

O/113/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6038520

OWNED BY TORAB MEHDIZADEH GHEZELGHEI

AND

**APPLICATION NO. 23/18 BY SNAIL SAKK (A DBA OF NORTH POLE
CREATIONS LLC)**

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The registered design which is the subject of the dispute was filed by Torab Mehdizadeh Ghezalghai (“the registered proprietor”) on 29 June 2018. The registered design is for a “post and letter catcher” and is depicted in the following representations:



2. The registered design is accompanied by the disclaimer “No claim is made for the colour shown. No claim is made for the material shown”.

3. On 18 September 2018, Snail Sakk (a DBA of North Pole Creations, LLC) (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that:

a) “The design was not new because an identical design whose features differ only in immaterial details had been made available to the public before the relevant date.”

b) “The Applicant’s design, which was first offered for sale in the UK no later than 2013, is identical to the Registrant’s design; differing only in immaterial details. The designs have the same overall dimensions and shape, same texture and type of fabric, same colour, embroidery at the top center, and even the same Velcro style strips across the top reverse side which the Registrant has claimed as part of its design. As to the differences in the words used – ‘POST’ is simply another 4 letter synonym of ‘MAIL’. Therefore, it is submitted that this minor difference is less striking than the overall impression created by the common features in the respective designs.”

c) That the registered proprietor has been selling goods in the form of the registered design since 2004.

4. The applicant filed a variety of documents with its application for invalidity, all intended to show that the registered design had been made available to the public prior to the relevant date. I will return to this evidence below.

5. The applicant claims that the registered design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a) [...]

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

6. The applicant claims that the registered design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

7. The registered proprietor filed a counterstatement denying the grounds of invalidation.

8. The applicant filed evidence in chief in the form of the first witness statement of Camie Amber Crawford dated 28 February 2019 and the witness statement of Amandeep Rana dated 22 March 2019. The proprietor filed a witness statement dated 29 April 2019. The applicant filed evidence in reply in the form of the second witness statement of Ms Crawford dated 9 September 2019. A hearing took place before me on 7 January 2020, by video conference. The proprietor was self-represented and was assisted by Ms Sharon Davies. The applicant was represented by Mr Aaron Wood, of Keystone Law.

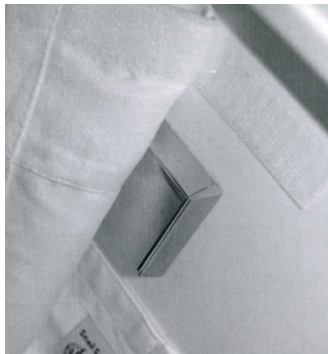
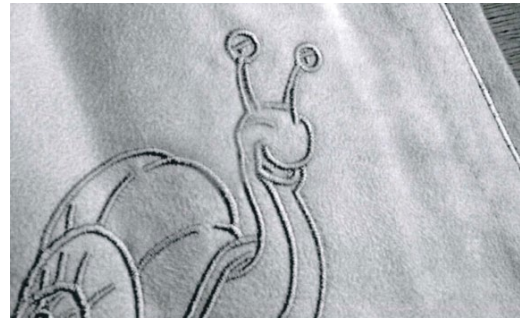
EVIDENCE

Applicant's Evidence in Chief

9. As noted above, the applicant filed a variety of documents which accompanied its application for invalidity. In particular, I note as follows:

a) An article from the website www.insideid.co.uk dated 26 April 2014 shows a picture of the packaged version of the applicant's product. The embroidered word MAIL is visible at the top. The article states that the brand's snail logo is stitched onto the product and is described as being available in cream, chocolate and tan.¹ The article displays the following images of the applicant's design:

¹ Annex 2



b) Reviews for the cream version of the applicant's product on Amazon date back to 22 August 2013.²

