

O/1029/24

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6130184

IN THE NAME OF DUALTOP LIMITED

IN RESPECT OF THE FOLLOWING DESIGN



AND

AN APPLICATION FOR INVALIDATION (NO 73/23)

BY LAWN & LACE LTD

BACKGROUND AND PLEADINGS

1. Dualtop Limited is the registered proprietor of Registered Design No. 6130184.¹ The design was applied for on 13 April 2021 (“the relevant date”), registered on 21 May 2021 and published on 22 May 2021. Although the design is registered as applying to Shoes, both parties refer to the design as being for Slippers. I shall do likewise.

2. The design is depicted in the following representations:

Main illustration	
Illustration 2	
Illustration 3	
Illustration 4	

¹ I shall refer to Dualtop Limited as the registered proprietor in this decision.



3. On 4 April 2023, Lawn & Lace Ltd (“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 does not meet the requirements of section 1B of the Act that a design be new and have individual character. The applicant cites six designs that it claims were available to the public before the relevant date and provides listings for each of these from websites such as Amazon. These designs are shown later in this decision.

4. The registered proprietor filed a counterstatement on 16 May 2023, denying the applicant’s claims. In particular, it criticises the reliance on listings from e-commerce websites, arguing that the dates given for when the products were first available may be inaccurate or that the listings may have been amended to show different products. It then compares the contested design to each of the alleged pieces of prior art and claims that its design is new and has individual character.

5. Both parties filed evidence. The applicant’s evidence comes in the form of a witness statement from Gemma Louise Pickavant, a solicitor in the firm of Harper James, who represent the applicant. Her witness statement is dated 25 July 2023 and consists of both evidence and submissions. The evidential part contains information on the requirement on Amazon sellers to create a new listing when the product undergoes changes, including changes of colour, size or material.²

² Paragraphs 13-15; Exhibit GLP 1.

6. The registered proprietor's evidence comes from Shan Youhe, Director of Dualtop Limited. The witness statement is dated 18 October 2023 and challenges some of the submissions made by the applicant. I shall discuss these in more detail in due course, where they are relevant to my decision.

7. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. I have already noted that the applicant is represented in these proceedings by Harper James. The registered proprietor is represented by IPEY.

RELEVANCE OF EU LAW

8. The provisions of the Act relied upon 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.

DECISION

9. 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”.

10. 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

11. The designs claimed by the applicant to be earlier designs are shown below:

Prior Art 1: HomeTop Women’s Fuzzy Curly Fur Memory Foam Loafer Slippers with Polar Fleece Lining



Sold on www.amazon.ca

Date first available: 6 January 2020

Sold on www.u-buy.co.uk

Date first available: 4 January 2020

Prior Art 2: Women's Fuzzy Fleece Closed Back Indoor Slipper



Sold on www.rockdovefootwear.com

Earliest review dated “almost 3 years ago”. The screenshot was captured on 9 March 2023.

Prior Art 3: RockDove Women's Teddy Fleece Closed Back Indoor Slipper



Sold on www.amazon.ca

Date first available: 29 January 2021

Prior Art 4: Cozylook 2-Pair Women's Soft Sole Slipper Socks with Grippers



Sold on www.amazon.ca

Date first available: 18 July 2021

Prior Art 5: RockDove Women's Nomad Slipper with Memory Foam



Sold on www.amazon.co.uk

Date first available: 28 July 2020

Prior Art 6: ULTRAIDEAS Women's Cozy Memory Foam Closed Back Slippers with Warm Fleece Lining, Wool-like Blended Cotton House Shoes with Anti-Slip Indoor Rubber Sole



Sold on www.amazon.ca

Date first available: 22 March 2019

12. I can quickly dismiss Prior Art 4, as the date on which this was made available is after the relevant date in these proceedings. Therefore, the design is not an earlier design.

