

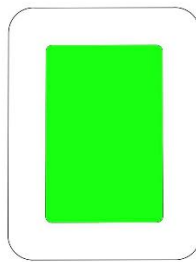
**O/0038/24**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF REGISTERED DESIGN No. 6196574**

**IN THE NAME OF UAB ORBIO WORLD**

**IN RESPECT OF THE FOLLOWING DESIGN**



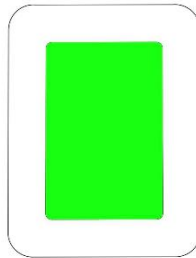
**AND**

**APPLICATION 97/22 FOR INVALIDATION**

**BY MB 'VIZUALI RECLAMA'**

## Background and pleadings

1. UAB Orbio World of Lithuania (“the proprietor”) filed application no. 6196574 to register the design shown on the front cover for a ‘cosmetic patch’ on 15<sup>th</sup> March 2022. The design is registered with effect from this date (“the relevant date”). The main illustration of the design looks like this.



2. On 14<sup>th</sup> July 2022, MB ‘Vizuali reclama’, also of Lithuania (“the applicant”), made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that products embodying the registered design, or designs that create the same overall impression, were made available to the public from as early as October 2018. Consequently, the registered design was not new and lacked the necessary individual character at the time it was applied for and registered.

4. In support of this claim the applicant filed copies of catalogues, invoices, and pages from Alibaba and Amazon online marketplaces said to show use of the same or similar designs in 2021 and earlier.

5. The registered proprietor filed a counterstatement defending the registration of the design on the grounds that:

- (1) The catalogues provided by the applicant do not show disclosure of relevant designs in the UK or EEA prior to the relevant date. This is because they are not dated and there is no information as to where they were published.
- (2) The invoices provided by the applicant are from an entity in China to an entity in Turkey and, therefore, do not disclose a design in the UK or EEA.

Further, there is no reason to believe that the disclosure would have come to the attention of persons in the relevant territory.

- (3) The pages from online marketplaces provided by the applicant do not show disclosure of relevant designs prior to the relevant date either. This is because although the date of the first offer to sell the goods is sometimes shown, the product itself can be altered and yet retain the original offer date. In this connection, the applicant says that some of the customer feedback connected with these webpages relates to different types of products. Further, providing a date of publication in the title is not sufficient to prove the actual date of publication.

## **Representation**

5. The applicant is represented by Groom, Wilkes and Wright LLP. The proprietor is represented by Rytis Rudzinskas, who is an attorney at law in Lithuania (with a postal address in London).

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

## **Evidence and submissions**

7. The applicant filed written submissions and factual evidence. The latter consists of a witness statement (with 5 exhibits) by Andrew Hawley of Groom, Wilkes and Wright. Mr Hawley's statement provides evidence about the designs it claims were published on (amongst other things) the Alibaba and Amazon websites prior to the relevant date. This material largely reproduces material filed with the application for invalidation.

8. The proprietor responded to that material in the counterstatement, as summarised at paragraph 5 above. The proprietor subsequently filed written submissions responding to Mr Hawley's evidence and submissions. These repeated and enlarged upon the criticisms made in the counterstatement of the material relied in the application to show prior disclosure of the design. The proprietor also rejected the

applicant's dismissal of those earlier criticisms as being, in essence, no more than procedural nit-picking.

## **The Law**

9. 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”.*

10. The relevant parts of Section 1B of the Act are 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) to (e) ---*

*(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) -- ”*

## **Prior disclosure**

11. Mr Hawley’s evidence is that the design at issue is for a foot patch applied to the sole of the foot to draw and absorb toxins. The colour appears to reflect the active substance, the colour green appearing to represent the use of mint. According to Mr Hawley, these patches are made by manufacturers in China and are available for onward sale in customised packaging chosen by the trade buyer. This is confirmed by the content of exhibits GW1 and GW3, which consist of extracts from the Alibaba website showing offers for sale of such foot patches and invoices for these goods dating from 2019.

