

O/0452/26

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6201964

OWNED BY HAOXIANG XUE

AND

APPLICATION NO. 55/23

BY ZHENKANG TIAN

BACKGROUND AND PLEADINGS

1. The design which is the subject of this dispute was filed by Haoxiang Xue (“the proprietor”) on 14 April 2022. The contested design is for a “LED desk lamp” and is depicted in the representations shown in the Annex to this decision. For illustrative purposes, I have reproduced one of those images below:



2. On 15 March 2023, Zhenkang Tian (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that the contested design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act reads as follows:

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

(a) [...]

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

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

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

5. The applicant is represented by Engvat Limited and the proprietor is represented by Isabelle Bertaux.

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

EVIDENCE AND SUBMISSIONS

7. The applicant filed documents with their DF19A. As this document is accompanied by a statement of truth signed by the applicant, I will treat these attachments as evidence. The applicant’s evidence in chief took the form of his own witness statement dated 26 December 2023, which is accompanied by 1 exhibit and a certified translation.

8. The proprietor filed evidence in the form of his own witness statement dated 10 September 2024, which is accompanied by 2 exhibits (HX01 and HW02).

DECISION

9. Section 1B of the Act reads as follows:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if –

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if –

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the geographical area comprising the United Kingdom and the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

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

...”

10. The relevant date is the application date for the contested design i.e. 14 April 2022.

The Prior Art

11. In order to be considered prior art, the design relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6). There are three images of products that have been filed with the applicant’s DF19A.

12. I note that in its Form DF19B the proprietor has contested whether these disclosures were, in fact, made available to the public prior to the relevant date. In this regard, I note that the image that represents the applicant’s best case (because it is the closest in appearance to the contested design) is from Amazon and is accompanied by a number of customer reviews.¹ The product and the reviews can be connected by virtue of the same product number. The earliest of these reviews is from November 2020. This is also supported by customer photographs contained within the reviews, which appear to show the same product as displayed in the Amazon listing.

¹ See Appendixes 1 and 2

In order for customers to have purchased and be leaving reviews for the product, the design must have been disclosed by at least November 2020. Consequently, I find that it does qualify as prior art.

13. I note that the applicant also relies upon a Chinese design which it states was disclosed in April 2021. However, for reasons that will become clear, I do not need to consider this disclosure in detail. I will return to it below to the extent that I consider necessary.

Novelty

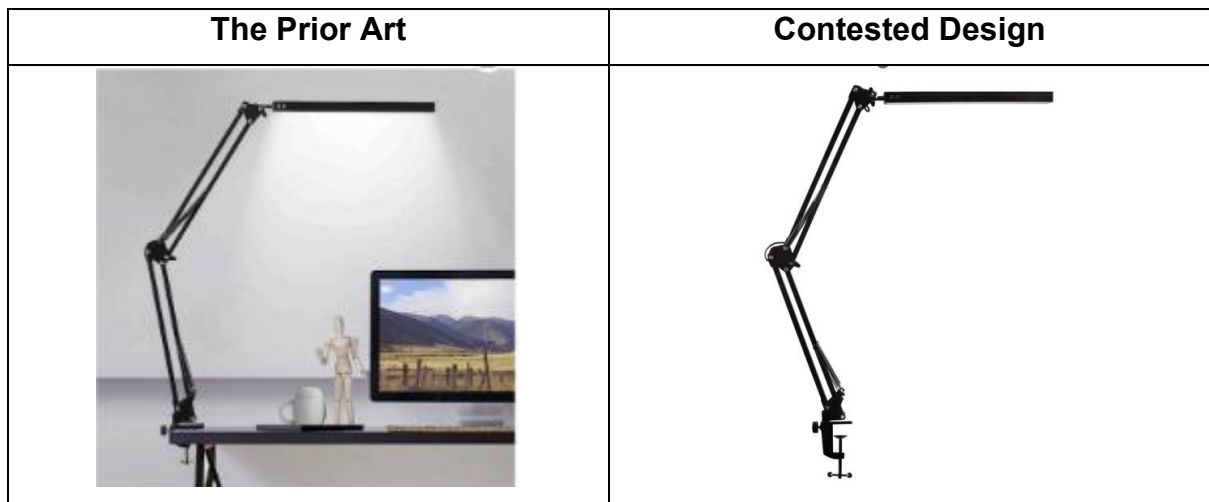
14. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a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

“‘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.”²

15. The competing designs to be compared are as follows:³

² Paragraph 26.

³ For ease of comparison, I have included here only the representation of the contested design which is in the same position as that of the prior art image. However, I have considered all of the representations included in Annex 1 which make up the contested design in reaching my decision.



