

O/0038/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6204523

IN THE NAME OF AFFARGO LTD

IN RESPECT OF THE FOLLOWING DESIGN:



**AND AN APPLICATION FOR INVALIDATION THEREOF UNDER NUMBER 08/24
BY LIBO SUN**

BACKGROUND AND PLEADINGS

1. UK Registered design no. 6204523 ("the contested design") stands in the name of Affago Ltd ("the Proprietor"). It has an application date of 25 April 2022 ("the relevant date"), was granted on 19 May 2022 and was published on 20 May 2022.
2. The contested design is registered as applying to stationery and office equipment, artists' and teaching materials, and materials and instruments for writing by hand, for drawing, for painting, for sculpture, for engraving and for other artistic techniques (Class 19, sub-class 06 of the Locarno classification). The indication of the product is given as "Magnetic pen". The contested design is depicted in the following representation:



3. On 8 January 2024, Libo Sun ("the Applicant") applied to invalidate the contested design under section 11ZA(1)(b) of the Registered Designs Act 1949 ("the Act"), on the grounds that it fails to fulfil the requirements set forth in section 1B of the Act. The Applicant claims it was not novel and did not hold individual character when compared to prior designs that had been made available to the public at the relevant date, seven examples of which have been provided in its pleadings, one being Chinese design number 201430360118.6. The Applicant claims the contested design is similar to, and not significantly distinguishable from, the prior designs, set out later in this decision.

4. The Proprietor filed a counterstatement dated 17 March 2024. This claims that the application for invalidation should be rejected in its entirety on the basis that: (i) the Chinese design is not strikingly similar to the contested design and (ii) the images of the remaining six prior designs are not sufficient evidence of the disclosure of such designs, because the information might have been altered or removed and may not show the content that was available before the relevant date. The Proprietor has not addressed, neither by admitting nor denying, the claimed similarity between the contested design and the remaining six prior designs.

5. The Applicant filed evidence in the form of a witness statement in his own name¹ and five exhibits (LS1-5), which will be discussed in more detail later in this decision. The Proprietor did not file evidence or submissions in these proceedings. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me.

6. The Applicant is represented in these proceedings by Paweł Wowra; the Proprietor represents itself.

DECISION

Relevant legislation

7. Section 11ZA(1)(b) of the Act states:

“(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 Dated 10 May 2024. Following Tribunal correspondence dated 14 May 2024 highlighting a discrepancy between a date in the statement and the corresponding date in Exhibit LS1, an amended witness statement was filed on 23 May 2024.

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 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.

[...]"

Prior Art

9. The designs claimed by the Applicant in its statement of case to be earlier designs are shown below:

(i) Design 1



Sold on Amazon UK

ASIN: B099257LCY

Date first available: 18 August 2021

(ii) Design 2



Sold on Amazon UK

ASIN: B0BWFP77PY

Date first available: 24 November 2021

(iii) Design 3



Package including:

13 x magnetic tubes
2 x large sized metal balls
8 x middle sized metal balls
2 x gel pen caps
1 x gel pen point tube
1 x clip
2 x refill
2 x touch screen tips

Sold on Amazon UK

ASIN: B09THCHFJ1

Date first available: 26 February 2022

(iv) Design 4



Sold on Amazon UK

ASIN: B09XB2VCWF

Date first available: 6 April 2022

(v) Design 5

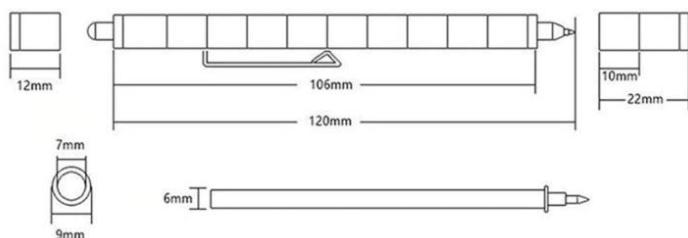


Sold on Amazon UK

ASIN: B09Y3MCG99

Date first available: 19 April 2022

(vi) Design 6



Sold on Amazon UK

ASIN: B09Y9DDQJJ

Date first available: 19 April 2022

(vii) Design 7



磁性笔	
Locarno class	19.06
Domestic classification	
Design number	201430360118.6
Application number	201430360118.6
Application language code	ZH
Registration office code	CN
Application date	26/09/2014
Registration date	15/04/2015
Publication date	15/04/2015
Verbal element	-
Design description	1. 本外观设计产品的名称: 磁性笔。2. 本外观设计产品的用途: 用于写字, 此笔每一段都是磁性铁, 可以由多个磁性铁磁性配合组装成笔筒。3. 本外观设计产品的设计要点: 在于产品的整体形状。4. 最能表明本外观设计设计要点的图片或照片: 立体图。
Expiry date	-
Effective date	15/04/2015
Design current status code	Design lapsed
Designated countries	-
Design current status date	09/11/2016

