

**O/0787/24**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 6194678**

**IN THE NAME OF FANCY-IT AGENCIES LTD.**

**IN RESPECT OF THE FOLLOWING DESIGN**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 31/23)**

**BY TRADELINK GLOBAL LIMITED**

**(FORMERLY STERUN LTD)**

## Background and Pleadings

1. Fancy-it Agencies Ltd. (“the registered proprietor”) filed Application No. 6194678 for a registered design for a clothes hanger in Class 06 (Furnishing), Sub class 08 (Clothes hangers) of the Locarno Classification on 2 March 2022 (“the relevant date”). It was registered on 11 March 2022 with effect from the relevant date and was published on 12 March 2022. 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 3 April 2023, denying the applicant’s claims. In particular, it states that it created the design and its moulds a few years beforehand but 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 they were “*all supplied by myself after contracting a manufacturer in India to produce the same*”. It also claims that the design was accepted for registration “*after due diligence*”. It then goes on to assert that the designs are different 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 Sunil J Desai.

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 Issue**

7. The registered proprietor disagrees with the applicant's claim that the contested design lacks originality, on the grounds that "*the design was successfully registered and approved by the IPO after due diligence*". 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.

### **Decision**

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

"The registration of a design may be declared invalid—

...

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

9. Section 1B of the Act is as follows:

"(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into account.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if—

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if—

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the geographical area comprising the United Kingdom and the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of

information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above ‘the relevant date’ means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

...”

10. 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.

### ***The Contested Design***

11. 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.

12. 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. ...”

13. 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**

14. The applicant claims that there are five 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
	<p>Seller: Keplin Plastic Hangers            ASIN B07D9V8VNQ            Date first available: 25 May 2018</p>
	<p>Seller: Ariana Homeware            ASIN B07B9M1VSF            Date first available: 5 August 2017</p>
	<p>Seller: RelianceUK Plastic Hangers            ASIN B07WSK46V1            Date first available: 17 August 2019</p>
<p><b>PERFECTLY SIZED HANGERS</b>            Slim body saving your space and time</p> 	<p>Seller: Nyxi Plastic Clothes Hangers            ASIN B07HX23KM3            Date first available: 20 September 2018</p>

Design	Details
	<p data-bbox="774 253 1385 286">Seller: Hangerworld Black Plastic Hangers</p> <p data-bbox="774 309 1054 342">ASIN B00ELU8WI2</p> <p data-bbox="774 365 1286 398">Date first available: 16 August 2013</p>

15. 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.

16. 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 Desai 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."

17. 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 Desai does not explicitly say is that the contested design was made available to the public before registration. He does, though, claim that the earlier designs relied on by the applicant are variations of the contested design, which might imply that it 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.



18. 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**


19. 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*

20. I shall begin with the second and fourth earlier designs relied on by the opponent, i.e. the hangers sold by Ariana Homeware and by Nyxi Limited.

The Registered Design	The Prior Art
	The Ariana clothes hanger: 

The Registered Design	The Prior Art
	<p data-bbox="810 255 1166 286">The Nyxi clothes hanger:</p>  <p data-bbox="826 367 1182 412"><b>PERFECTLY SIZED HANGERS</b> Slim body saving your space and time</p> <p data-bbox="815 472 1193 725">The drawing shows a triangular hanger with a hook at the top. Dimensions are: height 21cm (8.3"), hook height 21cm (8.3"), base width 27cm (10.6"), and base depth 21cm (8.3"). A circular logo with a stylized 'J' is also shown.</p>

21. 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 just to the left of 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 triangular structure and hook are made from relatively thick lengths of dark blue material. The colour has not been disclaimed so this is a factor I must take into account.

22. The Ariana hanger shares features (i) to (iii) and (v) to (vi) with the contested design. The proportions look to me to be identical, or at least highly similar. Turning now to the differences, I note that the hook at the top of the contested design is slightly offset to the left while the hook at the top of the earlier design is placed at the centre of the triangle. In addition, the lengths of material from which the Ariana hanger is made appear slightly thinner and the straight end of the hook is shorter. I consider that these are minor differences that do not affect the overall appearance of the hanger. However, it is my view that the user would notice the difference in colour between the dark blue contested design and the black Ariana hanger.

