

O/0182/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6314226

IN THE NAME OF FEOBA TECH LIMITED

IN RESPECT OF THE FOLLOWING DESIGN



AND

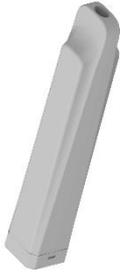
AN APPLICATION FOR THE INVALIDATION THEREOF

UNDER NO 187/24

BY SHENZHEN SKE TECHNOLOGY CO., LTD

BACKGROUND AND PLEADINGS

1. Registered Design No. 6314226 stands in the name of Feoba Tech Limited (“the registered proprietor”). The design was applied for on 22 September 2023 (“the relevant date”), registered on 29 September 2023 and published on 30 September 2023. The design is registered as applying to electronic cigarettes and is depicted in the following representations:



(“Main illustration”)



(“Illustration 2”)



(“Illustration 3”)



("Illustration 4")



("Illustration 5")



("Illustration 6")



("Illustration 7")

2. The registered design is registered as being in Class 27 (Tobacco and Smokers' Supplies), Sub class 07 (Electronic cigarettes and other electronic smoking supplies) of the Locarno Classification.

3. On 1 August 2024, Shenzhen SKE Technology Co., Ltd (“the applicant”) made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design did not meet the requirements set out in section 1B of the Act that a design be new and have individual character. The applicant claims that the contested design lacks novelty and individual character when compared with Registered Design No. 6213529, which is owned by the applicant and was published on 5 July 2022, and with a product shown in a YouTube video published on 7 March 2023 entitled “SKE Crystal Bar 600 Review”. Screenshots from this video have been provided. I reproduce the representations in Registered Design No. 6213539 and the YouTube screenshots later in my decision. The Form DF19A has been signed by Isabelle Bertaux, the applicant’s representative, and contains a statement of truth. I shall treat the statement of grounds as her evidence, pursuant to Rule 21 of the Registered Designs Rules 2006.

4. The registered proprietor filed a defence and counterstatement to the application for invalidation on 24 September 2024. It claims that the contested design has “*significant distinguishing design features*” when compared to the designs relied on by the applicant. The rest of the counterstatement sets out these alleged differences, and I shall come back to these comparisons in due course.

5. The applicant filed evidence in the form of a witness statement from Fanyun Liu, who is the intellectual property engineer of Shenzhen SKE Technology Co., Ltd. Their witness statement is dated 31 December 2024 and is accompanied by five exhibits. The evidence concerns the relative importance of different views of an electronic cigarette. At the same time, the applicant filed written submissions.

6. Neither side requested a hearing or filed written submissions in lieu of the same. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by IBE Avocat and the registered proprietor by Way Insight IP Services LTD.

RELEVANCE OF EU LAW

7. 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

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

“The registration of a design may be declared invalid –

...

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

9. 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.

