

**O/0876/25**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 6300996**

**IN THE NAME OF RYZAN ONLINE LIMITED**

**IN RESPECT OF THE FOLLOWING DESIGN:**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 57/24)**

**BY LIMARS LTD**

## **Background and pleadings**

1. The design shown on the front cover of this decision (No. 6300996) is registered in the name of Ryzan Online Limited. The design was applied for on 2 August 2023 (“the relevant date”), registered on 12 August 2023 and published on 13 August 2023. The indication of product is given as *Post box*. The registered design is classified in Class 25 (Building Units and Construction Elements), Sub-class 03 (Houses, Garages and Other Buildings) of the Locarno Classification.

2. There is a single representation of the design and I shall reproduce this later in my decision.

3. On 22 March 2024, Limars 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 contested design was not new, nor did it have individual character compared to another design that had been made available to the public before the relevant date. The applicant provided an Amazon screenshot of a letter box which is shown as first available on 2 July 2020. I shall reproduce this image later in my decision.

4. The registered proprietor filed a counterstatement on 27 July 2024, denying the applicant’s claims. In particular, it claimed that:

“Our product is a unique mold created by us and worked on closely with our supplier in manufacturing this unique mold and design in regards to size, material and our trademark molded into the postbox which makes this design unique from the design provided by the applicant therefore should be able to stay registered as it is currently.”

5. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, neither side has legal representation.

## **Evidence**

6. Neither side filed any evidence or written submissions during the evidence rounds. The applicant did file evidence with its statement of case. The statement of case

contains a statement of truth and it was signed by Marius Liatukas on 22 March 2024. It may therefore constitute evidence of fact in accordance with Rule 21(1)(a) of the Registered Designs Rules 2006. As I have already said, it is a screenshot from the Amazon website showing a product that is claimed to constitute prior art.

## **Decision**

7. 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”.

8. 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

9. The Amazon listing for the product relied upon by the applicant indicates that it was first made available to the public on 2 July 2020. This date is earlier than the date on which the registered proprietor filed its application to register the contested design and I consider that listing on the Amazon website constitutes publication. The registered proprietor has not questioned the reliance on this listing. Consequently, I find that it is acceptable prior art. It can be seen below:

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### Product Details

With 2 Keys

Waterproof

Transparent cover

Roll over image to zoom in

### Trintion Letter Box 32 x 21.5 x 8.5cm Post Box Wall Mounted Steel Mail Box Parcel Delivery Box Lockable Letter Weatherproof Post Box with 2 Keys Stylish Letterbox for Keep Your Mail Safe (Black)

Visit the Trintion Store

★★★★★ 628

Amazon's Choice

200+ bought in past month

**Limited time deal**

-15% **£16.59**

Was: £19.59

prime

Save up to 9% with business pricing. Sign up for a free Amazon Business account

Colour Name: **Black**

**Material** Alloy Steel

**Colour** Black

**Included security features** Lockable

**Brand** Trintion

**Mounting type** Wall Mount

**About this item**

- [Waterproof & Rust-Resistant] The steel flip cover and spring-activated hinges protect the lock cylinder from rusting and keep the inside dry, Mail box even in strong winds and heavy rain. The narrow slots reduce the risk of mail being removed without a key.
- [Secure & Stylish Design] This brief classic outdoor mailbox wall mounted is made of durable steel with powder coated for rust resistance, suits for any weather, keeps your letter from stealing and losing. Keeps your post safe from the weather and thieves and Pet.

Search in reviews, Q&A...

### Product information

#### Technical Details

Brand	Trintion
Model Number	qinghan1501-1228
Colour	Black
Product Dimensions	32 x 8.5 x 21.5 cm
Material	Alloy Steel

#### Additional Information

ASIN	B08C75J922
Customer Reviews	★★★★★ 628 4.4 out of 5 stars
Best Sellers Rank	2,451 in DIY & Tools (See Top 100 in DIY & Tools) 5 in Wall Mount Mailboxes
Date First Available	2 July 2020

#### Feedback

Would you like to [tell us about a lower price?](#)

## **Novelty**

10. 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:

“26. ‘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.”

