

O/0226/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 6106279
IN THE NAME OF WEIMING LI
IN RESPECT OF THE FOLLOWING DESIGN:**



AND

**AN APPLICATION FOR INVALIDATION (NO 84/22)
BY MARKUS NECHWATAL**

Background and pleadings

1. Weiming Li (the proprietor) filed application number 6106279 to register the design shown on the front cover of this decision, described as a 'corkscrew'. The filing date was 12 November 2020. The design was registered on 27 November 2020 (the relevant date).

2. The design is depicted as follows:



3. On 29 April 2022, Markus Nechwatal (the cancellation applicant) made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 ("the Act"), on the grounds that products embodying the registered design, or designs that create the same overall impression, were made available to the public from as early as 21 March 2013. Consequently, the design was not new and lacked the necessary individual character at the time it was registered.

4. In support of the claim the cancellation applicant filed copies of two patents filed in China, the first in 2015 and the second in 2018. It also filed pages printed from Amazon UK, said to show the same design, available to the UK public from at least 2013.

5. The proprietor filed a counterstatement defending the registration of the design on the ground that (reproduced as written):

“[The contested design] has unique characteristics and has an overall different impression than the products of the designs the applicants propose as the basis of his invalidation.”

6. Further, and with regard to the patents filed by the cancellation applicant, the proprietor submits that patent law does not offer protection for the appearance of a product.

7. Neither the cancellation applicant nor the proprietor is professionally represented.

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

Evidence

9. The cancellation applicant filed evidence that consists of a witness statement, made by the applicant, with four exhibits attached. Mr Nechwatal’s statement provides evidence about the designs that the cancellation applicant claims were available on Amazon UK. He also provides evidence of two patents filed in China prior to the relevant date. This material largely reproduces the material filed with the application for invalidation.

10. The proprietor did not respond beyond the comments in his counterstatement, reproduced above at paragraph 5.

The law

11. 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”.

12. Section 1B of the Act reads:

“(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 European Economic Area and specialising in the sector concerned;

(b) - (e)

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) ...

(9) ...

Prior Art

13. This comprises prints taken from Amazon UK for the following products:

- ‘Zap Cap Stainless Steel Bottle Opener – Elegant Magnetic Bottle Opener by CellarDine.’¹ The item is shown as first available on 21 August 2006.
- A ‘White Zap Cap’ from the same seller has a ‘first available’ date of 28 June 2006.²
- ‘Beer Bottle Opener with Magnet...Opens Glass Bottles in Half a Second, Magnet-Automatic Beer Bottle Opener...’.³ This product is shown as first available on 23 February 2019.

14. The cancellation applicant provides close up images of the thumbnail pictures included on the Amazon UK listings for the two ‘Zap Cap’ products it relies on. He concludes that when comparing these to the contested design, “...*anyone can see that the design of these*

¹ See exhibit 1.

² See exhibit 1.1(a).

³ See exhibit 1.2.

products is completely identical to the proprietor's design, in particular, the lines, contours, oval shape, texture or materials of the product are exactly the same".⁴

15. In *Senz Technologies BV v OHIM*, the General Court ('GC') held that, "A design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure."⁵

16. I accept the evidence shows that bottle openers, such as the three contained in the Amazon UK prints, were disclosed in the UK in places where they could "...reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the geographical area comprising the United Kingdom and the European Economic Area and specialising in the sector concerned."

17. The cancellation applicant has also provided details of two patents filed in China, which it claims represent further examples of the contested design being known before the relevant date. I cannot be sure whether the patents could reasonably have been known by the relevant sector in the necessary geographic area of the UK and EEA (European Economic Area) and no evidence has been provided in support of this point. Given that the applicant has provided three examples of prior art that are relevant I will base my comparison on these and will say no more about the Chinese patents.

Comparison of the designs

18. I note that the applicant describes the images of Amazon UK thumbnails he provides at exhibit 2 as being from the first two products listed on Amazon UK. Namely, the Zap Cap products. In fact, the two most useful examples are taken from the first product, and it is those that I will compare with the relevant representations of the contested design.⁶


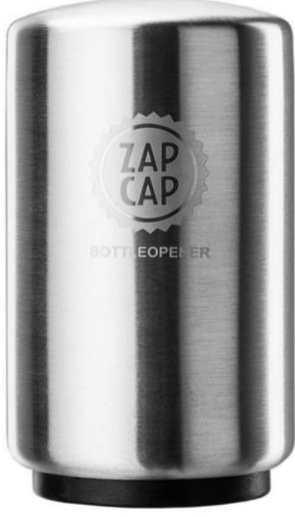


19. The registered design is shown with the wording upside down, the prior art is shown with its wording the correct way up. For ease of reference, I will compare the designs with both facing in the same direction with the writing applied to the surface of the design facing the correct way.

