

O/0131/25

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6183885

IN THE NAME OF

DIYANA POPOVA

AND

AN APPLICATION FOR INVALIDATION (NO. 194/23)

BY

ZEYSHAN MAHMOUD

Background and pleadings

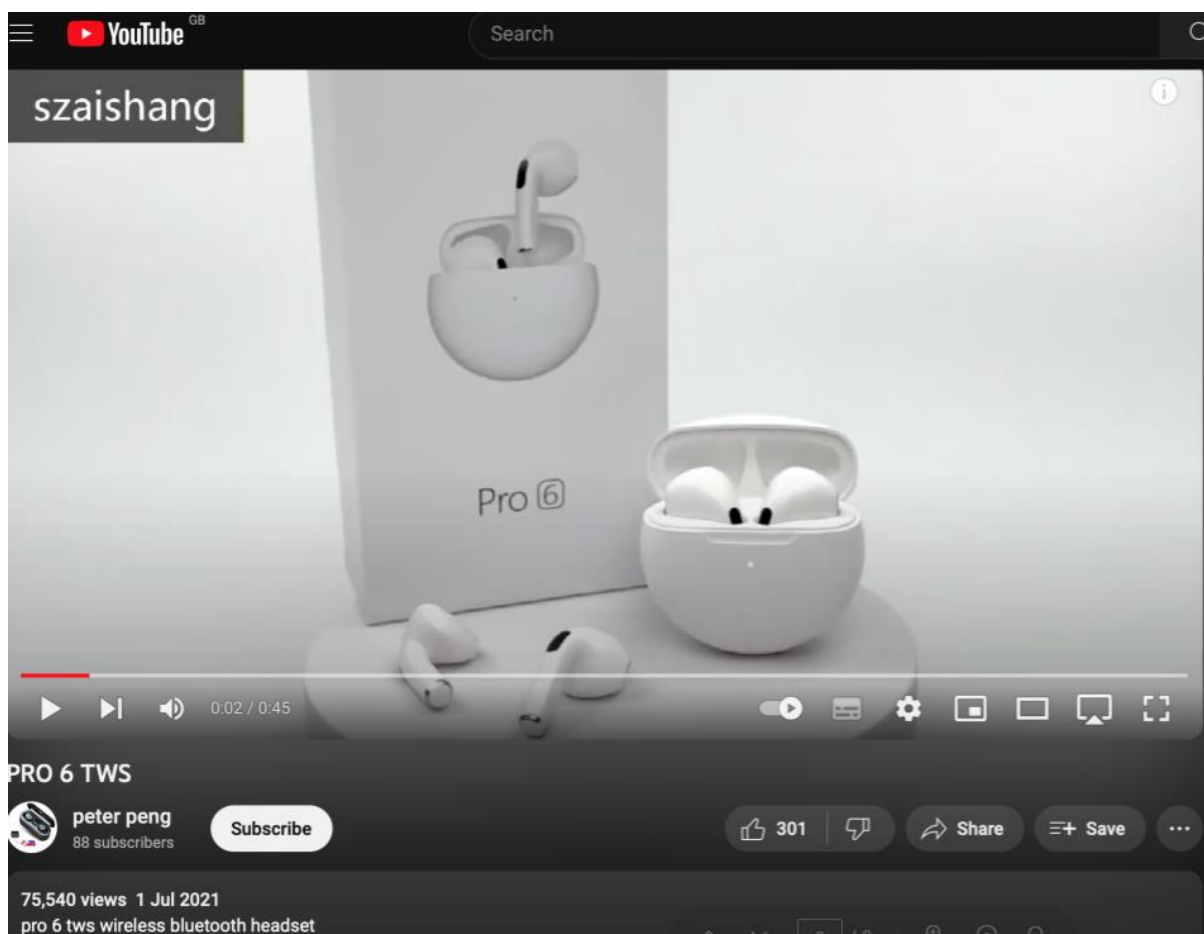
1. Registered design no. 6183885 stands in the name of Diyana Popova (“the Registered Proprietor”). The design was applied for on 29 December 2021 (“the relevant date”), registered on 8 March 2022, and published on 9 March 2022.

2. The product in which the design is embodied is indicated to be wireless earphones. The design is registered as applying to “*recording, telecommunication or data processing equipment*”, “*equipment for the recording or reproduction of sounds or pictures*” in class 14 and subclass 1 of the Locarno classification system.

