

O/0662/24

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6063553

IN THE NAME OF NYXI LIMITED

IN RESPECT OF THE FOLLOWING DESIGN



AND

AN APPLICATION FOR INVALIDATION (NO 33/23)

BY TRADELINK GLOBAL LIMITED

(FORMERLY STERUN LTD)

Background and Pleadings

1. Nyxi Limited (“the registered proprietor”) filed Application No. 6063553 for a registered design for a plastic hanger with hooks in Class 06 (Furnishing), Sub class 08 (Clothes hangers) of the Locarno Classification on 19 June 2019 (“the relevant date”). It was registered on 24 June 2019 with effect from the relevant date and was published on 25 June 2019. The design is depicted in a single representation, which is shown on the front cover of this decision.

2. On 24 February 2023, Sterun Ltd applied for the registered design to be invalidated under section 1B of the Registered Designs Act 1949 (“the Act”), on the grounds that the contested design was not new and did not have individual character compared to other designs that had been made available to the public before the application date of the contested design. Section 1B has effect in invalidation proceedings through section 11ZA(1)(b) of the Act. The applicant claims that it has identified a number of designs that were made available to the public on Amazon before the relevant date and that these designs differ from the contested design in only immaterial details. I shall say more about these designs in due course.

3. During the course of the proceedings, there was a substitution of the applicant, as Sterun Ltd was replaced by Tradelink Global Limited. From now on, I shall refer to Tradelink Global Limited as “the applicant”.

4. The registered proprietor filed a defence and counterstatement on 25 April 2023, denying the applicant’s claims. In particular, it states that it created the design “*with our partnered factories in China ... a few years ago*”, but had not registered the design at the time because it was unaware of the significance of design protection. It further claims that the earlier designs relied upon by the applicant are variations of its original design and that “*I supplied them all by contracting a manufacturer in China to produce them*”. It also claims that the design was accepted for registration “*after thorough examination*”. It then goes on to assert that the designs are different in a number of ways to which I shall return in due course.

5. 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 Briffa and the registered proprietor is represented by Suleiman Ramin.

The content of the counterstatement suggests that he is closely connected with the registered proprietor, but the exact nature of the relationship is not stated.

Evidence

6. Only the applicant filed evidence in these proceedings. There is a witness statement dated 26 June 2023 from Vaibhav Gandhi, the owner of Sterun Ltd. Much of this witness statement is actually submissions, rather than evidence of fact, although Mr Gandhi does explain the circumstances which led to the proceedings. Neither party filed any other submissions.

Preliminary Issues

7. A design registration lasts for a period of five years and it may be renewed up to four times. The registration at issue here ran from 19 June 2019 to 18 June 2024. It was not renewed and therefore has now expired. However, this does not mean that the invalidation falls away. This is because the registered proprietor may enforce the design against acts that were committed during the period in which it was registered, even though it has now expired. If the invalidation is successful, the design is treated as having been invalid from the date it was registered and so the registered proprietor would have no right that it could enforce. Therefore, the outcome of the invalidation proceedings would still have a material effect on the rights of the registered proprietor.

8. The registered proprietor disagrees with the applicant's claim that the contested design lacks originality, on the grounds that "*The IPO successfully registered and approved my design after thorough examination*". The Office does not examine applications for registration for novelty and so the fact that a design has been successfully registered does not necessarily mean that it is new or has individual character.

9. Following the closure of the evidence rounds, on 19 October 2023, the applicant filed three screenshots showing the date of first availability of the earlier designs it relied on in these proceedings. These were not attached to its statement of case, which contained images of the designs relied on, their ASIN codes and information on their sellers and dates when they were first made available. In related proceedings (Design Invalidation No. 31/23), the applicant had adopted the same approach in its statement

of case. However, in those proceedings, the Registry had written to the applicant asking it to provide the relevant screenshots. A similar letter should have been sent in this case at an earlier point in the proceedings. Therefore, I will accept these screenshots as verification of the evidence. In my view, the contents of the statement of case were sufficient for the registered proprietor to have identified the earlier designs. This is because it must have found the Amazon listings in order to have made the statement that they were all variations of its earlier design and it had supplied them all.

Decision

10. 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.”

11. 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

12. The registered proprietor claims that the designs are different in the following ways:

- The dimensions of the contested design were chosen to fit the average size of a wardrobe in a UK home;
- The materials used in the contested design have been customised to be lightweight, yet robust;
- The contested design has a streamlined shape to save space; and
- The contested design has a sleek, matte finish.

13. In *Magmatic Ltd v PMS International Ltd* [2016] UKSC 12, Lord Neuberger (with whom the rest of the Supreme Court agreed) held that:

“30. Article 3(a) of the Principal Regulation [Regulation No 6/2002] identifies what is meant by ‘design’, and, unsurprisingly, it refers to the appearance, which is expressed to include a number of different factors, all, some or one of which can be included in a particular registered design. It is, of course, up to an applicant as to what features he includes in his design application. He can make an application based on all or any of ‘the lines, contours, colours, shape, texture ... materials ... and/or ... ornamentation’ of ‘the product’ in question. Further, he can make a large number of different applications, particularly as the Principal Regulation itself provides that applications for registration have to be cheap and simple to make. As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, ‘[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs’. So, when it comes to deciding the extent of protection afforded by a particular



Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.


