

O/0881/25

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6309333

**IN THE NAME OF BEKA SPOR ZEMİNLERİ SANAYİ VE DIŞ TİCARET LİMİTED
ŞİRKETİ**

IN RESPECT OF THE FOLLOWING DESIGN



**AND AN APPLICATION FOR INVALIDATION THEREOF UNDER NO. 0094/24
BY HDM KAUÇUK ZEMİN KAP. SPOR EKİP. PEY. GERİ DÖN. İİTH.İİHR. SAN.
TİİC. LTD. ŞTİİ. (HDM)**

1. UK Registered design no. 6309333 stands in the name of BEKA SPOR ZEMINLERI SANAYI VE DIŞ TICARET LIMITED ŞİRKETİ (“the proprietor”). It has an application date of 8 September 2023 (“the relevant date”), was granted on 19 September 2023, and was published on 20 September 2023.
2. The design is registered in Sub-class 6 (Artificial or natural sheet material) of Class 5 (Textile piece goods, artificial and natural sheet material) and Sub-class 1 (Building materials) of Class 25 (Building units and construction elements) of the Locarno Classification. The design is indicated to be a floor covering. The design is depicted in the following representations:



3. The registered design is claimed as a repeating surface pattern.
4. On, 9 May 2024, HDM KAÜÇÜK ZEMİN KAP. SPOR EKİP. PEY. GERİ DÖN. İHTİ. SAN. TİC. LTD. ŞTİ. (HDM) (“the applicant”) applied to invalidate the registered design under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”). The applicant argues that the design fails to fulfil the requirements set forth in section 1B of the Act, as it is not novel and does not hold individual character compared to a design that had been made available to the public prior to the relevant date, an example of which has been provided. The applicant claims that elements of the contested design are highly similar if not identical to the earlier design (or “prior art”). The prior art relied upon is set out later in this decision.

5. The proprietor filed a counterstatement dated 27 June 2024. This claims that the design contained in the prior art provided is not identical to the the registered design, and the differences between them are on the material parts, which change the overall impression of the design on the informed user.
6. Both parties filed evidence in these proceedings, will be discussed in more detail later in this decision. Neither side filed written submissions, nor did they request a hearing. I have taken this decision after a careful consideration of the papers before me.
7. The applicant is represented in these proceedings by Murgitroyd & Company. The proprietor is represented by RightPro IP & Legal Consultancy Ltd.

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—

(1) [...]

(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

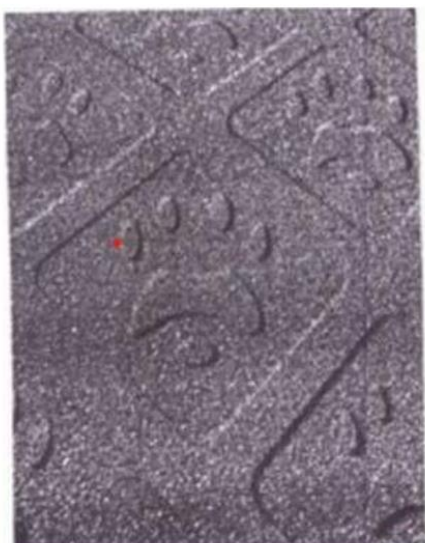
(e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(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 (as pleaded)

11. The applicant has, within its pleadings, set out the following example of prior art:

Illustration of Turkish Design 202008795 filed 27 November 2020 and published 24 December 2020. Product name – Floor covering



