

O/0733/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF

REGISTERED DESIGN NO. 6172051

IN THE NAME OF

THE VAULT MART LTD

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 131/22

BY ADONIS CONSULTING LTD

Background and pleadings

1. Registered design number 6172051 (“the contested design”) was filed on 26 October 2021 (“the relevant date”) and was registered with effect from the same date. It stands in the name of The Vault Mart Ltd (“the proprietor”). These are the illustrations showing the contested design:



2. The product indication is given as “coat hooks” and the design is registered as “tools and hardware”, “fastening, supporting or mounting devices not included in other classes” in class 08-08 of the Locarno classification system.

3. On 6 September 2022, Adonis Consulting Ltd (“the applicant”) applied for the registration of the design to be declared invalid under s. 1B, given effect by s. 11ZA(1)(b), of the Registered Designs Act 1949 (“the Act”). The applicant says that the contested design is not new, nor does it have individual character, compared to other designs made available prior to the relevant date. In particular, the applicant relies upon products made available on www.amazon.co.uk as early as 2017.

4. The proprietor filed a counterstatement denying the grounds for invalidation in full.

5. Only the applicant filed evidence. Neither party asked to be heard, nor did either party file written submissions in lieu. This decision is made following a careful reading of all of the papers.

6. The applicant is represented by United Legal Experts. The proprietor is an unrepresented litigant.

Preliminary issues

7. The proprietor makes a number of points in its counterstatement which it is convenient to address here. The first is its assertion that because the design has been registered the proprietor has fulfilled all of the requirements of the Act and is entitled to all of the rights arising from registration. However, the rights conferred by registration are not immune to challenge, as shown by the fact that it is permissible to apply to invalidate a registered design. The proprietor also says that the applicant should have objected earlier but there is no means by which a third party can object to the registration of a design before registration. It is, accordingly, not possible for third parties to prevent registration and an application for invalidation once the design has become registered is the only way in which a third party can remove an invalid design from the register. The applicant cannot be criticised for taking the only course available to it.

8. The proprietor also complains that the applicant did not object to the registration until the proprietor attempted to enforce its rights by making a complaint to Amazon. I see nothing untoward in the applicant's conduct. The law permits any party to apply to invalidate a design but if the applicant's ability to trade has been materially affected by the proprietor's assertion of its rights there is a clear reason for the applicant to seek invalidation of this particular design: it is not a "retaliatory" application in the sense that it is unrelated to an existing dispute between the parties. On the contrary, the contested design appears to have been the right relied upon to prevent the applicant's trade. Nor is the fact that the applicant did not apply to invalidate the contested design until the proprietor asserted its rights indicative of the applicant not having "clean hands", as the proprietor asserts. There are many reasons why the applicant may not have sought invalidation earlier, among which is a lack of awareness of the existing registered design. It is not wrong of the applicant to seek to invalidate the design on the grounds that the monopoly should never have been granted, and the claims made in the statement of case are not vexatious or obviously hopeless. Accordingly, the claim of invalidity must be assessed on its merits.

Evidence

9. The applicant filed evidence with its statement of case. The statement of case contains a statement of truth and it is signed by Shahzaib Amin Malik. The evidence is therefore his. The evidence shows website prints of the two products said to constitute prior art.

10. Mr Malik also filed evidence during the evidence rounds. It is not presented in the usual format of a witness statement and exhibits. It is a document headed “evidence and submissions” but it contains a statement of truth and is signed and dated. Although unusual in format, this material is Mr Malik’s evidence and I will treat it as such. It consists of further prints from www.amazon.uk regarding the two designs relied upon, including customer reviews.

11. I have read all of the evidence and will return to it as necessary.

The law

12. 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.”

13. 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) [...]”

14. 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. This is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Prior art

The Homepих design

15. The first design relied upon is shown in a print from www.amazon.co.uk.¹ The image below is taken from the statement of case, which is a better copy of what appears to be the identical image on the www.amazon.co.uk print:



16. The print records a “date first available” of 26 November 2019. There is also a review from a customer in the UK dated 13 August 2020.² Both of these precede the relevant date.

17. There does not appear to be any dispute that the above product was made available to the public prior to the relevant date in accordance with s. 1B(5). In any

¹ Statement of case, §9 and exhibit 2.

² Evidence document, §1.

event, I am satisfied that the above designs were disclosed prior to the relevant date. None of the exceptions in s. 1B(6) applies.

