

**BL O/0674/23**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN No. 6174333**

**IN THE NAME OF MD NADIM HOSSAIN**



**AND**

**THE APPLICATION FOR INVALIDATION THERETO (No. 55/22)**

**BY MALEEHA YOUSUF BERTIN**

## **Background and pleadings**

1. MD Nadim Hossain filed application no. 6174333 for a registered design for a “moss pole” in Class 08, Sub class 08 of the Locarno Classification (fastening, supporting or mounting devices not included in other classes) on 8 November 2021. The design was registered with effect from that date and is depicted in the three representations shown later in this decision.

2. On 23 May 2022, Maleeha Yousuf Bertin requested that the registered design be declared invalid under Section 1B/11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which requires that a registered design be new and have individual character. Ms Bertin attached to her claim form what she states to be prior art which destroys the novelty of the registered design.<sup>1</sup> I will refer to the claimed prior art later in this decision.

3. A notice of defence and counterstatement was filed by Mr Hossain, denying the claim and pointing out the differences between the registered design and the claimed prior art, using images to compare them.

4. Neither party is professionally represented. Both filed evidence. Neither party asked for a hearing or filed written submissions in lieu of attending a hearing. I make this decision after carefully considering all the papers filed in these proceedings.

## **Evidence**

5. The applications and the counterstatement were signed with a statement of truth and their contents can be treated as evidence, in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (“the Rules”).

6. Mr Hossain’s witness statement is dated 31 October 2022, adducing three exhibits.

---

<sup>1</sup> Form DF19A.

7. Evidence supporting the application was filed by Pierre-David Bertin, who states that he has been the Director of Tijara Services Global Ltd since April 2021.<sup>2</sup> His first witness statement is dated 25 August 2022 and he attaches three exhibits. Mr Bertin's amended evidence in reply is dated 27 February 2023, attaching four exhibits.

8. Following the filing of Mr Hossain's evidence, Ms Bertin said that she wished to file evidence in reply, consisting of physical examples of products. She asked for the address to which these should be sent, and was told by the Tribunal to send them to the Intellectual Property Office, but that it was not really necessary for the Hearing Officer making the final decision to have physical examples to consider. Ms Bertin sent a parcel to the IPO on 30 December 2022. However, the parcel did not contain any reference to these proceedings (such as the case number or the design registration number) and so it took the Tribunal some time to locate the parcel, given the volume of intellectual property right filings and ongoing proceedings at the IPO.<sup>3</sup>

9. The Tribunal wrote to Ms Bertin on 6 February 2023, noting that she had filed written submissions and a product sample. Neither of these had been copied to Mr Hossain. The Tribunal pointed out that the submissions and product sample could not be admitted to the proceedings in their current form, because the product sample had not been filed in correct evidential form (i.e. as an exhibit to a witness statement) and the submissions referred to facts which had not been filed as evidence. Ms Bertin was permitted until 27 February 2023 to rectify the deficiencies. The second witness statement of Mr Bertin, dated 27 February 2023, makes no reference to the physical product sample. His evidence in reply is very similar to his first set of evidence.

10. In any event, I am required to compare the registered design with the claimed prior art. Without at least knowing when or from where the product sample was obtained, even if I had seen it, the product sample would have been no assistance to Ms Bertin.

---

<sup>2</sup> Nothing turns upon the evidence coming from someone other than Ms Bertin and there is no *locus standii* requirement. Anyone may apply to invalidate a registered design under section 1B of the Act.

<sup>3</sup> For example, the Tribunal is currently dealing with 7,500 sets of live proceedings.

## Decision

11. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground that it was not new or that it did not have individual character on the date on which it was filed (section 1B). Section 11ZA(1)(b) reads:

“(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...”

12. Section 1B reads:

“(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 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.

(8) .....

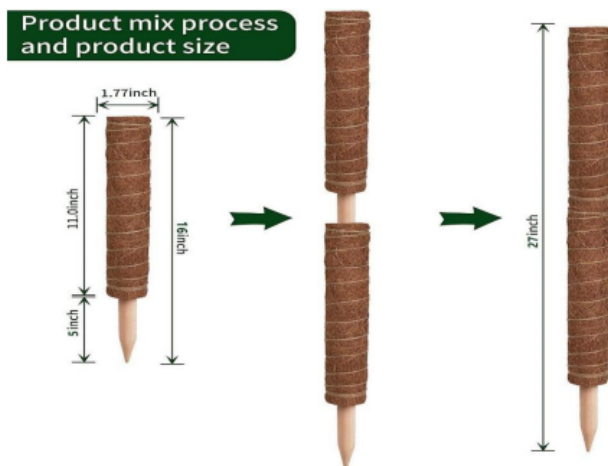
(9) ....”.

