

O-456-12

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 4021841

IN THE NAME OF GARDECO LIMITED

AND

A REQUEST TO INVALIDATE (NO. 5/12)

BY LA HACIENDA LIMITED

The background and the pleadings

1) The registered design the subject of these proceedings was filed by Gardeco Limited (“Gardeco”) on 6 October 2011. The design is described as “a conical steel chimenea with stainless steel rim around the mouth” and is depicted below:



Its certificate of registration was granted on 27 October 2011.

2) La Hacienda Limited (“Hacienda”) requests the invalidation of Gardeco’s design under section 1B(1)¹ of the Registered Designs Act 1949 (“the Act”), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The other design relied upon by Hacienda is its own registered design (no. 4012270) which was filed on 22 August 2009; its certificate of registration was granted on 18 September 2009. Hacienda also claims that articles made to its design were made available to the public by way of a brochure, also in 2009; a copy of the brochure was attached to its statement of case. Hacienda’s design is depicted below:



¹ Which is relevant in invalidation proceedings due to the provisions of section 11ZA.

- 3) Hacienda makes various comments in its statement of case including:
- That there is not “clear blue water” between the designs;
 - That the difference in the mouths of the two designs is not sufficient to provide individual character;
 - That none of the features of the designs are dictated by function;
 - That both products are chimeneas and thus the similarity is greater.
- 4) Gardeco filed a counterstatement denying the claim. It highlights various differences between the designs including:
- The difference in the opening/mouth shape;
 - The difference in the top piece;
 - The different arrangement of the feet;
 - That Gardeco’s design has a sleek/modern look whereas the prior art has a gothic/traditional look.
- 5) Both sides filed evidence. Neither side requested a hearing, both being content to provide written submissions instead.