Evidence

12. The applicant filed its evidence in the form of a witness statement in the name of Berna Bekarouğlu, an International transactions expert. The statement is dated 21 October 2024. It introduces a copy of the Turkish design registration no. 202008795, alongside an English translation of the same, as certified in the statement. The documents evidence the registration details for the prior art as it is set out in the applicant's pleadings.
13. The proprietor filed its evidence in the form of a witness statement in the name of Hatice Ahu Güneyli Havelock, a trade mark lawyer and part qualified UK trade mark attorney representing the proprietor. The statement is dated 2 December 2024. It goes to the existences of other decisions in proceedings against the proprietor's design before the EU IPO and before the 3rd IP Civil Court of Ankara, in addition to further proceedings filed by the proprietor for the invalidation of the design relied upon as prior art within these proceedings, before 1st IP Civil Court of Ankara, which is currently pending. These are provided as Exhibits I to Exhibit III to the statement. Exhibits I and II are filed alongside two further witness statements in the name of Serhat ÜRPEKLİ, Sworn Translator for Bursa 3rd Notary and dated 2 December 2024, certifying the English translations of the decisions of the 3rd IP Civil Court of Ankara and 1st IP Civil Court of Ankara.
14. Whilst the decisions of other courts and Tribunals are noted, I make this decision based on my own considerations of the merits of the case before me.

Disclosure

15. The proprietor has not denied the disclosure of the prior art to the relevant public prior to the relevant date. However, I note for completeness, the proprietor does make the following submission in its statement of grounds, and files corresponding evidence at Exhibit III to the witness statement of Hatice Ahu Güneyli Havelock (as outlined above):

“Finally, it should be noted that the earlier Turkish design is also being challenged before the IP Court in Türkiye and the expert report indicated that it is not new due to earlier disclosures of the identical designs. It is expected that the Court will follow the expert report and cancel the HDM’s design, as well.”

16. I note at this stage that as per section 1B(5)(a) of the Act, a design has been disclosed to the public if it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before the relevant date. The prior art in this case was published as a registered design in Turkey on 24 December 2020, considerably in advance of the relevant date in these proceedings. The subsequent invalidation of this design, if it should be successful, does not therefore have any bearing on whether its publication will constitute a valid disclosure to the public.

17. For completeness, whilst I consider there to be no real dispute that the disclosure of the prior art has taken place, I note at this stage that I have no doubt the publication of a Turkish registered design will constitute a public disclosure of the same, within the meaning of section 1B(5) and without engaging the provisions of 1B(6). In *Senz Technologies BV v OHIM*¹ the General Court upheld OHIM’s decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry. I find this principle to apply equally to the Turkish IP registers, including the design register accordingly.

Interpretation of the designs

¹ Joined cases T-22/13 & T-23/13

18. Prior to assessing the novelty and individual character of the registered design, I will set out my interpretation of the same. The interpretation of the registered design is a matter for me to decide.²
19. Firstly, I consider the use of the colour grey in the registered design, and I note particularly the speckled effect shown on the same. It is my view that the use of the speckled grey colour appears to be an intentional choice that forms part of the protection offered by the registered design, and part of the comparison I must make.
20. Next, I note the proprietor has indicated the design is a repeating surface pattern. However, I consider that this claim does not appear to be entirely supported by the proprietor's submissions. For example, I note in its DF19B, the proprietor refers consistently to the design as tiles and makes references such as to "[e]ach tile plate of the contested design" containing only one paw, and to "the contested design show[ing] the joint sore[sic] of each tile". In addition to this, I consider the representation of the design itself, which appears to show inconsistent shading featuring across the pattern represented in the second image, where it would normally be the case that a repeat pattern would be shown to repeat identically. Finally, I note that in the second representation of the design, ridges are present between each of the designs shown in the first image, but no part of the ridges present feature in the first representation of the single paw print design. Again, this appears to indicate the registered design actually represents a single tile which may be joined with others of its kind to make a pattern across a floor, rather than of a floor covering such as a large sheet with a true repeating pattern.
21. That said, I note in this instance, the design in the prior art does appear to be a true repeating pattern. It is my view that if consider the registered design as a repeating pattern, it will appear to be more similar in its overall impression to the prior art than if I consider it as a single tile design. Therefore, considering the proprietor indicated this to be the case for its own design at registration; it

² See *Sealed Air Limited v Sharp Interpack Limited* [2013] EWPC 23, at [20]-[21].

is not entirely clear from the actual images that this will not be the case; and this represents to best case for the applicant; I intend to proceed with my considerations on the basis that the design as registered represents a repeating pattern across a floor covering, and not the design of a single tile. If the application to invalidate the registered design based on the prior art outlined fails in these circumstances, it is bound to also fail if I consider the registered design as a tile design consisting of a single paw print only. However, should the application for invalidation succeed on this basis, I will return to this point to consider this issue further.

