

O/558/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6049429
IN THE NAME OF SUSAN TAYLOR SIMMS
IN RESPECT OF THE FOLLOWING DESIGN**



AND

**AN APPLICATION FOR INVALIDATION (NO 6/19)
BY WENDY JAYNE TANYA MEESE**

Background and pleadings

1. Susan Taylor Simms filed application no. 6049429 to register a design for a bandanna bib scarf or special needs bib in Class 02, Sub class 05 of the Locarno Classification (Neckties, scarves, neckerchiefs and handkerchiefs) on 5 December 2018. It was registered with effect from that date and is depicted in the following representations:



2. On 3 January 2019, Wendy Meese applied for the registered design to be invalidated under section 1B, under the provisions of section 11ZA(1)(b), of the Registered Designs Act 1949 ("the Act") on the grounds that the design is not new, nor does it have individual character, compared to Registered Design No. 4003718 for a "bandana styled" bib that she applied for on, and was registered with effect from, 24 July 2007. This design is shown in paragraph 15 below.

3. Ms Simms filed a counterstatement to the application for invalidation on 26 April 2019, denying Ms Meese's claims and describing the contested design as "unique in shape [and] individual character". She states that her design comprises two differently shaped pieces, resulting in permanent ruching.

4. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties have represented themselves.

Legislation

5. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid –

...

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

12. Section 1B of the Act is as follows:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into account.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if –

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if –

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

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

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

...”

6. The relevant date is the date of application for registration of the contested design: 5 December 2018.

Evidence

7. Both parties filed evidence with their application and counterstatement respectively. Ms Simms filed further evidence on 12 March 2020.

8. Ms Meese’s evidence consists of screenshots from eBay and correspondence with eBay’s Verified Rights Owners (VeRO) program, which give an account of her attempts to have Ms Simms’s products taken down from the platform on the grounds that they infringed her registered design no. 4003718 by copying it. She also states that Ms Simms made the contested design available via eBay in November 2018, before the application for registration was made.

9. In her counterstatement, Ms Simms disputes several of the details in Ms Meese’s evidence and provides her own account of the events surrounding the development of the design and subsequent interactions with Ms Meese on eBay.

10. Ms Simms’ further evidence comes in the form of a witness statement dated 12 March 2020 in which she states that she is the sole designer and creator of the registered design which she first sold on eBay on 3 January 2019, although she says that she sold a simpler design during the period 2017-2019, and that this was the design that Ms Meese succeeded in having removed from eBay.

11. Attached to the witness statement are documents relating to the registration of the contested design (an invoice and letter on registration), eBay listings, a sample of what

Ms Simms describes as the original, simpler design, pattern pieces that Ms Simms states are the front and back parts of the registered design, and the finished product.¹

12. There is considerable dispute as to the facts surrounding the creation of the respective designs and the parties' listings on eBay. However, I recall the comments of Jacob LJ in *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited*, [2007] EWCA Civ 936:

"The most important things in a case about registered designs are:

- (i) The registered design;
- (ii) The accused object;
- (iii) The prior art.

And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has 'individual character' or what the 'overall impression produced on an informed user' is. But 'it takes longer to say than to see' as I observed in *Philips v Remington* [1988] RPC 283 at 318. And words themselves are often insufficiently precise on their own."²

13. Although that particular case was an infringement, the same principle applies in an application for invalidation. I must make a decision on whether the contested design was new and had individual character on the relevant date and to do this I am required to compare the contested design with the design(s) that are pleaded as prior art. What the parties believed they were doing is of no assistance in the present proceedings.

