

**BL O/0530/23**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN Nos. 6120307 AND 6120308**

**IN THE NAME OF ROXANNE MENDIES**

**AND**

**APPLICATIONS FOR INVALIDATION No. 54/21 and 64/21**



**BY**

**HELEN THOMSON**

**(ON BEHALF OF TEMPLETON TOOLS & MACHINERY LTD)**


## Background and pleadings

1. This decision deals with the requests filed by Helen Thomson on behalf of Templeton Tools & Machinery Ltd (“**the Applicant**”) to invalidate two designs that stand registered in the name of Roxanne Mendies (“**the Proprietor**”). Given the close overlap of their facts and issues, the invalidation requests have been consolidated to be addressed simultaneously.
2. The Proprietor’s designs are for silicone moulds as detailed in the table below. No claim is made for colour for either design.

Design Number: 6120307 “ <b>the Hearts Mould</b> ”	Design Number: 6120308 “ <b>the Stars Mould</b> ”
	
<p>The Hearts and the Stars Moulds were both applied for on 22 February 2021 and became registered with effect from that date (“<b>the relevant date</b>”) in Class 07, Sub class 02 of the Locarno Classification (namely, Household goods, not elsewhere specified / Cooking appliances, utensils and containers).<sup>1</sup></p>	

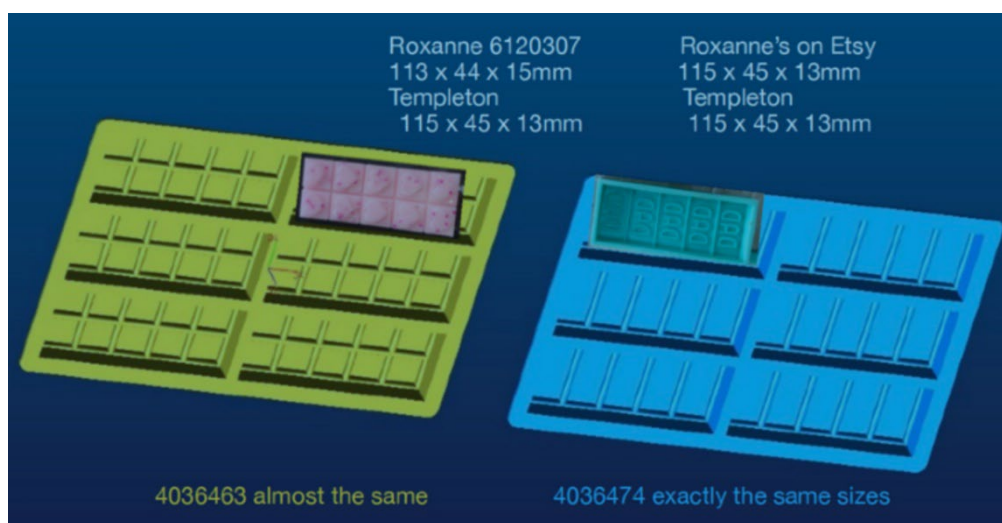
<sup>1</sup> The registration of both the Hearts and Stars Moulds was published on 16 June 2021.

4. The Applicant filed 2 x Form DF19A,<sup>2</sup> requesting that the Proprietor’s design registrations be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“**the Act**”). The Applicant claims that the Proprietor’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 small 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 (notably that presence of stars or hearts respectively). However, the consistent point of comparison for the challenges to contested designs is the Applicant’s UK design No. 4036473, registered 6 years earlier. Details of that earlier registered design are given in the table below:

<p><b>Design Number:</b> 4036473 - referred to herein as “<b>the 473 design</b>”</p> <p><b>Application / registration date:</b> 17 July 2014</p> <p><b>Publication date:</b> 22 August 2014</p> <p><b>Description:</b> 6 cell, 10 section bar silicone mould</p> <p>Colour does not form part of the design</p>	
	
<p>The 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>	

<sup>2</sup> The forms filed initially were amended on 26 October 2021, removing the original claims under other grounds s1C(1) and S1C(2), and s11ZA(3) and 11ZA (4).

