

**O/0388/25**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN NO. 6288292  
IN THE NAME OF AMY PROCTOR  
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND  
AN APPLICATION FOR INVALIDATION (NO 173/24)  
BY PATRICK YEBOAH**

## Background and pleadings

1. Amy Proctor (the proprietor) filed application number 6288292 to register the design shown on the front cover of this decision, described as a 'remote control'. The filing date was 6 June 2023 (the relevant date). The design was registered on 17 June 2023.

2. The design is depicted as follows:



3. On 15 July 2024, Patrick Yeboah (the cancellation 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 registered design is not new and does not possess

individual character because the same remote, described by the cancellation applicant as an 'Amazon Firestick', was made available to the public in March 2021.

4. In support of the claim, the cancellation applicant filed pages printed from Amazon UK, said to show the same design, available to the UK public from at least March 2021. These were attached to the statement of case, which includes a statement of truth. Consequently, these pages may be considered evidence for the purpose of these proceedings.

5. The proprietor filed a counterstatement, which denied the grounds. Attached to the counterstatement is an email that includes the following (reproduced as written):

*"...the listing can be manipulated, it can be made 2021 but can be changed to something like a remote but this won't change the year the listing was made, I would also like to point out that my remote does not have the in print on the bottom of the remote as to what the applicant is using as evidence and I would also like to point out that my remote has 1 Bluetooth hole at the top of the remote where as the amazon remote has 2 Bluetooth holes."*

6. Neither the cancellation applicant nor the proprietor is professionally represented.

7. Neither side filed any material other than that already referred to. The parties did not request a hearing. I have therefore taken this decision after a careful consideration of the few papers before me.

### **Relevance of EU law**

8. 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 that predate the UK's withdrawal from the EU.

## The law

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 reads:

“(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 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 consideration.

(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) – (e) ...

(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) ...

(9) ...

## **Prior Art**

11. This takes the form of a print taken from Amazon UK for a product titled, *‘Alexa Voice Remote (3<sup>rd</sup> generation) with TV Controls Requires compatible Fire TV Device 2021 Release.’* The cancellation applicant has not included the ‘date first available’ but the item is listed as the 2021 release. At the bottom of the page is a comparison table showing the differences between the Alexa Voice Remote 2021 (the prior art relied on by the cancellation applicant) and the Alexa Voice Remote Pro released in 2022 (which looks to have a different button configuration). The product brand is Amazon and the seller is Amazon.



12. The applicant's submissions suggest that the Amazon UK print provided by the cancellation applicant could have been manipulated by, if I understand the submission correctly, altering the image attached to the listing.

13. The cancellation applicant submitted in its statement of case:

*"The official Amazon Firestick remote was released and made available to the public in March 2021. The product has been widely accessible on Amazon's official website and other retail platforms starting from March 2021. To support this claim, I am providing visual representations of the Amazon Firestick remote, which clearly shows the design was available prior to the registration date. Please see below Amazon link that shows the release year is 2021."*

14. Whilst I accept, in principle, that photographs on such listings can be updated or amended, the applicant has not provided any evidence to indicate that the images shown in the prints differ from the product first placed on the website. In fact, the cancellation applicant's Amazon print includes not only a large image of the 2021 product but also a comparison table, presumably made available by Amazon, which compares the 2021 remote control with the 2022 remote control. If the cancellation applicant had altered the

main photograph for the 2021 version of the product, as the proprietor has suggested, I suspect it would not match the Amazon features table for the 2021 version of the product, and it does. The image provided supports the cancellation applicant's claim that was made and signed under a statement of truth. The proprietor's hypothetical case that images in Amazon listings can be changed is not sufficient in the absence of any attempt to prove that it actually happened in this case.

15. I am satisfied that the image provided by the cancellation applicant does represent the 2021 version of what the cancellation applicant calls the '*Amazon Firestick*' product.

16. The proprietor has not claimed that any of the exceptions set out in section 1B(6) apply. Consequently, in accordance with the decision in *Senz Technologies BV v Office for Harmonization in the Internal Market (OHIM)*,<sup>1</sup> the cancellation applicant may rely on the design shown in the Amazon print.

### **Is the registered design new?**

17. 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*,<sup>2</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.”

18. I note that neither design is shown from the side. The second image of the prior art is very blurry and shows very little detail, which makes the comparison, other than the front of the design, a little more difficult.

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<sup>1</sup> Joined cases T-22/13 and T-23/13, paragraph 26.

<sup>2</sup> [2019] EWHC 3149 (IPEC).