14. Ms Meese claims that the evidence she has submitted shows that Ms Simms was selling the contested design on eBay on 20 November 2018, which was before she filed an application to register it. Ms Simms denies this. However, I note that, even if Ms Simms had admitted she had done this, section 1B(6)(c) of the Act permits

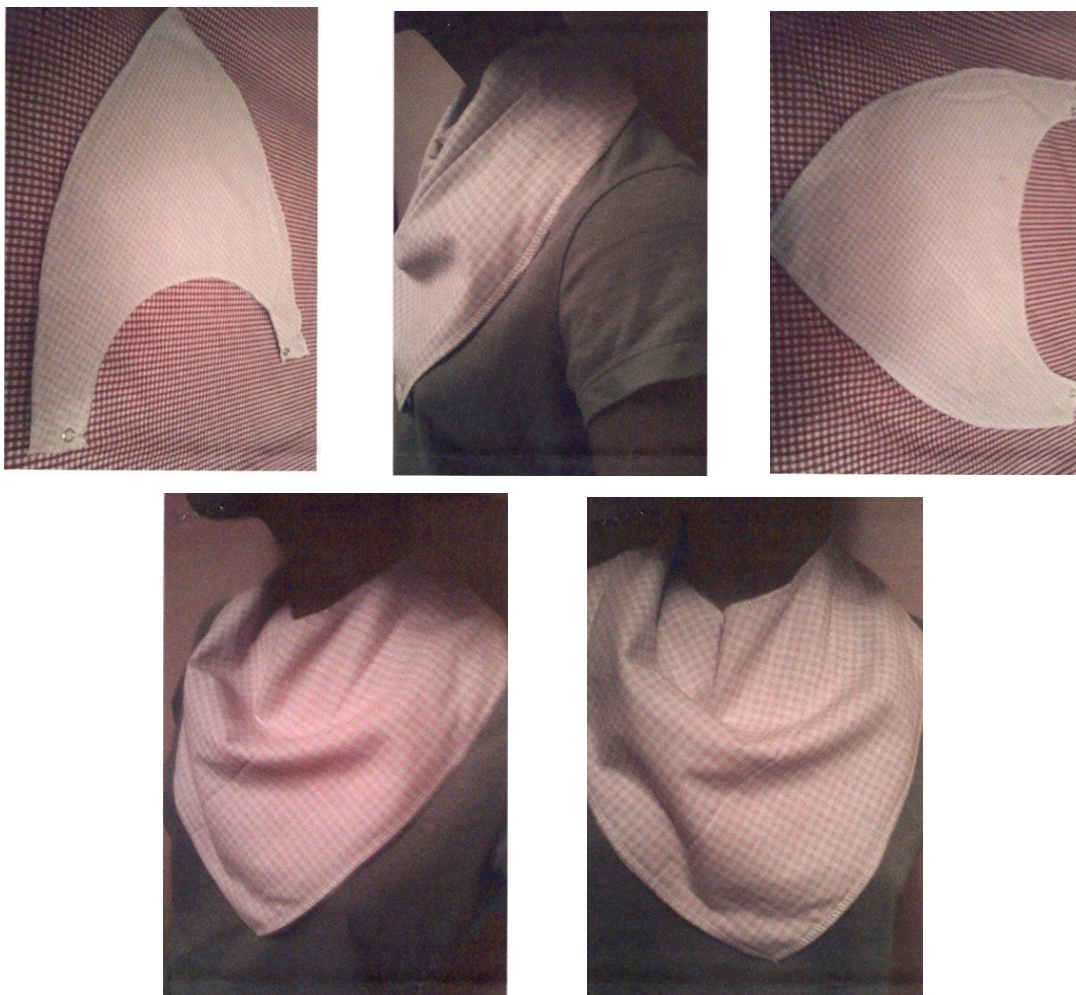
¹ Exhibits STS001-006

² Paragraph 3.

registration of a design within 12 months of a disclosure by the designer. As the application was made on 5 December 2018, a disclosure made by Ms Simms on 20 November 2018 would not destroy the novelty of her design.

Prior Art

15. Ms Meese's claim is based on registered design no. 4003718, of which she is the proprietor. The representations are shown below and I note that the registration carries the following disclaimer: "Colour and pattern do not form part of the design."