Novelty

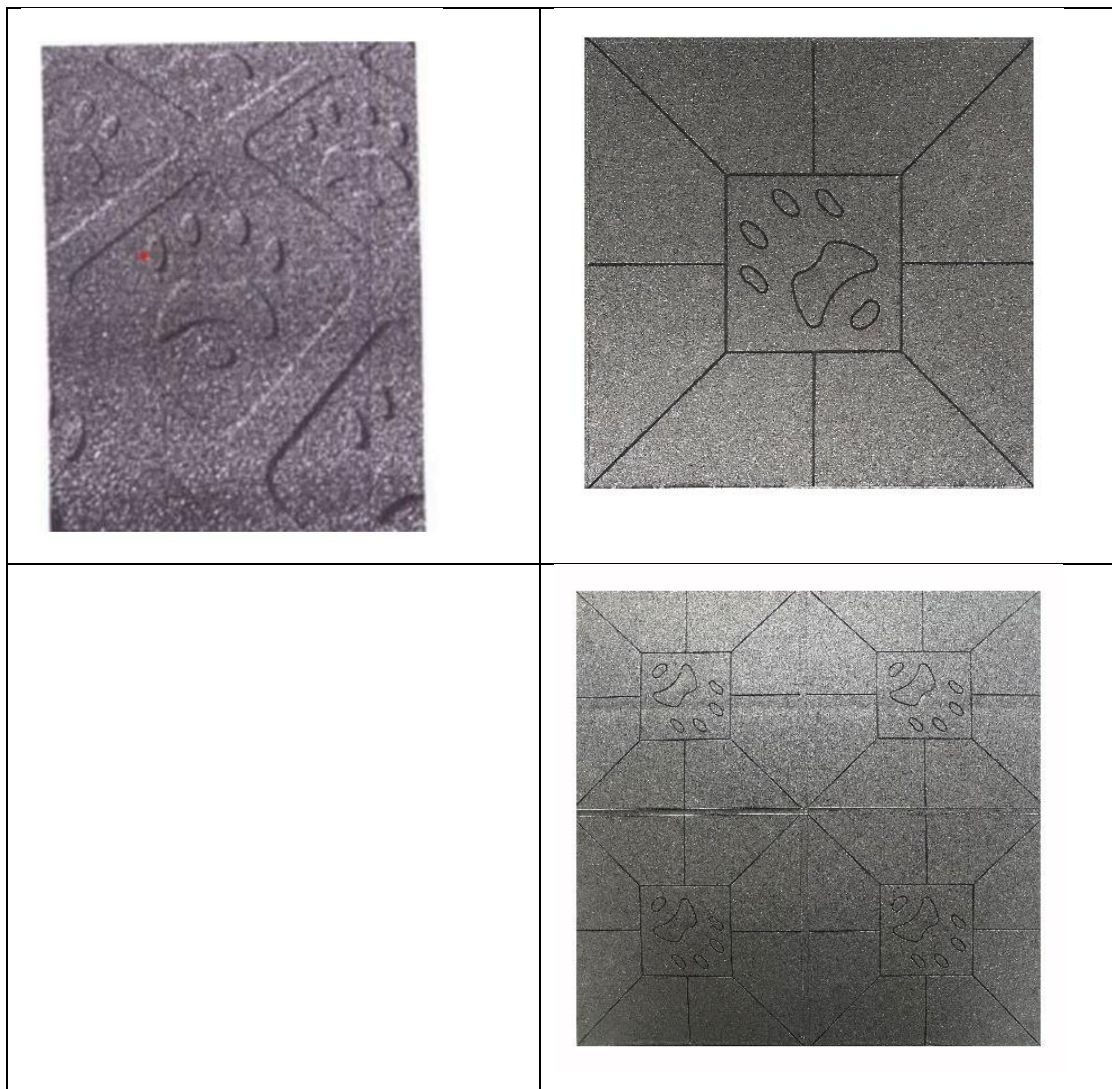
22. I therefore go on to consider the novelty of the registered design. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & 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

23. The designs for comparison are as follows:

Prior Art	Registered Design
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³ See paragraph 26



24. In its pleadings, the applicant submits:

“In each design, an animal paw print is provided within a square border.