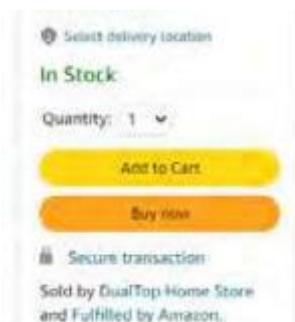
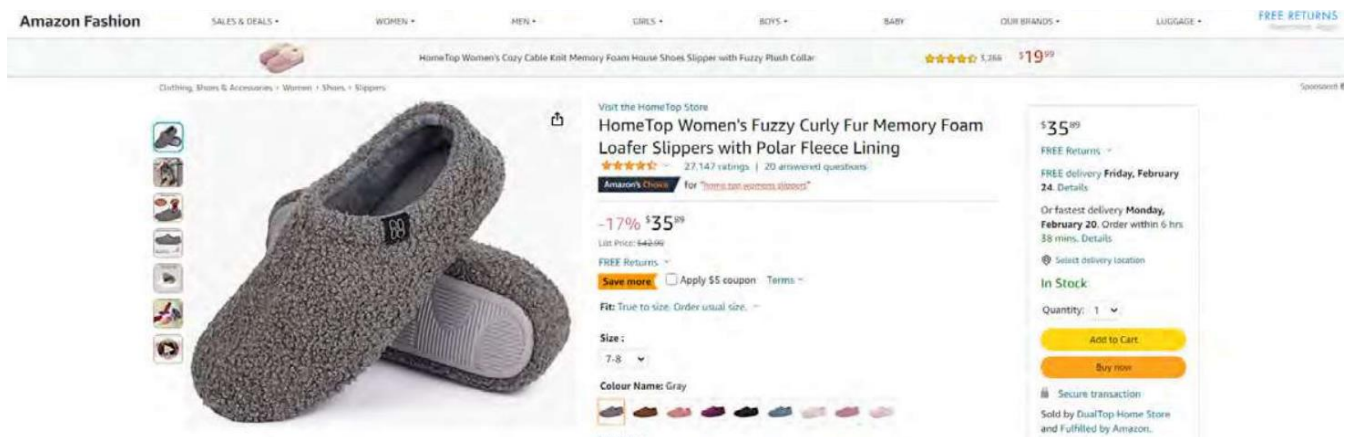
13. I have already noted that the registered proprietor criticises the applicant's reliance on these listings. At 6.4 of its counterstatement, it submits that the applicant "*has not proved beyond all reasonable doubt that the disclosure of the design [Prior Art 1] was prior to the contested Design's filing date*". The same comment is made for each of the designs relied on by the applicant. However, civil proceedings do not require facts to be proved beyond reasonable doubt, but on the balance of probabilities. The proprietor's submissions on the possibility of amending product listings on Amazon without that changing the date of the first recorded offer for sale of the product, have been challenged by the applicant, who has filed a printout from Amazon showing its

Product Detail Page Rules. These state that a seller will need to create new pages for new versions of products. In my view, the theoretical possibility of a seller changing the details of the product contrary to these rules is not, without more, sufficient to prevent the printouts filed by the applicant from providing *prima facie* evidence that the product shown at the later date was first made available to the public on the date stated. If I am wrong in this, the applicant may still rely on Prior Art 1, for the reasons I now give.

14. The registered proprietor says on page 3 of its evidence, under point (1), that:

“... the HomeTop brand is NANJING DUALTOP INFORMATION TECHNOLOGY CO. Accordingly, the HomeTop brand is our private brand at DUALTOP limited. There is no problem for us to use our own designed products for sales. Meanwhile, the sale date of Amazon and ubuy is 6, January 2020.”

15. The Amazon screenshot states that the goods are sold by DualTop Home Store. This can be seen in the magnified section of the screenshot reproduced below.



16. The registered proprietor has therefore admitted that it has made the goods shown in the above screenshot available to the public on 6 January 2020. This is more than 12 months before the relevant date. This means that the registered proprietor is not able to rely on the provision in section 1B(6)(c), which allows the design to be made available by the designer or their successor in title during the 12 months immediately before the relevant date, without being treated as an earlier design for the purposes of the assessment of novelty or individual character. I shall therefore treat it as disclosure of prior art.

17. Although the registered proprietor has admitted that it has disclosed this design, it has not, in my view, resiled from its pleading that the contested design is both new and has individual character when compared to Prior Art 1. I shall therefore proceed to consider the applicant's claims and return to the remaining prior art should that prove necessary.

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.”³

Comparison of the designs

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

³ Paragraph 26.

The Registered Design

The Prior Art



20. In making my comparison, I shall ignore the small icon in the top right corner of the image of the prior art. This icon allows users of a website to share the content with another person and so I consider that it is not part of the earlier design.