⁴ See page 2, paragraph 2 of the applicant's witness statement.

⁵ Joined cases T-22/13 and T-23/13, paragraph 26.

⁶ This is because the images include a clear view of the bottom of the product.

The comparison is as follows:

The Registered Design	The Prior Art
	
	

20. 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*,⁷ 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

⁷ [2019] EWHC 3149 (IPEC).

material respect, even if some or all of the design features, if considered individually, would not be.”

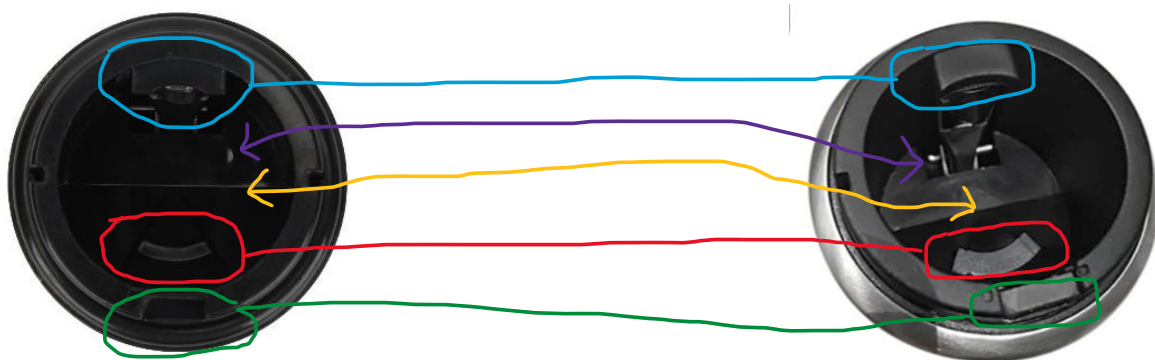
21. I note that the contested design is described as a corkscrew when it is clearly a bottle opener. Whatever the description, I will compare the contested design with the prior art and will draw the necessary conclusions.

22. I also note that the image showing the bottom of the contested design is of poor quality and not all of the details are clear. In addition, the images for the two designs are shown from different angles, which makes the comparison a little more difficult.

23. The contested design and the prior art both have:

- A cylindrical shape;
- A convex top;
- A ring at the bottom which is shallow in depth compared with the whole design;
- The ring being narrower than the main cylindrical part of the design.

24. Seen from the bottom, the contested design and the prior art have a circular void that contains the following features in common;⁸

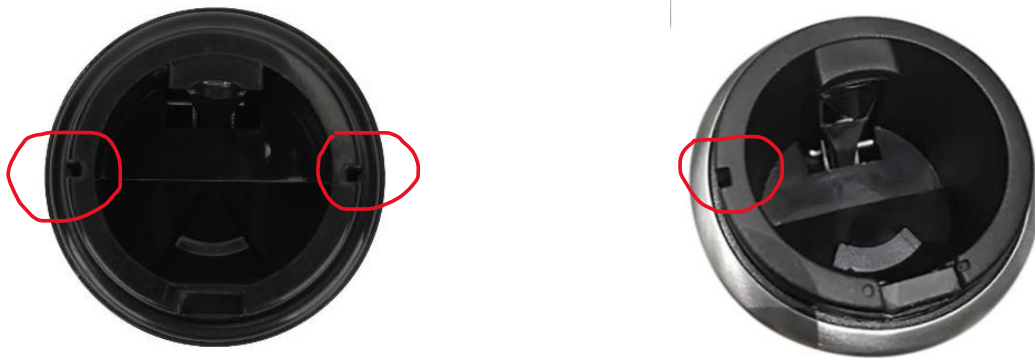


25. The thickness of the ring is the same in both designs as is the ratio between the circumference of the main body of the product and that of the ring.

26. Differences between the physical nature of the contested design and the prior art are:

⁸ These have been identified with coloured circles for ease of reference.

