

O-383-13

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN NO. 4025205**

**IN THE NAME OF MORRCK LIMITED**

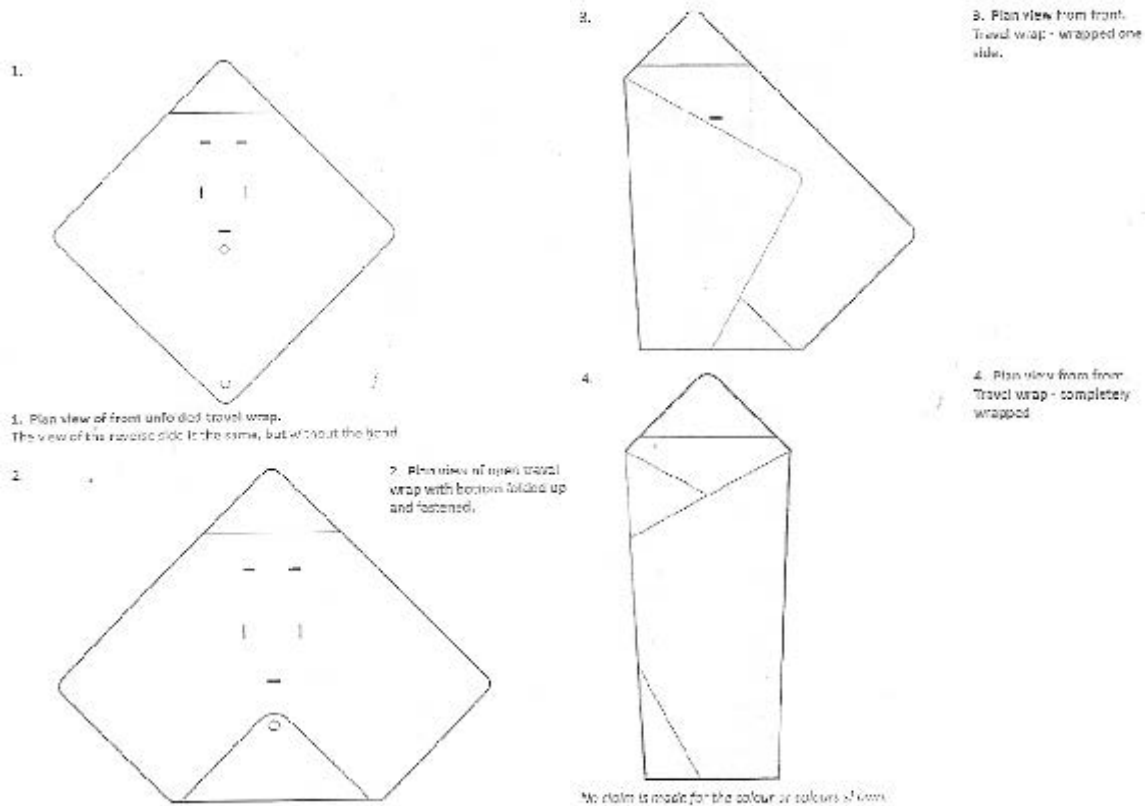
**AND**

**A REQUEST TO INVALIDATE (NO. 23/12)**

**BY TRACEY JAYNE HOLLINS**

## The background and the pleadings

1) The registered design the subject of these proceedings was filed by Morrck Limited (“Morrck”) on 22 June 2012. The design is described as “a baby blanket/Baby Travel wrap” and is depicted below:



Its certificate of registration was granted on 27 July 2012.

2) On 22 August 2012 Ms Tracey Jayne Hollins requested the invalidation of Morrck’s design under section 1B(1)<sup>1</sup> 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. It is stated that:

“Tracey Hollins designed this product in 2011 and the design is based on an old baby bath towel that has been available for 20+ years. I launched this product at Harrogate in March 2012 and it has been available in independent shops since March 2012.”

