

O/0558/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF REGISTERED DESIGN No. 6132696

IN THE NAME OF

LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED

IN RESPECT OF THE FOLLOWING DESIGN



AND

APPLICATION 75/21 FOR INVALIDATION

BY LIMAR TRADING LIMITED

Background and pleadings

1. Lanxi Yichao Electronic Business Company Limited (“the proprietor”) filed application no. 6132696 on 23rd April 2021 to register the design shown on the front cover for ‘Mattresses and Cushions’. The design is registered with effect from this date. The representation on the front cover shows the back of the product. The front of it looks like this.



2. The following disclaimer is in the register:

“No claim is made for the colour shown; no claim is made for the material shown”

3. On 22nd 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 a product embodying the registered design was made available to the public in November 2018 on Amazon’s website. Consequently, the registered design was not new and lacked the necessary individual character at the time it was applied for and registered.

4. The registered proprietor filed a counterstatement defending the registration of the design on the grounds that:

The registered design is different to the design shown on Amazon in the application for invalidation.

1. The fabric density is different, the suction pads shown in the registered design are arranged in a grid shape, the arrangement of the pads shown on Amazon is honeycomb shape.
2. The registered design has four suction cups, the product shown by the applicant has seven suction cups.
3. The registered design includes a hook, but the product shown by the applicant does not include the hook.

Representation

5. The applicant is represented by Wilson Gunn. The proprietor is not legally represented.

6. Neither side requested a hearing. I have therefore taken this decision after a careful consideration of the papers before me.

Evidence and finding of fact

7. Only the applicant filed factual evidence (the proprietor filed 'evidence' which simply repeated arguments made in the counterstatement). The applicant's evidence consists of a short witness statement by Andrew Marsden of Wilson Gunn. It is merely a vehicle for the applicant to introduce evidence about the design it claims was published on the Amazon UK website in 2018. The single exhibit to Mr Marsden's statement consists of pages from Amazon.co.uk downloaded on 14th April 2022. This is well after the date of the contested registration, and also later than the application for invalidation. The applicant's case that the design shown on these pages was first published prior to the date of the contested design appears to be based on an entry on one of the pages in the exhibit to the effect that the product in question (called the AmazeFan bath pillow) was "*first available*" on Amazon on 29th November 2018. This

is consistent with the associated customer product reviews, which go back to 2019. I note that:

- i) A couple of the reviews from 2019 complain about the suction pads on the back of the product not sticking to the bath;
- ii) The product shown in 2022 is described as having “7 Upgraded Large Suction Pads.”

8. This suggests that the design of the suction pads may have changed between the date the product was first made available to the public and the date the webpages were downloaded in April 2022. In different circumstances this may have made it difficult to accept that the design shown on Amazon.co.uk in 2022 was first made available to the public in 2018. However, this is what the applicant claimed in the application for invalidation. The proprietor’s counterstatement did not challenge this aspect of the claim or put the applicant to proof that the design it relied on was published before the date of registration of the contested design. Rather, the sole basis of the proprietor’s defence was, and is, that the designs are different. My role is to determine the matters in dispute. Accordingly, my observations about the potential shortcomings in the applicant’s evidence do not prevent me from accepting (for present purposes) that the design relied on by the applicant was first published in 2018, as claimed.

The Law

9. 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”.

10. The relevant parts of Section 1B of the Act are 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) to (e) ---

(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) -- ”

11. Section 1C(1) of the Act is as follows:

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.”

Comparison of the designs

12. In the table below I show the registered design alongside the prior art upon which the applicant relies:

The Registered Design	The Prior Art
	



13. The first picture of the prior art is taken from a representation of it included in the application for invalidation. It shows the back of a bath pillow the applicant claims was made available to the public on Amazon’s website in 2018 under a specific reference number. The application form includes a statement of truth. I am therefore prepared to accept its contents as evidence. The second picture of the prior art is taken from the representation in the applicant’s later-filed evidence. It shows the front of the bath pillow from which five depressions (consistent with sewn-in objects in the back of the pillow) are visible on the lower section of the pillow. However, there are also other smaller pictures of the product (which are too small and too low quality to be reproduced here) which show that the back of the pillow has seven suction cups, five on the lower section and two on the top (as shown on the first picture of the prior art).

14. A design is new 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*,¹ 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

¹ [2019] EWHC 3149 (IPEC)

design in some material respect, even if some or all of the design features, if considered individually, would not be.”

15. Neither the material from which the products are made nor the “*fabric density*” (if this is different) are included in the registered design. Consequently, contrary to the proprietor’s pleaded defence, any differences resulting from the use of different material or fabric density are irrelevant.

16. There are other differences between the designs. The number of suction pads differs. The registered design has six such pads (not four as the proprietor pleads) whereas the prior art has seven. As the proprietor points out, the arrangement of the suction pads differs, the prior art having an extra suction pad positioned between (and in the middle of) the two above and below it on the lower section of the pillow. The registered design includes a hook; the prior art does not. I also note that the pillow in the prior art is covered by small circular depressions giving the appearance of a light pattern, whereas the pillow depicted in the registered design has a very fine pattern and appears almost smooth. It is possible, but not certain, that this visual difference results from the use of different material. In any event, neither side attaches any weight to this difference, so neither will I.

17. I am satisfied that, at least when taken together, the relevant differences between the designs are not immaterial. The registered design is, therefore, a new design compared to the prior art.

