

O/0266/24

REGISTERED DESIGNS ACT 1949

REGISTERED DESIGN No. 6072387

IN THE NAME OF ALFRED VICTORIA LIMITED

FOR THE FOLLOWING DESIGN



AND

APPLICATION 150/21 FOR INVALIDATION

BY CARAFAX LIMITED

BACKGROUND AND PLEADINGS

1. On 1st October 2019 (“the relevant date”), Alfred Victoria Limited¹ (“the proprietor”) filed application 6072387 to register the design shown below for thermostatic shower bar valves.



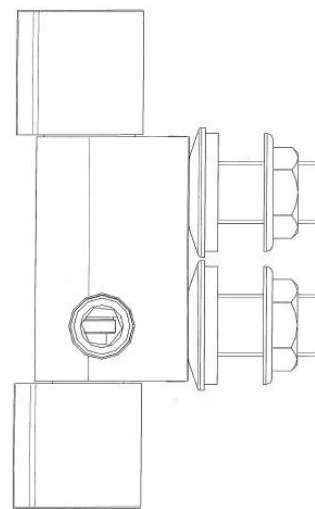
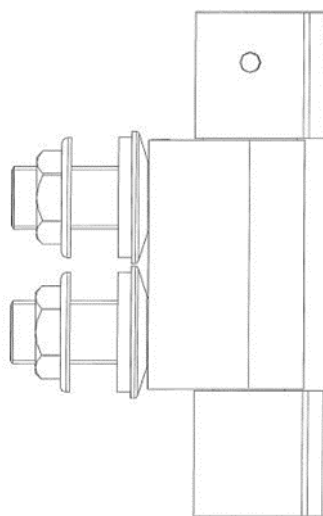
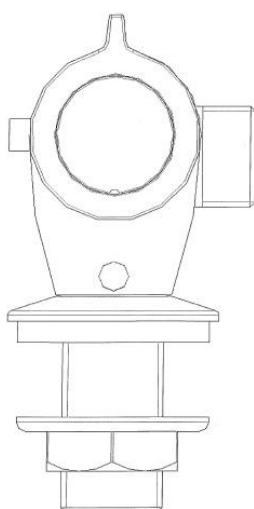
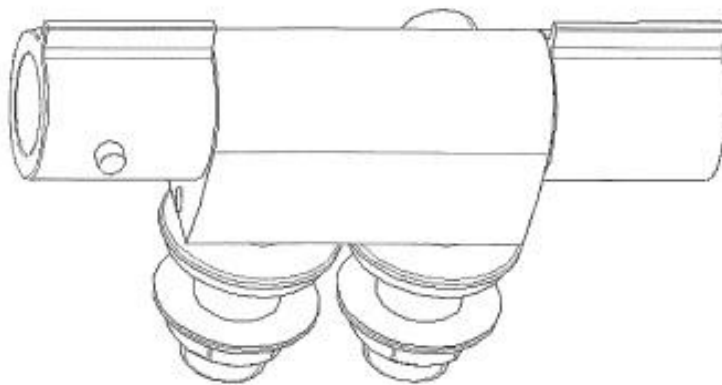
¹ Then called Alfred Bathroom Ltd



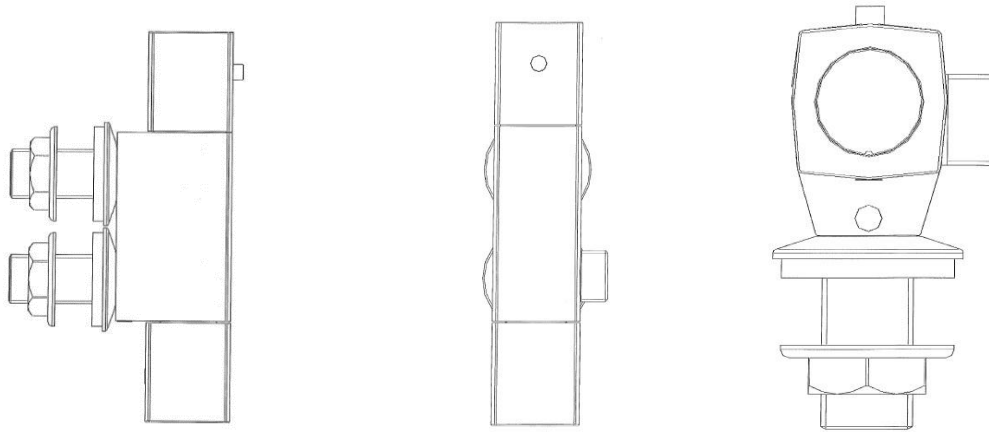
2. On 10th December 2021, Carafax Limited (“the applicant”), made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the grounds that it is the same as, or creates the overall impression as, earlier registered designs 90022179430001 (‘001) and 90022179430002 (‘002), of which the applicant is the proprietor, and a product marketed in the UK since 2013 which embodies the ‘001 design. Consequently, the contested design was not new and lacked the necessary individual character at the time it was applied for and registered.

3. Illustrations of the earlier designs are shown below.



90022179430001



90022179430002



Product embodying the earlier '001 design

Product according to the Registration	Product according to the Earlier Designs
	

4. The earlier registered designs were registered and published as EU designs in 2013. Following the UK's withdrawal from the EU the UK design registrations were created in accordance with withdrawal legislation. They are treated as though they have been registered here throughout.

