O/0497/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 90052330530001

IN THE NAME OF PERSAN, S.A.

IN RESPECT OF THE FOLLOWING DESIGN

AND

AN APPLICATION FOR THE INVALIDATION THEREOF

UNDER NO 234/24

BY ICAP LAUNDRY CARE, S.L.

BACKGROUND AND PLEADINGS

1. Registered design No. 90052330530001 stands in the name of Persan, S.A. ("the registered proprietor"). The design is a re-registered design, created pursuant to Article 54 of the Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community. It has an application date of 13 April 2018 ("the relevant date") and was registered and published on 23 April 2018. The design is registered as applying to *Capsules containing washing products, Blocks of washing products*. It is depicted in a single representation, shown on the cover page of this decision.

2. On 19 September 2024, ICAP Laundry Care, S.L. ("the applicant") applied 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 of section 1B of the Act that it should be new and have individual character compared to Chinese design no. 201730295889.5 ("the earlier design"), which was published on 23 February 2018, i.e. earlier than the relevant date. The proprietor of the earlier design is Henkel AG & Co KGAA. It is depicted in several representations. I reproduce one of these below and the rest can be seen in the Annex to this decision.

3. The applicant claims that both designs are applied to a detergent capsule consisting of a film material and featuring three drop-shaped chambers, each intended to hold a different detergent product, arranged around a central axis of rotation that protrudes perpendicularly from the plane of the figure. The outer side of each of these chambers forms part of the circumference of a circle with its centre on the central axis. They are orientated in the same direction and arranged at the same radial distance. Finally, the applicant submits that each of the chambers has an identical area. It contends that the

designs differ in the following respects: (1) the contested design has a square outline, while that of the earlier design is circular; and (2) the earlier design is not shown in colour, while the contested design has one blue, one green and one white compartment. The applicant claims that these differences are only immaterial details and therefore the contested design is not new within the meaning of section 1B(2) of the Act.

4. The applicant claims that the colour scheme used in the contested design is commonplace for the informed user and in support of this claim adduces six further designs that were published by the European Union Intellectual Property Office ("EUIPO") on 9 February 2018. These are the first designs that are shown in the table in [paragraph 67] below.

5. In the view of the applicant, the informed user is a consumer who is responsible for doing the laundry at home and buying the detergent products necessary for the job. It argues that there is a significant degree of design freedom. It contends that, by choosing colours that are not unusual or unknown to the informed user, without substantially changing the shape, the contested design does not produce a different overall impression on the informed user than the earlier design.

6. The Form DF19A has been signed by Ian Bishop, the applicant's representative, and contains a statement of truth. I shall treat the statement of case as containing his evidence, pursuant to Rule 21 of the Registered Design Rules 2006 ("the Rules").

7. The registered proprietor filed a counterstatement on 7 November 2024, denying the applicant's claims. In particular, it argues that the applicant has identified the wrong informed user and has misinterpreted the overall impression that the contested design would have on them. It claims that its design is new and has individual character compared to the earlier design and in particular points to the configuration of the capsules, with the contested design containing a smaller empty central area than the earlier design, and the use of colours in the contested design creating *"the impression of a capsule with improved cleaning utility"*.

8. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by IP21 Limited and the registered proprietor by Withers & Rogers LLP.

EVIDENCE AND SUBMISSIONS

9. The applicant filed submissions in response to the registered proprietor's counterstatement on 26 December 2024.

10. The registered proprietor filed evidence and written submissions on 3 March 2025. The evidence comes from two witnesses. The first of these is Bethan Halliwell, a representative of Withers & Rogers LLP, the registered proprietor's legal representative. Her witness statement is dated 3 March 2025 and is a vehicle for exhibiting Chinese design registrations and six decisions from the Third Board of Appeal of the EUIPO, dated 16 November 2021 and 16 May 2022.

11. The registered proprietor's second witness is Stephen Johnson, a consultant with over 30 years' experience in retail, brand and manufacturing environments. His witness statement is dated 24 February 2025 and is presented as the report of an expert that is intended to assist this tribunal in determining whether the contested design is new and has individual character.

12. The applicant filed written submissions in reply on 26 March 2025.

13. In reviewing the file at the end of the evidence rounds, I considered that Mr Johnson's evidence constituted expert evidence. The Tribunal wrote to the registered proprietor on 22 April 2025 to inform it that, as no permission had been sought to adduce expert evidence, the hearing officer would consider the report and its findings as submissions. The registered proprietor disagreed with this assessment and requested to be heard. A case management conference ("CMC") was held on 29 May 2025.

The Status of Mr Johnson's Report

14. At the CMC, the registered proprietor was represented by Ms Halliwell and Mr Rhodri Kendrick, both of Withers & Rogers LLP. The applicant was represented by Mr Bishop of IP21 Limited. Prior to the CMC, the registered proprietor filed a skeleton argument. I am grateful to the registered proprietor for doing so and to both parties for their oral submissions.

15. Ms Halliwell submitted that the Act and the Rules did not preclude a party from filing expert evidence. While there was guidance on the use of expert evidence in trade mark cases (which required permission) and patent cases (where there was no such requirement), there was nothing comparable for registered design proceedings before the Registrar. Consequently, she argued, it was open to the registered proprietor to have filed expert evidence, not least because the Registrar had not exercised his discretion under Rule 19 of the Rules to specify what issues should be covered by the registered proprietor's evidence, the nature of that evidence and the way in which it should be placed before the Tribunal. She did not consider that it was appropriate to apply trade mark practice to registered design disputes. In trade mark cases, where the perspective was that of the average consumer, expert evidence would rarely be useful, but the courts had identified several instances when it might be beneficial in registered design proceedings. The evidence should therefore be deemed admissible. Mr Kendrick went through Mr Johnson's report, highlighting those areas the registered proprietor considered were particularly helpful to the determination of the issues to be decided in this case.

16. Mr Bishop submitted that the evidence should not be taken into account. Mr Johnson, in his view, was not the informed user and so the applicant did not consider that the report was of assistance to the Tribunal. He held that permission should have been sought to file it, given that Mr Johnson states in section 1.2 of the report that he has read and understood the provisions of Part 35 of the Civil Procedure Rules ("CPR") which cover the reliance upon expert evidence and specifically state that a party wishing to file such evidence can only do so with permission of the court. Ms Halliwell interjected to submit that the CPR did not apply to proceedings in this Tribunal and this statement had been made in case of an appeal to the High Court. She added that Mr Johnson was not presenting himself as the informed user, but providing evidence on the market and different parties within the supply chain. Furthermore, evidence on the degree of design freedom could only really be given by an expert.