10. The first witness statement of Ms Crawford was accompanied by 9 exhibits. Ms Crawford is the owner of North Pole Creations LLC. I have read Ms Crawford's evidence in its entirety and, in particular, I note as follows:

a) A screenshot from Facebook dated 12 April 2014 shows the applicant's mail catcher available for sale.³

b) An Amazon dispatch email confirms that the applicant's mail catcher was purchased by UK-based customers as early as 16 June 2013.⁴

² Annex 6

³ Exhibit CAC3

⁴ Exhibit CAC5

c) Although the contested design displays the word “POST” (in contrast to the applicant’s design which displays the word “MAIL”), the proprietor did, for a time, use the word “MAIL” on its products as evidenced by a screenshot of an eBay page, which is undated.⁵

11. The witness statement of Ms Rana was accompanied by 6 exhibits. Ms Rana was, at the time of filing, the applicant’s representative in these proceedings. I have read Ms Rana’s evidence in its entirety and, in particular, I note that screen shots from the applicant’s Youtube page dated 21 September 2010 display its design as follows:⁶



12. I note that much of Ms Rana’s evidence focuses on the similarities between the packaging (and the branding used on that packaging) of the proprietor and the

⁵ Exhibit CAC8

⁶ Exhibit AR1

applicant. However, as this packaging does not form part of the contested design, it is not relevant to the decision I must make.

Proprietor's Evidence

13. The proprietor's statement was accompanied by 8 exhibits. I have read the proprietor's evidence in its entirety and, in particular, I note as follows:

a) The proprietor states that he created his "pet inspired products" in 2004 but that they were initially created for the proprietor's own household use only.⁷

b) It was not until 2017 that he started to sell his creations.⁸

14. I also note that the proprietor has provided samples of both the contested design and the applicant's product, which I have reviewed.

Applicant's Evidence in Reply

15. The second witness statement of Ms Crawford was accompanied by 23 exhibits. I have read Ms Crawford's statement in its entirety and, in particular, I note as follows:

a) Ms Crawford makes reference to the fact that both the contested design, and her own, use Velcro strips to attach to the doorframe.⁹

b) Undated Google search results show a variety of types of product aimed at catching mail posted through a letter box, including:¹⁰

⁷ Witness statement of Mr Mehdizadeh, para. 2

⁸ Witness statement of Mr Mehdizadeh, para. 2

⁹ Second witness statement of Ms Crawford, para. 11

¹⁰ Exhibit CAC16



c) Ms Crawford states that cage-style mail catchers dominate the market.¹¹

d) Various examples of fabric mail catchers have been provided by Ms Crawford. Many of the images are undated, although one is dated 2013. These include:¹²



e) A print out from the proprietor's website (which is undated) states "Our Post Catchers were first designed by myself back in 2004". However, it goes on to state "We originally designed The post catcher to protect the mail from our dog. As a professional Tailor, I designed my own style material catcher. We recently have decided to bring our product to the market."¹³

¹¹ Second witness statement of Ms Crawford, para. 12

¹² Exhibit CAC27

¹³ Exhibit CAC31

PRELIMINARY ISSUES

16. I understand that the images originally filed with the proprietor's application to register his design were unsuitable due to their size. The Registry wrote out to the proprietor to request that these be re-filed in a different format. The proprietor subsequently filed the images of his design that are now displayed on the Register. At the hearing, the proprietor made submissions regarding the fact that these subsequent images do not show the full extent of his design in the same way that his original photographs did. He stated that there are aspects of his design that were visible from the original photographs that are not now visible on the Register. Whilst I sympathise with the proprietor, the obligation was on him to ensure that the images supplied to the Registry accurately represented the design that he was trying to protect. It is the overall impression of the design as registered that I am required to take into account for the purposes of my assessment. Any details that are not visible from the representations of the design protected, are not relevant to my decision.

17. At the hearing, the proprietor sought to introduce a number of examples of his products as evidence, in an attempt to illustrate these differences. The proprietor also sought to introduce new documents (such as a letter from a patent examiner and correspondence with ecommerce sites). I declined to accept these documents as evidence. This was because they are not relevant to the issue before me and no attempt was made by the proprietor to file these documents until the day of the hearing. No explanation was given as to why this evidence could not have been filed during the evidence rounds.

