

O/0213/26

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 6204524

IN THE NAME OF AFFARGO LTD

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION (NO 002/25)

BY SYMIZ LIMITED

Background and pleadings

1. UK Registered Design number 6204524 ('the contested design') stands in the name of Affargo Ltd ('the proprietor') and has a filing date of 25 April 2022 ('the relevant date'). It was granted on 19 May 2022 and was published on 20 May 2022.
2. The indication of product is 'magnetic pen'. The registered design is classified in class 9 (stationery and office equipment, artists' and teaching materials), sub-class 06 (materials and instruments for writing by hand, for drawing, for painting, for sculpture, for engraving and for other artistic techniques) of the Locarno classification.
3. The contested design is depicted in the following single representation:



4. On 2 January 2025, Symiz Limited ('the cancellation 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 of section 1B of the Act because the contested registered design is not new and does not possess individual character.
5. In support of the claim, the cancellation applicant relies on UK Design 90024759470001 for 'pens', which was registered on 3 June 2014. It has also filed pages printed from Amazon UK, said to show the same design, available to the UK public from 31 March 2022 . These documents were attached to the statement of case, which includes a statement of truth. Consequently, these pages may be considered evidence for the purpose of these proceedings.

6. The proprietor filed a counterstatement, which included a comparison table of designs. It denied the grounds and said:

“...we cannot agree the above stated UK design is strikingly similar to our UK design 6204524 as common public could easily find the difference between them.”

7. Neither the cancellation applicant nor the proprietor is professionally represented.

8. Neither side filed any material other than that already referred to. The parties did not request a hearing. I have therefore taken this decision after careful consideration of the papers before me.

The law

9. 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”.

10. Section 1B of the Act reads:

“(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) – (e) ...

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

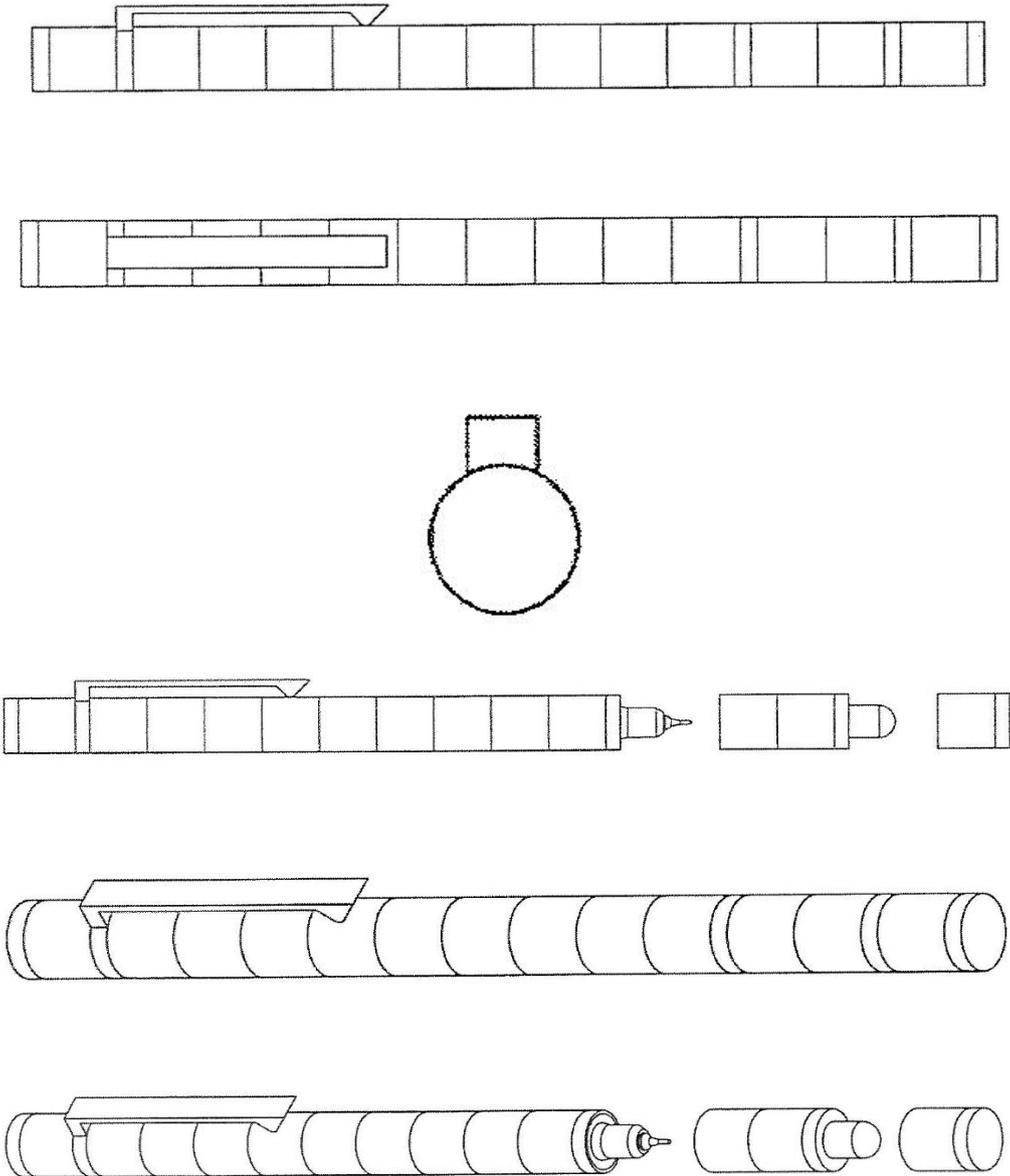
(8) ...