In each design, the paw is orientated so that it is angled with respect to the square sides, i.e. it aligns with the corners of the square.

In each design, the paw itself involves 4 toe/claw elements, and a palm element formed of two parts.

In each design, the shape and configuration of the toe/claw elements and palm elements is highly similar if not identical.”

25. On the contrary, the proprietor states:

“- Each tile plate of the contested design contains one (only) paw, resulting in a simple and clean design, whereas the Turkish design has numerous paw designs in little squares, brought together as a repeating paw image, whereas the tile of the contested design is divided into 8 pieces with the paw print in the centre, which creates a totally different visual when they are put together and mounted on the floor:

[images copied]

- In the contested design, the paw is drawn as [a] slim line drawing on the tile, whereas in the earlier design, the paws are hollowed on the tile, along with the little squares framing each paw.
- The final effect of tiles in their juxtaposition is quite different. Whereas the juxtaposition of the contested design shows the joint sore of each tile, the juxtaposition of the Turkish design does not show joints at all. This is relevant since the informed user generally wants to consider the final effect of tiles in their juxtaposition, where the general impression of difference is even more evident.
- Finally, the contested design shows a smooth surface which contrasts with the rough and white dotted structure of the earlier design.”

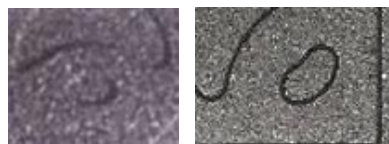
26. The registered design and the prior art share the following design features:

- As appears to be agreed by the parties, both designs include paw prints. The design of the upper pad and four toes of each paw pad appear identical. Both paw prints include a lower pad, spaced from the top pad slightly;
- In both designs, each time the paw print is featured, it is included within a square shape, with the paw print positioned at the same angle diagonally across the square, so the toes are pointing towards one corner, and the lower pad towards the opposite corner;

- In each design, the paw print takes up approximately the same space within the square in which it is featured;
- Each design features a speckled background, made up of white, grey and darker grey flecks.

27. The differences between the designs are as follows:

- In the prior art, the lower pad on the paw print design appears to be a symmetrical traditional oval shape, whereas the lower pad on the paw print design in the contested mark whilst still a sort of oval, appears more squished and raised at each end, slightly resembling the shape of a bean. This element in each design is shown below:



- In the prior art, the paw print itself and surrounding border appear to be raised from the surface. In the registered design, the paw itself appears to be flat to the surface, with the outline of the same either also flat or etched into the same.
- In the prior art, the corners of the square within which the paw print is placed are rounded. These are pointed in the registered design;
- In the prior art, the paw prints are repeated in fairly close proximity to one another, with a border between each square slightly raised and in a lattice pattern. In the registered design, the paw prints are spaced much further apart within the repeating pattern, with a series of 8 horizontal lines spanning from each square, each of which appearing to be slightly longer or a similar length to the sides of the square itself. The effect of this on the repeating pattern is that in the middle of every set of four paw prints appears a new square shape, the corners of which are overlapped by the squares featuring the paw prints. Inside this square appears an 'X' shape, with the end of each line running into the corner of the square

featuring the paw print. All of these additional elements appear to be flat or etched into the surface as opposed to raised;

- There appears to be a ridge between each paw print and set of lines in the registered design, which is possibly slightly indented;
- The colour grey used in the prior art is a slightly different shade to that which features on the registered design.

28. I note firstly that there are some similarities featured in the two designs. However, I consider that a design may be similar to the prior art, but still have features that render it new or novel. I consider that the most obvious difference between the designs is the spacing of the paw prints, and the pattern featured between the same. Further, there is the fact that the pattern in the earlier design appears raised. Whilst I note some of the differences featured, for example the slight differences in the shape of the lower pad on the paw print, are arguably immaterial, the differences created by more obvious differences outlined are not. It is my view that these differences are capable of distinguishing the registered design as new. As I have found the registered design has features which render it 'novel', I will now go on to consider if the registered design holds individual character.