17. Mr Bishop submitted that this should be a simple case and that it was easy to compare the respective designs and come to a decision on whether they created the same overall impression in the eyes of the informed user. This was a consumer

product understandable by everyone. He had no objection to the report being admitted as submissions, but he disagreed that it should be considered as expert evidence.

What is expert evidence?

18. “Expert evidence” has a particular meaning in litigation. That meaning is helpfully conveyed by the following extract from the Civil Justice Council’s *Guidance for the instruction of experts in civil claims*, which came into effect on 1 December 2014:

> “9. Experts always owe a duty to exercise reasonable skill and care to those instructing them, and to comply with any professional code. However when they are instructed to give or prepare evidence for civil proceedings they have an overriding duty to help the court on matters within their expertise (CPR 35.3). This duty overrides any obligation to the person instructing or paying them. Experts must not serve the exclusive interest of those who retain them.
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> …
>
> 11. Experts must provide opinions that are independent, regardless of the pressures of litigation. A useful test of ‘independence’ is that the expert would express the same opinion if given the same instructions by another party. Experts should not take it upon themselves to promote the point of view of the party instructing them or engage in the role of advocates or mediators.”

19. The key point I take from this is that ultimately the duty of the expert is to the court and their role is to assist the court in making a decision, rather than to assist one of the parties in strengthening its case. That is not to say that expert evidence might not achieve both of these ends, but rather that an expert should not be aiming to achieve the second. The commissioning of expert evidence is also likely to increase the cost of litigation. It is for this reason that the Part 35 of the CPR contains the following provisions governing the use of expert evidence:

"**Duty to restrict expert evidence**

35.1

Expert evidence shall be restricted to that which is reasonably required to resolve the proceedings.

…

Court's power to restrict expert evidence

35.4

(1) No party may call an expert or put in evidence an expert's report without the court's permission.

(2) When parties apply for permission they must provide an estimate of the costs of the proposed expert evidence and identify-

(a) the field in which expert evidence is required and the issues which the expert evidence will address; and

(b) where practicable, the name of the proposed expert.

(3) If permission is granted it shall be in relation only to the expert named or the field identified under paragraph (2). The order granting permission may specify the issues which the expert evidence should address.

…"

20. In general, an expert witness will be of assistance to the court where specialist knowledge is required to understand the matters that are to be decided.

Expert evidence in proceedings at the Intellectual Property Office

21. Proceedings at the Intellectual Property Office are not governed by the CPR. However, according to Tribunal Practice Notice ("TPN") 1/2000,

"5. In its role as a Tribunal, the Office adheres to the same overriding objective as the court for dealing with cases justly, as set out in rule 1.1 of the Civil Procedure Rules 1998. This includes, so far as is practicable:

(a) ensuring that the parties are on an equal footing;

(b) saving expense;

(c) dealing with cases in way which are proportionate-

(i) to the amount of money involved;
(ii) to the importance of the case;
(iii) to the complexity of the issues; and
(iv) to the financial position of each party;

(d) ensuring that it is dealt with expeditiously and fairly; and

(e) allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases."

22. This TPN applies to the patent, trade mark and design tribunals.

23. There is specific guidance on the use of expert evidence in tribunal proceedings concerning trade marks and patents, as Ms Halliwell pointed out. In the former, permission must be sought and it is understood that it will rarely be granted. This is because it is seldom of assistance in trade mark cases, where the matters are to be assessed from the perspective of the average consumer of the goods and/or services.[1] In contrast, in patents proceedings before the Comptroller, expert evidence may be filed without permission being required.[2] Given the nature of patent cases, it is not surprising that expert evidence is more likely to be helpful in such proceedings than it is in trade mark cases. That said, the Patents Hearing Manual makes clear that some questions are for the court (or the tribunal), not a witness, however expert, to decide. These include the construction of a patent specification.

[1] See Tribunal Section of the Trade Marks Manual, section 4.8.4.5.
[2] See Patents Hearing Manual, section 3.77.

The case law on expert evidence in registered designs cases

24. Ms Halliwell cited several authorities on the role of expert evidence in registered designs cases. The first of these is *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited* [2007] EWCA Civ 936. Jacob LJ said:

> "3. The most important things in a case about registered designs are:
>
> i) The registered design;
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> ii) The accused object;
>
> iii) The prior art.
>
> And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has 'individual character' or what the 'overall impression produced on an informed user' is. But 'it takes longer to say than to see' as I observed in *Philips v Remington* [1998] RPC 283 at 318. And words themselves are often insufficiently precise on their own.
>
> 4. It follows that a place for evidence is very limited indeed. By and large it should be possible to decide a registered design case in a few hours. The evidence of the designer, e.g. as to whether he/she was trying to make, or thought he/she had made, a breakthrough, is irrelevant. The evidence of experts, particularly about consumer products, is unlikely to be of much assistance: anyone can point out similarities and differences, though an educated eye can sometimes help a bit. Sometimes there might be a bit of technical evidence which is relevant – e.g. that design freedom is limited by certain constraints. But even so, that is usually more or less self-evident and certainly unlikely to be controversial to the point of a need for cross-examination, still less substantial cross-examination.
>
> 5. In *Thermos v Aladdin* [2000] FSR 402 at 404 I said:
>
> > 'Most registered designs are for consumer articles, objects bought or to be appreciated by ordinary members of the public. I

observed in *Isaac Oren v Red Box Toy Factory Ltd* [1999] FSR 785, at 791, that

> "I do not think, generally speaking that, 'expert' evidence of this opinion sort, (*i.e.* as to what an ordinary consumer would see) in cases involving registered designs for consumer products is ever likely to be useful. There is a feeling amongst lawyers that one must always have an expert, but this is not so. No-one should feel that their case might be disadvantaged by not having an expert in an area where expert evidence is unnecessary. Evidence of technical or factual matters, as opposed to consumer 'eye appeal' may, on the other hand, sometimes have a part to play – that would be to give the court information or understanding that it could not provide itself.'

