

O/0114/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6181575

OWNED BY ZAREE SERVICES LTD

AND

APPLICATION NO. 172/23

BY JULIUS OLIVETI

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The design which is the subject of the dispute was filed by ZAREE SERVICES LTD (“the proprietor”) on 16 December 2021. The contested design is for a toothbrush head and is depicted in the following representation (no claim is made for the colour shown):



2. On 10 August 2023, Julius Olivetti (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that identical or similar designs have been made available on Amazon prior to the relevant date.

3. The applicant filed a number of documents with its application for invalidity, intended to support its claim 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. In particular, the proprietor states:

“[The] claim could not be proved as the photos can easily be changed on Amazon at any time without affecting listing creation date. For example, if a listing created on Amazon on 1/5/2018, and for any reason (may be new model) new photos are added to that listing then the listing creation date wouldn't change and will remain the same as 1/5/2018.”

7. Both parties are unrepresented. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. As noted above, the applicant filed documents with its notice of invalidity. These are as follows:

- a. A printout from Amazon which shows the following toothbrush heads available for sale:



This product is described as having been made available for sale on 3 June 2020.

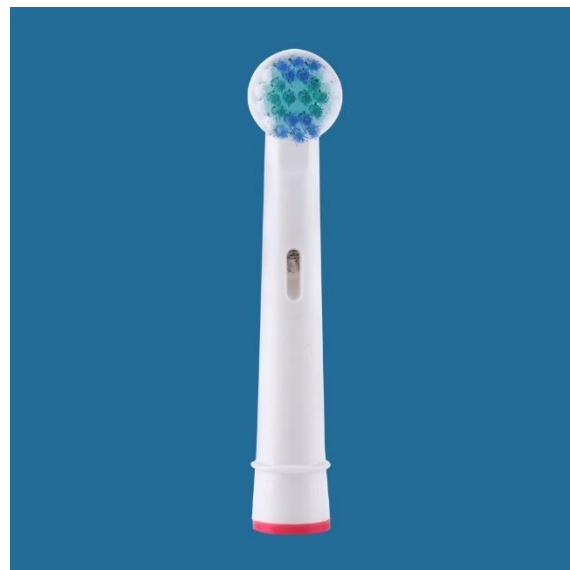
- b. A printout from Amazon UK which shows the following toothbrush heads available for sale:



This product is described as having been made available on 29 March 2018.

9. These documents were not filed in the correct evidential format i.e. under cover of a witness statement signed with a statement of truth. However, as they were filed under cover of the Notice of invalidation which includes a statement of truth signed by the applicant, I will give these documents the same weight as I would have done had they been filed correctly.

10. The applicant filed undated written submissions during the evidence rounds on 19 September 2023. In these written submissions, the applicant introduced a registered design (no. 90082202710002) upon which it sought to rely in answer to the proprietor's claim that the Amazon images referred to above may not reflect the correct representation of the product that was first made available on the dates shown. The applicant claims that the fact that this registered design was filed on 30 October 2020 shows that the design was not new and did not have individual character at the relevant date. Registered design no. 90082202710002 is represented by a number of images, the most relevant of which is as follows:



11. The proprietor filed undated written submissions during the evidence rounds on 20 October 2023.

12. The applicant filed undated written submissions in reply dated 1 November 2023.

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

DECISION

14. 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.

(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.

...”

15. The relevant date is the date of the application for the contested design i.e. 16 December 2021.

The Prior Art

16. 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).

17. I note that the designs relied upon by the applicant are described as having first been made available on Amazon on 3 June 2020 and 29 March 2018, respectively. Plainly, these are both dates prior to the relevant date. However, the proprietor challenges the accuracy of these dates as it claims that the images of the products sold under these listings might have been materially altered. The same issue has been considered before by this Tribunal.¹ In considering the matter, the Hearing Officer stated:

“[...] 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.”

18. That is also true here. The Amazon printouts which record the date of first availability of the products are *prima facie* evidence of the date on which those designs were disclosed. The proprietor has put forward nothing more than a possibility that the product listing may have been changed. Without something more to demonstrate that it is has (or is likely to have been) changed in the case of these particular listings, I do not consider that this assists the proprietor. In my view, these printouts show prior art upon which the applicant may rely.

19. There is no suggestion that these are excluded disclosures.

20. I note that the applicant introduced a registered design in its written submissions. However, reliance upon this design was not pleaded in its Form DF19A. For reasons that will become clear later on in this decision, nothing will turn on this and I do not need to consider the impact of that earlier registered design any further.