21. The applicant claims that the designs are identical. The registered proprietor, on the other hand, argues that the designs are different in that the contested design is marked with a label on the upper hem bearing the sign VC and has “*a far fluffier appearance to the fabric*” than Prior Art 1.⁴

22. I consider that the designs share the following features:

- a) they are broadly foot-shaped, with a hollow in which the foot will be placed;
- b) the top of the slipper would cover most of the top of the foot;
- c) the back of the slipper is high, covering the whole of the back of the foot. However, it is slightly lower than the part of the slipper covering the top of the foot;
- d) the hole at the top of the slipper, through which the foot is inserted, is oval-shaped;
- e) the upper part of the slipper is grey in colour;
- f) the upper is made from a curly fabric, giving the appearance of a fluffy texture;
- g) the material inside the slipper is also grey in colour;
- h) the sole is light grey in colour, and is marked with a pattern consisting of incomplete ellipses containing vertical lines, on a background of horizontal lines;
- i) there is a stitched hem line round the opening;
- j) a line of stitching can be seen extending from the centre of the hem line round the opening to the centre of the toe; and

⁴ Counterstatement, paragraph 6.6.

- k) there is a small square black label extending from the opening of the slipper to the hem line. This contains writing and is placed on the outer side of the slipper (i.e. the left side on the left slipper) towards the front. The label appears to be positioned in the same place in both designs.

23. The content of the small black label is different for each design, but I consider that this is the only difference between them. I cannot see that the contested design appears “*far fluffier*” than the prior art. To my eyes, the material used for both designs produces the same effect. Returning to the labels, I note that, in the contested design, the letters V and C can be seen in white, while the label on Prior Art 1 contains what appears to me to be a stylised image of a flower with four petals. In my view, given the size of the label in proportion to the slipper as a whole, the different content is an immaterial detail and so I find that the contested design is not new when compared against Prior Art 1. In case I am wrong in this, I shall go on to consider whether the contested design has individual character.

Individual Character

24. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the High Court, in *Safestand Ltd v Weston Homes PLC & Ors* [2023] EWHC 3250 (Pat) at [237]:

“(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 design 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."

25. 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 in question

26. The parties agree that the relevant sector is that of slippers.

The informed user

27. Earlier in *Samsung Electronics*, the judge 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 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, *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 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).”

28. The applicant submits that the informed user is a wearer of slippers who is an adult member of the general public and is reasonably well-informed but will not observe in detail minimal differences between the designs. The registered proprietor agrees that the informed user is a member of the general public but adds that they are “*fashion conscious and will pay a relatively high degree of attention when purchasing clothing and footwear. Such informed user will also be very brand conscious.*”⁵ I accept that branding may be important to users of fashion items and I see no reason to find that slippers would not be regarded as fashion items. I shall therefore bear this factor in mind when it comes to assessing the overall impression of both designs.

Design freedom

29. In *Dyson Ltd v Vax Ltd*, [2010] FSR 39, Arnold J (as he was then) 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).”

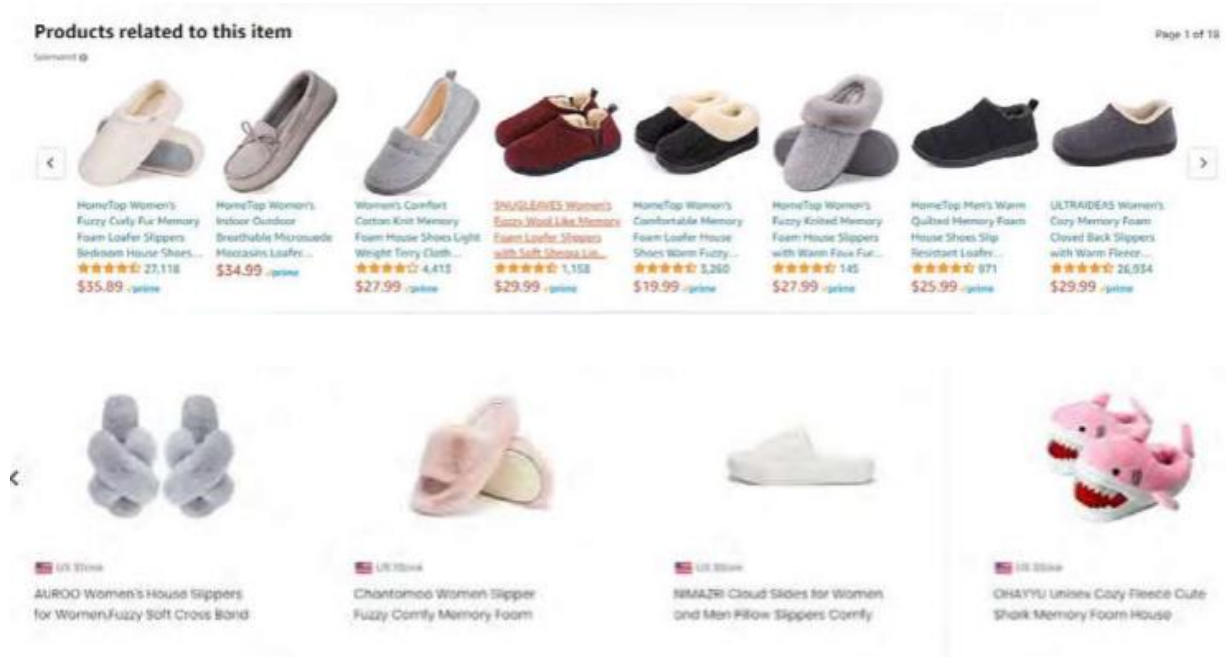
30. Both parties agree that the degree of design freedom is constrained by the requirement that the slippers are shaped to fit the wearer’s feet. The applicant also submits that the slippers must also have a sole in order not to be classified as socks. I agree with this submission. Apart from this, the applicant argues that the designer has the freedom to choose the materials, colour or ornamentation they wish to use. The proprietor submits that the degree of design freedom is narrow, as the products must fit the feet “*and be comfortable*”.⁶

