

O/1067/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6192550

IN THE NAME OF

MAKING MAN TRADING LTD

AND

AN APPLICATION FOR INVALIDATION (NO 34/22)

BY ULJANA LTD

Background and pleadings

1. Making Man Trading Ltd (“the registered proprietor”) filed application no. 6192550 for a registered design for a penis mould on 18 February 2022. It was classified in Class 7 (Household Goods, not elsewhere specified), Sub class 02 (Cooking Appliances, Utensils and Containers) of the Locarno Classification. The design was registered on 23 February 2022 with effect from the date of application and is depicted in the following representations:



2. On 7 April 2022, Uljana Ltd (trading as Sixstore) (“the applicant”) applied for the registered design to be invalidated 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. The applicant claims that the contested design is not new and does not have individual character compared with other designs made available to the public before 18 February 2022. The earlier design it relies on is shown below:



3. This image is taken from an Amazon printout showing what is described as “Selecto Bake 8 Cavity Fun Naughty Chocolate Ice Tray Silicone Mould Cake Decoration, Pink”. The item is shown as being sold by sixstore.co.uk and was first available on the site on 4 February 2020. There are three further thumbnail images, but these are too small for me to be able to see them clearly, even when magnified.

4. The registered proprietor filed a counterstatement to the application for invalidation on 12 July 2022, denying the applicant’s claims. In particular, it states that it had not, before filing, found any similar designs registered by the applicant.

Evidence

5. The applicant filed evidence in the form of a witness statement dated 27 July 2022 from Serghei Focsa, who is the Managing Director of the applicant and has held this position since 2012. He states that the applicant has been selling the design before the application date. Mr Focsa also says that he is supplying evidence from the factory from which it has been buying the design since 2016. Attached is a single page showing thumbnails of products overlaid by a software dialog box. The information in this box is in Chinese. At the bottom of the page, there is a manuscript note:

“Dear Tribunal

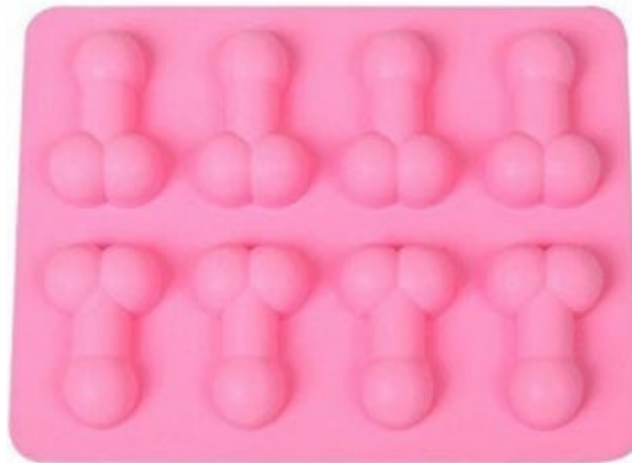
We Factory (XINGGUODIANQICHANG) have making this design (08-30-1) since 2012. I can confirm this design is free design in China, and no one have copyright. We have start supplied the design to company Uljana LTD since 2016.”

6. There is a signature but there does not appear to be a date. Furthermore, the information is supplied without a statement of truth.

7. The registered proprietor filed evidence in the form of a witness statement dated 2 October 2022 from Mika Shyu, who is the Sales Manager of Making Man Trading Ltd, a position held since 2021. The statement consists of submissions, rather than evidence. In particular, the registered proprietor states that “*Our design application*

was approved by the Intellectual Property Office. Design number: 6192550. No valid evidence from the applicant to show our design is illegal.”¹ It also submits that the applicant has not shown that it is the right holder of its design.²

8. The applicant filed evidence in reply in the form of a second witness statement from Mr Focsa dated 14 October 2022. Attached to the witness statement are screenshots from ebay showing a conversation between Mr Focsa and a representative of ebay where the latter confirms that the product shown below, described as a “Hen Party Willy Penis Dick Silicone Mould Chocolate Fondant Jelly Ice Cube Mold”, was first offered for sale on the site on 2 April 2020.³



9. The remaining exhibits are three print outs from Amazon showing other sellers offering penis-shaped cake moulds, the first two of which indicate that the goods were first available in 2021 and 2017 respectively.

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

11. In these proceedings, neither party is legally represented.

¹ Paragraph 2.

² Paragraph 5.

³ Exhibits 2a-2d.

Preliminary Issues

12. I consider it would be helpful to address here the points made by the registered proprietor that I have summarised in paragraph 7 above. First, the registered proprietor appears to be relying on the fact that its application was successfully registered. The Intellectual Property Office does not, however, examine design applications on the basis of novelty. This means that no search is carried out for earlier designs that might be identical or create the same overall impression. The invalidation process exists so that third parties may challenge the validity of the design if they can show that the registered design is not new and/or does not have individual character. Therefore, the fact that a design is registered is not in itself a defence against such a challenge. Neither is it a defence, as argued by the proprietor in its counterstatement, that it had not found any similar designs by the applicant before filing its own application for registration.