5. The applicant's pleaded case draws attention to what it says is the close similarity between the dimensions, shape and position of the following features of the contested design:

- (1) the cylindrical central housing with two 'handwheels' on either side;
- (2) the shape and dimensions of the central housing "*which are virtually identical;*"
- (3) the shape, size and location of the two spherical 'wall mounts' located centrally on the central housing;
- (4) the shape of the 'lip' on both of the 'handwheels';
- (5) the location and colour of the protruding button on the right-hand 'handwheels';
- (6) the size and location of the off-centred off pipe.²

6. The applicant says that its product was designed to meet the needs of the caravan and holiday home industry. As a result, it was the only product of its kind and established itself as a market leader. It is fitted as standard by several of the major holiday home manufacturers. According to the applicant, the degree of similarity between the prior art and the contested design, together with the potential for different designs, indicates the latter was copied from the applicant's designs.

7. The proprietor filed a counterstatement denying the applicant's grounds for invalidation. I note the proprietor agrees with the applicant that products embodying the designs at issue are mixer shower taps for use in caravans and holiday homes. I also note the proprietor:

- (1) claims that there are technical requirements limiting the design freedom for minimal size thermostatic mixer taps for caravans and holiday homes;

² The applicant also draws attention to the shape, size and location of two grub screws on the reverse of the central housing and the location of the hot and cold water pipes indicated with round red and blue stickers. However, as the proprietor points out, neither feature is shown in the registration of the contested design. Consequently, these cannot be points of similarity with the earlier registered designs.

- (2) complains that the applicant's case focuses on similarities between the designs relating to technical features whilst ignoring the design differences;
- (3) denies copying the earlier designs, and points out that copying is irrelevant to the validity of registered designs.

8. As regards the specific similarities identified by the applicant the proprietor responds:

- (1) Thermostatic mixer taps are technically constrained because they need to include a thermostatic cartridge, and such cartridges are generally cylindrical in shape. In order to satisfy the technical constraint of minimising the size of the product, a cylindrical housing (conforming to the shape of the cartridge) must be used.
- (2) The inclusion of a thermostatic valve *per se* is not a design choice – it produces a technical advantage of preventing accidental scalding;
- (3) Thermostatic taps operate using two handles – one which controls water flow, and one which controls temperature. Integrating the handles at the ends of the cylindrical housing minimises the space taken up by such handles and avoids the need for additional componentry to connect them.
- (4) Providing such handles as 'wheels' which are generally contiguous with the cylindrical central housing further minimises the size of the product.
- (5) The contested design includes black washers located between the handles and the main housing body, which are not included in the earlier designs. Furthermore, the cover caps at the end of the handles in the contested design are much smaller in diameter relative to the total handwheel diameter when compared to the cover caps of the earlier designs.

- (6) The contested design creates an overall more streamlined impression because the dimensions of the central housing have a smaller 'aspect ratio' than the earlier designs. In particular, the length of the housing of the earlier design appears to be less than twice the length of the handles. By contrast, the length of the housing of the contested design appears more than 2.5 times the length of the handles.
- (7) The wall mounts provide fluid connection with the hot and cold water pipes and are therefore a functional requirement of a mixer tap. As the pipes have a circular cross-section, it is most efficient for the wall mounts to also have a circular cross-section to avoid water leaks and minimize the material required. Further, the size constraints on a shower for small spaces limit how the wall mounts can be positioned.
- (8) The more streamlined shape of the central housing of the contested design allows a small gap to be provided between the wall mounts. In contrast, the wall mounts of the earlier designs appear to be very nearly touching.
- (9) It is a functional requirement to provide a lip on the 'handwheels' so that the handles can be gripped and turned. The lips of the contested design are located on the top of the handles and extend directly upwards when in the 'off' position. By contrast, the lips of the earlier designs are located at the front of the housing and extend forwards when in the 'off' position. Further, the lips of the contested design are shorter than those in the earlier designs, and have a squarer shape with less tapered ends.
- (10) Thermostatic valves generally include override stops to prevent the water temperature rising above a set value unless deliberately actuated. Therefore, the feature of a 'protruding button' located on the handwheel configured to control water temperature is a technical constraint enforced by statutory requirements.
- (11) The 'protruding buttons' of the contested design and the earlier designs

are “*strikingly different.*” The one in the contested design incorporates a slider in the shape of an elongated rectangle with rounded corners whereas the earlier designs implement the safety feature as a button, which is cylindrical in shape and extends directly out from the handle. Further, the slider of the contested design is located on the front face of the handle (when the handle is in the ‘off’ position). In contrast, the button of the earlier designs is located on the upward face and protrudes upwards.

(12) The size of the off pipe is dictated by the technical requirement that it be suitable for connection to a shower hose. As the housing of the contested design is technically constrained so as to be as small as possible, the thermostatic cartridge occupies nearly half of the length of the shower bar. The size of the cartridge precludes the possibility of placing the off pipe in a central position, and so the off pipe is necessarily located off-centre. The off pipe of the contested design also includes a design feature which is not present in the earlier design; namely, a tapered section between the off pipe and the main housing.

REPRESENTATION

9. The applicant is represented by Womble Bond Dickinson (UK) LLP. The proprietor is represented by Mathys & Squire LLP

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

EVIDENCE AND SUBMISSIONS

11. The applicant filed written submissions and factual evidence. The evidence consists of two witness statements by Daniel Sampson, who is a director of the company. The purpose of Mr Sampson’s first statement (with four exhibits) is to show that the applicant has been marketing a product embodying the ‘001 earlier design since 22nd February 2013. It is called the V200. He also refers to the contents of ten annexes to written submissions filed at the same time as his statement, which he says

show a wide variety of designs for taps that perform the same function as the designs at issue in these proceedings, including taps for caravans and holiday homes. According to Mr Sampson, this illustrates the degree of design freedom available. Mr Sampson's second statement replies to the proprietor's evidence-in-chief.