3. The design is depicted in the following representations:



4. On 1 September 2023, Zeyshan Mahmoud (“the Applicant”) applied to invalidate the registered design under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design was not new and did not have individual character as required by section 1B of the Act. The Applicant claims that the contested design was first made available to the public to purchase on many third party websites and in a video published on YouTube on 1 July 2021. A screenshot of this video is reproduced as follows:



5. The Registered Proprietor filed a counterstatement to the application on 1 November 2023, denying the Applicant’s claims. In particular, she states that:

“my design has been available to the public since May 2021 through my online eBay shop – xonlinetraderx, making it accessible before its official registration and well before the date of the video posted via internet Mr Mahmoud mentioned as evidence.

As such I reserve the right to my design as the rightful owner under the IPO and within the law and I am providing evidence of (a) listing to highlight the item design has been made available and sold to the public in May 2021.

The video Mr Mahmoud sent as evidence from July 2021 it's possibly one of our products which was sold in May and throughout June and July as such proving our point that we have the right of ownership.”

6. This image is attached to the counterstatement:

The screenshot shows the eBay Seller Hub interface for an order. The order is titled "NEW Wireless Bluetooth Headphones Earphones Earbuds In-Ear For All Devices UK" and is marked as "Delivered on 2 Jun". A progress bar shows the order status: "Buyer paid" (28 May), "Dispatched" (28 May), and "Delivered" (2 Jun). The order details include: Order no. 19-0937-76712, Sales record no. 1326, Date sold 28 May 2021, Date buyer paid 28 May 2021, and Buyer isohell02 (123). The postage information shows it was sent via Royal Mail 1st Class Letter / Large Letter to Sheffield, South Yorkshire S1 4FS, United Kingdom. The item table shows one unit of "NEW Wireless Bluetooth Headphones Earphones Earbuds In-Ear For All Devices UK" for a price of £9.49. The payment summary shows an order total of £9.49, with item subtotal at £9.49 and postage at £0.00. The earnings summary shows an order total of £9.49, selling costs, and transaction fees of -£1.07, resulting in order earnings of £8.42.

Item	Quantity	Price	Total
NEW Wireless Bluetooth Headphones Earphones Earbuds In-Ear For All Devices UK Wireless Technology: P6 Pink Metallic VAT rate: 0.00% Item ID: 85440347801 Tracking: 3206405020004279E41D4	1	£9.49	£9.49

What your buyer paid	
Item subtotal	£9.49
Postage	£0.00
Order total	£9.49

What you earned	
Order total	£9.49
Selling costs	
Transaction fees	-£1.07
Order earnings	£8.42

7. The Applicant filed evidence (in an acceptable format) in the form of a witness statement dated 8 April 2024. He repeats statements made in the application for invalidation and refutes the Registered Proprietor's claims. He produces screenshots

from a video (reproduced below) which he says was made available to the public on 18 February 2021 on YouTube, which received 32,000 views. Consequently, he claims that the Applicant is not the rightful owner of this design.





8. The Registered Proprietor did not file evidence or submissions.

9. Neither party requested a hearing. I have taken this decision after a careful consideration of the papers before me.

Relevance of EU Law

10. 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

11. 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”.

12. 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.

[...]"

13. A design may only be registered if it is new and has individual character. A design is new if no identical design has been disclosed before the relevant date; it has individual character if there has been no disclosure of a design giving the

same overall impression to the informed user before the relevant date. The relevant date is the date of application for the registered design which is, in the present case, 29 December 2021. According to section 1(B) a design which has been made available to the public before the relevant date i.e. prior art, can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked.

Prior Art

14. The Applicant in his pleadings relied on a design he claimed was made available to the public prior to the relevant date through a video on YouTube published on 1 July 2021.

15. In *Crocs, Inc. v European Union Intellectual Property Office (EUIPO)*, Case T-651/16, the General Court held at [48] that it would be appropriate to undertake a two-step analysis to determine whether the disclosure had been made available to the public. First, I should ask whether the evidence provided by the Applicant shows that the alleged contested design had been disclosed before the relevant date. I start by noting that the Applicant filed evidence in which he relied on disclosure from an even earlier date, namely 18 February 2021, however, this date was not his pleaded case, and he did not make any application to amend his pleadings to rely on this earlier date. Consequently, I shall only consider the disclosure of the contested design as of 1 July 2021 for the purpose of this decision.

16. As stated, the screenshot produced by the Applicant taken from a YouTube video is dated 1 July 2021. I find that the design was made available to the public, as the video would have been viewable in the UK and the European Economic Area at the relevant date. In light of this finding, the burden then shifts to the Registered Proprietor to show that the disclosure event claimed by the Applicant could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned in the geographical area of the UK and the European Economic Area. The Registered Proprietor has not made any such claim. The publication of the video on YouTube constitutes a disclosure. In so far as the exemptions under section 1B(6) are concerned, none apply and therefore the design produced by the Applicant is acceptable prior art.