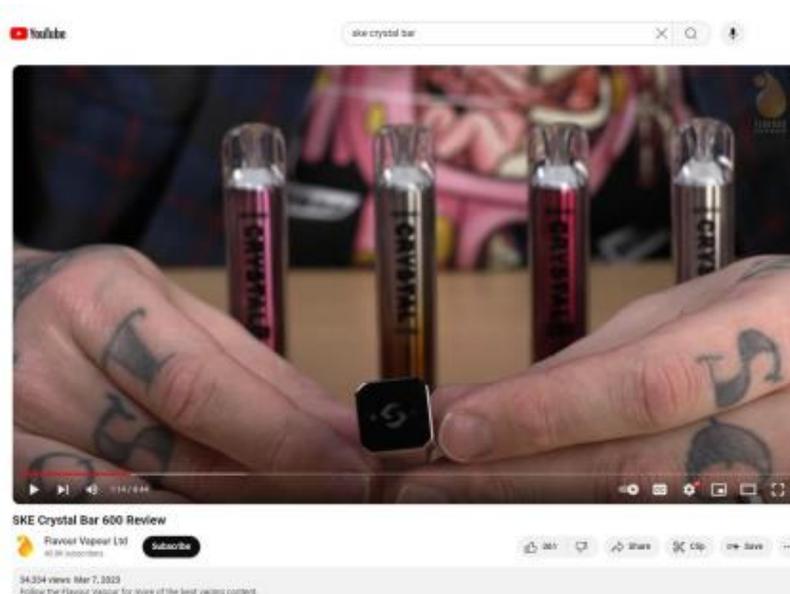
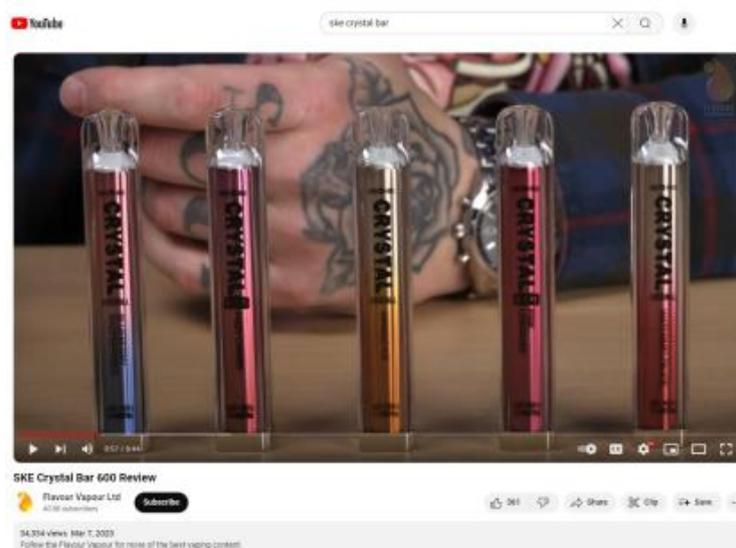
(7) In subsections (2), (3), (5) and (6) above ‘the relevant date’ means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

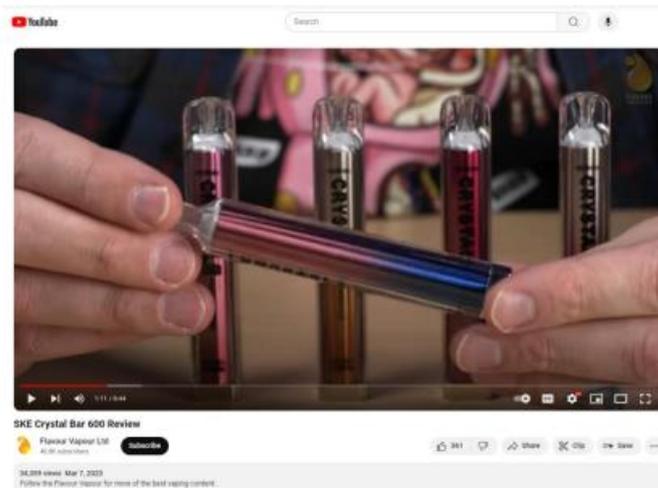
...”

The Prior Art

10. As I have already noted, two items of prior art are relied upon by the applicant. The first of these is Registered Design No. 6213529, which was published on 5 July 2022, which is earlier than the relevant date. The representations of this design can be seen in [paragraph 15] below. Publication by the Registry is a disclosure on which the applicant may rely.

11. The second is a YouTube video published on 7 March 2023 and the following screenshots have been provided:





12. The date of publication is earlier than the relevant date in these proceedings and the registered proprietor has not claimed that any of the exceptions provided for by section 1B(6) apply in respect of this video. Consequently, I find that this is also prior art on which the applicant may rely.

13. I shall begin by comparing the contested design to Registered Design No. 6213529. This is because the design is shown from many of the same angles used in the representations of the contested design. I shall come back to the second example of prior art later if necessary.

Novelty

14. 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.”

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

The Contested Design	The Prior Registered Design
 <p data-bbox="461 539 711 577">(Main illustration)</p>	
 <p data-bbox="496 927 695 965">(Illustration 2)</p>	
 <p data-bbox="515 1326 715 1364">(Illustration 3)</p>	
 <p data-bbox="539 1744 738 1783">(Illustration 4)</p>	

The Contested Design	The Prior Registered Design
 <p data-bbox="536 613 730 651">(Illustration 5)</p>	
 <p data-bbox="464 981 659 1019">(Illustration 6)</p>	
 <p data-bbox="453 1317 647 1355">(Illustration 7)</p>	

16. The applicant claims that the designs share the same shape and proportion, namely a squared bar shape with a square mouthpiece and a carved pattern on the bottom. From the front and back, it argues, the edges of both designs are squared, while from the side they are trapezoid. In its view, the only difference is the pattern on the base of the product.

