

O/0672/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6194241

IN THE NAME OF

DAVINCI II CSJ, LLC

AND

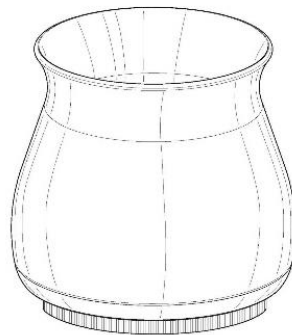
AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 161/22

BY XIAOHONG LIN

Background and pleadings

1. Registered design number 6194241 (“the contested design”) was filed on 28 February 2022 and was registered with effect from the same date. It stands in the name of DaVinci II CSJ, LLC (“the proprietor”). The application for the design claimed a priority date of 1 September 2021 (“the relevant date”) from US design registration 29/806181. The illustration below gives an indication of the contested design:



2. The design is described as a “furniture leg cover” and is registered in class 06-06 of the Locarno classification system.

3. On 24 November 2022, Xiaohong Lin (“the applicant”) applied for the registration of the design to be declared invalid under s. 11ZA(1)(b) and s. 1B of the Registered Designs Act 1949 (“the Act”). The applicant says that the contested design is the same as, or creates the same overall impression as, two earlier registered Chinese designs and three products which were made available to the public from as early as April 2020.

4. The proprietor filed a counterstatement denying the grounds for invalidation. I note in particular that it claims a description is attached to the contested design which reads, “The vertical lines in a bottom portion of the design represent the colour red”. The proprietor denies that all of the prior art relied upon by the applicant was made available to the public in such a way as to constitute prior disclosures and challenges the reliability of the evidence of prior disclosure filed by the applicant.

5. Neither party asked to be heard. Only the proprietor filed written submissions in lieu. This decision is made following a careful reading of all of the papers.

6. The applicant is represented by IPEY. The proprietor is represented by Dummett Copp LLP.

Evidence

7. There were procedural irregularities in the processing of this design case. As things now stand, both parties have filed documents with their pleadings, which are signed by individuals and are verified by a statement of truth. I will treat these as having evidential weight.

8. The applicant also filed evidence, in the form of the witness statement, with a number of exhibits, of Huw Evans, the applicant's representative. Mr Evans' statement provides evidence about the designs the applicant says were published on, among others, the WIPO Global Designs Database and the Chinese website Weibo prior to the relevant date. This material reproduces the evidence filed with the statement of case.

9. The proprietor's evidence, attached to its counterstatement, comprises an uncertified copy of the application for the contested design (exhibit 1) and an article from *Der Spiegel* about the apparently small number of active users on Weibo (exhibit 2).

10. Both parties filed written submissions during the evidence rounds. I have read all of these and will return to them as necessary.

The law

11. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid – [...]

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act.”

12. Section 1B of the Act, so far as is relevant, 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 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.

(8) [...]”

Relevance of EU Law

13. The provisions of the Act relied on 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 decisions of the EU courts which predate the UK’s withdrawal from the EU.

Prior disclosures

Chinese design registrations

14. The applicant’s evidence includes a print from the WIPO Global Design Database for Chinese registration number 305961581 (“the ’581 design”).¹ The date of publication is given as 4 August 2020. The illustrations of the design, with duplication removed, are reproduced below:

¹ Exhibit HE-1.1 (to Mr Evans’ statement). HE-1.2 consists of prints from the EU Intellectual Property Design View database relating to the same design, showing the same publication date.



15. A further print from the WIPO Global Design Database shows Chinese design registration number 305684150 (“the ’150 design”), for which the date of publication is 7 April 2020. The illustrations include the following:²



16. There is no dispute that the above design registrations were made available to the public prior to the relevant date. Nor is it suggested that any of the exceptions in s. 1B(6) apply. I am satisfied that the above designs were disclosed prior to the relevant date.

Amy talks about fashion (Weibo)

17. The applicant’s evidence also includes prints from the website <https://m.weibo.cn>, from the “Amy talks about fashion” account.³ The exhibits show the original versions and machine translations. The products shown in the prints are as follows:



² HE-2.1. See also HE-2.2.

³ Evans, §§8 to 11, HE-3.1 to HE-3.4. See also HE-6.



18. The prints appear to show that the posts are dated 2 August 2020. The proprietor takes issue with this prior disclosure on a number of bases. It disputes that the products shown on the “Amy talks about fashion” blog were made available prior to the relevant date. The basis for this denial is that the full URL addresses were not provided. However, although the URL is not visible on the prints, it is included in both the statement of case and in Mr Evans’ statement. Mr Evans was not cross-examined and no evidence has been filed to call into question the claimed date of disclosure. The website addresses have been provided and there is no reason to doubt that the posts were uploaded to and available on the Weibo website from August 2020.

19. The proprietor also disputes that a person named Amy commented on the furniture leg covers at all. It relies on the article from *Der Spiegel* as evidence that Weibo “has been suspected of publishing unverifiable results on several occasions”. It is true that the article implies that claims of the number of users have been inflated and that only a fraction of accounts are active. However, there is nothing in the article to suggest that the posts shown in the applicant’s evidence were not placed on the site as indicated. Moreover, whether the posts were made by someone called Amy or not can only be relevant if the identity of the person or entity who made the disclosure engages the exceptions in s. 1B(6)(b) to (e). None of these exceptions is relied upon by the proprietor.

20. The proprietor also submits that this disclosure cannot be taken into account because it cannot reasonably have become known to persons carrying on business in the UK or in the EEA before the relevant date, i.e., it says that the exception in s. 1B(6)(a) applies and that this prior art must be ignored. It submits that:

“[...] disclosures in Chinese language and on Chinese websites are to be disregarded. It cannot be expected from the informed user in the United

Kingdom to review Chinese e-commerce platforms in Mandarin or Cantonese language. Websites in Chinese language cannot reasonably have become known to the circles specialized in the sector concerned and operating within the UK, according to Section 1B(6)(a) of the Registered Designs Act.”

21. The applicant replies by submitting that although the text of the Weibo disclosures was not translated, the text is irrelevant and can be ignored because both the date and images of the Weibo disclosures are readily apparent without a translation.

