

O/0386/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6248940

OWNED BY FRADUR S.A.

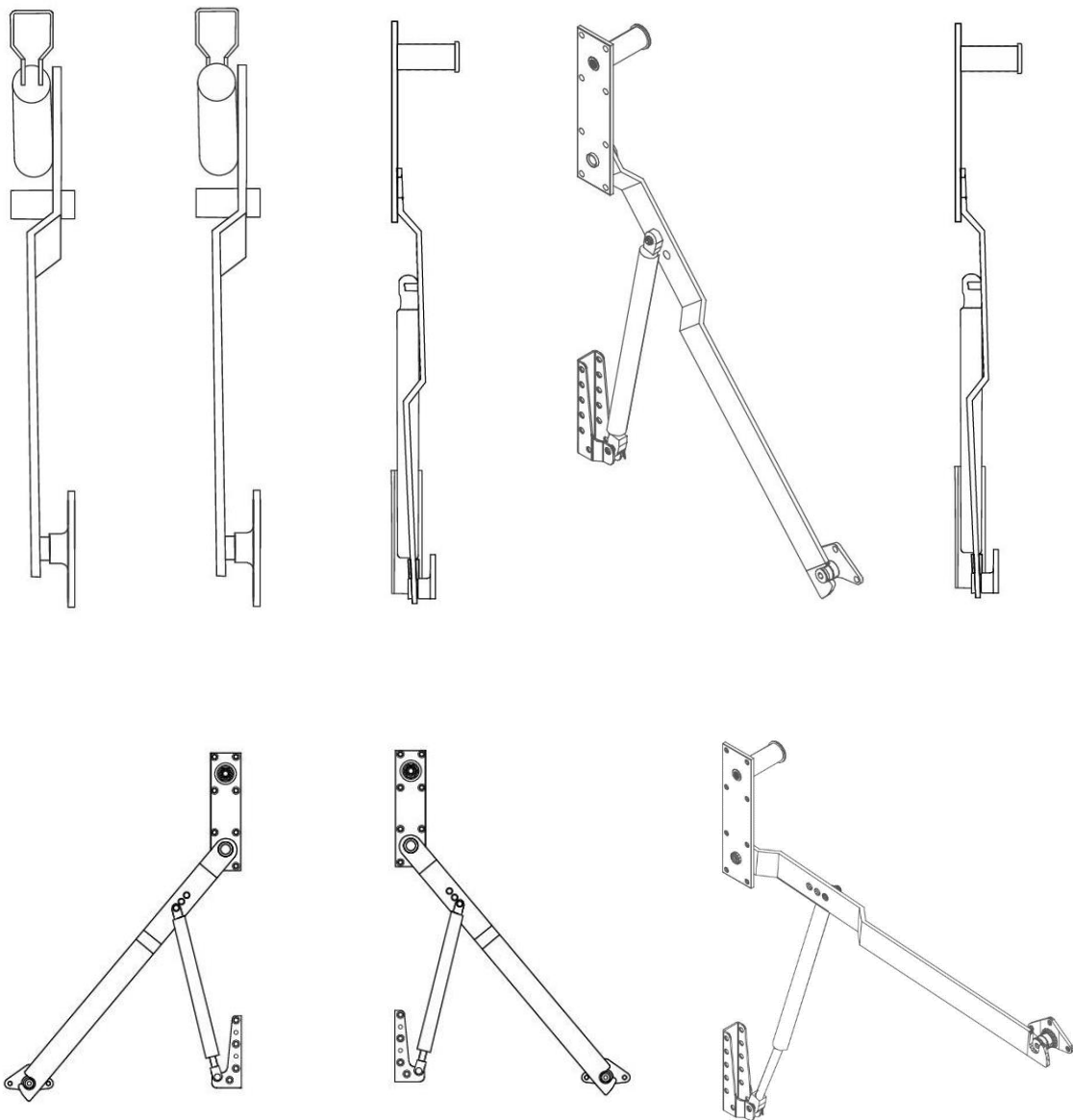
AND

APPLICATION NO. 137/23

BY THE STUDY BED COMPANY LIMITED

BACKGROUND AND PLEADINGS

1. The design which is the subject of the dispute was filed by Fradur S.A. (“the proprietor”) on 9 December 2022. A priority date is claimed of 13 June 2022. The contested design is for an “articulated parallelogram mechanism for furniture movement” and is depicted in the following representations:



2. On 28 June 2023, The Study Bed Company Limited (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that the same

design has been made available to the public prior to the relevant date, as it has itself purchased the same product. I will return to this in more detail below.