(9) ...

Prior art

11. The cancellation applicant relies on UK registered design 90024759470001. The design was registered on 3 June 2014. The indication of product is 'pens'. The design expired on 3 June 2024 but was clearly published prior to the date of filing of the contested design and therefore constitutes prior art.

12. The design appears as follows:



13. In addition to the registered design, the cancellation applicant also relies on an Amazon listing that it says is evidence of a product, identical to the contested design, being sold to the public before the filing date of the contested registration. It appears as follows:



14. The 'date first available' shown on Amazon is 31 March 2022. This has not been challenged by the proprietor and I have no reason not to accept that this is the date the design was made available on Amazon UK.

15. There are differences between the designs relied on as prior art. However, as both the earlier registered design and the Amazon UK listing were made publicly available before the application date of the contested design, I will compare both to the contested design. I shall refer to the earlier registered design as 'prior art 1' and the Amazon UK listing as 'prior art 2'.

Is the registered design new?

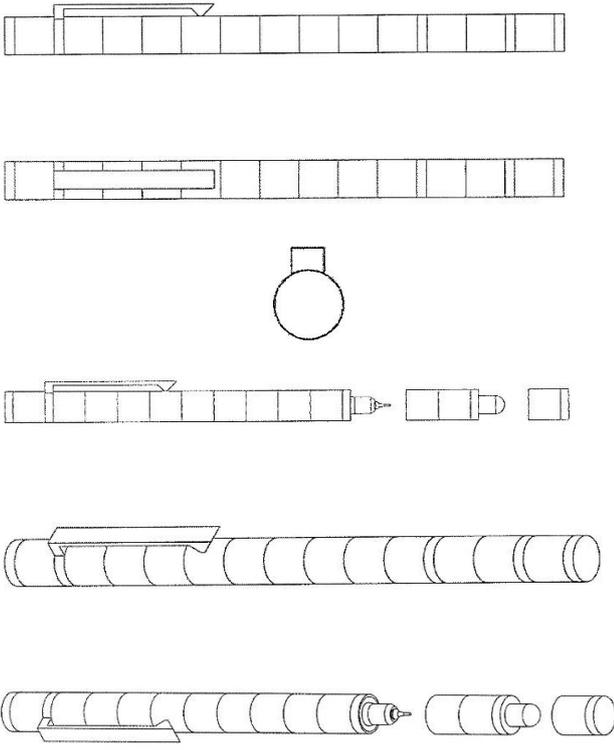
16. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,¹ HHJ Melissa Clarke, sitting as a Judge of the High Court,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

“Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered

¹ [2019] EWHC 3149 (IPEC).

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.”

