

O/1007/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6132687

IN THE NAME OF

LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION NO 84/21

BY LIMAR TRADING LIMITED

BACKGROUND AND PLEADINGS

1. On 23 April 2021 (“**the Relevant Date**”) Lanxi Yichao Electronic Business Company Limited (“**the Proprietor**”) filed Application No. 6132687 for a registered design for a set of 5 Car Detailing Brushes (“**the Contested Design**”). It was registered with effect from that date and published on 23 July 2021 in Class 04, Sub-Class 01 of the Locarno Classification (Brushware / Brushes and brooms for cleaning).
2. Photographic representations of the design are shown later in this decision. The register states that no claim is made for the colour or the material shown.
3. On 23 September 2021, Limar Trading Limited (“**the Applicant**”), acting through Wilson Gunn as its legal representatives, filed a Form DF19A applying for a declaration of invalidity against the Contested 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. The Form DF19A claimed that the design was available in November 2019 in the UK on Amazon under ASIN B077ZYL8R4Q. It stated that the Applicant would provide details in its evidence (to be filed during the evidence rounds subsequent to the filing of the Form DF19A); meanwhile, the Form DF19A itself included this image:



4. On 1 November 2021, in defence of the Contested Design, a Form DF19B was filed, signed on behalf of the Proprietor by Yichao Wang. In that first version of its Form DF19B, the Proprietor framed the following counterstatement:

Regards Design number : 6132687

Counter-statement:

1, Please prove that this complainer asin B07ZYL8R4Q is sold by the applicant for invalidation .

2, Please prove that this complainer asin B07ZYL8R4Q was successfully listed and sold before registration.

(because in Amazon asin,you can edit pictures and products in the listing, so please show us the evidence of sales).

Issues with the Proprietor's Counterstatement

5. In sending in that first version of the Form DF19B to the Registry, the Proprietor did not copy in the Applicant so it is not entirely clear that the Proprietor received that first version making those points in counterstatement – though there has been no suggestion from the Proprietor that it did not receive that first version separately (whether from the Proprietor or from the Tribunal). In any event, on 14 January 2022, the Tribunal wrote (to both parties) identifying certain deficiencies in the completion of the first filed Form DF19B, giving the preliminary view that it required amendment before the proceedings could progress. One point for correction was that the Applicant was misidentified; the other points related to the counterstatement. The Tribunal letter included the following with regard to the counterstatement provided by the Proprietor:

Counterstatement: *The purpose of a counterstatement is to admit or deny the claims made by the applicant for invalidity. You have not specifically admitted or denied the grounds raised in the DF19A. You are required to include this in your counterstatement.*

Proof of sales request: *Points 1 and 2 of the counterstatement request that the applicant for invalidity provide proof of sales, however this is not a requirement of the grounds raised. The design does not have to have been sold, it only has to have been made available to the public. The applicant for invalidity will be required to file evidence to show that the design was made available to the public at the applicable date pleaded, however there is no requirement for them to evidence sales. Once the cancellation applicant files evidence, the proprietor will have the opportunity to challenge this, and file their own evidence. However, this will be dealt with during the evidence rounds, and is not applicable to the counterstatement. In view of the above, please remove*

points 1 and 2 from your counterstatement, or amend to remove reference to sales, as this is not a requirement of the grounds raised.

6. On 19 January 2022, a second Form DF19B was filed. It corrected the Applicant's name and the counterstatement was amended so that it now read (in its entirety) "I deny the grounds raised in the DF19A".
7. The Tribunal wrote to the parties on 16 March 2022, requesting that the Proprietor provide further information about why the claims are denied. The Proprietor replied by email on 13 April 2022, enclosing a Form DF19B. However, on 27 May 2022, the Tribunal again wrote to the parties noting that the amendments requested in the official letter of 16 March 2022 did not appear to have been made. The Tribunal allowed the Proprietor until 10 June 2022 to file the requested amendments. The Proprietor did not respond, so on 14 September 2022, the Tribunal wrote giving the Proprietor until 28 September 2022 to respond, and stated that should the Proprietor choose not to amend its counterstatement, the Registry would consider whether it is appropriate to strike out any elements of the defence that are not adequately particularised.
8. Having received no response from the Proprietor the Registry wrote to the parties on 16 November 2022 stating that it was content to admit into proceedings the Form DF19B as filed on 13 April 2022. The letter enclosed a copy of that completed form and set out the evidence rounds (reminding of the need to provide a copy to the other party).¹

Evidence rounds

9. The Applicant filed its evidence and submissions on 28 December 2022. The Applicant's evidence comprised a witness statement from Andrew Marsden (of the Applicant's attorney firm) with Exhibit AM1, which comprises several pages extracted from Amazon's UK website, showing a product identified by the code ASIN B077ZYL8R4Q as offered for sale and "first available 4 November 2019."² The submissions essentially reiterated the basis of its claim as set out in the Form DF19A, claiming that the evidence shows that an identical or at least a design which is not

¹ In accordance with Rule 16(4).

² See "Additional Information section at the top of page 3 of the exhibit.

different in overall impression was in existence and available to the public before the date of the application of the contested design. It highlighted that the evidence in Exhibit AM1 provides the date from which the product corresponding to the earlier design was first available in the UK.

