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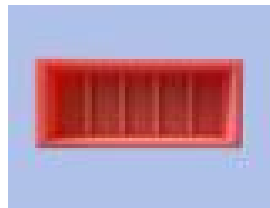
REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6136045

IN THE NAME OF PAUL CARDY

IN RESPECT OF THE FOLLOWING DESIGN



AND

AN APPLICATION FOR INVALIDATION (NO 110/22)

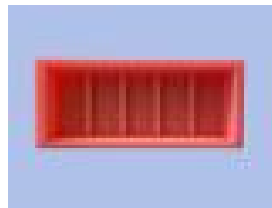
BY CORINNE TWIST

Background and pleadings

1. Paul Cardy (“the registered proprietor”) filed Application No. 6136045 for a registered design for a 5-celled silicone snap bar mould in Class 7 (Household goods, not elsewhere specified), Sub class 2 (Cooking appliances, utensils and containers) of the Locarno Classification on 10 May 2021. It was registered on 13 July 2021 with effect from the application date and published on 14 July 2021.

2. A snap bar is a bar containing individual segments that, as the name suggests, can be snapped off. It is a form that has been used for some time for chocolate bars, and Mr Cardy states that bars produced by the manufacturer Cadbury’s and the Yorkie chocolate bar inspired him to create his design.

3. The design is depicted in a single representation, which is shown below:



The following disclaimers were entered on the register: “No claim is made for the colour shown, no claim is made for the material shown.” At this point, I note that the quality of the image is such that it is not possible to magnify it without it becoming blurry.

4. On 15 August 2022, Corinne Twist (“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”),¹ on the grounds that the design did not meet the requirements of section 1B of the Act that a design be new and have individual character. The applicant claims that snap moulds comprised of five sections have been used for years and she provides what she describes as a non-exhaustive collection of examples. These include social media posts, an Etsy listing and the

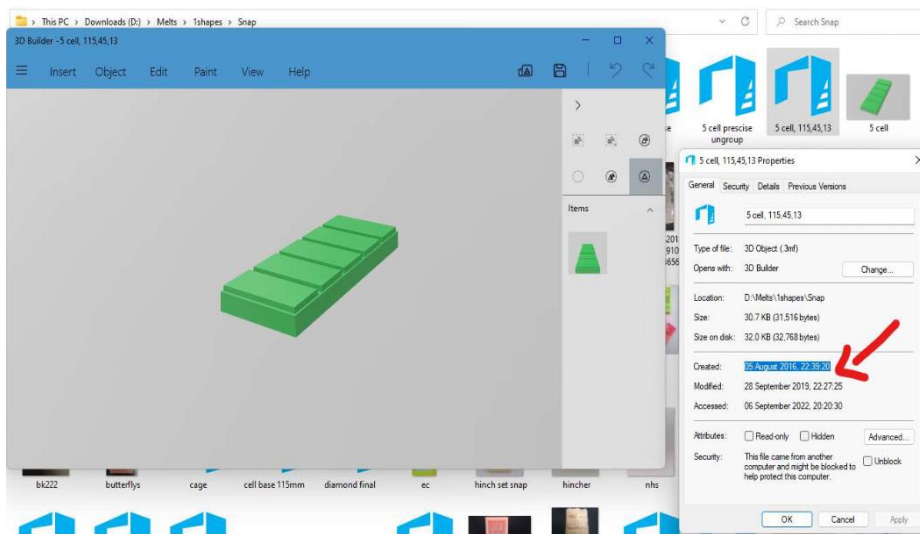
¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

details of an earlier registered design. The latter was registered on 17 October 2016 and shows a product that the applicant claims was made using a plain five-cell snap bar mould. Some of the images of the moulds show a single item containing multiple moulds or the cells marked with words or pictures.

5. The registered proprietor filed a defence on 6 September 2022, denying the applicant's claims. In particular, he states that:

“My 5 segmented snap bar was originally designed and created (in its current form) way back in 2016. At the time of creation, there was no single snap bar moulds that used the same dimentions [sic] and contours. This predates everything the Applicant has provided.”

6. As evidence of this claim, the proprietor adduces a screenshot showing when the file was created and modified:



7. He also provides an advertisement from his business's Facebook account dated 24 September 2019 and an excerpt from a chat with a customer in December 2019. The proprietor has customised a five-celled mould and a photograph shows both the moulds and the resulting bar.