3. 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...”

4. 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.

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

6. The proprietor is represented by Valet Patent Services Limited and the applicant is represented by London IP Limited. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

7. The applicant filed evidence in the form of the witness statement of Denton Berry dated 27 October 2023, which is accompanied by 1 exhibit. Mr Berry is the sole director and principal shareholder of the applicant.

8. The applicant’s evidence was accompanied by written submissions dated 6 November 2023.

9. The proprietor filed written submissions dated 18 December 2023.

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

DECISION

11. Section 1B of the Act 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.

...”

12. The relevant date is the priority date for the contested design i.e. 13 June 2022.

The Prior Art

13. In order to be considered prior art, the design relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6).

14. The design relied upon by the applicant is set out in the evidence of Mr Berry, as shown at paragraph **18** below.

15. Mr Berry gives evidence that his company sells a piece of furniture which converts between a desk and a bed. He states that he has been purchasing this item for onward sale since 2006 and has been selling it in the UK since 2007. He states that he originally purchased these goods from the proprietor (or connected companies), although nothing turns on this. Mr Berry gives evidence that the best-selling models of that bed use a hinge which has been available in the UK and Europe since at least 2014. He states that the furniture is not purchased in its finished form, but rather he places orders for the individual component parts (including the relevant product) depending on their particular requirements.

16. Mr Berry's evidence is not challenged by the proprietor. Consequently, I accept the date on which he states that the design relied upon was disclosed and I will treat it as prior art. There is some suggestion that it was the proprietor itself that disclosed the design. However, given the length of time between the disclosure date relied upon by Mr Berry and the relevant date, there can be no suggestion that it is an excluded disclosure.

Novelty

17. 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:

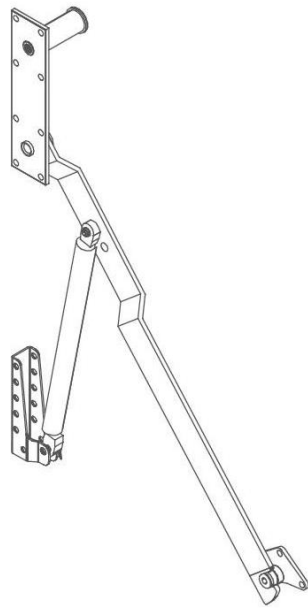
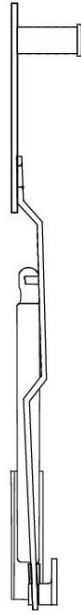
“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some

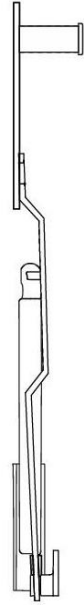
material respect, even if some or all of the design features, if considered individually, would not be.”¹

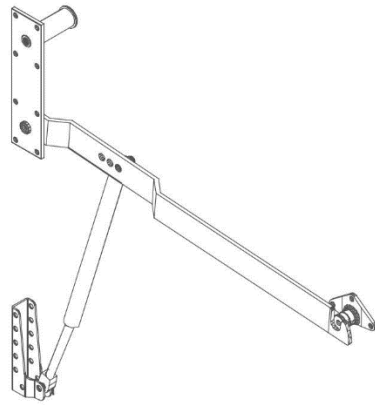
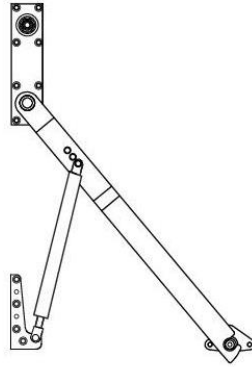
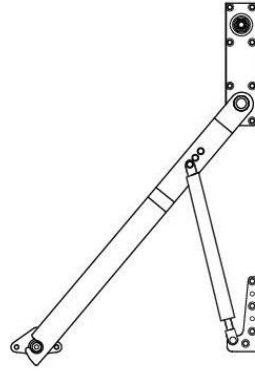
18. The designs to be compared are as follows:

The Prior Art	The Contested Design
	

¹ Paragraph 26.