10. On 17 February 2023, the Registry wrote to the parties identifying the evidence and submissions filed by the cancellation applicant and noting that the Proprietor “should have received a copy of this”. It also noted that “*a period of six weeks from the evidence being filed is usually allowed for the registered proprietor to submit evidence or submissions. The evidence or submissions should therefore have been received on or before 8 February 2023. However, in view of the length of time taken by the Tribunal to examine the Applicant’s evidence, it is considered appropriate for the Proprietor to be granted 14 days should they wish to request an extension of time to file evidence. Any such request should be received on or before 3 March 2023. If no response is received the evidence rounds will be considered closed and the parties will be asked if they wish to be heard on this matter.*”
11. The Proprietor filed no evidence or submissions, so on 12 May 2023, the Registry wrote to the parties confirming the end of the evidence rounds, that the matter was ready for a substantive decision, and offering the parties an opportunity to make any final submissions about the merits of their case, either in writing, or at an oral hearing. Neither party requested a hearing nor filed further submissions; this decision is based on my careful consideration of the papers that were filed.

Relevance of EU law

12. The Proprietor acts in these proceedings without legal representation in the matter, so it is perhaps worth explaining that 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

13. 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”.

14. 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

15. Before comparing the designs, I must decide whether the brushes shown for sale on Amazon - on which the Applicant relies as the prior art for its invalidity claim - had been made available to the public before the Relevant Date.
16. As I noted earlier in this decision, the Proprietor's initial counterstatement had numbered two points, each of which requested proof of sales. In order for a contested design to lack novelty in comparison with an earlier product based on the same design, there is no requirement for that product to have been sold at all (let alone sold by the person citing it as prior art). The Registry letter of 14 January 2022 corrected this misapprehension and gave the Proprietor an opportunity to remove reference to sales. The Proprietor's amended counterstatement, on which these proceedings are based, removed the full content of what had been included in the initial counterstatement, including the statement that "in Amazon asin, you can edit pictures and products in the listing ..."
17. The evidence from Amazon.co.uk shows the "Date First Available" as 4 November 2019, as seen here:

28/12/2022, 12:25 Jsdojn Car Detailing Brush Set(Set of 5), Automotive Detail Brushes for Cleaning Wheels, Interior, Exterior, Leather, Air Vent...

Technical Details		Additional Information	
General Information		ASIN	B07ZYL8R4Q
Product Dimensions	3 x 3 x 23 cm; 160 Grams	Customer Reviews	4.5 out of 5 stars 866 ratings
Item model number	ADLQ0186	Best Sellers Rank	260 in Automotive (See Top 100 in Automotive) 7 in Brushes & Dusters
Product Name	Brush	Date First Available	4 Nov. 2019
Units	5.0 count	Warranty & Support	
Brand	Jsdojn	Amazon.com Return Policy: Regardless of your statutory right of	
Manufacturer	NIAGUOJI		
Country of origin	China		

18. The exhibit also shows that the extracts were printed off on 28 December 2022 (after the Relevant Date of 23 April 2021) and I do not overlook the assertion made in the initial counterstatement that pictures in an Amazon listing may be edited. Nor do I overlook that the earliest of the "Top reviews from United Kingdom" shown is dated 25 June 2022 and no reviews are shown to predate the Relevant Date. However, I note firstly that the Proprietor's point about editing is made only in the initial counterstatement, which is not a document on which these proceedings are now







based; secondly, the point is not supported by any evidence around the capacity to change images relating to a product designated by a particular ASIN code (without, for instance, there being a change of ASIN or impact on the stated date of first availability); it is not even directly submitted that there has been editing of images in the present case, still less *evidence* of any changes having been made. While the Applicant's evidence might have been stronger had it shown the content of the Amazon website before the Relevant Date, it is my view that the Date First Available is acceptable prima facie evidence that the product had been made available to the public before the Relevant Date. The Proprietor was afforded opportunities to file evidence and / or submissions if it wished to challenge the prima facie evidence. It did not do so. In the circumstances, I find that the Applicant is able to rely on the product shown in the extracts from Amazon presented in Exhibit AM1 as prior art.

Novelty

19. 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.”

20. The table below shows the prior art shown on Amazon alongside illustrations of the Contested Design as they appear in the register.

The Registered Design	The Prior Art
<p data-bbox="280 651 400 685">Image 1</p> 	
<p data-bbox="288 1048 408 1081">Image 2</p> 	
<p data-bbox="233 1310 352 1344">Image 3</p> 	
<p data-bbox="240 1608 360 1641">Image 4</p> 	
<p data-bbox="225 1951 344 1984">Image 5</p> 	

21. The Proprietor has drawn to the attention of the tribunal no difference between the Contested Design and what is shown in the evidence of prior art. From the images above, especially Image 1 and the image of the prior art on Amazon, it appears to me that the designs are clearly identical. Each is a set of 5 variously sized brushes, which appear to share the same dimensions, shape and features, including, for instance the hole one end of the handle. From the images, I am unable to discern even immaterial differences. I find that the Contested Design was not new at the Relevant Date since it lacks novelty when compared to the prior art.

Individual Character

22. 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 UK 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. This assessment involves taking a step back to consider the impact on the overall impression of the design of the similarities and differences. The overall impression is based on the viewpoint of “the informed user” in the sector concerned (here users of car detailing brushes). On the subject of the informed user, I note the following points made by HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“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).”

[...]

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.”

23. Since I have noted no differences between the Contested Design and the image on Amazon that forms the prior art, and have therefore found the respective designs to be identical, it inevitably follows that the overall impressions produced on the informed user will not differ. Consequently, I find that the Contested Design lacked individual character when compared with the prior art cited by the Applicant.

OUTCOME

24. The application for a declaration of invalidity succeeds - Design No. 6132687 is invalid.

COSTS

25. The Applicant is entitled to a contribution to the costs of bringing this invalidity application. The Applicant engaged professional legal representation and I make the following award based on the standard scale.

Filing a statement of case and considering the proprietor's statement £200

Preparing evidence £500

Official fee £48

Total £748

26. I order Lanxi Yichao Electronic Business Company Limited to pay Limar Trading Limited the sum of £748. This sum should 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.

Dated this 27th day of October 2023

Matthew Williams

For the Registrar