

O/0862/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6207283

IN THE NAME OF

C & L (SW) LIMITED

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION NO 94/23

BY SONGBAI TANG

BACKGROUND AND PLEADINGS

1. UK Registered design no. 6207283 (“**the Contested Design**”) stands in the name of C & L (SW) Limited (“**the Proprietor**”). It has an application date of 11 May 2022 (“**the Relevant Date**”).¹ The Contested Design is registered as from the Relevant Date as applying to telecommunications equipment, wireless remote controls and radio amplifiers within recording, telecommunication or data processing equipment (Class 14, Sub-class 03 of the Locarno classification). The indication of the product is given as “remote control”. Photographic representations of the design are shown later in this decision.
2. On 21 April 2023, Songbai Tang (“**the Applicant**”), through Monyin Lin Chien as his legal representative, filed a Form DF19A applying for a declaration of invalidity against the Contested Design 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 designs must be new and have individual character. The Form DF19A claimed that the design had been publicly available before the Relevant Date, detailing the following 5 prior disclosures, comprising 3 listings on Amazon and 2 earlier registered designs (in China and the EU):

Prior disclosure 1 - ASIN B0932JM8FK – Publication date as early as 21 April 2021;

Prior disclosure 2 - ASIN B09PRD14F9 – Publication date as early as 5 January 2022;

Prior disclosure 3 - ASIN B09W94P5LP – Publication date as early as 23 March 2022;

Prior disclosure 4 - CN 306794941 – Published August 31 2021;

Prior disclosure 5 - EUD 005619855-0002 – Publication date as early as August 31 2021;

3. A Form DF19B was filed in defence of the Contested Design, and, following amendments, the counterstatement makes the following points:
 - i. The Proprietor disagrees with the Applicant’s claims;
 - ii. “the original design is not the same as mine as per picture attached [below]. The original has a hole in top right hand corner and mine doesn’t”

¹ The registered design was granted on 2 June 2022 and published on 3 June 2022.



- iii. The Proprietor argued that the Applicant's evidence based on "date first available" on Amazon marketplace, is unreliable because pictures of a listing can be changed on Amazon and a seller may have been selling a different product at the date of first availability.
- 4. No evidence or submissions were filed during the evidence rounds, and neither party requested a hearing or filed further submissions; this decision is based on my careful consideration of the papers that were filed.

Relevance of EU law

- 5. The Proprietor acts in these proceedings without legal representation in the matter, so it is perhaps worth explaining that although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period (i.e. at 31 December 2020). The provisions of the Act relied on in these proceedings are derived from an EU Directive. That is why there are references in this decision to the designs case law of the EU courts.

DECISION

Legislation

6. 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”.

7. 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.”

Prior Art

8. The Applicant's DF19A contains pages of exhibited images and the statement of case is signed under a statement of truth.² As such, I find that it has some evidential materiality. In addition to the URLs for the links to the three separate Amazon listings, the Applicant provides images from the relevant pages from Amazon, including:

Prior disclosure 1:

Product details

Package Dimensions : 14.2 x 4.2 x 1.8 cm; 40 Grams

Date First Available : 21 April 2021

Manufacturer : DaMohony

ASIN : B0932JM8FK

Item model number : L5B83H

Best Sellers Rank: 13,477 in Electronics & Photo (See Top 100 in Electronics & Photo)

870 in Remote Controls (Electronics & Photo)

Customer reviews: ★★★★★ 2,546 ratings

Prior disclosure 2

Product details

Package Dimensions : 14.1 x 4 x 1.9 cm; 40 Grams

Date First Available : 5 Jan. 2022

Manufacturer : ciciglow

ASIN : B09PRD14F9

Manufacturer reference : ciciglowtk321h8dic2617

Best Sellers Rank: 57,912 in Electronics & Photo (See Top 100 in Electronics & Photo)

4,818 in Remote Controls (Electronics & Photo)

Customer reviews: ★★★★★ 55 ratings

² At section 7 of the Form DF19A.

Prior disclosure 3:

Product details

Batteries : 2 AAA batteries required.

Product Dimensions : 14.1 x 4.7 x 1.9 cm; 40 Grams

Date First Available : 23 Mar. 2022

Manufacturer : RUIZHI

ASIN : B09W94P5LP

Best Sellers Rank: 5,472 in Electronics & Photo (See Top 100 in Electronics & Photo)
305 in Remote Controls (Electronics & Photo)

Customer reviews: ★★★★★ 35 ratings

9. Before I compare the Contested Design against the claimed prior disclosures, I will first address the Proprietor's submission that the remote controls shown for sale on Amazon may be an unreliable basis on which to establish that the designs had been made available to the public before the Relevant Date. The DF19A contains pages of exhibited images and includes the following observations:

"The nature of the internet can make it difficult to establish the actual date on which information was in fact published. For instance, not all web pages mention the date when they were launched. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records that enable members of the public to establish precisely what was published and when.

