

**O/0099/24**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**REGISTERED DESIGN NO. 6171855  
OWNED BY BLACKSTONE LEISURE LTD**

**AND**

**APPLICATION NO. 25/23  
BY SIGNZWORLD LIMITED  
TO INVALIDATE THE REGISTERED DESIGN**

## BACKGROUND AND PLEADINGS

1. The design which is the subject of the dispute was filed by Blackstone Leisure Ltd (“the proprietor”) on 22 October 2021. The contested design is for a gazebo and is depicted in the following representations:



2. On 13 February 2023, Signzworld Leisure Limited (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that identical designs have been available on Amazon prior to the relevant date.

3. The applicant filed a number of documents with its application for invalidity, all intended to show that the contested design had been made available to the public prior to the relevant date. I will return to this evidence below.

4. The applicant claims that the contested design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a) [...]

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

5. The applicant claims that the contested design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

6. The proprietor filed a counterstatement denying the claims made.

7. The proprietor is represented by Sandersons and the applicant is represented by National Business Register Group Limited. Only the applicant filed evidence. Neither party requested a hearing, but both filed written submissions. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

8. As noted above, the applicant filed a number of documents with its application for invalidity. I have reviewed these documents and they appear to be entirely replicated in the applicant’s evidence. Consequently, I need only consider the evidence as filed by the applicant during the evidence rounds.

9. The applicant's evidence is given by its representative, Mitchell Willmott of National Business Register Group Limited. His evidence introduces the following documents:

- a. An undated print out from Amazon.co.uk which displays the following images, amongst others (I have shown only the most relevant here):<sup>1</sup>

Garden Furniture & Accessories › Event Shelters



**EAGLE PEAK 3m x 3m Pop Up Gazebo Tent with 4 Side Walls, Easy Set up Shelter Barnum with 100 Square Feet of Shade (Cream)**

Visit the EAGLE PEAK Store  
4.1 410 ratings

**-3% £139<sup>99</sup>**  
Was: ~~£143.99~~

Colour Name: Cream

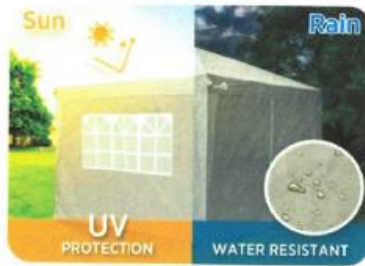
£139.99 £139.99 £199.78

**Brand** EAGLE PEAK  
**Material** Best Quality Frame and Fabric  
**Style** Home, garden, indoor outdoor camping party  
**Item** 3.05 x 3.05 x 2.87 metres

Roll over image to zoom in



<sup>1</sup> Exhibit MW1



## EASY ASSEMBLY



**STEP 01**  
Open the canopy frame

**STEP 02**  
Attach the top, push up on the Easy Peak Center-Push mechanism to raise and lock the canopy frame



**STEP 03**  
Adjust the height or angle for preferred shade coverage and secure the sidewalls

The product is described as having first been available on 8 May 2020.

b. An undated print out from Amazon.co.uk which displays the following image:<sup>2</sup>



This product is listed as having first been made available on 17 May 2018.

10. The applicant filed written submissions dated 14 September 2023 and the proprietor filed written submissions dated 15 September 2023.

11. I have taken the evidence and submissions into account in reaching this decision and will refer to them below where necessary.

## DECISION

12. Section 1B 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.

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<sup>2</sup> Exhibit MW2

(2) For the purposes of subsection (1) above, a design is new if no identical 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 consideration.

(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 condition 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 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.

...”

13. The relevant date is the application date for the contested design i.e. 22 October 2021.

### **The Prior Art**

14. In order to be considered prior art, the designs relied upon will need to have been disclosed prior to the relevant date and must not be excluded disclosures under section 1B(6). I note that the proprietor has challenged whether the provision of Amazon printouts taken after the relevant date are sufficient to establish a disclosure for the purposes of section 1B(6). In this regard, I note that the designs relied upon are described as having first been made available on Amazon on 17 May 2018 and 8 May 2020. In any event, for reasons that will become clear later in my decision, nothing will turn on this. Consequently, I will treat them as prior art. There is no suggestion that they are excluded disclosures.

### **Novelty**

15. 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:

“‘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.”<sup>3</sup>

16. The designs to be compared are as follows:

The Prior Art	The Contested Design
	

<sup>3</sup> Paragraph 26.