17. I observe that the base of the prior design is lighter in colour than the upper part of the electronic cigarette. This can be seen in a comparison of the Main Illustration or any of Illustrations 2-5 and the equivalent representation of the prior design. The applicant submits that the colour shown in the prior art should not be taken into account, as the comparison should be made on the basis of the features shown in the

contested design. The interpretation of the representations in the designs is a matter for this tribunal: see *Sealed Air Limited v Sharp Interpack Limited & Anor* [2013] EWPC 23, paragraph 20. In *Magmatic Ltd v PMS International Ltd* [2016] UKSC 12, Lord Neuberger (with whom the rest of the Supreme Court agreed) held that:

“30. Article 3(a) of the Principal Regulation [Regulation No 6/2002] identifies what is meant by ‘design’, and, unsurprisingly, it refers to the appearance, which is expressed to include a number of different factors, all, some or one of which can be included in a particular registered design. It is, of course, up to an applicant as to what features he includes in his design application. He can make an application based on all or any of ‘the lines, contours, colours, shape, texture ... materials ... and/or ... ornamentation’ of ‘the product’ in question. Further, he can make a large number of different applications, particularly as the Principal Regulation itself provides that applications for registration have to be cheap and simple to make. As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, ‘[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs’. So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.

31. Accordingly, it is right to bear in mind that an applicant for a design right is entitled, within very broad limits, to submit any images which he chooses. Further, in the light of article 36(6), an applicant should appreciate that it will almost always be those images which exclusively identify the nature and extent of the monopoly which he is claiming. As Dr Martin Schlötelburg, the co-ordinator of OHIM’s Designs Department has written, ‘the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them’ – *The Community Design: First Experience with Registrations* [2003] EIPR 383,

385. And, as Dr Schlötelburg went on to explain, an applicant is free to indicate which, if any, aspects of the images of a Community Registered Design are disclaimed:

‘Where an applicant wishes to exclude features which are shown in the representation for explanatory purposes only, but do not form part of the claimed design, he may disclaim those auxiliary features by depicting them in broken lines (for drawings) or by means of colouring them (for black and white drawings or photos) or encircling them (for any drawing or photo).’”

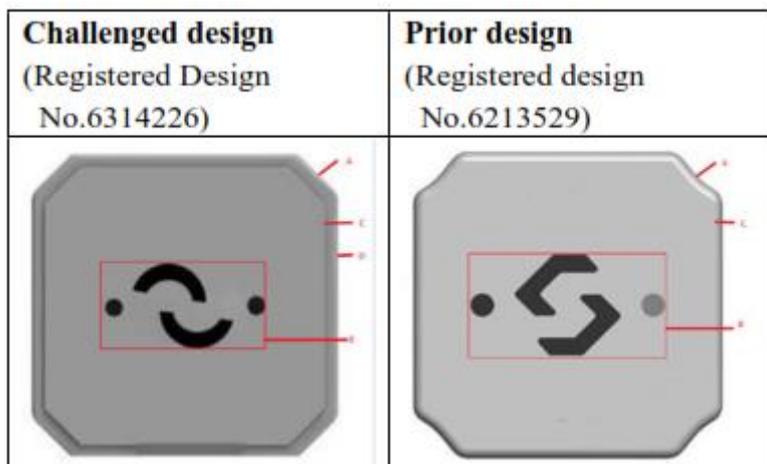
18. The representations here are not line drawings, which would clearly concern just the shape of the product, but show it in light grayscale. I cannot see in the front, side and back views of the contested design any shading between the top and bottom of the electronic cigarette. The device on the bottom is shown in a contrasting colour, as is the mouth opening: see Illustrations 6 and 7. I take the view that the prior design is for a product with contrasting shades, while the contested design is for a single-coloured product.

19. The registered proprietor identifies what it considers to be the contested design’s distinguishing features on the basis of three views: from the bottom, from the top, and from the front.

The bottom view

20. The registered proprietor identifies three differences, as marked in the images below:¹

¹ The pages of the counterstatement are unnumbered. The image can be found on the second page.



21. The first of these concerns the corners (marked with the letter A). In the contested (or “challenged”) design, they are cut straight, while the prior design’s corners are cut in a slight curve.