18. Throughout the proceedings the parties have referred to various matters in their evidence which does not form part of the contested design and are not, therefore, relevant to the decision I must make. Specifically:

- a) The fact that the proprietor's product may be used as a carrier for mail;
- b) The fire-retardant properties of the products;

- c) The material with which the respective designs are made;
- d) The colour of the products;
- e) The panel structure of the designs; and
- f) The content of the product descriptions used on online selling platforms by the parties.

19. At the hearing, the proprietor made specific reference to the fact that both fabric and colour is disclaimed in the contested design. The proprietor was of the view that this created a difference between the contested design and the prior art because the proprietor's product could be produced in any colour or material. That is a misunderstanding on the part of the proprietor. For the sake of clarity, the disclaimer simply identifies which aspect of the representations shown are not covered by the protection of the registered design. That means, for these purposes, that any differences or similarities created by the colour or fabric used in the contested design and the prior art are not relevant to my assessment.

20. Both in evidence and at the hearing, the proprietor drew my attention to documents that showed similar designs that pre-date the applicant's design. However, the novelty of the applicant's design is not relevant to the issue before me. The issue in this case is whether the proprietor's design is new and has individual character. The prior art relied upon by the applicant to demonstrate that the proprietor's design is not new and does not have individual character may be designs owned by third parties, not just their own.

DECISION

21. Section 1B reads 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 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.

...”

22. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EQHC 1882 (Pat):

“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 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; *Shenzhen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned *PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse the 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 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."

The Relevant Date

23. The relevant date is the application date for the registered design i.e. 29 June 2018.

The Informed User

24. The design is of a fabric mail catcher. The informed user is, therefore, a home owner or occupier who would use a mail catcher. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus and Design Freedom

25. The applicant filed evidence to show a variety of mail catchers which are available on the market. These include metal cages and fabric mail catchers that attach to the interior of the door. Much of the applicant's evidence which shows fabric mail catchers

is undated. However, one of the images is dated 2013 and shows a fabric mail catcher which differs in shape and ornamentation to the registered design.

26. It is clear to me that there were different fabric mail catchers available at the relevant date, although they must all share a degree of overlap in terms of their basic shape in order to achieve their function. There were also clearly a range of other types of mail catcher available, in the form of metal cages.

27. There will clearly be constraints upon the design freedom of a fabric mail catcher which attaches to the interior of a door, to ensure that it achieves its function. The mail catcher will need to operate as a bag in order to achieve this requirement. However, even the bag element of the design carries a degree of design freedom as it could vary in shape. Further, the surface decoration and mechanism used to secure the bag in place could differ.

The Comparison



28. As noted above, a design will be considered new if “no identical design whose features differ only in immaterial details has been made available to the public before the relevant date” and it will be considered to have 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”. For the application to succeed, the registered design must not be new and/or must not have individual character, when compared with the prior art.

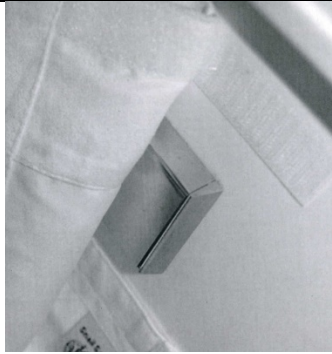
29. In order to be considered prior art, the designs depicted in the evidence will need to have been disclosed prior to the relevant date and must not be excluded disclosures under section 1B(6).

