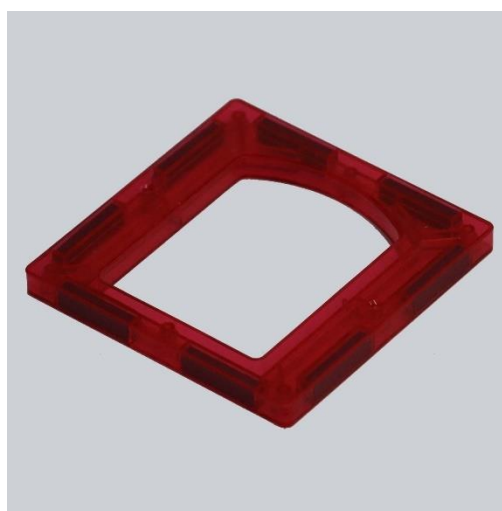
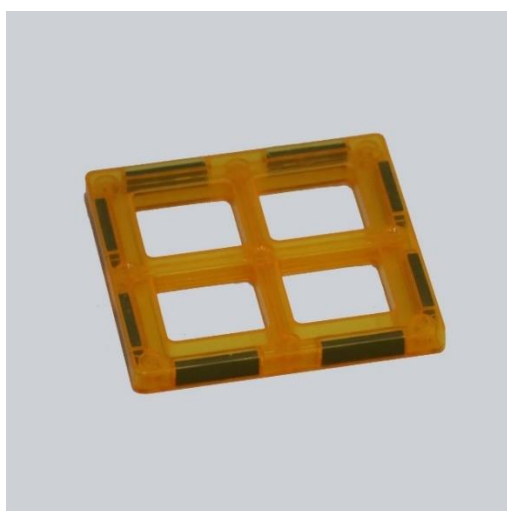


O/0906/25

REGISTERED DESIGNS ACT 1949

**IN THE MATTER OF REGISTERED DESIGN NOS. 6145708 & 6145709
IN THE NAME OF YONGKANG YUQI INDUSTRY AND TRADE CO., LTD
IN RESPECT OF THE FOLLOWING DESIGNS:**