Elite3DMoulds
24 September 2019 · 🌐

"Adding that professional look to all your hard work"
These items are 100% customisable
Some logos may not be suitable, obviously small or thin wording will be harder to be captured by your wax. message me for a free consultation 💎... See more

Fully Customised Snap-Bar Moulds

3 Cell	4 Cell	5 Cell	6 Cell
			
£14.99	£16.99	£19.99	£22.99

(Price includes the Master Template + Heavy Duty, Heat resistant Silicone mould. UK postage £3, overseas £4.30)



8. Both parties have filed evidence, which I list briefly here:

- The applicant's evidence in chief is from Mrs Twist and is dated 4 January 2023. She exhibits what she claims to be examples of prior art, some of which were filed with the application for invalidation. Her witness statement also covers the disputes between the parties over the applicant's listings of certain products on Etsy;
- The proprietor's evidence is from Mr Cardy and is dated 22 February 2023. His evidence is intended to support his claims to have been producing single snap bar moulds before anyone else. It also covers the Etsy dispute;
- The applicant's evidence in reply is from Mrs Twist and responds to statements made by Mr Cardy.

9. I shall not summarise the evidence here but will refer to it as appropriate during the course of my decision.

10. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties represent themselves.

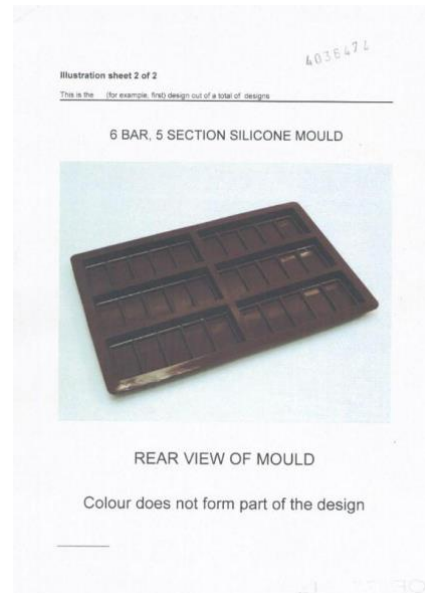
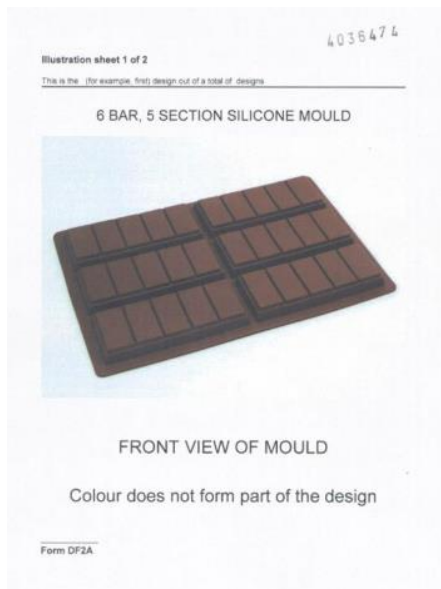
Preliminary Issues

11. First, I have noted above that both parties have filed evidence relating to the proprietor's filing of take-down notices against the applicant on Etsy. I consider it helpful to clarify the scope of these proceedings. The issue that is before me is whether the contested design was new and had individual character when compared with any other design that had been made available to the public on or before the relevant date, which is the date of application for the contested design. This is 10 May 2021. I shall therefore say no more about the claims of infringement.

12. In her first witness statement, Mrs Twist makes submissions about how the informed user would view the design and, in particular, encourages me to take into consideration the look of the finished product that results from use of the mould. She cites in her application an earlier registered design, No. 6001403, and says that *"it is clear that it came from a plain 5 section snap bar mould that pre dates Mr Cardy's registration claim. This registration has now lapsed but this proves that he was not the first proprietor of this design of mould"*.



13. The evidence of both parties contains examples of other moulds that could be used to create five-celled snap bars, such as registered design No. 4036474, shown below:



14. Mrs Twist also refers to single-use clam shells that can also be used to make snap bars. An example is shown below:²



15. I take from this evidence that there are different tools that can be used to produce the same product. However, my point of reference must be the representation of the contested design on the register, along with any disclaimers. This indicates what the proprietor wished to protect. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012]

² Applicant's evidence in chief, page 6.