13. According to section 1B(7) of the Act, prior art (a design which has been made available to the public before the relevant date) can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked, unless the exceptions in subsection (6) apply. The relevant date is 8 November 2021. Mr Hossain claims in his witness statement of 31 October 2022 that he first disclosed his product on Amazon on 16 May 2021.

14. I have reproduced below the claimed prior art images shown in Mr Bertin’s first and second witness statements.<sup>4</sup>

(i) Claimed date of the prior art: 8 July 2021

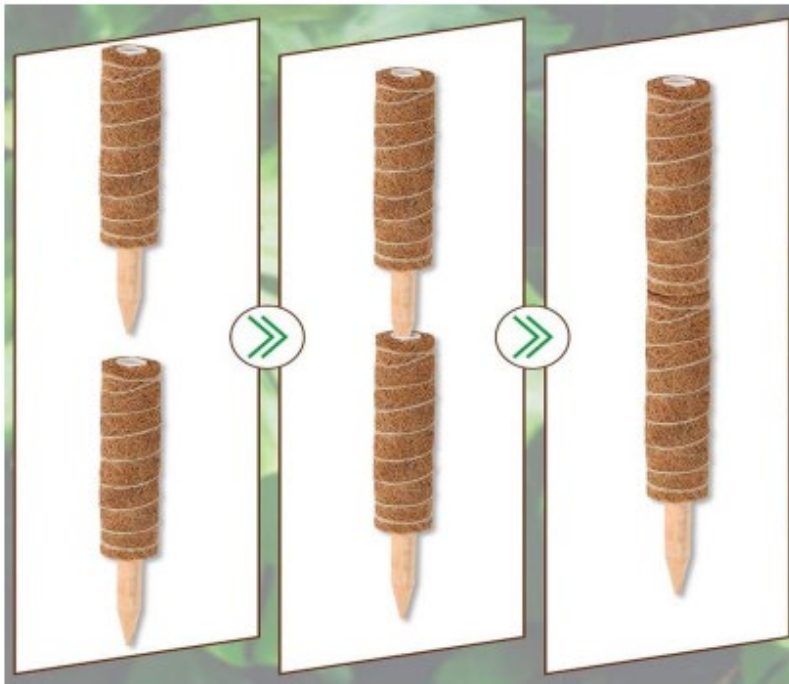
Exhibit #1.2 - Brand name: MABUSIYI, Date first available: 8 July 2021, Marketplace: Amazon  
Design:



<sup>4</sup> Examples (i) and (ii) only were shown in the first witness statement. All three examples of prior art were shown in the application for invalidation.

(ii) Claimed date of the prior art: 8 July 2020

Example #2.0: Brand name: Augshy, Date first available: 8 July 2020, Marketplace: Amazon  
Design:



(iii) Claimed date of the prior art: 8 July 2020

Exhibit #1.1 - Brand name: Feelava, Date first available: 29 May 2020, Marketplace: Amazon  
Design

