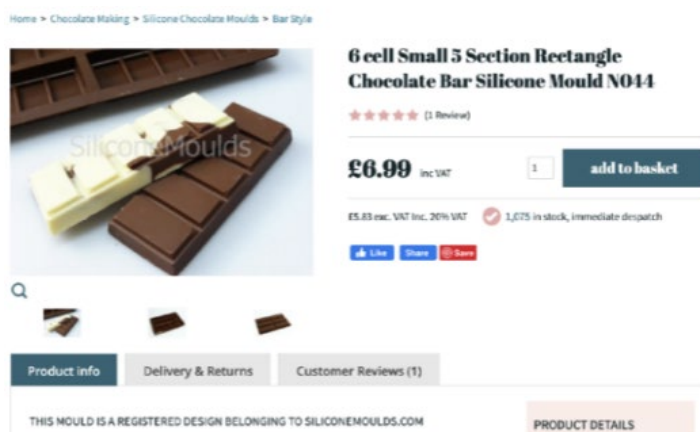
The 474 design is registered in Class 07, Sub class 02 of the Locarno Classification (Household Goods, Not Elsewhere Specified / Cooking Appliances, Utensils and Containers).

5. The Applicant’s statement of grounds included the following claims and allegations:³
- i. The Applicant is “the originator and Copyright Holder of” the 474 design. The design is “the original thought” of an individual who, at the time of both its design and registration, was an employee of the Applicant company.
 - ii. The 474 design is “for use in professional chocolatiering and multiple crafts”. “It is a break-apart outer mould comprising 6 sections (bars). Each bar is a principal part comprising 5 smaller ‘break apart’ square cells.” The statement of grounds includes the image below, to highlight the “principal part” of the 474 design on which the Applicant bases its objection to the contested design.

³ The continuation sheet includes a statement of truth and electronic signature.
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- iii. Measurements are not part of the 474 registration (allowing the moulds to be scaled up or down by the same proportions/ratios), but the Applicant’s statement of grounds includes information on the actual dimensions of the Applicant’s mould, as published online, and claims that the circled bar (the claimed ‘principal part’) is “EXACTLY the part used by Mr Cardy.”
- iv. It includes the photo below from its website showing “samples in chocolate of the final product from the 474 design which it says is also used by crafters for making wax melts and has been widely sold online since 2014.



6. Mr Cardy filed a Form DF19B defending its design registration, which he states was inspired by chocolate bars such as Yorkie and Cadbury, and provides this image:



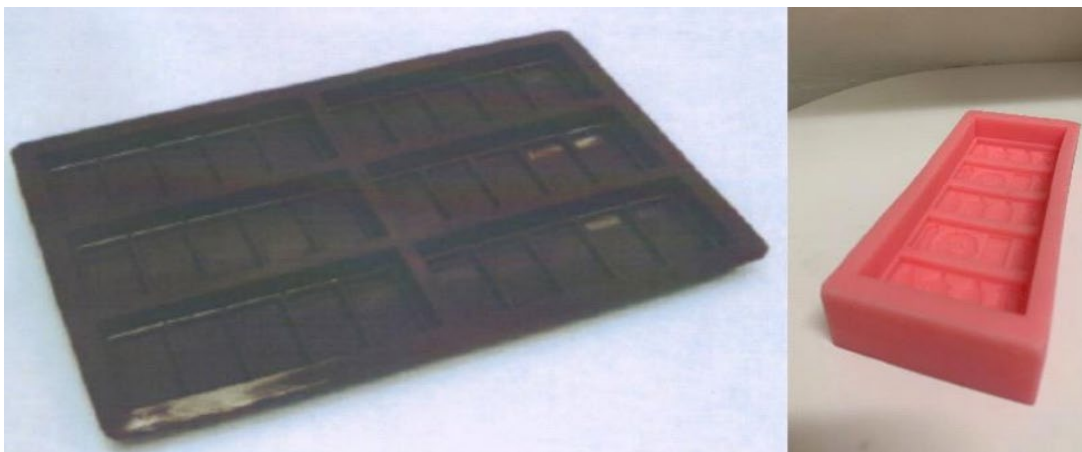
7. Mr Cardy included a signed and dated witness statement that provides images of other registered designs he owns, namely: 6136043, 6136044, 6136045, and 6136046, featuring moulds of 3 – 6 cells. His registered design **6136045** is shown here:



8. He also included images of other moulds that he has made for charity, including this five-cell mould:



9. He includes images that compare his contested design with the 474 design, and submits that they are completely different in appearance, physical shape, configuration and decoration. One such image is shown below:



10. During the evidence rounds, the Applicant filed a witness statement in which Ms Thomson reinforced points made in the Forms DF19A. 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 shall refer to the parties' submissions / evidence 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 the Applicant

14. The Applicant’s 474 design is a UK registered design and publication in the Design Journal counts as being “made available to the public”. It was registered and published in 2014, several years prior to the relevant date (28 October 2020). It is therefore clear that the 474 design satisfies the provisions of section 1B(5) of the Act.
15. I therefore turn to decide whether Mr Cardy’s contested design had the required novelty and individual character when compared with the 474 design. The 474 design is protected in respect of shape and form, but since its registration expressly states that

colour does not form part of the design, I will disregard colour for the purposes of my comparison.