17. The Registered Proprietor, in her counterstatement, stated that she had disclosed the design before the date of the YouTube video produced by the Applicant and produced as evidence of this earlier disclosure, a screenshot of an eBay listing dated 29 May 2021. This date is within 12 months of the relevant date and predates the disclosure of the contested design. In principle, this could afford the Registered Proprietor a defence to the invalidation action, because section 1B(6) of the Act provides her with an exception as it allows Registered Proprietors of registered designs leeway to test their designs on the market prior to applying for a registration provided that disclosure takes place within 12 months prior to the relevant date.

18. However, it is necessary to consider what has been provided by the Registered Proprietor in her pleadings as I remind myself that she did not file evidence. As the DF19B form contains a statement of truth signed by the Registered Proprietor, who is an individual, I may treat its contents as evidence. The claimed prior disclosure contains a thumb nail of an image of a design, taken from a screenshot from an eBay page. The image itself is so small and illegible that it is impossible to see any detail, even after magnifying it beyond 100%. This means that it is impossible to discern with any certainty the details from the image, in order to assess whether it is indeed the registered design, as claimed by the Registered Proprietor. There is no proof that the product sold in this transaction was in fact the registered design. In so far as the contested design in the YouTube video produced by the Applicant whilst the Registered Proprietor states that this is “possibly” one of her products, there is nothing in the evidence to support such an argument given the difficulties in examining the thumb nail image. There is also no evidence produced by the Registered Proprietor that the person who published the video was one of her customers. On this basis the Registered Proprietor has not established any disclosure of the registered design that predates the prior art.

19. I shall now undertake a comparison between the registered design and the earlier design relied on by the Applicant to ascertain whether the registered design had individual character. If I find that it had individual character, I shall then go on to consider whether it was new at the relevant date.

Individual character

20. Section 1B(3) of the Act states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. A design may create the same overall impression on the informed user as another design, while being different from it in some respects. I therefore need to assess the similarities and differences and decide upon their impact on the overall impression of the design.

21. 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*¹:

“(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,

¹ [2023] EWHC 3250 (Pat) at [237]

(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.”

22. The sector is the market for wireless earphones.

23. In so far as the informed user is concerned, HHJ Birss Q.C. (as he then was, sitting as a Deputy Judge of the Patents Court) in *Samsung Electronics (UK) Ltd v Apple Inc*² observed that:

“ ... 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.”

24. HHJ Birss Q.C. 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.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

² [2012] EWHC 1882 (Pat)

- 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]).”

25. The informed user of the design at issue is a person who uses and is familiar with wireless earphones. They will be reasonably attentive to the aesthetic qualities of the product together with their comfort and fit and technological characteristics. However, I do not consider that they will examine the design with forensic attention to detail. In my view, there does not appear to be any special circumstances which would prevent the informed user from conducting a direct comparison of the designs.

26. As set out by the caselaw, the informed user will have knowledge of the design corpus. This means that they will be aware of current trends in the design of wireless earphones and the means used for charging them. This factor can be significant if a contested design were 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.³ The Applicant has filed screenshots from YouTube videos that were published earlier than the video he relied on for his pleadings. However, I understand from his witness statement that he is claiming that the design in the earlier videos is the same as the one in the later video. Therefore, this evidence sheds no light on the design corpus at the relevant date.

27. In *Dyson Ltd v Vax Ltd*, Arnold J (as he was then) stated that:⁴

“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).”

28. The point of wireless earphones is that the devices can be placed within the ears to connect to an electronic device, usually a smart phone, via Bluetooth, without having to connect using a lead or wire. Given the size of the earphones and the ease with which they could be lost the consumer would expect a case, which could perform the dual function of acting as a means of charging and storing the goods. It would make economic sense therefore to combine the two. The earphones are usually sold in pairs and must be sufficiently small and rounded to hold in place within the ear comfortably, without falling out. The mechanism by which they charge is usually a common feature as is the fact that the earphones need to include internal speakers through which the sound is transmitted. Beyond this there appears to be a reasonable degree of design freedom. In so far as the case which holds the earphones, there does not appear to be any design restriction placed on it and therefore it could be any shape.

Comparison of the prior art and the registered design

29. The registered design comprises a number of representations. I shall reproduce only those representations that give the clearest view of the registered design. The respective designs are set out as follows:

³ [2008] FSR 8 Paragraph 35(ii).

