

O/0214/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6288291

IN THE NAME OF AMY PROCTOR

IN RESPECT OF THE FOLLOWING DESIGN:



AND AN APPLICATION FOR INVALIDATION THERETO UNDER NUMBER 96/24

BY ALEXANDER WINGROVE

BACKGROUND AND PLEADINGS

1. UK Registered design no. 6288291 (“the contested design”) stands in the name of Amy Proctor (“the Proprietor”). It has an application date of 6 June 2023 (“the relevant date”), was granted on 17 June 2023 and was published on 18 June 2023.

2. The contested design is registered as applying to telecommunications equipment, wireless remote controls and radio amplifiers within recording, telecommunication or data processing equipment (Class 14, Sub-class 03 of the Locarno classification). The indication of the product is given as “remote control”. The contested design is depicted in the following six representations:





3. On 26 April 2024, Alexander Wingrove (“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, three examples of which have been provided in its pleadings: UK Registered design numbers 6042336, 6042337 and 6042338. The Applicant claims the contested design is a copy of the three prior designs, which the Applicant refers to collectively as “Amazon fire stick remote”. The prior designs are set out later in this decision.

4. On 6 June 2024, the Applicant filed evidence in the form of images comprising the details and illustrations of the three UK Registered designs relied upon as prior designs; the images are taken from the designs register on the gov.uk website. These images, along with the Applicant’s statement of case, were served on the Proprietor on 13 June 2024.

5. The Proprietor filed a counterstatement on 25 July 2024 (and an amended version on 15 August 2024). This claims that the prior designs feature a “hole” at the top, right-hand corner of the remote, which the contested design does not. The Proprietor contests the disclosure of the prior designs on the basis that sellers on ‘Amazon’ are able to manipulate their listings in order to imply an earlier selling date. However, the Applicant does not rely upon ‘Amazon’ listings for the prior designs, but UK Registered

designs and so this line of argument by the Proprietor does not contribute to the case before me. I will, however, deal with the disclosure of the prior designs later in this decision.

6. Beyond the Applicant's evidence filed at the commencement of the proceedings, neither party filed evidence during the evidence rounds. Neither party requested to be heard and neither filed written submissions in lieu of a hearing.

7. The Applicant and the Proprietor represent themselves in these proceedings.

DECISION

Relevant legislation

8. 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; [...]"

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 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.

[...]”

Relevance of EU law

10. 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.