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

The Registered Design	The Prior Art
	

12. The designs share the following features:

- a) They are both cuboid shapes;

- b) The front face has a fairly narrow border in the same colour as the rest of the box;
- c) At the top of the box there is a flap that runs across the whole of the box (save the border) with a protruding lip that enables it to be opened easily;
- d) There is a border below the flap;
- e) The rest of the front face of the box consists of a rectangle, with a keyhole at the top of the centre and a rectangle towards the bottom. This appears to be a clear window, surrounded by a light border at the bottom, right and left of the window. It is not wholly clear whether there is a border at the top, but if so, it is very narrow; and
- f) Both boxes are black.

13. The designs differ in the following respects:

- a) The proportions are different. The prior art is longer in relation to its width than the contested design. In addition, the prior art appears to be deeper than the contested design;
- b) The appearance of the keyholes differs. In the contested design, the place for inserting the key is at the bottom, with a curved section at the top. In the prior art, the configuration is reversed, as shown below:



(contested design)



(prior art)

- c) The border between the flap and the rectangle on the front face of the contested design is narrower than the equivalent on the prior art, although it is possible that this may be the result of the different angles of the photograph; and
- d) There is a logo on the contested design at the right of the flap. It consists of an animal head with the name of the registered proprietor. The logo has not been disclaimed by the registered proprietor and therefore forms part of the registered design.

14. In my view, the difference in proportions and the presence of a logo on the registered design affect the overall appearance of the product and are therefore not an immaterial difference between the two designs. This includes the differences between the borders set out in (c) in the paragraph above. For the sake of completeness, I note here that I consider the difference between the keyholes is immaterial and likely to be overlooked. Consequently, I find that the registered design is new when compared with the prior art, and shall proceed to assess whether it has individual character.

### ***Individual Character***

15. 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.

16. 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."

17. 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 concerned*

18. Both the earlier design and the prior art are for *Post boxes*. The prior art is clearly meant to be mounted on a wall, and I consider that the contested design will also need to be mounted securely so that the recipient's mail cannot be stolen. Given the size of both designs, it is my view that these are intended for domestic use. They are too small to meet the needs of anything other than the smallest of businesses.

### *The informed user*

19. 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)."

20. The informed user of the contested design is a householder. The box is likely to be fixed to the outside of the property and so the informed user will be interested in its appearance as well as its functionality. They will possess all the traits indicated in the case law cited above.

#### *The design corpus*

21. This is the term used to describe the body of designs that already exists in the sector concerned. Neither party has filed any evidence showing other designs and so I have no information on the design corpus.

#### *Design freedom*

22. 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)."

23. The technical function of the post box requires an opening in which post can be inserted and some means of covering that opening, to protect the post from the weather. That covering will have to include a protruding part (such as a lip or a knob) to enable it to be opened by someone delivering post. There will also need to be a

larger, closable opening so that post can be retrieved without damaging it. For security, the box would be expected to be lockable. A lock will need to be placed near an opening, and there must be a surface, such as the border in these designs, to which part of the lock mechanism is attached. The box itself must be large enough to accommodate standard-sized mail, such as A4 magazines and promotional material. A cuboid shape is likely to be most convenient for these purposes, given the standard rectangular shape of envelopes.

24. Subject to the comments above, the designer has the freedom to choose the proportions of the box and its colour and any decoration. They may also have a degree of freedom over the materials, although any materials used will need to be weatherproof.

25. I have no information to tell me whether small windows are common to these products. They perform a technical function in enabling the user to see whether there actually is any post in the box before opening it, but I consider that there is some degree of design freedom over the size and appearance of the window, including any border that may surround it.

### *Overall impression*

26. I have already listed the features of the designs and identified which are similar and which are different. I keep in mind that similarity between purely functional elements should be ignored. Nevertheless, it is my view that the differences in proportions and the presence of the logo on the registered design, mean that they create different overall impressions on the informed user.

### **Conclusions**

27. The invalidation application has failed, and Design No. 6300996 will remain registered.

### **Costs**

28. The registered proprietor has been successful. As it has not been legally represented, it was informed that if it intended to make a request for an award of costs, it should complete and return a proforma detailing the time spent on various stages of

the proceedings. In the same letter, the Registry stated that if the proforma were not completed and returned, costs, other than official fees arising from the action, may not be awarded. No proforma was returned. As the registered proprietor has incurred no official fees, I make no award of costs.

**Dated this 23<sup>rd</sup> day of September 2025**

**Clare Boucher**

**For the Registrar,**

**The Comptroller-General**