22. The registered proprietor then submits that the base of the contested design has two layers, marked with the letters C and D on the above image. The layer C is smaller than the layer D and appears to be superimposed on D. In contrast, the base of the prior design has only one layer, with chamfered edges joining it to the sides of the product. The effect of this can be seen in the image below showing the front of the designs:²



23. The third difference identified by the registered proprietor is the pattern visible on the base of the product. On the contested design, this takes the form of two dots, which appear to be a circle cut in two, with the bottom half shifted to the right and slightly down. The registered proprietor submits that the pattern gives “*the impression of a smile*”.³ The pattern on the base of the prior design also consists of two dots, separated by a device. The registered proprietor submits that the device is made up half-squares

² This image can be found on the fourth page of the counterstatement.
³ First page of the counterstatement

and “gives the impression of two hands holding each other”.⁴ In my view, these shapes are not squares, but rather squared arcs. The patterns are therefore different. The registered proprietor also submits that the pattern on the prior design takes up a larger proportion of the base than the pattern on the contested design does. I accept this, but do not consider that it is a more than immaterial difference.

24. The registered proprietor submits that the differences are “huge”⁵ and sufficient to influence the purchasing decision. It also argues that when the electronic cigarette is hung on a lanyard, the bottom will be facing the user and so the pattern is not a minor design feature. The applicant notes that there is nothing on the designs that would enable a lanyard to be attached and submits that, even if a lanyard is used, the conventional orientation is for the mouthpiece to be uppermost. I have no evidence to support either of these submissions.

25. I consider that the first two differences identified by the registered proprietor are minor. The image in [paragraph 22 above] has been significantly enlarged, but even so it would be necessary to examine the contested design in minute detail in order to be able to spot the layer marked as “D”. It is also my view that the differences to the cut of the corners, when viewed from the bottom, are immaterial. I accept that the pattern is different.

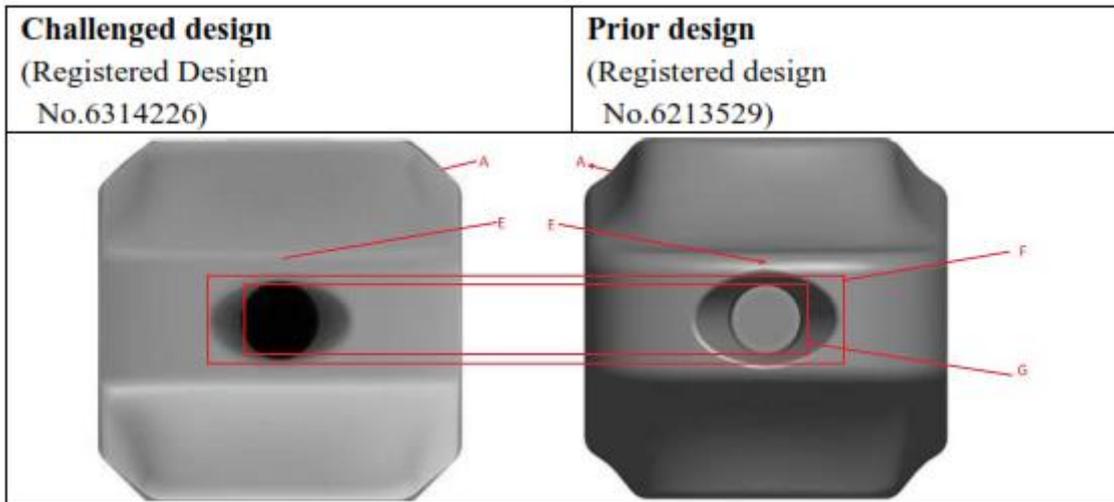
The top view

26. The registered proprietor identifies three differences, as marked in the images below:⁶

⁴ Second page of the counterstatement.

⁵ Second page of the counterstatement.

⁶ Third page of the counterstatement.



27. The first of these differences concerns the corners, which I have already noted in [paragraph 20] above. The second difference is marked by the letter E. The registered proprietor submits that the chamfer of the suction nozzle is smaller in the contested design than it is in the prior design. In its view, the lines “*appear relatively rigid*” in the contested design and “*relatively rounded*” in the prior design.⁷ I am having some difficulty in identifying the difference here, and have used another representation to see if the alleged difference is clearer on that view. The first image below is taken from a magnification of the main illustration of the contested design and the second is the equivalent representation from the prior registration. Again, this is an instance in which very close examination is required to identify any differences. It is possible that there is a difference in the chamfer, but it is by no means obvious. I have marked the chamfers with arrows.