Prior Art

11. The designs claimed by the Applicant in its statement of case to be earlier designs are shown below:¹

(i) UK Registered design no. 6042336

Application date: 24 August 2018

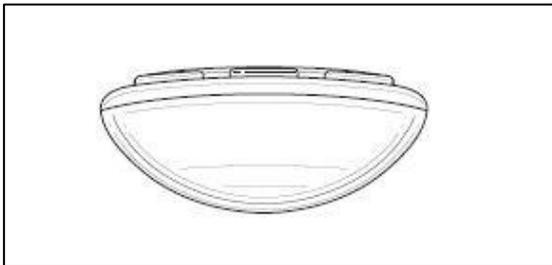
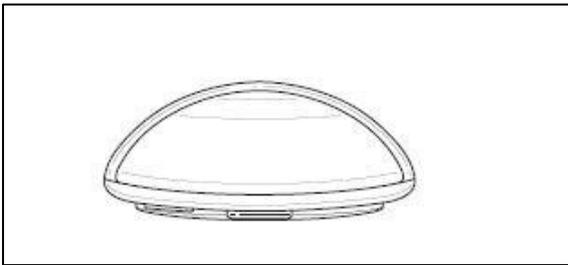
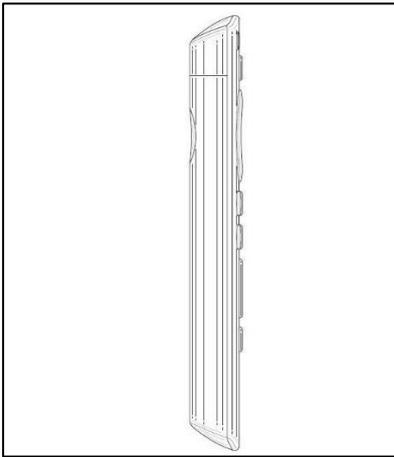
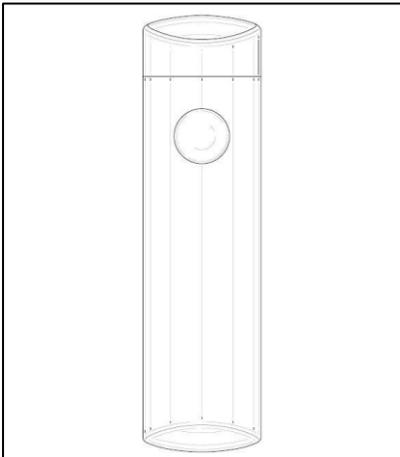
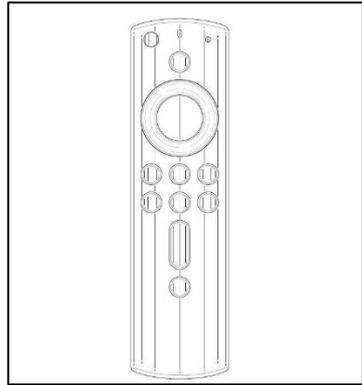
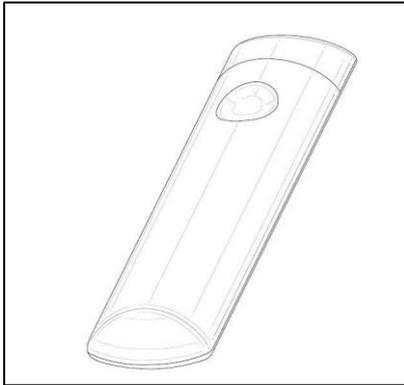
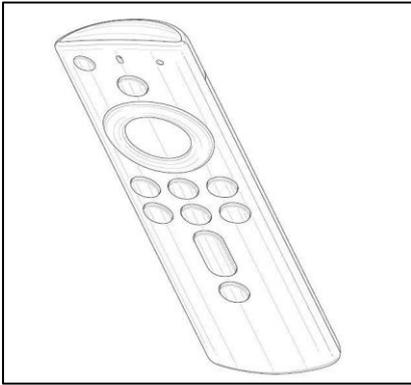
Grant date: 29 August 2019

Publication date: 30 August 2019

Indication of product: “remote control”

Representations:

¹ The three UK Registered designs claim priority from US Application number 29641357, which has an application date of 21 March 2018.



