

O/0924/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6109463
IN THE NAME OF MONTANA DAVIS-HUNTER
IN RESPECT OF THE FOLLOWING DESIGN**



AND

**AN APPLICATION FOR INVALIDATION NO 49/21
BY LAUREN BUTLER**

BACKGROUND AND PLEADINGS

1. Montana Davis-Hunter (“the registered proprietor”) filed Application No. 6109463 for a registered design for a disco ball planter on 10 December 2020 (“the relevant date”). It was registered with effect from that date and published on 2 February 2021 in Class 11, Sub-Class 02 of the Locarno Classification (Trinkets, Table, Mantel and Wall Ornaments, Flower Vases and Pots). The representations for the design can be found in the Annex to this decision.

2. The following disclaimers were entered on the register: *“No claim is made for the colour of the disco ball or the colour of the rope attached. No claim is made for the stick-on hook shown.”*

3. On 29 June 2021, Lauren Butler (“the applicant”) applied for a declaration of invalidity against the registered design under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design did not meet the requirements of section 1B of the Act that designs must be new and have individual character. She claims that the design was in the public domain long before the relevant date. She says that she had made some disco ball planters having seen some ideas on the internet and hung them in her hair salon. The registered proprietor then contacted Ms Butler and said she had stolen her design.

4. The registered proprietor was given a deadline of 24 August 2021 to file a defence. As none had been received, the Registry wrote to her on 31 January 2022 stating that it was minded to deem the application undefended. The registered proprietor wished to be heard on this matter and the joint hearing took place on 14 March 2022. In the meantime, the registered proprietor had filed a defence on 15 February 2022. I directed the registered proprietor to file further material to inform my decision, which was issued on 21 June 2022 as BL O/534/22. I decided to admit the Form DF19B into the proceedings.

5. The registered proprietor states that she believes that the applicant had seen her work in the UK and that this work had been the main inspiration for the design used

by the applicant in her salon. She also claims that the designs the applicant included in her application look nothing like her registered design and are based in the US.

6. There is no evidence beyond what was filed with the DF19A and DF19B.

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

PRELIMINARY POINTS

8. As neither side has legal representation, I consider that it might be helpful to clarify a few points at the outset. First, it is important to keep in mind that a registered design protects the appearance of a product, or part of a product. This means that it protects what this particular disco ball planter looks like, rather than the idea of using a disco ball as a planter. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court, said:

“31. I start by reminding myself that what really matters is what the court can see with its own eyes (per Jacob L.J. in *Dyson Ltd v Vax Ltd* [2011] EWCA Civ 1206 at [8] and [9], emphasising a passage from his judgment in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936; [2008] ECDR 3; [2008] FSR 8 (at [3] and [4])). The most important things are the registered design, the accused object and the prior art and the most important thing about each of these is what they look like.” (my emphasis)

9. That was said in the context of an infringement case (where a party owning a registered design alleged that “the accused object” infringed its rights). In the present proceedings, I have to compare the registered design with what is referred to as “the prior art”. This term simply means the designs that the applicant is alleging were available earlier than the relevant date of 10 December 2020. Later in my decision, I shall explain how I am required to do this.

10. Whether the planters that were used in the applicant's hair salon were copies of the registered design, or were too close in appearance, is not a matter I am able to decide. The present proceedings are relatively narrow in scope. The question is whether the registered design meets the requirements of the legislation that it must be new and have individual character.

11. I also need to make a point about the relevance of EU law to this decision. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period (i.e. at 31 December 2020). The provisions of the Act relied on in these proceedings are derived from an EU Directive. That is why there are references in this decision to the designs case law of the EU courts.

DECISION

Legislation

12. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid–

...

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

13. Section 1B of the Act is as follows:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

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

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

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

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

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

(6) A disclosure falls within this subsection if–

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

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

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

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

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

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

...”

Prior Art

14. Before comparing the designs, I must decide whether the examples given by the applicant were made available to the public before the relevant date.