The Dripex design

18. Mr Malik provides a second print from www.amazon.co.uk which shows the following image:³



19. This print gives a “date first available” of 7 December 2017. There is an additional image in the fixing instructions, as follows (re-oriented for ease of viewing):



20. There are also provided reviews for this product from customers in France and Spain from 2019 and 2020, respectively.⁴ I am satisfied that this design was also disclosed to the public prior to the relevant date and that it qualifies as prior art. Again, none of the exceptions in s. 1B(6) applies.

Additional prior art

21. The statement of case includes a second image of a Dripex design, as follows:



³ Statement of case, §10 and exhibit 3.

⁴ Evidence document, §2.

22. The statement of case says that this is a design “since 2019”. However, there is nothing to show where or how this design was made public or to corroborate the date of publication. This design does not qualify as prior art.

23. In his evidence, Mr Malik provides additional reviews, with images, from www.amazon.co.uk and www.amazon.com.⁵ All of the reviews pre-date the relevant date. The products in question are shown below:



24. I accept that these products were disclosed to the public prior to the relevant date. However, none was pleaded as a novelty-destroying design in the statement of case.

Approach

25. I will focus on the Homephix and qualifying Dripex designs, since they are, in my view, the closest to the contested design. If the application for invalidity fails based on those designs, it would also have failed in relation to the other earlier designs, including those shown at paragraph 23, above.

⁵ Evidence document, §§3-4.

Novelty

26. 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.”

27. These are the illustrations of the contested design:



28. This is the Homepfix prior art:⁶



29. There is a difference between the designs because the contested design features five hooks and the Homepfix design has six. This is not an immaterial difference. The contested design is new compared with the Homepfix design.

30. The Dripex design is as follows:⁷



31. The Dripex design has six hooks, whilst the contested design has five. This is not an immaterial difference and the contested design has novelty compared with the Dripex design.

Individual character

32. A design may still be new but still lack the necessary individual character compared to the prior art. In *Safestand Ltd v Weston Homes PLC & Ors* [2023] EWHC

⁶ This image is taken from the body of the statement of case, as it is clearer.

⁷ This illustration is also taken from the body of the statement of case, as it is a better representation.

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.”

33. I also bear in mind the comments of HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat) at [58]:

“How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of ‘different overall impression’ is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The sector concerned

34. The sector is that of coat hooks and related home storage accessories.

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

35. In *Samsung*, HHJ Birss described the informed user in the following terms:

“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).”

36. The informed user is a homeowner or other individual such as a renter or landlord who wishes to find a storage solution for a home. They exhibit all the traits set out in the case law quoted above. I see no circumstances or particular characteristics of the products that would make it impractical or unusual for the informed user to conduct a direct comparison of the designs in issue.

Design corpus

37. As an “informed” user, the user is aware of the products and designs which already exist in the marketplace. This includes all of the earlier designs considered above. Other than this, there is no evidence of the design corpus.

Design freedom

38. In *Dyson Ltd v Vax Ltd*, [2010] FSR 39, Arnold J (as he was then) stated at [34] that:

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

39. Coat hooks require at least one hook so that they can fulfil their intended purpose of hanging coats. They also need to have some means of fixing to the wall and, where the design is for multiple hooks as one unit, a way of joining the hooks to one another.

40. However, there remains considerable scope for design freedom. The designer may choose the shape of the backing piece which joins the hooks together, as well as its dimensions relative to the hooks. There is also choice about the placement of the hooks on the backing piece (e.g., in a straight line or staggered). In the case of hooks incorporating a hat hook and coat hook, as in the designs in question, the presence of these elements achieves a technical end. However, beyond the constraints imposed by the requirement for two hanging elements on one hook, the exact shape of the hook (e.g., whether it is curved or angular) is a design choice. The shape of the metal length used to fashion the hook is also subject to a reasonable degree of design freedom, as it may be cylindrical, rectangular or another shape (e.g., oval) in cross-section; similarly, the hook may present when viewed face-on as straight or, for example, an inverted teardrop shape.

Comparison of the designs

41. The contested design consists of the following features:

- (i) A flat oblong backing plate with slightly rounded corners, longer than it is high. The first image, which is the clearer of the two, shows it an equal thickness from top to bottom. As for its depth, it is thin compared to its height and width;

- (ii) Five hooks attached to the oblong, centred on it and evenly spaced along its length;
- (iii) The ends of the oblong extend beyond the outermost hooks by approximately one third of the length of the space between the hooks;
- (iv) The hooks have a flat section where they are fixed to the oblong piece. This section is flush with about half the height of the oblong;
- (v) The upper part of the hooks curves out from the flat central section into straight piece at approximately a 45° angle from the oblong;
- (vi) The lower portion of the hooks curves down and round at the bottom, then upwards at an approximately 30° angle;
- (vii) The bottom part of the hooks is straight at its outermost end;
- (viii) The sides of the hooks are flat, as if a long, thin oblong piece of metal has been bent into shape. Their ends are slightly curved;
- (ix) The base hook protrudes slightly less than the top hook;
- (x) Two cylindrical fixings (or covers for the fixings) placed halfway between the outermost hooks. These have a technical function and will not be given any, or any significant, weight in the comparison;
- (xi) Etching at the bottom right of the oblong which reads “SUS 334”.