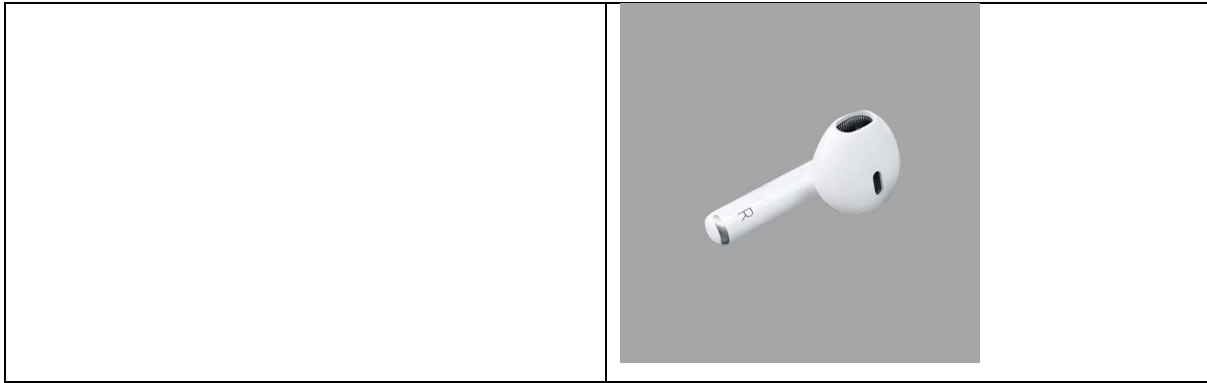
⁴ [2010] FSR 39.

Prior art



Registered design





30. The respective designs are for products which appear comparable in proportions, colour, materials and functionality.

31. Dealing with functionality first. Those features which appear to be purely technical in nature are, in accordance with the decision in *Safestand*, to be disregarded from the comparison of the respective designs. I consider that these technical features include the overall size, outline and shape of the earphone head, given that they are required to be inserted into the ear comfortably and securely. I also consider that the requirement for speaker vents and their position are likely to be dictated by function in order to provide the best possible listening experience. There is no evidence, however, to indicate that the shape of the vents was dictated by technical function. Both designs include a silver band at the bottom of the stem of the earphones which acts as a charging connector. This is also in my view a technical function.

32. Separating out those features from those which are dictated purely by technical function, the respective designs share the following attributes:

- They are both white in colour.
- They each include a circular case, which opens off centre (roughly three quarters of the way up) to create a lid. The lid is indented in the same place in both designs. At the centre of the case both include an indication light to show whether the unit requires charging or is charged.
- The earphones themselves each comprise of a rounded head moulded onto a longer thinner stem.
- Each design includes speaker vents positioned at the front and back of the head.

33. The designs differ as follows:

- In the prior art the indication light is white in colour whilst in the registered design it is green.
- The registered design has a small speaker vent on the inner side of each head which does not appear in the representation of the prior art.
- The registered design includes the letters R and L to indicate left and right. From the image produced I am unable to see whether the prior art/design has any markings included on the stem.

34. I recognise that a number of the common features of the respective products, as outlined above, are to a degree dictated by technical function. These features are necessary to ensure that the user can comfortably and securely insert the earphone into the ear so that the sound is transmitted easily to the user. The shape of the head and the design of the same, therefore, will be dictated by these requirements. I note that the shape of the case in the respective designs is circular but there is nothing to restrict the design requiring it to be circular other than the necessity for it to be easily transportable in a pocket or handbag for example.

35. Taking account of the decision in *Samsung v Apple*, the differences and similarities I have outlined will be observed to a lesser and greater extent by the informed user who pays a reasonable attention to detail. Taking all of the above into account including the weight of the similarities against the differences, the degree of design freedom in relation to the various elements, and discounting those features that are technological in nature, I conclude that the Registered Proprietor's design produces the same overall impression on the informed user compared to the prior art. I am satisfied that the respective designs only differ in immaterial differences that will not create different overall impressions on the average consumer. I find that the registered design did not have individual character at the relevant date and is invalid for that reason.

Outcome

36. The application for invalidation is successful. Design registration number 6183885 is hereby declared invalid.

Costs

37. As the Applicant has been successful, he is entitled to an award of costs. As the Applicant is unrepresented the Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction applies, which sets the amount payable to litigants in person at £19 per hour. In order to make a claim under this provision the Applicant would need to complete and return a pro forma setting out the amount of time expended on any given task, the absence of which would mean that no award would be made. Having reviewed the file, I note that, in error, the Tribunal failed to send this document to the Applicant at the conclusion of the evidence rounds. Given this omission, whilst this decision concludes my determination of the substantive matter, it does not do so in relation to any award of costs. Should he wish to make a claim for his costs, I direct that the Applicant file a completed pro forma within 14 days, a copy of which accompanies this decision.

38. This decision will take effect as a final decision when the question of costs is decided, and at that point, but not before, the provisions relating to the right of appeal will come into operation.

Dated this 13th day of February 2025

Leisa Davies

For the Registrar,

The Comptroller-General