15. The first image is the following Instagram post which shows a disco ball planter on sale in Asda. The applicant states that this planter was available in May 2020, which is before the relevant date. The quality of the image is not particularly good, and I cannot read the date of the post. However, I can just make out that the comments were made 58 weeks prior to the retrieval of the post. As the DF19A was filed on 29 June 2021, I can accept that the image was posted no later than May 2020.



16. Next, there is a selection of results from an internet search for “disco ball planter 2020”. I shall only refer to those that are accompanied by an image of the planter, as what matters is what the respective designs look like. The following images are, in my view, too small and indistinct for me to be able to use them as comparisons.



Way to Grow: Turn a Disco Ball Into a Groovy Planter | HGTV
 YouTube · HGTV
 10 May 2018

www.youtube.com › watch

DIY Disco Ball Hanging Planter - YouTube



This tutorial shows you how to utilize a simple hanging ceramic planter and transform it into a disco ball ...
 26 Jun 2020 · Uploaded by audreyObscura

17. The next image is larger and refers to a disco ball planter seen on TikTok. The post dates from “1 year ago”. As with the image of the goods on sale in Asda, I can accept that this was published before the relevant date.

↑ Posted by u/tenoresesa 1 year ago
12 Saw this on tiktok and thought you guys would like it and be inspired! A styrofoam disco ball cut out to be a planter (plastic potted plant was put into the ball)
↓
PLANT HOMES



18. The final image is shown below:



19. The applicant states that this Instagram account listed the planters shown in the image as being for sale from September 2020. I cannot make out the date at the bottom of the post, but I can see that the comment “*Today is Disco Friday*” was posted 29 weeks before the example was captured for inclusion in the DF19A. By my calculations, this means that the image was posted on or before 8 December 2020, which is before the relevant date.

20. The registered proprietor claims that the images come from the US. I do not accept this criticism in the case of the first image reproduced in paragraph 15 above, as the prices of the goods are shown in sterling. Even if the others do come from the US, this does not necessarily mean that they cannot be relied on as prior art: see *Senz Technologies BV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined cases T-22/13 and T-23/13, paragraph 27. The requirement is that the posts could reasonably have become known to the persons specialising in the sector concerned, which I consider would cover vases, planters and plant pots. They were available on Instagram and TikTok, which are easily accessible. In paragraph 41 of his judgment in *Magmatic Limited v PMS International Limited* [2013] EWCH 1925 (Pat), Arnold J (as he then was) held that the burden of proving that the publication could not reasonably have become known to these persons rests with the party making such an argument.¹ In this case, this would be the registered proprietor. The burden of proof has not been discharged and so I find that the designs shown in paragraphs 15, 17 and 18 are prior art on which the applicant may rely.

Novelty

21. 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:

“26. ‘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.”

22. In the table below, I show the registered design alongside the prior art upon which the applicant may rely. Further views of the registered design can be seen in the Annex to this decision.

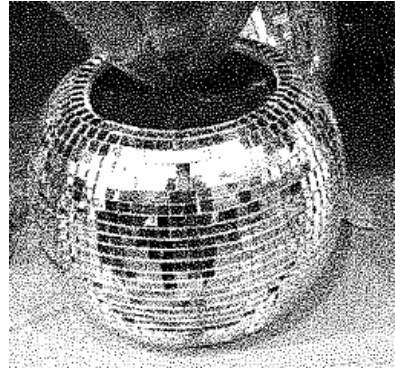
¹ This part of the judgment was unchallenged on appeal.