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

- a. They both share the same rectangular, horizontal lamp which casts light downwards (this is visible from the light in the image of the prior art and from certain representations of the contested design which show the lamp bulbs on the underside of the rectangular lamp section).
- b. There are two circles in the same position on the left of the rectangular lamp section, which appear to be screws.
- c. Both lamps are supported by two sets of two parallel bars, both sets being connected by joints which appear to be the same shape.
- d. In both the prior art and the contested design, the top and bottom joints have three visible screws in each, whereas the middle joint appears to have four visible screws.
- e. There is a small protrusion from the top and middle joints in both the prior art and the contested design. It is clear from the other representations of the contested design (shown in the Annex to this decision) that these are to enable the lamp to be adjusted; it is not clear whether the same is true for the prior art.

- f. Both the prior art and the contested design have two cross-support bars which join to one of the parallel bars at each section. It is clear from the contested design that these are springs; it is not possible to tell whether this is also the case for the prior art.
- g. The dimensions of each of these respective elements appear to be roughly the same.
- h. The connector at the base of the lamp which enables it to be attached to a table/desk, both have two screw-like fittings, one on the side which has a thicker top and one at the bottom which is thinner and appears to have a ball on each end.
- i. Both lamps are black in colour.

17. The only differences that I am able to identify are:

- a. There is a small line above the middle joint in the contested design which appears to be a wire/cable. There is no corresponding wire/cable visible in the prior art.
- b. The top lamp section appears to be connected to a slightly different part of the top joint section in the prior art when compared to the contested design. However, it is not clear whether this is actually the case or if it is simply as a result of the way that each lamp has been adjusted in the images provided.
- c. The attachment at the base of the contested design appears bigger than that in the prior art, but it is not clear if that is simply as a result of the way it has been adjusted.

18. In my view, the differences identified are immaterial. Consequently, I consider that the contested design lacks novelty when compared with the prior art. That is, in itself, reason to invalidate the contested design. However, for the sake of completeness, I

will go on to consider the position with regard to individual character in the event that I am wrong in my finding regarding novelty.

Individual character

19. A design may be “new”, but still lack the necessary “individual character” compared to the prior art. This depends on whether the overall impression it produces on the informed user differs from the overall impression produced on such a user by the prior art.

20. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in H&M Hennes for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user’s awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

(a) the sector in question,

(b) the designer's degree of freedom, and

(c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

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

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

doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”⁴

The Informed User

22. Earlier in the same decision, the judge gave the following description of the informed user:

“33. ... The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) he (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62, Shenzhen paragraph 46);

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

iii) he has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) he is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

⁴ Paragraph 58.

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).”

23. The contested design is for a desk lamp. The informed user is, therefore, most likely to be a member of the general public. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

24. No evidence has been filed regarding the type, range or variety of desk lamps that were available at the relevant date.

Design Freedom

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

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

26. A design of a product of this kind will, inevitably, be constrained by the function of the product as it needs to be of a shape and size that can sit on or be attached to a table/desk and have bulbs in the correct position to cast light downwards onto the work top in question. There will, however, clearly be freedom within these limits as to the

shape, size and colour of the lamp, whether it is adjustable or not (and how) and whether it sits upon the table/desk top or is attached in some other way.

Conclusion

27. In my view, the contested design and the prior art will create the same overall impression on the informed user. The overall shape of the lamp is the same, as is the colour and the way that it attaches to the desk/table. The support structure for both lamps is the same or extremely similar, as is the lamp section itself. Taking all of this into account, I find that the contested design does not have individual character.

Final remarks

28. As noted above, the applicant also filed evidence relating to a Chinese design. The proprietor does not appear to contest the existence of this design but contends that his distributor filed an earlier-still Chinese design (and as such there has been no copying). However, copying (or the absence thereof) is not relevant to the issues before me. The design in question can be seen as follows:



29. There is no suggestion that this design is an excluded disclosure, and I would have found it to be prior art. Although this appears in a different position to that of the contested design (both are adjustable), the same findings that I have set out above

apply to this design. In my view, the designs give the same overall impression, and I find that this design lacks individual character. Consequently, I also would have found in favour of the applicant when comparing this prior art with the contested design.

CONCLUSION

30. Registered design no. 6201964 is declared invalid under section 11ZA(1)(b) of the Act.

COSTS

31. The applicant has been successful and is entitled to a contribution towards its costs. The applicant has been professionally represented in these proceedings, and I make the following award based on the standard scale:

Preparing a Notice of invalidation and considering the counterstatement	£250
Preparing evidence and considering the proprietor's evidence	£700
Official fee	£48
Total	£998

32. I therefore order Haoxiang Xue to pay Zhenkang Tian the sum of **£998**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of May 2026

S WILSON

For the Registrar

ANNEX