16. Ms Meese also provides print outs from eBay that she states show this design. However, it is the representations of registered designs that show what is protected, as the Supreme Court held in *Magmatic Ltd v PMS International Ltd*, [2016] UKSC 12:

“Article 3(a) of the Principal Regulation [Regulation No 6/2002] identifies what is meant by ‘design’, and, unsurprisingly, it refers to the appearance, which is expressed to include a number of different factors, all, some or one of which can be included in a particular registered design. It is, of course, up to an applicant as to what features he includes in his design application. He can make an application based on all or any of ‘the lines, contours, colours, shape, texture ... materials ... and/or ... ornamentation’ of ‘the product’ in question. Further, he can make a large number of different applications, particularly as the Principal Regulation itself provides that applications for registration have to be cheap and simple to make. As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, ‘[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs’. So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.”³

17. I shall therefore compare the contested design with Ms Meese’s earlier registered design as registered and shown in the representations in paragraph 15 above. I am satisfied that this earlier design would have been disclosed to the public when it was registered on 24 July 2007.

Novelty

18. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

³ Paragraph 30.

“Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”⁴

19. The contested design has the features set out below. The registration disclaims colour and material, and the proprietor has not claimed that the pattern constitutes a point of differentiation between the designs. It seems to me that the disclaimer also includes any pattern. These elements form no part of the design which comprises:

- a shape formed from the upper half of a circle joined to a triangle, with circular hole for the wearer’s neck towards the top;
- a fastener at the top that joins two strips of fabric together to make the curve of the semicircle. The fastener is shown as a single circle at the front and two circles on the rear;
- a rear piece, the edges of which are attached to the edges of the front piece. Just below the neck hole, it is clear that the rear piece is smaller than the front;
- soft folds descending from the neck hole and producing a ruched effect when worn;
- a label (such as may be used for care instructions) attached at the inside hem near one of the fastenings.

20. The earlier design consists of the following features:⁵

- a piece of cloth with a triangular point and straight sides until about a third of the way up, where they gently curve before straightening at the top, and semicircle cut out of the top at the centre, leaving two narrow pieces on either side;
- contrasting circles at the top which I take to be fasteners. Fastening the design produces a circular hole for the wearer’s neck;

⁴ Paragraph 26.

⁵ Colour and pattern are disclaimed.

- hems around the edge of the design giving the effect of a border; and
- a single, fairly stiff-looking fold in the fabric when the design is worn.

21. In my view, the differences between the designs are more than immaterial. When the product is not being worn, it will be apparent that they are constructed in different ways, which have an impact on how the design looks when being worn. In my view, then, the contested design has novelty when compared with the earlier design.

Individual Character

22. Section 1B(3) of the Act states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date. In *Ball Beverage Packaging Europe Ltd v European Intellectual Property Office (EUIPO)*, Case T-9/15, the General Court (GC) said:

“According to the case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (judgments of 7 November 2013, *Budziwska v OHIM – Puma (Bounding feline)*, T-666/11, not published, EU:T:2013:584, paragraph 29, and of 29 October 2015, *Roca Sanitario v OHIM – Villeroy & Boch (Single control handle faucet)*, T-334/14, not published, EU:T:2015:817, paragraph 16).”⁶

23. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, set out the correct approach to assessing individual character as follows:

⁶ Paragraph 78.

“53. The exercise must start with identifying the informed user and the existing design corpus. The overall impression is something produced on the informed user.

54. Although the outcome depends on overall impression, as a practical matter the design must be broken down into features. Each feature needs to be considered in order to give it appropriate significance or weight. Each feature needs to be considered in three respects. A feature dictated solely by function is to be disregarded. As long as it is not disregarded, each feature must be considered against the design corpus and it must be considered from the point of view of design freedom.

...

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.”