This case was started before the new Civil Procedure Rules came into effect. Leave was given to each side to call expert evidence by an order of April 15, 1999. The spirit and effect of the new Rules require the court to look even more closely at the need for expert evidence. In future in registered design actions, I think the court should take care before allowing any expert evidence. In particular, the court should know precisely as to what areas that expert evidence will be directed. If blanket permission is given, each side feels compelled to get an expert who then has to say something. What is then said has to be read by the other side. Thereby time and cost to no particular use is expended.

It was suggested to me that an expert might be able to assist the court about technical matters in this case, such as the fact that the I-beam type of construction used in the handles of the flasks has a function. But this is so obvious that one hardly needs an

expert, and certainly one does not need two experts. The expert evidence in this case was completely redundant.

As to factual evidence, again it is clear that there is a temptation, bordering on the compelling, to overdo things. Much the most important matters in a registered design action are what the various designs look like. Everything else is secondary. It is, for instance, clear law that whether or not the defendant copied is irrelevant; see, for example, *per* Aldous J in *Gaskell & Chambers Ltd v Measure Master Ltd* [1993] RPC 76, 81. So it is irrelevant for the claimants' witness to throw down a challenge that he thought the defendant copied, as was done here, and it is equally irrelevant for the defendant to prove or to give disclosure about how his design was arrived at.

Similarly, it is irrelevant for the claimant to prove, if it be the case, that he spent a fortune in arriving at his design. It matters not whether he thought of it in the bath or by engaging the most prestigious design consultants in the world.

One area of evidence which I think is admissible, and is of some secondary assistance, is the reaction of the public and trade (who expect to sell to the public) to the design.'

6. *Thermos* was decided in relation to the then UK domestic law of registered designs. This case is the first to reach this Court concerning a Community Design Registration ('CDR') granted pursuant to Council Regulation EC 6/2002 ('the Regulation'). But everything I said then applies also to actions about CDRs too."

25. The next case was the dispute between Marks and Spencer PLC and Aldi Stores Limited over light-up Christmas-themed liqueur bottles.[3] Ms Halliwell noted that the parties' witnesses included the Buying Director at Aldi and the Lead Product Developer for beers, wine and spirits for Marks and Spencer, and that both witnesses commented

[3] *Marks and Spencer PLC v Aldi Stores Limited* [2023] EWHC 178 (IPEC); *Marks and Spencer PLC v Aldi Stores Ltd* [2024] EWCA Civ 178.

on technical function and design constraints. These witnesses clearly had specialist knowledge, but I do not consider that they gave expert evidence in the sense described in [paragraphs 18-20] above. For a start, as employees of the respective parties, they can hardly be said to be independent. Consequently, I consider that this case does not provide any helpful guidance on the use of expert evidence in registered design proceedings.

26. In contrast, the remaining cases cited are relevant. In *Safestand Limited v Weston Homes PLC & Ors* [2025] EWCA Civ 374. Arnold LJ said:

> "15. I have no doubt that expert evidence is admissible in an appropriate case to educate the court as to the relevant design field, but I am doubtful whether expert evidence is admissible to interpret the images in a registered design. …"

27. The second case was the decision of Mr David Stone, sitting as a Deputy High Court Judge, in *Rothy's Inc. v Giesswein Walkwaren AG* [2020] EWHC 3391 (IPEC). The designs at issue here were applied to women's shoes. The claimant's solicitor requested permission to file expert evidence as *"An IPEC judge, and particularly a male judge, is very likely to need to be informed of the aesthetic context in which such articles fall to be considered."*[4] Permission was given to both parties to file expert evidence on a specific issue, namely, on the design corpus. It was noted that neither party complied with the order. Mr Stone said:

> "35. In this case, it was common ground that there were no relevant restraints on design freedom and no elements of the designs were said to be solely dictated by technical function. Both parties conceded that interpretation of the RCD was a matter for the Court, as was the identity of the informed user, and the overall impression produced on the informed user by the various designs and shoes. Shoes are basic household items, with which all people have day-to-day experience. Reading the experts' reports helped me to 'don the spectacles' of the informed user. However, that could readily and more cost-effectively have been achieved by an

[4] Paragraph 28.

agreed, brief primer along the lines of the section I have set out below headed Shoe Design.

36. Having heard submissions from counsel for both parties during the trial, I said that I would not formally exclude any of the experts' evidence, but that that did not mean that I would give it any weight. As counsel for the Defendant put it, the Court 'should place no weight on anything that goes to comment on infringement or invalidity or comparison of the designs in the way that Jacob LJ said is not going to be helpful'. I agree. I have therefore admitted the evidence of the experts as to the state of the design corpus as at 10 May 2017 (which was almost entirely agreed), but in relation to the issues that are for determination by the Court, I do not consider myself bound by the expert evidence. I have given it no weight. Significant costs and court time could have been saved had that evidence not been adduced. …"

The admissibility of Mr Johnson's evidence

28. Mr Johnson's report contains the following sections:

1. *Introduction*
   - *1.1. Personal background and experience*
     - *1.1.1. Biography*
     - *1.1.2. Other qualifications*
     - *1.1.3. Experience in household goods*
   - *1.2. My duty to the Tribunal*
   - *1.3. My instructions*
2. *Background*
   - *2.1. Background to the laundry market*
   - *2.2. Definitions*
3. *Validity*
   - *3.1. Novelty*
   - *3.2. Individual character*
     - *3.2.1. Identify the sector of the registered design*

3.2.2. Identify the informed user

3.2.3. Designer's degree of freedom

3.2.4. The design corpus

3.3. Observations on specific designs

3.3.1. Unilever designs (RCD 3456771-0017, -0018, -0019, -0020, -0023, -0026)

3.3.2. Designs in page 20 of the proprietor's reply

3.3.3. CN 201730295927.7 – "Design 927"

3.3.4. CN 201730295890.8 – "Design 890"

4. Overall impression

4.1. Overall impression of the registered design

4.2. Overall impression of Design 889

4.3. Differences between the registered design and Design 889

5. Statement of truth

29. In section 1.2, he says:

> "I understand that my duty is to help the tribunal decide on matters which are within my own expertise. Furthermore, I understand that the views that I present must be my own and that I must not be swayed by anyone else. I understand that I must provide an objective opinion and not one which has any particular agenda. I understand that I must consider all material facts, including those which I find hard to reconcile with my overall view. I understand that I must say when an issue falls outside my area of expertise or when I do not have sufficient information to make a judgement. I have read and understand the provisions of Part 35 of the Civil Procedure Rules and the related Practice Direction along with the Civil Justice Council's Protocol for the Instruction of Experts to give Evidence in Civil Claims (as amended in October 2014)."