22. In *Magmatic Limited v PMS International Limited* [2013] EWHC 1925 (Pat). Arnold J (as he then was) considered what he described as the “obscure disclosures exception” of Article 7(1) of Regulation No. 6/2002, the equivalent of s. 1B(6)(a). The judge’s statement of the law and his findings on obscure disclosures were unchallenged on appeal. He summarised the law as follows:

“36. First, the exception refers to ‘these events’. The ‘events’ are the events constituting disclosure referred to earlier in the first sentence of Article 7(1) – publication, exhibition, etc. Counsel for PMS submitted that the exception did not apply if the relevant event could reasonably have become known, even if the design itself could not reasonably have become known as a result of that event. I do not accept that submission. The purpose of the exception is to prevent obscure designs from being relied upon to attack the novelty and individual character of a Community registered design. If a design could not reasonably have become known, it cannot matter that the event could have become known. In most cases, of course, one will follow from the other.

37. Secondly, what is ‘the sector concerned’? In *Green Lane [Green Lane Products Ltd v PMS International Group Ltd* [2008] EWCA Civ 358] the Court of Appeal held that it was the sector from which the prior design came, not the sector from which the registered design came. The Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) came to the opposite conclusion in Case R 84/2007-3 *Ferrari SpA v Dansk Supermarked A/S* (unreported, 25 January 2008) and Case R 9/2008-3 *Crocs Inc v Holey Soles Holdings Ltd* [2010] ECDR 11. An appeal to the General Court

in the latter case was not pursued. In those circumstances, I am bound by the Court of Appeal's decision in *Green Lane*. Furthermore, I agree with it.

38. Thirdly, who are 'the circles specialised in' that sector? In *Green Lane* Lewison J (as he then was) held at first instance that this comprised all individuals who conducted trade in relation to products in that sector, including those who designed, made, advertised, marketed, distributed and sold such products in the Community ([2007] EWHC 1712 (Pat), [2008] FSR 1 at [34]-[35]). This point was not addressed by the Court of Appeal. In Case R 552/2008-3 *Harron SA v THD Acoustics Ltd* (25 July 2009, unreported) the Board of Appeal held that the circles included experts and all businesses involved in the trade including importers. Thus it seems clear that the words are to be broadly interpreted.

39. Fourthly, the test is whether the events 'could not reasonably have become known in the normal course of business'. It is common ground that this is an objective test. Counsel for PMS emphasised that the question was whether the events *could not* have become known, not whether the events *would not* have become known. I accept that, but subject to the qualification that the test is whether the events could not *reasonably* have become known *in the normal course of business*. The wording must be interpreted as a composite whole.

40. It is common ground that the events in question must have occurred prior to the filing or priority date of the registered design. Counsel for PMS accepted that it was theoretically possible for a design to have become sufficiently obscure as a result of the passage of time that it could not reasonably have become known in the normal course of business at the filing or priority date even if it could have become known at the date of the event, although he submitted that this was unlikely to occur in practice.

41. Fifthly, who bears the burden of proof? Counsel for PMS submitted that the burden of proving that the exception applied rested on the party who relied on it, here Magmatic. He argued that this interpretation was supported by both the wording and purpose of the exception and by the case law of the Board of Appeal, in particular Case R 1516/2007-3 *Normanplast snc v Castrol Ltd*

(unreported, 7 July 2008) at [9]. Counsel for Magmatic submitted that the burden of proving that the disclosure was made available to the public rested on the party challenging the validity of the registered design, and that included proof that the design could reasonably have become known as a result of the event relied on. In the alternative he submitted that, if the burden of proof lay on the proprietor of the design, nevertheless the evidential onus could shift if on its face the disclosure was an obscure one. In support of these submissions, he relied on the decision of the Board of Appeal in Case R 1482/2009-3 *Termo Organika Sp. z o.o. v Austrotherm GmbH* (unreported, 22 March 2012) at [38]-[44]. As counsel for PMS submitted, however, there is no indication in that decision that the question of burden of proof was argued or that the Board of Appeal was addressing its mind to the question. In my judgment the burden of proving that the exception applies rests on the party relying on the exception. I accept, however, that the evidential onus may shift to the other party once it is shown that the disclosure relied on appears to be an obscure one.”

23. In addition, in *H. Gautzsch Großhandel GmbH & Co KG v Münchener Boulevard Möbel Joseph Duna GmbH*, Case C-479/12, the Court of Justice of the European Union (CJEU) held at [33] that it is not absolutely necessary for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public, adding that whether a disclosure outside the European Union could reasonably have become known to persons forming part of those circles is a question of fact to be assessed in each case.

24. In *Senz Technologies BV v OHIM*, Joined cases T-22/13 and T-23/13, the General Court (“GC”) considered whether a US patent would be a disclosure. It said:

“29. In order to carry out the assessment referred to by the Court of Justice, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications,

customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.”

25. In the same case, at [26] of the judgment, the GC held that a design is deemed to have been made available within the meaning of Article 7 of Regulation No 6/2002 once the party relying thereon has proven the events constituting disclosure. In order to refute that presumption, the party challenging the disclosure must establish to the requisite legal standard that the circumstances of the case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned.

26. As I have found that the disclosure was made as claimed, the burden is on the proprietor to displace the presumption that the disclosure could reasonably have become known to the relevant circles.

27. The mere fact that Weibo is a Chinese website does not make it obscure: China is one of the most important industrialised nations and a manufacturing powerhouse. The applicant refers to the site as a microblogging site, and the *Der Spiegel* article describes Weibo as the “Chinese Twitter counterpart”. There is nothing to establish that at the relevant date Weibo was a website which was difficult to access or obscure; on the contrary, the analogy with Twitter suggests that it is very large indeed. Whilst the blog is in Mandarin (or Cantonese) and there is no indication it was available in English, there are likely to be Mandarin speakers operating in the furniture accessories sector in the UK and EEA. The fact that the blog was not in English or another European language does not appear to be sufficient, on its own, to discount the disclosure. There is nothing else either in submissions or evidence to support the claim that the disclosure could not reasonably have become known and I dismiss the claim that the disclosure is obscure.

28. Lastly, the proprietor complains that a number of designs are shown within the prior art. It therefore says that each image must be treated as a separate design. It is clear from the statement of case that only the round designs are relied upon. It is also clear from the applicant's submissions that it considers all of the round designs to be the same design, apart from the colour, as it says, "Apart from the colour, all of the designs of Grounds 3 and 4 are the same respective designs and the different coloured versions were simply shown in the tabular comparison of the Statement of Grounds as they provided the best corresponding views". There is no unfairness to the proprietor, since it has had a chance to respond and, whilst it is true that there are several images shown, for reasons which I will shortly explain, the different colour of these designs is not relevant in the comparison.

