

**BL O/0838/24**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN No. 6144642  
IN THE NAME OF MADIMAH LIMITED**

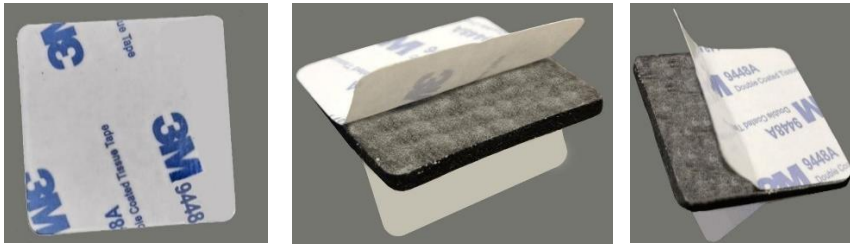


**AND**

**THE APPLICATION FOR INVALIDATION THERETO (No. 102/23)  
BY MUHAMMAD ASGHAR ALI**

## Background and pleadings

1. Madimah Limited (“the proprietor”) filed application no. 6144642 for a registered design for “double sided sticky pads” in Class 19, Sub class 8 of the Locarno Classification (other printed matter) on 24 June 2021. The design was registered with effect from that date (“the relevant date”) and is depicted in the three representations shown below.



2. The registration specifies the following disclaimer:

“No claim is made for the Logo and text that appear in each representation.”

3. On 9 May 2023, Muhammad Asghar Ali (“the applicant”) requested that the registered design be declared invalid under Section 1B/11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which requires that a registered design be new and have individual character. The substance of the claim is as follows:

“The design 6144642 was not new when it was approved and registered in the United Kingdom. The is a generic product being sold for many years now. One of the best way [sic] to support my claim is the Date First Available on Amazon for one of the sellers which is 20 April 2018 (see attached pdf evidence...) Whereas the design 6144642 was registered on 24 June 2021.”

4. Evidence of the claimed prior art was attached to the application for invalidation, which I will reproduce later in this decision.<sup>1</sup> This was the only evidence filed by the applicant.

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<sup>1</sup> The document filed with the applicant’s statement of case constitutes evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (as amended).

5. A notice of defence and counterstatement was filed by the proprietor, denying the claim. In short, the proprietor claims that the contested design is different to the claimed prior art, stating:

“Prior to the introduction of our product with its distinctive round corners, no other publicly available product existed that incorporated such design features. The existing products in the market at that time all featured 90-degree corners, and our innovation in introducing rounded corners was not only unprecedented but also not protected by any prior patent or available for sale before our introduction.”

6. Both parties represent themselves. Only the proprietor filed evidence during the evidence rounds, evidence which has no relevance to the assessment I must make. It consists of a very short witness statement by Raja Karim, the proprietor’s Managing Director, and five exhibits.<sup>2</sup> Mr Karim explains that Exhibit 1 is the proprietor’s Amazon product listing page which he states shows the launch of his company’s product. It does not show the launch of the product because the ‘date first available’ has been blanked out (redacted). It is the comparison between the registered design and the prior art which is key, not what the proprietor has sold. For the same reason, Exhibits 2 and 3, which comprise the proprietor’s sales reports, are not relevant; nor is the proprietor’s website from where it has sold the product since 2021 (which also contains redacted text). Finally, Exhibit 5 comprises the proprietor’s official complaint to Amazon. It is not relevant, not least because it is about a product which is not shown and about a company which does not appear to be the applicant.

7. Neither party has filed written submissions and neither party wished to be heard. I make this decision after careful consideration of all the papers filed.

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<sup>2</sup> Dated 29 November 2023.

## Decision

8. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground that it was not new or that it did not have individual character on the date on which it was filed (section 1B). Section 11ZA(1)(b) reads:

“(1) The registration of a design may be declared invalid

(a)...

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

9. Section 1B reads:

“(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 condition 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 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) .....

(9) ....”.


### Claimed prior art

10. The alleged prior art which was attached to the application for invalidation is an undated print from Amazon, the relevant parts of which are:

Hardware › Adhesives & Sealers › Tape › Mounting Tape



Roll over image to zoom in



**Double Sided Sticky Pads Black, 50 Pcs Adhesive Foam Pads Mounting Pads, Squares and Round**  
Brand: Auroral  
4.2 ★★★★★ 7,174 ratings  
Amazon's Choice for "mirror adhesive pads"