30. I remain of the view that this report constitutes expert evidence. I agree with Ms Halliwell that there is nothing in the Act or Rules that states that expert evidence may not be adduced and that at present there is no guidance on the point that is specific to registered designs. The report has been admitted into proceedings and

therefore I do not consider it would be appropriate to exclude it. On the basis of the case law cited by Ms Halliwell, it would be equally inappropriate to consider myself bound by the entirety of the report. I therefore set out here which parts of the report I deem to have evidential weight and on which parts I shall place no weight, and the reasons for my decision.

31. Part 1 contains introductory material, consisting of Mr Johnson's career and credentials; section 1.2 quoted above; and his instructions. This provides the context to what follows.

32. Part 2 consists of a section giving background information on the laundry market and the definitions used in the report. I will accept this as a summary of the market.

33. Part 3 contains sections on novelty, the individual character of the registered design, the informed user, the designer's degree of freedom and the design corpus, together with observations on specific designs. I consider that the part dealing with the designer's degree of freedom (3.2.3) is relevant to the issues I must determine and has weight. Mr Johnson says that he is unable to comment specifically on the design corpus at the relevant date and so I give no weight to section 3.2.4. Section 3.2.2. concerns the informed user. I shall say more about this legal construct later in my decision, but for the moment note that it is established case law that the informed user *"is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller"*: see *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), paragraph 34(i) (the emphasis is mine). For this reason, I do not consider that discussion of the behaviour of retail buyers is of much assistance, and so I give this section no evidential weight, although I will treat it as submission. The remaining sections in this part concern comparisons between designs. These are precisely the issues on which the court have said that expert evidence is not helpful, and so I will not accord these parts of the report any evidential weight, just as Mr Stone treated similar material in *Rothy's*. The same point applies in regard to Part 4 of the report.

Final written submissions

34. Neither side requested a hearing. On 8 July 2025, both sides filed written submissions in lieu of a hearing.

RELEVANCE OF EU LAW

35. 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.

PRELIMINARY ISSUE

36. On 12 November 2025, the applicant wrote to the Tribunal enclosing a copy of the decision of the EUIPO invalidating the Registered Community Design which was the basis for the contested design in these proceedings. This was followed by an email from the registered proprietor dated 17 November 2025, in which it objected to the submission of this decision at such a late stage and noting that the registered proprietor had filed an appeal against it. I can confirm that I have not taken the EUIPO's decision into account when making my decision, which is based on a careful consideration of the papers filed by both parties up to 8 July 2025.

DECISION

37. 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".

38. 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.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above 'normal use' means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product."

Prior art

39. As I have already noted, the applicant's statement of case refers to a number of registered designs with earlier filing dates. It is clear from the submissions of the applicant that it is the Chinese design No. 201730295889.5[5] ("the earlier design") that

[5] See paragraph 2 and the Annex to this decision.

is to be used as the basis of the comparison. I shall refer to the remaining designs when I come to consider the individual character of the designs, particularly in relation to the design corpus and the degree of design freedom for these products.

40. The earlier design has a publication date of 23 February 2018, which precedes the application date of the contested design (13 April 2018). It was clearly disclosed before the relevant date in these proceedings.

41. The registered proprietor submits that, contrary to the claims of the applicant, that it cannot be taken to be a fact that this design had *"become reasonably well known in normal commercial trade"*. I do not take this to be a challenge to the ability of the applicant to rely on this design as prior art. The registered proprietor rightly argues that this is not a relevant question. The test is whether the design *"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 the sector concerned"* (section 1B(6)(a)). If that is shown to be the case, the disclosure is an exempt disclosure. As I have said, I do not understand that the registered proprietor is arguing that the disclosure is covered by the exemption of section 1B(6)(a), but, even if it were, the onus would be on the registered proprietor to prove that allegation: see *Fairfax & Favor Limited & Ors v The House of Bruar Limited & Ors* [2022] EWHC 689 (IPEC), paragraph 89. It has not done so, and therefore the applicant may rely on the earlier design.

Identification of what is registered and the appropriate comparison

42. The parties were not in agreement about the interpretation of the contested design and what should be the basis for the comparison. The contested registration contains a single representation and the applicant submits that, if the registered proprietor had wished to protect the three-dimensional shape of the product, it would have filed more views. The registered proprietor, on the other hand, submits that the single representation does provide information about the three-dimensional aspects of the product's appearance.

43. In *Sealed Air Ltd v Sharp Interpack Ltd* [2013] EWPCC 23, HHJ Birss QC (as he then was) said:

> "20. … in my judgment the determination of what design is actually registered is a matter for the court. Once the design has been identified, then questions of overall impression and so on are matters to be decided by reference to the informed user. …"

44. In *Magmatic Limited v PMS International Group Plc*, [2016] UKSC 12, the Supreme Court considered the proper approach to the images of a registered design.[6] Lord Neuberger PSC said:

> "30. Article 3(a) of the Principal Regulation 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 *Proctor & 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 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

[6] In that case, it was a Registered Community Design, but the same law applies.

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 Registration* [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).'

32. This is entirely consistent with what is stated in paragraph 4.3 of OHIM's *Manual Concerning Proceedings Before the Office for Harmonisation in the Internal Market (Trade Marks and Designs), Registered Community Designs, Examination of Applications* (2nd ed, in force at the relevant time for present purposes). Over and above these considerations, it is also worth remembering that an applicant is entitled to make any number of applications. More broadly, it is for an applicant to make clear what is included and what is excluded in a registered design, and he has wide freedom as to the means he uses. It is not the task of the court to advise the applicant how it is to be done. That it may be said is a matter of practice rather than law …

33. So far as the presence or absence of colouring in any image is concerned, in para 32 of his judgment on this case Kitchin LJ explained that:

> '[a]n application for a Community Registered Design may be filed in black and white (monochrome) or in colour. If colour forms no part of the design then it is conventional to file the design in black and white. Similarly, if a particular colour does form part of an

aspect of a design then it may be filed wholly or partly in that colour. So also, if monochrome colours are a feature of the design, this can be shown by placing the design against a background of a uniform but different colour.'