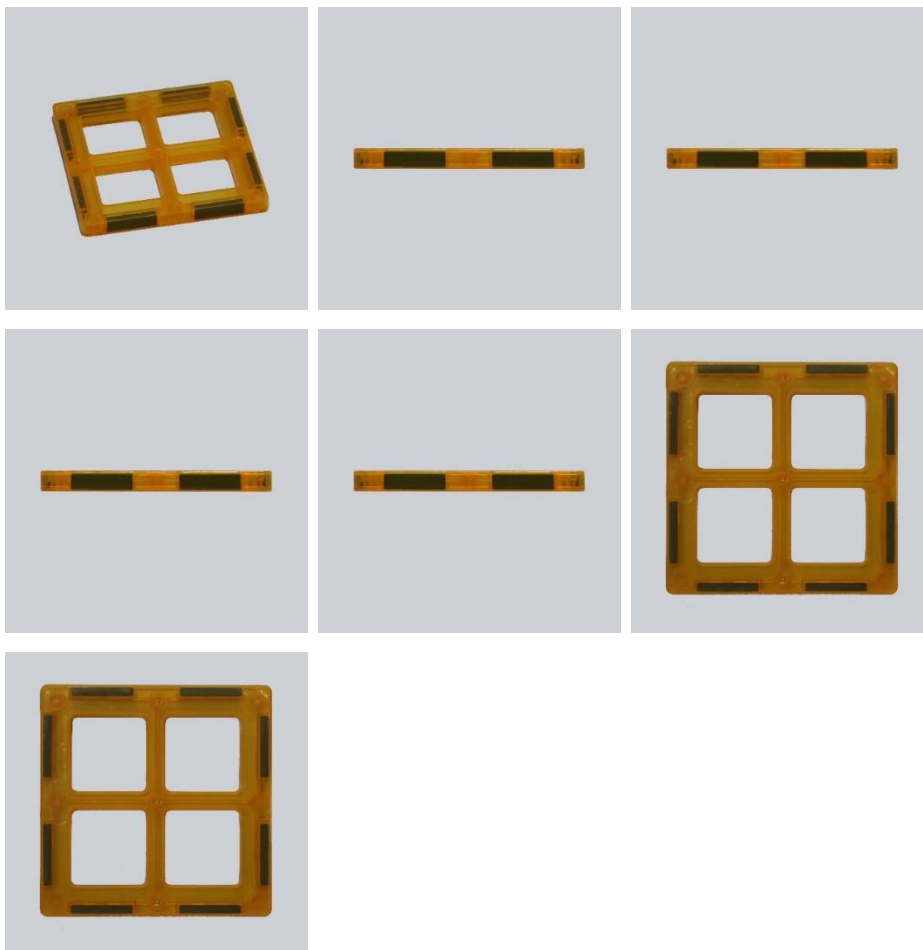
AND

**APPLICATIONS FOR INVALIDATION THEREOF
UNDER NOS. 64/24 & 65/24
BY SHENZHEN DEBAISITE TRADING CO., LTD**

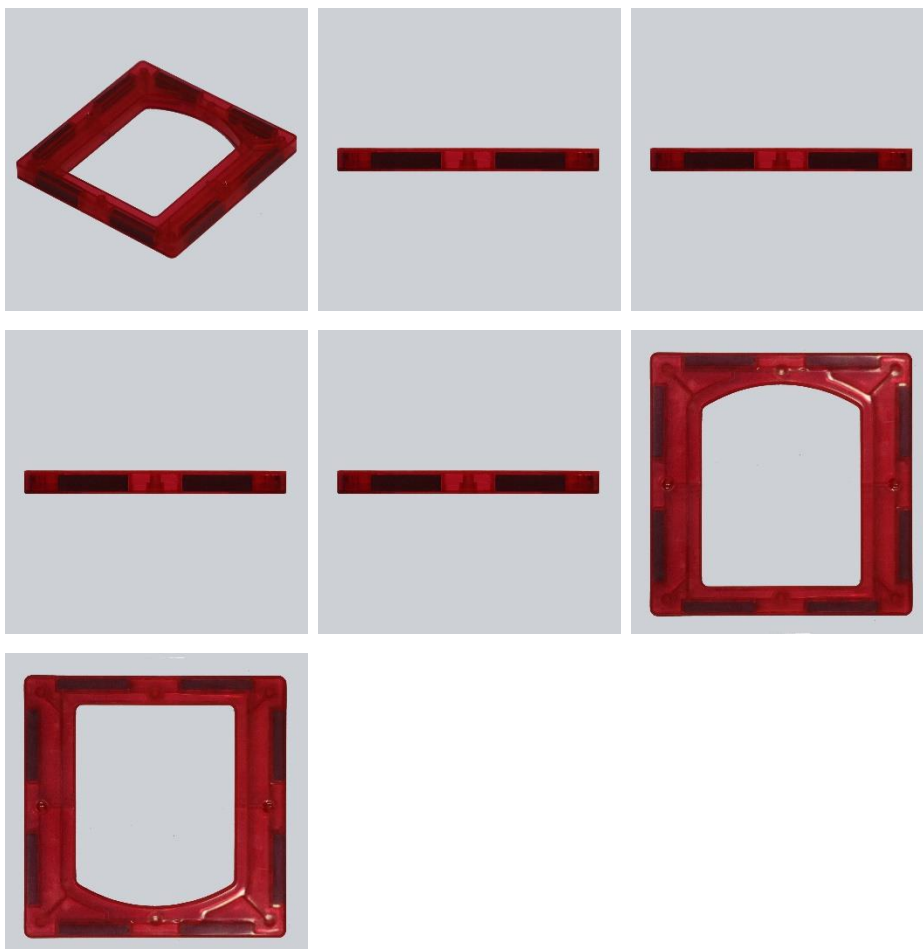
Background and pleadings

1. Yongkang Yuqi Industry and Trade Co., Ltd (“the proprietor”) filed application numbers 6145708 and 6145709 for “magnetic toy” in class 21, sub class 1 of the Locarno Classification (games and toys) on 29 June 2021 (“the relevant date”). The designs were granted with effect from 8 August 2021 and published on 9 August 2021. The designs are depicted in the representations shown below. Both registrations specify that “no claim is made for the colour shown”.