**Currently unavailable.**  
We don't know when or if this item will be back in stock.

Pattern Name: **Black Square+Round**

<b>Black Square+Round</b> 1 option from £3.99	Black Square+White Round 1 option from £4.27
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- ♥ [2 SHAPES & 2 SIZES] This double sided foam pads has 2 shapes—square & round, square foam pad size is 1.57x1.57inches / 4x4cm(LxW), round foam pads size is 0.98inches / 2.5cm in thickness.
- ♥ [50 - IN - 1 PACKAGE] The package includes 50 pcs double sided adhesive pads.20 pcs of square, 30 pcs of round, different shapes and colors can meet your various needs.
- ♥ [STRONG & DURABLE] Our double adhesive sticky pads are made of good quality EVA foam , can stick very well and provide long servicing life.
- ♥ [MULTI-FUNCTIONAL] These double sided foam tape are perfect for sticking together a wide variety of similar and dissimilar materials such as paper, wood, metal, glass, paint plastic and more.
- ♥ [CUSTOMER SERVICE] Any question, feel free to contact us and we will reach you at the soonest.Tips: Suitable for light and small products. Heavy weight is not recommended.

› See more product details

**Customer ratings by feature**





























Lightweight ★★★★★ 4.3

## Product information

### Technical Details

Manufacturer	Auroral
Part Number	022-Foam Pad-B
Package Dimensions	19.5 x 15 x 1 cm; 50 Grams
Item model number	2021-01FU-4-12209
Size	2 size - double sided sticky pads
Colour	Black - Double Sided Sticky Pads
Material	EVA
Pattern	Black Square+Round
Shape	Square
Thickness	0.12 Inches
Item Package Quantity	1
Measurement System	Metric, Imperial
Batteries included?	No
Batteries Required?	No
Item Weight	50 g

### Additional Information

ASIN	B07C6F7G3W
Customer Reviews	4.2                            

14. In *Safestand Ltd v Weston Homes PLC & Ors* 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:<sup>3</sup>

“(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

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<sup>3</sup> [2023] EWHC 3250 (Pat)



(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.”

15. The sector is the market for adhesive items of stationery.

16. The next consideration is the informed user. HHJ Birss QC (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) observed that:<sup>4</sup>

“ ... 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.”

17. HHJ Birss QC also gave the following detailed summary of the characteristics of 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 Inc v Grupo Promer Mon Graphic SA* (C-281/10 P) [2012] FSR 5 at [53]-[59] and also in *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-9/07) [2010] ECR II-981; [2010] ECDR 7, (in the General Court from which *PepsiCo* [2012] FSR 5 was an appeal) and in *Shenzhen Taiden Industrial Co Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (t-153/08), judgment of June 22, 2010, not yet reported.

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<sup>4</sup> [2012] EWHC 1882 (Pat)

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* [2012] FSR 5 at [54] referring to *Grupo Promer* [2010] ECDR 7 at [62]; *Shenzhen* (T-153/08) at [46]);

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* at [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* at [59] and also [54] referring to *Grupo Promer* [2010] ECDR 7 at [62]);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* at [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* at [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* [2012] FSR 5 at [59]).”

18. The informed user in the present proceedings is a member of the public with an interest in adhesive items of stationery, particularly those in the form of adhesive pads. The informed user will pay an average degree of attention because whilst there may be an aesthetic choice to be made as to whether the adhesive pad remains visible, and a decision about how adhesive it is, these are everyday products. 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; in fact, the evidence of both parties shows the respective products on Amazon.co.uk. Direct comparisons of the designs are, therefore, likely to be made.

19. As the case law states, the informed user will have knowledge of the design corpus. This means that they will be aware of current trends in the design of adhesive pads. This factor can be significant if an earlier design was markedly different from what has gone before and so is likely to have a greater visual impact: see *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited*.<sup>5</sup> However, the applicant has only provided one example of prior art, and the proprietor has stated only that all the existing products in the market when it launched its product had 90-degree corners, so there is not really any evidence of the design corpus.

20. In *Dyson Ltd v Vax Ltd*, Arnold J (as he was then) stated that:<sup>6</sup>

“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).”

