

O/0547/24

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6132680

**IN THE NAME OF LANXI YICHAO ELECTRONIC BUSINESS
COMPANY LIMITED**

IN RESPECT OF THE FOLLOWING DESIGN



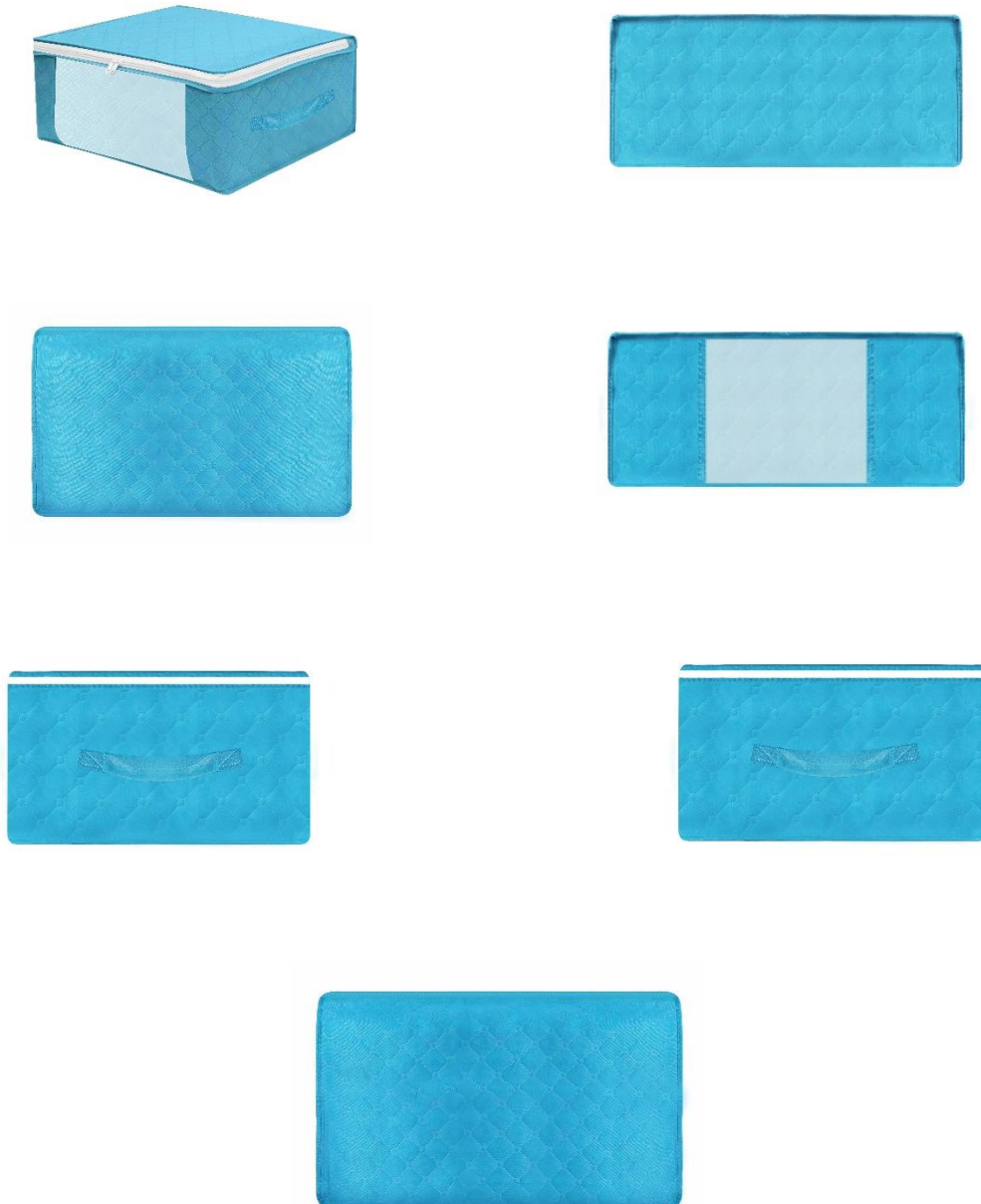
AND

AN APPLICATION FOR INVALIDATION (NO 83/21)

BY LIMAR TRADING LIMITED

Background and pleadings

1. Lanxi Yichao Electronic Business Company Limited (“the registered proprietor”) filed application no. 6132680 for a registered design for a clothes storage bag on 23 April 2021. It was registered with effect from that date and is depicted in the following representations:



2. The following disclaimers were entered on the register: *No claim is made for the colour shown; no claim is made for the material shown.*

3. On 22 September 2021, Limar Trading 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 the design lacks novelty and individual character. The applicant claims that it had been available in the UK on the Amazon website in October 2018. The image shown in the application is reproduced below:



4. At this point, I note that the applicant has provided the ASIN number for the product on Amazon as well as the above image. I consider that the white arrows shown on the bags are not part of the product and merely indicate that the viewer could move between this image and others.

5. The registered proprietor filed a counterstatement to the application for invalidation on 11 August 2022, denying the applicant’s claims and arguing that the designs are “*totally different*”.