**EASY ASSEMBLY**



**STEP 01**

Open the canopy frame

**STEP 02**

Attach the top, push up on the Easy Peak Center-Push mechanism to raise and lock the canopy frame



**STEP 03**

Adjust the height or angle for preferred shade coverage and secure the sidewalls





17. In my view, the designs share the following attributes:

- a. They all consist of four upright poles.
- b. Each has a peaked roof.
- c. They all appear to be approximately square in shape.
- d. They all have two windows, when all sides are down, which each consist of three panels that are square at the bottom and rounded at the top, each of which is made up of ten individual segments, which are identical in position/shape.
- e. When all sides are in the lowered position, they all have one solid panel on one side of the gazebo.
- f. They all have one side which opens with a curtain-effect, with each side of the panel being secured in place at the middle point of the upright poles.
- g. All have a panel of material that comes down from the roof to cover a small section of the upright pole and form a border around the top of the structure.

- h. The images from exhibit MW1 appear to have a similar angular shaped internal structure to the roof, although it is difficult to tell because the structure is partially obscured in all of the images.

18. However, they differ in the following ways:

- a. The contested design has a peak which gradually slopes to a point with an inward curve effect, whereas the prior art has a more rigid peak or, in the case of the image taken from Exhibit MW2, an outward curving peak.
- b. The sides of the gazebo shown in Exhibit MW1 and the contested design appear more rigid than those of MW2.
- c. When the gazebo is erected, the upright poles in the images taken from Exhibit MW1 are all covered with triangular pieces of material which come to a point at the base of the poles, whereas there is no covering on the poles in the contested design. As I have no image of the gazebo shown in Exhibit MW2 with any of the sides fully raised or absent, it is not clear whether the upright poles would be exposed or not.
- d. On the outside, the contested design is black in colour, whereas the gazebo shown in the prior art are all white, blue or green.
- e. The inside material of the contested design is black, whereas the inside material of the prior art is either blue or white.
- f. The fastenings of the curtain-effect panel in the contested design appear to be much looser than those in the prior art, meaning that the opening appears smaller in the contested design.
- g. The contested design features a badge in the top right hand corner of the front facing panel. The images taken from Exhibit MW1 all display a different badge on the left hand corner of the front facing panel and the image taken from Exhibit MW2 does not carry a badge at all.

19. The prior art shown in Exhibit MW1 contains legs that appear to be extendable/adjustable. The applicant also submits that the legs of the contested design are adjustable, but that is not apparent to me from the images contained within the registration. In this regard, I note that in *Magmatic Ltd v PMS International Ltd* [2016] UKSC 12 the Supreme Court stated that:

“when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.”

20. Whilst I note that there appears to be a join or support half way up the structure, it is not clear that this is (or can be) used to extend/adjust the legs. As it is not clear from the representations shown in the contested design, I am not able to take it into account.

21. Clearly, there are some differences between the designs. In my view, these differences are more than immaterial. Consequently, the claim that the contested design is not new fails.

### **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 registered design compared to the prior art.

23. 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.”

24. 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.”<sup>4</sup>

### The informed user

25. Earlier in the same decision, 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-

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<sup>4</sup> Paragraph 58.

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)."

26. The contested design is for a gazebo. The informed user is, therefore, most likely to be a member of the general public looking to purchase the goods for use on their



own private property, but may also include some business users looking to use the goods for outside seating areas at business premises. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

### Design Corpus

27. No evidence has been filed regarding the type, range or variety of gazebos that were available at the relevant date.

### Design freedom

28. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) stated at paragraph 34 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).”

29. The designer of a gazebo will, to some extent be constrained as to the shape of the product as it will need to consist of upright posts, which secure in place a roof to keep the user shaded from the weather (be it rain or sun). Similarly, the designer is likely to ensure that materials are sufficiently weatherproof. However, even within those constraints, there is likely to be a significant amount of design freedom in terms of colour, surface decoration, size, particular features (such as windows, collapsible/foldable sides) and material.

### Findings

30. In my view, the designs do not share the same overall impressions. I bear in mind that at least some of the similarities arise by virtue of their function and purpose. For example, the common existence of upright poles and a roof structure is essential for the goods to achieve their function/purpose. They are all noticeably different in overall

appearance, not least because of their colour, but also because of the differences to their configurations. For example, the triangular-effect on the poles in exhibit MW1 and the impact that this has on the appearance of the gazebo when the curtains are in the open position is an important point of difference. In respect of exhibit MW2, there appears to be far less rigidity to the structure, creating a bulbous appearance which is absent from the contested design. Consequently, I consider that the contested design lacks neither novelty nor individual character.

## **CONCLUSION**

31. The application for invalidation fails.

## **COSTS**

32. The proprietor has been successful and is entitled to a contribution towards its costs. The proprietor was professionally represented in these proceedings, and I make the following award based on the standard scale:

Preparing a counterstatement and considering the Notice of invalidation	£250
Written submissions	£350
<b>Total</b>	<b>£600</b>

33. I therefore order Signzworld Limited to pay Blackstone Leisure Ltd the sum of £600. 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.

**Dated this 12<sup>th</sup> day of February 2024**

**S WILSON**

**For the Registrar**