12. Exhibit GW4 includes examples of pages from the website amazon.co.uk. showing that an offer that was made in November 2022 (i.e. after the relevant date) to sell foot patches corresponding to the design shown below to customers in the UK.



13. The applicant relies on indications on these webpages (at pages 25 and 29 of the exhibit) that the product was first made available on 13<sup>th</sup> April 2020 (i.e. before the relevant date).

14. The proprietor submits that there are “*reasonable doubts*” as to whether the product may have changed between the date of the first offer and the date in 2022 when the webpages were downloaded from Amazon. These doubts are based on the alleged ability to amend products and product descriptions on Amazon whilst retaining the ‘first made available’ date, and the posting of customer feedback (albeit not for this particular offer) that appear to relate to completely different products. According to the proprietor, this undermines the probative value of the evidence and prevents it from substantiating the applicant’s claim that the product shown on the webpages dated 2022 was first made available to the public in 2020.

15. It is important to recognise that the standard of proof in civil proceedings in the UK is the balance of probability. It is not necessary to prove matters ‘beyond reasonable doubt’ as is the case in criminal proceedings. The proprietor is, of course, entitled to rely on the possibility (not contested by the applicant) of amending product listings on Amazon without that changing the date of the first recorded offer for sale of the

product. However, in my view, the theoretical possibility of such a change is not, without more, sufficient to prevent material of this kind from providing *prima facie* evidence that the product shown at the later date was first made available to the public on the date stated. The proprietor has challenged this evidence by pointing out that some of the customer feedback in evidence appears to relate to completely different products. The two examples identified by the proprietor are on the Alibaba website. In one case the feedback refers to an eye mask, and in another to a 'jelly bath'. I accept this raises a serious question as to whether some of the products originally offered on Alibaba were foot patches. However, given the stark difference between eye masks/jelly baths and foot patches, it seems more likely that these are examples of feedback being posted against the wrong product rather than indications the original offers did not relate to foot patches at all, but to eye masks/jelly baths.

16. In any event, there is nothing to suggest that the foot patch shown on the pages from amazon.co.uk (see paragraph 12 above) was any different to the product first made available in April 2020. Indeed, the customer reviews shown on page 31 of exhibit GW4 include four from UK users made prior to the relevant date, none of which obviously relate to a different product. These include a review dated 9<sup>th</sup> July 2021 following a 'verified purchase' which states:

*"I use them to detox along with a diet and they certainly change colour."*

17. That description matches the information available about how detoxification foot patches work.

18. Further, standing back and looking at the evidence as a whole, I find it paints a coherent and consistent picture of foot patch products, such as the one shown at paragraph 12 above, having been available from manufacturers in China since at least as early as 2019, and that such products found their way on to the UK, US<sup>1</sup> and Canadian<sup>2</sup> markets during 2020/21.

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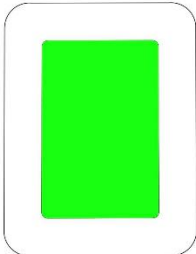

<sup>1</sup> See page 21 of exhibit GW4 for reviews by US customers following offers for sale of similar foot patches on amazon.com

<sup>2</sup> See page 5 of exhibit GW1 which shows information from Alibaba.com about 3 transactions involving the sale of similar foot patches from China to Canada in August 2021

19. For these reasons, I accept the evidence shows that, prior to the relevant date, foot patches such as the one shown in paragraph 12 above, were disclosed in the UK and/or in places where they could “*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.*”

### Comparison of the designs

20. In the table below I show the registered design alongside the most relevant prior art:

The Registered Design	The Prior Art
	

21. I have had to re-produce the background to the prior art, and some of the overlay (such as prices and the rectangular white box). However, the background/overlay clearly forms no part of the product in question and must therefore be disregarded for comparison purposes.



