

O/0090/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6132697

IN THE NAME OF

LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED

AND

AN APPLICATION FOR INVALIDATION UNDER NO. 76/21

BY LIMAR TRADING LIMITED

Background and pleadings

1. Registered design number 6132697 was filed on 23 April 2021 (“the relevant date”) in the name of Lanxi Yichao Electronic Business Company Limited (“the proprietor”) and was registered with effect from the same date. The design consists of seven illustrations, of which two examples are shown below:



2. The design is described as a “bicycle rear bracket” and is registered as “tools and hardware”, specifically “fastening, supporting or mounting devices not included in other classes” (i.e. class 8, sub-class 8 of the Locarno classification).

3. On 23 September 2021, Limar Trading Limited (“the applicant”) applied for the registration of the design to be declared invalid. It claims that the contested design lacks novelty and individual character and should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that the contested design did not fulfil the requirements of s. 1B. The applicant claims that the same or a similar design has appeared for sale on a website in the UK since October 2019.

4. The proprietor filed a counterstatement denying the grounds for invalidation.

5. Only the applicant filed evidence. The applicant also filed written submissions with its evidence. Neither party requested a hearing, nor did they file written submissions in lieu. This decision is made following a careful reading of all of the papers.

6. The applicant is represented by Wilson Gunn. The proprietor is not professionally represented.

Evidence

7. The applicant's evidence consists of the witness statement of Andrew Marsden, a Chartered Trade Mark Attorney with the applicant's professional representatives. Mr Marsden provides evidence about a design the applicant says was available on Amazon UK prior to the relevant date.

Decision

8. Section 1(2) of the Act is as follows:

“In this Act ‘design’ means the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.”

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. Section 1B of the Act, so far as is relevant, reads 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.

(8) [...]

(9) [...].”

Prior disclosure

11. Mr Marsden’s evidence consists of prints from www.amazon.co.uk.¹ It shows the following image:



12. Although the web page was printed on 28 December 2022, it gives the “Date First Available” of the product as 28 October 2019.

13. I am satisfied that bike kickstands such as that shown in the image above were made available to the public on www.amazon.co.uk prior to the relevant date. I accept that a disclosure on that website constitutes a disclosure that could reasonably have become known to persons carrying on business in the UK and specialising in the

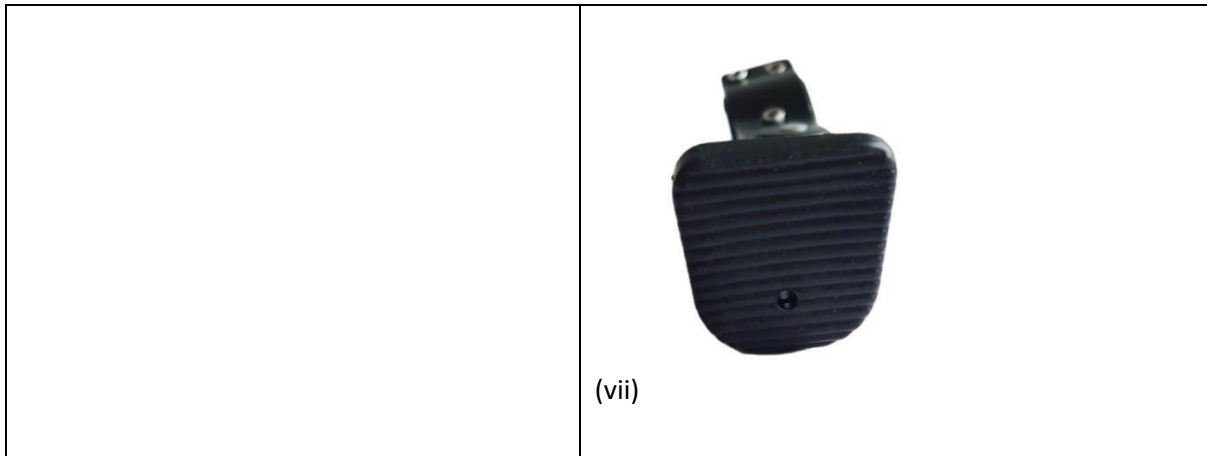
¹ Exhibit AM1.

sector concerned. There is no suggestion that any of the exceptions in subsection 6 apply.