6. The Applicant made various claims and allegations across its statements of grounds,<sup>3</sup> including that:
- i. The Applicant is “the originator and Copyright Holder of” the 473 design. The design of a bar mould comprising 10 cells in the format of 5 rows of 2 square cells was created in 2014 and is “the original thought” of an individual who was, at the time of both its design and registration, an employee of the Applicant company.
  - ii. The 473 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 10 smaller ‘break apart’ square cells.”
  - iii. Measurements are not part of the 473 registration allowing the moulds to be scaled up or down by the same proportions/ratios. However, the statement of grounds includes information on the actual dimensions of the Applicant’s mould as published online, and notes that the Proprietor’s Hearts and Stars Moulds involve bars of very similar sizes.



- iv. The number cited on the left in the image above – 4036463 – is not the same as the design relied on by the Applicant, but I take this to be just a typographical error and that it should read 4036473. The Applicant includes the image on the right (4036474) in order to make the point that the Proprietor (Roxanne Mendies) sells another mould (seemingly featuring the word “DAD”) that involves bars of precisely the same size. The Applicant asserts that the similarity of the Proprietor’s moulds to those of the

<sup>3</sup> The continuation sheet includes a statement of truth and electronic signature.  
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Applicant is not accidental. (A comparable image to that above is also included in the 64/21 application, where the image on the left instead features the superimposition of the Hearts Mould (6120308).)

- v. The Applicant states that “the added surface embellishments [of hearts / stars] are of no interest to us” and “are not admissible as new designs”.
- 7. The Proprietor filed Forms DF19B defending its design registrations, highlighting how they differ from the 473 design. The counterstatements were accompanied by several supporting images. Although the Proprietor 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.
- 8. 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**

- 9. 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.
- 10. 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”.
- 11. 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*

12. The Applicant’s 473 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 (22 February 2021). It is therefore clear that the 473 design satisfies the provisions of section 1B(5) of the Act.
13. I therefore turn to decide whether the Proprietor’s challenged designs had the required novelty and individual character when compared with the 473 design. The 473 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***





14. 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.”<sup>4</sup>

**Comparison of the designs**

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

<b>The Applicant’s 473 Design</b>	
	
<b>The challenged Hearts Mould</b>	<b>The challenged Stars Mould</b>
	

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

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<sup>4</sup> Paragraph 26.

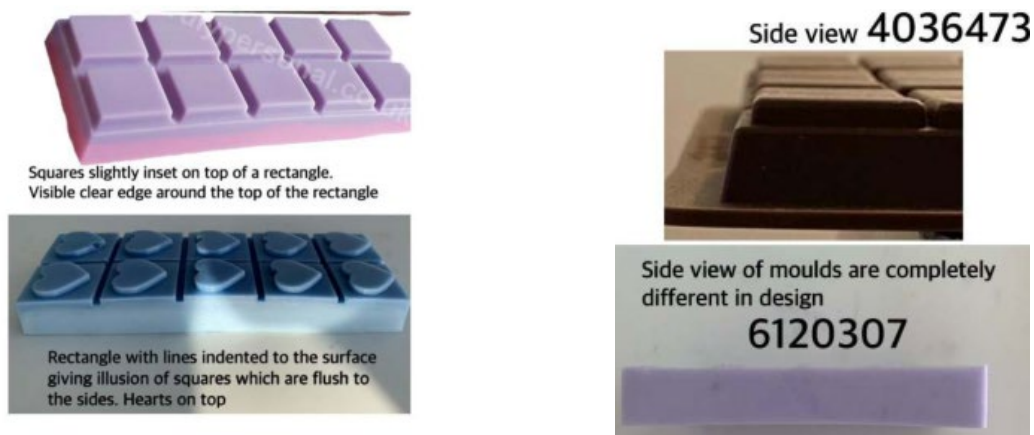


“12. ... It has long been the practice, where there is a physical embodiment of a registered design, for the court to look at that. Of course one has to be very careful that the physical object is a true reproduction of the design. ....”