The Registered Design



The Prior Art

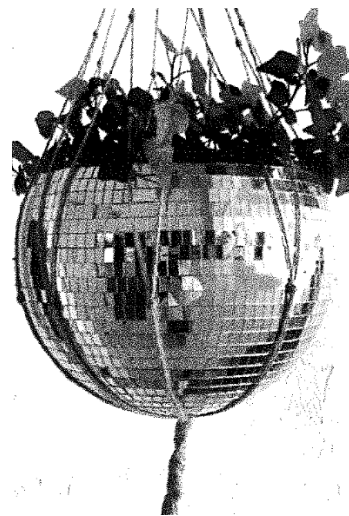
Earlier Design No. 1:



Earlier Design No. 2:



Earlier Design No. 3:



23. All the designs consist of a mirrored ball, the top of which has been removed, leaving a hollow which can be filled with plants. There are significant differences between the registered design and Earlier Design No. 1 in that the prior art appears to have a flat bottom to enable it to rest on a surface and no means of hanging it from a ceiling or wall. These are more than immaterial details and so I find that the registered design would have novelty when compared to this particular piece of prior art.

24. Earlier Design No. 2 does have a means for hanging the planter. This consists of four lengths of an unidentifiable material that surrounds the ball in what seems to be a diamond pattern. The angles at which these lengths rise up from the ball suggest that they meet at a single point, which is not visible from the image I have before me. Similarly, the image does not show the bottom of the planter so I cannot see how the other ends of the lengths are tied together, nor whether the bottom of the planter is flat or curved.

25. Contrast this with the registered design. The lengths here are clearly of rope and are doubled. Magnifying the first of the representations of the registered design shows that the diamond pattern is created by separating out and then joining the strands. The knots at the points of separation and joining are large enough to be noticeable.



26. There is a large knot at the bottom of the ball and eight strands of rope dangle down from this. There is a further large knot some distance above the ball, with a loop enclosing a small metal ring which will be used to hang the planter. I find that these differences between the registered design and Earlier Design No. 2 are also more than immaterial details.

27. Finally, I come to Earlier Design No. 3. Here, the ball is suspended by a larger number of lengths of material. From the spacing visible in the image I have been provided, I consider it reasonable to infer that there are eight. They descend vertically down the ball and are drawn together in a knot at the bottom. I find that the larger number of lengths and the different configuration of these lengths are more than immaterial differences.

28. When compared with each of the items of prior art, I find that the registered design was new at the relevant date.

Individual Character

29. 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* [2010] FSR 39, “*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 of the overall impression created by a registered design compared to the prior art. A design may create the same overall impression on the informed user as another design, while being different from it in some respects. What I need to do is to assess these similarities and differences and take a step back to consider their impact on the overall impression of the design.

30. 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:

“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.”

31. I also bear in mind the comments of HHJ Birss QC (as he then was) in *Samsung*:

“58. ... 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. A further point I must bear in mind is that in assessing whether the contested design has individual character, I must not take features from several earlier designs and combine them, as the Court of Justice of the European Union ruled in *Karen Millen Fashions Ltd v Dunnes Stores & Anor*, Case C-345/13:

“35. ... Article 6 of Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs is to be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.” (my emphasis)

33. I must compare the contested design with each of the three items of prior art shown in the table in paragraph 22 above.

The sector concerned

34. Earlier in my decision, at paragraph 20, I found that the relevant sector was vases, planters and plant pots.

The informed user

35. In *Samsung*, HHJ Birss QC (as he then was) 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

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).”

36. The informed user is a person who is interested in interior decoration, in particular in planters and other containers used for plants. They pay a relatively high degree of attention to the products, the appearance of which will be an important factor in choosing between items for their home or other premises.

37. The informed user will have knowledge of the design corpus. This means that they will be aware of current trends in the design of containers for plants. This factor can be significant if an earlier design was markedly different from what has gone before and so is likely to have a greater visual impact: see *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited*, [2007] EWCA Civ 936, paragraph 35(iii). However, I have no evidence before me to indicate what other designs have been used for products of this type and so am unable to assess the extent to which the earlier designs shown in the table in paragraph 22 above represent a departure from what was previously available.

Design freedom

38. In *Dyson Ltd v Vax Ltd*, [2010] FSR 39, Arnold J (as he was then) stated that:

“34. ... 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).”