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

3) On the basis of the above claimed facts, Ms Hollins also claims that Morrck's design is invalid under section 11ZA(2) of the Act because Morrck is not the proprietor of the design, she is. In her statement of case she adds that:

- Tracey Hollins designed the product in 2011 and launched it at the Baby Show for trade in Harrogate in March 2012.
- The product has been available to the public since March 2012.
- The design is based on an old style baby towel, a square one with a hood in the corner.
- Isobel Thompson (later evidence demonstrates that Ms Thompson is connected with Morrck) saw the product and design on sale to the public at the NEC Baby show in May 2012.
- When design 4025205 was filed on 22 June 2012, it was a copy of Ms Hollins' design.

4) Ms Hollins' statement of case is on the headed paper of a trading entity called Coverdry. Also attached to the statement of case are three documents as follows:

- An extract from a publication called *Nursery Industry*. Ms Hollins has added a date of May 2012 to the top of the document. It features a product called SnuggleBlanki from Coverdry. It is described as a swaddle blanket that can be used on the go. It apparently has "5-point harness openings" so the blanket can be used in conjunction with a harness. A picture of the product wrapped around a child is depicted.
- A similar extract from the same publication albeit this time dated (by Ms Hollins) June 2012. It has the same picture.
- A leaflet featuring the SnuggleBlanki product. It appears to be a promotional leaflet used at the "Nec2012" show. Various images show the product in use.
- A copy of what is, effectively, a cease and desist letter dated 10 July 2012 from Morrck (via a firm of solicitors called Novalex) to Coverdry Limited claiming that the SnuggleBlanki product is an infringement of a design right held by Morrck. Ms Hollins has added a hand written note to this letter to the effect that the design right relates to the design embodied by a now expired design registration (no. 3022685).

5) Morrck filed a counterstatement denying the claims. Morrck states that it is not clear from the evidence provided by Ms Hollins what the actual design was due to the fact that the images show the blanket in use (whilst wrapped around a child etc) and, so, it could be any shape. It is stated that Morrck is the true proprietor

having conceived of the design in early 2011. Attached to the counterstatement is a witness statement of Ms Isobel Thompson, a director of Morrck; I note the following statements:

- That Morrck produced a “baby hoodie” product in 2005 which was sold to the public around this time.
- That between January to June 2011, modifications were made to the original design and it explored the potential for an alternative baby hoodie that would be more suitable for a stroller/buggy.
- That this new design was registered under number 4025205 (the design the subject of these proceedings).
- That at the time of conceiving the design, she was not aware of any other product closely resembling the new design, other than Morrck’s previous baby hoodie which has functional similarities.
- That the evidence provided by Ms Hollins with her statement of case does not demonstrate what the actual design of her product was.

6) Both sides then filed further evidence to support their case. Neither side requested a hearing. Ms Hollins filed written submissions in lieu of a hearing, Morrck did not.

### **Ms Hollins’ further evidence**

7) A summary of Ms Hollins’ further evidence is as follows:

- A statement is made that the design has been available for 20 years. An accompanying witness statement is provided which contains a picture of a square baby towel with a hood in the top corner. The statement is provided by “Karen ccc” In this it is stated that “Cardiff cash and carry wholesalers have been selling hooded square towels for 20 years”. The witness statement does not contain a statement of truth. The person giving evidence is not identified. The detail provided is limited. This evidence has little probative value.
- Ms Hollins states that Isobel Thompson saw Ms Hollins’ design on 18 May 2012. She later adds that she saw it at the NEC in May 2012 and that her claim that she did not know of Ms Hollins’ design must be untrue. The evidence to support this comes from the cease and desist letter mentioned earlier. However, the letter merely states that “Our client discovered on 18 May 2012 that your company has been copying our client’s design..”. The client is Morrck not Ms Thompson. However, what is clear is that as of 18 May 2012, Morrck was aware of the SnuggleBlanki product.

- That in the cease and desist letter no mention is made of design 4025205, the allegations of infringement being based on a design right claimed to be owned by Morrck which Ms Hollins has already stated corresponds to a design embodied by a now expired design registration (no. 3022685).
- That her product has been available in shops and online since March 2012.
- That she did not file for design registration herself as it is not a new design and has been available for 20 years; she had one for her son 17 years ago.