29. This disclosure is valid prior art upon which the applicant may rely.

Taobao (Weibo)

30. There is a second disclosure relied upon from Weibo, which is dated 31 July 2020.⁴ It appears to be from an account called "Taobao Coupon". The following products are shown:



31. The proprietor makes the same criticisms regarding the URL not being apparent on the website prints, which I dismiss for the reasons given at paragraph 18, above.

⁴ HE-4.1- HE-4.2. See also HE-5.

32. The proprietor also relies upon s. 1B(6)(a) in respect of this disclosure. For the same reasons as given above, the fact that the post is on a Chinese website is not decisive. Nor is the fact that it is in Mandarin/Cantonese determinative of the validity of the disclosure. The proprietor refers to Taobao as an “e-commerce platform”. This suggests that the website is not only technically accessible anywhere in the world but that there is unlikely to be any significant difficulty in accessing it. For this and the reasons given above, I do not consider this an obscure disclosure.

33. As with the Amy talks about fashion disclosure, the proprietor complains about the number of images of products shown, which have different colours. As with the above disclosure, however, it is clear from the tabular comparison in the statement of case that only the round designs are relied upon, and the colour is not relevant for the present comparison. This disclosure constitutes prior art.

Amazon.de

34. The final disclosure upon which the applicant relies consists of prints from www.amazon.de.⁵ The prints show the following images:



35. The statement of case includes the additional image, shown below. It is not easy to see this on the Amazon print itself but it appears to be taken from part of one of the smaller images on the web page. The proprietor has not disputed whether this image is a genuine reproduction from the print and I will proceed on the basis that it forms part of the claimed disclosure:

⁵ HE-G2A.



36. The proprietor disputes whether the product was disclosed before the relevant date. It says that the print is dated 21 March 2022 (i.e., after the relevant date) and makes the following comments:

“Insofar as the Applicant refers to the ‘date first available’ of 21 June 2021, printouts of e-commerce platforms such as Amazon need to show more than just the first available date.

Even if the ASIN number is a unique number created by Amazon when the product is first offered in the Amazon catalogue online, it has no evidence value as regards the date this design has [sic] made available to the public for the first time.”

37. I do not accept these criticisms of the applicant’s evidence. The civil standard of proof is the balance of probabilities. Whilst I accept that it is possible that the product/product images could be altered after the ASIN has been allocated and the “date first available” logged, there is no evidence that this is likely to have occurred in this case. In the absence of any evidence capable of casting doubt on the first recorded offer for sale of the product shown having been made on 21 June 2021, I accept that the evidence establishes that furniture leg covers such as the one shown on the www.amazon.de print were disclosed in accordance with s. 1B(5). None of the exceptions in s. 1B(6) applies.

Novelty and individual character

38. 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.”

39. A design may still be new but still lack the necessary individual character compared to the prior art. The following guidance was set out by HHJ Birss (as he then was) at [31] to [59] of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“The informed user

33. The designs are assessed from the perspective of the informed user. 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-281/10P)* [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 7, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

- i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* 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)”

“Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* [*Dyson Ltd v Vax Ltd*, [2010] FSR 39] Arnold J. summarised that passage from *Grupo Promer* as follows:

“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).”

“Effect of differences between the registered design and the design corpus

51. [...] The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.”

“The correct approach, overall

[...]

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.”

40. In *Safestand Ltd v Weston Homes PLC & Ors* [2023] EWHC 3250 (Pat) HHJ Hacon, sitting as a judge of the High Court, set out at [237] the approach to the assessment of whether a design has individual character:

“(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,

(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,

(d) that features of the designs which are solely dictated by technical function are to be ignored in the comparison, and

(e) that 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

41. The designs are furniture leg covers. The sector is the market for furniture accessories.

The informed user, their awareness of the prior art and their level of attention

42. The products in question are sold directly to ordinary members of the public for use with their existing furniture. The end users are members of the public with an interest in furniture accessories.

43. The applicant submits that the informed user is “not particularly circumspect”. It is, however, well established that the informed user in design law sits between the reasonably observant and circumspect average consumer of trade mark law and the person skilled in the art of patent law. The judgment in *PepsiCo* confirms that the informed user is “particularly observant”. In *Marks and Spencer PLC v Aldi Stores Ltd* [2024] EWCA Civ 178, Arnold LJ said that “[as] an informed user, the user would exercise a relatively high degree of attention compared to the average consumer who is the touchstone in trade mark law”. The informed user will pay a relatively high degree of attention to designs for furniture leg covers to ensure that they will perform the intended function, will fit the furniture in question and will be acceptable from an aesthetic point of view.

44. The only evidence about the exposure of the informed user to the prior art is that the product on www.amazon.de has 674 global ratings. Of the reviews which are visible, reviewers from only Germany and Canada are identified. The informed user is therefore unlikely to have had any significant exposure to the products relied upon. As an “informed” user, the user is aware of the products and designs which already exist in the marketplace. However, other than the prior art, there is no evidence of the design corpus. There do not appear to be any special circumstances which would mean that the informed user does not conduct a direct comparison of the designs, or that more extensive knowledge of the prior art would affect that comparison.

Design freedom

45. In *Doceram GmbH v CeramTec GmbH*, Case C-395/16, EU:C:2018:172, the CJEU clarified the meaning of the words “designs which are solely dictated by technical function,” as follows:

“32. [...] 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. It added that it is for the national court to take into account all of the objective circumstances relevant to the individual case and that:

“37. [...] such an assessment must be made, in particular, having regard to the 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. The applicant says that there are no statutory or technical requirements which apply in this case, except that the product must be cup-shaped to fit on to the bottom of furniture legs. It submits that the designer therefore enjoys a wide degree of design

freedom, as protective caps for furniture can have different shapes, colours, patterns, proportions or decoration.

48. In contrast, the proprietor submits that the design freedom in the present case is very limited. It says that furniture leg covers must be suitable for accommodating and protecting chair or table legs, covering the base and part of the sides of the leg and fitting the diameter of the leg, and that the cover must be non-slip.