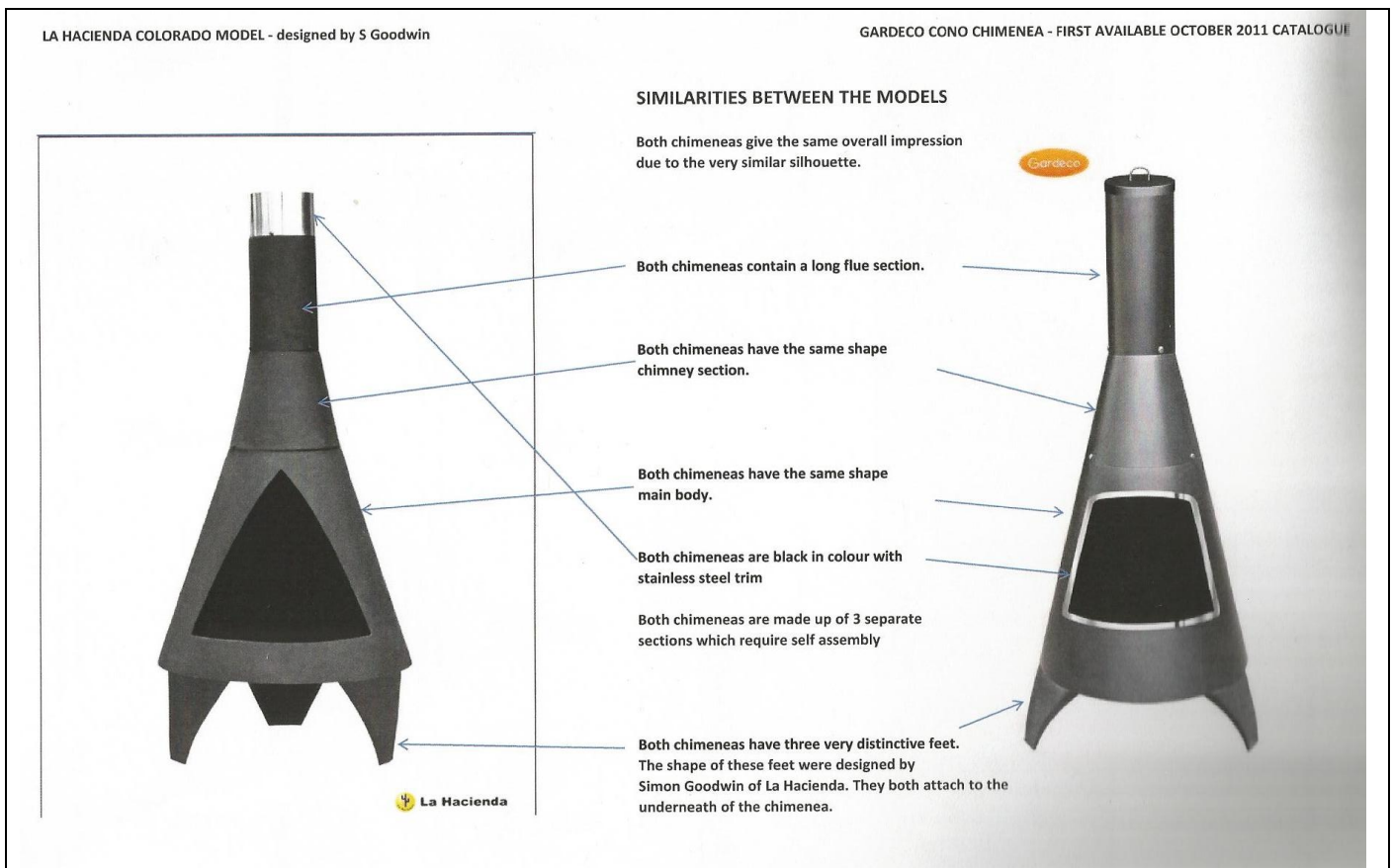
The evidence

Hacienda’s evidence - first witness statement of Ms Kelly Hudson

- 6) Ms Hudson is a solicitor employed by McDaniel & Co, Hacienda’s representatives. Her main points are that:
- The designs have an almost identical outline, with a long flue section, the same shape chimney (middle) section, and the same main body shape.
 - Both designs are chimeneas, with four sections which make up the overall shape (feet, main body, chimney and flue).
 - That the feet in the prior art are highly distinctive (being triangular) which has been replicated in the registered design – it is stated that the shape of the feet is not dictated by function.
 - That the overall shape and configuration is the same.
 - That the difference in mouth opening is an immaterial difference. Further, that the mouth on the registered design is not a rectangle (as claimed by Gardeco) but is trapezoid and, thus, more akin to a triangle as per the mouth of the prior art.
 - That the other differences highlighted by Gardeco are also immaterial – reference is made to the decision of the General Court (“GC”) in *Kwang Yang Motor Co Ltd v OHIM* (Cases T-10/08 and T-11/08) which Ms Hudson says supports the proposition that the informed user is guided by basic structures and not the differences in the detail.
 - That the design of the prior art is not dictated by function so there is no limitation on design freedom (unlike other cases where this factor has

been more relevant – e.g. in my own decision in case BL-O-023-09 relating to the shape of a golf tee).

- That there are a wide range of chimeneas available which demonstrates the high level of design freedom in play. Some (but not all) of these are depicted in the annex to this decision.
- Ms Hudson provides an illustration of the designs side by side, with her main points annotated:



Gardeco's evidence - witness statement of Ben Lincoln

7) Mr Lincoln works for Barker Brettell, Gardeco's representatives. His main points are that:

- Due to their technical function, chimeneas will always have feet, a wide base section in which the fire can burn, a flue section and a tapering section to direct the smoke from the base to the flue, all of which the informed user will be aware of.
- The informed user knows of the various designs which exist in the field and the features they normally contain, resulting in the average consumer showing a relatively high degree of attention.