(i) Registered design no. 6145708 (“the first registered design”)



(ii) Registered design no. 6145709 (“the second registered design”)



2. On 20 March 2024, Shenzhen Debaisite Trading Co., Ltd (“the applicant”) requested that the registered designs be declared valid under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which states as follows:¹

“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.”

¹ Within its statement of grounds, the applicant refers to section 11ZA(1A) of the Act. However, in its Form DF19As, it indicated that the applications were based upon section 1B (utilised under the provisions of section 11ZA(1)(b)). From this, combined with what is said elsewhere and the examples provided of earlier designs, it is clear that reference to section 11ZA(1A) was an error.

3. The applications are based upon section 1B of the Act. The applicant claims that the registered designs are not novel and do not hold individual character when compared to multiple products which were available on the market prior to the relevant date.

4. Notices of defence and counterstatements were filed by the proprietor on 4 June 2024. The proprietor denies the ground of invalidation and submits that the registered designs are original, novel and new. The proprietor contends that it created the registered designs and made them public.

5. Both parties are professionally represented; the applicant by Greg Sach and the proprietor by IP Loilo. Neither party filed evidence during the evidence rounds, though the applicant attached evidence of claimed prior art to the applications for invalidation.² No hearing was requested and neither party elected to file written submissions in lieu. This decision is taken after a careful consideration of all the papers before me.

Relevance of EU law

6. 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

7. Section 1B of the Act reads 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 These documents constitute evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (as amended) (“the Rules”).

(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 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) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

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

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

[...]”

8. Before proceeding with the applicant’s claims, I record here a point of interpretation of the registered designs.³ The registered designs are said to be magnetic toys. In the representations supplied by the proprietor, there appear to be two magnets on all sides of the designs. On this basis, I consider that the registered designs are magnetic pieces or ‘tiles’ that can be used with other such pieces to create larger patterns or structures.

Prior art

9. The designs claimed by the applicant in its applications for invalidation to predate the registered designs are as follows:⁴

(i) Prior Art 1

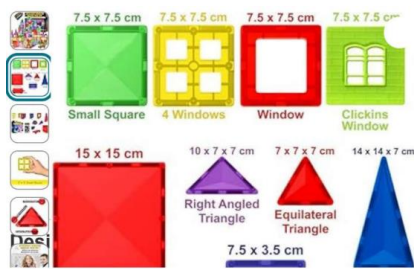
“Desire Delux Magnetic Building Blocks”

Sold on Amazon (UK)

³ The interpretation of the registered designs is a matter for me to decide: *Sealed Air Limited v Sharp Interpack Limited* [2013] EWPCC 23, paragraphs 20-21.

⁴ Annexes 1-16; The dates in italics have been provided by the applicant, rather than being visible in the evidence itself. However, the dates given by the applicant have not been challenged by the proprietor. Whilst further examples were provided, these appear to be duplicates.

Date first available: 28 February 2018



(ii) **Prior Art 2**

“Playmags 100 PCS di Contruzioni Magnetiche”

Sold on Amazon (Italy)

Date first available: 11 August 2013



(iii) **Prior Art 3**

“Playmags Kit di partenza”

Sold on Amazon (Italy)

Date first available: 2 December 2013



(iv) **Prior Art 4**

“Magblock 70pcs Magnetic Building Blocks Kids Magnetic Tiles”

Sold on Amazon (UK)

Date first available: *18 August 2020*



(v) Prior Art 5

“vatenick Magnetic Building Blocks Tiles Toy 64PCS”

Sold on Amazon (UK)

Date first available: *26 May 2021*



(vi) Prior Art 6

“Theefun 100Pcs Magnetic Tiles Shape Toys”

Sold on Amazon (UK)

