

O/194/19

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

**REGISTERED DESIGN NO. 6030437  
IN THE NAME OF TAUNTON TRANSPORTERS LIMITED**

**AND**

**APPLICATION NO. 19/18 BY JAMES STEPHEN WHELDON  
TO INVALIDATE THE REGISTERED DESIGN**

## **Background and claims**

1. The registered design the subject of these proceedings was filed by Taunton Transporters Limited (“the proprietor”) on 16 March 2018. The design was subsequently registered with effect from that date. I will detail more of the representations later but the following illustrations give an idea of the design:



2. The application form confirms that the design is for a “T5 T6 TV Adapter Bracket”. When filing the design, the proprietor stated that no claim is made for the colour shown.

3. On 3 July 2018, James Wheldon applied for the registration of the design to be declared invalid. He claims that the contested design lacks novelty and individual character and should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the ground that the contested design did not fulfil the requirements of s. 1B. The prior art upon which Mr Wheldon relies is his own design registration number 6022530, which was filed and registered on 21 November 2017. The design is described on the register as a “Transporter TV Mount” and the register

shows that no claim is made for colour or material, only shape. The earlier design contains multiple representations but, for now, the following is sufficient to show the design:



Mr Wheldon claims that products made to the design were made available to the public in March 2017.

4. The proprietor filed a counterstatement denying the grounds for invalidation. It claims that the designs are different. As regards individual character, it points towards the different dimensions and width of the designs, as well as the hole in the centre of the contested design. It further claims that the hole centres are based on a particular TV bracket, which restricts their dimensions.

5. Neither party is professionally represented. Both parties filed evidence with their statement of case.<sup>1</sup> The proprietor filed further evidence during the evidence rounds. Mr Wheldon did not but he did file written submissions, which I will bear in mind. Neither party requested to be heard or filed submissions in lieu of a hearing.

6. The relevant date for the assessment is the date of application of the contested design, namely 16 March 2018.

### **Evidence**

7. I have read all of the evidence. As not all of it is relevant (for example, certain documents are from after the relevant date), it is summarised only to the extent I consider necessary.

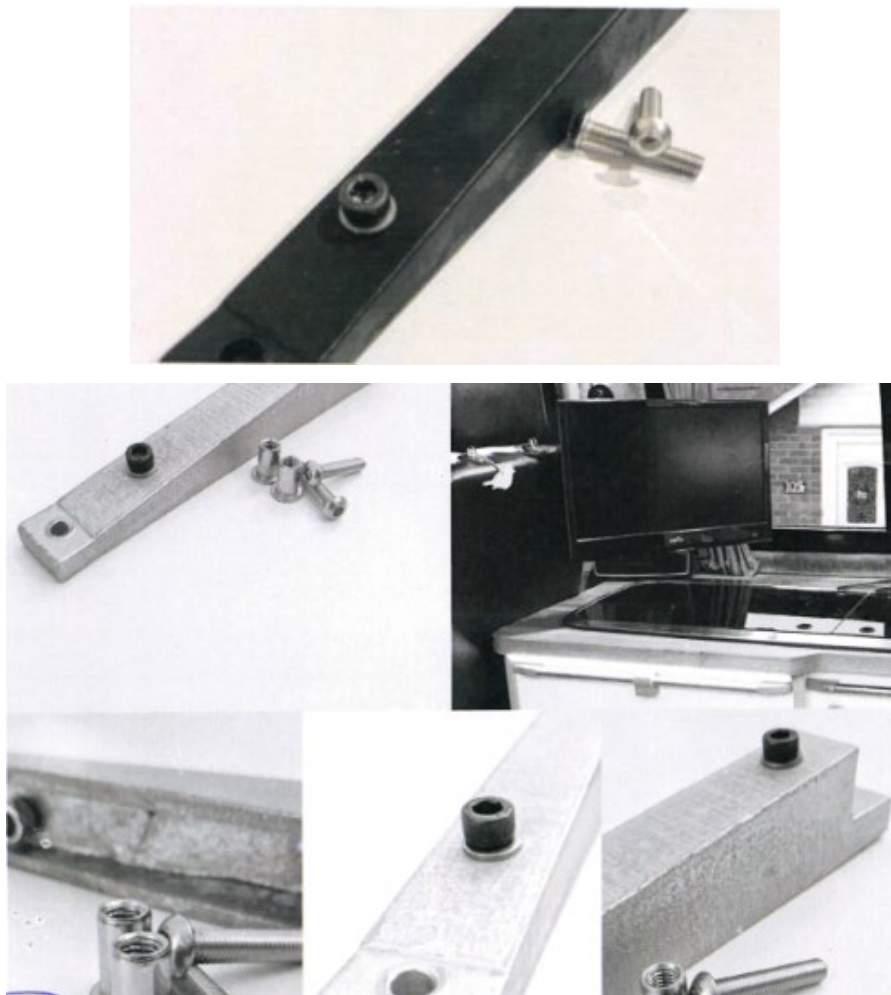
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<sup>1</sup> Rule 21(1)(a) of the Registered Designs Rules 2006 permits evidence to be filed with a statement of case.