49. In *Dyson*, 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.”

50. The www.amazon.de prints include images of a number of other designs for furniture leg covers, whose date of first availability is not clear. I reproduce these below:



51. The images show designs which are circular or square, of varying lengths relative to their width. Some are transparent, others are not. Some are much thinner than others. Most have a base piece of a different colour and/or texture/material but at least one, at the bottom right of the images above, appears to be of the same material throughout.

52. There are some constraints on the designer because the product must be capable of secure attachment to the legs of furniture. It must cover the base and part of the sides of the leg. Given that there is no uniformity of furniture legs, a single product intended to fit legs of different dimensions and shapes must have the flexibility to do so. The examples above show that this can be achieved through the use of a material which can be stretched or through the incorporation of design features which allow the leg cap to accept legs of different diameters. I accept that many furniture legs are round and that the choice of a round leg cover is likely to be an efficient choice because less material is required than, for example, a square design, particularly if the product is intended to fit both round and square legs. Therefore, although it is not necessary for a furniture leg cover to be round, there may be a technical and economic advantage in it being so. However, there is freedom in other respects. The cap must be tall enough not to slip off the leg unintentionally but provided that minimum height is reached, there is then freedom of choice of the height of the product relative to its width. Whether to use a lip or another design feature which enables the cap to be attached to the leg easily is a choice between technical solutions but there is choice over the sharpness of the angle or length of a lip. There is also considerable choice regarding the base of the design, including whether to use a separate section and, if so, its width and height relative to the body, and how it is incorporated (e.g., encapsulated or a distinct section beneath the body). There are also design choices to be made regarding any colour contrast between the base and the body, and regarding the shape of the side walls of the product. I accept that where a flexible material is used the shape of the side walls of the body once in use may adapt to the shape and size of the furniture leg to which it is fitted. However, there is no obvious reason why the shape of the side walls is solely dictated by function: the evidence shows both straight-sided and curved outer walls, including in one case a square design whose inner walls appear to be a straight-sided square but whose outer walls flare outwards towards the bottom. The designer retains considerable freedom over

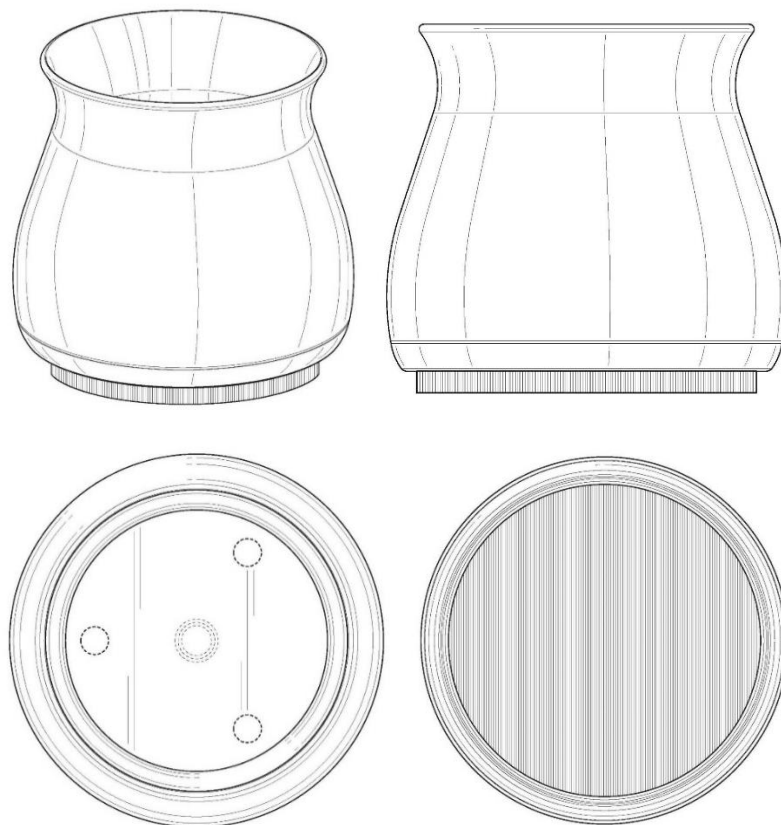
the precise shape of the side walls. Overall, whilst there are some restrictions, the designer has a reasonable degree of freedom.

Comparison of the designs

53. A design must be interpreted objectively: *Celaya Emparanza y Galdos Internacional SA v Proyectos Integrales de Balizamiento SL* (Case C-488/10) EU:C:2012:88, at [55]. The objective interpretation of a design is a matter for the tribunal, not the tribunal viewing the design through the eyes of an informed user: *Sealed Air Limited v Sharp Interpack Limited* [2013] EWPC 23, at [20]-[21].

Features of the contested design

54. These are the illustrations of the contested design, with duplicates removed:



55. The registration for the contested design specifies that no claim is made for the parts of the design shown in dash-dash broken lines. This applies to the four circles on the base of the design, which I will ignore.

56. The proprietor submits that the base of the contested design, which is shown with vertical lines in the side view, is red. In support of this contention, it has filed an uncertified copy of the application as filed.⁶ This document contains the words “The vertical lines in a bottom portion of the design represent the colour red” under the heading “additional description”. This is said to be a limitation because the US design upon which the priority claim is based includes a limitation that the base is red. The applicant has responded to the proprietor’s assertion that the contested design features a red base by arguing that the base is not visible in use; it has not questioned whether the contested design does, properly interpreted, have a red base.

57. I do not consider that the description of the contested design having a red base is sufficient to limit the protection of the design. There is no evidence of the US registration or how descriptions included as part of design applications for the US register are to be interpreted. It is true that the contested design must be the same as the design upon which the priority claim is based but without assistance to determine the significance of the description of the illustrations in US law, I cannot be sure that the proprietor’s submission is correct. The UKIPO does not review the scope of protection of the US design patent in recording the priority claim and US drawing conventions differ. In *Rothy’s, Inc v Giesswein Walkwaren AG*, David Stone, sitting as a Deputy High Court Judge, said at [60] that he did not consider the position in relation to registered designs clear cut. In the UK, a description of the representation does not narrow the scope of protection as such. Article 36(3)(a) of Regulation 6/2002 on Community Designs (“the CDR”) permits the use of “a description explaining the representation or the specimen” but Article 36(6) says that “The information contained in the elements mentioned in [...] paragraph 3(a) and (d) shall not affect the scope of protection of the design as such”. The importance of the representations of the design has been stressed in a number of UK cases. 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

⁶ Exhibit 1 to the form DF19B.

