

**O/0043/25**

**REGISTERED DESIGNS ACT 1949**

**REGISTERED DESIGN No. 6228591**

**IN THE NAME OF SHENZHEN SHENGTAIXI TRADING CO., LTD**

**IN RESPECT OF THE FOLLOWING DESIGN**



**AND**

**APPLICATION FOR INVALIDATION No. 45/23**

**BY TILCO TRADING PTE. LTD**

## BACKGROUND AND PLEADINGS

1. Shenzhen Shengtaixi Trading Co., Ltd of China (“the proprietor”) is the proprietor of registered design No.6228591, which has a filing date of 1<sup>st</sup> September 2022 and is protected with effect from this date. The design is shown below.





2. The product in which the design is embodied is indicated to be a urinal.

3. On 6<sup>th</sup> March 2023, Tilco Trading Pte. Ltd of Singapore (“the applicant”) applied to invalidate the registered design on the grounds it is the same, or creates the same overall impression on an informed user, as two earlier published designs. The first is the applicant’s own design called the Tilcare design. Representations of this design are shown below.



3. According to the applicant, the Tilcare design was made available to the public at least as early as August 2022, i.e., a month before the contested design was applied for and registered.

4. The background to the current application is the proprietor's use of its registered design to invoke the Amazon take-down service to remove the applicant's Tilcare products from sale on that platform on the grounds they infringe the registered design.

5. The second alleged prior design is a design embodied in a third-party product called PerfectMed. Representations of this design are shown below.



6. According to the applicant, this design was made available to the public on 1<sup>st</sup> October 2019, well before the contested design was applied for and registered.

7. The applicant claims the registered design is invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 ("the Act") because the design does not satisfy section 1B of the Act, the relevant parts of which are shown below:

*“(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.”*

8. The registered proprietor filed a counterstatement signed by Yue Huifang who identified himself as the registered proprietor’s legal representative. According to Yue Huifang, the registered proprietor launched its urinal product on Amazon in March 2022. This was before the applicant launched the Tilcare product in August 2022. Yue Huifang also states:

*“[The registered proprietor] designed a groove on the bottle body of the handle, which is convenient for people with large hands to grasp comfortably. The inclined bottom design makes the center of gravity of the bottle stored in liquid shift, which is more convenient for users to use.”*

9. Yue Huifang annexed two pictures to the counterstatement. These appear to be intended to show the features he describes. The picture below seems to be intended to show the “groove on the bottle body of the handle” which makes the product easier to grasp.



10. The second picture (below) appears to be intended to show the “*inclined bottom design [which] makes the center of gravity of the bottle stored in liquid shift.*”



11. The applicant subsequently filed a witness statement by Tilen Schweizer, who is the applicant’s CEO. He essentially repeats the information and claims set out in the application. This includes a copy of an extract from Amazon’s UK website appearing to show the PerfectMed product referred to in the application was first made available on Amazon on 1<sup>st</sup> October 2019. A further picture taken from Amazon of the product concerned was annexed to Mr Schweizer’s statement and this is re-produced below.



12. Mr Schweizer also gives evidence that in his opinion as an informed user of the products, the prior designs create the same overall impression as the contested registered design.

13. The registered proprietor filed no evidence.

### **REPRESENTATION**

14. The applicant is represented by Abel & Imray. The registered proprietor has not appointed external legal representation. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing. I have taken this decision after a careful consideration of the papers before me.

### **RELEVANCE OF EU LAW**

15. 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.



## DECISION

### Is the registered design new?

16. Section 1B(2) of the Act states that a design is new 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*,<sup>1</sup> 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.”*

17. The designs at issue are self-evidently very similar. The body of the Tilcare design appears to have similar relative proportions to the registered design with similar flat(ish) sides from which a round neck of similar length emerges from the front of the body at a similar upwards angle. The urinals share a very similar round screw-on cap with a retaining connection.

18. Looked at from above, the designs also feature the same slight flare running along the length of the design from the back of the urinal to the front.

19. The design of the handles is also very similar. The handles are attached at the base of the ‘neck’ of the urinals, are roughly square in profile, and extend backwards along the length of the body of the urinal to roughly the same point. The ends of the handles share the same curved top and backwards sloping design. The front of the undersides of the handles share an indentation which continues down and into the body of the urinal to provide an enlarged space for the index finger to slip into and grip the front of the handle securely when the urinal is in use. The shape creates the impression of a partial circular cut-out but is in fact formed (in each case) by eight small straight sections arranged to form the curving finger hole/grip.