Mr Wheldon's evidence

8. It is not entirely clear how all of the documents attached to Mr Wheldon's statement relate to the numbered points in his covering letter. Making the best I can of it, there are screenshots regarding eBay's "VeRO program", dated 4 June (the year is not specified). These are said to be "after 6 removals from Ebay due to infringing their intellectual Property and Verified Ownership Scheme".

9. There are also screenshots, marked attachment 6, said to be Mr Wheldon's public disclosures of the product in 2017, which have a date of 3 and 10 March. Only part of the product is visible. The images are as follows:



10. There are further undated images of both parties' products (marked attachment 4), which show in particular the way in which the proprietor's product attaches a TV to a vehicle:



The proprietor's page includes the following: "Have you ever tried to fix a TV to your van and have your tv [sic] level? [...] Our adapter simply attaches to the side of the van, behind the drivers [sic] seat and allows TV bracket (not included) to be mounted". Further images, which appear to be of Mr Wheldon's Facebook page show his bracket adaptor used to fix a television in the same place.<sup>2</sup>

11. There is also in evidence an exchange of messages between the parties dated 16 March 2018. These are not relevant.

#### The proprietor's evidence

12. The proprietor provides copies of various notices from eBay regarding reinstatement of items on the site, dated July 2018.<sup>3</sup> There are also copies of two messages, apparently from Mr Wheldon.<sup>4</sup> They, too, are after the relevant date.

13. The proprietor has also filed what appears to be a screenshot of Mr Wheldon's product for sale.<sup>5</sup> The proprietor relies on this to show that it is a cast item. However, Mr Wheldon's design registration disclaims both colour and material: the registration is for shape only. Consequently, any comparison based on Mr Wheldon's registered design must only concern the shape of the design, disregarding colour and material. This evidence, therefore, does not assist.

14. That concludes my summary of the evidence, to the extent I consider necessary.

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<sup>2</sup> Statement of case, document 7.

<sup>3</sup> Counterstatement and exhibits E2 to E4.

<sup>4</sup> Counterstatement.

<sup>5</sup> Exhibit E5.

## **Decision**

15. Section 1B of the Act (so far as it is relevant) 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) 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) [...].”

16. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*.<sup>6</sup> The most relevant parts are reproduced below:

*“The informed user*

33. The designs are assessed from the perspective of the informed user. 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-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v*

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<sup>6</sup> [2012] EWHC 1882 (Pat)

*OHIM [2010] ECDR 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; *Shenzen* 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)”

[...]



### *Design freedom*

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“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).”

### *Effect of differences between the registered design and the design corpus* [...]

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a

relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

*The correct approach, overall*

[...]

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

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".

