

O/0589/23

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

CONSOLIDATED PROCEEDINGS

REGISTERED DESIGN NOS. 6122861, 6122862 AND 6147906

UKDOTCOM LIMITED

AND

APPLICATION NOS. 45/22, 46/22 AND 47/22

BY BBHUGME AS

TO INVALIDATE THE REGISTERED DESIGNS

BACKGROUND AND PLEADINGS

1. Registered design nos. 6122861 (“the First Contested Design”) and 6122862 (“the Second Contested Design”) were filed on 5 March 2021. Registered design no. 6147906 (“the Third Contested Design”) was filed on 12 July 2021. They are all registered in the name of UKdotcom Limited (“the proprietor”).

2. The First Contested Design is depicted in the following representation:



No claim is made for the colour or the material of the outer cover. The product is described as a “lumbar support cushion”.

3. The Second Contested Design is depicted in the following representation:



No claim is made for the colour used. The product is described as a “lumbar support cushion”.

4. The Third Contested Design is depicted in the following representations:



No claim is made for the colour or material shown. Images two and three are described as being for illustration purposes only. The product is described as a “tubular pillow wrap with decorative rings”.

5. On 24 June 2022, bbhugme AS (“the applicant”) applied for the First and Second Contested Designs to be declared invalid. On 13 May 2022, the applicant applied for the Third Contested Designs to be declared invalid.

6. The applicant claims that the First, Second and Third Contested Designs should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Design Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act states:

“(1) The registration of a design may be declared invalid

(a) [...]

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

7. The applicant claims that the First, Second and Third Contested Designs do not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character. In this regard, the applicant relies upon two images taken from Norwegian registered designs, which were filed by the applicant on 5 November 2018.

8. The proprietor filed counterstatements, accepting that the applicant’s “pregnancy support pillow” has been registered in Norway since 2018 and accepting that the applicant began trading in these goods in Norway in 2014 and in the UK in 2016. The proprietor denies that the First, Second and Third Contested Designs lack novelty and individual character when compared with the prior art.

9. Only the proprietor filed evidence. The applicant did not file evidence in reply.

10. The applicant is represented by Gunnercooke LLP and the proprietor is unrepresented. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

11. The applicant filed written submissions during the evidence rounds dated 21 October 2022 and the proprietor filed written submissions dated 1 December 2022.

12. The proprietor filed evidence in the form of the witness statement of Alice Croeser dated 10 January 2023, which is accompanied by 5 exhibits (AC1-AC5). Ms Croeser is the sole director of the proprietor.

13. The proprietor filed written submissions in lieu dated 3 April 2023.

DECISION

Preliminary Issue

14. I note that much of the proprietor's counterstatement was focused upon whether the design registrations relied upon by the applicant as prior art are validly registered. That is not a matter for me to decide; the validity of those registrations is largely irrelevant. The applicant relies upon those registrations to demonstrate that designs (which it states are immaterial in their differences to or give the same overall impressions, as the First, Second and Third Contested Designs) were made available to the public prior to the filing date for the Contested Designs.

The Law

15. Section 1B reads 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 whose features differ only in immaterial details has been made available to the public before the relevant date.

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

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

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

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

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

(6) A disclosure falls within this subsection if –

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

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

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

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

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

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

...”

16. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EQHC 1882 (Pat):

"The informed user

33. The designs are assessed from the perspective of the informed user. 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-281/10P)* [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 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 the details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).”

“Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“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).”

“Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’”.

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be

attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. 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."

"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.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of "different overall impression" is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection.

Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The Relevant Date

17. The relevant date is the application date for the contested designs i.e. 5 March 2021 for the First and Second Contested Designs and 12 July 2021 for the Third Contested Design.

The Informed User

18. The First, Second and Third Contested Designs are for a tubular pillow or pillow cover. The informed user is, therefore, a member of the general public. The informed user is a knowledgeable, observant user, possessing the types of characteristics set out in the preceding case law.

Design Corpus

19. In addition to examples of the applicant’s design for sale in the marketplace (which were contained in the applicant’s invalidation request form)¹, the proprietor has filed examples of other lumbar support pillows/tubular pillow wraps in the marketplace. For example:



¹ DF19A

20. With regard to both lumbar support pillows and tubular pillow wraps, I consider that there was likely to be a reasonable range of products available (in terms of shape, size and surface decoration) on the market at the relevant date.

Design Freedom

21. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) stated at paragraph 34 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).”