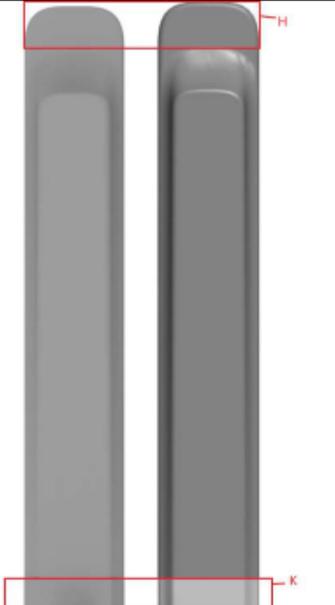
28. Thirdly, the registered proprietor submits that the proportions of the holes in the suction nozzles differ. It argues that the inner hole (marked G) is relatively large

⁷ Second page of the counterstatement.

compared with the outer hole (marked F) of the contested design, while the reverse is the case for the prior design. It submits that the effect of this is that the inner hole appears to be relatively deep in the contested design and relatively flat in the prior design. I agree that the proportions of the outer and inner holes differ, but I am not convinced that this would be a material difference.

The front view

29. The registered proprietor identifies two differences, as marked in the images below:⁸

<p>Challenged design (Registered Design No.6314226)</p>	<p>Prior design (Registered design No.6213529)</p>	
		
<p>Challenged design (Registered Design No.6314226)</p>	<p>Prior design (Registered design No.6213529)</p>	
		<p>Enlarged view of part k</p>

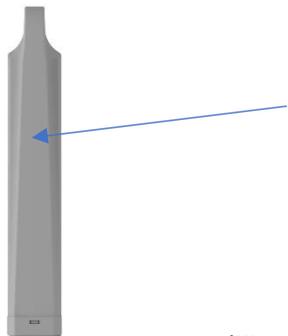
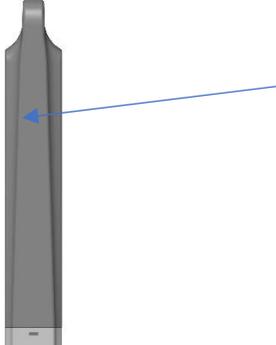
⁸ Fourth page of the counterstatement.

30. The registered proprietor draws attention to differences in the height between the two products. This is marked with the letter H in the above image. The second difference relates to the base K and what the registered proprietor describes as the two-layer or one-layer base: see [paragraph 22] above.

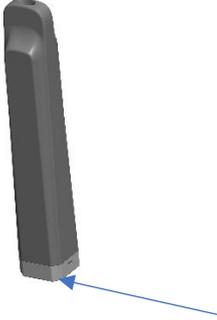
31. In my view, the difference in the height is very small indeed and is a minor detail that does not affect the overall appearance of the design. I take the same view in respect of the difference in the base. Consequently, I find that this is also an immaterial difference.

Findings on novelty

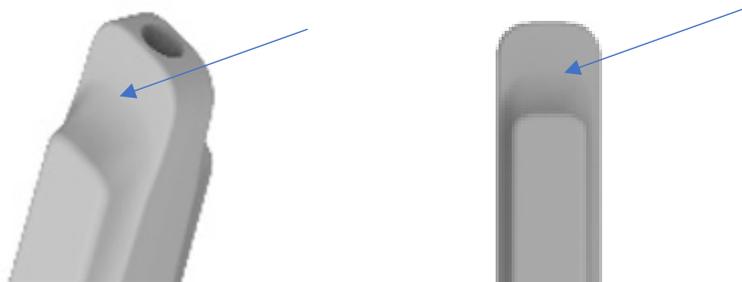
32. I accept that both designs have a squarish bar shape and that from the side the shape is that of a tall, narrow trapezoid (marked with an arrow in the images below). On either side of this trapezoid are two triangular shapes, one side of which gently curves towards the top of the trapezoid.

The Contested Design	The Prior Registered Design
 <p>(Illustration 5)</p>	

33. The differences between those triangular shapes are not readily apparent from Illustration 5 and the equivalent representation from the prior design. They are more easily discernible in the representations below. The cut corner of the contested design appears to be shorter than the cut corner of the prior registered design. However, I consider this to be an immaterial difference requiring close examination to detect.