17: In the table below, I show the contested registered design alongside prior art 1:

The contested registered design	Prior art 1
	

18. In *Marks and Spencer plc v Aldi Stores Ltd*,² HHJ Hacon summarised the principles governing the interpretation of registered designs. At paragraph 11 of that decision, he said:

“10. Generally, issues of the interpretation of an image in a registration arise when the image is a line drawing, as was the case in *Magmatic* (see also *Lutec (UK) Ltd v Cascade Holdings Ltd* [2021] EWHC 1936 (IPEC) at [15]-[24] and *Rothy's Inc v Giesswein Walkwaren AG* [2020] EWHC 3391

² [2023] EWHC 178 (IPEC).

(IPEC) at [53]-[66]). There are conventions regarding dotted lines, grayscale and so on.

11. Where the image is a photograph of a product, the design claimed consists of the features - the lines, contours, colours, shape, texture, materials and/or ornamentation - visible in the photograph (again, subject to s. 7(4))”.

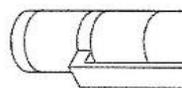
19. In this case, the contested design is a photograph showing a pen that is gold in colour. Prior art 1 is depicted in monochrome and so covers all colours.

20. The contested design and prior art 1 share the following features:

- a) The body of the pen is made of small segments;
- b) The nib is within a cylinder that is narrower than the body of the pen;
- c) The last section of the pen is a separate piece that has a nib;
- d) A pen clip begins one segment down from the top of the pen;
- e) The pen clip has a long flat profile;
- f) The pen clip is the length of three and a half segments of the pen.

21. The designs differ in the following features:

- a) The tops of the pens are different. The registered design has two angled sections that emerge either side of the top at a little more than a 90-degree angle, they each finish with a ball. There is also a ball at the top of the pen. Prior art 1 has a flat top and no elements that emerge from the side of the pen:



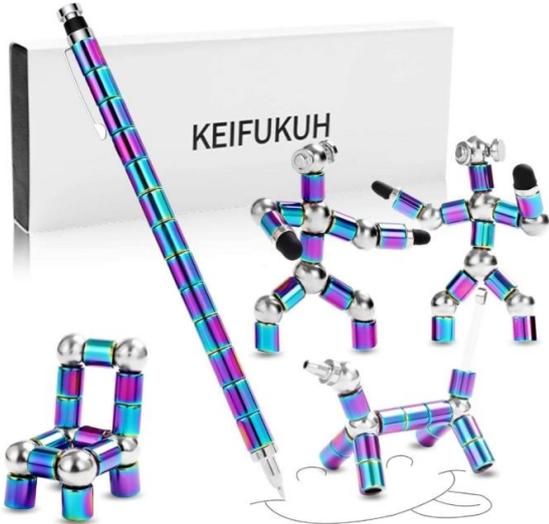
- b) The pen caps differ. The contested design has an uncovered nib, with no obvious cap. Prior art 1 has a two-section cap, the first part being made up of two segments with a smaller cylinder in its centre,³ and a second, single segment cap, with a flat end.

³ I note that in drawing four of Prior art 1 the smaller cylinder in the first of the pen caps has a domed top. In drawing six it is a flat-topped cylinder. Nothing turns on this, so I will say no more about it.

- c) The proportions are different. The contested design has an elaborate top followed by eleven segments, followed by an exposed nib. Prior art 1 is made up of ten segments, followed by the nib and then a two segment and a single segment cap.
- d) The pens have a different number of thicker rings between the segments. The contested design appears to have a thicker ring at the start of the clip, at the top of the pen and a second at the start of the nib. Prior art 1 has five thicker rings around the body. The first is around the top of the pen, the second is at the start of the clip, the third is at the start of the nib and the remaining two are at the bottom of each of the pen caps.

22. The differences in the tops of the pens and the presence or absence of pen caps are not immaterial differences. Consequently, I find the contested registered design is new when compared to prior art 1.

23. In the table below, I show the registered design alongside prior art 2:

The contested registered design	Prior art 2
	

24. Prior art 2 includes a rectangular box with the letters 'KEIFUKUH' in plain text on its front face. In addition, there are two human characters, a dog and a chair, made up of cylinders and balls. There are no similar elements in the contested design. Accordingly, I will compare the 'pen' in prior art 2 to the contested design.

25. In accordance with the decision in paragraph 18, above, as both designs are colour photographs, colour is a factor in the comparison of the contested design with prior art 2.