Comparison of the designs

14. The designs to be compared are as follows:

Prior art	Registered design
	<p>(i) </p> <p>(ii) </p> <p>(iii) </p> <p>(iv) </p> <p>(v) </p> <p>(vi) </p>



15. I have had to reproduce the background and some of the overlay (e.g. price details, accessories) in the prior art but it is clear that these elements do not form part of the product in question. These elements will be disregarded in the comparison.

16. The representations of the registered design at (vi) and (vii) appear to be the ends of the kickstand and I proceed on that footing. However, for other reasons, the registered design appears to include two very similar but different products. In the representations above, the left-hand edge of the product at (i) curves smoothly to the right below the hinge, from almost flush with the hinge at its highest part; whilst the product shown at (ii) and (v) has a flat section on that side immediately below the hinge which curves to the left. I have viewed the images under magnification but come to the same conclusion. I also note that the images at (iii) and (iv) above, again including when viewed under magnification, both show a curve immediately from the hinge, despite being opposite sides of the product. This is consistent with the registered design showing two designs, rather than one. Although the legislation allows for “sets” of products to be registered (see *GBL UK Trading Ltd v H&S Alliance Ltd*, BL O/374/21 for a discussion), there is no obvious reason why bicycle kickstands would be sold in a pair. I therefore have reservations that the registered design is a single design rather than two designs. Nevertheless, the applicant has not pleaded that the design is invalid on that basis and it is therefore a matter beyond the scope of this decision.

17. 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.”

18. In my view, the registered design comprising two slightly different products differs in more than immaterial details from the prior art which only shows one. The design is new compared to the prior art.

19. A design may still be new but still lack the necessary individual character compared to the prior art. This may also apply to a registered design which contains two distinct products while the prior art only shows one product. The following guidance was set out by HHJ Birss (as he then was) at [31] to [59] of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“The informed user

33. The designs are assessed from the perspective of the informed user. 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-281/10P)* [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 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; *Shenzen* 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)”

“Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* [*Dyson Ltd v Vax Ltd*, [2010] FSR 39] Arnold J. summarised that passage from *Grupo Promer* as follows:

“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).”

“Effect of differences between the registered design and the design corpus

51. [...] The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.”

“The correct approach, overall

[...]

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.”

20. In *Safestand Ltd v Weston Homes PLC & Ors* [2023] EWHC 3250 (Pat) HHJ Hacon, sitting as a judge of the High Court, set out at [237] the approach to the assessment of whether a design has individual character:

“(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,

(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,

(d) that features of the designs which are solely dictated by technical function are to be ignored in the comparison, and

(e) that 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 concerned

21. The designs are bicycle kickstands. The sector is the market for bicycle accessories.

The informed user

22. The products in question are sold directly to ordinary members of the public for retrofitting to bicycles. The end users are members of the public with an interest in bicycle accessories. The informed user is particularly observant and will pay a relatively high degree of attention when using the product.

23. The only evidence about the exposure of the informed user to the prior art is that the product has 4,775 global ratings on the www.amazon.co.uk print. The informed user is therefore unlikely to have had any significant exposure to the prior art. However, there do not appear to be any special circumstances which would mean that the informed user does not conduct a direct comparison of the designs, or that more extensive knowledge of the prior art would affect that comparison.

Design freedom

24. 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).”

25. There are some constraints on the designer because the product must be capable of secure attachment to the rear bracket of a bicycle and it must support the bicycle when standing. The stand must also be designed in such a way that when it is not required and the bicycle is in motion, it neither catches the ground nor obstructs the rear wheel. The weight of the product is likely to be another consideration weighing against a bulky design. The need for the stand to support the bicycle and to be easily employed by the user probably make a hinged design most likely, though other options are no doubt possible (such as a retractable stand). That said, there is freedom in the precise shape of the design, such as whether it is straight or curved on each side, in the shape of the foot of the stand, or whether a foot is even present, and in the surface design, which in this case includes the ridges each side of the lowest bolt and the red oval. There is also design freedom in the decision whether the stand is adjustable or fixed in length and in precisely how that is achieved. Overall, the designer has a reasonable degree of freedom.