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. As Dr Martin Schlötelburg, the co-ordinator of OHIM's Designs Department has written, 'the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them' – *The Community Design: First Experience with Registrations* [2003] EIPR 383, 385. And, as Dr Schlötelburg went on to explain, an applicant is free to indicate which, if any, aspects of the images of a Community Registered Design are disclaimed:

'Where an applicant wishes to exclude features which are shown in the representation for explanatory purposes only, but do not form part of the claimed design, he may disclaim those auxiliary features by depicting them in broken lines (for drawings) or by means of colouring them (for black and white drawings or photos) or encircling them (for any drawing or photo).''

58. It was plainly open to the proprietor to file a representation of the design which showed the base in red. I also bear in mind that the description attached to the design is not a published part of the registration and, as a result, would be undiscoverable to any party searching the register. Absent evidence that the design upon which the priority is based is protected only with a red base, it seems to me that, in view of the terms of the CDR and the judgment in *Magmatic*, that the contested design should be interpreted from the illustrations alone, not from the description. I will proceed on that basis.

59. I should also note that there are a number of thin lines running from top to bottom of the body and horizontally near the top on the illustrations of the contested design. Similarly, there are thin straight lines and thin circular lines indicated across and around the base of the design (the third illustration, above). I understand these to be indications of the shape rather than surface decoration. I will treat them as such.

60. The contested design consists of:

- A tube-like body, which is circular when viewed from above and below. It is wider at the bottom than the top;
- A neck approximately one fifth of the way down the body, narrower than the rest;
- The top of the body curves out from the neck. The top edge is slightly rounded;
- The lower portion flares out from the neck and then narrows again slightly to the base. It resembles a very elongated "S" shape. The wider part of the body occupies approximately one third of the height of the body;
- A line around the body, approximately one tenth of the way up the sides;
- An overhang where the body meets the base, which is a short horizontal section;
- A shallow, circular base bearing thin parallel lines.


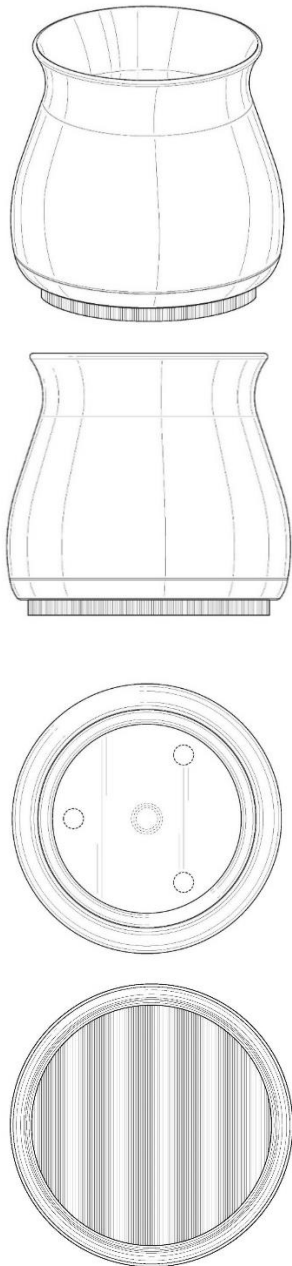
61. The applicant submits that the product of the contested design would adopt a different shape according to the shape of the furniture leg and that the informed user would not, therefore, “pay significant attention to the as-formed shape of the product”. It also submits that the outer shape of the side walls is the part of the design to which the informed user will pay the most attention, because the underside and inside of the product is hidden from view once fitted to the furniture leg.

62. I agree that the bottom surface of the product will not be seen once fitted to a furniture leg. The inside of the product will be visible when being fitted or inspected prior to fitting but, once in place, the product is unlikely to be removed and replaced with any regularity. The inside will not be seen once attached and it therefore has limited weight in the comparison. I do not accept that the base section of the contested design is completely invisible in use. The user will still be able to see that there is a base joined to the body when the product is fixed to furniture, albeit possibly not—or not clearly—if the furniture legs are much wider than the cover and/or from certain heights or angles. As to the outer shape of the design’s walls, this will again be apparent at the time of selection of the product and prior to fitting but it is possible that the design may not retain its shape once fitted. However, this will not always be the case. For example, a round leg which is no wider than the neck of the leg cover may not distort the outer shape of the walls at all. That this is plausible is evident in the examples from the Amy talks about fashion blog.

63. I disagree with the proprietor’s assertion that the user will pay a high degree of attention to the base of the design because of its practical significance in protecting the floor. A user may pay some attention to the composition of the base, (for example, because it is required to stop slipping) but the leg covers may be chosen for other reasons, including to protect the sides of furniture legs from damage from, for example, vacuum cleaners and sweeping brushes. I do not consider that any more attention will be paid to the design features of the base than to the body of the design, not least because “practical significance” suggests functional, not aesthetic considerations and because once the product is fitted the base will be less visible.

Comparison with the '581 design

64. For convenience, the competing designs are shown below:

Prior art	Contested design
	

65. I should note first that the prior art does not show only one design. The second image shows multiple black circles, whilst the third shows only seven. There is also some doubt in my mind that the first and second representations show the same product, as the base section does not appear to be of the same dimensions relative to the width of the body. Further, in the first image the circular pieces between the base and body appear to be protrusions, whilst in the second image they look like apertures. The applicant says that they are “an array of apertures formed in the bottom wall to

allow air out of and into the interior [...]”. The point has not been raised by the proprietor.

66. Both the first and second representations of the '581 design feature:

- A tubular shape with a flared neck and side walls which are wider at the bottom than the top;
- A lip at the top of the design;
- Side walls which taper out from the neck;
- A horizontal line circling the body close to the bottom.

67. These are, to a degree, shared with the contested design. However, there are the following differences:

- The shape of the side walls is not a smooth curve resembling an elongated “S” shape; there is a straight line from the narrowest part of the neck to just above the bottom;
- Close to the bottom of the body, a short section of the walls is straight and vertical.