(1) the small square holes on the left and right sides of the contested design, which only appear on the left side of the prior art. Shown below:



(2) the colour of the main body of the product, which is black in the contested design and silver/metal in the prior art. I note that neither material nor colour have been disclaimed in the contested design.

27. With regard to the surface decoration, I must also consider the 'logo' that has been applied to the main cylinder of the contested design, as it has not been disclaimed by the proprietor. It features a guitar with lightning and the words 'Thunder Rock 1979'. It is pale grey/silver on the black body of the product. The prior art has words Zap Cap printed on the body of the bottle opener and has the words 'bottle opener' written below Zap Cap. The words are white/pale grey on a silver background.

28. In considering the extent to which these surface decorations are relevant, I bear in mind the decision of the Supreme Court in *Trunki*.⁹

29. In that case surface decoration such as animal stripes and whiskers were applied to the outsides of children's suitcases that took the form of animals. Clearly, in that context, the surface pattern can be said to contribute to the overall animal design and reinforces the design message. This can be distinguished from this case to the extent that the design of a product and its surface decoration remain separate and unconnected. However, the product is a bottle opener, which carries a brand/logo that is 'decorative' and is clearly a

⁹ PMS International Group Plc v Magmatic Limited [2016] UKSC 12.

feature of the design. It clearly provides a further point of difference between the contested design and the prior art, which has very different decoration.

30. In conclusion, whilst the area of the product used to open bottle caps is very similar in both designs, the colour and surface decoration are clearly different. Overall, I find the differences between the two designs to be more than immaterial and conclude that the contested design is new compared with the prior art.

Individual character

31. A design may be new but still lack the necessary 'individual character' compared with 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*,¹⁰

"The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration."

32. 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*.¹¹ 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

¹⁰ [2010] FSR 39.

¹¹ [2018] EWHC 345 (Pat).

- (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.”

33. 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.*¹²

“58...How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One

¹² [2012] EWHC 1882 (Pat).

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.”

The sector to which the products belong

34. The relevant sector is the market for bottle openers.

The informed user

35. 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);

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).”

36. The informed user is an individual who wants to remove caps from bottles. This may be for their own use or in the context of, inter alia, a bar or restaurant. They will be observant and will have an interest in both appearance and functionality of the design.

The design corpus

37. The applicant’s evidence consists of the prior art I have used for the purposes of comparison and a couple of other examples of the same type of product. I therefore have no evidence beyond those examples to show me the design corpus at the relevant date.

Design freedom

38. In *Dyson Ltd v Vax Ltd*,¹³ Arnold J (as he was then) stated that:

¹³ [2010] FSR 39.

“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).”

39. The technical function of the bottle opener necessitates the opening at the bottom to accommodate a standard bottle cap and it must have the necessary components to remove the cap. This means that the physical similarities in the undersides of the respective designs are functional and must be given a much lower weight in the overall comparison. In addition, I bear in mind that the underside of the design is also much less likely to be seen in use.

40. The designer has the freedom to choose the shape of the opener and its proportions, though this will be in the context of the user needing to hand hold the product and remove bottle caps from bottles, which will always be round. The designer has more freedom in determining the profile of the top of the opener and the texture and decoration applied to the outer surface. Colour and materials have not been disclaimed by the proprietor, but the materials must be, at least, impervious to liquid, given the purpose of the product.

41. I have already listed the features of each of the respective designs and have identified the physical and aesthetic differences between them. In my view, bearing in mind point 5 in *Cantel Medical*, which makes clear that similarity between functional elements of designs should be disregarded in the comparison, and point 6 in the same case, which makes clear that the informed user is likely to place less weight on parts of the design that are not seen in use, I find that the differences between the respective designs, in particular, the colour and surface decoration, mean that they create different overall impressions on the informed user.

The invalidation against this design has failed under section 1B of the Act.

COSTS

42. The proprietor has been successful and is entitled to a contribution towards its costs. The proprietor represented themselves until 24 October 2022 when they appointed a

professional representative. No evidence or written submissions were filed but an amended counterstatement was filed after the appointment of the proprietor's professional representative. I make the following award based on the standard scale:

Preparing the counterstatement and considering the Notice of invalidation	£250
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I therefore order Markus Nechwatal to pay Weiming Li the sum of £250. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an unsuccessful appeal, within 21 days of the conclusion of those proceedings.

Dated this 15th day of March 2024

**Al Skilton
For the Registrar,
The Comptroller-General**