¹ BL O/0038/23

Novelty

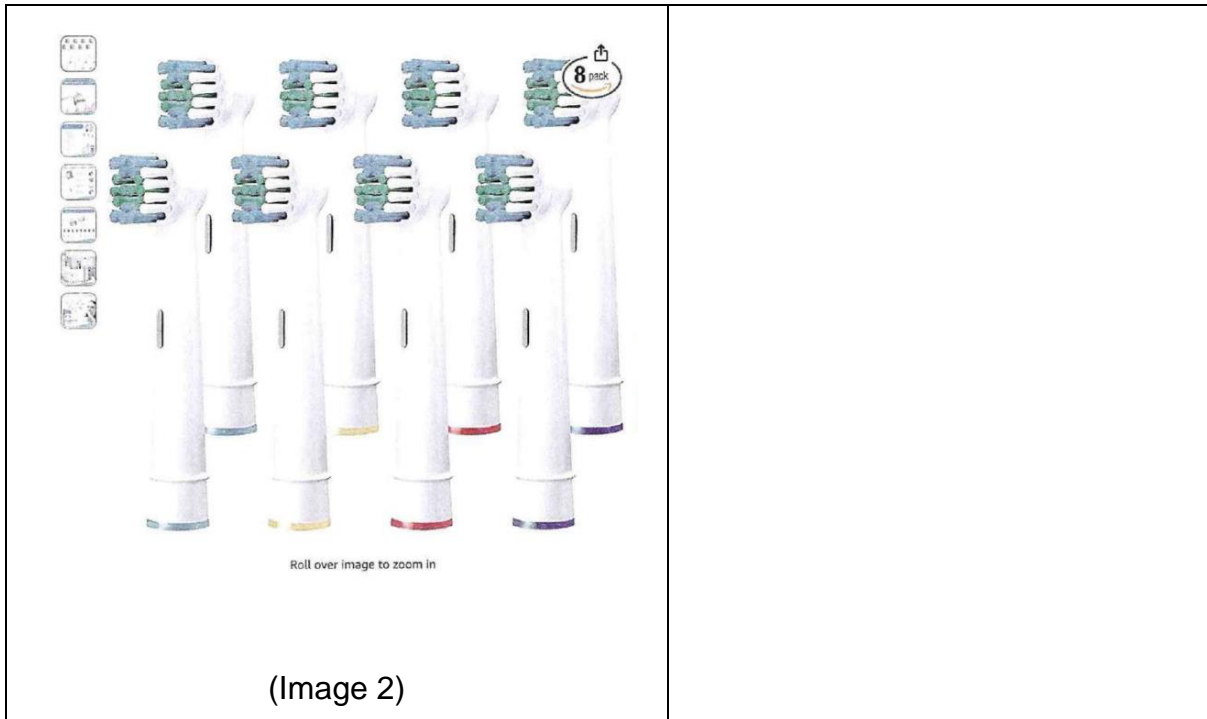
21. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a 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.”²

22. The designs to be compared are as follows:

The Prior Art	The Contested Design
 <p data-bbox="454 1731 595 1771">(Image 1)</p>	

² Paragraph 26.



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

- a) They all consist of a rounded upright structure, which is wider at the base than it is at the top.
- b) At the top of each is a circular section into which the bristles are secured.
- c) The bristles themselves are all arranged in a circular pattern.
- d) Further, the pattern of the coloured bristles in Image 2 are arranged in the same pattern to those in the contested design. There are four white bristles on either side and three blue bristles at the top and bottom. There is then an inner circle of bristles, which shows two blue bristles at the top and bottom, and three green bristles on either side. There are then two central green bristles in the middle of the circular head. I note that no claim is made to the colour shown, but the common pattern used is relevant to the assessment.
- e) The pattern of the colour used in Image 1 follows a similar pattern to that used in the contested design.

- f) All of the designs have two circular bands near the base of the upright structure. The higher of the two appears to be a ridge in the plastic, which appears identical in all three designs.
- g) The designs all appear to have the same shaped hole just over halfway up the upright structure.

24. However, the designs differ in the following ways:

- a) There are four central bristles in Image 1, whereas there are only two in the contested design.
- b) There appears to be a grey oval-shaped marking on the upright structure of Image 1, which appears to contain a brand name, which is absent from the contested design.
- c) There is a raised circle at the base of the upright structure in the contested design which does not appear to be replicated in either Image 1 or Image 2.
- d) I note that the lower band appears on the upright structure of each of the designs appears in different colours in the images shown, but I bear in mind that no claim is made to the colour shown in the contested design.

25. The only difference between Image 2 and the contested design is the raised circle on the upright structure of the contested design. As noted above, any differences arising from the colours used are not relevant due to the disclaimer in the contested design. Whilst these are differences between the designs, I consider them to be immaterial. I agree with the applicant that the design lacks novelty when compared with Image 2. I also consider the differences between the design shown in Image 1 and the contested design to be immaterial, such that it also lacks novelty when compared with Image 1.

Individual character

26. For the sake of completeness, I will also consider whether the contested design lacks the necessary “individual character” when 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.

27. 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.”

28. 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.”³

The Informed User

29. 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-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);

³ 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).”

30. The contested design is for a toothbrush head. The informed user is, therefore, most likely to be a member of the general public looking to purchase the goods for their own use. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

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

Design Freedom

32. 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).”

33. The designer of a toothbrush head will, to some extent be constrained as to its shape and size as it will need to be small enough to fit inside the user’s mouth and to

secure to the toothbrush handle. It will also need to have a brush head which is a suitable shape to fulfil its function of cleaning the user's teeth. There will also be some constraints as to material by virtue of the need for it to be waterproof. However, there will be some variation, for example, in the surface decoration, arrangement of the bristles and shape of the brush head.

Findings

34. In my view, the designs share the same overall impression. I bear in mind that some of the similarities arise by virtue of their common functionality and purpose. However, when taking account of the areas in which there would be design freedom, these are all identical or very similar (such as the shape of the brush head and the arrangement of the bristles). The colour and bristle pattern of the brush itself is the same or similar. I consider that the same overall impression will be created, notwithstanding the minor differences between the designs. Consequently, I consider that the contested design lacks individual character when compared to the prior art.

CONCLUSION

35. The application for invalidation is successful.

36. Registered design no. 6181575 is declared invalid under section 11ZA(1)(b) of the Act.

COSTS

37. As the applicant has been successful he would normally be entitled to a contribution towards its costs. However, as the applicant is unrepresented, the Tribunal wrote to him on 6 November 2023 inviting him to file a completed costs proforma if he wished to claim costs. The Tribunal stated:

“If the pro-forma is no completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.
[...]

38. No costs proforma has been filed. Consequently, I award only the official fee for the application of £48.

39. I therefore order ZAREE SERVICES LTD to pay Julius Olivetti 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.

Dated this 15th day of February 2024

S WILSON

For the Registrar