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 LJ 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.”

16. He gave this judgment in an infringement case, but the principle applies equally to invalidations. The important things to consider are the registered design as shown in the representation and the prior art relied on by the applicant.

Decision

17. 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”.

18. 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.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above ‘normal use’ means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

The proprietor’s use of the design

19. The proprietor’s defence is primarily that it has been using the contested design since 2016. It is important to remember that the Act does not make any distinction between earlier designs owned by another party and ones owned by the proprietor. This means that the proprietor can destroy the novelty of a contested design if it has made available to the public an identical design or one that creates the same overall impression on the informed user, unless one of the exceptions in section 1B(6) applies.

20. Mr Cardy says in his counterstatement that he created the five-cell snap bar in its current form in 2016 and provides the screenshot shown in paragraph 6 above as evidence of creation. The file was created on 5 August 2016 and modified on 28 September 2019, both dates being before the relevant date. This does not,

however, show the mould or provide evidence of the mould's disclosure. The same considerations apply in the case of the advertisement dated 24 September 2019 and reproduced in paragraph 7 above. This shows illustrations of the bars that would be made from the moulds, but not the moulds themselves. I am therefore unable to conclude that this advertisement destroys the novelty of the contested design.

21. In his witness statement, Mr Cardy says:

“At the time of its original concept and design there was no one else on the market that sold a single snap bar mould designed for wax, absolutely no one. I guarentee [sic] that any 3/4/5 or even 6 segmented single snap bar silicone moulds found from 2016-2019 were created by me.”

22. Mr Cardy states that he is no longer able to access any evidence prior to 2019 and that the advertisement shown in paragraph 7 above is “*the earliest advert I can find showing my mark*”. The earliest photographic evidence comes from 2 November 2019 and messages with a customer:³

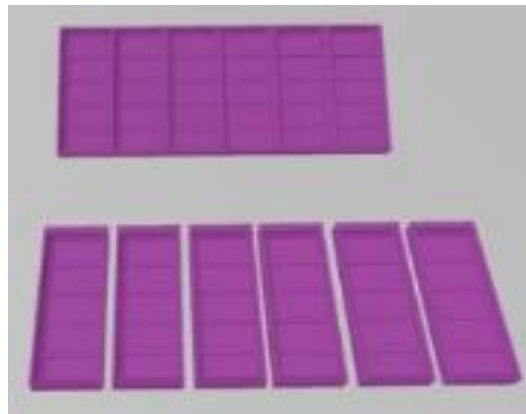


23. However, the mould shown above is different in a number of ways from the contested design. First, the mould shown in paragraph 15 has 10 cells, arranged in 2 columns, while the registered design is a single row. Secondly, I consider that it is reasonable to infer that the cells are not plain, as they are in the contested design, as the finished product is clearly marked with words and pictures. In my view, it is unlikely

³ Exhibit C2.

that Mr Cardy would have sent a customer a photograph showing goods produced from a mould that is different from the one pictured.

24. There is also an exchange of messages with another customer on 28 December 2019, and the following image is included here. The messages suggest that the tray shown at the top of the image is created by combining six individual 5-cell moulds.⁴



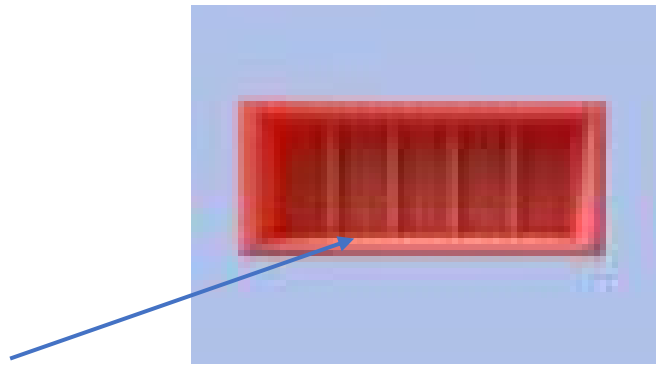
25. For ease of comparison, I have magnified the bottom half of this image below. The cells of these moulds are plain and, although the image is not the clearest, it seems to me that the mould on the left contains ridges at both the narrow and long ends which would produce the stepped profile shown on the bars in the Facebook advertisement of 24 September 2019. I have added an arrow to indicate where this can be seen most clearly.