19. The designs are as follows:

| The Registered Design   | The Prior Art   |
|---|---|
|   |    |
|  |  |

20. Looked at from the front, the designs are self-evidently very similar. They are both black, rectangular devices with the same straight sides and curved top and bottom edges. They have identical button configurations, with the same functions on each of the buttons. They both include a large round button in the top centre, which is placed below a small round blue button. In both cases the same icon is shown on the blue button. Both designs also feature nine black buttons that have the menu access and playback functions on them. They are the same and both include an elongated +/- button in black in the centre of the third row of black buttons. Four 'lozenge' shaped coloured buttons give access to 'prime video', 'NETFLIX', 'Disney' and 'amazon music'. They are shown in the same colours and in the same order, with the same services featured.



21. I cannot compare the backs or sides of the designs because neither design is shown from the side and only the registered design is shown from the back. However, both are remote controls and appear to be of a similar thickness and in use it is the front of the remote control design that plays the greater role in the overall impression that the design makes on the informed user.

22. The two differences identified by the proprietor are the 'in print' on the bottom of the prior art and the fact that the registered design has one Bluetooth hole, while the prior art has two. I take the proprietor's reference to an 'in print' to mean the Fire TV wording shown in a shiny black finish on the matt black of the prior art, which has no equivalent in the registered design. This is a difference between the designs. However, because the word/device is black on black it blends into the overall design. Consequently, it does not make a great deal of difference to the appearance of the designs as whole. The second Bluetooth hole in the prior design would appear to be the small round turquoise light in the top right of the remote, again, this contributes little to the overall impression of the design as a whole.

23. In addition, the registered design appears to be very slightly longer and narrower than the earlier design relied on as prior art. Also, the centre of the large round circle appears slightly textured in the registered design (though this may be the same in both designs as it is only apparent from one particular angle of photograph). The red dot that is present on the 'Disney' button of the earlier design appears to not be part of the design. I say this because the same red dot is present on the unclear image of the same design and in that case it is on the table rather than part of the remote control. It would seem to be on the screen of the person capturing the image.

24. In my view, the differences between the designs are small but (just) sufficient, in combination, to have some effect on the overall appearance of the registered design compared with the prior art. I therefore find that the registered design is new.

### **Individual character**

25. 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 Birss J (as he then was) pointed out in *Dyson Ltd v Vax Ltd*,<sup>3</sup>

*“The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration.”*

26. 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*.<sup>4</sup> 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,

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<sup>3</sup> [2010] FSR 39.

<sup>4</sup> [2018] EWHC 345 (Pat).

(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.”

27. 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.*<sup>5</sup>

“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.”

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<sup>5</sup> [2012] EWHC 1882 (Pat).

### The sector to which the products belong

28. The relevant sector is the market for remote controls.

### The informed user

29. Earlier in the same decision, 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).”

30. The informed user is an individual who wants to access TV services using a remote control. They will be observant and will have an interest in both the appearance and functionality of the design.

#### The design corpus

31. The cancellation applicant’s evidence consists of the prior art I have used for the purposes of comparison. I therefore have no evidence beyond that example to show me the design corpus at the relevant date.

#### Design freedom

32. In *Dyson Ltd v Vax Ltd*,<sup>6</sup> 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).”

33. The technical function of a remote control means that it must be fairly slim, to fit comfortably in the user’s hand and must have the necessary buttons to enable the user to access menus, channels, tv streaming services, volume and playback functions. This means that the physical size and shape is partially dictated by function. In addition, I bear in mind that the underside of the design is also much less likely to be seen in use.

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<sup>6</sup> [2010] FSR 39.

34. The designer has some limited freedom to determine the size and shape of the overall design, within the limits discussed above. The designer has considerable freedom to choose the shape, size, colour and configuration of all the buttons on the remote control. This will, of course, be in the context of usability, meaning that the buttons will likely be on the top surface of the remote and it will be slim enough to fit in the user's hand.

35. Considering these designs as wholes, I find the similarities are sufficient for them to create the same overall impression on an informed user. The button sizes and shapes are varied (for example, the large round button towards the top and the elongated +/- button in the middle of the remote control) and are identical in both cases, with the same function given to each button. The differences have far less impact than the features in common. The additional Bluetooth hole is unlikely to be given much weight by the informed user and as I said above, the black on black 'Fire TV' element plays a small role in the overall design and is difficult to see and will be mostly obscured by the user's hand in use.

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

## **COSTS**

36. The cancellation applicant has been successful and is, in principle, entitled to a contribution towards his costs. As he is unrepresented, at the conclusion of the evidence rounds the Tribunal invited him, in the official letter dated 10 March 2025, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the cancellation application; it was made clear to the cancellation applicant that if the pro-forma was not completed then no costs will be awarded. No response was received. Consequently, I make no order as to costs.

**Dated this 29<sup>th</sup> day of April 2025**

**AI Skilton**

**For the Registrar,**

**The Comptroller-General**