12. The proprietor also filed written submissions and evidence. The latter consists of three witness statements by Ting Huang, who is a director of the proprietor. The purpose of Mr Huang's first statement (with three exhibits) appears to be show that a product embodying the contested designs (which the proprietor calls the VM37) is a development of an earlier design which had a vertical L-shaped configuration. According to Mr Huang, the design was changed (he does not say when) in response to customer feedback calling for a horizontal configuration to match household (as opposed to caravan/holiday home) shower valves.

13. Mr Huang's second statement (with ten exhibits) provides evidence:

- as to the relationship between the shape and dimensions of the housing of the applicant's V200 product, the proprietor's VM37 product, and the thermostatic cartridges they house (exhibits TH4 and TH6);
- that Building Regulations 2010 and market standards stipulate the use of thermostatic valves to control the temperature of the water from showers in all new build properties (exhibits TH7 and 8);
- about the design corpus for thermostatic shower valves for caravans (exhibit TH9);
- intended to show that thermostatic mixer taps with "*cylindrical central housing and two 'handwheels' on either side*" and "*the shape and dimensions of the central housing* [of the designs at issue] are commonplace (exhibit TH12); and
- that one such product (the Bristan VSHXSPDIV) was disclosed in 2011 and therefore constitutes prior art compared to the applicant's earlier designs (exhibit TH13).

14. The following matters are included in Mr Sampson's statement in reply to Mr Huang's statements:

- Illustrations showing at least three designs for caravan thermostatic mixer valves with a centrally positioned outlet or off-pipe (see exhibit DJS6);
- That the parties' V200 and VM37 mixer taps have the same dimensions;
- Standard product requirements do not constrain the look of a tap as long as the product has anti-scald protection;
- The images of the design corpus for caravan thermostatic mixer taps at exhibit TH9 show that the proprietor could have produced a different design while complying with any technical constraints;
- The Bristan shower tap shown in exhibits TH12 and 13 is not a thermostatic shower mixer tap for caravans, and has an 'in-line' (vertical) valve with different control levers than those in the earlier designs.

15. Mr Huang filed a further witness statement in which he:

- accepted that the outlet or off-pipe can be positioned in various places on thermostatic mixer taps in general, but maintains that the position and size of the thermostatic cartridge imposes a technical constraint on designs for *"minimally sized thermostatic shower mixer taps;"*
- disputed the V200 and VM37 taps have the same dimensions, pointing out that the handles on the V200 are noticeably longer than in the product embodying the contested design;
- claimed it would not have been possible to design a very different product while still meeting the necessary technical requirements of being minimally sized (in particular such that the protrusion of the product towards a user is minimised) but still ergonomic;
- agreed that the standard product requirements do not require any particular look, but maintained they do require the presence of a button of some sort on the handwheel in order to avoid accidental scalding;
- disputed the relevance of Mr Sampson's evidence that the Bristan VSHXSPDIV is not a thermostatic shower mixer tap for caravans.

THE LAW

16. Sections 11ZA(1)(b) and 11ZA(1A) of the Act state 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”.

“(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—

*(a) has been made available to the public on or after the relevant date; but
(b) is protected as from a date prior to the relevant date by virtue of registration under this Act or an application for such registration.*

(1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later 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.”

17. The relevant parts of Section 1B of the Act are 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) -

(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.”

18. A thermostatic shower bar valve is part of a shower and, therefore, part of a complex product.

STATUS OF EU LAW

19. 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 some decisions of the EU courts which predate the UK's withdrawal from the EU.

IRRELEVANT MATTERS

Colour of the earlier registered designs

20. The earlier registered designs are in the form of black and white line drawings. This usually means that they cover only the shape and configuration of the product. The contested design is registered in colour. Therefore, the colours shown form part of the design.³ However, to the extent that the applicant's complaint is that the contested design takes the shape and configuration of the earlier designs, the colours shown in the contested design do not negate the applicant's complaint. That is particularly so in this case because the main colour shown (silver) is plainly commonplace for taps, as is the use of red for warning signals, such as an override button for a hot water control.

21. I accept that a product embodying the '001 design has been marketed in the UK since 2013. It therefore constitutes an earlier design. The product in question is silver in colour and has a red anti-scald button. Consequently, the use of the same colours in the contested design can be taken into account. However, for the reasons given above, they have limited impact on the required assessments.

Measurements

22. The contested design is not registered in a specific size. Therefore, the measurements of products embodying the design and the prior art are irrelevant. By contrast, the relative proportions of different parts of the products are a feature of the designs. These can be taken into account.

³ See paragraphs 31 -49 of the judgment of the Supreme Court in *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12

Copying

23. It is not necessary to show copying in order to invalidate the contested design on grounds of lack of novelty. Therefore, the issue of whether the proprietor copied the earlier designs (as the applicant claims) or not (as the proprietor says) is also irrelevant, except to the extent that evidence of copying could shed light on whether the contested design is new, or whether an inference can be drawn that it creates the same overall impression on an informed user as the earlier designs, partly because it was intended to do so.

Parts not visible in normal use

24. The water pipes and the back nuts that hold the mixer taps to the inside of the shower enclosure are not visible in normal use. Consequently, the appearance of this part of the designs is irrelevant.