31. The prior art cited by the applicant shows that designers use a range of different colours. In addition, the Amazon printouts in Annex 2 to the applicant’s statement of

⁵ Counterstatement, paragraph 5.4.2.

⁶ Counterstatement, paragraph 5.5.3.

grounds show further styles and I have reproduced a number of examples from the first few pages below:



32. I accept that there is no evidence that these slippers were available on the market on or before the relevant date. However, in *Dyson*, Arnold J (as he then was) said:

“37. Counsel for Dyson also submitted, and I accept, that evidence of design freedom could also come from designs produced after the date of the registered design. If a wide variety of designs was produced after the registered design, that is evidence that the designer of the registered design had not been constrained to design the product in the way that he had.”

33. Slippers are for the most part worn inside the home, although they may also be used in hotels and spas. Even accepting that the informed user would expect slippers to be comfortable, I find that the designer has a significant degree of design freedom. The examples show slippers with and without backs; with open and closed toes; with and without bands of contrasting colour or material around the opening for the foot, using different materials. There is even a pair of shark-shaped slippers. To my mind, the only constraints are that the slippers should be shaped and sized so they can be placed on the foot in such a way that the wearer may safely walk indoors, and should have a sole. With these constraints in mind, the designer has the freedom to choose

the colour, materials, degree of ornamentation, and shape of the upper part of the slipper.

Overall impression

34. The registered proprietor submits that two factors determine the overall impression of the contested design. One of these is the alleged fluffier appearance. However, I have already explained that I am unable to see a difference between the designs in this respect. The second is the content of the small black label. A finding that the contested design has individual character requires me to conclude that the content of the label makes a significant contribution to the overall impression of the design and outweighs the points of identity. In his *Safestand* summary of the approach to assessing the overall impression, HHJ Hacon said that the informed user may attach greater importance to some parts of the design. The registered proprietor submits that the informed user is very brand-conscious and so would pay a high degree of attention to the branding on the label. However, the label itself is very small and so the content would not be easy to see when the slippers are in use. If the branding is part of the overall impression of an item of clothing or footwear, it is reasonable to expect it to be visible to others when the product is being worn. I further note that HHJ Birss said in *Samsung* that “*minute scrutiny by the informed user*” is not the right approach.⁷ Consequently, I find that the difference in the content of the label is not sufficient for me to find that the designs create different overall impressions. The contested design does not have individual character when compared with Prior Art 1.

Final Remarks

35. As I have found that the contested design is not new and does not have individual character compared to Prior Art 1, I shall not compare it against the other cited prior art.

Outcome

36. The application to invalidate Registered Design No. 6130184 is successful.

⁷ At [58].

Costs

37. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 1/2023. I award the applicant the sum of £898 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

£250 for preparing a statement and considering the other side's statement

£600 for preparing evidence

£48 for official fees for filing the application.

£898 in total

38. I therefore order Dualtop Limited to pay Lawn & Lace Ltd the sum of £898. 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 30th day of October 2024

Clare Boucher

For the Registrar,

The Comptroller-General