21. The applicant's evidence shows that double-sided adhesive pads are variously shaped, such as round and square. They could be rectangular, oval, triangular, hexagonal and so on. Generic pads will be of a regular shape (i.e. discounting pads of irregular shape made for a specific, bespoke item) and a square or round shape would appear to be the most universally useful for general items, such as mounting household items to a surface. There is a finite range of generic shapes. The size of the product is not referred to in the contested design, but there would seem to be no reason why there could not be a broad range of sizes for such products. For the product to work as a double-sided adhesive pad, there must be a peelable covering or film on each side of the product. This is a design constraint. For pads of a rectilinear

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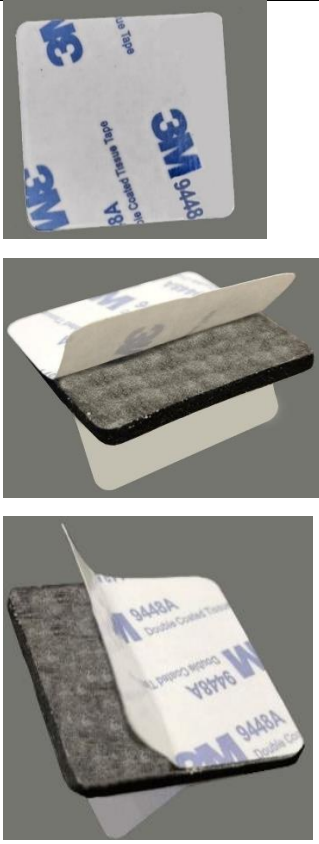
<sup>5</sup> Paragraph 35(iii).

<sup>6</sup> [2010] FSR 39

shape, there will be corners. The product is relatively simple, with few features. Overall, there is a moderate, but not a great, degree of design freedom.

22. As the verbal element in the contested design has been disclaimed, this forms no part of the comparison.

Comparison of the prior art and the contested design

Claimed prior art	Contested design
	

23. The part of the prior art which is relevant for the comparison is clearly the square adhesive pads, shown as a pile and as a single item. I will compare these with the contested design and ignore the round pads because they are not relevant.

24. The first illustration in the registered design would seem to have little relevance because the design registration expressly disclaims the logo and text and this is all that is visible, apart from the fact that they appear on a pale square with rounded edges. There is an obvious difference between the prior art and the other design two

illustrations which is that the latter show the adhesive pad with the protective wrap or film peeled back on both sides, whereas the prior art does not. I can see in the prior art that the (same) protective wrap covers the entirety of the pad, as it does in the design, and that there is a thicker black pad between the upper and lower wrap. The wrap is necessary for the product to function: if it were not there, the pad would stick to anything to which it came in contact, whether it was meant to or not; and the wrap preserves the adhesiveness of the pad until it is deliberately removed to use the pad. As said earlier, this is a design constraint; and there must be an upper and lower peelable wrap because the pad has adhesive on both sides.

25. The difference to which the proprietor draws attention in its counterstatement is that the contested design has rounded corners whereas the prior art has 90-degree corners. The proprietor states that all the existing products in the market when it launched its product had 90-degree corners (it refers to launch rather than the creation or application for the design). There is no evidence of this, which would have helped the assessment of the design corpus. Nevertheless, it is indeed a difference between the prior art and the contested design which I consider to be an important difference. This is because the products are very simple, with few features, and some of those are necessary to obtain a technical result; i.e., the double peelable wrap protecting the upper and lower adhesive sides of the pad. The corners of the prior art are 'sharp', 90-degree corners. The corners in the contested design are rounded. This is likely to make an impression on the informed user because an aesthetic choice may move the informed user to choose either the rounded corner product or the sharper cornered product. Returning to *Samsung Electronics (UK) Ltd v Apple Inc*, these differences and similarities will be observed by the informed user who pays attention to detail. The differences and similarities will not be picked up only through minute scrutiny. Taking all of the above into account, including the weight of the similarities and differences and the degree of design freedom in relation to the various elements, I conclude that the proprietor's design produces a different overall impression on the informed user compared to the prior art. I find that the proprietor's design had individual character at the relevant date.

## **Novelty**

26. 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.”

27. Since I have found that the contested design has individual character, it follows that it differs from the prior art in a material respect. This means that the contested design is new.

## **Final remarks**

28. It is important for the parties to understand that, if I am right in holding that the registered design is validly registered because of the differences compared to the prior art, the use of a design corresponding to the identified prior art will not infringe the registered design because of those differences. If I am wrong about that then the registered design is invalid.

## **Outcome**

29. The contested design has individual character when compared with the prior art and so the application for a declaration of invalidity fails. Design No. 6144642 remains registered.

## **Costs**

30. The proprietor has been successful and is entitled to a contribution towards its costs. As the proprietor is unrepresented, in its letter to the proprietor of 11 January 2024, the Tribunal said:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk).

If there is to be a “decision from the papers” this should be provided by **8 February 2024**.

If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the proforma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

31. No cost pro forma has been received to date. Since the proprietor did not file a cost pro forma, and as it has not incurred any official fees in defending its design registration, I make no order as to costs.

**Dated this 30<sup>th</sup> day of August 2024**

**Judi Pike**

**For the Registrar,**

**The Comptroller-General**