22. The designer of lumbar support pillows will, to some extent, be constrained as to the size and shape of the product as it will have to fit comfortably behind the user's lower back. There is also likely to be some constraint as to the materials used, as again it will have to be sufficiently comfortable for the user. Similarly, with regard to tubular pillow wraps, there will be some constraints as to shape and size by virtue of the fact that they must be capable of easily fitting over an appropriately shaped pillow. There will also be constraints to the extent that it will be necessary to have some sort of fastening mechanism to secure the wrap in place. However, even within the constraints identified for those products, there is likely to be a significant amount of design freedom, particularly in terms of decoration and materials.

The Comparison

23. As noted above, a design will be considered new if “no identical design whose features differ only in immaterial details has been made available to the public before the relevant date” and it will be considered to have 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”. For the applications to succeed, the First, Second and Third

Contested Designs must not be new and/or must not have individual character, when compared with the prior art.

24. In order to be considered prior art, the designs relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6). The designs were disclosed at least by 5 November 2018 when they were registered in Norway. Further, it appears that the proprietor accepts that these designs were in fact available in the marketplace at even earlier dates. Consequently, they are prior art. They are not excluded disclosures.

25. The designs to be compared are as follows:

The Prior Art	The Contested Designs
<div data-bbox="300 331 678 680" data-label="Image"> </div> <p data-bbox="209 757 770 902">(the first of these images is described as a pillow and the second is described as a pillow cover)</p>	<p data-bbox="898 309 1294 342"><u>The First Contested Design</u></p> <div data-bbox="815 412 1337 555" data-label="Image"> </div> <p data-bbox="874 725 1315 759"><u>The Second Contested Design</u></p> <div data-bbox="802 779 1350 1095" data-label="Image"> </div> <p data-bbox="890 1227 1299 1261"><u>The Third Contested Design</u></p> <div data-bbox="802 1308 1382 1402" data-label="Image"> </div> <div data-bbox="823 1476 1337 1720" data-label="Image"> </div> <div data-bbox="826 1794 1329 1944" data-label="Image"> </div>

26. I note that no claim is made to the colour or materials shown in the First Contested Design. With that in mind, in my view, the First Contested Design shares the following attributes with the prior art:

- a) They are both tubular in shape;
- b) They are both drawn in at the end of the cushion, with a length of material overhanging at each end;
- c) They are both longer than their width;
- d) They are both absent of surface decoration.

27. However, they differ in the following ways:

- a) The prior art appears to be shorter in length than the First Contested Design;
- b) The First Contested Design appears to use bands/rings to hold the fabric in place, whereas in the prior art the fabric is secured with a knot;
- c) The length of material overhanging in the prior art is noticeably longer than it is in the First Contested Design;
- d) On the short side of the prior art there is a circle (in white) surrounding the tie, which does not appear to have a counterpart in the First Contested Design.

28. In my view, the same overlaps apply to the comparison with the Second Contested Design. However, there is an additional similarity created by the similar materials used (which are not disclaimed from the Second Contested Design). There is also a further difference created by the fact that the tie only appears at one end of the Second Contested Design (whereas the material is secured at both ends of the prior art).

29. With regard to the pillow cover shown in the second image of the prior art, this shares the following attributes with the Third Contested Design:

- a) Both appear to be tubular in shape (although the full extent of the prior art is not visible from the image provided);
- b) Both appear to be longer than they are wide.

30. However, they differ in the following ways:

- a) The Third Contested Design is secured in place by two bands/rings, which do not appear to be present in the prior art.

31. Clearly, there are some differences between the designs. In my view, these differences are more than immaterial. Consequently, the claims that the First, Second and Third Contested Designs are not new fails. However, I must also consider whether these differences are enough to create a different overall impression. In *Samsung, Birss HHJ* set out the correct approach to the comparison in an infringement case. The same approach also applies to invalidity. At paragraph 58, he stated:

“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.”

32. In my view, the marks do not share the same overall impressions. Bearing in mind the parts of the designs that must overlap to some degree (by virtue of their purpose and function), I consider the differences to be sufficient to create a different overall impression. In particular, the different fastenings used in the designs is a clear and significant point of difference. Consequently, the First, Second and Third Contested Designs neither lack novelty or individual character.

CONCLUSION

33. The applications for invalidation fail.

COSTS

34. The registered proprietor has been successful and is entitled to a contribution towards its costs. As the proprietor is unrepresented, it must file a costs proforma if it wishes to make a claim for costs. If so, it should file a completed proforma within 14 days of the date of this decision. I will then issue a supplementary decision on costs.

35. The appeal period will not commence until the supplementary decision on costs is issued.

Dated this 22nd day of June 2023

S WILSON

For the Registrar