34. That this has long been well established is supported by Dr Schlötelburg's article, in which he wrote that 'when a design is shown in colours, the colours are claimed, while a black and white drawing or photo covers all colours' – [2003] EIPR 383, 385. Accordingly, as Kitchin LJ observed at para 42 of his judgment, 'the various representations [in the CRD] are shown in monochrome, and so it must be concluded that this design is not limited to particular colours', and therefore 'PMS cannot point to the colour of the Kiddee Case as being a point of distinction'. There is, rightly in my judgment, no challenge to that conclusion, which is consistent with what was said by the Fourth Chamber of the General Court in *Sphere Time v OHIM* (Case T-68/10) [2011] ECDR 20, para 82."

45. Later in this judgment, Lord Neuberger PSC referred to the *Procter & Gamble* case cited in the above passage and said:

"46. … In *Procter v Gamble*, the registered design was illustrated by line drawings, which were clearly concerned purely with external shape. Both Lewison J ([2007] FSR 13) and the Court of Appeal held, as Jacob LJ put it at [2008] FSR 8, para 40, that '[t]he registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant.' Many line drawings simply show a physical shape, as in *Procter & Gamble*, but while they can show colouring and decoration, they are generally less appropriate for that purpose than photographs or CAD images, which can easily show subtle shadings and contours, as well as decoration, such as colours and ornamentation. Accordingly, while each Community Registered Design image must be interpreted in its own context, a line drawing is much more likely to be interpreted as not excluding ornamentation than a CAD image. That is consistent with what Dr Schlötelburg wrote on the article from which I have already quoted, namely that '[b]asically, the broadest claims

can be achieved by drawings showing only the contours of the design. In contrast, a photo specifies not only the shape, but the surface structure and the material as well, thereby narrowing the scope of protection accordingly' – [2003] EIPR 383, 385."

46. The single representation of the contested design shows the front (or top) view of a washing capsule. I agree with the applicant's claim that it consists of three drop-shaped chambers arranged in a circle on a square background. The contours of this background suggest to me that it is flexible and may be a film. I note here that the applicant's pleadings refer to the capsule as containing film material. Contours can also be seen on the chambers along with images showing the effect of light on the surface. I consider that the chambers protrude from the film background with the light spots showing their highest points.

47. I am unable to draw any conclusions about the appearance of the rear (or bottom) of the capsule. It is possible that the three-chamber structure is repeated below, but it is equally possible that there is a further single chamber or that the chambers that are visible sit on the film background, which has nothing underneath (or behind) it.

48. The point of reference for my comparison is the contested design. In *Ball Beverage Packaging Europe Ltd v European Union Intellectual Property Office (EUIPO)*, Case T-9/15, the General Court ("GC") said:

"87. In that context, in paragraph 29 of the contested decision, the Board of Appeal correctly noted that the contested design showed three beverage cans, without printed text, in black and white and that it was not possible to clearly determine, from the representation, whether the cans were fitted with a lid. The Board of Appeal correctly concluded that, in so far as the comparison could be based solely on the features which are disclosed in

the contested design, the configuration of the lid of the can should not be taken into consideration in the assessment of the overall impression."

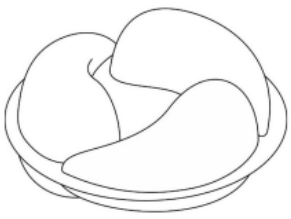
49. I shall therefore base my comparison on the appearance of the top/front half of the earlier design. The representations of this design are line drawings. In the light of the discussion in *Magmatic*, I consider that what is disclosed in the earlier design is the shape of the capsule, along with the configuration of the chambers. It is the shapes of the two designs that will be the subject of my comparison.

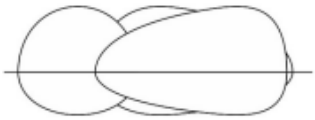
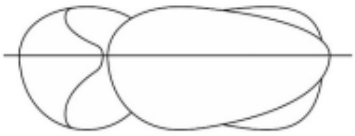
Novelty

50. 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."

51. In the table below I show the contested design alongside the prior art upon which the applicant may rely:

The Contested Design	**The Earlier Design**
	

The Contested Design	The Earlier Design
	    

The Contested Design	The Earlier Design
	

52. The parties are in agreement that the two designs share the following features:

(i) The capsules contain three drop-shaped chambers, each intended to hold detergent;

(ii) these chambers are arranged around a central axis of rotation that protrudes perpendicularly from the plane;

(iii) the outer edges of the drops form a circle; and

(iv) each of the chambers has the same area as the other chambers in the design.

53. The applicant submits that a further similarity is that each of the chambers is orientated in the same direction and arranged at the same radial distance *"as if they were rotating around the central axis all in the same direction"*.[7] This is denied by the registered proprietor who submits that the point at which the radial distance is measured has not been specified and argues that:

"The widest portions of the chambers in Design 889 [the earlier design] are oriented generally towards the narrow end point of the adjacent chambers. In contrast, the wider portions of the chambers in Registered Design [the contested design] are oriented towards a much wider region of the adjacent

[7] Statement of Case, page 8.

chamber, more than halfway along the inner edge of the adjacent chamber."[8]

54. This is illustrated in the image below:[9]

Registered Design	Design 889
	

55. In response, the applicant maintains that they are arranged at the same radial distance and that this is apparent from the front view of the prior design. In my view, all the drop-shaped chambers are orientated with wide end to narrow end in the prior design, and with wide end to the concave part of the inner curve of the drop in the contested design. That all drops within a design are orientated the same way is a similarity, but the nature of that orientation is a difference between the designs.

56. The parties are agreed that the designs differ in the following ways:

(i) The outer part of the contested design is square, while that of the earlier design is circular; and

(ii) The contested design is in colour while the earlier design has no colour. However, for the reasons I have already explained, this is not a factor in my analysis.

57. The registered proprietor also points to what it sees as further differences. In the contested design, the drops are arranged more closely together, with a smaller central space between the chambers. It also submits that the drops are proportionally larger in the contested design than they are in the prior design and have a more pronounced curvature, which allows them to fit together more closely. I agree that these are all noticeable differences between the designs. In my view, the differences I have

[8] Counterstatement, paragraph 33(iii).
[9] Ibid, paragraph 46.

described are more than minor and trivial and so I find that the contested design is new when compared with the earlier design.