Date first available: *29 October 2018*



(vii) **Prior Art 7**

“Desire Deluxe Kit Bloques de Construcción Magnéticos”

Sold on Amazon (Spain)

Date first available: 6 March 2019



(viii) **Prior Art 8**

“Magna-Tiles 2132”

Sold on Amazon (Spain)

Date first available: 7 August 2012



(ix) **Prior Art 9**

“Paymags – Juego de Baldosas Magnéticas para Construcción”

Sold on Amazon (Spain)

Date first available: 27 August 2014



(x) **Prior Art 10**

“Magblock 70pcs Magnetic Building Blocks Kids Magnetic Tiles”

Sold on Amazon (UK)

Date first available: 18 August 2020



(xi) **Prior Art 11**

“Playmags Costruzioni Magnetici”

Sold on Amazon (Italy)

Date first available: 20 November 2013



(xii) **Prior Art 12**

“VegCow 100pcs Magnetic Tiles Set”

Sold on Amazon (UK)

Date first available: 24 June 2021



(xiii) **Prior Art 13**

“Magna-Tiles Colori traslucidi”

Sold on Amazon (Italy)

Date first available: 10 August 2010



(xiv) **Prior Art 14**

“Desire Deluxe Magnetic Tiles Building Blocks Construction Toys”

Sold on Amazon (UK)

Date first available: 8 March 2021



10. I note that no evidence has been provided to support the proprietor’s claim that it made the registered designs public. It is also not entirely clear whether the proprietor is suggesting that it made the designs public before filing its applications for registration or, rather, the act of registering the designs made the designs public. In any event, the proprietor does not deny that the designs provided in, and attached to, the applications for invalidation were disclosed to the relevant public prior to the relevant date. The designs shown above were made public on Amazon (UK, Italy and Spain) before the filing of the registered designs. None of the exceptions set out in section 1B(6) of the Act applies. I am satisfied that this constitutes disclosure in accordance with the Act.

Novelty

11. 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.”

12. I will begin by comparing the registered designs with aspects of Prior Art 5 for the first registered design and Prior Art 4 for the second registered design. This is because, whilst accepting that I do not have all the views of them that I do for the registered designs, these seem to be the most similar overall to the registered design. Moreover, although these aspects are only parts of larger scale structures, they are clearly representations of what can be built with the packs of individual magnetic tiles.

The first registered design

13. The designs to be compared are as follows:⁵

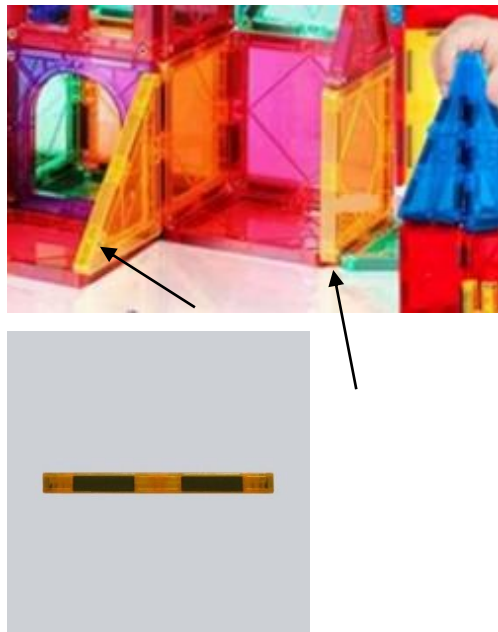
The registered design	The prior art
	

14. It is my view that the registered design and the prior art share the following design features:

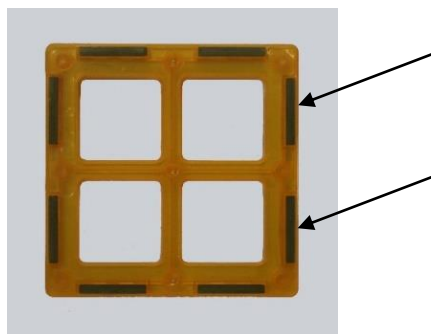
- (i) The overall shape of the magnetic tiles is square.
- (ii) The square faces feature four square gaps or ‘windows’ with rounded corners.