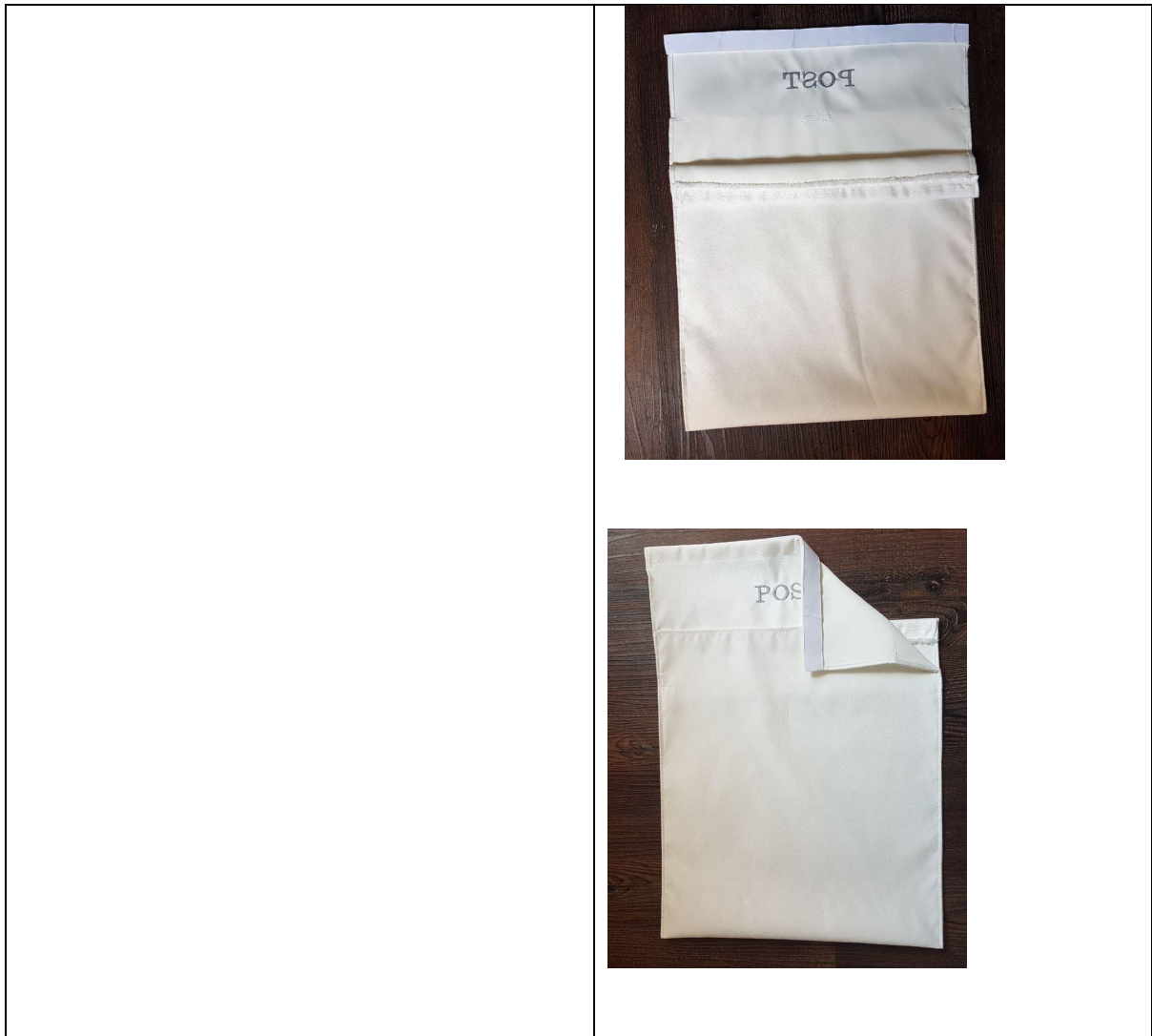
30. The images of the applicant’s product date back to 2010 and 2014. At the hearing, the proprietor made reference to the fact that the applicant was originally selling its product in the US and that the owner of the applicant company is not a UK citizen. This line of argument is misguided. It is true that section 1B(6) of the Registered

Design Act 1949 provides that a disclosure will not amount to a design being made available to the public if it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the sector concerned in the European Economic Area (“EEA”). However, this does not mean that disclosures made outside of the EEA will automatically not amount to the design being made available to the public. For this exemption to apply, the disclosure must also be sufficiently obscure that it could not have become known to individuals in the sector within the EEA. There is nothing in the evidence to indicate that the applicant’s business in the US was sufficiently obscure so as to fall within that exemption. In any event, the invalidation applicant subsequently (and prior to the relevant date) started selling products in the UK. These were available on a popular ecommerce website and were covered in the press. I do not consider that these were excluded disclosures. Consequently, the applicant’s product can be considered prior art.