- That the informed user will appreciate the differences between the designs, particularly: the different mouth shape (said to be rectangular in the registered design) and its contrasting border strip, that the flue section is plain and uniform rather than having a chromed top section, that the feet of the registered design form a sleek continuation of the base section.
- That the difference in the mouth is not immaterial. Mr Lincoln states that the mouth is one of the main focal points of a chimenea and whether it is rectangular or trapezoid, the registered design's mouth has four sides in contrast to the triangular prior art which he describes as arch-like/gothic.
- There is a broader gap between the bottom of the mouth and the base of the chimenea in the registered design compared to the prior art.
- That the mouth of the registered design has an outline border which is not shared by the prior art.
- That feet are a key technical functional aspect of a chimenea and that being positioned around the edge of the base section is a common feature (Mr Lincoln refers to Ms Hudson's evidence of the design corpus). He argues that the design freedom is limited in this respect. In terms of the actual feet in question, Mr Lincoln states that in the registered design they are continuous (from the base section) creating an unbroken extension of the base, so creating a sleek finish. He contrasts this to the prior art which has a clear break from the base and where the feet are set more inwardly and are more squat.

Hacienda's reply evidence - second witness statement of Ms Kelly Hudson

8) This is essentially a critique of Mr Lincoln's witness statement. Much of what Ms Hudson says refers back to her original arguments, so I need not repeat the information here. She does add that the design of chimeneas is not dictated by technical function – whilst chimeneas have some common features there is nothing in the function of the article which dictates its shape. She highlights, for example, that it is not necessary for a flue to be present, so long as there is a hole for the smoke to escape (an example of a flue-less chimenea is shown in Exhibit KH1 – it is replicated in the annex to this decision).

9) Ms Hudson also states that the contrasting border around the mouth is intended to mirror the chrome on the flue section of the prior art in an attempt to copy it. It is added that the chrome flue section of the prior art is not as large as Mr Lincoln alleges. In relation to the feet, she states that their shape is not dictated by function and that there is no evidence of a wealth of chimeneas with similar shaped feet; she argues, in fact, that the number, size, shape and placement are the same in both designs.

The legal background

10) Section 1B of the Act reads:

- “(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.
- (3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.
- (4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.
- (5) For the purposes of this section, a design has been made available to the public before the relevant date if-
 - (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
 - (b) the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
 - (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
 - (b) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);
 - (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
 - (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action

taken by the designer or any successor in title of his;
or

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

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

(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 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.”

11) The relevant date in these proceedings is 6 October 2011, as per section 1B(7) of the Act.

12) In terms of the legal principles, guidance on various relevant issues can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”). Some of the key points from this are that:

a) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.

b) In terms of design freedom, this 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). The more restricted a

designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.

c) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.

d) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised similarities means that the machines give the same overall impression. ...”

13) An appeal was made against Mr Justice Arnold’s decision which was dismissed by the Court of Appeal (case [2011] EWCA Civ 1206). Worth mentioning here is some additional commentary provided by Sir Robin Jacob in the Court of Appeal’s judgment, namely that:

“30.....Moreover the list of nine features relied upon by Dyson is far too general. Thus it is no good saying "both have transparent bins through which the cyclone shroud is visible" when the reality is that both the bins and shrouds are very different in shape. You cannot take features of a design, turn them into general words and then treat those words like a patent claim.”

and

“34. I would only add one matter, irrelevant in this case. In *P&G* I drew attention to the difference between Recital 14 and Art. 6 of the Design Regulation (EC 6/2002). The former uses the expression "the design clearly differs" whereas the latter merely says "differs." "Clearly" does not reappear. I thought the difference was deliberate and so had some significance. I was wrong, though that does not affect the main reasoning in *P&G*. The difference in wording is merely the result of sloppy drafting as has been pointed out by Dr Alexander von Mühlendahl in *Design Protection in Europe, 3rd Edn.* (2009 at pp.232-3). The same of course applies to the identical wording in the Directive (Recital 13 and Art. 9).”

14) Matters must be judged from the perspective of an informed user. In case C281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA, OHIM*, it was stated:

“It should be noted, first, that Regulation No 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.”

15) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user of chimeneas and will possess those characteristics (knowledge/experience) set out in the preceding case-law.