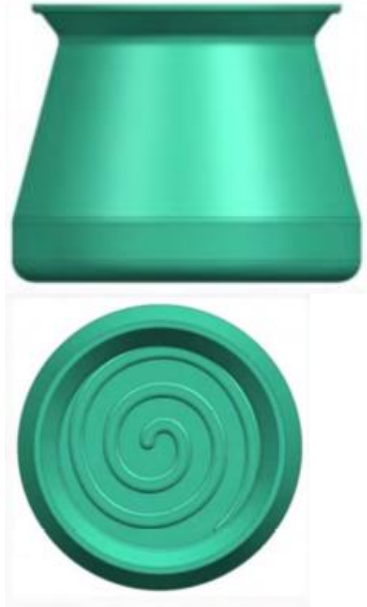
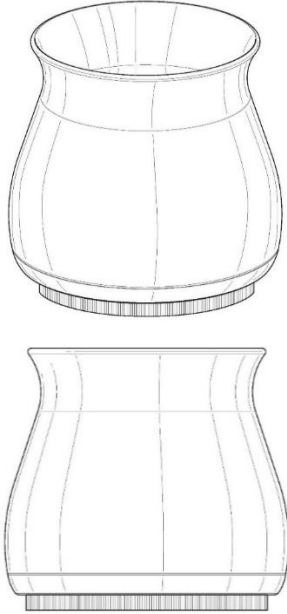
68. In my view, the difference in the shape of the outer walls is more than immaterial. The '581 design does not destroy the novelty of the contested design.

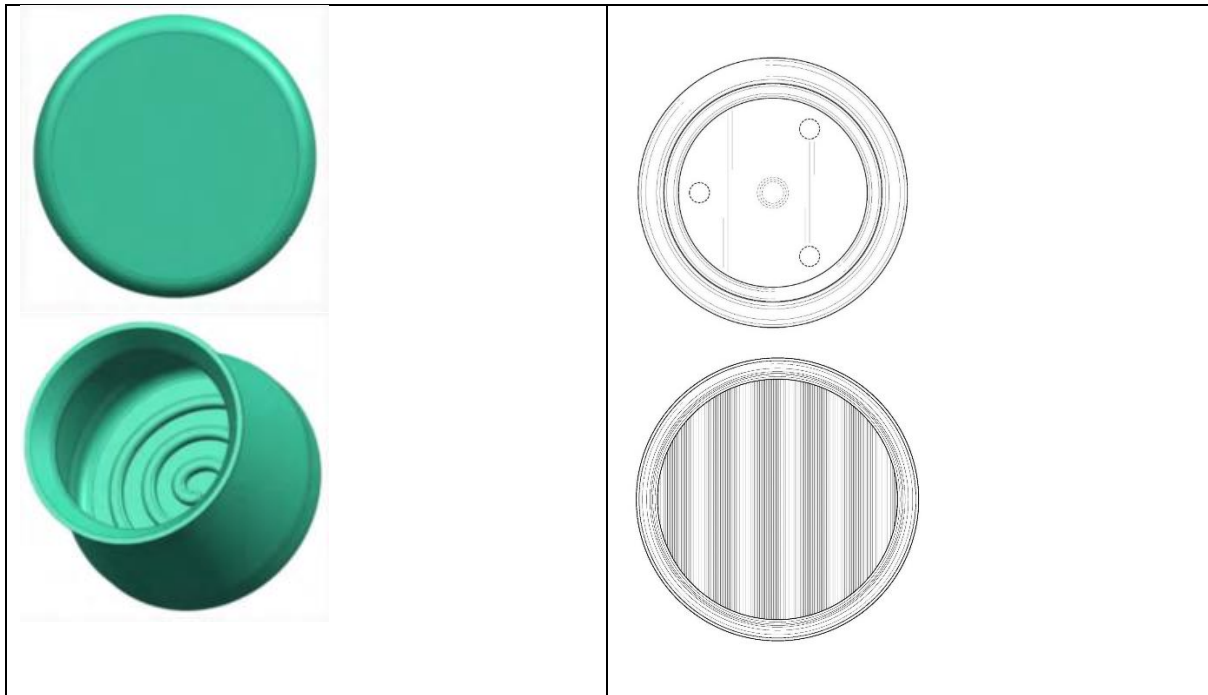
69. As to overall impression, there are further points of difference in addition to the above. The top of the prior art has a ridge at the lip giving the prior art a thicker appearance than the contested design. The proprietor says that there is a “clearly visible space between the circular bottom surface of the cup-shaped portion and the non-slip surface”. I understand it to be saying that the dark shaded areas between the body and the base are gaps for air to escape. I am not persuaded that this is so, because the edges of the design appear to curve to the base, with no gap. This suggests that the circular posts/apertures do not have the technical function posited by the applicant. In the first representation, the base section appears to be slightly deeper relative to the overall height of the product in the prior art compared with the

same features in the contested design but this is a fine difference and will be less apparent, or not at all apparent, when the product is fitted to a furniture leg. The difference between the shape of the overhang where the base meets the body of the respective designs is also unlikely to be noted. In the second representation, there appears to be little or no overhang at all. The prior design has a textured underside which differs from the lined base of the contested design. The base section of the prior art also has two layers in different colours. However, the undersides will not be visible in use and the base sections will have limited impact on the overall impression once fitted. Nonetheless, despite the similarities between the designs, I am satisfied that the contested design conveys a different overall impression from either the first or second representation of the prior art, in particular because the main body of the prior art is a more angular design than the gentle curve of the contested design and the overall impression of the prior art is of a thicker and less elegant product.

Comparison with the ‘150 design

70. These are the competing designs:

Prior art	Contested design
	



71. The '150 design consists of:

- A tubular body which is slightly narrower at the top than the bottom, which has a neck about one sixth of the way from the top;
- A lip at the top which flares out from the neck in a straight line and which has a ridge at the top edge;
- Sides which extend outwards from the neck to the base in a straight line;
- A short section at the bottom of the design where the side walls are vertical;
- A swirling pattern on the interior of the base of the design. This will not be seen in use;
- A smooth base. This, too, will not be visible in use.

72. The fact that the prior art is in green is not relevant, because the contested design is not protected for a particular colour.