31. Accordingly, it is right to bear in mind that an applicant for a design right is entitled, within very broad limits, to submit any images which he chooses. Further, in the light of article 36(6), an applicant should appreciate that it will almost always be those images which exclusively identify the nature and extent of the monopoly which he is claiming. ...”

14. I have highlighted two brief passages from this judgment. They emphasise the importance of the representations that were filed with the application. It is those representations, together with any disclaimers, that, in almost all cases, will determine what is protected by the registered right. In the present case, they do not give any information about the dimensions of the design or the materials used. I therefore dismiss the registered proprietor’s first two claims.

Earlier Designs

15. The applicant claims that there are three earlier designs that differ only in immaterial details from the contested design. They were all made available on Amazon and are shown below:

Design	Details
	Seller: Keplin Plastic Hangers ASIN B07D9V8VNQ Date first available: 25 May 2018
	Seller: Ariana Homeware ASIN B07B9M1VSF Date first available: 5 August 2017

Design	Details
	<p data-bbox="774 253 1385 286">Seller: Hangerworld Black Plastic Hangers</p> <p data-bbox="774 309 1056 342">ASIN B00ELU8WI2</p> <p data-bbox="774 365 1286 398">Date first available: 16 August 2013</p>

16. I am satisfied that these clothes hangers were made available to the public prior to the relevant date. Listing a product on Amazon constitutes a disclosure that could reasonably have become known to persons carrying on business in the UK and the European Economic Area and specialising in the sector concerned. The registered proprietor has not claimed that any of the exceptions in section 1B(6) apply.

17. I shall now address a point made by Mr Gandhi in his witness statement. He refers to the registered proprietor's counterstatement and the claim that the design was created a few years ago. Mr Gandhi submits that:

"5. ... This appears to be an admission that the Contested Design had already been disclosed prior to the relevant date. This assumption is further enriched by the admission by Mr Ramin that the importance of registration was not properly understood, in other words, it was realised at the time of filing the Contested Design, that it had been left it [sic] too late."

18. I have no difficulty in accepting that the registered proprietor has admitted that the design was created a few years before it was registered. This is clearly stated. What Mr Ramin does not explicitly say is that the contested design was made available before registration. He does, though, claim that the earlier designs relied on by the applicant are variations of its design, which might imply that the contested design was disclosed before the dates on which the earlier designs relied on by the applicant were made available. If that were indeed the position, there would be no need to proceed any further. I could find that the registered proprietor had disclosed the design before the 12-month "grace period" allowed by section 1B(6)(c) and therefore destroyed the novelty of the design itself. The contested design could then be declared invalid.

19. However, I consider that I must compare the earlier designs with the contested design. Even if I accept that the earlier designs relied on by the applicant are variations on the registered design, created a few years ago, this does not necessarily mean that the registered proprietor's design was disclosed in a way that it could reasonably have become known to persons carrying on business in the United Kingdom or the European Economic Area.



Novelty

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

“26. ‘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.”

Comparison of the designs

21. I shall begin with the second earlier design relied on by the opponent, i.e. the hanger sold by Ariana Homeware.

The Registered Design	The Prior Art
	

22. The registered design has the following features:

- i. A triangular shape with a long base and two shorter sides rising to a point;
- ii. A large open centre to the triangle;
- iii. Two curved corners at the bottom of the triangle and a pointed corner at the top;
- iv. A hook of the same width as the sides of the hanger, rising from the top of the triangle at a slight acute angle;
- v. Two small hooks at either end of the base of the triangle, set slightly in from the corners;
- vi. Clean lines with no embellishments; and
- vii. The colour is black

23. The prior art has exactly the same features. The proportions look to me to be identical and I can see no differences between the designs. The overall appearance of the designs is the same and so I find that the contested design is not new when compared with this earlier design. I see no need to compare the contested design with the remaining designs relied on by the applicant.

Individual Character

24. I have found that the contested design has the same appearance as the design made available by Ariana Homeware. It follows that the overall impression the contested design produces on the informed user does not differ from the overall impression produced on such a user by Ariana Homeware's design. The contested design does not have individual character.

Conclusion

25. The application is successful and Registered Design No. 6063553 is declared invalid.

Costs

26. The applicant has been successful and in the circumstances is entitled to a contribution towards the costs of the proceedings. I note that the applicant did complete a costs proforma. However, as it was represented throughout these proceedings, that proforma was sent in error and I shall make my award based on the

scale of costs set out in Tribunal Practice Notice No. 1/2023. I award the applicant the sum of £848 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

£300 for preparing a statement and considering the other side's statement;

£500 for preparing evidence and submissions;

£48 for the official fee for filing a DF19A.

27. I order Nyxi Limited to pay Tradelink Global Limited the sum of £848. 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 if the appeal is unsuccessful.

Dated this 11th day of July 2024

Clare Boucher

For the Registrar,

The Comptroller-General