The informed user

24. Earlier in the same decision, the judge gave the following description of the informed user:

“33. ... The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer*

(C-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) he (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62, *Shenzhen* paragraph 46);

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);

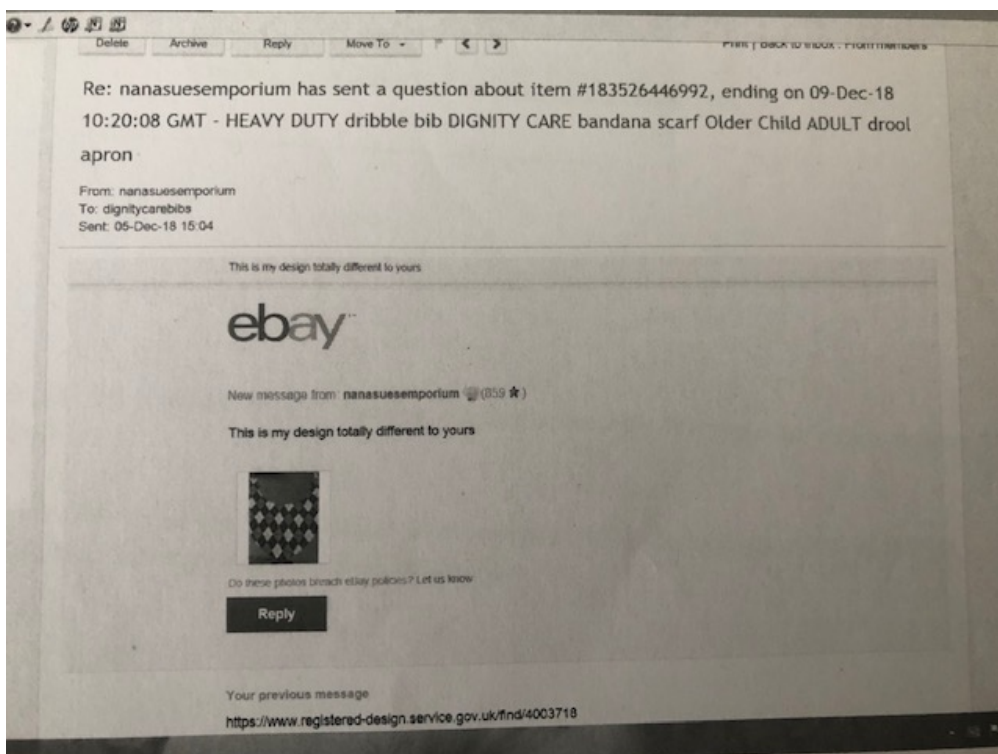
v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

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)."

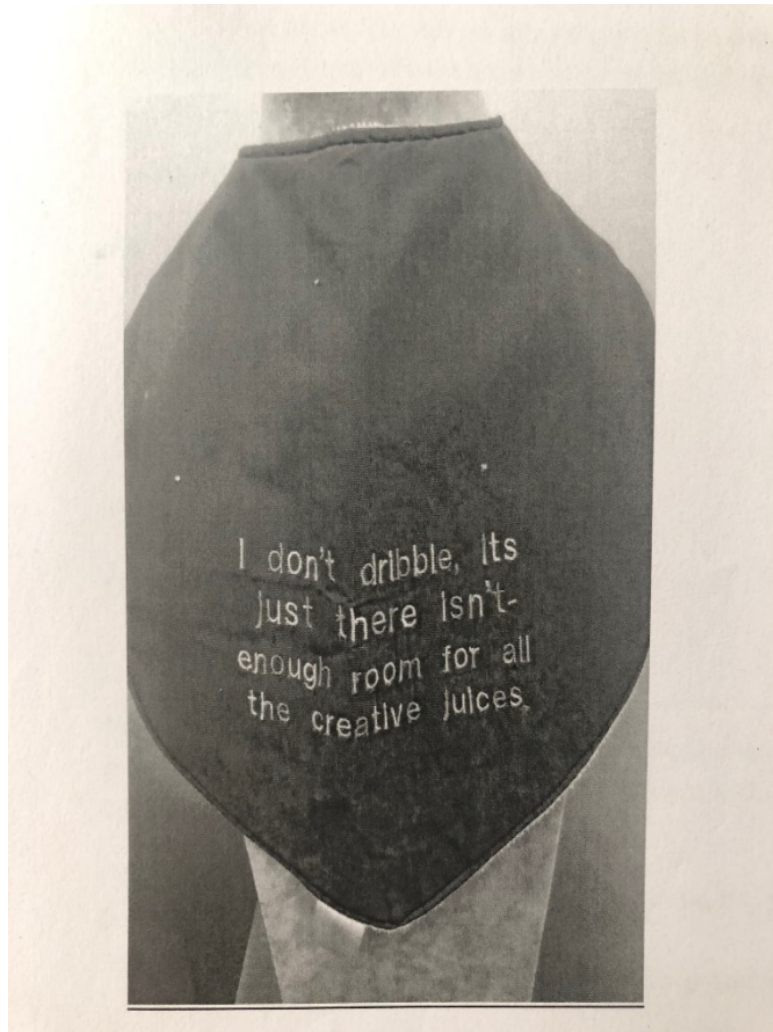
25. Both parties state that their designs are intended for people with special physical needs. The informed user is therefore an adult or a child who is a wearer of a bib or somebody who chooses them for others to wear. However, it may also be a member of the general public, as Ms Meese describes her design as a bib and Ms Simms says that her design is either a bandanna or a special-needs bib. These may be worn by anybody. However, as Mr Recorder Douglas Campbell, sitting as an Enterprise Judge, said in *Utopia Tableware Limited v BBP Marketing Limited & Anor*, [2013] EWHC 3483 (IPEC), the informed user is a legal construct and what is important is that they have knowledge of the existing design corpus, are interested in the products concerned, show a relatively high degree of attention when they use them, and (unless it is impractical or uncommon to do so) conduct a direct comparison of the designs at issue.⁷