(ii) UK Registered design no. 6042337

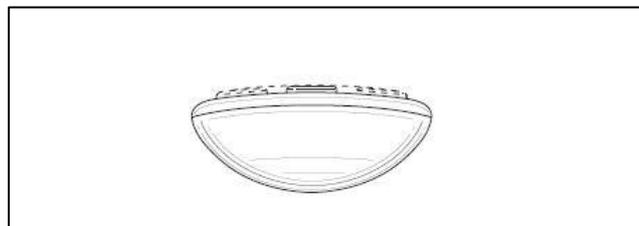
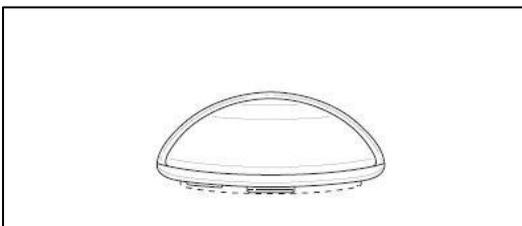
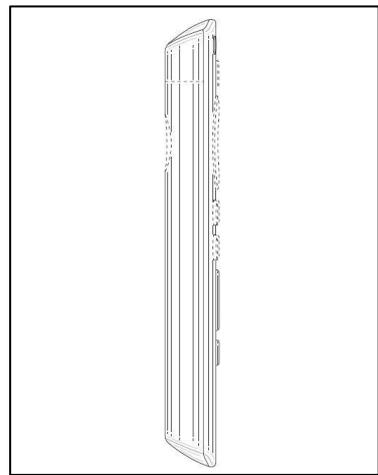
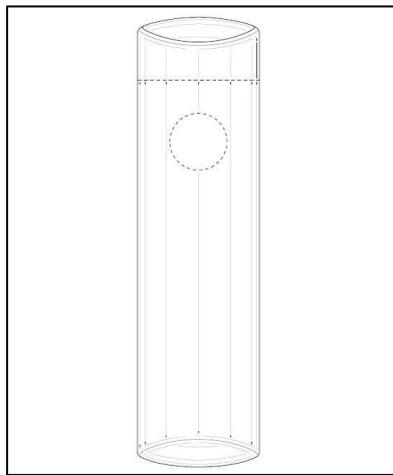
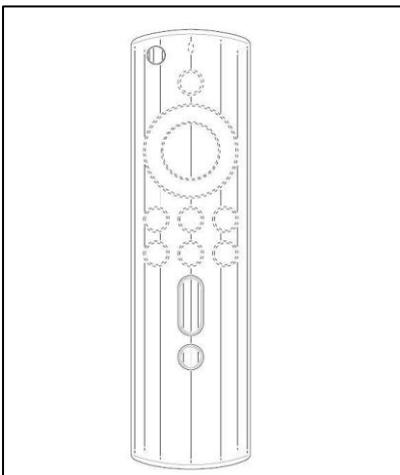
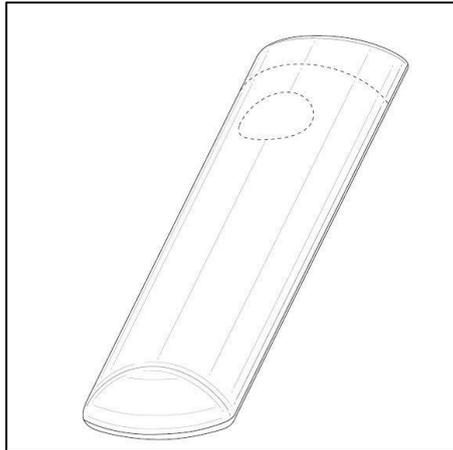
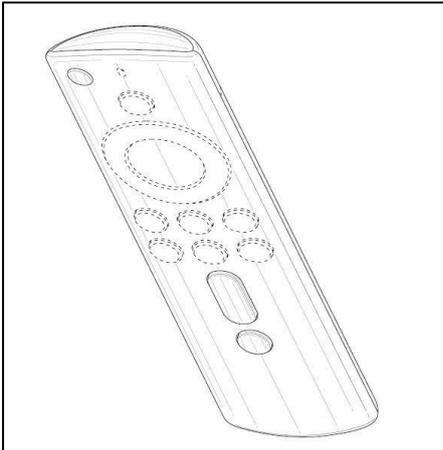
Application date: 24 August 2018

Grant date: 29 August 2019

Publication date: 30 August 2019

Indication of product: "remote control"

Representations:



(iii) UK Registered design no. 6042338

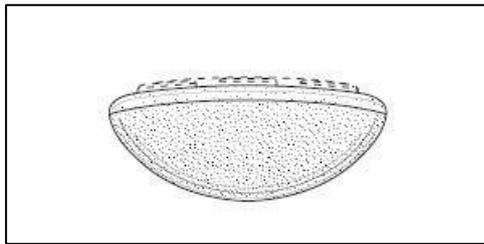
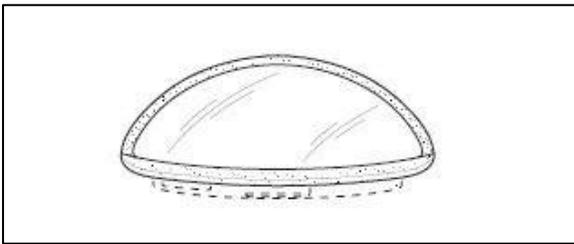
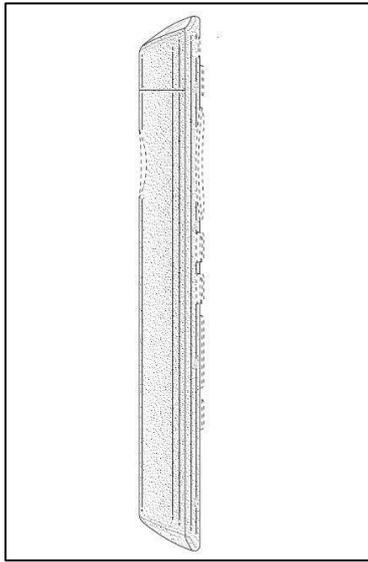
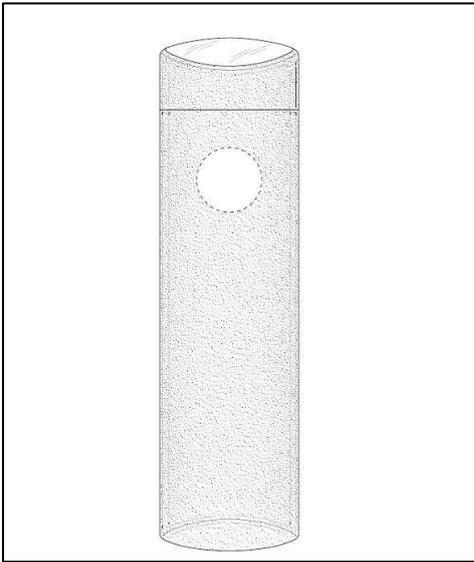
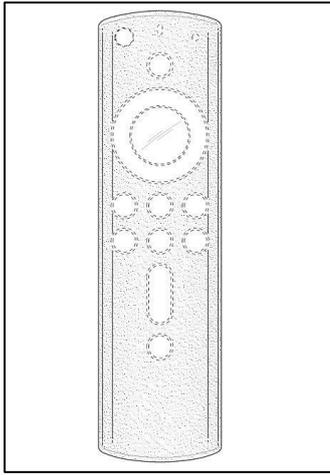
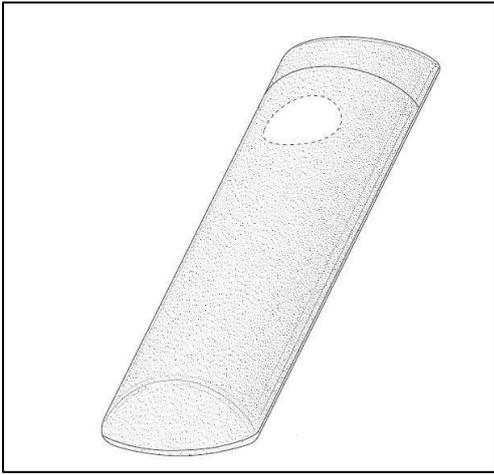
Application date: 24 August 2018

Grant date: 29 August 2019

Publication date: 30 August 2019

Indication of product: "remote control"

Representations:



12. The prior designs were filed on 24 August 2018 and published on 30 August 2019, before the application date of the contested design. Registering a design in the UK clearly constitutes it being made available to the public. I shall therefore treat this as disclosure of the prior art in accordance with Section 1B(5) of the Act. The Proprietor has not claimed that any of the exceptions in section 1B(6) apply.

Individual character

13. For reasons which will become clear, I will concentrate on whether the contested design had individual character at the relevant date. Section 1B(3) states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. A design may create the same overall impression on the informed user as another design, while being different from it in some respects. I need to assess the similarities and differences and decide upon their impact on the overall impression of the contested design.

14. In *Safestand Ltd v Weston Homes PLC & Ors*,² HHJ Hacon, sitting as a Judge of the High Court, set out at [237] the approach to the assessment of whether a design has individual character:

“(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,

² [2023] EWHC 3250 (Pat).

(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 designs 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.”

The sector and the informed user

15. The sector is the market for remote controls.

16. The next consideration is the informed user. HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court in *Samsung Electronics (UK) Ltd v Apple Inc.*³ observed that:

“[...] 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.”

17. HHJ Birss QC also gave the following detailed summary of the characteristics of the informed user:

³ [2012] EWHC 1882 (Pat).