73. I am satisfied that the difference between the outer shapes of the walls of the designs, consisting of straight lines in the prior art and curved lines in the contested design, renders the contested design novel. I also consider that the absence of a base

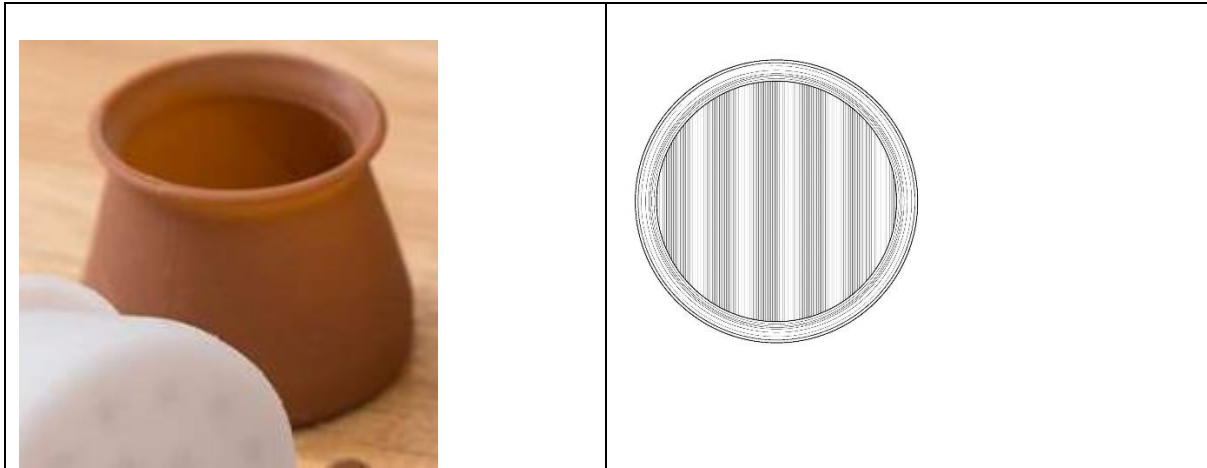
section has the same effect, independently of the shape of the sides. The designs are not identical and do not differ only in immaterial differences.

74. Regarding the overall impression of the designs in issue, I find that the differences described above are sufficient to create a different overall impression on the informed user.

Comparison with the Amy talks about fashion product

75. The clearest representations of the prior art are in the table of the statement of case. These are shown below, alongside the contested design:

Prior art	Contested design
 <p>The 'Prior art' column contains three photographs of silicone cups. The top image shows a pink cup next to its lid. The middle image shows a white cup with a lid. The bottom image shows a white cup without a lid.</p>	 <p>The 'Contested design' column contains three technical drawings. The top drawing is a perspective view of a cup with vertical lines on its side. The middle drawing is a side view of the same cup. The bottom drawing is a top-down view showing the lid with four circular holes.</p>



76. The prior art consists of:

- A tubular body which is slightly narrower at the top than the bottom, which has a neck about one fifth of the way from the top;
- A lip at the top which flares out from the neck in a slightly curved line and which has a ridge at the top edge;
- Sides which extend outwards from the neck to the base in a straight line;
- A short section at the bottom of the design where the side walls are vertical;
- A horizontal line approximately one tenth up from the bottom of the product, which circles around the product and which appears to be indented (giving the impression of a joint between body and base);
- Nineteen evenly spaced circular protrusions on the inner surface of the base. These will not be visible once the product is fitted to a furniture leg;
- A smooth base. This, too, will not be visible in use.

77. As the applicant's intention appears to have been to claim one prior design (rather than the same shape in multiple colours) I will treat the prior art as one design. The difference in colour between the prior art and the contested design is not a relevant one in any event, as the contested design is not protected for a particular colour.


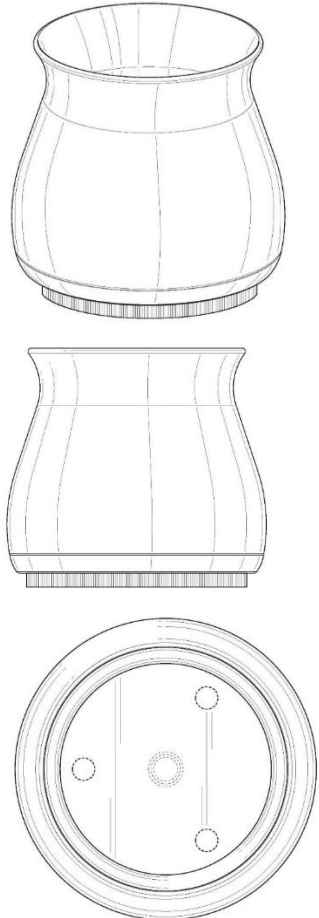
78. As with the design considered immediately above, I am satisfied that the difference between the outer shapes of the walls of the designs, consisting of straight lines in the

prior art and curved lines in the contested design, renders the contested design novel. I also consider that the absence of a base section has the same effect, independently of the shape of the sides. The designs are not identical and do not differ only in immaterial differences.

79. Regarding the overall impression of the designs in issue, I find that the differences described above are sufficient to create a different overall impression on the informed user.

Comparison with the Taobao product

80. The respective designs are below. Again, I have taken the images from the table in the statement of case, as these are clearer:

Prior art	Contested design
	



81. I have had to produce some of the overlay in the images (e.g., the word “Gorgeous”). It is clear that this forms no part of the design and I will ignore it in the comparison.

82. The prior art consists of:


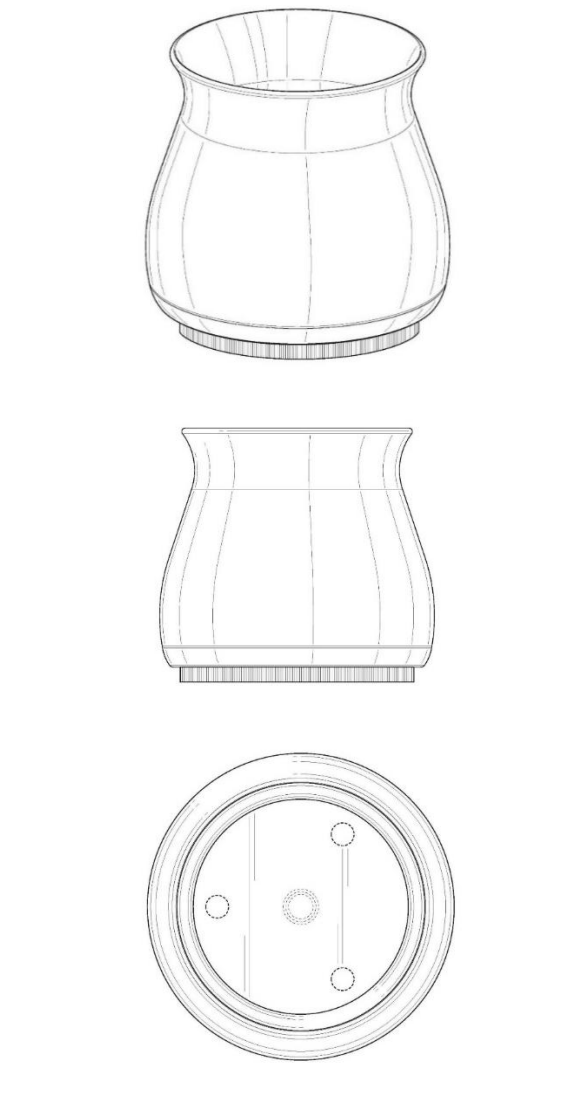
- A tubular body which is slightly narrower at the top than the bottom, which has a neck about one fifth of the way from the top;
- A lip at the top which flares out from the neck in a straight line and which has a ridge at the top edge;
- Sides which extend outwards from the neck to the base in a straight line;
- At the bottom of the design, the side walls straight to vertical, or very slightly curved, before curving round underneath to the base;
- A horizontal line approximately one tenth up from the bottom of the product, which circles around the product and which appears to be slightly raised (giving the impression of a joint between body and base);
- An unclear number of circular protrusions evenly spaced on the inner surface of the base. These will not be visible once the product is fitted to a furniture leg.