The Contested Design	The Prior Registered Design
 <p data-bbox="507 584 756 622">(Main illustration)</p>	

34. The projecting surfaces on the front and back are clearly visible on the prior registered design. They are less obvious on the lighter shaded representations of the contested design. However, the shading does indicate that the pieces are similar in shape and degree of projection to those of the prior registered design. I have marked sections of the main and second illustration with arrows to show where I consider the projection begins.



35. The projection may be smaller on the contested design, but again I consider this to be an immaterial difference that would require the user to study the design in more detail than the case law holds that they do.

36. However, I consider that the single colour of the contested design and the contrasting shading of the prior registered design constitute a material difference between the designs. I find that the contested design is new, compared with the prior registered design.

Individual Character

37. A design may be new, but still lack the necessary individual character compared to the prior art. This depends on whether the overall impression is produced on the informed user differs from the overall impression produced on such a user by the prior art. As HHJ Birss QC (as he then was) pointed out in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), “*The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration.*” The same applies to a comparison of the overall impression created by a registered design compared to the prior art.

38. 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.”

39. I also bear in mind the comments of HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of ‘different overall impression’ is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The sector concerned

40. The sector to which the product in which the designs are applied belongs is that of smoker’s articles, namely electronic cigarettes.

The informed user

41. 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);

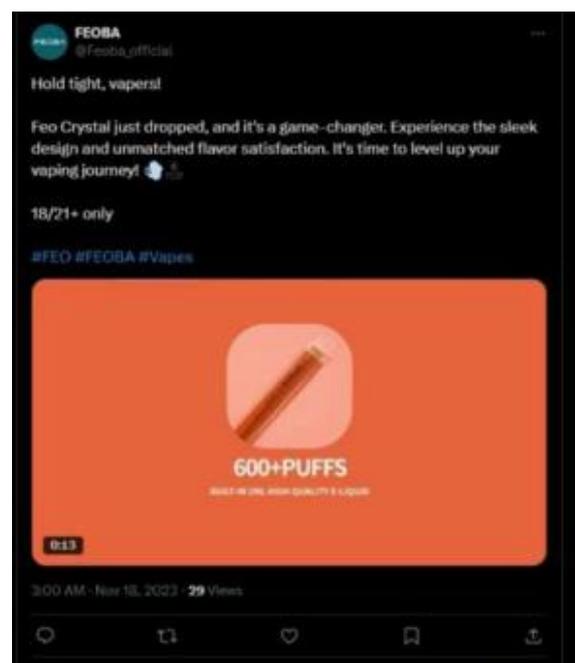
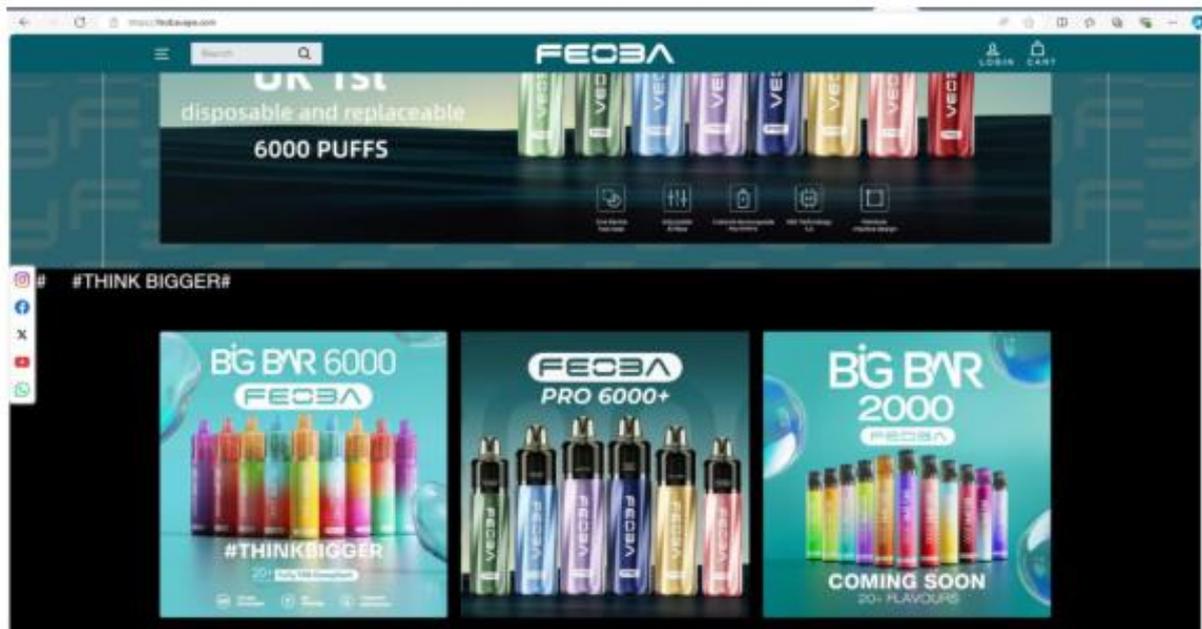
ii) however, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