26. Unfortunately, there is only one representation of the contested design. It is a photograph taken from above. I cannot see any ridges equivalent to those present in

⁴ Exhibit C3.

the moulds in the previous image. It appears to me that the side of the mould joins the base at a right angle. Again, I have marked the representation with an arrow.



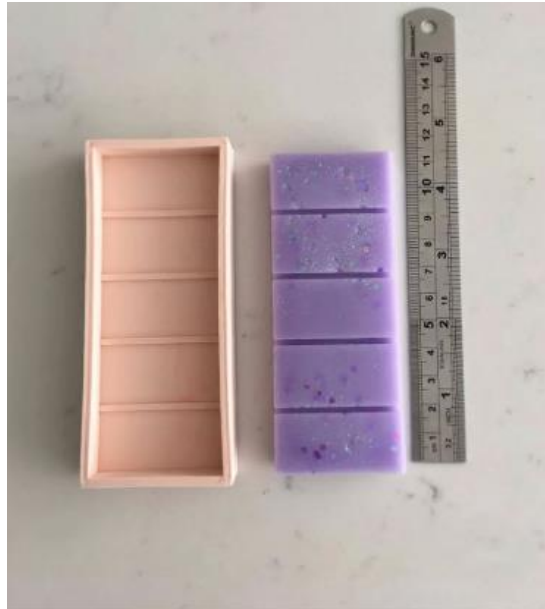
27. The proprietor has filed no further dated images of single snap bar moulds. Those that I have discussed above are not, in my view, so similar to the contested design for me to be able to conclude here and now that the proprietor has invalidated his own design. I shall therefore proceed to consider the examples filed as prior art by the applicant.

The prior art

28. The images below are taken from the social media posts of what appears to be an Australian seller. They show a plain five-celled snap bar mould and are dated 28 June 2020 and 12 January 2020 respectively. They are therefore earlier than the relevant date. The proprietor has not claimed that these disclosures could not reasonably have become known before the relevant date in the normal course of business to persons specialising in the sector in the UK and the European Economic Area. I find that these designs are acceptable as prior art.



29. There is also an Etsy listing that comes from a UK business. It shows a plain five-celled snap bar mould, together with an example of a wax bar which it is reasonable to infer was created using that mould. I reproduce the image below. The listing contains reviews dated 6 November 2020, 20 November 2020, 2 April 2021 and 11 December 2021. Three of these predate the application for the contested design.



30. Mr Cardy states that the seller of this particular item is a close colleague who has his permission to use the design. Section 1B(6)(d) states that a disclosure made by a person other than the designer during the 12 months prior to the relevant date is not a novelty-destroying disclosure when it is made *“in consequence of information provided or other action taken by the designer or any successor in title of his”*. Although the proprietor has not formally said that he is relying on this exception, I understand that to be the thrust of his argument. The Etsy listing does not say when the mould was first available, but the earliest review is dated 6 November 2020. This is less than 12 months before the relevant date in these proceedings. Mr Cardy states that the seller is a moderator of his Facebook group and has full permission to use the design.⁵ Elsewhere, he says that everyone invited to the group (which numbers around 8,000) has been given permission to use his intellectual property.⁶

⁵ Mr Cardy’s evidence, page 3.

⁶ Page 1.

31. In *Magmatic Limited v PMS International Limited*, [2013] EWHC 1925 (Pat), Arnold J (as he then was) expressed his view that the burden of proving that an exception applies rests, in the first place, with the party relying on that exception.⁷ I note that, although the judgment was successfully appealed, the judge's findings on disclosure were not challenged. Mr Cardy has provided no documentary evidence to corroborate his statement. In my view, it would have been straightforward to provide some evidence of the contested design being made available to the members of the Facebook group, which would be evidence of the information given by, or action taken by, the designer. Instead, there is no evidence to show what Mr Cardy did in relation to this particular design. Consequently, I find that he cannot rely on the exception in section 1B(6)(d) and that this disclosure is acceptable as prior art.

Novelty

32. Section 1B(2) of the Act states that a design is new 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:

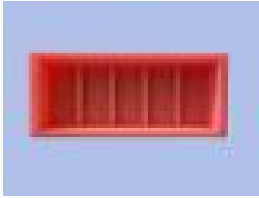

“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”⁸

Comparison of the designs

33. In the table below, I show the registered design alongside the prior art upon which the applicant may rely.

⁷ Paragraph 41 of that judgment.