Product illustrations

25. The applicant seeks to rely on the product illustrations shown in paragraph 3 above citing the judgment of the Court of Appeal in *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd.*⁴ The court said that it should be able to look at physical specimens embodying the registered design.

26. The proprietor disputes that it is appropriate to compare the registered designs based wholly or partly on the applicant's photograph of products embodying the designs at issue.

27. Only aspects of the registered designs that are apparent from the drawings and illustrations on the register can be taken into account. Looking at additional photographs is different to looking at physical specimens. The latter may assist the tribunal to better understand what it is seeing in the representations of the design(s) on the register. Additional photographs are less likely to do that without introducing

⁴ [2007] EWCA Civ 936

features that are not apparent from the register. Therefore, I will base my comparisons with the earlier registered designs on the representations of those designs on the register. Where I re-produce photographs from the applicant's evidence, I do so purely to make clear points of similarity or difference I have observed from what is on the register.

28. Comparisons with the applicant's prior disclosed V200 product, which embodies the shape and configuration of the '001 design, can take account of any visible feature of that design, such as the use of the colours silver and red.

The Earlier '002 Design

29. The applicant's '002 design clearly differs from the contested design in one important respect; namely, that it does not have a cylindrical housing or cylindrical 'handwheels'. These are features on which the applicant's case is partly based. I will therefore assess the matter based on the earlier '001 design. If the applicant succeeds on that design the '002 design is irrelevant. If it does not, it cannot succeed on the '002 design.

WAS THE CONTESTED DESIGN NEW?

30. A design is new if no identical design, or design differing only in immaterial details, has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,⁵ 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.”

31. I reject the proprietor's submissions that the differences arising from:

⁵ [2019] EWHC 3149 (IPEC)

- the suggested difference in the shape of the 'lips' on the 'handwheels';
 - the presence of black washers between the central housing and the 'handwheels' in the contested design;
 - the size of the end caps relative to the diameter of the 'handwheels';
 - a tapered section between the off pipe and the central housing;
- are sufficient to distinguish the products. In my view, these are trivial differences in appearance that are not likely to be noticed in use and do not affect the overall appearance of products embodying the designs.

32. However, I accept that:

- the different position of the 'lips' on the 'handwheels' when the taps are closed;
 - the different appearance and position of the temperature override controls;
 - the difference in the lengths of the central housings relative to the lengths of the 'handwheels';
- are sufficient, at least when taken together, to amount to material differences which affect the overall appearance of products embodying the designs. The registered design is, therefore, a new design compared to the prior art.

INDIVIDUAL CHARACTER?

33. 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 created by the prior art. As HHJ Birss (as he then was) pointed out in *Samsung Electronics (UK) Ltd v Apple Inc.*,⁶ "The scope of protection of a registered design clearly can include products which can be distinguished to some degree from the registration." The same applies to a comparison between the overall impression created by a registered design and that created by an earlier design.

⁶ [2012] EWHC 1882 (Pat)

34. In *Cantel Medical (UK) Limited v Arc Medical Design Limited*⁷ HHJ Hacon, sitting as a judge of the High Court, set out a six point approach for use in the assessment of whether a design has individual character. It is as follows:

“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 [prior art] 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.*

⁷ [2018] EWHC 345 (Pat)

- (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.”*

The sector to which the products belong

35. It appears to be common ground that the relevant sector is shower mixer taps for use in caravans and holiday/motor homes.

The informed user

36. The applicant submits that the informed user is a user of shower mixer taps in holiday homes, caravans and motor homes.

37. The proprietor submits that the informed user may be a designer of bathrooms for caravans etc. In support of this submission the applicant relies on the comments of Briss J (as he then was) in *Louver-Lite Ltd v Harris*⁸ where he stated:

“Generally it seems to me it is safe to start from the premise that a user of a product is likely to be a person who is involved in buying or selecting it as well as in operating it.”

38. In *PepsiCo v Grupo Promer Mon Graphic SA*,⁹ the CJEU held that an informed user:

“... is.. not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs

⁸ [2012] EWPC 53

⁹ Case C-281/10 P

normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them." (emphasis added)

39. The CJEU's judgment in *Pepsi v Grupo* appears to rule out the proprietor's argument that the informed user may be a designer. However, the court had in mind a designer of the product embodying the design (in this case shower mixer taps) rather than a designer of the product in which such products are installed (caravans etc.). The thrust of the court's judgment is that an informed user is not an expert in the product covered by the design. The point at issue in *Louver-Lite Ltd v Harris* arose because users of the products (window blinds) were said to pay a low degree of attention to the design and only to observe the products from a distance. It was in that context the judge held that informed users included the type of person who selected the product, in that case architects. It seems likely that mixer taps for caravans, holiday homes etc. are also likely to be selected by the designer of the caravans etc., at least as far as the taps fitted by the manufacturer are concerned. Therefore, I accept that such persons should be considered informed users of the products. However, I do not accept that designers of caravans etc. should be taken to be experts in designs for mixer taps. Rather, they should be attributed the characteristics of an informed user as set out in the quotation from *Pepsi v Grupo* in the previous paragraph.

40. Owners, of caravans, holiday homes etc. are likely to be involved in the selection of replacement shower mixer taps, as well as in the day-to-day use of such products. Accordingly, it is also necessary to include such people as informed users. Again, they must be attributed the characteristics of an informed user, as set out in *Pepsi v Grupo*. The distinction between the user of shower mixer taps and designer of caravans etc. should, therefore, make little practical difference, there being no argument in this case that one is better placed than the other to observe the differences between the products.