Individual character

29. 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."

30. 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

31. The sector in question is that of floor coverings.

The informed user

32. 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)."

33. I consider the informed user in this case will either be a professional such as a designer or trades person used to choosing and/or fitting floor coverings for others, or a member of the general public choosing a floor covering for their own home. I note they will have a relatively good awareness of the prior art, and will pay a relatively high level of attention. Both groups will likely have aesthetic and practicality considerations at the forefront of their minds when choosing these items and I will bear this in mind when it comes to assessing the overall impression on the informed user.

Design Freedom

34. 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)."

35. I note that floor coverings will need to be relatively flat and fairly durable, so that they may be spread across a floor and walked over without getting damaged or causing people to trip. However, the choice of materials, colour, design and pattern is for the most part unrestricted. The overall freedom enjoyed by the designer of floor coverings is fairly broad, and as such only minor differences between the registered design and the prior art will not suffice to produce a different overall impression on the informed user.

Overall impression

36. The applicant pleads that due to the similarities in the designs, the registered design does not have individual character when compared to the prior art. On the contrary, the proprietor argues the differences between the designs are on the material parts, which changes the overall impression on the informed user.

37. For completeness, I note at this stage that the applicant pleads:

“At the very least, the animal paw print element of UK Design 6309333 cannot be considered new nor does it have individual character compared to Turkish Design 202008795.”

38. However, in my view it is clearly the case that in accordance with the provisions of the Act and the wording of the case law, it is all features claimed within the design as registered that must be considered, and the overall impression that the combination of these features create on the informed user when compared to the prior art. It would not, therefore, be the correct approach to take to focus on only the similarities between one element of the registered design and the prior art, unless it is considered that all other features are immaterial.

39. 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. In this case, it is my view that the informed user would pay particular attention to the general aesthetic appearance of the design, as well

as to any practical concerns. I therefore consider particularly that both the overall pattern, and the texture of the products themselves would feature highly in these considerations. Whilst I remind myself that it is the that it is the appearance of the products that are the subject of design protection, I consider that where the texture of the product does have an impact on the look of the design, for example in the prior art where the pattern appears raised, this may be taken into account in its overall impression on the informed user.

40. In this instance, as mentioned previously there are some differences between the designs that may be considered immaterial. For example, the exact shape of the lower paw pad being very slightly different, and perhaps even the slight difference in the shade of grey used (although, I note in the case of floor coverings, it is more arguable that exact the shade used will be given more attention). However, it is my view that the pattern of the design, including the spacing of the paw prints and the use of the lattice pattern in the prior art and the square and cross pattern in the registered design will constitute material differences. These are elements of the design that will be given particular consideration by the consumer, as they change the overall aesthetic appearance of the patterns considerably. Further, I find the fact that the pattern in the prior art appears raised, whilst it appears flat or etched in the later design, to also be a material difference between the designs, considering this will again considerably alter the overall appearance.

41. Overall, I find the differences in the registered design sufficient to produce an overall different impression on the informed user.

Final remarks

42. As I have found the design to be new and to have individual character at the relevant date, the application for invalidation has failed, and the design will remain registered.

Costs

43. The proprietor has been successful and is entitled to an award of costs in accordance with Tribunal Practice Notice 1/2023. I therefore award the proprietor the sum of £650 as a contribution towards the costs in the proceedings. This sum is calculated as follows:

Reviewing the statement of grounds and preparing and filing the counterstatement:	£350
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Reviewing the evidence and preparing and filing evidence:	£600
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Total	£650
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44. I therefore order HDM KAUÇUK ZEMİN KAP. SPOR EKİP. PEY. GERİ DÖN. İTH.İHR. SAN. TİC. LTD. ŞTİ. (HDM) to pay BEKA SPOR ZEMİNLERİ SANAYİ VE DIŞ TİCARET LİMİTED ŞİRKETİ the sum of £650. 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 23rd day of September 2025

R. Le Breton
For the Registrar