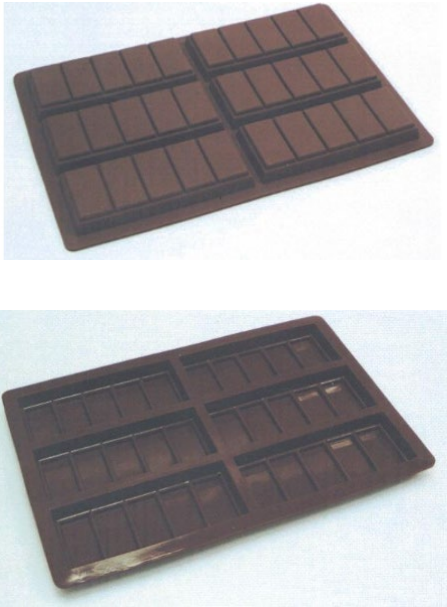

Novelty

16. 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.”⁴

Comparison of the designs

17. The registered designs are shown in the tables below:

The Applicant’s 474 design	The contested design
	

⁴ Paragraph 26.

18. In *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited*, [2007] EWCA Civ 936, Jacob LJ stated:

“12. ... It has long been the practice, where there is a physical embodiment of a registered design, for the court to look at that. Of course one has to be very careful that the physical object is a true reproduction of the design.”

19. In the present case the materials filed by the Applicant included images of the chocolate bars that are the product of its 474 mould, as shown in my paragraph 5(iv) above. Those images are of course not “a physical embodiment” of the designs – they are images of end products that may emerge from 474 design. However, the images are not entirely unhelpful, since they tend to confirm details that are anyway discernible from the images of the registered 474 design for the mould itself, which remains the true point of comparison.

20. As I understand it, the Applicant’s objection is framed on the basis that:

- (i) the contested design constitutes the “principal part” of its 474 design, and that
- (ii) the “surface embellishment” in the contested design is not sufficient to permit it to be considered new nor to have individual character.

21. With regard to point (i), the law does provide that “a design applied to or incorporated in a product which constitutes a component part of a complex product is registrable only to the extent that the visible features of the component part are new and have individual character”.⁵ However, a “complex product” is defined as “a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product.”⁶ The contested design is for a mould to produce single bars – e.g. of chocolate. The 474 design involves a base plate made of silicone, set into which are six bars - but those six bars are not “replaceable component parts”. The 474 design is not a complex product, and the contested design is not a component falling within the provisions of section 1B(8) of the Act.

22. With regard to point (ii), it must be emphasised that the fundamental emphasis of design law is the protection of the appearance of a whole or part of a product, which may arise

5 Section 1B(8) of the Act

6 Section 1(3) of the Act.

for example from the lines, contours, shape or ornamentation of the product. I note in particular the following differences between the designs at issue:

- (i) The 474 design features a base plate for six bars, featuring a total 30 rectangular cells; contrastingly, the contested design is comprised of a single bar featuring a total of 5 rectangular cells;
- (ii) The other stark difference is that the rectangular cells of the 474 design are plain, whereas the cells of the contested design features prominent representations of smiling faces and various bottles.

23. The designs at issue are obviously not identical, nor do they differ only in immaterial details, as is clear from the differences listed above. The different numbers of cells and the presence or absence of surface decoration are especially significant and are clearly not “minor and trivial”. Since I find that the differences between the contested design and the prior art of the Applicant’s 474 design are not immaterial, the objection based on lack of novelty must be rejected.

Individual Character

24. 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:⁷

“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

7 Although the UK has left the European Union, what the judge says in relation to a Registered Community Design (RCD) remains applicable to UK registered designs.

(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.”

25. 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.”⁸

The informed user

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

“33. ... The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

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);

⁸ Paragraph 58.

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).”

27. The parties’ designs are moulds registered in the same class and sub class, covering household goods/cooking utensils and containers. The informed user of the challenged designs is likely to be a person – whether a member of the public or a small business - who uses moulds to make chocolate bars (or perhaps wax melts), 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

28. 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.”

29. In the present case, the parties’ evidence included several images of silicone moulds, but the evidence does not establish *when* (or often even where) 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 the Applicant.

Design freedom

30. 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).”⁹

31. Even without regard to the images in the materials filed, as a 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. However, 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 (or ‘cells’). A chocolate bar mould

9 Paragraph 34.

will commonly feature channels for thinner chocolate, separating the chunks and enabling chunks to be snapped off in small numbers or individually.

32. 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

33. I have already identified relevant features of each of the respective designs. In my view, it is not enough to create the same overall impression that the bars in the respective designs comprise five individual rectangular cells. The differences arising in particular from the number of the bars (and consequently cells) and from the presence or absence images (faces and bottles) on the surface of the individual cells, will make a particularly significant contribution to their overall impressions in the eyes of the informed user. I find that the contested design has individual character when compared with the prior art put forward by the Applicant.
34. For completeness, I note two further points. Firstly, whether or not Mr Cardy drew inspiration for the contested design from a Cadburys or other chocolate bar, or from any other design, is not relevant to the assessment of whether the contested design lacked novelty or individual character. That assessment is based on the principles I have set out and applied in this decision. Secondly, both parties refer to Mr Cardy's registered design 6136045, which is for a bar of five cells, the surface of which, as with the 474 design, are plain.¹⁰ However, not only is registered design 6136045, not the subject of this application for invalidation, but the design register shows that it was applied for and published in 2021, so was not a design that had been made available to the public before the relevant date.

Outcome: There is no evidence to show that Registered Design No 6104929 lacked novelty or individual character at the relevant date. It therefore remains validly registered.

¹⁰ Registered design 6136045 is shown at my paragraph 7 above.

Costs:

35. The application for invalidity has failed. 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. Neither party responded to that invitation. As the Mr Cardy has incurred no official fees in defending its design registrations, I make no order as to costs in its favour.

Dated this 9th day of June 2023

Matthew Williams
For the Registrar