41. Informed users (of both kinds) pay a relatively high degree of attention to designs for shower mixer taps to ensure they will perform the intended function, will fit with the other bathroom fittings and the space available, and be acceptable from ergonomic and aesthetic perspectives.

42. An informed user of shower mixer taps is likely to have knowledge of designs used for shower mixer taps used in caravans, motor/holiday homes, and also those used in people's permanent homes, and in public buildings. This will include designs used for thermostatic shower mixer taps. Accordingly, such users will know about the design of the Bristan VSHXSPDIV for household use, which according to the proprietor's evidence looks like this:



43. I note that exhibit TH13 to Mr Huang's second statement, which consists of Bristan's 2011 Collection of products, includes at least two further designs, also for household use. These are:

Prism Thermostatic Bar Shower Valve



Carre Thermostatic Dual Control Shower Valve with Integral Diverter



44. The informed user will know of these designs too. However, the evidence falls short of establishing that thermostatic mixer taps with “*cylindrical central housing and two ‘handwheels’ on either side*” were “*commonplace*”, either at the time the earlier ‘001 design was created in 2013, or at the date of the registration of the contested design in 2019.

Design Freedom

45. In *Doceram*¹⁰ the CJEU clarified the meaning of the words “*designs which are solely dictated by technical function,*” as follows:

“.....in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.”

46. The court also clarified how this matter is to be assessed, as follows:

“36.it is for the national court..... to take account of all the objective circumstances relevant to each individual case.

37. As the Advocate General stated in essence, in points 66 and 67 of his Opinion, such an assessment must be made, in particular, having regard to the

¹⁰ Case C-395/16

design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.”

47. This means that the existence of alternative functional designs is not decisive. However, the existence of such designs may assist (together with other evidence) in answering the question of whether a design feature is solely dictated by function (and therefore to be ignored in any comparison with other designs) or determined only partly by functional requirements or constraints (and therefore to be given some, albeit reduced, weight in any such comparison).

48. In his first statement Mr Huang states that:

“We agree that aesthetic considerations are important in shower design, and we exercised design freedom within technical constraints. The VM37 [i.e. a product embodying the contested design] creates a modern and sleek aesthetic impression...”

49. The proprietor’s case does not, therefore, appear to be that there is little or no design freedom for thermostatic shower mixer valves. Rather, the proprietor seems to contend that the similarities between the designs at issue are a result of technical constraints.

50. As to what constitutes a constraint on design freedom, I note that in *Dyson Ltd v Vax Ltd*¹¹ Arnold J (as he was then) stated that:

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

¹¹ [2010] FSR 39

The shape of the central housing

51. The proprietor contends that the cylindrical shape of the central housing is a consequence of the need for thermostatic shower mixer taps to include a thermostatic bar valve, which are usually cylindrical in section, along with the need to keep the tap as small as possible so as to fit into small spaces.

52. In this connection, I note that the applicant's '002 design is not cylindrical in section. I also note that exhibit TH13 to Mr Huang's second statement includes examples of thermostatic shower mixer taps with square and oval housings. Admittedly, these taps do not appear to be designed specifically for caravans and/or motor/holiday homes. However, the proprietor cannot rely on this document to try to show that cylindrical housings with two handwheels are 'commonplace', whilst simultaneously denying the relevance of other designs showing thermostatic shower mixer taps with non-cylindrical housings.¹² That would make even less sense in circumstances where the proprietor claims the contested design arose out of customer feedback on its pre-existing vertical caravan mixer taps, which it is said showed a desire for a horizontal mixer tap design similar to those used in households.

53. Exhibit TH9 to Mr Huang's second statement provides the results of an image search on Google for 'caravan thermostatic shower mixer'. The search was done in February 2023, which is years after the registration of the contested design. Consequently, it sheds no real light on the commonness of such designs at the relevant date. However, it is helpful in showing designs that are deemed suitable for caravans. About 30 designs are shown, including the applicant's products. The results break down into designs for vertical and horizontal installations. It is fair to say that most of the horizontal designs are round or oval in cross section, at least when seen from the front, such as the one shown below:

¹² Annex 9 to the written submissions filed with Mr Sampson's first statement includes similar material, albeit from after the relevant date.



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caravanspares-direct.co.uk

54. Annexes 6 and 9 to the written submissions filed with Mr Sampson's first statement contains similar material (again from after the relevant date) albeit with a wider range of designs for caravan shower mixer taps.

55. I do not accept that a cylindrical shape is necessary for thermostatic shower mixer taps to accommodate the thermostatic cartridge. The evidence clearly shows that other shapes can be used for the same purpose. Nor do I accept that a cylindrical shape is necessary for thermostatic shower mixer taps specifically for caravans and other holiday homes in order to save space. In the absence of expert evidence, I find it hard to accept that a housing with a rounded front (compared to – say - a square or oval one) makes a substantial difference to the space available to the user of the shower. However, I accept the evidence that thermostatic cartridges tend to be round, and that a housing that broadly follows that shape is liable to be an efficient design because it uses less metal than other alternative shapes. Therefore, although it is a design choice, I accept that there is a technical advantage in using a cylindrical housing.

56. In fact, the central housing shown in the contested design is not truly cylindrical. As the illustrations on the register show, the top and bottom of the central housing has two flat surfaces and the rear of the central housing is also flat. The top and bottom of the housing taper in slightly before they meet the vertical back of the housing. Only the front of the housing is rounded. Therefore, there is at least limited design freedom

when it comes to the shape and configuration of the top and bottom of the central housing.