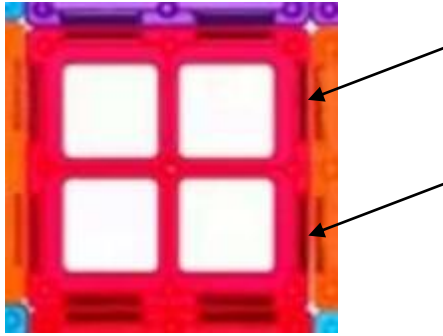
⁵ Whilst I have only included one view of the registered design here, I keep in mind all of the representations shown at paragraph 1.

(iii) The magnetic tiles are three-dimensional and appear to be of the same, or a similar, thickness. Whilst I do not have all the views of the prior art that I do for the registered design, when consulting the wider image of the prior art, it appears that all of the tiles neatly attach to one another and line up consistently. The height of these tiles appears to be the same as the prior art under consideration. From this, I infer that each individual tile is the same thickness, including the one shown in the table at paragraph 13. The thickness of some of the tiles in the same structure can be seen due to them being pictured 'side on'. Examples of this are shown below. The thickness of the registered design is also shown below.

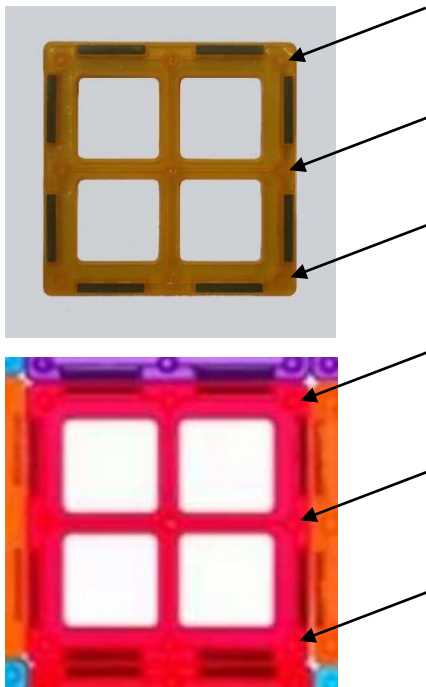


(iv) Each side of the magnetic tiles features two dark rectangles, which appear to be the magnets. This is shown below.





(v) The square faces appear to feature nine dots or circles in the same positions, namely three rows of three separated by the windows. This is shown below.





(vi) The magnetic tiles both appear to be made from a translucent, plastic (or similar) material.

15. The registered design clearly differs from the prior art to the extent that the magnetic tile is a yellow/orange colour, rather than red. At this juncture, I must consider whether the colour forms part of the registered design, and so should be compared with the prior art. As the Supreme Court confirmed in *Magmatic Limited v PMS International Limited* [2016] UKSC 12, an applicant for a design may, within broad limits, submit any images they choose to represent the design, and it will almost always

be those images that determine the scope of the protection. The registered design expressly limits the scope of its protection by disclaiming the colour features shown.⁶ I must, therefore, disregard the colour shown in the representation of the registered design; the protection afforded to the registered design is limited to its shape, configuration and any features of appearance which derive from the choice of materials, such as their translucent quality. On this basis, I find that the registered design is identical to the prior art (or that their features differ only in immaterial details). The registered design lacks novelty and, as such, fails to satisfy the requirements of section 1B(1) of the Act.