6. The applicant filed evidence in the form of a witness statement from Andrew Marsden, a Chartered Trade Mark Attorney, with Wilson Gunn LLP, the applicant’s legal representatives. It is dated 27 February 2023 and is a vehicle for exhibiting the details of the product claimed to be prior art. At the same time, the applicant also filed brief written submissions.

7. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Wilson Gunn and the registered proprietor is a litigant in person.

DECISION

8. 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”.

9. Section 1B of the Act is 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) 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 conditions 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 period of 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.

...”

The Contested Design

10. I shall begin by making some remarks on the contested design. The registered proprietor claims in its counterstatement that the designs are totally different and invited me to look at the pictures. The representations of the registered design are photographs of the product. Generally, where the representations of the design are photographs, the design claimed consists of all those features that can be seen in the photographs. These include the lines, contours, colours, shape, texture and materials of the product. The contested design is, as I have noted above, subject to a disclaimer.

This means that I must disregard the colour and the material when making any comparisons. The fact that the representations shown a different blue from the Amazon images is not relevant. However, I consider that it is appropriate to take account of the vertical lines seen in the first representation and the diamond pattern on the surface of the product.

Prior Art

11. The amazon.co.uk listing for the product relied on by the applicant indicates that it was first available on 10 October 2018. This date is earlier than the date on which the registered proprietor filed its application to register the contested design and I consider that listing on the Amazon website constitutes publication. The clothes storage bag relied on by the applicant is therefore acceptable prior art. It is shown most clearly in the images reproduced in the table in paragraph 13 below. The white arrows that are shown on the image contained in the application for invalidation are not present.

Novelty

12. 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

Comparison of the designs

13. In the table below I show the registered designs alongside the prior art upon which the applicant may rely:

¹ Paragraph 26.

The Registered Design

The Prior Art



The Registered Design	The Prior Art
 <p>The registered design is shown in three views: a top view, a side view, and a front view. The pouch is blue with a repeating diamond quilted pattern. A zipper is visible on the top edge in the top and side views.</p>	 <p>The prior art shows a close-up of a zipper on a dark blue fabric. A circular inset provides a magnified view of the zipper teeth and pull tabs. The word "Zipper" is written in white text on the fabric.</p>

14. The registered design consists of the following features:

- a. A box shape, with a rectangular base;
- b. The shorter sides are less than half the length of the longer sides;
- c. The corners of the base are rounded;
- d. The height of the box is roughly half the length of the longer sides;
- e. The surface of the product is covered with a repeating diamond pattern. I have magnified one of the representations so this pattern can be seen more clearly. It consists of small diamonds surrounded by four larger diamonds, which themselves make up a larger diamond. This pattern is not, in my view, dependent on the material (which I acknowledge is disclaimed);



- f. On each of the short sides of the box is a slightly curving handle. They appear to be attached to the box by diagonal stitching across rectangular patches;
 - g. The front of the box is divided into three sections by vertical lines. The middle section takes up over half the length of the front;
 - h. There is a further representation (the 4th image) showing a panel which is narrower in width than the panel shown on the front of the box. There appears to be heavy stitching on the inner sides of the outer panels. It is not clear what part of this box is shown by this representation, although given that the edges of the section appear to protrude, it may be the interior of the box;
 - i. The top of the box is separated from the rest of the product by a zip on three sides. The zip has two sliders;
 - j. The main representation appears to show a lip of material in which the zip is set. However, on the images of the sides of the box, the zip appears more flush to those sides, with stitching beneath it; and
 - k. The side images indicate that there is a gentle curve from the zip to the top of the box.
15. The prior art consists of the following features:
- a. A box shape, with a rectangular base;

- b. The shorter sides are less than half the length of the longer sides;
- c. The second image suggests that the corners are not rounded;
- d. The height of the box is roughly half the length of the longer sides;
- e. The surfaces of the product are undecorated;
- f. On each of the short sides of the box is a straight handle. They appear to be attached to the box by stitching in the shape of a letter X on square patches;
- g. None of the visible sides is divided into sections and there are no contrasting parts;
- h. The top of the box is separated from the rest of the product by a zip on three sides. The zip has two sliders;
- i. The zip is flush with the sides of the box; and
- j. The third image appears to show a slight curve above the zip to the top of the box.

16. The division of the front of the registered design and the patterned surface are, in my view, more than minor and trivial differences. It affects the overall appearance of the product and would be noticed by the user. Consequently, I find that the registered design has novelty when compared with the prior art.

Individual Character

17. A design may be “new”, but still lack the necessary “individual character” compared to the prior art. This depends on whether the overall impression is produced on the informed user differs from the overall impression produced on such a user by the prior art. As HHJ Birss QC (as he then was) pointed out in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), “*The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration.*” The same applies to a comparison of the overall impression created by a registered design compared to the prior art.

18. 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.”

The sector concerned and the informed user

19. The sector concerned is storage, namely storage of clothes. The informed user is not a designer, technical expert or person in the trade, but an individual who wants to store clothes. They are particularly observant, show a relatively high degree of attention when using the products and are aware of the range of designs available for these products and the features that are normally included in them. Importantly, they conduct a direct comparison of the designs unless there are specific circumstances that mean this is not possible or practical: see *Samsung Electronics*, paragraph 34.