'Wheels' which are contiguous with the cylindrical central housing

57. The proprietor points out that thermostatic taps operate using two handles – one which controls water flow, and one which controls temperature. According to the proprietor, integrating the handles at the ends of the cylindrical housing minimises the space taken up by such handles and avoids the need for additional componentry to connect them. I accept this. However, I am not persuaded that *“providing such handles as ‘wheels’ which are generally contiguous with the cylindrical central housing further minimises the size of the product.”* I see no reason why using round contiguous ‘wheels’ makes the taps smaller than using other forms of handle, such as crosshead handles or lever designs.

58. Further, even within the choice of *“‘wheels’ which are generally contiguous with the cylindrical central housing”*, there is design freedom. For example, exhibit DJS6 to Mr Sampson’s second statement includes pictures of thermostatic mixer taps for caravans.¹³ These are again from after the relevant date, but they illustrate than such handles can be designed with cut-out grooves to aid grip (instead of ‘lips’) and/or with curved (as opposed to straight, cut-off) ends.



¹³ The one above was marketed by Abyss Caravan Supplies and carries the brand A & G Caravans Ltd. The one below was marketed by The Caravan Warehouse.



59. Therefore, although I accept that the type of, and design for, handles for thermostatic shower mixer taps for caravans is limited by certain technical constraints, I find the designer retains significant freedom of design.

The wall mounts

60. According to the proprietor, it is most efficient for the wall mounts to have a circular cross-section to match the shape of the water pipes, and this also avoids water leaks and minimises the material required. Further, the size constraints on a shower for small spaces limits how the wall mounts can be positioned.

61. I accept that it is most efficient for the wall mounts to have a circular shape so as to match the shape of the water pipes inside. The positioning of the part of the wall mounting that is visible in normal use of the shower i.e. the water pipe cover plate that sits against the shower wall - is clearly determined by the positioning of the water pipes relative to the central housing. The minimum diameter of the cover plate is determined by the need for the mounting to absorb the force created when the nut behind the shower wall is tightened, and thus to hold the water pipe firmly in place without stressing the pipe itself. Beyond these things the designer is free to decide on the size of the water pipe cover plate relative to the rest of the tap, whether the cover is flat like a coin or flared so as to be wider at the back than at the front, as well as the way it is designed to join the rear of the central housing.

The position of the off-pipe

62. The proprietor submits that the central housing of the contested design is technically constrained so as to be as small as possible, and the thermostatic cartridge

occupies nearly half of the length of the shower bar. According to the proprietor, this precludes placing the off pipe in a central position, and so the off pipe is necessarily located off-centre.

63. The applicant disputes these submissions, pointing to several similar shower bars with centrally positioned off-pipes.

64. I accept that the length of the central housing when combined with the need for it to accommodate a thermostatic cartridge are technical constraints which severely limit the possible positions for the off pipe. However, I am not satisfied that the length of the central housing is determined by technical constraints. In this connection, I note that central housings for the caravan thermostatic mixer taps shown at paragraphs 53 and 58 above are wider than those in the designs at issue, allowing a centrally positioned off pipe. Accordingly, I do not accept the positioning of the off pipe is entirely outside the control of the designer.

The presence, shape and position of the 'lips' on the 'handwheels'


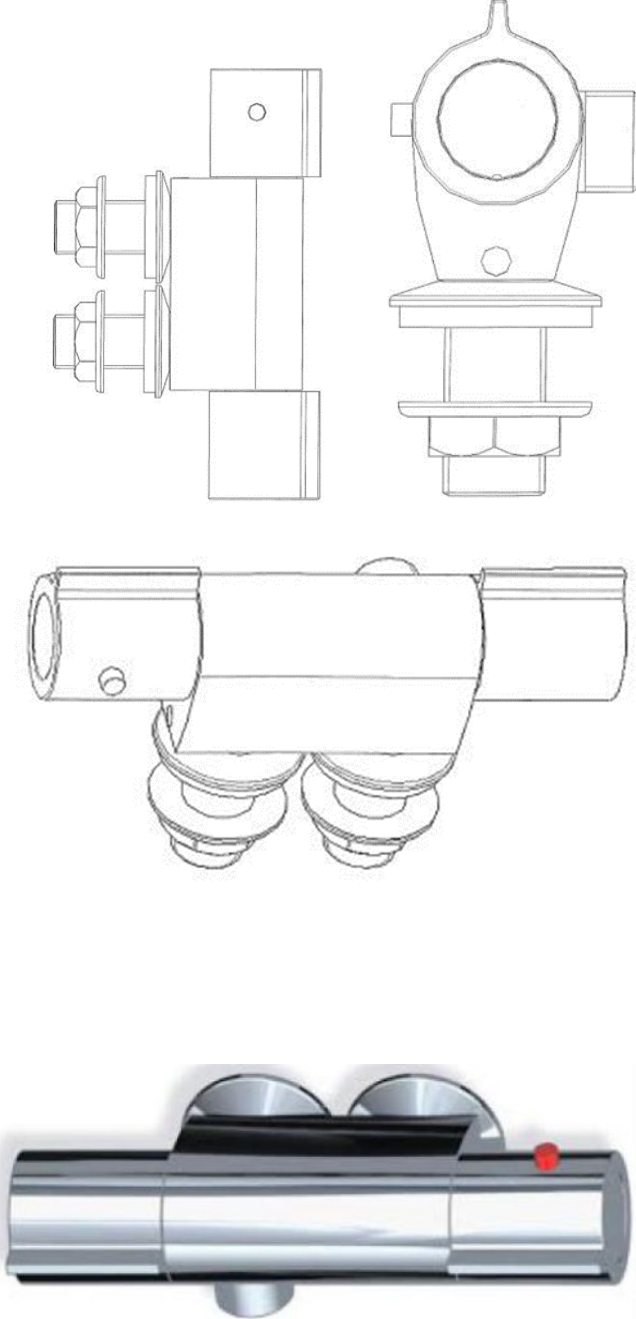
65. The proprietor claims that it is a functional requirement to provide a lip on the 'handwheels' so that the handles can be gripped and turned. I do not accept this. The evidence shows that other designs, e.g. grooves, raised knob, can achieve the same function, even within the option of using 'wheels' as handles. The use of lips is therefore partly a design choice driven by the desired appearance of the product. However, I accept that 'lips' also serve a functional purpose, and that there is limited design freedom in this respect. Having chosen to use 'lips', the designer is free to decide on length, height and position of the 'lips' on the 'handwheels'.