31. The designs to be compared are, therefore, as follows:

The earlier design	Contested Design
	





32. At the hearing, Mr Wood made reference to the fact that the proprietor had used his registered design to facilitate a ‘take down’ of the applicant’s products on ecommerce websites. Mr Wood states that validity and infringement are two sides of the same coin and this is, therefore, evidence that the contested design is invalid. However, there is no suggestion that there has been a finding of infringement by a Court. The only action that has been taken in this regard is by way of complaint to an ecommerce site which has resulted in the invalidation applicant’s products being removed from its website. Further, I have no evidence as to what product was relied upon by the proprietor in order to facilitate that ‘take down’. It is not, therefore, clear to me that the proprietor was relying upon the same version of the design as the one in issue in these proceedings. Consequently, I do not consider that this line of argument assists the invalidation applicant.

33. As noted above, the proprietor has made reference to a number of 'differences' between the designs. I will address each of these in turn:

a) The proprietor states that when the designs are in use, users will identify that the contested design has a front opening to enable them to access mail without reaching around to the back of the product. The proprietor notes that the applicant's design does not have this feature. However, there is no front opening visible on the design as registered and, consequently, I cannot take this into account in my assessment.

b) The proprietor states that his design consists of three panels, whereas the applicant's design only consists of two. The proprietor states that when in use on a door, only one panel will be visible in the applicant's design, whereas two would be visible in the contested design. Again, this is not relevant to the decision I must make as it is not visible from the registered design.

c) The proprietor makes reference to the fact that the applicant's design has side openings to enable the user to reach their mail from the side of the product, without removing it from the door. The proprietor states that the contested design does not have this feature. Whilst I recognise that there is a photograph of the prior art displaying this feature, it is not clear to me from the registered design whether this feature is shared or not. In any event, there are examples of the prior art in use where this feature would not be visible to the user.

d) The proprietor has made reference to the fact that the applicant's design is substantially larger than his contested design. He states that the applicant's design is approximately 16x21inches, whereas the contested design is 12x18inches. Again, this is not clear to me from the contested design. In any event, the relative dimensions mean that both products are rectangular in shape.

e) The proprietor notes that the applicant's design displays a 'snail logo' which is absent from the contested design. I agree with the proprietor that this is a point of difference between the designs.

f) The proprietor notes that the applicant's design has the word MAIL embroidered at the top, whereas the contested design has the word POST embroidered at the top. I agree that this is a point of difference between the designs.

34. Submissions were also made at the hearing regarding the similarity of the packaging used for each product when sold. That is not relevant to the decision I must make as it does not form part of the registered design. Mr Wood made reference to this in the context of an intention to copy on the part of the proprietor. I return to this point below.

35. To summarise, I consider that the designs share the following attributes:

- a) They are both rectangular in shape;
- b) They both consist of one smaller rectangle attached to a larger one to create a 'pouch' effect in which post can be caught;
- c) They both attach to the user's door using two self-adhesive strips;
- d) Both the contested design and the prior art have four letter words stitched at the top centre of the product; and
- e) The stitching creates the impression of a strip across the top of the products.

36. They differ in the following ways:

- a) The contested design displays the word POST, whereas the applicant's design displays the word MAIL; and
- b) The applicant's design displays a 'snail logo' which is absent from the contested design.