The prior art

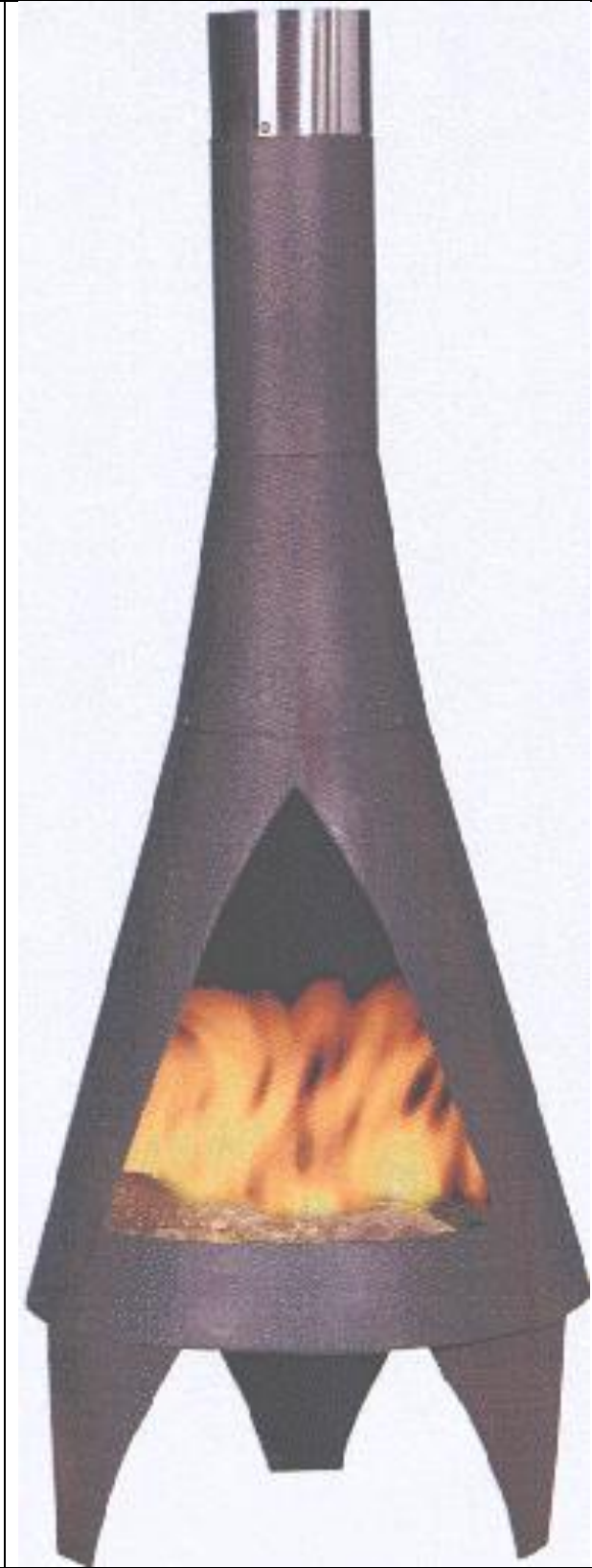
16) Hacienda relies on its own design registration as prior art. Having been registered in 2009, it would have been made available to the public around this time in the relevant design journal. This counts as a public disclosure which predates the relevant date in these proceedings. Furthermore, the design was

also included in brochures issued by Hacienda in 2009 which also counts as a public disclosure. Gardeco have made no challenge on the issue of public disclosure. **The design embodied by UK design registration 4012270 counts as relevant prior art in these proceedings.**

Novelty

17) It is necessary to consider the similarities and differences between the designs, but the matter still boils down to one of overall impression. Chimeneas are quite large articles, therefore, to do the matter justice, I have depicted the designs below, side by side, on as large a scale as I can:

Gardeco's design	Hacienda's design (the prior art)
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18) I have already rehearsed the parties' arguments above. As Ms Hudson says, the outline shape of the respective designs is very similar indeed. However, I must bear in mind that many chimeneas will have a similar structure (and consequently a similar outline) because, as Mr Lincoln states, they have common features borne of function, including having feet (although I will come back to the feet), a wide bottom section in which the fire burns, and a narrower top section(s) to draw the smoke away. The design corpus as evidenced by Ms Hudson demonstrates this although, I accept from the evidence, that it is possible to make chimeneas in a wide variety of shapes. Balancing these factors, I consider the correct approach to be that the very similar (although not identical) outline shapes of the designs will be appreciated and noticed by the informed user and that this will form part of the overall impression he/she appreciates, however, there will be a degree of discount in terms of this factor due to the elements that a chimenea typically incorporate.

19) What is quite significant is the shape of the feet. Whilst it is possible to have a footless chimenea, most will have feet; again, this is borne out by the evidence. Whilst having feet is functional, they can be designed in a great many ways. The way in which the feet in the prior art have been designed does not appear to be common place. There is fairly large degree of design freedom here, yet the shape of the feet in the respective designs is very similar. Whilst they are not identical due to those in Gardeco's design being squatter and, also, given that the feet in Hacienda's designs are set more inwardly, such differences may not leap out when viewed by the informed user. There is, therefore, a strong similarity in terms of the feet which plays a key part in the overall impression of both designs.

20) The next aspect of the designs I turn to consider is the shape of the mouth. Having a mouth is a functional aspect. However, functional requirements do not dictate its shape. That being said, there are some limits on what shape a hole can be. The shape of the mouth in Hacienda's design is clearly triangular. The shape of the mouth in Gardeco's design is, on the other hand, four sided rather than three. I think the informed user will clearly notice this difference. I consider that the informed user will appreciate that the shapes of the respective mouths are more than just a functional opening and that the respective shapes are meant to form part of the design characteristics of the article. I agree with Mr Lincoln that when in use the mouth is one of the focal points of a chimenea. I also agree with Mr Lincoln that the contrasting border around the mouth in Gardeco's design creates a further and noticeable point of difference. There is no functional aspect to this at all. I note Ms Hudson's comment that the contrasting border is, in her view, part of an attempt to copy Hacienda design (which has a contrasting lid) but there is no evidence in these proceedings as to intent, and I do not consider that the informed user will reach this view. The difference in the mouth is, therefore, a highly relevant factor.

21) I finally consider what I will refer to as the lid of the respective chimeneas. This aspect is, again, part functional, but not to the extent that the exact design of the lid is dictated by function. Non-functional design characteristics can be brought to play. In terms of the lids, the one in Hacienda's design is quite striking, being taller and being designed to contrast with the rest of the chimenea. The lid in Gardeco's design is shorter, it has a handle (which I do not play too much regard to), and it does not contrast with the rest of the chimenea; it is a very simple lid. I think the informed user will clearly notice this difference as part of the overall impressions of the designs.

22) I consider the above four aspects of the designs (outline shape, feet, mouth & lid) to be the ones which the informed user will appreciate as contributing to the overall impression of the designs. There may be other more detailed aspects but none which alter this assessment when considered at what I believe to be the correct level of generality. Ms Hudson referred in her evidence to the decision in *Kwang Yang Motor Co Ltd v OHIM* which referred to the informed user being guided by basic structures and not the differences in the detail – whilst this is noted, I do not consider that this judgment sets any legal principle – the court was simply commenting on the designs the subject of that decision and what the informed user would have appreciated in that case (a case involving internal combustion engines). In any event, and as stated above, I consider the level of detail I have identified to be the correct level of generality in the case before me. There are clearly some similarities and some differences. **Despite the similarities, I come to the view that the differences which exist between the designs means that the overall impressions are different. Gardeco's design is novel. The request for invalidation fails.**

Costs

23) Gardeco has been successful and is entitled to a contribution towards its costs. I hereby order La Hacienda Limited to pay Gardeco Limited the sum of £1200. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Filing evidence and considering Hacienda's evidence	£500
Filing submissions	£400

24) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

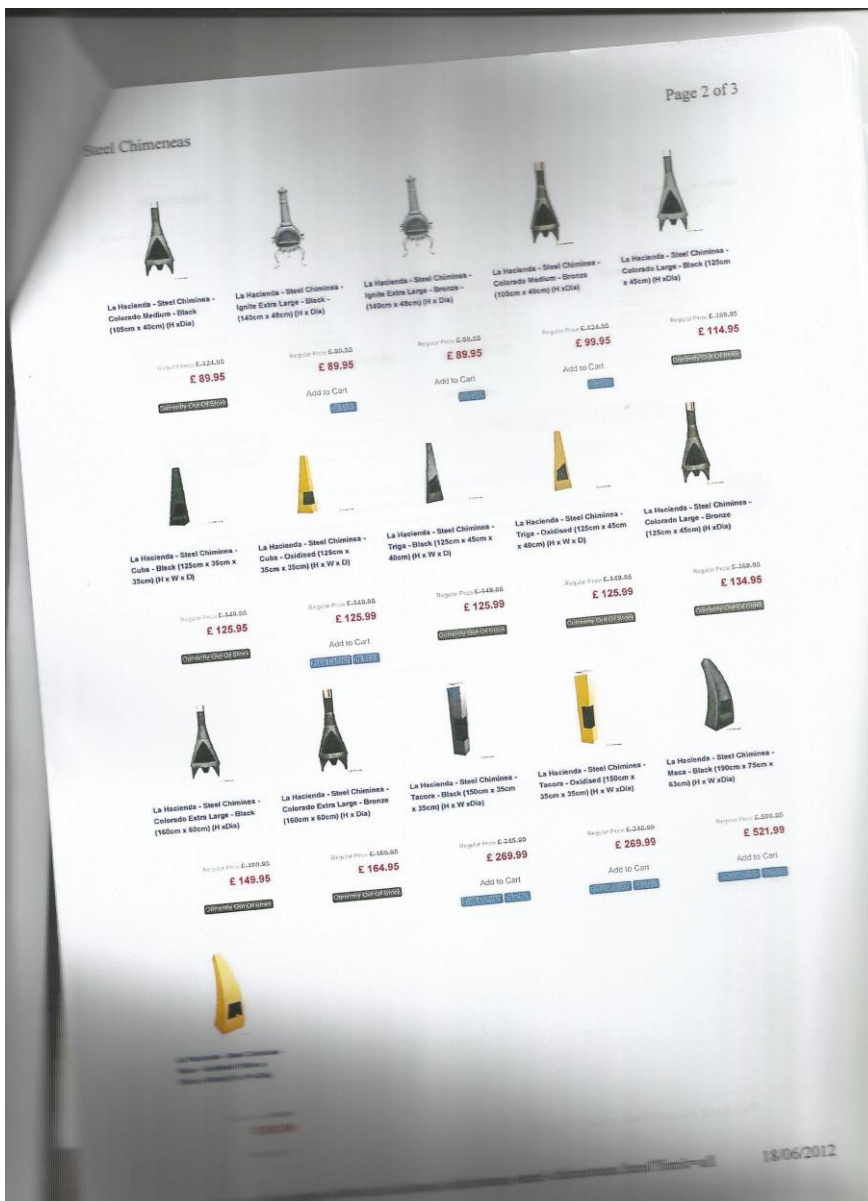
Dated this 20th day of November 2012

**Oliver Morris
For the Registrar, The Comptroller-General**

Annex – other chimeneas



The flue-less chimenea



View as: Grid List Sort by Price

 <p>La Hacienda - Mexican Clay Chimenea - Sun Kissed (65cm x 30cm) (H x Dia)</p> <p>Regular Price £52.99 £ 49.95</p> <p>Add to Cart</p> <p>View Details Reviews</p>	 <p>La Hacienda - Mexican Clay Chimenea - Zamora Small - Old Ivory - (90cm x 36cm) (H x Dia) - FREE Chimenea Cover</p> <p>Regular Price £69.95 £ 59.99</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - Mexican Clay Chimenea - Soft Yellow - BBQ Pit (75cm x 32cm) (H x Dia)</p> <p>Regular Price £69.95 £ 69.95</p> <p>Add to Cart</p> <p>View Details Reviews</p>	 <p>La Hacienda - Mexican Clay Chimenea - Rustic Rust (85cm x 32cm) (H x Dia)</p> <p>Regular Price £69.95 £ 69.95</p> <p>Add to Cart</p> <p>View Details Reviews</p>	 <p>La Hacienda - Mexican Clay Chimenea - Soft Yellow Flowers (75cm x 32cm) (H x Dia)</p> <p>Regular Price £69.99 £ 69.95</p> <p>Add to Cart</p> <p>View Details Reviews</p>
 <p>La Hacienda - Mexican Clay Chimenea - Rio Small - Ochre - (80cm x 36cm) (H x Dia) - FREE Chimenea Cover</p> <p>Regular Price £99.95 £ 79.95</p> <p>Add to Cart</p>	 <p>La Hacienda - Mexican Clay Chimenea - Toluca Small - Brown Earth - (90cm x 36cm) (H x Dia) - FREE Chimenea Cover</p> <p>Regular Price £99.95 £ 79.95</p> <p>Add to Cart</p>	 <p>La Hacienda - Mexican Cone Clay Chimenea - Basket Medium - Moss - (107cm x 45cm) (H x Dia)</p> <p>£ 92.95</p> <p>Add to Cart</p>	 <p>La Hacienda - Mexican Cone Clay Chimenea - Diamonds Medium - Old brown - (107cm x 45cm) (H x Dia)</p> <p>£ 92.95</p> <p>Add to Cart</p>	 <p>La Hacienda - Mexican Cone Clay Chimenea - Circles Medium - Antique - (107cm x 45cm) (H x Dia)</p> <p>£ 109.95</p> <p>Add to Cart</p>