⁸ Paragraph 26.

The Contested Design	The Prior Art
	

34. I shall base my comparison on the Etsy mould, as this appears to me to be closer to the contested design. In particular, the Australian mould contains a step round the outside of the bar, which is absent in the contested design.

35. The colour and material are disclaimed in the contested design, so these form no part of my comparison. I find that the contested design has the following features:

- a) a flat rectangular base;
- b) five rectangular cells;
- c) cells arranged in a 1x5 row, with the longer sides being the point of near contact with the next cells;
- d) cells separated by a thin straight raised bar;
- e) no decoration on the cells;
- f) straight sides, which are thicker than the raised bar in (d); and
- g) an open top.

36. The overall appearance of the contested design is of a simple, unfussy mould.

37. Looking at the Etsy mould, I find that it also has a flat rectangular base with five undecorated rectangular cells arranged in the same format as in the contested design and each cell separated by a raised bar. This bar appears thicker in the contested design, and it may be that the sides of the mould are slightly thicker in the contested design, and the length of the rectangle slightly longer in relation to the width in the contested design than in the prior art, but in my view these are minor differences that are immaterial and so find the contested design is not novel. However, in case I am

wrong in this assessment, I shall proceed to consider whether the contested design has individual character.

Individual Character

38. 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.

39. 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.”

40. I also bear in mind the comments of HHJ Birss (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):

“How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of ‘different overall impression’ is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand 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.”⁹

The sector concerned

41. Both parties refer to the use of the contested design in the production of wax melts. This is the sector concerned.

The informed user

42. In *Samsung v Apple*, the judge 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);

⁹ Paragraph 58.

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).”

43. The informed user is an individual who makes wax snap bars for their own use or to give to friends, or a small trader who creates the bars for sale. They will be particularly observant when choosing the moulds and be aware of the range of designs available, in other words “the design corpus”.

The design corpus

44. As can be seen from the parties’ evidence, the design corpus includes moulds consisting of single bars with decorated cells, moulds containing multiple bars, and the clam shell shown in paragraph 14 above.

Design freedom

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

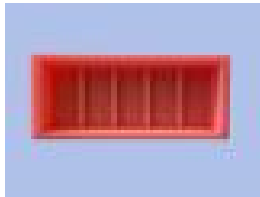

“34. ... design freedom may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive).”

46. The technical function of the mould is to produce a five-celled snap bar. This requires a hollow into which the wax can be poured and which is segmented towards the base to give five sections which are joined together at the base of the bar (top of the mould). Within these constraints, the designer has freedom to choose the

proportions of the bar; whether it will be cuboid in form, or some other shape such as a prism; the thickness of the sides; the width and depth of any dividing sections; whether the cells are all the same size and whether they are plain or decorated; whether the mould can make a single or multiple bars; and whether the top of the mould is open or covered. The designer can also choose the colour or materials, but I remind myself that these features of the design are not claimed by the proprietor. Therefore, I shall not consider the effect of any differences in colour and materials between the contested design and the prior art.

Overall impression

47. Earlier in my decision, I found that the overall impression of both the contested design and the prior design sold on Etsy was of a simple and unfussy mould. Both are cuboid moulds for creating a single, five-celled bar. The moulds have relatively thin sides and open tops. It may be that the sides of the contested design are slightly thicker than those of the prior art, but if they are I consider these to be minor and trivial differences that do not in my view prevent the designs from creating the same overall impression on the informed user. The same applies with regard to the proportions of the cells and the width of the dividing bars between them.

The Contested Design	The Prior Art
	

48. In my view, the designs create the same overall impression on the informed user.

Conclusion

49. The contested design and will be cancelled with effect from 10 May 2021.

Costs

50. The applicant has been successful and would be entitled to a contribution towards the costs of the proceedings. As the applicant is not legally represented, the Tribunal wrote to her on 10 July 2023 to inform her that, if she intended to make a request for an award of costs, she should complete and return a proforma detailing the time spent on the activities listed. As no completed proforma was received, the applicant is entitled only to the official fee arising from the action. This was £48.

51. I therefore order Paul Cardy to pay Corinne Twist 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 8th day of February 2024

Clare Boucher

For the Registrar,

The Comptroller-General