The design corpus

26. The parties' evidence contains images that both agree show designs that were available to the public before the relevant date:



⁷ Paragraphs 73 and 74.



27. Ms Simms says in her counterstatement that the first image shows the simpler design that was originally listed on eBay in 2017. The image is small but the shape looks identical to that of Ms Meese's earlier design. She also states that the second image shows the shape of her original design. The sample supplied in Exhibit STS004 matches the features that are visible in the photograph.

28. The remaining images in the evidence are either undated, have a date later than the relevant date, or, even if I were to accept Ms Meese's evidence in its entirety, would represent a permitted disclosure by Ms Simms. I shall therefore not take them into account as part of the design corpus.

Design freedom

29. In *Dyson Ltd v Vax Ltd*, [2010] FSR 39, Arnold J (as he was then) stated that:

“... 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).”⁸

30. I remind myself that the contested design is subject to a disclaimer regarding the colour, material and, by extension, the pattern shown in the representations. Although there would be a significant degree of design freedom over these aspects, they are not relevant for the present purposes. The designer can, however, choose the shape. Although both designs end in a point, they could equally be curved or square. Neither are the proportions fixed. The designer will need to ensure that it fits comfortably round the neck but the size of the bib element when compared with the neck pieces may be varied. A bib or bandana may sit flat or the fabric may be ruched, with a varying number of folds. The designer can also choose different ways of fastening the item.

Overall impression

31. Ms Simms chose to construct the contested design from two differently shaped pieces of material and this has a noticeable effect on the draping of the design, even when it is not worn. The folds are smaller, and there are more of them. When worn, the fabric falls in soft ruffles. The overall impression of the contested design is fluid, while the earlier design appears to be more stiff. Both these designs differ from the design corpus, notably the second image in paragraph 26 above where the material has no folds and sits flat, although its outline shape appears to be the same at the bottom. The appearance of the fastenings is also different but, in my mind, the construction and draping are the most significant features and they outweigh any similarities in the triangular shaping of the bottom of the design. Consequently, I find that the contested design has individual character.

⁸ Paragraph 34.

Conclusions

32. The application for invalidity has failed and design no. 6049429 will remain registered.

Costs

33. The registered proprietor has been successful and would be entitled to a contribution towards her costs. As she is a litigant in person, the Tribunal invited her to complete a proforma detailing the time spent on a series of activities associated with the proceedings. As she did not return this proforma, I make no award of costs.

Dated this 10th day of November 2020

Clare Boucher

For the Registrar,

The Comptroller-General