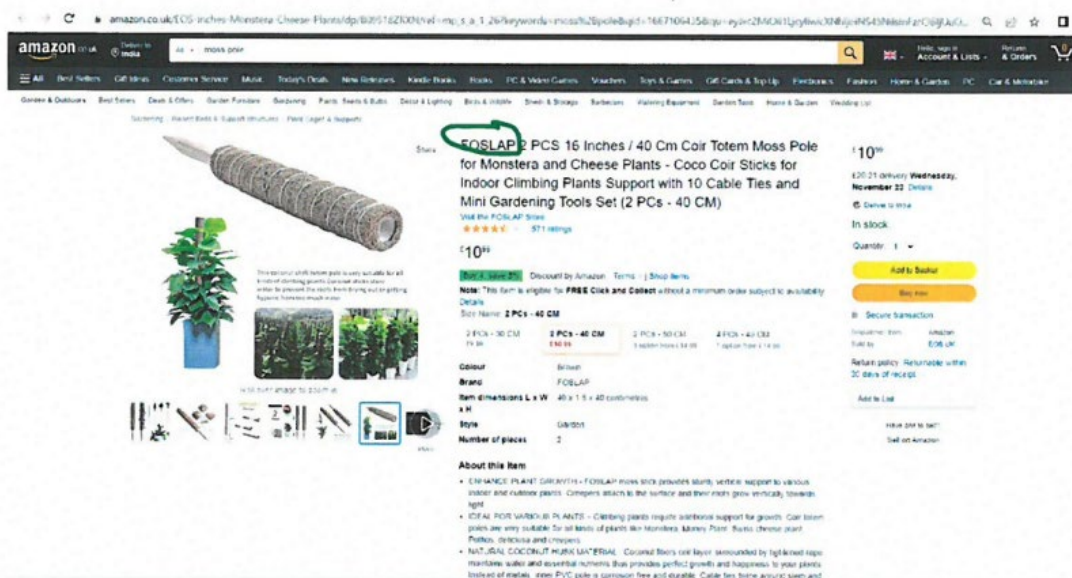


15. Mr Bertin has made a statement that these products were available on Amazon at the stated dates. It would have been preferable to have exhibited screenshots of the listings, or some other way of showing from where Mr Bertin obtained the claimed dates. However, I note that Mr Hossain has not disputed the provenance of the images. In fact, he states the following in his counterstatement (my emphasis):

“Proprietor/Registrant for the design number 6174333 is aware of the different Amazon platform sellers who sell similar appearing designs but the Proprietor for the registered design 6174333 had differentiated his design over the three competitors (Feelava, MABUSIYI, AUGSHY) existing in the market places (such as Amazon) and thereafter applied for registering his novel design”.

16. The inclusion of the word ‘thereafter’ indicates to me that Mr Hossain accepts that he registered his design after the prior art was made available to the public. He claims the defence provided by the exceptions in section 1B(6) of the Act; it appears, specifically, subsection (6), that the disclosure is excepted if it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date. The twelve month period immediately preceding the relevant date was from 8 November 2020 to 7 November 2021. Mr Hossain claims in his witness statement that he first disclosed his product on Amazon on 16 May 2021. To substantiate this, he has filed Exhibit NH3, which he states was his disclosure of the product (design) on Amazon, with the brand name FOSLAP:





17. I note that Mr Hossain states in his witness statement that his disclosure pre-dates the MABUSIYI prior art (image (i) above) and that the MABUSIYI evidence is not, therefore, prior art. The MABUSIYI evidence is dated 8 July 2021, which is after the beginning of the twelve-month period for the disclosure exception. Mr Hossain's disclosure on Amazon was not obscure, any more so than the claimed prior art, which was also made public on Amazon. I agree with Mr Hossain that the MABUSIYI evidence is not prior art. However, he is silent in his evidence about the other two pieces of claimed prior art, from Feelava and Augshy, dated 29 May 2020 and 8 July 2020, respectively. These clearly pre-date the relevant twelve-month period, which began on 8 November 2020. The Feelava and Augshy evidence may be relied upon as prior art.

18. I note that Ms Bertin refers in her application for invalidation to "many" Chinese manufacturers having sold moss pole products for over two years, and she gives two such names. However, there are no images or any other information, so I have not

taken these references into account because they do not show any relevant facts (i.e. dated product images and where they were made public).

19. Having established that there are two pieces of prior art, the next task is to compare the prior art with the registered design. I will look at whether the contested registered design had individual character rather than whether it was new: if it did not have individual character at the relevant date, it cannot be new. The law on overall impression was summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user’s awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

(a) the sector in question,

(b) the designer's degree of freedom, and

(c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

20. HHJ Birss QC (as he was then) stated in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“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 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.”

21. Section 1B(3) states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. In the absence of evidence about moss poles in general, it is difficult to make a finding about the design corpus. No evidence is provided about whether there are restrictions to design freedom in respect of moss poles. Ms Bertin has not said or shown in evidence what they are for. I can see from Mr Hossain’s Exhibit NH3, reproduced above, that they are plant supports. A pole is long and narrow.<sup>5</sup> I infer that there is a certain amount of design restriction in that moss poles are likely to be long and narrow poles covered in, presumably, moss.<sup>6</sup> As they are for supporting plants, they will be curvilinear rather than rectilinear, as it will be harder to train or support a plant against a pole with corners. The parties have only shown straight poles in their evidence. There must, however, be a degree of design freedom in how long they are, and how much they are covered in moss, either in length or width of the moss.