23. The lengths of material in the Nyxi hanger appear to be of the same thickness as those of the contested design, but the Nyxi hanger is also black, as indeed are all the earlier designs relied on by the applicant. I have already found that the user would notice the difference between the colours of the designs. I find that the contested design is new compared to all these earlier designs.

### ***Individual Character***

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

25. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are to intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user’s awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

- (3) Decide the designer's degree of freedom in developing his design;
- (4) Assess the outcome of the comparison between the RCD and the contested design, taking into account
- (a) the sector in question;
  - (b) the designer's degree of freedom, and
  - (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

26. 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):

“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*

27. The sector is that of clothes hangers and clothes storage more generally.

*The informed user*

28. In *Samsung Electronics*, HHJ Birss QC (as he then was) gave the following description of the informed user:

“33. ... The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court form 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, *Shenzhen* paragraph 46);

ii) however, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) he has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) he is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which makes 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).”

29. The applicant submits that the informed user should be deemed to be an individual familiar with clothes hangers and that I should assume that the informed user can make a direct comparison between the designs to be compared. I agree.

#### *The design corpus*

30. The “design corpus” is the term used to refer to the body of designs that already exists and of which the informed user is deemed to be aware. There is no evidence of any other designs of clothes hangers than the earlier designs relied on by the applicant.

#### *Design freedom*

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

“34. ... 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).”

32. The applicant submits in its statement of case that a designer of clothes hangers has an “*almost unlimited*” degree of design freedom:

“23. ... The only relevant restriction when producing a clothes hanger is to create something which can hang clothes, usually whilst hooked onto a bar.”

33. The technical function of the product is to hang the clothes in a way that minimises any creases to the garments. Consequently, for clothes intended to be worn on the upper body, the hanger would be expected to be symmetrical with some downwards

sloping from the centre to reflect the position of the neck and shoulders. The hanger would also need to have a means of attaching it to a hook or a bar in a wardrobe or retail environment. Within these constraints, the designer has some freedom with regards to the degree of sloping; whether to include a base piece, clips or hooks; whether, if there is a base piece, the corners are rounded or angular; the thickness of the hanger; its colour; the precise shape of the hook used for attaching the hanger to the bar or hook, and whether it is part of a single piece or is a part, possibly of a different material and/or thickness, which is fixed to the main body of the hanger.

#### *Overall impression of the designs*

34. I have already compared the separate features of the contested design with the Ariana hanger and the Nyxi hanger. I shall not repeat what I have said in paragraphs 21 to 23 above, but note that it was the difference in colour that resulted in my finding that the contested design was new compared to these two earlier designs. What I must therefore do is weigh up the contribution the colour makes to the overall impression of the contested design, as opposed to the other features that are identical or very similar to those of the earlier design. In its statement of case, the applicant submits that:

“23. ... the blue used in the Contested Design is irrelevant when assessing whether the Contested Design has individual character; clothes hangers can be produced in a variety of colours, resulting in the informed user not paying attention to such immaterial features.”

35. It is my view that the overall impression of all the designs rests largely in their configuration and proportions. The proportions of the contested design and the Ariana hanger are highly similar. Noticing the difference in the placement of the hooks (slightly offset to the left or at the centre of the triangle), the length of the straight end of the hook, and the thickness of the sides of the triangle would require the kind of minute scrutiny that HHJ Birss QC (as he then was) said was not the right approach. I consider that the informed user is likely to notice that one is blue and one is black, but that this will be a minor factor when weighed against the configuration and proportions of the hanger. I find that the contested design does not have individual character compared to the Ariana clothes hanger.

## **Conclusion**

36. The application is successful and Registered Design No. 6194678 is declared invalid.

## **Costs**

37. The applicant has been successful and in the circumstances is entitled to a contribution towards the costs of the proceedings 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.

38. I order Fancy-it Agencies Ltd 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 16<sup>th</sup> day of August 2024**

**Clare Boucher**

**For the Registrar,**

**The Comptroller-General**