In this context, the date of disclosure on the internet will be considered reliable in particular where:

- the web site provides time stamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or*
- indexing dates are given to the web page by search engines; or*
- a screenshot of a web page bears a given date; or*
- information relating to the updates of a web page is available from an internet archiving service."*

10. I find that these are reasonable submissions. The Proprietor's point about editing is not supported by any evidence around the capacity to change images relating to a

product designated by a particular ASIN code (without, for instance, there being a change of ASIN or impact on the stated date of first availability); it is not even directly submitted that there has been editing of images in the present case, still less *evidence* of any changes having been made. While the Applicant's evidence might have been stronger had it shown the content of the Amazon website before the Relevant Date, it is my view that the Date First Available is acceptable prima facie evidence that the product had been made available to the public before the Relevant Date. The Proprietor was afforded opportunities to file evidence if it wished to challenge the prima facie evidential material contained in the Form DF19A. It did not do so. In civil proceedings, facts are to be decided on the balance of probabilities. In my view, in the absence of evidence to the contrary from the Proprietor, the Applicant's DF19A provides prima facie evidence that the products shown therein (Prior disclosures 1, 2 and 3) were first made available to the public on the dates stated. This is all the more probable given the three different manufacturers identified in association with the remote controls shown as listed. I shall therefore treat these as disclosure of the prior art in accordance with Section 1B(5) of the Act.

11. In addition to the three remote controls shown for sale on Amazon, the Applicant has also identified two registered designs that predate the Relevant Date, namely: Prior disclosure 4: CN 306794941 S (published on 31 August 2021) and Prior disclosure 5 - EUD 005619855-0002 (publication date 24 September 2020). The fact of disclosure of these registered designs prior to the Relevant Date is unimpeachable.

Novelty

12. 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.”

13. The table below shows the illustrations of the Contested Design as they appear in the register:

The Contested Design	
Image 1 	Image 2 

The Contested Design	
Image 3 	Image 4 
Image 5 	Image 6 

14. The table below shows the images of the remote control available on Amazon before the Relevant Date – Prior Disclosures 1 - 3.