The presence, appearance and position of a 'protruding button' on the 'handwheels'

66. The proprietor contends that the presence of a device configured to control water temperature is a technical constraint enforced by statutory requirements. I accept the protruding buttons shown in the designs at issue serve a functional purpose. However, there is design freedom when it comes to the appearance and position of the device.

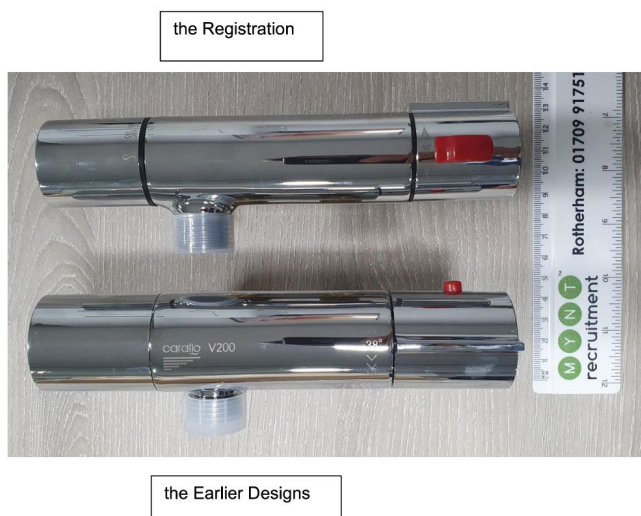
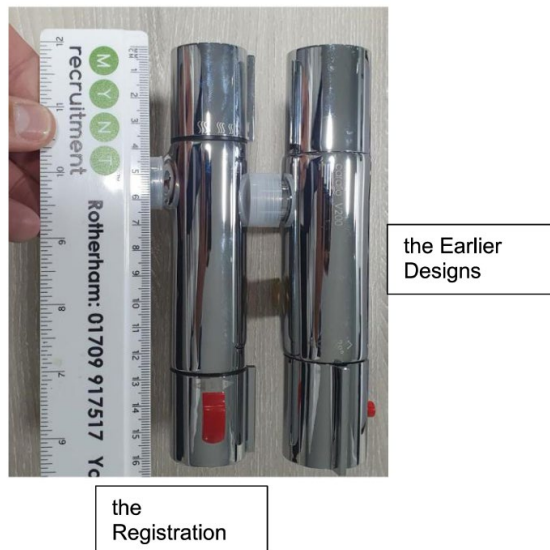
Comparison of the designs

67. For convenience, I show below illustrations of the contested design alongside the earlier '001 design:

The Registered Design	The Prior Art
	

68. The proprietor points out that the length of the central housing in the contested design has an aspect ratio of 2.5:1 compared to that of the 'handwheels', whereas the comparable aspect ratio in the earlier '001 design is about 2:1. According to the proprietor, this gives products embodying the contested design a more streamlined shape.

69. The difference in the relative lengths of the central housings and the handwheels can be seen clearly from the pictures below (taken from the applicant's statement of case):



70. I have already acknowledged that a greater aspect ratio of central housing to handwheels (compared to the earlier '001 design) makes some difference to the appearance of the products. However, the use of shorter contiguous handwheels tends to diminish the impact of a relatively longer central housing compared to the '001 design. This is because the net result is a shower bar which is almost identical in overall length (relative to the height and depth of the shower mixer) compared to the prior art.

71. I also note that, like the earlier design, the flat sections at the top and bottom of the central housing of the contested design taper inwards to the point where they meet the vertical back of the housing. The designs for the central housings and handwheels are, therefore, very similar. Admittedly, the informed user is likely to attach more importance to the appearance of the front and top of the shower mixer than the back and bottom of it. This is because the latter are not visible, or less visible, when the shower is installed and in normal use. Even so, I do not accept the different aspect ratios of the length of the central housings to the length of the cylindrical handles gives the contested design a noticeably more streamlined overall appearance than the prior art, or that it has a substantial impact on the overall impression created by the contested design.

72. The proprietor submits that the "*more streamlined*" shape of the central housing of the contested design allows a small gap to be provided between the wall mounts. In contrast, the wall mounts of the earlier designs appear to be almost touching. I accept this. However, in my view, the resulting difference in overall appearance is trivial and liable to go unnoticed, even by an informed user.

73. The wall pipe cover plates in the contested design appear to be the same size as in the '001 design relative to the rest of the tap. However, the shape of the wall pipe cover plates differs. The ones in the '001 design have a coin-like or disc shape. By contrast, the ones in the contested design flare outwards from front to back. This makes some difference to the appearance of products embodying the designs when they are in normal use. However, most of the wall pipe covers are obscured by the central housing: only the top, bottom and one side of the plates are visible.