Comparison of the designs

26. The registered design includes images of the inner side of the kickstand (i.e. the part closest to the wheel once fitted) and I accept that both the inner side and the inside of the bracket will be visible before being attached. The inside of the bracket will, however, not be visible once fixed to the bicycle. The rubber fitting inside the bracket serves to ensure a snug fit and is therefore a functional part of the design. The inner part of the stand will not be completely invisible but it will not be seen from above, nor the side of the bicycle to which it is attached, whilst the view of it from the other side will be partially obscured by, at least, the rear wheel. The base of the foot will be visible but the ridged detailing is likely to be taken as a functional element to prevent slipping. The most important features are those which will be plainly visible when the product is in use, having been attached to the bicycle.

27. The prior art and illustration (i) above appear to have the following features in common:

- The shape of the bracket for attaching the kickstand is identical

- The three nuts for securing the bracket have the same position in both products, including the lowest of the three protruding from the face of the bracket
- Both designs have a circular piece with a fixing in the centre which serves as a hinge for the leg to be rotated. There is no visible difference in the shape or proportions, relative to the bracket or leg, of this piece
- The leg of the kickstand is in both cases in two parts
- The front edge of the kickstand below the hinge has the same curved shape
- Both products feature a red oval set a little less than halfway down the upper portion of the leg
- The oval is oriented in the same way in both products
- The rear edge of the upper part also appears to have the same slight curve
- There are two parallel ridges in the bottom third of the upper part of the leg. They are raised and the upper edge appears to be slightly curved
- Between the ridges, at the lower end and in the middle, is a bolt
- The upper portion of the leg ends with a point, which is not sharp but slightly curved
- The lower part of the leg has a groove in the centre. The smaller image shown at paragraph 11 above shows the adjustment mechanism for the prior art: the groove is not a trick of the light
- The kickstand has a foot which encases the end of the leg and is proud of it
- The shape of the foot appears to be identical: both flare out at the lowest point and appear roughly triangular from the side.

28. The only difference which I can detect between the prior art and illustration (i) are white letters present on the red oval in the prior art but not in the registered design. Whilst the presence or absence of ornamentation is a factor to be taken into account, in and of itself it does not mean that the overall impression must be different.

29. Proceeding on the basis that the image at (ii) above of the contested design registration does in fact show a second product, it appears to me that it is the mirror image of the design at (i). Instead of curving to the right from the hinge, it curves to the left. Therefore, in addition to the presence of text on the prior art and its absence from the registered design, there is a difference because the design shown at (ii) curves in the opposite direction. However, other than these factors, I have been unable to identify any further differences between the product at (ii) and the prior art.

Outcome of the comparison

30. The presence of lettering on the prior art is noticeable, as is the fact that the contested registration shows two kickstands rather than one. However, in view of the fact that one of the contested products is identical to the prior art in all respects but the lettering and that the other product is the mirror image of the same design, I do not consider that these differences give the contested registration a different overall impression. I accept the applicant's case that the contested registration does not have individual character and that registration of the design was contrary to s. 1B of the Act.

Conclusion

31. The registered design is invalid and will be cancelled with effect from 23 April 2021.

Costs

32. The applicant has been successful and is entitled to an award of costs. I award costs to the applicant as follows, bearing in mind that the proprietor filed no evidence and the applicant's evidence was very light:

Official fee:	£48
Filing the application and considering the counterstatement:	£300
Filing evidence:	£400
Total:	£748

33. I order Lanxi Yichao Electronic Business Company Limited to pay Limar Trading Limited the sum of £748. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of February 2024

Heather Harrison

For the Registrar,

The Comptroller-General