Images Cited from Prior Disclosure 1



Images Cited from Prior Disclosure 2

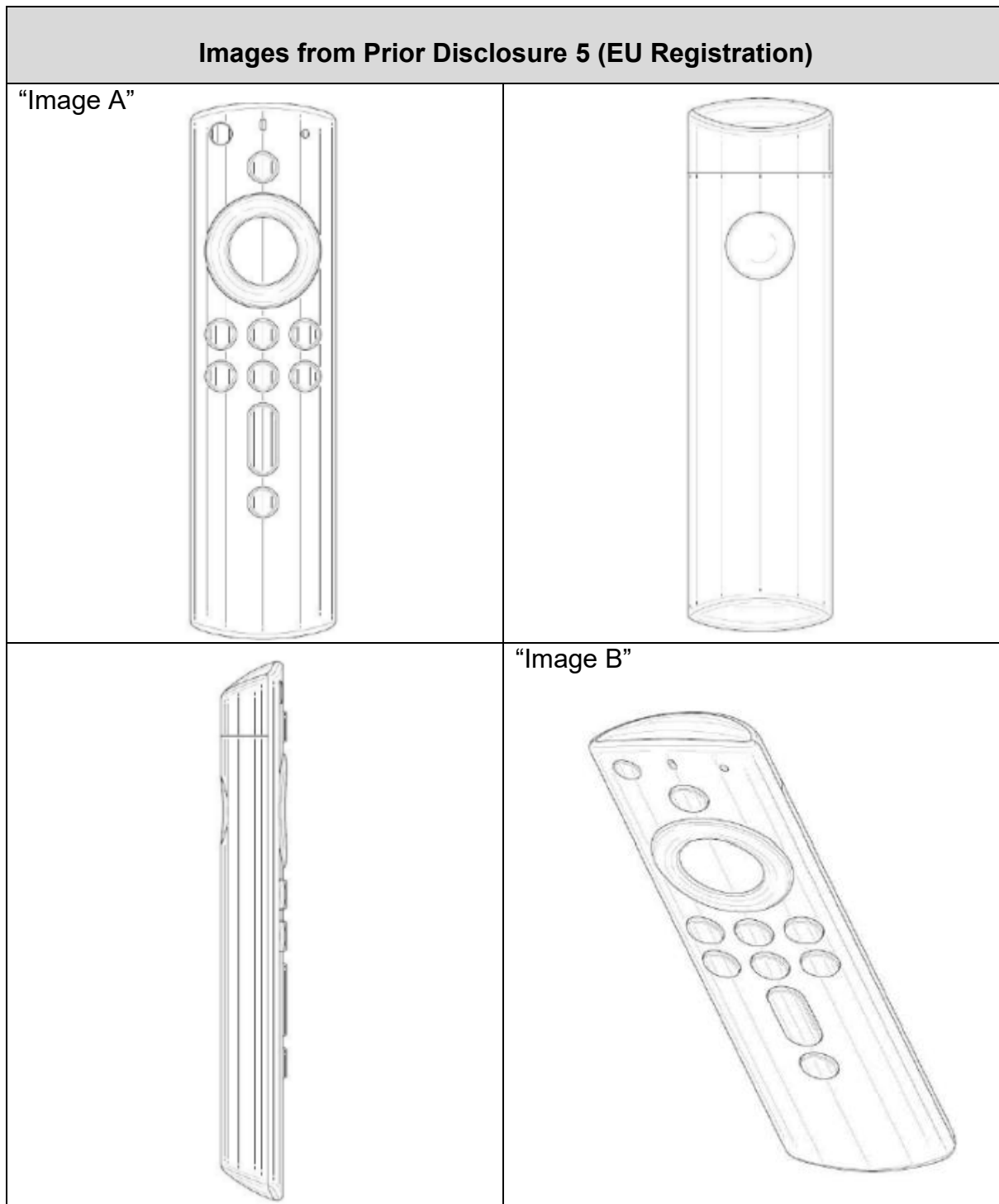




15. The Proprietor's defence, summarised at paragraph 3 above, contained no denial that the remote control products shown as sold on Amazon are identical to the Contested Design. From images in the tables above, I am unable to discern even immaterial differences and it appears to me that the designs are clearly identical. I find that the Contested Design was not new at the Relevant Date since it lacks novelty when compared to the prior art.
16. Since I have noted no differences between the Contested Design and the images on Amazon that form the prior art, and have therefore found the respective designs to be identical, it inevitably follows that the overall impressions produced on the informed user will not differ. Consequently, I find that the Contested Design lacked individual character when compared with the prior art cited by the Applicant.

17. In light of my above findings, based on the Amazon products, the Contested Design is invalid. For the sake of completeness, I shall also consider the prior art based on the previously published designs registered in China and the European Union.

Images from Prior Disclosure 4 (Chinese Registration)	
	
	



Individual character

18. I shall first consider whether the Contested Design had individual character at the Relevant Date, since a design may be "new", but still lack the necessary "individual character" compared to the prior art.

19. Section 1B(3) states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. A design may create the same overall impression on the informed user as another design, while being different from it in some respects. I need to assess the similarities and differences and determine their impact on the overall impression of the Contested Design.
20. In the High Court case *Safestand Ltd v Weston Homes PLC & Ors*,³ HHJ Hacon, set out at [237] the approach to the assessment of whether a design has individual character:
- “(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;
- (2) Identify the informed user and having done so decide
- (a) the degree of the informed user's awareness of the prior art and
- (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;
- (3) Decide the designer's degree of freedom in developing his design;
- (4) Assess the outcome of the comparison between the RCD and the contested design, taking into account
- (a) the sector in question
- (b) the designer's degree of freedom
- (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public
- (d) that features of the designs which are solely dictated by technical function are to be ignored in the comparison, and

3 [2023] EWHC 3250 (Pat).

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

The sector and the informed user

21. The sector is the market for remote controls.
22. The next consideration is the informed user. HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court in *Samsung Electronics (UK) Ltd v Apple Inc.*,⁴ observed that: “[...] the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”
23. HHJ Birss QC also gave the following detailed summary of the characteristics 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);*

4 [2012] EWHC 1882 (Pat)

- 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)."*

24. The informed user in the present proceedings is a member of the public with an interest in remote controls. The informed user will be reasonably attentive to ensure that the remote control is compatible with the machine or device to be operated, as well as considering the aesthetics. There appear no special circumstances that would mean that the informed user does not conduct a direct comparison of the designs.

Design freedom

25. In *Dyson Ltd v Vax Ltd*,⁵ Arnold J (as he then was) stated that:

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

5 [2010] FSR 39.