13. Secondly, the registered proprietor submits that there is no valid evidence that the applicant is the right holder of the contested design. This is not a requirement under section 11ZA(1b), which is the provision of the Act under which this application for invalidation has been brought. It is open to any individual or business to bring such a claim. There are other provisions that require an invalidation action to be brought by the individual or business that owns the rights relied upon. An example is section 11ZA(3) from which it appears that the registered proprietor is quoting at the end of paragraph 5 of its witness statement. However, the ground under which this action is brought is not one of those.

Decision

14. 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”.

15. 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.

...”

The prior art

16. In *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, the General Court (“GC”) held in paragraph 26 of its decision that “*A design is therefore deemed to have*

*been made available once the party relying thereon has proven the events constituting disclosure.*⁴ I remind myself that a qualifying disclosure is one where none of the exceptions set out in section 1B(6) of the Act applies.

17. The prior art relied on by the applicant is shown in paragraph 2 of this decision. I have already stated that the Amazon printout attached to the application for invalidation shows that the item was first made available for sale on 4 February 2020, which is earlier than the date of application for the contested design. I find that this is prior art on which the applicant may rely. For reasons that shall become apparent, I will also refer to the ebay listing for a product that was confirmed as being available from 2 April 2020, i.e. before the date of application for the contested design.


Novelty and individual character

18. 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.”

19. In the table below I show the registered design alongside the prior art upon which the applicant may rely. I have included both the image from the Amazon printout filed with the Form DF19A and the image taken from the ebay listing.

⁴ 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 Brexit transition period. The provisions of the Registered Designs Act 1949 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the design case law of the EU courts.

The Registered Design	The Prior Art
 <p>The registered design is shown in two views. The top view is a rectangular plate with a 2x4 grid of eight identical raised, dumbbell-shaped features. The perspective view shows the same plate from an angle, highlighting the three-dimensional nature of the features.</p>	 <p>The prior art is shown in two views. The top view is a rectangular plate with a 2x4 grid of eight identical raised, dumbbell-shaped features, similar to the registered design. The perspective view shows the same plate from an angle, highlighting the three-dimensional nature of the features.</p>

20. I have only been given one useable view of the prior art. There is no equivalent of the second representation of the contested design. However, In *Framery Oy v European Union Intellectual Property Office*, Case T-373/20, the GC said:

“23. It should be noted that, as regards the assessment of disclosure for the purposes of Article 7 of Regulation No 6/2002, it is not apparent from that regulation that the representation of the earlier design at issue must include views reproducing it from all possible angles, so long as that representation allows the shape and the features of the design to be identified (see, to that effect, judgment of 29 April 2020, *Bergslagernas Järnvaru v EUIPO – Scheppach Fabrikation von Holzbearbeitungsmaschinen (Wood-splitting tool)*, T-73/19, not published, EU:T:2020:157, paragraph 42 and the case-law cited).”

21. This judgment was given after the end of the Brexit transition period. However, I find that it has persuasive value. The image of the prior art shows one side of a mould. From this, I can infer what the finished cake or other edible item would look like, and what features would be present on the reverse of the mould to produce this effect.

22. The registered design consists of the following features:

- i. A pale pink rectangle with rounded corners, which I infer to be fairly thin;
- ii. Eight hollows in the shape of a penis with testicles, arranged in two rows of four, with the bottom row being a mirror image of the top;
- iii. Hollow moulds extending above the pink rectangle in the first representation and below it in the second;
- iv. Raised lines within the hollows separating the various parts of the penis, but there are no further textural features;
- v. The testicular part of the mould making up around a third of its height, with a Y shape separating each testicle;
- vi. A bulbous section at the top of each hollow. This is slightly shorter than the testicles, with a flat base;
- vii. Between (v) and (vi), a straight-sided, rounded, upright section.

23. The earlier design also incorporates a pale pink rectangle with rounded corners. The image used on the Amazon listing has been taken at a slightly different angle and there is a variation in the shade of pink. It is not clear whether this latter difference reflects the colour of the product itself or is a result of how the image has been reproduced. Nevertheless, the configuration of the hollows appears identical to that of the hollows in the contested design, and the number and layout are identical. The only discernible difference is the exact shade of that pink.

24. Turning to the image taken from the ebay listing, I see that the shade of pink is the same as used for the contested design. I can make out no difference at all between these two and so I find that the two designs are identical and that the contested design was invalidly registered.

25. As I have found that the registered design was not new, it follows that it does not have individual character compared to the prior art.

Outcome

26. The application for a declaration of invalidity is successful. Subject to a successful appeal, Registered Design No. 6192550 is declared invalid.

Costs

27. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings. As the applicant is a litigant in person, it was invited to complete and return a proforma setting out the time spent on particular activities associated with the proceedings. It was informed that, if no completed proforma were received, costs, other than official fees arising for the action, may not be awarded. As the applicant did not return a completed proforma, I make an award of £48 to cover the official fees incurred in filing the application.

28. I order Making Man Trading Ltd to pay Uljana Ltd the sum of £48. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 9th day of November 2023

Clare Boucher
For the Registrar,
The Comptroller-General