37. I recognise that the strips used to attach the product to the door are dictated by the function of the product. It is necessary to ensure that the product is secured in the correct place to enable it to catch mail that is posted through the door. However, there was, in my view, a design choice as to how the product was affixed to the door. For example, it could have been attached by cord or self-adhesive pin. The choice of adhesive must have been, in part, driven by the appearance of the product. The decision of the registered proprietor to use the same type of adhesive mechanism as the prior art, whilst driven by functional considerations, also represents a design choice which is partly about appearance.

38. The shape of the product is also, in part, dictated by function. However, it is clear, in my view, that any number of shapes could have been used and the same function achieved. The decision to use a rectangular shape in the contested design was, again, a design choice.

39. The stitching of the words POST and MAIL, whilst being linked with the nature of the product itself, are both design choices. They have both been stitched in exactly the same location, in very similar (if not the same) fonts. Very similar words have been chosen, with them both being synonyms for each other. Similarly, the stitching of both designs creates a similar impression in terms of a strip being created across the top of the product in which the word POST or MAIL lies.

40. I recognise that in some of the examples of the prior art there appears to be a label or snail design stitched into it, which creates a point of difference between the designs. However, this will clearly be viewed as indicating trade origin.

41. I accept that the designs are not identical. The different wordings and the presence of the trade name/trade mark are sufficient to prevent this from being the case. However, taking all of the above factors into account, I am satisfied that they differ in only immaterial differences and that they will not create different overall impressions on the average consumer. In my view, the registered design does not, therefore, have individual character.

Use of the proprietor's own design

42. For the sake of completeness, I now turn to the applicant's second line of argument regarding the validity of the contested design. The applicant referred to the extract from the proprietor's website at Exhibit CAC31 which states: "Our post catchers were first designed by myself back in 2004". The relevance of this statement is that section 1B(6)(c) of the Registered Design Act 1949 provides an exemption for disclosures of a design prior to registration, provided it was made during the 12-month period preceding the relevant date. It is the invalidation applicant's case that the proprietor invalidated his own design by disclosing it as early as 2004, which is well before the 12-month grace period provided for by section 1B(6)(c).

43. The proprietor's evidence in this regard is that he had originally designed his product for use in his own home only. He states that it was not until 2017 that he decided to bring his product to the market.

44. In any event, without an accompanying photograph, it is not clear to me exactly what design is being referred to in the document shown at Exhibit CAC31. Further, the website goes on to state: "We originally designed the post catcher to protect the mail from out dog. [...] We recently have decided to bring out product to the market." As the website print out is undated, it is not clear what is meant by "recently". However, this does seem to corroborate the explanation given by the proprietor. This would not, therefore, mean that the design was available to the public. Depending on the date of this website print out, the decision to bring the product to market may have been made during the 12-month grace period. Without further detail on this point, I cannot possibly conclude that the proprietor has invalidated his own design by disclosing it prior to the 12-month grace period.

Intention to copy

45. The intention of the parties is not relevant to an assessment of novelty and individual character of the contested design. Consequently, I do not consider Mr Wood's submissions in this regard to be relevant to the issue before me. In any event, I do not consider the evidence filed by the applicant to support this contention to be

compelling enough to lead me to conclude that the proprietor had intentionally sought to copy the cancellation applicant's design.

CONCLUSION

46. The application for invalidity succeeds.

COSTS

47. As the applicant has been successful they are entitled to a contribution towards their costs. At the hearing, Mr Wood indicated that if a costs award was to be made in his client's favour then an opportunity to file further submissions would be required, as there were matters of relevance to this issue that could not be discussed prior to a substantive decision being issued (presumably, because they relate to matters that are without prejudice save as to costs). I, therefore, direct as follows:

- a. The applicant file written submissions relating to the issue of costs within 14 days of the date of this decision.
- b. The proprietor file written submissions strictly in reply within 14 days of receipt of the applicant's written submissions.

48. For the avoidance of doubt, any submissions filed which go beyond the issue of costs will be disregarded.

49. A supplementary costs decision will then be issued.

Dated this 24th day of February 2020

S WILSON

For the Registrar