26. The purpose of a remote control is to enable a user to operate the associated device (such as a television) wirelessly, from a distance. The remote control must be of a size and shape that fits comfortably in the user's hand. It must also feature buttons that are pressed by the user for the purpose of controlling the device. Beyond that, there appears to be a reasonable degree of design freedom. The outside shape and the edges of the remote control can vary, and, within the confines of the different functions the remote control needs to perform, it does not really matter how many buttons there are, what size and shape they are, or how they are configured on the remote control.
27. A design must be interpreted objectively: *Celaya Emparanza y Galdos Internacional SA v Proyectos Integrales de Balizamiento SL*.⁶ The objective interpretation of a design is a matter for the tribunal, not the tribunal viewing the design through the eyes of an informed user: *Sealed Air Limited v Sharp Interpack Limited*.⁷
28. The Prior Disclosure 5 (the EU Design) shows the product in line-drawing form, whilst the registered images of the Contested Design are photographs of the product. The indication of the product should be taken into account in looking at the features of the contested design when it is assessed for individual character against the prior design.⁸ In my view, when considering the prior design in the context of the indication of the product (a remote control), it is reasonable to interpret the lines in the representations as showing the shape of the remote control and the configuration of the buttons on the front of the remote control.
29. The Prior Disclosures 4 and 5 and the contested design share the following design features:.
- (a) The remote controls are oblong-shaped. When looking at each design from a different angle, perspective changes the way the shape appears, such that when viewed from above, the shape appears rectangular, but with a curved top and bottom; when viewed from either end, the shape appears almost semicircular, with the top of the remote control being fairly flat and the bottom domed. When

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

7 [2013] EWPCC 23, at [20]-[21]

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

considering the above representations of the competing designs, the shape appears identical in each design when viewed from the same angle.

- (b) On the front of the remote control, each design features the same number of button shapes, which appear to be of the same size and configuration. The buttons from the top of the remote control to the bottom include: a circular button at the top, left-hand side, a circular button centrally near the top, a larger circular button (represented by two rings in the EU Design), six circular buttons in two, horizontal lines of three, a capsule-shaped button (rectangular with semicircular ends) positioned vertically, and a circular button centrally near the bottom.
- (c) On the front of the remote control, each design also features a small oval shape centrally at the top. This appears to be a hole for a microphone or an LED light, for example, and is the same size and shape and in the same location in each design.
- (d) On the reverse of the remote control, each design features a horizontal line near the top which spans the width of the remote control. Below the line, the designs include a circular shape identical in size and location (though this detail is not fully clear in the Chinese design).

- 30. Prior Disclosure 5 features double dashed lines round some of the buttons. It is my understanding that these indicate that there is a thin gap between the button itself and the surface of the remote control. This gap can also be seen on the Contested Design.
- 31. There are vertical lines on the front and back of the prior design, which I take these to indicate a slight curve of the surface of the remote control. It is a little difficult to see, but it appears that the Contested Design has a curved front (it clearly has a curved back), but anyway the difference between the front of each remote control is so slight that I do not consider it to affect the overall impression of the designs.
- 32. The fact that the Contested Design is in black and that the buttons feature specific symbols is not relevant, because the earlier registered China and EU designs are not

protected for a particular colour or particular text on the buttons. The prior designs are registered for their shapes, which are identical to that of the contested design.

33. The only difference mentioned by the Proprietor between the Contested Design and what is shown in all of the prior art relates solely to Prior Disclosure 5 (the EU Registered Design), restricted to the second tiny hole visible in Image A and B in the top right corner of the remote control. In my view, that hole is so small that it may be considered to be an “immaterial detail”, a difference “only minor and trivial in nature, not affecting overall appearance”. In that event, on the basis of the principles I outlined previously, the Contested Design would lack novelty even compared to Prior Disclosure 5.
34. However, even if the additional tiny hole were enough to generate novelty, the Contested Design would still lack individual character. According to the principles from *Samsung Electronics (UK) Ltd v Apple Inc*, the similarities and differences will be observed by the informed user who pays attention to detail. The similarities and differences will be picked up not only through minute scrutiny. Taking into account the analysis above, including the weight of the similarities and differences and the degree of design freedom in relation to the various elements, I find that the Contested Design conveys the same overall impression on the informed user as both Prior Disclosures 4 and 5. (Indeed the Proprietor made no submission to contest that the Contested Design differs from Prior Disclosure 4, and I find that they are identical in shape and configuration and the Contested Design cannot be considered new.)

OUTCOME

35. The application for a declaration of invalidity succeeds - Design No. 6207283 is invalid.

COSTS

36. The Applicant is entitled to a contribution to the costs of bringing this invalidity application. The Applicant engaged professional legal representation and I make the following award based on the standard scale.

Official fee: £48

Filing a statement of case and considering the proprietor's statement (including evidential content): £500

Total £548

37. I order C & L (SW) Limited to pay Songbai Tang the sum of £548. This sum should 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 24th day of September 2026

Matthew Williams

For the Registrar