Individual Character

58. 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. As HHJ Birss QC (as he then was) pointed out in *Samsung*, "*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. He also said

> "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."

59. 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."

The sector to which the designs belong

60. Both parties agree that the designs are for detergent capsules. They include a single dose of the products used for laundry purposes.

The informed user

61. In *Samsung*, the judge gave the following description of the informed user, which was approved on appeal:[10]

[10] [2012] EWCA Civ 1339 at [10].

"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)."

62. The applicant submits that the informed user is the consumer at the household level who is responsible for doing the laundry and for purchasing the products required to carry out that task. The registered proprietor disagrees. In its view, this person is the average consumer of trade mark law, and a more appropriate definition of the informed user would be a retail buyer, a media service provider who has experience advertising this type of laundry product, or a generic capsule manufacturer. I disagree with the registered proprietor's definition. It is settled case law that the informed user is not a designer, technical expert, manufacturer or seller: see point (i) of the summary cited above. I have already referred to this point when considering the extent to which Mr Johnson's report constitutes expert evidence.[11]

63. The informed user is a legal construct, described by the Court of Justice of the European Union ("CJEU") in *PepsiCo Inc v Grupo Promer Mon-Graphic SA*, C-281/10 P, in the following terms:

> "53. It should be noted, first, that Regulation 6/2002 does not define the concept of the 'informed user'. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question."

64. In my view, the informed user is an individual who does the laundry at home, but who has an awareness of the designs in this sector and pays attention to the products when using them. I do not consider that it is likely that the informed user will conduct a direct, side-by-side comparison of the designs at issue. This is because they are sold in containers, and such a direct comparison would require the informed user to have purchased competing goods. Mr Johnson's evidence on the nature of the laundry

[11] See [paragraph 33] above.

detergent market is that there is a significant degree of brand loyalty, and this points away from the scenario in which direct comparison takes place. Instead, I find that it is more likely that the informed user will compare the design of the product that they use with an image of another product on the container in which it is sold or in advertisements.

The design corpus

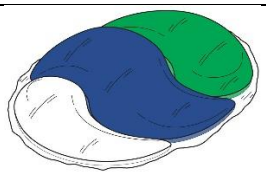
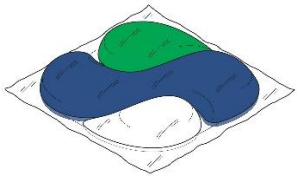
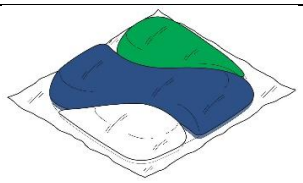
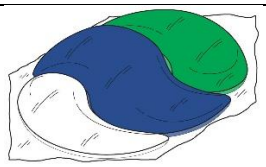
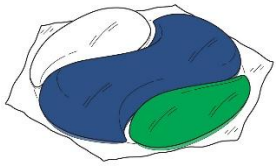
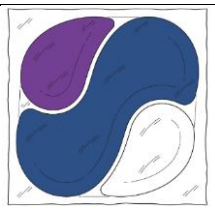
65. Both parties have drawn my attention to designs registered prior to the relevant date which show multi-chamber capsules. In addition, the applicant has also given me images of the containers or packaging in which the capsules are sold.

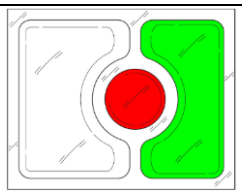
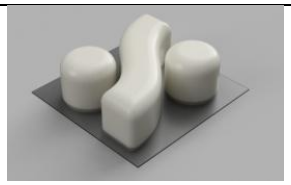
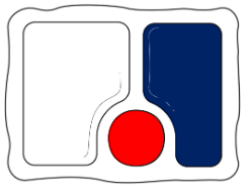
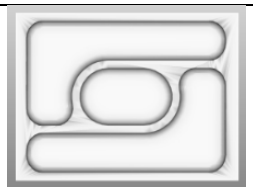
66. In *Marks and Spencer PLC v Aldi Stores Limited* [2023] EWHC 178 (IPEC), HHJ Hacon said:

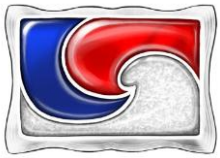
> "56. The corpus includes designs of which the informed user is not aware, see *Easy Sanitary Solutions BV v Group Nivelles* (Case C-361/15 P) EU:C:2017:720, at [130]-[134]. In that case the CJEU was concerned with validity but I will assume the same applies in the context of infringement. The corpus includes any design 'disclosed' within the meaning of art.7 of Regulation 6/2002 at the relevant date. The apparent legal fiction is that for the purpose [of] making a comparison of overall impressions, the informed user may be directed to compare a design within the corpus of which he or she had hitherto been unaware."

67. Following this guidance, I shall therefore consider that all the design registrations shown in evidence that were published prior to the relevant date are part of the design corpus, as these would be considered to be disclosed at the relevant date. As there is no evidence that the packaging shown in the applicant's statement of grounds was on the market at the relevant date, I shall disregard those examples.

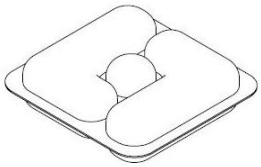
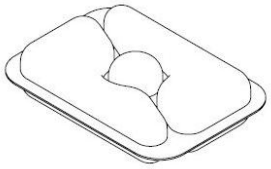
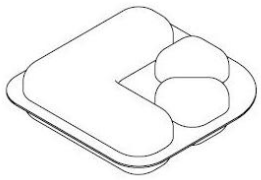
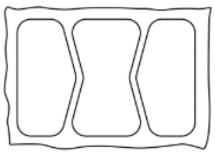
68. The table below shows the registered designs that had been published by the relevant date of 13 April 2018:

RCD 003456771-0017 Publication date: 9 February 2018	
RCD 003456771-0018 Publication date: 9 February 2018	
RCD 003456771-0019 Publication date: 9 February 2018	
RCD 003456771-0020 Publication date: 9 February 2018	
RCD 003456771-0023 Publication date: 9 February 2018	
RCD 003456771-0026 Publication date: 9 February 2018	
RCD 003456771-0015 Publication date: 9 February 2018	