The second registered design

16. The designs to be compared are as follows:⁷

The registered design	The prior art
	

17. To my mind, the registered design and the prior art share the following design features:

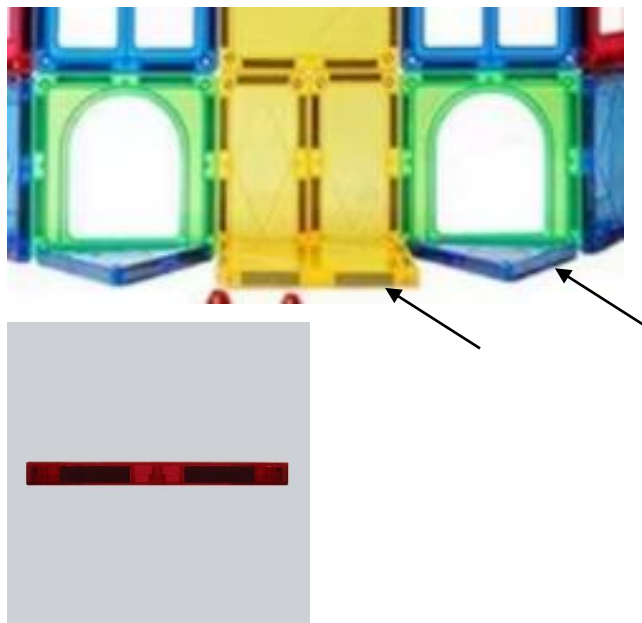
- (i) The overall shape of the magnetic tiles is square.

⁶ As per rule 6 of the Rules.

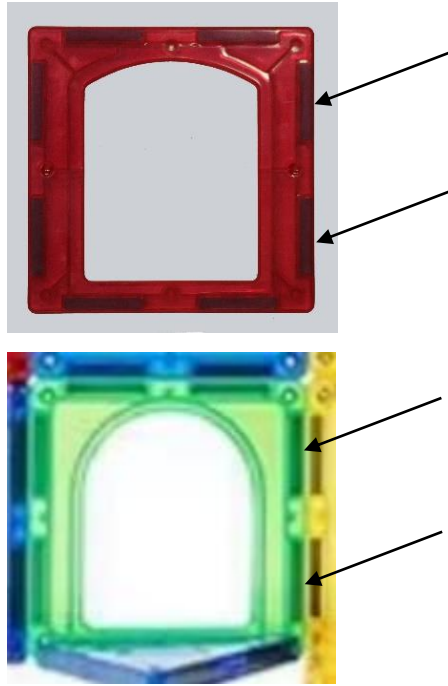
⁷ Again, I have only included one view of the registered design here, but I keep in mind all of the representations shown at paragraph 1.

(ii) The square faces feature a window, which has three straight sides and one curved side.

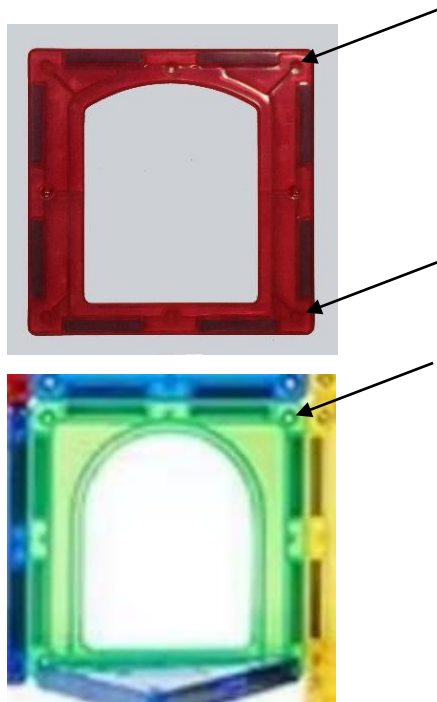
(iii) The magnetic tiles are three-dimensional and appear to be of the same, or a similar, thickness. Again, I do not have all the views of the prior art that I do for the registered design. Nevertheless, when consulting the wider image of the prior art, all of the tiles appear to neatly attach to one another and line up consistently. The height of the tiles appears to be the same as the prior art under consideration. I infer that each individual tile, including the prior art under consideration, is of uniform thickness. The thickness of some of the tiles in the same structure is visible. Examples of this are shown below. The thickness of the registered design is also shown below.



(iv) Each side of the magnetic tiles features two dark rectangles, which appear to be the magnets. This is shown below.



(v) The square faces appear to feature dots or circles in the corners. Examples of this are shown below.



(vi) The magnetic tiles both appear to be made from a translucent, plastic (or similar) material.