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

- a. Both designs are made up of one flat strip of metal which has an indentation at one end.
- b. In the middle of the indentation is a cylindrical arm which is fixed to, and protrudes from, the metal strip at one end, can be moved into different positions.
- c. At the other end of the arm in each design is a bracket which is thinner at one end than the other.
- d. The bracket in each design has six holes in it, with the one at the thicker end being offset to the righthand side.
- e. The bracket in each design appears to be attached to the arm by what appears to be a circular headed screw.
- f. The arm itself is made up of two sections, one of which has a wider diameter than the other.

- g. At one end of the flat strip is a triangular piece of metal (with curved edges) which is attached to the flat strip by what appears to be a relatively large bolt at its centre.
- h. The triangular piece of metal has three holes in it, one at each corner.
- i. At the end of the flat strip which has the indentation (and to which the arm is attached) there is another (shorter) flat strip of metal which is attached to the longer strip by what appears to be a large circular screw.
- j. The shorter strip has eight holes in it (four on each side) spread roughly evenly along the length of each side, although with a slightly longer gap between the two middle holes.
- k. At the opposite end of the shorter strip is a cylindrical piece of metal, attached by what appears to be a large circular bolt.

20. However, they differ in the following ways:

- a. The arm in the contested design appears to be adjustable, as one section appears longer in some images than others. However, it is not clear from the prior art whether the arm in that design is adjustable or not.
- b. The arm appears longer in the prior art because each section appears roughly the same length, whereas in the contested design the wider section is longer. However, it is not clear whether this is due to the adjustability of the length of the arm.
- c. The point of the flat strip which connects with the arm in the contested design appears to have three holes in it. Plainly, there is at least one hole in the prior art to which the arm is connected. However, it is not clear whether there is just one or more from the images that have been provided.

21. For the avoidance of doubt, I have borne in mind that the second image of the prior art appears to show the arm protruding at more of an angle from the main flat strip in the prior art than it does in the contested design. However, when examining the fifth image shown above (as well as others) this angle does not appear to be present. Consequently, I do not consider that this actually constitutes a point of difference between the two designs.

22. I accept that there are some differences between the designs (although this may simply be due to the lack of visibility in the images of the prior art). However, the burden is on the applicant to show that any differences between the designs are immaterial. The adjustability (or lack of) of the length of the arm is something that it would have been relatively easy for the applicant to demonstrate in evidence, if it was in fact a feature of the prior art. It has not done so. In my view, this is not an immaterial difference and I do not consider that the contested design lacks novelty. I will now go on to consider whether the contested design has individual character when compared with the prior art.

Individual character

23. A design may be “new”, but still lack the necessary “individual character” compared to the prior art. This depends on whether the overall impression it produces on the informed user differs from the overall impression produced on such a user by the prior art.

24. 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."

25. 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.”²

The Informed User

26. 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:

² Paragraph 58.

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).”

27. The contested design is for a mechanism used as part of a piece of furniture. The informed user is, therefore, most likely to be involved in the business of manufacturing furniture, although I recognise that it may also include some members of the general public who are engaging in DIY. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

28. No evidence has been filed regarding the type, range or variety of furniture mechanisms of this type that were available at the relevant date.

Design Freedom

29. 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).”

30. The designer of a furniture mechanism of this kind will, to a large extent, be constrained by the function of the product and the specific movement that the mechanisms needs to facilitate. However, there will be some variation as to the specific construction of the mechanisms, the shape of the various parts used and the way in which they attach to the parts of the furniture that they are intended to move. I bear in mind that any adjustability of the design enable the mechanisms to fit to whatever part(s) of the furniture the user wants to be moveable. This is a solely functional aspect of the design, which I must attribute no weight in the assessment of the overall impression.³

Findings

31. In my view, the designs share the same overall impression. The prior art shares the same attachment mechanisms at each point, with the same number of holes (presumably intended for screws) in the same positions. The appearance of the individual limbs of the mechanism are very similar, as is the shape of the bracket. I do not consider the differences between them, such that they are, to be sufficient to create

³ *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat).

a different overall impression. Consequently, the contested design does not have individual character.

CONCLUSION

32. Registered design no. 6248940 is declared invalid under section 11ZA(1)(b) of the Act.

COSTS

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

Preparing a Notice of invalidation and considering the counterstatement	£300
Preparing evidence and considering the proprietor's submissions	£650
Official fee	£48
Total	£998

34. I therefore order Fradur S.A. to pay The Study Bed Company Limited the sum of **£998**. 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 29th day of April 2024

S WILSON

For the Registrar