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).”



44. I am prepared to accept that the informed user will pay more attention to the front, back and side views of the product than to the bottom and the top.

The design corpus

45. The screenshots and images shown above are the only examples I have of other designs. I note that the screenshots are undated and that the posts on X come from

November 2023, which is after the relevant date. Furthermore, they only show products from the registered proprietor.

Design freedom

46. 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).”

47. The parties have made no specific submissions relating to the degree of design freedom in developing their design. The registered proprietor does state that the length of the product will have an impact on the experience of the user: *“the difference in overall length will lead to differences in smoke channel size and opening size; and even a slightest difference will lead to a difference in suction resistance, and a process, structure and e-liquid adjustment corresponding thereto will be completely different, which will eventually lead to different products.”*⁹ No further explanation is given. However, I consider that the designer will be required to design a product that can be held comfortably in the hand, which suggests that it is more likely to be longer than it is wide. It will need to be large enough to include the liquid and a battery. Both these parts could be contained in a single unit with straight sides, or the design may clearly separate the liquid and the battery compartments. In the latter case, the bottom may even be wider than the top. The technical function of the product dictates that there must be a mouthpiece and the size and shape will be required to fit comfortably in the user’s mouth. Beyond these constraints, the designer may choose flatter or more rounded options. In theory, the mouthpiece could extend from one of the sides, but I consider that it is more likely to be at the top of the product as this will be easier for the user.

⁹ Third page of the counterstatement.

Overall impression

48. In *Shenzhen Taiden Industrial Co. Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-153/08, the General Court said:

“66. It should also be observed that, contrary to what the applicant claims, taking into account the reduced visibility of the lid of the speaker is not contrary to the rule that the overall impression produced by the contested design on the informed user should be assessed. That impression must necessarily be determined also in the light of the manner in which the product at issue is used, in particular on the basis of the handling to which it is normally subject on that occasion.”

49. In my view, the informed user will pay very low level of attention to the base of the electronic cigarette than to the back, front, sides and even the mouthpiece. It will not be seen when in use. Therefore, the pattern that decorates the base makes a very small contribution to the overall impression of the design. I also consider that the informed user will give little regard to the size of the holes in the mouthpiece. The other difference that I identified earlier in my decision was the contrasting colour of the bottom part of the prior registered design. This is only a small part of the electronic cigarette as a whole and so while it would be noticed, and so I found the contested design to be novel, it makes a limited contribution to the overall impression of the designs, which are dominated by the squarish bar shape, the projecting front and back pieces, a trapezoid shape at the sides and a narrow mouthpiece that extends along the whole width of the product. These features are found identically, or nearly identically, in both designs. Differences in height and length are minor. In my view, the designs create the same overall impression on the informed user and so Registered Design No. 6314226 lacks individual character.

50. As I have made this finding on the basis of the prior registered design, I shall not carry out a comparison with the product shown in the YouTube video.

OUTCOME

51. The application is successful and Registered Design No. 6314226 is declared invalid.

COSTS

52. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 1/2023. I award the applicant the sum of £1048 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

£300 for preparing a statement and considering the other side's statement

£700 for preparing evidence and submissions during the evidence rounds

£48 for the official fee for filing the application

£1048 in total

53. I order Feoba Tech Limited to pay to Shenzhen SKE Technology Co., Ltd the sum of £1048. 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 4th day of March 2026

Clare Boucher

For the Registrar,

The Comptroller-General