Comparison with the Homephix design

42. The Homephix design features:

- (i) A long, thin oblong backing plate, longer than it is wide, with rounded corners;
- (ii) Six hooks, attached to the oblong, evenly spaced;
- (iii) The ends of the oblong extend beyond the outermost hooks approximately one fifth of the length of the space between the hooks;

- (iv) The hooks curve at the top of the oblong, protruding in a straight line at an approximately 45° angle;
- (v) The hooks have a straight piece in the centre which is the full height of the oblong to which they are attached;
- (vi) The hooks curve out and down from the bottom of the backing plate, then up at an approximate 45° angle;
- (vii) The hooks have flat sides and curved ends;
- (viii) The lower curve of the hooks protrudes slightly further than the upper straight piece;
- (ix) The word “homephix” and a device is visible at the bottom right of the oblong, to the inside of the outermost hook;
- (x) There are three holes, placed halfway between the central hooks and the first/second and fifth/sixth hooks. These have a technical function and are unlikely to be given weight.

43. There are certain similarities between the designs, in particular the size of the backing oblong is similar relative to the overall height of the hooks and the hooks of both designs are fashioned from rectangular lengths with rounded ends. However, there are also differences. Most obviously, the contested design has one less hook than the Homephix design. In addition, the hooks differ in shape, with the contested design having what appears to be a proportionately longer hat hook relative to the coat hook, and a coat hook which has a less curved appearance than that of the Homephix design. Even bearing in mind the design freedom available, I consider that the above differences are sufficient to give the contested design a different overall impression from the Homephix design.

Comparison with the Dripex design

44. The features of the Dripex design are as follows:

- (i) A flat oblong backing plate with slightly rounded corners, longer than it is high. It is thin compared to its height and width;
- (ii) Six hooks attached to the oblong, centred on the oblong and evenly spaced along its length;
- (iii) The ends of the oblong extend beyond the outermost hooks by approximately one third of the length of the space between the hooks;
- (iv) The hooks have a flat section where they are fixed to the oblong plate. This section is flush with the full height of the oblong;
- (v) The upper part of the hooks curves out from the flat central section into straight piece at approximately a 50° angle from the oblong;
- (vi) The lower portion of the hooks curves down and round at the bottom, then straightens and points upwards at approximately a 60° angle;
- (vii) The sides of the hooks are flat, their ends slightly curved;
- (viii) The base of the hooks protrudes slightly more than the top;
- (ix) Two holes, centred between the second/third and fifth/sixth hooks;
- (x) Etching at the bottom right of the oblong which reads “304”;
- (xi) It also appears that this design includes round metal fixings/caps for the fixings.

45. The Dripex design has six hooks. That is a material point of difference, as I have already held. In addition, the curve at the base of the Dripex hooks is quite tight compared with that of the contested design and ends with a steeper angle. Although the designs have some similarities, in particular the rectangular profile of the hooks and the attachment on to a base plate of similar dimensions relative to the hooks, I

consider the differences identified above outweigh the similarities and give the contested design individual character when compared with the Dripex design.

46. The contested design has individual character compared with both earlier designs. I would add that, if I am right in holding that the registered design is validly registered, the use of a design corresponding to the identified prior art will not infringe the registered design. If I am wrong about that then the registered design is invalid.

47. As I have already indicated, the other prior art is no more similar to the contested design. The application for invalidation is dismissed accordingly.

Conclusion

48. The contested design is new and has individual character compared with the prior art. The application for invalidation is rejected and design number 6172051 will remain registered.

Costs

49. The proprietor has been successful and would ordinarily be entitled to an award of costs. However, as an unrepresented litigant, the proprietor was invited to file a costs pro forma giving a breakdown of its costs. It was advised that a failure to file the pro forma may result in no costs other than official fees being awarded. The proprietor did not file a costs pro forma and incurred no official fees. I direct that the parties bear their own costs.

Dated this 2nd day of August 2024

Heather Harrison

For the Registrar,

The Comptroller-General