18. A design may be ‘new’, but still lack the necessary ‘individual character’ compared to the prior art. This depends on whether the overall impression it produces on the informed user differs from the overall impression produced on such a user by the prior art. As Birss J. (as he then was) pointed out in *Dyson Ltd v Vax Ltd*², “*The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration.*” The same applies to a comparison between the overall impression created by a registered design and that created by prior art.

² [2010] FSR 39

19. In *Cantel Medical (UK) Limited v Arc Medical Design Limited*³ HHJ Hacon, sitting as a judge of the High Court, set out a six step approach for use in the assessment of whether a design has individual character. It is as follows:

“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 [prior art] 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.*

³ [2018] EWHC 345 (Pat)

- (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.”*

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

20. The relevant sector is bathroom furniture, specifically pillows for baths.

The informed user

21. The informed user is a user of bath pillows who is deemed to be interested in the products concerned, is particularly observant, and pays a relatively high degree of attention when he or she uses them.

The designer’s degree of freedom in developing the design

22. In *Dyson Ltd v Vax Ltd*, 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).”

23. The registered design consists of a rectangular upper section joined to a lower section about twice the length of the upper section. The lower section is also broadly rectangular, except that towards the bottom of the pillow the design curves in gently from both sides. This means the lower section of the pillow is not a true rectangle. In fact the bottom of the pillow is straight for only about 60% of the total width of the pillow. The depth of the pillow is about half the length of the shorter top section. The design features a seam which flows around the visible edges of the pillow, except for the straight section at the bottom. The top and lower sections of the pillow are joined

along most of its width. The joint is flexible so as to allow the two sections of the pillow to be attached to the bath at different angles. In effect, the sections are hinged along the joint.

24. The back of the pillow has six transparent suction pads attached to it. They are arranged in a grid: two on the top section and four on the lower section. The method of attachment creates six corresponding slight depressions on the front of the pillow.

25. The top section of the pillow has a hook attached to one side.

26. Bath pillows provide a cushion allowing the user to rest his/her neck and head on the top of the bath. There is some design freedom around the dimensions. However, the length of the pillow is broadly constrained by its purpose, which is to support the user's neck and head (and possibly the top of the shoulders), as with a bed pillow. The top section of the pillow is intended to sit on the flat ledge of the bath. Consequently, there would be little point in it being much longer than a typical bath ledge. The pillow must be wide enough to accommodate the user's head and allow at least a small degree of lateral adjustment of the user's head position, but narrow enough to fit into most baths. The pillow must be deep enough to hold enough content to effectively cushion the user's head, neck etc., but not so deep as to force the user's head and neck forward at an uncomfortable angle relative to the rest of their back as they lay against the sloping end of the bath.

27. There is no specific evidence on the available means of attaching bath pillows to baths. Suction pads is an obvious solution. There may be others. Suction pads will work better if they are spread out across the back of the pillow and positioned on both sections of the pillow so they can be attached to the back of the bath as well as to the flat ledge on the top. Beyond this constraint the designer appears to be free to arrange the suction pads as he or she chooses.

28. A hook is obviously a tool to store the bath pillow when it is not in use. However, it not necessary to include a hook in designs for bath pillows.

The outcome of the comparison

29. The prior art design appears to have broadly similar relative dimensions to the registered design. They both curve in towards the bottom of the pillow. The designs have similar seamed edges, and a similar flexible joint between the top and lower sections of the pillow. The designs both have transparent suction pads on the back of the pillows for attaching them to the bath when in use.

30. The main differences are:

- (i) The top section of pillow in the registered design appears slightly longer than the corresponding section of the prior art (relative to the length of the lower sections of the pillows);
- (ii) The prior art has an additional suction pad on the lower section of the pillow positioned equidistant between the other four pads, one in each quadrant, and correspondingly has one fewer depression visible on the front of the pillow;
- (iii) The registered design has two visible depressions on the front of the top section of the pillow, whereas it is not evident that the prior art has visible depressions on the front of the top section of the pillow;
- (iv) The prior art lacks the hook visible on the side of the top section of the pillow in the registered design.

31. Differences (i) and (iii) will make hardly any difference to the informed user's impression of products embodying the registered design compared to the impression created by the prior art. Difference (ii) is potentially more significant. However its impact on the informed user is moderated by (a) the presence of suction pads *per se* being a solely functional feature, and (b) the visual difference resulting from the different number and arrangement of the suction pads on the lower section of the pillows being reduced by the fact that the back of the pillow is not visible when it is attached to the bath. The latter point means that relatively more attention will be paid to the look of the front of the pillow. Difference (iv) will undoubtedly catch the eye of an informed user, but its impact on the user's overall impression of pillows embodying

the registered design will be moderated by the knowledge that the hook is a functional feature with no significant design effect.

32. Taking all of the above into account, I find that the registered design will create the same overall impression of an informed user of bath pillows as the prior art. I therefore accept the applicant's case that registration of the contested design was contrary to section 1B of the Act.

Overall outcome

33. The registered design is invalid and will be cancelled with effect the from date of registration.

Costs

34. The applicant is entitled to a contribution towards its costs. I assess this as follows:

Official fees for filing Form DF19A: £48

Preparing DF19A and considering counterstatement: £300

Preparing evidence: £400

Total: £748

35. I therefore order Lanxi Yichao Electronic Business Company Limited to pay Limar Trading Limited the sum of £748. This sum must be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful or does not proceed.

Dated this 15th day of June 2023

Allan James

For the Registrar