

O/0999/25

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6215260

OWNED BY C&L (SW) LIMITED

AND

APPLICATION NO. 282/24

BY ANTHONY BYRNE

BACKGROUND AND PLEADINGS

1. The design which is the subject of the dispute was filed by C&L (SW) Limited (“the proprietor”) on 22 June 2022. The contested design is for a “remote control” and is depicted in the representations shown in the Annex to this decision. For ease of references the following two images capture all of the details visible from the registered design:



2. On 18 November 2024, Anthony Byrne (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that the contested design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a) [...]

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

3. The applicant claims that the contested design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

4. The proprietor filed a counterstatement denying the claims made.

5. Neither party is represented.

6. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of all of the papers on file.

EVIDENCE AND SUBMISSIONS

7. Both parties filed documents with their DF19A or DF19B. They did not file evidence during the evidence rounds. As both of these documents are accompanied by a statement of truth, I will treat these documents as evidence.

8. The applicant filed very short written submissions during the evidence rounds.

DECISION

9. 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) 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) it was made to a person other than the designer, or any successor in title of his, under condition 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 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.

...”

10. The relevant date is the application date for the contested design i.e. 22 June 2022.

The Prior Art

11. In order to be considered prior art, the design relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6).

12. The documents relied upon by the applicant all relate to a product described as the “Alexa Voice Remote”. They are as follows:

- a. The first document relied upon by the applicant is a report dated 17 August 2020 which the applicant states was taken from the FCC website. I understand “FCC” to be a reference to Federal Communications Commission, which is part of the United States Government.
- b. The second document relied upon by the applicant is an extract from a product manual for the Alexa Voice Remote. The applicant says that this document is available on Amazon UK, but no date has been provided as to when this was made available.

- c. The third document is a screenshot of what the applicant describes as a YouTube video. The YouTube website is not actually visible, all that can be seen are stills of the Alexa Voice Remote. The applicant states that this was uploaded on 5 June 2021, although this is not visible from the document itself.
- d. The fourth document is a picture of the Alexa Voice Remote, alongside the words “2021 3rd-Gen Alexa Voice Remote”. No other context can be seen from the document, but the applicant states that it is taken from “a website that announced the new release” of the Alexa Voice Remote and was “posted on 2nd February 2022”.

13. A photograph of the product relied upon by the applicant can be seen at paragraph 19 below.

14. The proprietor submits that the document relating to Amazon UK could have been manipulated by altering the image attached to the listing so that the date on which the listing is recorded as having first been made available appears to relate to the product in issue when, in fact, it relates to an entirely different product.

15. Given that the document provided by the applicant does not actually display a date on which the product was first made available, I am not clear what relevance this submission has. The proprietor has not challenged the descriptions of the documents provided by the applicant i.e. it has not challenged the claims that the product was posted on Amazon (or any of the other forums described by the applicant). Instead, it focuses upon the date on which it was posted (as discussed above) and the similarity (or lack thereof) between the prior art and the contested design. Specifically, the proprietor notes:

“The 2 attachments of photos from the applicant, where is the date of proof that this remote was made before mine, because the 2 photos they uploaded are pictures with no date it was made?”

16. This statement by the proprietor put the date of the photographs which are undated in issue in these proceedings. The applicant had an opportunity to file evidence during the evidence rounds, at which point it would have been easy for the applicant to provide screenshots of the actual websites from which the photographs were taken with dates showing. It did not do so. I note that it did file a letter which included dates for some of the documents in issue. However, as these were not filed in the correct evidential format (in particular, they were not accompanied by a statement of truth), I cannot take them into account. Consequently, I am not prepared to take its narrative as to the dates at face value.

17. The only document that the applicant can, therefore, rely upon is the one taken from the FCC website, which is, itself, dated. I recognise that this disclosure was made on a website operated by the US Government and, therefore, not within the geographical area of the UK and the European Economic Area. Consequently, there is potentially an argument here that this disclosure could not reasonably have become known before the relevant date in the normal course of business to persons carrying on trade within that geographical area.¹ However, that line of argument was not raised by the proprietor as part of their defence (or subsequently). In any event, the case law tells us that disclosures made outside of the territory are not necessarily obscure.² Indeed, if the proprietor had wanted to claim that a disclosure on the US Government website was too obscure such that it could not be known to the relevant sector, then the burden of proving that fact would fall on the proprietor.³ It has not filed any evidence to support such a claim. Consequently, I find that the disclosure on the FCC website is one that the applicant is entitled to rely upon. As it was made prior to the application date for the contested design, it qualifies as prior art.

Novelty

18. 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

¹ See section 1B(6) of the Act.