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<sup>1</sup> [2019] EWHC 3149 (IPEC)

20. The registered design is registered without disclaimers. It therefore includes the white colour of the body of the urinal and the light blue colour of the cap. White is one of the most common colours used for containers of all kinds. The prior art has the same colour. A contrasting light blue cap is not an established feature of the Tilcare design. However, it is hardly a novel feature.

21. On close examination one can see that the Tilcare product has the brand name TILCARE and a device of cusped hands embossed on the side of the urinal. The registered design has no such feature. This is another difference between the designs. However, because the word/device are embossed in the same colour as the urinal body, and consequently blend into the overall design, they do not stand out. Consequently, the embossed word/device does not make a great deal of difference to the appearance of the designs as wholes.

22. The two differences identified by the proprietor are the “*groove on the bottle body of the handle*” and the “*inclined bottom design.*” It is not clear what the proprietor means by the former. The handles of the registered design and the Tilcare design appear the same. It is possible the proprietor is referring to the groove on the top of the urinal body in the registered design, which is absent from the prior art. This aspect of the design appears to be intended to provide more space between the handle and the body, and thereby make it easier for users with large hands to get the last three knuckles of his/her hand into the gap and grip the handle comfortably and securely.

23. The inclined (angled) bottom of the urinal is hard to see when it is rested on its side, as in the picture on the cover page of this decision. The feature is also difficult to make out from the representations on the register. Judging from the pictures the proprietor has provided purporting to show the design in use, the inclined bottom may be more apparent when the product is placed end up, as the urinal may be when filled with urine. This appears to be a functional feature intended to maintain a central centre of gravity when the urinal is placed this way up (and therefore to make it less likely to fall over).

24. In my view, the differences the proprietor has identified are sufficient, at least in combination, to have some effect on the overall appearance of products embodying

the registered design as compared to the Tilcare design. I therefore find that the registered design is new compared to the Tilcare design.

25. Comparing the registered design to the prior PerfectMed product leads me to the same conclusion for similar reasons. Admittedly, the PerfectMed product also has a light blue cap, but set against that is that the cap does not appear to have a retaining connection like the registered design. Further, the PerfectMed design includes two oval-shaped indentations on the neck of the urinal (probably grip points for the user to use whilst screwing/unscrewing the cap) which are not a feature of the registered design.

### **Individual Character**

26. A design may be 'new', but still lack the necessary 'individual character' compared to the prior art. This depends on whether the overall impression is produced 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.

27. 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 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."*

28. Earlier in *Samsung* 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)."*

29. The relevant sector is the hospital/care home sector, but also includes members of the public outside these settings dealing with urine incontinence and/or with limited access to toilet facilities.

30. The informed user in this case is a user of portable urinals, such as a person suffering from urine incontinence and/or with limited access to toilet facilities

(such as someone restricted to bed), or a medical professional caring for such a person, such as a nurse or other care provider.

31. There is no evidence that Mr Schweizer is an informed user as I have defined that person. The mere fact that his company makes or sells portable urinals does not make him so. Consequently, I have attached no weight to his opinion as to the overall impression created by the registered design and the prior art.

32. The design of a portable urinal is constrained in some respects. It must have an opening large enough to capture the user's urine stream. It must have sufficient capacity to hold a generous volume of urine. It must have flat surfaces on which it can be stood whilst not in use or awaiting emptying. It must have a handle of some sort so that it can be carried and held securely whilst in use. Beyond these basic requirements the designer appears to have significant freedom of design.

33. I find the similarities between the designs identified above are sufficient for them to create the same overall impression on an informed user. The differences I have observed, or which the registered proprietor has identified, have much less impact than the features they have in common. The additional groove on the top of the body of the registered design to accommodate the users knuckles is a functional feature. The informed user will recognise this and attach less weight to it for this reason. Further, the feature is partly obscured by the handle of the product, which further reduces its impact on the informed user.

34. The inclined (angled) bottom of the registered design is a subtle design feature. The informed user may notice it, particularly when the product is placed on end with the cap pointing up, but it makes little difference to the overall impression created by the design as a whole. Indeed, as I have already noted, it is hard to identify the feature at all from the representations of the design on the register, which are the critical ones for present purposes.

## **OVERALL RESULT**

35. The registered design is invalid and will be cancelled accordingly.

## **COSTS**

36. The applicant is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 2/2006. I award the applicant the sum of £948 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

*Official fees: £48 per action*

*Preparing the application and considering the counterstatement: £500*

*Preparing evidence: £200*

*Filing written submissions: £200*

*Total: £948*

37. I order Shenzhen Shengtaixi Trading Co., Ltd to pay Tilco Trading Pte. Ltd the sum of £948. 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 January 2025**

**Allan James**  
**For the Registrar**