Consequently, the difference in this aspect of the designs makes only a small contribution to the overall impression created by the designs on an informed user.

74. The proprietor also points to a tapered section between the off pipe and the main housing in the contested design as a design feature which is not present in the earlier design. I have had trouble seeing this tapered section from the representations on the register. In any event, given that the join between the top of off pipe and the bottom of the central housing will be difficult to see when the shower is in normal use, the difference (if it exists) is trivial.

75. I have already accepted the position of the lips of the contested design on the top of the handles (extending directly upwards when the taps are in the 'off' position), compared to the position of the lips of the earlier designs (at the front of the housing and extending forwards when in the 'off' position) makes some difference to the overall appearance of the products. The difference will, of course, be most apparent when the mixer taps are not in use. Once they are in use the position of the lips naturally moves as the controls are used. In both designs, the 'lips' cover the full length of the 'wheels', are similar in height relative to the diameter of the wheels, and are rectangular in cross section. On close examination, the 'lips' in the contested design appear to taper downwards slightly in height as they extend towards the ends of the handles. However, this difference is not immediately obvious (particularly from the illustrations of the contested design on the register) and, in my view, has negligible impact on the overall impression created by the designs.

76. The most immediately noticeable difference between the designs is, in my view, the appearance of the temperature control override. The contested design has a raised, red-coloured slider on the front of the right hand wheel (when the taps are in the off position). The prior art has a cylindrical, raised button located on the top of the same wheel (again, when the taps are in the off position). This is also red in the product marketed under the '001 design (although not in the registered design). The use of a button or slider are simply different functional solutions. The informed user will, therefore, attach less weight to the difference in the type of control used in the designs compared to a difference with more design input. The effect of the difference

in the position of the control makes more difference, although it will be less noticeable once the handle is turned when the shower is in use.

The outcome of the comparison

77. Taking all of the above into account, I find that the (relevant) similarities between the designs outweigh the (relevant) differences to the extent that the contested design creates the same overall impression on the informed user as the '001 design and the prior art embodying that design.

78. The applicant provided evidence that the proprietor's product was promoted as an alternative to the applicant's V200 product (i.e. the '001 design). Annex 7 to the written submissions accompanying Mr Sampson's first statement includes a copy of a page from the website of Caravan Warehouse. The proprietor's product was promoted as a "*V200 Alternative Horizontal Shower Valve 45cm Centres.*" The accompanying text described the product as an "*Ideal v200 replacement shower valve*" and stated that "*This is the same fitting as the original V200 model shower valve and no modifications needed.*"

79. The proprietor denies promoting its product as a replacement for the applicant's product, pointing out it has no control over the way its distributors market the product. The proprietor also complains the applicant is attempting to gain an unjustified monopoly in the technical field of minimally sized thermostatic shower taps for the caravan and holiday home market.

80. I remind myself that:

- (1) The applicant claims the V200 product is a market leader in the caravan/holiday home market for shower mixer taps;
- (2) The proprietor has not specifically denied this claim, and the evidence from the Caravan Warehouse website tends to support the claim that the V200 product is a well-established product in that market;

- (3) The proprietor has expressly denied knowing about or copying the V200 in its counterstatement and in subsequent written submissions, but has not expressly done so in any of Mr Huang's three witness statements;
- (4) On the other hand, Mr Huang has put forward an alternative explanation for some of the similarities between the designs at issue, i.e. that the contested design was derived from an earlier vertical shower mixer tap with which it shares some dimensions;
- (5) The applicant has not sought to cross examine Mr Huang on his evidence.

81. I accept that the evidence raises a question as to whether the contested design was created with the prior art in mind. However, I am not prepared to find that the proprietor copied the '001 design and/or the prior art embodying that design. Consequently, I have not drawn any negative inferences as to whether the contested design resembles the prior art because it was intended to do so.

82. As to the labelling of products made to the contested design as an 'alternative' to the applicant's V200 product, I accept that (1) the proprietor is not responsible for the advertisement in question, and (2) it may indicate no more than that the proprietor's product has the same fitting requirements as the V200. The latter indicates nothing more than fair competition. I accept that the distributor's advertisement could also be taken to indicate that it viewed the proprietor's product as a like-for-like replacement for the V200 product. That would be more supportive of design infringement. However, I do not consider the evidence is clear enough to reach a concluded view one way or the other. I have therefore attached no weight to it.

83. As to the proprietor's complaint that a finding in favour of the applicant could give it an unjustified monopoly in the field of minimally sized thermostatic shower taps for the caravan and holiday home market, I do not accept it. I am satisfied that there is ample design freedom to produce competitive designs which do not produce the same overall impression as the '001 design and the related prior art, even within the market for 'minimally sized' shower mixer valves for caravans etc.

Overall outcome

84. I accept the applicant's case that registration of the contested design was contrary to section 1B of the Act. The contested design is invalid and will be cancelled with effect from 1st October 2019.

Costs

85. The applicant is entitled to a contribution towards its costs. I assess this as follows:

Official fees for filing Form DF19A: £48

Preparing DF19A and considering counterstatement: £300

Preparing evidence: £1500

Written submissions: £352

Total: £2200

86. I therefore order Alfred Victoria Limited to pay Carafax Limited the sum of £2200. This sum must 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 or does not proceed.

Dated this 27th day of March 2024

Allan James

For the Registrar