

**O/0881/24**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 6143659**

**IN THE NAME OF DEBORAH BROWNBILL**

**IN RESPECT OF THE FOLLOWING DESIGN**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 87/22)**

**BY CLAIRE LOCKE**

## Background and pleadings

1. Deborah Brownbill (“the registered proprietor”) filed application no. 6143659 for a registered design for a ‘graphic design’ on 18 June 2021. It was registered on 16 September 2021 for the following:



2. On 1 July 2022, Claire Locke (“the applicant”) made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design lacks novelty and individual character. The applicant claims that an item described as an ‘OLDI MAN Mug Product’ was listed on Amazon and available to purchase from 16 March 2021. The applicant also makes reference to its own design, which it submits was designed on photoshop on 15 March 2021, though registered after the date of the contested design. The following is a picture of that design:



2. The applicant provides a print from its own Amazon inventory. This shows the mug above listed on Amazon. There are six variations, which appear to show the same design, with different colours applied to the handle and interior. Three of the designs are for sale for £11.99, the other three for £9.99. There are more than 750 of each type of mug available. The creation date for each listing is 16 March 2021.

3. The registered proprietor filed a counterstatement to the application for invalidation on 22 December 2022, denying the applicant's claims and arguing that her own design, which features a 'zimmer frame', is different to the cancellation applicant's design, which features the silhouette of a figure with a walking stick.

4. She submits:

*"This design is my own original take on a common theme that has been available to purchase from many sellers for quite a few years. For example, a relative of mine had a similar design on a t-shirt circa 2019. A quick search on Amazon, Etsy, eBay or Google will reveal many similar designs with slight variations."*

5. Neither side filed evidence beyond that which was included with the cancellation application, nor did either side request a hearing.

6. I have taken this decision after a careful consideration of the papers before me.

7. Both parties represent themselves.

## **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.

...”

### **Prior Art**

10. The amazon.co.uk inventory for the product relied on by the applicant indicates that it was first available to the public on 16 March 2021. This date is earlier than the date on which the registered proprietor filed its application to register the contested design and I consider that listing on the Amazon website constitutes publication. It is shown most clearly in the image taken from photoshop dated 15 March 2021 and I can see that the product shown on the dated photoshop page is the same product as the second smaller image listed on the Amazon inventory page, described as OLD-MAN-MUG-BLA-HAN-ONE-PRI.

11. The mug (with black interior and handle) relied on by the applicant is therefore acceptable prior art.

## Novelty

12. 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:

“‘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.”<sup>1</sup>

## Comparison of the designs

11. In the table below I show the registered design alongside the prior art upon which the applicant may rely:

The Registered Design	The Prior Art
	

12. The registered design consists of the following features:

- i) It is a 2D graphic design, not applied to any particular product;

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<sup>1</sup> Paragraph 26.

- ii) It is a rectangle with rounded corners.
- iii) The shorter sides are more than half the length of the longer sides;
- iv) The 'border' is made up of three bands of colour. These are red, surrounded by orange, surrounded by yellow;
- v) The background colour is dark blue;
- vi) The word 'OLDI' is shown at the bottom of the design in a white, plain block typeface;
- vii) A pale blue image is placed above the word. It depicts a front view of a person in a hat, using a walking frame on wheels.

13. The prior art consists of the following features:

- i) It is a mug, with a white body, black handle and black interior;
- ii) The mug has a design on the front face, no other views of the product are provided, so I cannot be sure what the other faces of the mug look like;
- iii) The design applied to the mug is a rectangle with rounded corners.
- iv) The shorter sides are more than half the length of the longer sides;
- v) The 'border' is made up of three bands of colour. These are red, surrounded by orange, surrounded by yellow;
- vi) The background colour is dark blue;
- vii) The word 'OLDI' is shown at the bottom of the design in a white, very slightly stylised, plain block typeface;
- viii) A shaded blue image is placed above the word. It depicts a side view of a simplified person, bending over a walking stick.

14. The fact that the registered design is a two-dimensional design and the prior art is a three-dimensional mug results in more than minor and trivial differences between the two designs. The differences between the figures in the respective designs also result in more than minor and trivial differences. These factors affect the overall appearance of the product and would be noticed by the user. Consequently, I find that the registered design has novelty when compared with the prior art.

## Individual character

15. A design may be 'new', but still lack the necessary 'individual character' compared with 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 with the prior art.

4. 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 [Registered Community Design] 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 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.”

### **The sector concerned and the informed user**

16. The sector concerned is primarily the novelty gift sector – although the registered design is a graphic design that could be applied to any product, it is likely the resulting products would fall into that category. The hypothetical attributes of the informed user are well established in case law. The informed user is not a designer, technical expert or person in the trade, but an individual who buys novelty gift items. They are particularly observant, show a relatively high degree of attention when using the products and are aware of the range of designs available for these products and the features that are normally included in them. Importantly, they conduct a direct comparison of the designs unless there are specific circumstances that mean this is not possible or practical: see *Samsung Electronics*, paragraph 34.

### **The design corpus and the freedom of the designer**

17. Despite the proprietor's comments regarding the number of products of this type that are available, I have no evidence beyond the applicant's Amazon listings attached to its cancellation application. In other words, I have no evidence to show me the design corpus at the relevant date.

18. It is clear that when it comes to novelty/amusing designs applied to gifts, the designer has considerable freedom to choose the imagery. Where the design is applied to an item such as a mug, then the mug will need to hold liquid and will need to have a handle in order to be held by the user. Beyond those requirements, the designer has freedom of side, shape, number and shape of handles and so on.

### **Overall impression**

19. I have already listed the features of the designs in paragraphs 12 and 13 above. I find that the differences in these designs are obvious, one being a 2D graphic design and the other being a mug, featuring a design. However, even if the proprietor's design were applied to a mug, I find that the differences between the style of the figure, its position and configuration and the differences in lettering in each design are such that the registered design has individual character over the prior art. As the informed user is deemed to be showing a relatively high degree of attention, the designs will, in my view, create different overall impressions on that informed user.

### **CONCLUSION**

20. The application for invalidation against Registered Design No. 6143659 has failed and it will remain registered.

**The invalidation against this design has failed under section 1B of the Act.**

### **COSTS**

21. The proprietor has been successful and is entitled to a contribution towards the costs of the proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice 2/2016. As the proprietor is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a proforma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the defence of the action. It was made clear to the proprietor that if the proforma was not completed, no costs other than official fees arising from the action and paid by the successful party would be awarded.

22. The proprietor did not respond to that invitation and has not incurred any official fees in defending its design registration. Accordingly, I make no order as to costs.

**Dated this 11<sup>th</sup> day of September 2023**

**Al Skilton  
For the Registrar,  
The Comptroller-General**