26. The contested design and prior art 2 share the following features:

- a) The body of the pen is made of small segments;
- b) The nib is within a cylinder that is narrower than the body of the pen;
- c) The last section of the pen is silver and contains the nib;
- d) Neither pen has a cap for the nib.
- e) The pen clip has a long flat profile;

27. The designs differ in the following features:

- a) The contested design is gold with a silver nib and silver ball elements at the top. Prior art 2 is pearlescent blue and purple, with a silver nib and silver and black top.
- b) The tops of the pens are different. The registered design has two angled sections that emerge either side of the top at a little more than a 90-degree angle from the pen barrel. They each terminate with a ball. There is also a ball at the top of the pen. Prior art 2 has a cylinder at the top that is narrower than the barrel and appears to be made of three parts, as shown below:



- c) The proportions are different. The contested design has an elaborate top followed by eleven segments, before the nib. Prior art 2 has the three-part cylindrical top,

shown in the previous paragraph and is made up of thirteen segments, followed by the nib.

- d) The length and position of the clip is different. The clip in the contested design begins at the top of the second segment and is three and half segments long. The clip in prior art 2 begins at the top of the barrel and is three segments long, making it shorter and higher on the pen than is the case in the contested design.

28. The slight difference in length of the pen clips is immaterial and is likely to be overlooked. However, the differences in the top of the pens, the colour of the pens and the position of the clips are not immaterial. Consequently, I find the contested registered design is new when compared to prior art 2.

Individual character

29. A design may be new but still lack the necessary ‘individual character’ compared with 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.

30. 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*:⁴

“(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;

⁴ [2023] EWHC 3250 (Pat) at [237]

- (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
- c) the sector in question,
 - d) the designer's degree of freedom,
 - e) 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,
 - f) that features of the design which are solely dictated by technical function are to be ignored in the comparison, and
 - g) 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."

31. 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*:⁵

"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

⁵ [2012] EWHC 1882 (Pat)

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 to which the products belong

32. The relevant sector is the market for pens.

The informed user

33. Earlier in the *Samsung* 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).”

34. The informed user is an individual who wants to write or make marks using a pen. They will be observant and will have an interest in both the appearance and functionality of the design.

The design corpus

35. This is the term used to describe the body of designs that already exist in the relevant sector. Neither party has provided evidence showing other designs, beyond the prior art I have used for the purposes of comparison. I therefore have no information about the design corpus at the relevant date.

Design freedom

36. In *Dyson Ltd v Vax Ltd*,⁶ 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

⁶ [2010] FSR 39

item to be inexpensive).”

37. The technical function of a pen requires it to have a barrel to hold. This will need to be a suitable size and shape to be held in the hand. It will need to contain ink and will need a nib to deliver ink to the page, or other writing surface. This means that the physical size and shape is partially dictated by function.

38. The designer has some limited freedom to determine the size and shape of the overall design, within the limits discussed above. The designer also has some limited freedom to determine the presence or absence, shape and size of any clip used to attach the pen to the user or another item such as a bag or notebook. Again, any clip would need to be designed in such a way as to be effective.

39. The designer has considerable freedom to choose the configuration of non-functional parts of the pen, such as pen tops and pen caps, which do not need to fit in the users’ hand in the same way and in the case of caps, may be removed before use.

40. I have identified the features of the designs that are similar and those that are different. I bear in mind that similarity between functional elements should be ignored.

41. There is some similarity in non-functional elements, such as the segmented nature of all of the pens I have compared. However, I find that the unusual top of the pen that is the subject of the contested design creates a strikingly different overall impression on the informed user from either of the pens relied on as prior art. It will therefore create a different overall impression on the informed user.

42. The invalidation application has failed and registered design 6204524 will remain registered.

COSTS

43. The registered proprietor has been successful. It has not been legally represented, and was informed, by a letter dated 29 July 2025, that if it intended to make a request for an award of costs, it should complete and return a proforma detailing the time spent on

various stages of the proceedings. In the same letter, the Registry stated that if the proforma were not completed and returned, costs, other than official fees arising from the action, may not be awarded. No proforma was returned. As the registered proprietor has incurred no official fees, I make no award of costs.

Dated this 12th day of March 2026

Al Skilton

For the Registrar,

The Comptroller-General