22. Individual character must be assessed through the eyes of the informed user. The informed user of the design at issue is a person who uses and is familiar with moss poles. The informed user is not an ‘average’ consumer but is someone who will have an interest in such products. However, they will not examine the design with forensic attention to detail.

---

<sup>5</sup> Online Oxford English Dictionary, accessed on 30 June 2023: “a long, straight, slender, and more or less cylindrical piece of wood or another material, used in scaffolding, as a support, or for various other purposes.”

<sup>6</sup> Although the evidence of both parties suggests the material is coir or some such substance.

23. The contested design illustrations on the register, of which there are three (I have labelled them (a), (b) and (c)), are as follows:



(a)

(b)

(c)

24. Mr Hossain states that the patterns of the thread wrapped around the pole in his design are different to those of Feelava and Augshy. He seeks to show this in his Exhibit NH2, which is a comparison of illustration (c) with what looks like the middle picture from the MABUSIYI image. However, as this is not prior art (and Mr Hossain claims this to be so), the exhibit is redundant. I can see that there are differences between the threading in the contested design and the Feelava image, whereby the spirals appear closer together than in the contested design, and they are pointing down and towards the right of the pole in the contested design compared to the prior

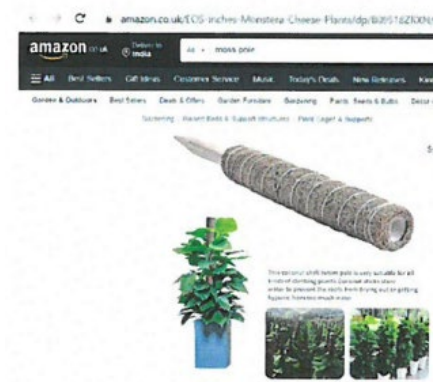
art. There are similar differences in the double wrapping which appears three times along the pole in illustration (c) compared to both pieces of prior art.

25. However, I note that the double wrapping in illustration (c) is different to illustrations (a) and (b) of the contested design, which only have double wrapping at the top and bottom of the bound material. This is highlighted by Mr Bertin in his second witness statement:

“... the images used for the patent registration number 6174333 themselves display different positions as far as string patterns are concerned. The other indicia substantiates clearly the fact that this feature is in no way a material feature of the moss pole. One could even argue, that if the patterns of the string were of such importance, and really made an impact on the visual appearance of the moss pole, at least, we could have expect the patent owner to ensure that the photos submitted were matching.”

26. I consider that there is force in this point. The wrapping of the string appears to be a functional way to secure the moss (or coir, as Mr Hossain says) to the pole, tied off with a double wrap, rather than being an aesthetic design choice. If it were an aesthetic choice of the designer, I would have expected the string in the three illustrations in the contested design registration to be the same. That they are not suggests to me that the feature is, as Mr Bertin puts it, immaterial. The informed user is unlikely to give the similarities or differences of the string patterns, as represented in the contested design and the prior art, any significant degree of importance.

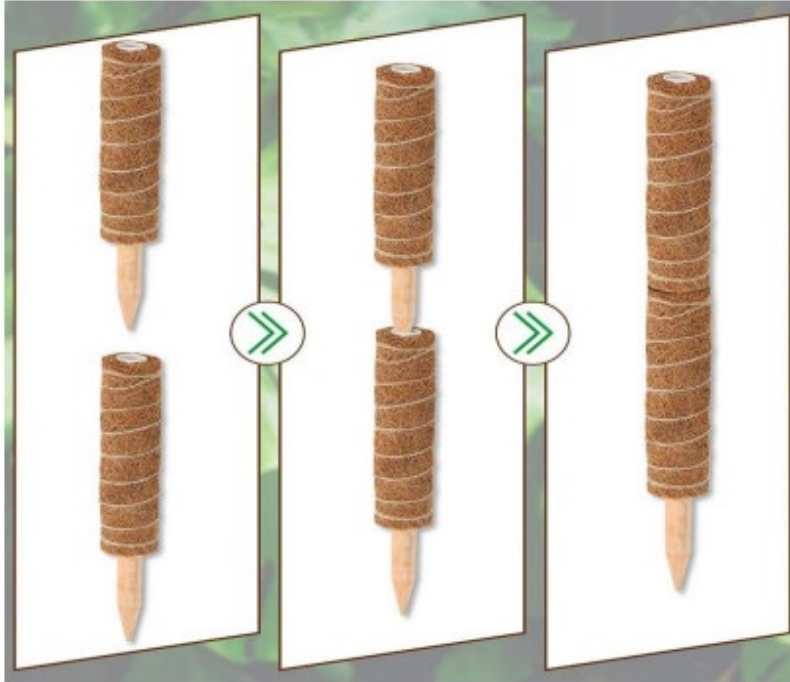
27. The Augshy image shows the capacity of the poles to be inserted by the tip into the top of another pole to make a longer pole. This is also shown in representations (a) and (b) of the contested design. Neither the Feelava image nor the design illustrations show the top section of the pole, whereas the Augshy image does, in the form of what looks like a hollowed out part of the pole. This is a point of difference between the Augshy evidence and the design. However, I note that the evidence upon which Mr Hossain relies for the disclosure exceptions (reproduced above) also shows the hollowed out top of the pole, like the Augshy evidence:



