

O/0980/24

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6052187 IN RESPECT OF THE
FOLLOWING DESIGN**



**AND REGISTERED DESIGN NO 6052188 IN RESPECT OF THE
FOLLOWING DESIGN**



BOTH IN THE NAME OF POSH FASHION LIMITED

AND

APPLICATION FOR INVALIDATION (NO 53/19)

BY AHMET EROL

Background and pleadings

1. Posh Fashion Limited (“the registered proprietor”) filed application no. 6052187 for a registered design for a ‘Hoodie/Sweatshirt’ on 16 January 2019. It was registered on 18 January 2019 with effect from the relevant date and was published on 19 January 2019, for the following:



2. On the same date, Posh Fashion Limited filed application no. 6052188 for a registered design for a ‘Hoodie/Sweatshirt’. It was also registered on 18 January 2019 with effect from the relevant date and was published on 19 January 2019, for the following:



3. On 14 November 2019, Ahmet Erol (“the applicant”) made an application for the registered designs to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that both designs lack novelty and individual character.

4. The applicant relies on four design registrations. The first two are 4020066, which was registered on 18 May 2011, and 4020067, which was registered on 18 May 2011. Both were invalidated on 31 March 2022, as a result of invalidation actions before the court. This means that they are deemed never to have existed and cannot be relied on by the applicant in these proceedings.

5. Design 4019135 was applied for on 3 March 2011 and published 11 April 2011. It was registered on 3 March 2011, but the registration expired on 3 March 2021. The design, described as a 'hoody', appears in the following form:



6. Design 5000930 was applied for on 31 December 2015 and published on 19 January 2016. It was registered on 31 December 2015, but the registration expired on 31 December 2020. The design, described as a 'sweatshirt', appears in the following form:





7. In addition to the earlier designs the applicant relied on under s.1B of his statement of case, which I have outlined above, he also included (with his evidence) prints of design 6003776, for which he was the proprietor. The design was filed on 30 November 2016, registered with effect from that date, published on 1 December 2016 and expired on 30 November 2021. It was described as ‘clothing’.



8. Mr Ahmet includes prints of five invoices. The first four have at the top, the name ‘ista textile limited’ the fifth has ‘SANTEXTILE LIMITED’. The invoices are dated between 4 September 2014 and 14 November 2019. The invoices are for quantities of items described at ‘sweats’ and ‘hoodies’.

9. The registered proprietor filed a counterstatement to the application for invalidation on 17 January 2020, denying the applicant’s claims and arguing that, “...*there are [a] substantial number of differences between the design registered by the Applicant and the design registered by the [proprietor].*” It further claims that there is no or insufficient

evidence that the applicant has made the design public prior to the proprietor's registration. It says:

"The Applicant's invoices are insufficient to demonstrate this and this is not accepted by the [proprietor]."

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

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

12. The proprietor is represented by Aliant Law,¹ the applicant represents himself.

DECISION

13. 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".

14. 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

¹ Formerly Scarmans Ltd. The tribunal was notified of the name change by a letter received on 19 February 2020.

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

15. The invoices filed by the applicant do not show the appearance of the designs being sold, nor do they indicate who was selling the goods and when they were made available to the public. This evidence does not assist the applicant and I will say no more about it.

16. The three expired designs, which I will refer to as the black, grey and red hoodies, were published on 11 April 2011, 19 January 2016 and 1 December 2016, respectively.

17. Those publication dates are earlier than the date of filing of the contested designs and I consider the applicant’s expired registrations to be acceptable prior art. The fact that those earlier designs are now expired does not alter the fact that they were available to the public at a date earlier than the proprietor’s applications.

Novelty



18. 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.”²

Comparison of the designs

19. In the table below I show the registered design alongside the relevant prior art:

The Registered Designs	The Prior Art
	

² Paragraph 26.

The Registered Designs	The Prior Art
	 <p>The image shows a maroon hoodie with a hood. On the front, the word 'LONDON' is printed in a large, blue, outlined, block serif font, arched over the word 'ENGLAND', which is also in a blue, outlined, block serif font. A small Union Jack flag is positioned between the two words. The hoodie has a kangaroo pocket and ribbed cuffs and hem.</p>

20. The first registered design consists of the following features:

- i) It is a 2D graphic design, not applied to any particular product;
- ii) It has a grey rectangular background;
- iii) The shorter sides are more than half the length of the longer sides;
- iv) The top part of the design is the word 'BOURNEMOUTH' presented in blue outline in a block serif typeface. The word is curved with the highest point being the centre of the word. The first 'B' and the last 'H' are larger than the rest of the text;
- v) Beneath the first word, in the centre of the design, is a union jack. It is approximately one and a half letters wide;
- vi) The word 'ENGLAND' is shown at the bottom of the design in the same blue outline in a block serif typeface.

21. The second registered design consists of the following features:

- i) It is a 2D graphic design, not applied to any particular product;
- ii) It has a grey rectangular background;
- iii) The shorter sides are more than half the length of the longer sides;
- iv) The top part of the design is the word 'BRIGHTON' presented in blue outline in a block serif typeface;
- v) Beneath the first word, in the centre of the design, is a union jack. It is approximately one and a half letters wide;

vi) The word 'ENGLAND' is shown at the bottom of the design in the same blue outline in a block serif typeface.