China data last updated on: 30/12/2023

10. Save for Design 7 (Chinese design number 201430360118.6), the Proprietor challenged the reliability of the above evidence, claiming that “the information accessible might be altered or removed and, therefore, may not show the content that was available for the public before the date of filing of the UK design” and that the evidence “should be supported by additional evidence such as printout or screenshots of the relevant information showing the full URL address of a website”.² These

² Paragraph 4 of the Proprietor’s counterstatement.

submissions from the Proprietor have been challenged by the Applicant, who in its evidence filed full-page printouts from Amazon UK demonstrating the ASINs and corresponding ‘first available’ dates for Designs 1, 2 and 4 shown above.³ The printouts also show the full URL, as requested by the Proprietor, and the date on which they were accessed. The Applicant’s witness statement explains that the ‘date first available’ cannot be altered and is permanently recorded once the product is placed online. The Proprietor did not respond to this evidence, either with evidence or submissions. In civil proceedings, facts are to be decided on the balance of probabilities. In my view, in the absence of evidence to the contrary from the Proprietor, the Applicant’s exhibits provide *prima facie* evidence that the products shown therein (Designs 1, 2 and 4) were first made available to the public on the date stated. I shall therefore treat this as disclosure of the prior art in accordance with Section 1B(5) of the Act. I will proceed on the basis of Designs 1, 2 and 4 and return to the remaining prior designs if necessary.

11. As noted above, in its counterstatement, the Proprietor does not explicitly deny the Applicant’s claim that the contested design is similar to, and not significantly distinguishable from, Designs 1, 2 and 4. As I have dismissed the Proprietor’s argument regarding the reliability of the Applicant’s evidence, there is now no basis upon which the Proprietor defends the Applicant’s pleaded case that the contested design, on the basis of the aforementioned prior designs, is neither new nor has individual character.⁴ In my view, the application for invalidation succeeds at this point. Nevertheless, in case I am wrong, and for reasons that will become apparent, I will proceed to assess the Applicant’s claim on its merits.

Novelty

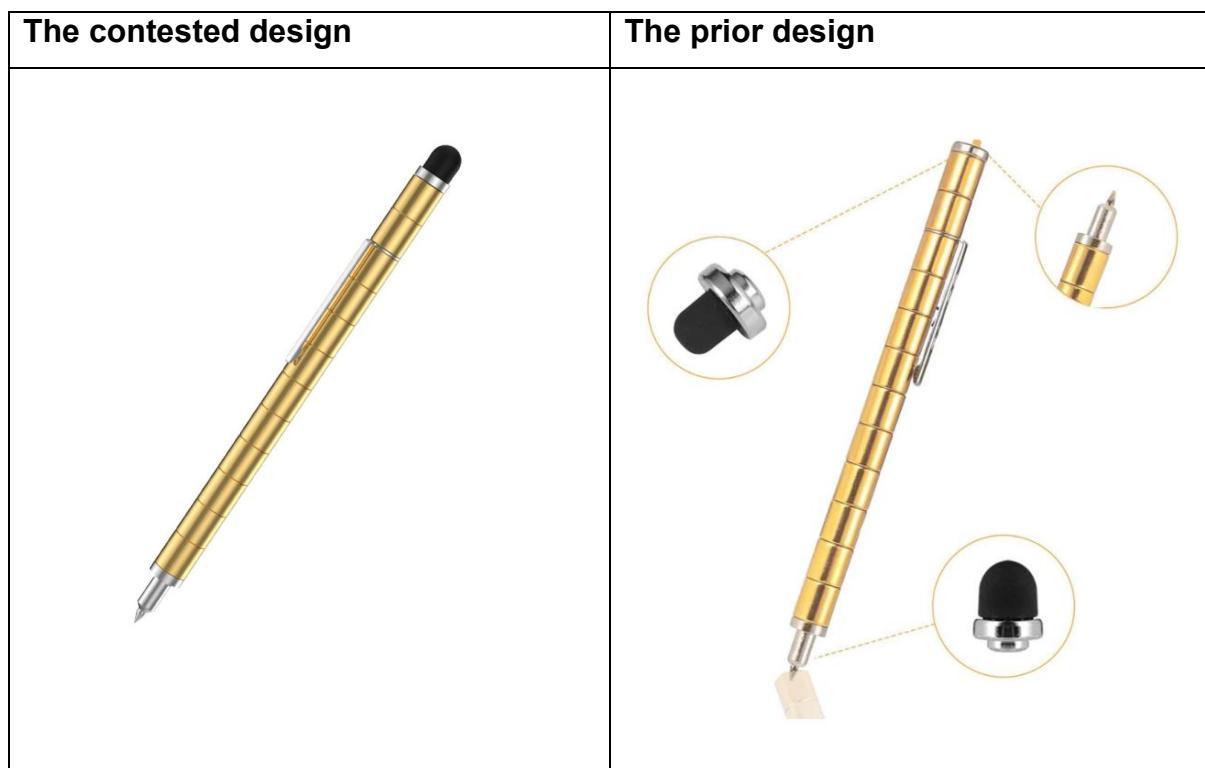
12. Section 1B(2) of the Act states that a design has novelty if no identical design, or no design differing only in immaterial details, has been made available to the public before the relevant date. In *Shnuffle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