17. I should also take into account the judgment in *Doceram GmbH v CeramTec GmbH*,<sup>7</sup> in which the Court of Justice of the European Union held that:

“Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.

Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an ‘objective observer’”.

18. It is important to determine whether (or to what extent) the relevant features of appearance of a product are dictated by its technical function. Having done so, I must factor that into my assessment of the overall impression created by the designs on an informed user of the products at issue.

19. In determining whether technical function is the only factor which determined the features of a particular design, national courts and tribunals must take account of “all the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence”.<sup>8</sup> Accordingly, although the existence of alternative designs for the product does not preclude a finding that the features of a design are dictated by function (and therefore not protectable), the existence of

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<sup>7</sup> Case C-395/16

<sup>8</sup> *Doceram*, paragraph 37.

alternative designs may shed some light on whether aspects of appearance play some role in the design.

What prior art can be considered?

20. Mr Wheldon's registered design was applied for and registered on 21 November 2017. It was published on the IPO website on or around that date. The proprietor has not denied that the design was publicly disclosed. It may be relied upon as prior art.

21. Mr Wheldon has also included images, marked attachment 4 of the request for invalidation, of what he states are "our public disclosures of the product in 2017". These appear to date from March of that year. The inference is that this is the same product as the registered design. It is clearly not: the registered design has two holes in total, one at each end; the product shown has what appear to be holes fitted with a hexagon screw on the angled face, which are absent from the registered design. However, although this could potentially represent prior art, there is no image of the complete product, which makes comparison with the contested design impossible.

22. There are further images of a product at attachment 7, which appears to be a print of Mr Wheldon's *Facebook* page. It shows a TV bracket adaptor, which looks similar to that shown at attachment 4, insofar as the product shown at attachment 4 is visible. The images are dated 10 March but the year is not given, either on the images themselves or in Mr Wheldon's narrative evidence. Given that Mr Wheldon's only reference to this design is that it is "[e]vidence showing the side profile recognising the exact replica of shape and design", it is not clear either that Mr Wheldon intended to rely on this as a separate piece of prior art or that the images are dated before the application date of the contested design. I do not think that, in those circumstances, it can be considered properly pleaded, or that the design can be reliably considered prior art. However, for the reasons which I will shortly give, I do not think that it would affect my overall finding even if I were to consider the design.

### Informed user

23. The informed user is not a casual user but a knowledgeable or particularly observant user of television bracket adaptors. There is nothing in the parties' evidence or submissions to suggest that the informed user should be construed in a different way (e.g. a more specialised subset of user). The informed user will possess the characteristics of knowledge and experience set out in the above case law.

### Design corpus

24. There is no evidence of any other television bracket adaptors which would show either way whether the designs at issue in these proceedings represent a departure from the norm. This factor is, therefore, neutral.

### Features of the design dictated by function

25. It is common ground that both designs are intended for affixing a television bracket to a VW van interior. The evidence indicates that the purpose of the bracket adaptor is to provide the correct angle for the TV bracket. The angle of the bracket is, therefore, dictated by the function of the product rather than being a design choice, whilst the necessity of the base fitting the side wall of the van also limits design freedom. The presence of holes for screwing the adaptor to the vehicle, or for fitting the bracket to the adaptor are essential to the purpose of the adaptor and do not represent a design choice. Having said that, whilst the spacing of the screw holes for the bracket and for fixing the adaptor to the vehicle are likely to be dictated by the location of the corresponding holes on the vehicle and the bracket, the position of the holes relative to the overall dimensions of the adaptor offers some, albeit limited, freedom to the designer. The decision to raise or recess the holes (or not) is itself a design choice.