“33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo Inc v Grupo Promer Mon Graphic SA* (C-281/10 P) [2012] FSR 5 at [53]-[59] and also in *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (T-9/07)* [2010] ECR II-981; [2010] ECDR 7, (in the General Court from which *PepsiCo* [2012] FSR 5 was an appeal) and in *Shenzhen Taiden Industrial Co Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (t-153/08)*, judgment of June 22, 2010, not yet reported.

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* [2012] FSR 5 at [54] referring to *Grupo Promer* [2010] ECDR 7 at [62]; *Shenzhen* (T-153/08) at [46]);

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* at [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* at [59] and also [54] referring to *Grupo Promer* [2010] ECDR 7 at [62]);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* at [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* at [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 [2012] FSR 5 at [59]).”

18. The informed user in the present proceedings is a member of the public with an interest in remote controls. The informed user will be reasonably attentive to ensure that the remote control is compatible with the machine or device to be operated, as well as considering the aesthetics. There do not appear to be any special circumstances which would mean that the informed user does not conduct a direct comparison of the designs.

Design freedom

19. In *Dyson Ltd v Vax Ltd*,⁴ Arnold J (as he then was) stated that:

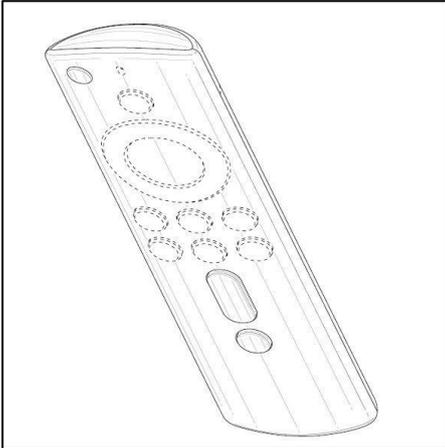
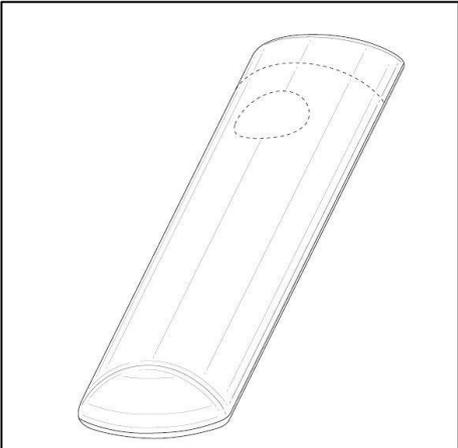
“34. [...] design freedom may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive).”

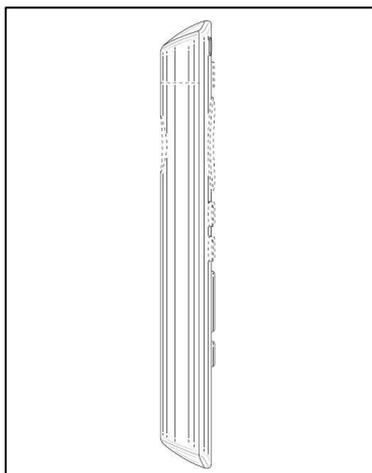
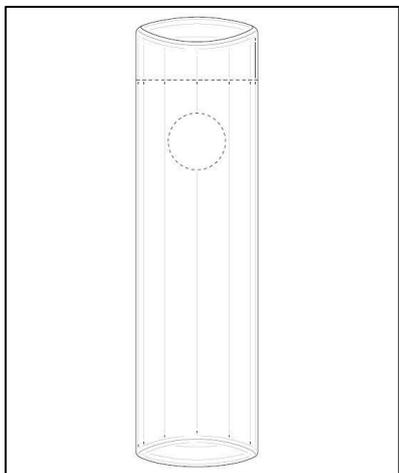
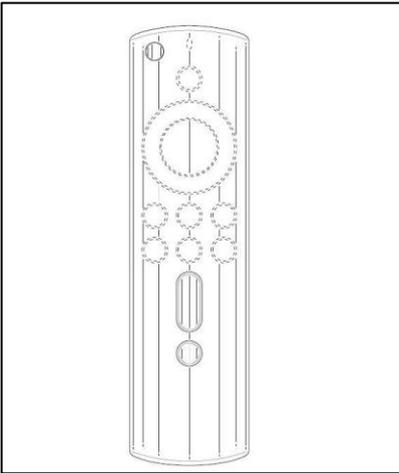
20. The point of a remote control is that the user can operate the associated machine or device wirelessly, from a distance. The remote control must be of a size and shape that fits comfortably in the user’s hand. It must also feature buttons that are pressed by the user for the purpose of controlling the machine or device. Beyond that, there appears to be a reasonable degree of design freedom. The outside shape and the edges of the remote control can vary, and, within the confines of the different functions the remote control needs to perform, it does not matter how many buttons there are, what size and shape they are, nor their configuration on the remote control.