22. The first example of prior art consists of the following features:

- i) It is a black hooded sweatshirt with long sleeves. The inside of the hood is white;
- ii) Three letters can be seen at the back of the neck. The first is a larger letter N, the second an 'a' or 'o', and the third is a larger letter 'D'. The letters are white on a black background;
- iii) The hooded sweatshirt has a design on the front face, the back is plain black;
- iv) The design applied to the front of the hooded sweatshirt is the word 'LONDON' presented in white block serif text, with a red outline. It is slightly curved up in the centre;
- v) Above and to the left of the word 'LONDON' is a small white shape that looks like a tick;
- vi) Beneath the first word, in the centre of the design, is a union jack. It is approximately one and a half letters wide;
- vi) The word 'ENGLAND' is shown at the bottom of the design in the white block serif typeface, with a red outline;
- vii) There appears to be a 'kangaroo' style pocket on the front of the hooded sweatshirt, below the design.

23. The second example of prior art consists of the following features:

- i) It is a grey hooded sweatshirt with long sleeves. The inside of the hood is patterned with red, white and blue check;
- ii) A small union jack appears on the left sleeve;
- iii) The hooded sweatshirt has a design on the front face, the back is plain grey;
- iv) The design applied to the front of the hooded sweatshirt is the word 'LONDON' presented in checked red, white and blue block serif text, with a white outline. It is slightly curved up in the centre;
- v) Beneath the first word, in the centre of the design, is a union jack. It is approximately one and a half letters wide;

- vi) The word 'ENGLAND' is shown at the bottom of the design in dark red block serif typeface, with a white outline;
- vii) The letters TM in a circle appear to the right of the word 'ENGLAND', possibly in dark blue, although it is difficult to see the colour;
- viii) There appears to be a 'kangaroo' style pocket on the front of the hooded sweatshirt, below the design.

24. The third example of prior art consists of the following features:

- i) It is a dark red hooded sweatshirt, with long sleeves. The inside of the hood is darker, though it is difficult to see the exact colour;
- ii) A small union jack appears on the left sleeve;
- iii) The hooded sweatshirt has a design on the front face, the back is plain dark red;
- iv) The design applied to the front of the hooded sweatshirt is the word 'LONDON' presented in a black block serif text, with a white outline. It is slightly curved up in the centre;
- v) Beneath the first word, in the centre of the design, is a union jack. It is approximately one and a half letters wide;
- vi) The word 'ENGLAND' is shown at the bottom of the design in a black block serif typeface, with a white outline;
- vii) There appears to be a 'kangaroo' style pocket on the front of the hooded sweatshirt, below the design.

25. The fact that the registered designs are two-dimensional designs and the prior art examples are three-dimensional hooded sweatshirts results in more than minor and trivial differences between the contested designs and the prior art. The differences between the words 'BOURNEMOUTH' in the first contested design and 'BRIGHTON' in the second contested design and the word 'LONDON' in all three of the prior art examples also gives rise to 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 designs have novelty when compared with the prior art.

Individual character

26. 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

27. The sector concerned is primarily the clothing sector, in particular, souvenir clothing – although the contested registered designs are graphic designs that could be applied to any product, it is likely the resulting products would fall into that category, given that the product description for both designs is ‘hoodie/sweatshirt’. 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 souvenir clothing 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

28. I have no evidence to show me the design corpus at the relevant date.

29. It is clear that when it comes to souvenir clothing items, they will usually include some reference to the place visited by the purchaser. Beyond that, the designer has considerable freedom to choose the associated imagery, wording and so on. Where the design is applied to an item such as a sweatshirt or hoody, then the clothing item will need to have sleeves, a neck opening and possibly a hood. Beyond those requirements, the designer has freedom of size, length, pockets and other embellishments.

Overall impression

30. I have already listed the features of the designs in paragraphs 12 to 16 above. I find that the differences in these designs are obvious, the contested designs being 2D graphic designs and the prior art relied on by the applicant being hoodies, featuring the main design on the front. However, even if the proprietor's designs were applied to hoodies or sweatshirts, I find that the differences between the word 'BOURNEMOUTH' and the earlier 'LONDON' designs and the proprietor's 'BRIGHTON' design and the earlier 'LONDON' designs are such that the registered designs have individual character over the prior art. As the informed user is deemed to be showing a relatively high degree of attention, the proprietor's two designs will, in my view, create different overall impressions on that informed user.

CONCLUSION

31. The applications for invalidation against Registered Design No.s 6052187 and 6052188 have failed and they will remain registered.

The invalidations against these designs have failed under section 1B of the Act.

COSTS

32. The proprietor has been successful and is entitled to a contribution towards the costs of the proceedings. This cost award is governed by Annex A of Tribunal Practice Notice 2/2016. There are no fees for defending an invalidation action, no evidence was filed by the proprietor and no hearing was held. Consequently, I award the proprietor £300 for considering the other side's statement of case and filing its counterstatement.

33. I order Ahmet Erol to pay Posh Fashion Limited the sum of £300. The above sum should 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 14th day of October 2024

Al Skilton

For the Registrar,

The Comptroller-General