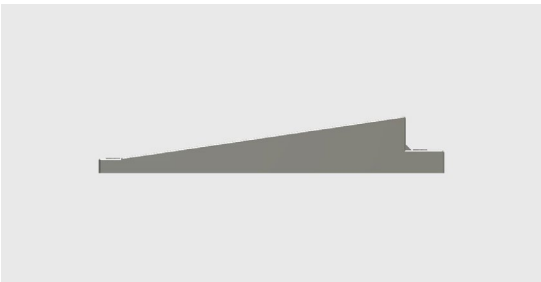

26. The proprietor indicated, in a "to whom it may concern" letter not eventually filed as evidence, that "the side profile was formed to save material alone". Though I see no reason to doubt that statement, as it is not in evidential format I give it only limited weight. It does, however, assist in fortifying my view that features in both designs may be for the purpose of saving weight and may be so perceived by the informed user. In

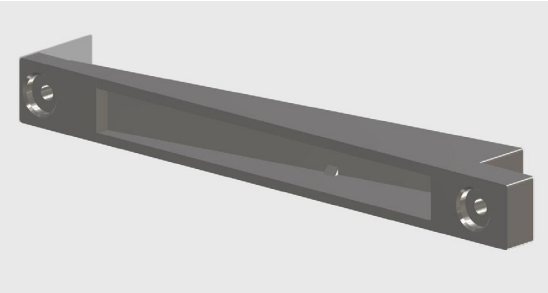
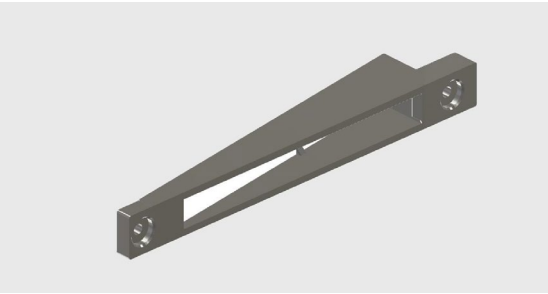
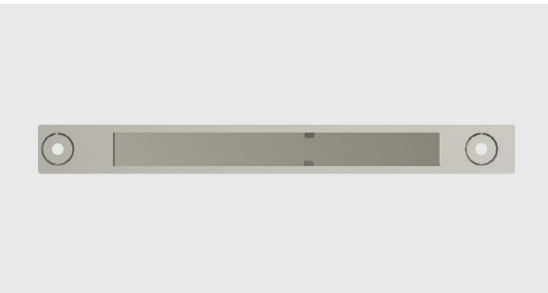
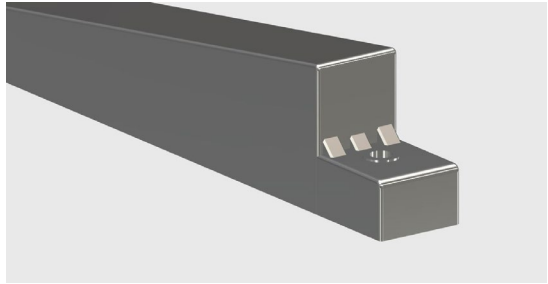
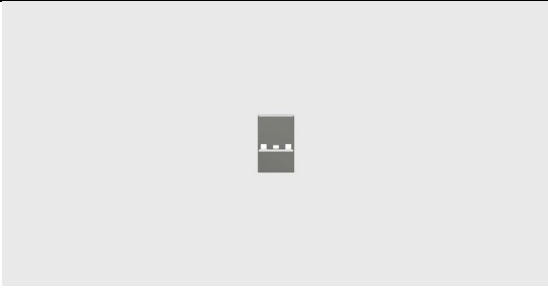
the contested design, that is the hole running through the full width of the adaptor, whilst in the earlier design it is the recess underneath the angled part of the design. As evidenced by the different approaches to the problem in the designs before me, the way in which the weight-/material-saving is effected does offer some scope for design freedom. The same applies to the way in which weak points in the design may be strengthened: the need to strengthen may arise but how it is done can vary.

27. Taking all of the above into account, I find that there is a low degree of design freedom in the shape and configuration of the type of bracket adaptor shown in the contested design.