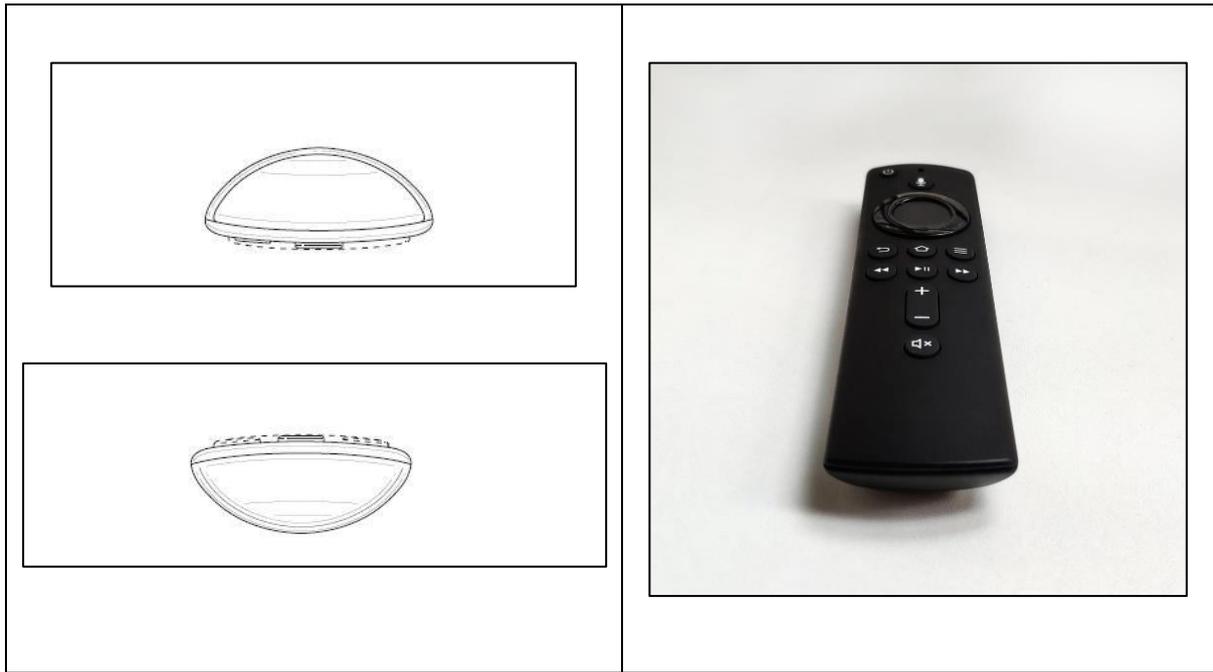
⁴ [2010] FSR 39.