The design corpus and the freedom of the designer

20. The Amazon listing filed by the applicant contains small images of alternative products that are related to the item in question. I have reproduced these below:

Products related to this item

Sponsored

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	<p>90L Underbed Storage Bags with Zips, Large Clothes Storage Bags with Strengthened H... 421</p>	<p>Budding Joy 2 Pack 90L Storage Bags, Large clothes storage bags with Zips Durable H... 26,767</p>	<p>75L Clothes Storage Bags with Zips, 2 PCS Oxford Cloth Duvet Storage Bag King Size, ... 764</p>	<p>Extra Large Thicker Durable Waterproof Organizer Storage Bags with Backpack Straps, ... 657</p>	<p>Smavles Oxf Bag 3 Pieces Bags Storage Double Zip E</p>
	<p>£15.99</p>	<p>£9.99</p>	<p>£13.99 (€7.00/count)</p>	<p>£11.99</p>	<p>£12.99 (€</p>



90L Underbed Storage Bags, Large Clothes Storage Bags With Zips, Thick Foldable Bre...
1,815

£16.99



VENO 8 Pack Heavy-Duty Oversize Large Storage Bag Organizer with Zips and Tag...
11,985

£41.99



Naturedeho 90L [3 Pack] Large Clothes Storage Bag Organizer with Reinforced Handle ...
77

£13.99 (€4.66/count)



2PCS 100% Natural Cotton Canvas, 12OZ Thick Soft Breathable Storage Bag Closet...
300

£20.99 (€10.50/Count)



3 Pack 180L Under Bed S With Zips, Tl Oxford Wate

£27.97 (€)



Lifewit Large Capacity Clothes Storage Bag Organizer with Reinforced Handle Thi...
21,696

#1 Best Seller in Under-Bed Storage

£15.99 (€3.20/count)
Get it as soon as Thursday, Mar 2



Laundry Bags Strong Heavy Duty Storage Bags Best for Moving House Shopping and Laundry Reusable Zip...
6,118

£11.99

Get it as soon as Thursday, Mar 2



Spacesaver Premium Vacuum Storage Bags with 80% More Storage, Includes Hand-Pump for Travel, Triple Seal Turb...
128,281

£21.99 (€1.47/count)

Get it as soon as Friday, Mar 3
FREE Delivery on orders dispatched by Amazon over £20



90L Large Clothes Storage Bags with Zips Duvet Storage Bag King Size Thick Breathable Fabric Underbed Stora...
617

£16.99 (€5.66/count)

Get it as soon as Thursday, Mar 2



Dream elf Small Foldable Storage Bag with Zipper, Large Clear Window and Carry Handles, Great for...
198

£12.89

Get it as soon as Thursday, Mar 2

21. It is not clear when these products were first made available. However, I note that in *Dyson Limited v Vax Limited* [2010] EWHC 1923 (Pat), Arnold J (as he then was) said:

“37. Counsel for Dyson also submitted, and I accept, that evidence of design freedom could also come from designs produced after the date of the registered design. If a wide variety of designs was produced after the registered design, that is evidence that the designer of the registered design had not been constrained to design the product in the way that he had.”

22. The images show box-type containers, with handles on the same sides as in the registered design and the prior art, some of which have transparent panels so that the user can see what has been stored within the bag. All the storage bags of this type

appear to have the zip at the top, in the same place as in the registered design and the prior art. Their dimensions vary. There are other bags with a long, narrow base, relatively high sides, with handles towards the tops of the longer sides and the zip on the top. Finally, vacuum storage bags are also available for the same purpose. These have no handles and are rectangular with a round opening to which a pump can be attached in order to create the vacuum.

23. What I take from these examples is that the designer had the freedom to decide the dimensions and shape of the bag, although I notice that in all but the vacuum bags the bags all have four sides. The placing of the handles appears to follow this choice, although there is some freedom as to their precise dimensions and style. Similarly, the position of the zip appears to follow the initial choice on the shape of the bag. The designer also has the choice of whether or not to include a transparent panel and whether or not the bag should be decorated with a pattern.

Overall impression

24. I have already listed the features of the designs in paragraphs 14 and 15 above. Stepping back to consider the overall impression that each of these designs has on the informed user, I find that the differences in the surface decoration of each design are such that the registered design has individual character over the prior art. As the informed user is deemed to be showing a relatively high degree of attention, the designs will, in my view, create different overall impressions on that informed user.

CONCLUSION

25. The application for invalidation against Registered Design No. 6132680 has failed and it will remain registered.

COSTS

26. The registered proprietor has been successful and would in the circumstances be entitled to a contribution towards the costs of the proceedings. As the registered proprietor is unrepresented, it was invited to complete a proforma with details of the time spent on particular activities associated with the proceedings. It was informed that if the proforma were not completed and returned, costs, other than official fees

arising from the action, may not be awarded. As no proforma was received, and the registered proprietor incurred no official fees, I make no award of costs.

Dated this 13th day of June 2024

**Clare Boucher
For the Registrar,
The Comptroller-General**