Comparison of designs

28. The designs to be compared are:

<b>The earlier design</b>	<b>Contested design</b>
	
	





29. Before I compare the designs, I note that the penultimate image of the earlier design shows the bracket adaptor lying on its side with a white part in the centre of the design. The white part would, ordinarily, indicate a void which, in the present case, would mean that the sloping part of the design has sides but no top. That is plainly inconsistent with the other views of the design. The last image also appears to show a flat edge protruding from the narrow end of the adaptor. That is also inconsistent with the remaining images of the design. I therefore proceed on the basis that these illustrations are erroneous. I will only rely on the aspects of these images which are



reproduced in the other illustrations, which I will treat as properly representing the earlier design.

30. In profile, both designs have a wedge shape. A flat part forming the base at one end flares out into a right-angled triangle. At the other end of the design, next to the widest part of the wedge, there is a further flat section which extends the base of the design.

31. There are some differences between the designs. In the earlier design, the flat part at the narrow end of the wedge is noticeably thinner than the flat part at the widest end of the wedge. In the contested design, the flat parts at each end of the wedge are of equal depth. Whilst the presence of a screw hole allowing the adaptor to be fastened to the van will be given no design significance, the earlier design has the hole positioned in the centre of the object, whilst in the contested design the screw hole is offset. The two screw holes in the earlier design have a raised edge on the upper face and are recessed underneath, whilst the holes in the contested design are completely smooth. The earlier design has three small triangular shapes where the widest part of the wedge meets the flat base, the edge of which is visible in profile. It also has two similar components on the underside of the product, roughly two thirds along.

32. Further, the contested design appears to be wider in proportion to its length than the earlier design. The corners of the base plate are, in the earlier design, square, whilst in the contested design they are rounded, though the effect is not particularly pronounced and noticing this borders on minute scrutiny, which goes too far.

33. I have not, so far, mentioned what is the most obvious difference between the designs as shown above, namely the large hole in the middle of the contested design. The recessed under side of the earlier design is also a significant difference. However, whilst these differences, as well as those mentioned above which are on the underside of the earlier design, will be visible at the point of purchase, they will not be visible when the products are fitted to the vehicle. As the removal and reattachment of the bracket adaptor does not strike me as something which will be done with any frequency, if at all, once the adaptor has been fitted, these elements will not be visible

during normal use of the products.<sup>9</sup> They are, therefore, of limited weight in the comparison.

34. The designs are plainly not identical. Nor do I consider that the differences are immaterial. They are sufficiently important that they will be noticed by the informed user. Turning to individual character, the design choices made in the positioning of the holes for fixing to the vehicle, the wider proportions relative to its length of the contested design, the differing depths of the flat portions of the base part and the smooth as opposed to raised screw holes, when considered alongside the limited degree of design freedom available, are sufficient to create a different overall impression from that of the earlier design.

### **Final remarks**

35. I have conducted the comparison on the basis of the earlier registered design only. Even if that was not right, the outcome would not have been different. A different finish in the other prior art would make the designs less similar. The only other difference between the registered design and the other prior art which I have been able to identify is the presence of two holes and screws for fitting the bracket to the adaptor. As I indicated above, these are features which the informed user is likely to consider dictated by function and would have little or no impact on his/her perception of the design as a whole.

### **Conclusion**

36. The application for invalidity has failed. The design will remain registered.

### **Costs**

37. The proprietor has been successful and would ordinarily be entitled to an award of costs. However, the tribunal wrote to the parties on 10 December 2018 indicating that,

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<sup>9</sup> See *Group Nivelles v OHIM*, Case T-15/13

as unrepresented litigants, the parties would be required to complete a costs pro-forma if an award of costs was sought. The letter stated that if the pro forma was not completed and returned, “no costs, other than official fees arising from the action [...] will be awarded”. Neither party has filed a costs pro-forma. The proprietor did not incur any official fees in the prosecution of the action. That being the case, I direct that the parties bear their own costs.

**Dated this 10<sup>th</sup> day of April 2019**

**Heather Harrison  
For the Registrar  
The Comptroller-General**