8) Ms Hollins provided two physical samples of products. One is of the SnuggleBlanki produced by Coverdry. The other is of a square shape towel with a hood in the top corner containing a *Mothercare* label. Neither of these physical samples was formally introduced as exhibits to Ms Hollins' evidence and no specific reference made to them. I therefore directed Ms Hollins to provide a further short witness statement so as to introduce these samples as exhibits and to give them some context. A short witness statement was duly provided introducing the samples as exhibits, also confirming that the sample is her SnuggleBlanki product (the one she claims has been disclosed) and that the hooded towel is an item that has been on sale to the public for 20 years and that it is the same shape as the SnuggleBlanki which, she states, was disclosed at the trade fair in Harrogate in March 2012. Despite Morrck being given an opportunity to comment on the evidence I directed to be filed, it did not do so. The evidence merely clarifies and formalises matters, it is thus accepted into the proceedings.

### **Morrck's evidence**

9) This comes from Ms Thompson. In relation to the witness statement that accompanied Ms Hollins' statement of case (the one from "Karen") similar criticisms are made in relation to it as I have already made; Ms Thompson states that this proves nothing. She adds, in any event, that the product is a towel not a blanket and it does not have the opening to permit the product to be used for travel. In relation to the SnuggleBlanki, she states that she did not personally see the product prior to filing an application to register the design and did not see it before she began to develop Morrck's design. She does not, however, explain how Morrck became aware of Ms Hollins' product in May 2012 (as detailed in the cease and desist letter).

### **Ms Hollins' evidence in reply**

10) A witness statement is provided from Ms Jane Johnstone, a director of Perfectly Happy People. She states that she has been manufacturing and selling a square hooded baby item for five years. She provides an image which she says

is identical to the product she has sold. It is a square blanket/towel with a hood in the top corner. A product brochure from 2009 is provided which shows a hooded towel/blanket although, it is not possible to see whether it is square or not. On both, the hood has some form of decorative element upon it.

### **The legal background – the novelty ground**

11) 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.”

12) The relevant date in these proceedings is 22 June 2012, as per section 1B(7) of the Act.

13) In terms of the legal principles, guidance on the 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. ...”

14) 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, 3<sup>rd</sup> Edn.* (2009 at pp.232-3). The same of course applies to the identical wording in the Directive (Recital 13 and Art. 9).”

15) 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.”

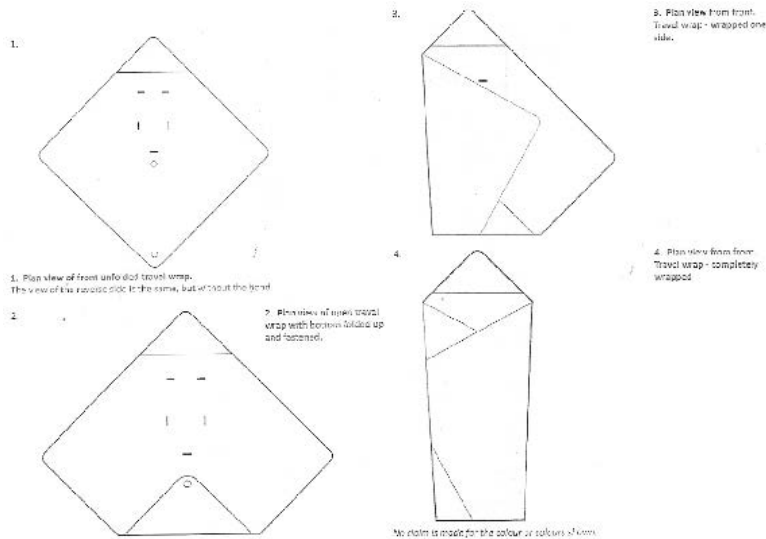
16) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user of baby blankets and will possess those characteristics (knowledge/experience) set out in the preceding case-law.