RCD 003456771-0012 Publication date: 9 February 2018	
RCD 002496265-0001 Publication date: 5 January 2017	
RCD 002756205-0046 Publication date: 13 November 2017	
RCD 002938332-0006 Publication date: 22 November 2016	
RCD 003467711-0007 Publication date: 21 November 2016	
RCD 003042696-0050 Publication date: 27 October 2016	
RCD 003416536-0031 Publication date: 26 October 2016	

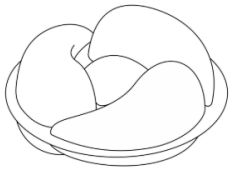
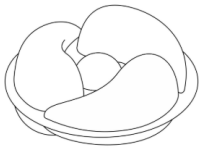
RCD 003228105-0001 Publication date: 5 July 2016	
RCD 001785361-0006 Publication date: 25 January 2013	

Registered proprietor's counterstatement

RCD 002063412-0001 Publication date: 15 September 2014	
RCD 002063412-0004 Publication date: 15 September 2014	
RCD 002063438-0001 Publication date: 21 October 2014	
RCD 002844035-0002 Publication date: 17 November 2015	
RCD 002118075-0001 Publication date: 16 October 2012	

RCD 004390664-0002 Publication date: 17 October 2017	
RCD 004390664-0001 Publication date: 17 October 2017	

Registered proprietor's evidence

Chinese design 201730295890.8 Publication date: 23 February 2018	 
Chinese design 201730295927.7 Publication date: 23 February 2018	 

69. There are 25 registered designs, the majority of which are for capsules with three chambers. The two shown in the registered proprietor's evidence have one inner and three outer chambers. The shapes of those chambers vary. The first six consist of a central "S"-type chamber, with teardrop-shaped ones either side. Four further designs also use teardrop shapes. These account for two-fifths of the examples shown. Other

shapes include the letter “L”, rectangles with portions cut out, circles and a wave pattern in RCD 001785361-006. The chambers are configured in a variety of different ways with only the drops shown in the registered proprietor’s evidence being arranged in around a central axis of rotation, at the centre of which is the fourth chamber. The majority of the designs are surrounded by what appears to be a flat surface. In some of these this is shown as a film. The designs are circular, oval, square, rectangular or hexagonal.

Design freedom

70. In *Whitby Specialist Vehicles Limited v Yorkshire Specialist Vehicles Limited* [2014] EWHC 4242 (Pat), Arnold J (as he then was) said:

> “24. … I considered the designer’s degree of freedom in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), [2010] FSR 39 at [32]-[37], where I concluded 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. I also concluded that both a departure from the existing design corpus and the production of a wide variety of subsequent designs were evidence of design freedom. Apart from emphasising that the degree of freedom to be considered was that of the designer of the registered design, the Court of Appeal appears to have agreed with this: [2011] EWCA Civ 1206, [2012] FSR 4 at [18]-[20].”

71. The applicant submits that there are no limitations on design freedom and *“all forms are conceivable”*.[12] In particular, it argues that there are no size limitations:

> “… the Tribunal is reminded that the indication of product in a registered design does not limit the scope of protection. The indication of product is primarily for administrative purposes, such as classification and searching, and does not restrict the rights granted by the registration. The scope of protection is determined by the visual appearance of the design as represented in the application, not by the specific product it is initially intended for.

[12] Statement of Case, page 10.

…

> The registered design could … be reproduced in a large scale advertisement at one extreme being the size of a large billboard or at the opposite extreme on packaging whilst still comprising the same features of shape as defined in the design."[13]

72. It is well established that the protection conferred by a registered design includes any design which is not new or does not produce on the informed user a different overall impression, and that this does not depend on the nature of the product in which the design is to be incorporated: see *Easy Sanitary Solutions BV v EUIPO*, Joined Cases C-361/15 P and C-405/15 P, paragraphs 91-92. However, in order to determine the degree of freedom enjoyed by the designer, I must keep in mind the product in which the design is to be incorporated and the sector concerned. This is, as I have already found, detergent capsules for laundry. I accept that the representation in the registration could be shown on the packaging or on a large billboard. Nevertheless, it would be used in this way as a representation of the physical laundry detergent capsule.

73. The registered proprietor submits that there are constraints on the size of detergent capsules. Mr Johnson states that they need to be large enough to include sufficient detergent to wash laundry effectively. They would also need to be small enough to fit in the hand of the user.

74. He also states that the shape of the capsule is constrained by manufacturing techniques:

> " … Typically a die is used to form chambers in a film of material, such as PVA. For a single chamber capsule, the die would have a base cup and a top sheet. The more chambers that are added, the more difficult it becomes to manufacture a capsule, because the die is required to be more complex, and it becomes harder to seal the chambers to prevent leakage between them. Therefore, it is not simple to make any arbitrary, intricate shape. For

[13] Final written submissions, pages 1-2.

this reason, the capsule market was originally dominated by single chamber capsules, because square-shaped chambers are easiest to make and fill.

With the manufacturer I visited for multi-chamber capsules, the chambers have to be filled simultaneously. This means that with more chambers or with complex shapes, it becomes harder to fill the capsules at the same time while avoiding leakage between the chambers.

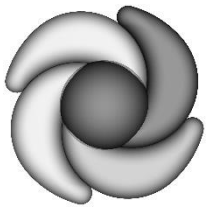
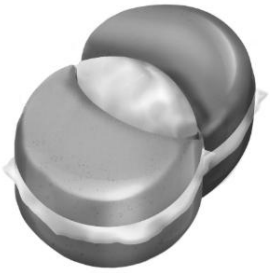
Another constraint on shape is imposed by the fact that the film thickness has to be correct for several reasons. It is important not to overfill or underfill the chambers since when a capsule is formed, the film becomes thinner due to it being stretched (i.e., the film will be thinner if more liquid is put into the capsule).

To prevent leakage between chambers, the spacing between the chambers of the thickness of the film in the spaces needs to be controlled, which impacts the chamber shapes and film thicknesses that can be used. The correct film thickness has to be robust enough to survive the manufacturing process and shipping process, which can be weeks and include air and sea transport for commoditised goods such as laundry detergent capsules. Therefore, there is a minimum film thickness for the capsules to be robust enough to survive manufacturing and transit. So the more complex the design the greater the risks of failures which would again reduce the freedom to design really complicated shapes.