22. A design is new if no identical design, or design differing only in immaterial details, has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,<sup>3</sup> HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

*“‘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.”*

23. The products are foot patches, which are essentially flat. Therefore, the key comparison must be based on the top-down view shown above. The corners of the product constituting the prior art are a little more rounded than those of the registered design, and the green square inset has sharp corners rather than the slightly rounded ones shown in the registered design. However, these are trivial differences not affecting the overall impression created by the designs. The main difference is in the relative size of the green square where the active substance is stored, compared to the shape of the product as a whole, and in the shade of green used.

24. I am satisfied that, at least when taken together, the relevant differences between the designs are not immaterial. The registered design is, therefore, a new design compared to the prior art.

25. 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*<sup>4</sup>, *“The scope of protection of a .... registered design clearly can include products which can be distinguished to some degree from the registration.”* The same applies to a comparison between the overall impression created by a registered design and that created by prior art.

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<sup>3</sup> [2019] EWHC 3149 (IPEC)

<sup>4</sup> [2010] FSR 39

26. In *Cantel Medical (UK) Limited v Arc Medical Design Limited*<sup>5</sup> HHJ Hacon, sitting as a judge of the High Court, set out a six step approach for use in the assessment of whether a design has individual character. It is as follows:

*“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 [prior art] 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.*

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<sup>5</sup> [2018] EWHC 345 (Pat)

- (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.”*

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

27. The relevant sector is the market for foot patches.

The informed user

28. The informed user is a user of foot patches who is deemed to be interested in the products concerned, is particularly observant, and pays a relatively high degree of attention when he or she uses them.

Comparison of the designs and the designer’s degree of freedom

29. In *Dyson Ltd v Vax Ltd*, Arnold J (as he was then) stated 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).”*

30. The registered design consists of a rectangular shape with rounded corners within which is a broadly rectangular green section occupying around 60% of the width of the overall product, and about 80% of its height. It is a very simple design.

31. The prior art also consists of a rectangular shape with rounded corners within which is a broadly rectangular green section occupying around 60% of the width of the overall product, and about 60% of its height. The shade of green shown in the

registered design is significantly lighter and more vivid than the rather dark colour green shown in the prior art.

32. The area around the central green rectangle serves to provide an area for attaching the patch to the sole of the foot (like a plaster). In order to maintain effective adhesion and keep the active area in contact with the sole of the foot, the attachment zone must run completely around outside of the active area.

33. The central green rectangle is where the active substance is stored and held against the sole of the foot so that it can absorb toxins. Given the shape of a foot, a foot patch that is longer than it is wide has obvious technical advantages, particularly if the aim is (as it appears to be) to maximise the active area of the patch that is in contact with the sole.

34. There is some design freedom when it comes to the relative dimensions of the attachment zone and the area where the active substances is stored. The designer is also free to select the colours used for the patch, although there is likely to be an economic advantage in using colours which match the user's perception of the active ingredients in the patch, e.g. green for mint, purple for lavender.

35. Overall, I find there is limited design freedom.

#### The outcome of the comparison

36. The difference in the area of the designs occupied by what I have called the 'attachment zone' coupled with the difference between the shades of green used are noticeable. However, they will not change the overall impression the designs create on an informed user of foot patches. I therefore accept the applicant's case that registration of the contested design was contrary to section 1B of the Act.

## **Overall outcome**

37. The registered design is invalid and will be cancelled with effect the from 15<sup>th</sup> March 2022.

## **Costs**

38. The applicant is entitled to a contribution towards its costs. I assess this as follows:

*Official fees for filing Form DF19A: £48*

*Preparing DF19A and considering counterstatement: £300*

*Preparing evidence: £400*

*Total: £748*

39. I therefore order UAB Orbio World to pay MB 'Vizuali reclama' the sum of £748. This sum must 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 or does not proceed.

**Dated this 22<sup>nd</sup> day of January 2024**

**Allan James**

**For the Registrar**