28. In his counterstatement, Mr Hossain states that the Feelava product is curvy whereas his design has straight sides. The Feelava design is:



29. I agree that the tightness of the string has caused the material it binds to bulge slightly in the gaps between the string, which could be a point of aesthetic choice, and make a difference to an informed user in terms of importance. However, this is not the case for the Augshy product, which has straight sides like the contested design:



30. Mr Hossain states that the length and pointedness of the tip in his design is a further point of difference; although again, he appears to be comparing it to the MABUSIYI design which I have discounted as prior art.

31. Given the potential for the poles to be elongated by inserting the tip of one into the top of another, it could be a point of difference that the length of the tip was longer and therefore more secure once joined than that of a shorter tip. However, I am unconvinced that the prior art shows a shorter, or less pointed, tip than the contested design. I note, once again, that there appears to be a difference between illustrations (a) and (b) and that of (c) in this regard. The tip appears slightly longer in (c):





(a)

(b)

(c)

32. However, I cannot see any discernable difference in tip dimensions or pointedness between illustrations (a), (b) and the prior art:



Augshy



Feelava

33. If there are such differences, they would require forensic examination to spot, something which the caselaw states would not be a feature of the informed user.

34. The closer of the two pieces of prior art is the Augshy evidence in view of the curvier appearance of the bound material in the Feelava evidence. Although the Augshy evidence also shows the round hole at the top of the pole, absent from the design, illustrations (a) and (b) of the contested design show that the poles are meant to interconnect by the pointed tip being inserted into the top of another pole. The overwhelming inference is that the contested design has a hole in the top. Furthermore, Mr Hossain's evidence upon which he relies for the disclosure exceptions defence also shows the round hole at the top of the pole. I infer that this is why Mr Hossain has been silent about the 'hole' aspect of the Feelava evidence. I have borne in mind the limitations to the degree of design freedom. However, balancing that consideration with the insignificant differences between the design and the prior art, I find that the overall impression of contested design 6174333 on the informed user does not differ from the prior art. 6174333 did not have individual character at the relevant date or at the date which was twelve months prior to the date of application.

### **Outcome**

35. I find that design registration number 6174333 did not have individual character when it was filed or twelve months prior to the date of application. It is therefore invalid. The application for invalidation of the registered design succeeds under section 11ZA(1)(b) of the Act.

### **Costs**

36. Ms Bertin has been successful and is entitled to a contribution towards her costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 2 of 2016. As Ms Bertin is unrepresented, at the conclusion of the evidence rounds the tribunal invited her to indicate whether she intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of her actual costs, including providing accurate estimates of the number of hours spent on a range of

given activities relating to the prosecution of the proceedings. It was made clear to Ms Bertin that if the pro-forma was not completed that costs, other than official fees arising from the action, may be not awarded.<sup>7</sup> Since Ms Bertin did not respond to that invitation within the timescale allowed (nor has any response been received from Ms Bertin prior to the date of the issuing of this decision), and as the only official fee which Ms Bertin has incurred was the fee for filing the application (£48), this is the only award of costs which I will make in her favour.

37. I order MD Nadim Hossain to pay to Maleeha Yousuf Bertin the sum of **£48**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12 day of July 2023**

**Judi Pike**

**For the Registrar**

---

<sup>7</sup> By way of a letter dated 30 March 2023.