Comparison of the designs

21. For reasons which will become clear, I will compare the contested design with UK Registered design no. 6042337, shown at paragraph 10(ii) above, hereafter referred to as “the prior design”. This is because it appears to be the most similar overall to the contested design. Further, the prior design does not feature the “hole” at the top, right-hand corner of the remote control, referred to by the Proprietor, in the counterstatement, as the difference between the designs. The designs to be compared are as follows:

The prior design	The contested design
	
	





22. A design must be interpreted objectively: *Celaya Emparanza y Galdos Internacional SA v Proyectos Integrales de Balizamiento SL*.⁵ The objective interpretation of a design is a matter for the tribunal, not the tribunal viewing the design through the eyes of an informed user: *Sealed Air Limited v Sharp Interpack Limited*.⁶

23. I am also mindful that the indication of the product should be taken into account in looking at the features of the contested design when it is assessed for individual character against the prior design.⁷

24. Clearly, the prior design shows the product in line-drawing form, whilst the images in the contested design are photographs of the product. In my view, when considering the prior design in the context of the indication of the product (a remote control), it is reasonable to interpret the lines in the representations as showing the shape of the remote control and the configuration of the buttons on the front of the remote control.

25. The prior design and the contested design share the following design features:

⁵ Case C-488/10 EU:C:2012:88, at [55].

⁶ [2013] EWPC 23, at [20]-[21].

⁷ See the comments of Martin Howe QC (as he then was) in BL O/821/21, at [26].

(a) The remote controls are both oblong-shaped. When looking at each design from a different angle, the perspective changes the way the shape appears, i.e. when viewed from above, the shape appears rectangular but with a curved top and bottom; whereas when viewed from either end, the shape appears almost semicircular, with the top of the remote control being fairly flat and the bottom being domed. When considering the above representations of the competing designs, the shape appears identical in each design when viewed from the same angle.

(b) On the front of the remote control, each design features the same number of shapes (as buttons in the contested design and intended to be buttons in the prior design), which appear to be of the same size and configuration. Describing the buttons from the top of the remote control to the bottom, these include: a circular button at the top, left-hand side, a circular button centrally near the top, a larger circular button represented by two rings, six circular buttons in two, horizontal lines of three, a capsule-shaped button (rectangular with semicircular ends) positioned vertically, and a circular button centrally near the bottom.

(c) Also on the front of the remote control, each design features a small oval shape centrally at the top. It is unclear whether this is a button or a hole, for a microphone or an LED light, for example; regardless, it appears to be the same size and shape and in the same location in each design.

(d) On the reverse of the remote control, each design features a horizontal line near the top which spans the width of the remote control and, below the line, a circular shape positioned centrally. These are identical in size, shape and location in each design.

(e) The prior design features double dashed lines round some of the buttons: I understand these to indicate that there is a thin gap between the button itself and the surface of the remote control. This gap can also be seen on the contested design.

26. There are vertical lines on the front and back of the prior design: I take these to indicate a slight curve of the surface of the remote control, which is confirmed by the sixth and seventh representations in the table above. It is difficult to see whether the

contested design has a curved front (it clearly has a curved back), but even if it does not, the difference between the front of each remote control is so slight that I do not consider it affects the overall impression of the designs.

27. The fact that the contested design is in black and that the buttons feature specific symbols is not relevant, because the prior design is not protected for a particular colour or particular text on the buttons. The prior design is registered for its shape and that shape is identical to that of the contested design.

28. Returning to *Samsung Electronics (UK) Ltd v Apple Inc*, these differences and similarities will be observed by the informed user who pays attention to detail. The differences and similarities will not be picked up only through minute scrutiny. Taking all of the above into account, including the weight of the similarities and differences and the degree of design freedom in relation to the various elements, I conclude that the contested design conveys the same overall impression on the informed user as the prior design.

Conclusion

29. The application for invalidation has been successful. Subject to any appeal against this decision, design number 6288291 will be declared invalid under section 11ZA(1)(b) of the Act.

Costs

30. The Applicant has been successful and would ordinarily be entitled to a contribution towards its costs, in line with Tribunal Practice Notice (“TPN”) 1/2023. As the Applicant is unrepresented, at the conclusion of the evidence rounds, it was sent a costs pro-forma to complete if it intended to request an award of costs. The pro-forma was not completed and returned and so, in accordance with the TPN, only official fees may be awarded: in these proceedings, the Applicant paid £48.

31. I therefore order Amy Proctor to pay Alexander Wingrove the sum of £48. 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 12th day of March 2026

MRS E FISHER
For the Registrar