**The SnuggleBlanki product**

17) The leaflet and other material provided with Ms Hollins’ statement of case do not, as Morrck has highlighted, show the full shape and configuration of the product. This is because it is depicted in use, wrapped around a baby. I agree with Morrck that it would not be possible to make a proper comparison based solely upon this material. However, Ms Hollins has provided a physical sample of the product. The first question is whether the physical sample can be considered as prior art in these proceedings?

18) Ms Hollins has stated that the sample is the same product as was launched in March 2012 at a trade show in Harrogate. She has stated that Ms Thompson may have purchased one at the NEC show in May 2012. Whilst it is not established that she did, this at least supports the proposition that a SnuggleBlanki product was available for sale. Furthermore, as evidenced by the cease and desist letter, someone within Morrck became aware of the SnuggleBlanki so they must have seen a disclosure of some sort. As Morrck point out, the product that was made available to the public before the relevant date could have been different from the sample provided. However, on the basis of the evidence before the tribunal, I consider Ms Hollins’ evidence to be reliable. Although brief, her evidence has been consistent in that the SnuggleBlanki itself was available at the NEC show in May 2012 (and also earlier in March that year). **I come to the view that the SnuggleBlanki, the shape and configuration of which can be seen in the provided sample, was publically disclosed before the relevant date.**

19) I must now compare the registered design with the SnuggleBlanki. The registered design is depicted below:



20) I have taken a photograph of the physical sample, which can be seen below:



21) The registered design has no features of decoration or colour. It is the shape and configuration that must be assessed and compared with the shape and configuration of the prior art. Therefore, the fact that the prior art has a pattern on one side (and on the hood) and a coloured trim is not relevant to the comparison.

22) In terms of similarities, both designs are square shaped, both have a triangular section that becomes a hood for the babies' head, both have a series of openings for a harness to be fed through, both have a popper (or similar fastening device) in the bottom corner which allows the bottom corner to be folded upwards and fastened in place. Most of these similarities are in very similar positions and proportions. In terms of the openings, both designs make use of slit-like openings. Both designs have a lower horizontal slit above which

are two vertical slits. There are then two further slits towards the top of the respective designs (but below the hood); however, in the registered design these are two horizontal slits whereas in the SnuggleBlanki they are parallel vertical slits.

23) In terms of differences, I have already mentioned the different orientation of the upper slits. The only other difference is that the SnuggleBlanki has a trim to the outline of the product.

24) Designs can be considered identical if the differences between them exist in immaterial details. The difference created by the trim is something which I consider an immaterial difference. In terms of the orientation of the upper slits, I come to the view that this is also another immaterial difference. The slits are simply there to perform a particular function and the different orientation is simply a result of the designer achieving this in a slightly different way. In the scheme of things, such a minor difference is immaterial. **The designs are considered to be identical. The application for invalidation succeeds on this basis.**

25) Even if I am wrong to consider the designs identical, I nevertheless consider that the designs do not differ in overall impression. Whilst there may not be a huge amount of design freedom in the shape and configuration of a baby blanket which incorporates a hood, the shape and configuration achieved by the designers is so close that there is no real difference in overall impression. The overall impressions of both are of square blankets, with a triangular hood, which incorporate a series of openings (which, despite the one difference I have identified, are still very similar) with a fastener at the bottom for folding the bottom portion over and securing it in place. **Therefore, if the designs are not identical, the application would nevertheless succeed on the basis of there being no difference in overall impression.**

26) The application for invalidation having succeeded, it is not necessary to consider the other grounds/prior art. **Morrck's registered design is hereby declared invalid.**

### **Costs**

27) Ms Hollins has been successful and is entitled to a contribution towards her costs. I note that Ms Hollins was not legally represented so would not have incurred any legal costs; this is a factor to bear in mind in my assessment. Furthermore, Ms Hollins' submissions were of limited value which is also reflected in the award. I hereby order Morrck Limited to pay Tracey Jayne Hollins the sum of £500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£150
Filing evidence and considering Morrck's evidence	£250
Filing submissions	£50

Official fee for filing invalidation	£50
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28) 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 19th day of September 2013**

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