³ At Exhibits LS2, 3 and 4, respectively.

⁴ See *Delta Air Lines, Inc v Ontro Limited*, BL O/044/21. Although this is a trade mark decision, I consider that the reasoning on the pleadings point applies to registered design cases also.

“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.”

13. I will begin by comparing the contested design with Design 4, shown at paragraph 9(iv) above, hereafter referred to as “the prior design”. This is because it appears to be the most similar overall to the contested design. The designs to be compared are as follows:



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

- a. The writing instruments are both comprised of 12 gold-coloured cylindrical segments.

- b. Each features a silver-coloured nib comprised of three parts: a short cylinder the same width as the aforementioned 12 cylindrical segments, a longer, narrow cylinder, and a pointed tip.
- c. A silver-coloured clip is attached at the same position in the upper portion of each writing instrument: two cylindrical segments from the top. Each clip is oblong-shaped and of the same length, running the length of around 3.5 of the cylindrical segments.
- d. On the opposite end to the nib of each writing instrument is a silver and black, cylindrical tip with a rounded end.

15. I note that the tip described at point (d) above is attached in the representation of the contested design but unattached in that of the prior design. However, it is clear from the representation of the prior design that the tip can be attached to one (or either) end of the writing instrument, in which case it would be in an identical position to that of the contested design.

16. I cannot identify any (or any material) differences between the contested design and the prior design. If I am wrong and there is a perceived difference in: (i) how pointed the tip of the nib of each writing instrument is; or (ii) how closely set the 12 gold-coloured, cylindrical segments are when attached, I consider such differences to be both minor and trivial to the extent that they are immaterial. The designs are therefore identical, or differ only in immaterial details. Accordingly, the contested design lacks novelty and fails to satisfy the requirements of section 1B(1) of the Act. Even if I am wrong about this, the Proprietor's only challenge to the application for invalidation based on Design 4 related to the reliability of the Applicant's evidence, i.e. it did not deny that the registered design lacks novelty when compared to that design.

17. For the sake of completeness, I note that, as I have found that the design lacks novelty, I also consider it would create the same overall impression on the informed user. Therefore, it does not have individual character.

Conclusion

18. The application for invalidation has been successful. Subject to any appeal against this decision, design number 6204523 will be declared invalid under section 11ZA(1)(b) of the Act.

Costs

19. The Applicant has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 1/2023. I award the Applicant the sum of £898 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee:	£48
Preparing a statement and considering the other side's statement:	£250
Filing evidence:	£600
Total:	£898

20. I therefore order Affargo Ltd to pay Libo Sun the sum of £898. 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 final determination of the appeal proceedings.

Dated this 21st day of January 2026

MRS E FISHER
For the Registrar