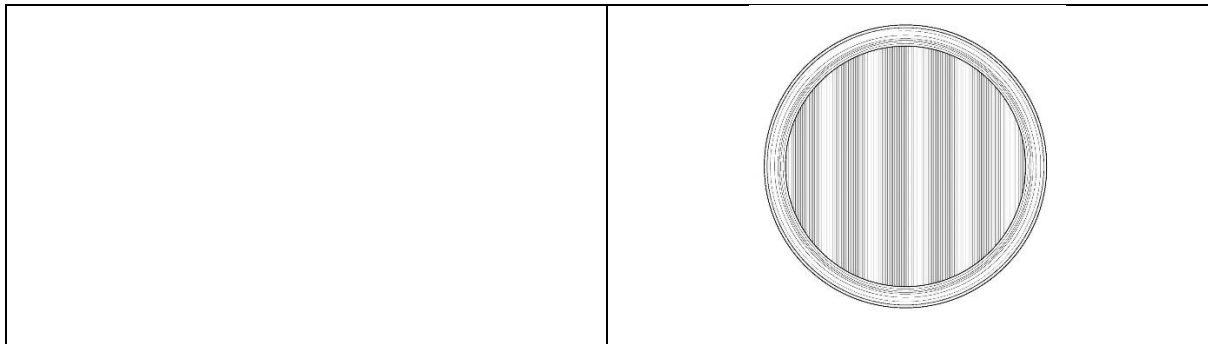
83. I do not consider that this product destroys the novelty of the contested design. The straight side walls are an obvious, not an immaterial difference.

84. I also consider that straight side walls and absence of a base section distinct from the rest of the product give the contested design a different overall impression from that of the prior art.

Comparison with the amazon.de product

85. These are the designs to be compared:

Prior art	Contested design
 <p>The prior art section contains several images of a product. At the top, there are four images of the product in different sizes, labeled 'gest', 'Large', 'Small', and 'Smallest', with their respective dimensions. To the right is a small inset showing 'Round leg' and 'Square leg' options. Below these are three images of the product with different leg shapes: 'Round shape', 'Square shape', and 'Irregular shape'. A text box states 'Strong stretching is great for different shapes and size legs'. At the bottom, three images show the product from different angles, with a text box stating 'No more noise and scratches on the tile/hardwood'.</p>	 <p>The contested design is shown in three line drawings. The top drawing is a front view showing a rounded, bulbous shape with a flared top and a textured base. The middle drawing is a side view showing the same shape from a different angle. The bottom drawing is a top-down view showing the circular shape of the product with a central circular element and two smaller circular elements on either side.</p>



86. As with the above design, I approach this on the basis that the overlay forms no part of the prior art.

87. The representations of this prior art are not terribly clear. The applicant says that this product is “practically identical” to the ’581 design and it relies on the submissions made in relation to the registered design. I would assess the features of the prior art as follows:

- A tube-shaped body which is very slightly wider at the base than the top;
- A neck close to the top from which there is a straight line outwards and upwards forming a lip;
- Straight sides which angle down and out to the bottom;
- A curved section from the widest part of the body (near the bottom) to a base piece;
- A thin disc forming the base. This is not visible from the slightly angled side views.

88. The proprietor says that the base of the design is textured (felt). This is not apparent from the representations in evidence. The proprietor also says that the inside of the product has an array of dots. This is just about visible if the representations are viewed under magnification. However, as with the designs compared above, neither the underside of the products nor the inside will be visible once fitted to furniture so differences in these parts of the design have limited weight. The brown colour of the prior art is also not relevant, the contested design being protected only for the shape (and visible surface decoration) not a particular colour.

89. The designs differ in the shape of their side walls. The longest section of the sides in the prior art is straight, whilst that in the contested design is obviously curved. The contested design is new.

90. In my view, the designs also convey different overall impressions. The prior art is an angular design, with the sides extending outwards in straight lines from the neck. In addition, although the view which shows the base of the design appears to show a base of similar proportions relative to the width of the body as in the contested design, when the angled side views of the respective designs are compared, which appear to be from the same or very similar angles, the base is not visible in the prior art, whereas it is in the contested design. This suggests that the base of the prior art is thinner relative to the overall height of the earlier product. It is, however, not possible to be certain given the quality of the representations. I acknowledge that the image of the product applied to an “irregular shape” leg appears to show that where the body meets the base there is a straight line from the base piece to where the body flares out. However, the other two images do not show this and I conclude that the shape in the right-most illustration is determined by the leg the product surrounds, not the product itself. The designs convey a different overall impression.

Conclusion

91. The contested design is new and has individual character compared with the prior art. The application for invalidation is rejected and design number 6194241 will remain registered.

Costs

92. The proprietor has been successful and is entitled to an award of costs. I award costs as follows, bearing in mind that the evidence was very light:

Considering the application and filing the counterstatement:	£300
Filing evidence:	£400
Total:	£700

93. I order Xiaohong Lin to pay DaVinci II CSJ, LLC the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of July 2024

Heather Harrison

For the Registrar,

The Comptroller-General