18. The registered design differs from the prior art in that the magnetic tile is red, rather than green. However, the registered design expressly limits the scope of its protection by disclaiming the colour features shown. As such, for the same reasons as given at paragraph 15 above, I must disregard them. More importantly, the registered design differs from the prior art because the depth of the curve is more pronounced in the prior art; it presents more like a typical arch shape, whereas the straight lines of the window of the registered design are longer, creating a shallower curve. In addition, the registered design appears to feature more dots or circles than the prior art (nine, rather than four). Taking these differences into account, it is my view that the registered design differs in more than immaterial details from the prior art. Therefore, I find that the design is new when compared to the prior art.

19. A design may be new but still lack the necessary individual character compared to the prior art. As such, I shall now go on to consider whether the registered designs have individual character.

Individual character

20. An assessment of whether a design has individual character depends on whether the overall impression it produces on the informed user differs from that of the prior art. The approach to carrying out this assessment 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."

21. 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* ("*Samsung*") [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

22. The relevant sector is that of magnetic toys. More specifically, the registered designs appear to be magnetic tiles intended for attaching to other magnetic tiles.

The informed user

23. Earlier in *Samsung*, the judge gave the following description of the informed user:

“33. [...] The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

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

- i) he (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62, *Shenzhen* paragraph 46);
- ii) however, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);
- iii) he has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned

(*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) he is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59)."

24. The registered designs are described as magnetic toys, classified under 'Games and Toys'. The informed user is a person who uses games and toys, taking a particular interest in their features. They may also be a relative or carer who purchases games and toys to give to children. I see no reason why the informed user should not be able to conduct a direct comparison of the designs in issue.

The design corpus

25. Whilst the only evidence before me comprises the designs relied upon by the applicant as disclosures, there are a relatively large number of them. Upon review of the same, the tiles in the public domain at the relevant date appeared to have some features in common; they all seem to have had magnets in the same places (around each side) and, as far as I can ascertain, appear to have been of a similar thickness.

Design freedom

26. 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).”

27. By definition, the designer will need to ensure that the tile is magnetic. It is also considered that the tile will need to be a suitable material for use by children. The designer has the freedom to choose the shape of the tile, although straight sides will make it easier to attach to other pieces. Moreover, the tile may be solid material or have gaps, and there is some freedom as to the number, size and shape of those gaps.

Overall impression

The first registered design

28. Even if I was wrong to find that the registered design lacked novelty, it is my view that, when taking into account all the above factors, as well as an analysis of the overall impression of the designs, it lacks individual character. The configuration of the registered design would, to my mind, create the same overall impression in the eyes of the informed user as the prior art. Consequently, I find that the registered design fails to satisfy the requirements of section 1B(1) of the Act.

The second registered design

29. I have already outlined the features of the designs and identified the similarities and differences. I acknowledge that similarity between features which are purely dictated by technical function are to be ignored. This includes the presence of magnets on the sides of the tiles and the straight sides of the tiles. I also bear in mind that, whilst the informed user does not merely perceive designs as a whole without any

analysis of details, minute scrutiny by the informed user is not the right approach.⁸ However, the design corpus suggests that tiles in the public domain at the relevant date all had two magnets on each side, were of a similar thickness, and that it was relatively common for them to be square shaped. This all means that the difference created by the curve, namely the shallower curve in the window of the registered design, takes on a greater significance. Considering all of the elements, it is my view that this difference is sufficient to produce a different overall impression on the informed user. As a result, I find that the registered design does have individual character, such that it satisfies the requirements of section 1B(1) of the Act.

Conclusion

30. The application for invalidation against the first registered design has been successful, whilst that against the second registered design has been unsuccessful. Subject to a successful appeal against this decision, registered design number 6145708 will be declared invalid under section 11ZA(1)(b) of the Act. Registered design no. 6145709 will remain registered.

Costs

31. As both parties have achieved what I regard as an equal measure of success, I direct that they should bear their own costs.

Dated this 29th day of September 2025

James Hopkins
For the Registrar

⁸ *Samsung*, paragraph 58