17. In the present case the materials filed by both parties included images of the chocolate bars that are the product of the parties' moulds (see below). For instance, the Applicant's evidence included these images:



And the Proprietor's defence included these images:



18. These images filed by the parties are of course not “a physical embodiment” of the designs – they are images of end products that may emerge from the parties' moulds (though clearly the flower bar is not from either of the moulds at issue). However, the images are not entirely unhelpful, since they tend to confirm details that are anyway discernible from the images of the registered designs for the moulds themselves, which are the true subjects of comparison.

19. As I understand it, the Applicant's objection is framed on the basis that:
- (i) the contested designs constitute the "principal part" of its 473 design, and that
  - (ii) the hearts and stars are "embellishments" that are insufficient to permit the contested designs to be considered new nor to have individual character.
20. 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".<sup>5</sup> 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."<sup>6</sup> The contested designs are for moulds to produce single bars – e.g. of chocolate. The 473 design involves a base plate made of silicone, set into which are six bars - but those six bars are not "replaceable component parts". The 473 design is not a complex product, and the contested designs are not components falling within the provisions of section 1B(8) of the Act.
21. 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 for example from the lines, contours, shape or ornamentation of the product. The following differences are in line with points made by the Proprietor in its counterstatement:
- (i) The 473 design features a base plate for six bars, featuring a total 60 squares cells; contrastingly, each of the contested Hearts and Stars Moulds is comprised of a single bar featuring a total of 10 square cells;
  - (ii) The other stark difference is that the square cells of the 473 design are plain, whereas the square cells of the Proprietor's designs feature prominent representations of hearts and stars respectively.
  - (iii) There are also the more subtle, but in my view, still material differences, such as the squares in the 473 design being such as to cast, as the Proprietor puts it, "squares slightly inset on top of a rectangle" with a "visible clear edge around the top of the rectangle"; this contrasts with the Proprietor's moulds that are designed

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5 Section 1B(8) of the Act

6 Section 1(3) of the Act.

to produce a bar in which the indented lines extend full length and width, to generate squares that are “flush to the sides”.

22. 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 (stars or hearts) are especially significant but nor do I consider the other differences to be only “minor and trivial”. Since I find that the differences between the contested designs for the Hearts and Stars Moulds and the prior art of the Applicant’s 473 design are not immaterial, the objection based on lack of novelty must be rejected.

### ***Individual Character***

23. 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:<sup>7</sup>

“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

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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.

- (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.”

24. 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.”<sup>8</sup>

### *The informed user*

25. 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);

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain

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<sup>8</sup> Paragraph 58.

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).”

26. The parties designs are silicone 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 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*

27. 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.”

28. In the present case, the evidence included several images of silicone moulds, all of which are presumably offered for sale or have at least been published.<sup>9</sup> Some are indicated as having been for sale on Etsy. 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 the Applicant.

#### *Design freedom*

29. 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).”<sup>10</sup>

30. 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

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9 Such as the extracts in the Annexes shown at the end of this decision.  
10 Paragraph 34.

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

31. 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*

32. I have already listed the main 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 ten individual square cells, paired in two strips. The differences arising in particular from the number of the bars (and consequently cells) and from the presence or absence of heart and star shapes on the face of the individual cells, will make a particularly significant contribution to their overall impressions in the eyes of the informed user. I find that each of the contested designs has individual character when compared with the prior art put forward by the Applicant.

**Outcome:** There is no evidence to show that Registered Design Nos 6120307 and 6120308 lacked novelty or individual character at the relevant date. Those designs remain validly registered.

#### **Costs:**

33. The applications for invalidity have 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



Proprietor has incurred no official fees in defending its design registrations, I make no order as to costs in its favour.

**Dated this 8<sup>th</sup> day of June 2023**

**Matthew Williams**

**For the Registrar**

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