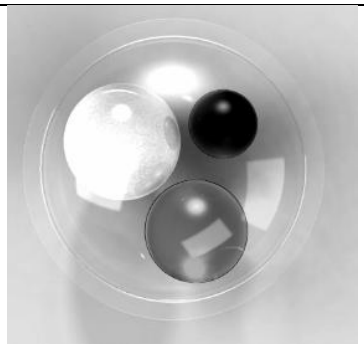
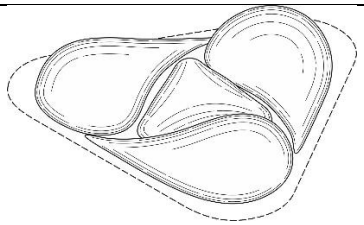
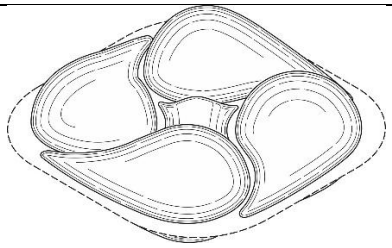
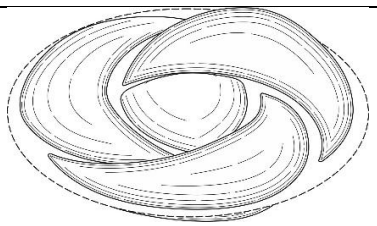
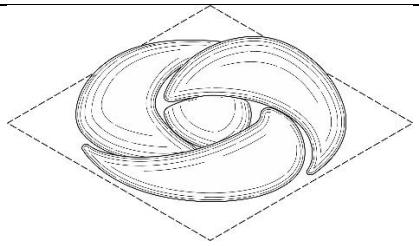
Additionally, the more complicated the shape, the harder it becomes to ensure that capsules are manufactured consistently. Since capsules are mass produced and consistent performance between washes is important to consumers (and this is a factor that is important to consumers, since brand loyalty and familiarity is strong in the laundry sector), it is not acceptable if different capsules perform differently or if some of the capsules in a packet show leakage. For commoditised products such as laundry capsules, economic considerations mean that it is desirable for manufacturing sites to operate long runs without faults developing, which would impact the level of complexity in shape that can be achieved.

Therefore, because of the practicalities of the manufacturing process, it can be hard to manufacture extremely intricate (e.g., extremely thin, or complex interlocking or multiple curved) shapes while avoiding breakage during manufacturing and/or transit, while achieving standardised performance in capsules having sizes that consumers require at acceptable prices."[14]

75. Some of the designs referred to by the registered proprietor were published after the relevant date but they may still be informative of the degree of design freedom. Those designs are as follows:

UK registered design 90037092290001 Publication date: 13 March 2019	
RCD 4406866-0016 Publication date: 18 November 2019	
RCD 4559565-004 Publication date: 20 June 2018	
RCD 4559565-005 Publication date: 20 June 2018	

[14] Witness statement of Stephen Johnson, section 3.2.3.

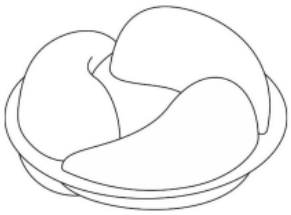
RCD 4559565-003 Publication date: 20 June 2018	
UK registered design 90045576270001 Publication date: 15 November 2019	
UK registered design 90045576270003 Publication date: 15 November 2019	
UK registered design 90045576270004 Publication date: 15 November 2019	
UK registered design 90045576270006 Publication date: 15 November 2019	

76. The images reproduced above, along with those in the table in [paragraph 67] above, show that there is, within the technical constraints described by Mr Johnson, a variety of different shapes that can be used for the chambers and ways in which those chambers may be configured. There is also a degree of freedom over the number of compartments, although this will in my view be dictated by the number of different separate functions the capsule must perform (e.g. cleaning the clothes, fabric

conditioning, preserving the colour of the laundry, and so on), rather than be the result of an aesthetic choice.

Overall impression

77. For convenience, I show the contested and earlier designs below, focusing on a smaller number of representations of the earlier design:

The Contested Design	**The Earlier Design**
	 

78. In *Marks and Spencer*, HHJ Hacon said:

> "78. … Jacob LJ also observed in *Procter & Gamble* that the design corpus does not have a bearing on the assessment of infringement because of any statutory provision or other rule of law. It arises from the way that human observation works. There is a continuous spectrum of possibilities but the more strikingly different the registered design is from the design corpus generally and the fewer in the corpus that are close to it in appearance, the more likely it is that an accused design with something of the registered design's unusual features will produce the same overall impression."

79. I see no reason why the same should not apply in the case of a question of validity.

80. Earlier in my decision, I found that the two designs consisted of capsules containing three identically-sized drop-shaped chambers, arranged around a central axis of rotation protruding perpendicularly from a plane, with the outer edges of the drops forming a circle. They differ in the details of the shapes of the drops, for instance the curvature, which results in differently-sized central spaces, and in the shape of the outer part of the capsule.

81. I am required to base my assessment on the overall impression of the respective designs, not a list of the similarities and differences. The examples from the design corpus show that there is a relatively high degree of design freedom in the shapes of the chambers, their configuration and the overall shape of the capsule. It is my view that the overall impression of both designs is of three drop-shaped chambers arranged in a circle. The differences that exist are of relatively minor detail when considered in the light of the design corpus and the degree of freedom enjoyed by the designer. I find that the contested design and the earlier design do not produce a different overall impression on the informed user.

CONCLUSION

82. The application to invalidate Registered Design No. 90052330530001 is successful.

COSTS

83. The applicant has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. In the circumstances, I award the applicant the sum of £2,398, which has been calculated as follows:

> *£400 for preparing a statement and considering the other side's statement;*
> *£1,200 for considering and commenting on the other side's evidence and submissions;*
> *£450 for preparing written submissions in lieu of a hearing.*
> *£300 for preparing for and attending the Case Management Conference;*
> *£48 for official fees*
> ***£2,398 in total***

84. I order Persan, S.A. to pay ICAP Laundry Care, S.L. the sum of £2,398. 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 11th day of June 2026

Clare Boucher
For the Registrar,
The Comptroller-General

ANNEX

Representations of Chinese Design No. 201730295889.5