39. The technical function of a planter is to hold plants. Therefore, it must have a hollow in which a potted plant or compost can be placed. Aside from this, there is a considerable degree of design freedom in the shape of the planter, its colour,

the materials used and whether it has a flat base, feet or is to be suspended from a ceiling or wall.

Overall impression

Comparison with Earlier Design No. 1



40. I shall not carry out a full comparison of these designs. While both planters are mirrored balls, the earlier design has a flat base that enables it to sit on a shelf or other flat surface. The other two pieces of prior art are hanging planters so are closer to the contested design. If the contested design has individual character over those two designs, it will also have individual character over Earlier Design No. 1.

Comparison with Earlier Design No. 2



41. Both these designs are planters made from mirrored balls. I note that the image of the earlier design is in black and white so it is not possible to know what the colour is. However, colour is disclaimed in the contested design, and so this feature is not relevant to my comparison. I have already referred to both designs sharing the same diamond patterning of the ropes, chains or threads on the surface of the ball, with four lengths ascending to what I consider it reasonable to infer from the image of the earlier design is a single point. The top of both balls has been removed.

42. Now I come to the differences. I have already noted that the bottom of this earlier design is not shown, and it would not be reasonable for me to make any inferences about its appearance. The bottom of the planter could be flat or it could be curved. The supporting ropes, chains or threads could be tied together in a knot close to the base with dangling tails, as in the contested design. Alternatively, they could, if strong enough, form a net around the surface of the ball. This brings me on to another point: it is not possible to tell from the image of the earlier design what the ropes, chains or threads are made from and so how they might appear to the informed user. What I can say is that they look to be thinner than the rope used in the contested design. It is also not clear how they are joined together at the top, and again I consider that I am not able to make any reasonable inferences on that point.

43. I consider that the ropes, in particular the dangling rope at the bottom, of the contested design produce on the informed user a different overall impression than that produced by Earlier Design No. 2, based on the features of that earlier design that I can see. Consequently, I find that the contested design has individual character when compared with Earlier Design No. 2.

Comparison with Earlier Design No. 3



44. Both designs contain a mirrored ball with the top removed. While it is not possible to be entirely sure, I consider that it is likely that the ball in the Earlier Design No. 3 is also suspended by ropes. This is because of the way that they appear to be knotted together at the bottom of the ball. They extend below the ball, but from the image above it is not possible to tell by how much, or whether there are further knots or if the lengths dangle fairly freely, as in the contested design. Earlier Design No. 3 appears to use eight lengths of rope. As noted above, this is an inference I have made on the basis of the spacing of the ropes that I can see on the image above. The configuration of those ropes is, as I have already mentioned, different. The diamond pattern can be seen in the contested design, and this has no counterpart in the earlier design. Above the ball, Earlier Design No. 3 has a more cluttered look: the ropes (or other lengths of

material) appear thinner than in the contested design, but there are more of them (probably twice as many). This naturally means that the spaces in between the ropes are smaller and, in my view, this has a noticeable effect on the overall impression of the designs. The configuration of the ropes in the contested design creates a more geometric impression. Consequently, I find that the contested design has individual character when compared with Earlier Design No. 3.

OUTCOME

45. I have found that the contested design is new and has individual character when compared with the earlier designs and so the application for a declaration of invalidity fails. Design No. 6109463 remains registered.

COSTS

46. The registered proprietor has been successful and would in the circumstances be entitled to a contribution towards the costs of the proceedings. As the registered proprietor is unrepresented, she was invited to complete a proforma with details of the time spent on particular activities associated with the proceedings. She was informed that if the pro-forma were not completed and returned, costs, other than official fees arising from the action, may not be awarded. As no proforma was received, and the registered proprietor has incurred no official fees, I make no award of costs.

Dated this 29th day of September 2023

Clare Boucher
For the Registrar,
The Comptroller-General

ANNEX