² *Senz Technologies BV v OHIM*, Joined Cases T-22/13 and T-23/13.

³ *Crocs, Inc. v EUIPO*, Case T-651/16

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.”⁴

19. The designs to be compared are as follows:

The Prior Art	The Contested Design
	

⁴ Paragraph 26.



20. In my view, the designs share the following attributes:

- a. They both appear to be the same size and shape, with a flat rectangular front with rounded edges, and a curved section to the back.
- b. They both share a large circular button at the top centre, with the same shape and layout of the buttons surrounding it.
- c. The majority of the buttons on each of the remotes display identical signs, presented in exactly the same way (see below for the exceptions to this).
- d. They both have a small oval mark at the top of the remote, which appears to identify the location at which a light would show when the remotes are in use.
- e. They both have a curved panel in the same size and shape at the back of the remote, which is most likely the location for batteries to be placed.
- f. Three of the four horizontal oval-shaped buttons at the bottom of the remote share the same colours, in the same positions (blue and white in the top left, red and white in the top right and black and white in the bottom left).

21. However, they differ in the following ways:

- a. The central circular button at the top of each remote is different; in the prior art it is black with a white microphone device displayed on it, whereas in the contested design it is blue, with a white circle displayed on it.
- b. The prior art displays a rectangular patch at the bottom of the front of the remote, which appears to be the place where a trade mark would appear; this is absent in the contested design.
- c. The fourth horizontal oval-shaped button in the prior art is presented in a green and white colourway, whereas in the contested design it is dark blue and white.
- d. The prior art displays a circular indent at the back, which is absent from the contested design.
- e. The contested design displays an arrow device at the back, which is absent from the prior art.
- f. Although it is not completely clear from the images provided, it appears that the prior art is matt in appearance, while the contested design has a slight gloss finish.
- g. In the prior art, the text on each of the horizontal oval-shaped buttons at the bottom of the remote is *Partner 1*, *Partner 2* etc, whereas in the contested design it reflects the branding of well-known streaming services. I bear in mind that the partner buttons may be replaced with the relevant streaming services at some point in the future.

22. In my view, these differences cannot be described as immaterial. Consequently, I do not consider that the contested design lacks novelty. I will now go on to consider whether the contested design has individual character when compared with the prior art.

Individual character

23. A design may be “new”, but still lack the necessary “individual character” compared to 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.

24. 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* [2018] EWHC 345 (Pat). 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 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,

(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.”

25. 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):

“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.”⁵

⁵ Paragraph 58.

The Informed User

26. 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)."

27. The contested design is for a remote control. The informed user is, therefore, most likely to be a member of the general public using an electronic device which requires a remote control. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

28. No evidence has been filed regarding the type, range or variety of remote controls that were available at the relevant date.

Design Freedom

29. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) stated at paragraph 34 that:

"... 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)."

30. A designer of a product of this kind will, inevitably, be constrained by the function of the product as it needs to be of a shape and size that will fit comfortably in the user's hand and possess the necessary buttons to enable the user to navigate the associated electronic device. There will also be the need for a secure area in which the batteries can sit, and an easy way of this being accessed by the user for the purposes of replacing those batteries. There will be some freedom within these limits as to the

shape, size, colour and layout of the buttons (albeit they will need to be positioned on the topside of the remote for usability).

31. In my view, the contested design and the prior art will create the same overall impression on the informed user. The layout of the buttons is identical in each design, and the overall shape is the same. In my view, the differences have far less impact than the similarities overall. Consequently, the contested design does not have individual character.

CONCLUSION

32. Registered design no. 6215260 is declared invalid under section 11ZA(1)(b) of the Act.

COSTS

33. The applicant has been successful and is entitled to a contribution towards its costs. The applicant has not been professionally represented in these proceedings but has filed a costs proforma setting out the time spent in pursuit of the application.

34. The applicant has claimed 2 hours for completing the Form DF19A, 2 hours for commenting on the other side's evidence and 20 hours for completing written submissions. I take the latter to include the time spent in the preparation of the evidence that was filed with the DF19A. I consider 2 hours to be appropriate for completion of the Form DF19A. In my view, 10 hours in total is reasonable to cover the preparation of evidence and submissions.

35. In relation to the hours spent on these proceedings, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets out the minimum level of compensation for litigants in person in Court proceedings at £19.00 per hour. I see no reason to award anything other than this. I therefore award the applicant the sum of £228 (being 12 hours at £19 per hour) plus £48 for the official fee, being a total of **£276**.

36. I hereby order C&L (SW) Limited to pay Anthony Byrne the sum of **£276**. 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.

Dated this 28th day of October 2025

S WILSON

For the Registrar

ANNEX