View as: Grid List Show All per page

Sort by Price

 <p>La Hacienda Essential Range - Cast Mesh Chimenea - Black - (90cm x 38cm) (H x Dia)</p> <p>£ 49.95</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - 100% Cast Iron Chimenea - Palma - Black (73cm x 38cm) (H x Dia)</p> <p>Regular Price £69.95 £ 54.95</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - 100% Cast Iron Chimenea - Palma - Bronze (73cm x 38cm) (H x Dia)</p> <p>Regular Price £69.95 £ 54.95</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - 100% Cast Iron Chimenea - Dorado - Black (72cm x 38cm) (H x Dia)</p> <p>Regular Price £64.95 £ 59.95</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - 100% Cast Iron Chimenea - Dorado - Bronze (72cm x 38cm) (H x Dia)</p> <p>Regular Price £64.95 £ 59.95</p> <p>Currently Out Of Stock</p>
 <p>La Hacienda - Cast Iron & Steel Chimenea - Cadiz Small - Black (85cm x 40cm) (H x Dia)</p> <p>£ 74.95</p> <p>Currently Out Of Stock</p>	 <p>La Hacienda - Cast Iron & Steel Chimenea - Cadiz Small - Bronze (85cm x 40cm) (H x Dia)</p> <p>£ 74.95</p> <p>Add to Cart</p>	 <p>La Hacienda - Cast Iron & Steel Chimenea - Havana Medium - Bronze (105cm x 42.5cm) (H x Dia)</p> <p>Regular Price £89.99 £ 79.95</p> <p>Add to Cart</p>	 <p>Gardeco - Cast Iron & Steel Chimenea - Zeta - Bronze (142cm x 46cm) (H x Dia)</p> <p>Regular Price £99.95 £ 84.95</p> <p>Currently Out Of Stock</p>	 <p>Gardeco - Cast Iron & Steel Chimenea - Zeta - Black (142cm x 46cm) (H x Dia)</p> <p>Regular Price £99.95 £ 84.95</p> <p>Currently Out Of Stock</p>