

BL O/392/21

**CONSOLIDATED PROCEEDINGS**

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

**IN THE MATTER OF REGISTERED DESIGN Nos. 6064061, 6060604 & 6064060  
IN THE NAME OF WONG SUI LIN**



**AND**

**THE APPLICATIONS FOR INVALIDATION (Nos. 1/20, 2/20 & 3/20)  
BY JUNAID MAHOMED**

## Background and pleadings

1. The registered designs which are the subject of this dispute were filed by Wong Sui Lin on 26 June 2019 (no. 6064061, invalidation no. 1/20 and no. 6064060, invalidation no. 3/20) and 13 May 2019 (no. 6064061, invalidation no. 2/20). The designs are described on the application forms by the registered proprietor as “battery”. Each design application comprises a single illustration on the register, as follows:

6064061

6060604

6064060



2. The applications specify that no claim is made for colour.

3. On 17 January 2020 and 20 January 2020, Junaid Mahomed requested that the designs be declared invalid under Section 1B/11ZA(1A)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which requires that a registered design be new and have individual character. Mr Mahomed attaches evidence of what he claims to be prior art which destroys the novelty of the registered designs, and claims as follows:<sup>1</sup>

<sup>1</sup> The application form includes a statement of truth, signed by Mr Mahomed, meaning that the statement of case qualifies as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (“the Rules”).

- The registered designs were originally designed by a company called Shenzhen Huidafa Technology Co., Ltd (“Shenzhen”) as a mobile phone battery;
- Mr Mahomed’s company, Zeltech Ltd (“Zeltech”), is the official distributor for Shenzhen in the UK, selling their products on ebay since the beginning of September 2019;
- On 16 January 2020, Zeltech received an email from ebay stating that its listings had been removed because they infringed Ms Wong’s intellectual property rights;
- Ms Wong has been disguising parts of designs by blacking out logos and company names in a bid to register these designs (and others) that others have created.

4. The remainder of the statements of grounds refer to the attached evidence. I will refer to this later in this decision.

5. Notices of defence and counterstatements were signed by Ms Wong, denying the claims and simply stating that the designs are new and have individual character. At this point, the three sets of proceedings were consolidated.

6. Only Mr Mahomed filed evidence. Neither party requested a hearing and neither filed written submissions in lieu of a hearing. Both parties represent themselves. I make this decision after a careful reading of all the papers.

## **Evidence**

7. Apart from the aforementioned documents attached to the statement of grounds, Mr Mahomed has also filed a witness statement dated 25 October 2020. He states that he is his company’s account manager and that the content is either from his own knowledge or, where from another source, he believes the facts to be true. I will refer to this evidence in so far as it is relevant to the issues to be decided.

## Decision

8. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground that it was not new or that it did not have individual character on the date on which it was filed (section 1B). Section 11ZA(1)(b) reads:

“(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...”

9. Section 1B 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) .....

(9) ....”.

10. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked, unless the exceptions in subsection (6) apply. This means that the relevant dates for my assessment are 26 June 2019 and 13 May 2019. None of the exceptions apply. Ms Wong has not claimed or filed any evidence to show that she relies on the exceptions. I say more about this later in this decision.

11. I will focus on whether the contested registered designs had individual character rather than whether they were new: if they did not have individual character at the relevant dates, they cannot be new. The relevant case law in this respect was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). The parts which are most relevant to these proceedings 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 OHIM* [2010] ECDR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, BAILII: [2010] EUECJ 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 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."

12. Section 1B(3) 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 EUIPO*, the General Court (GC) said<sup>2</sup>:

"78...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

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<sup>2</sup> Case T-9/15

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, *Budziewska 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).”

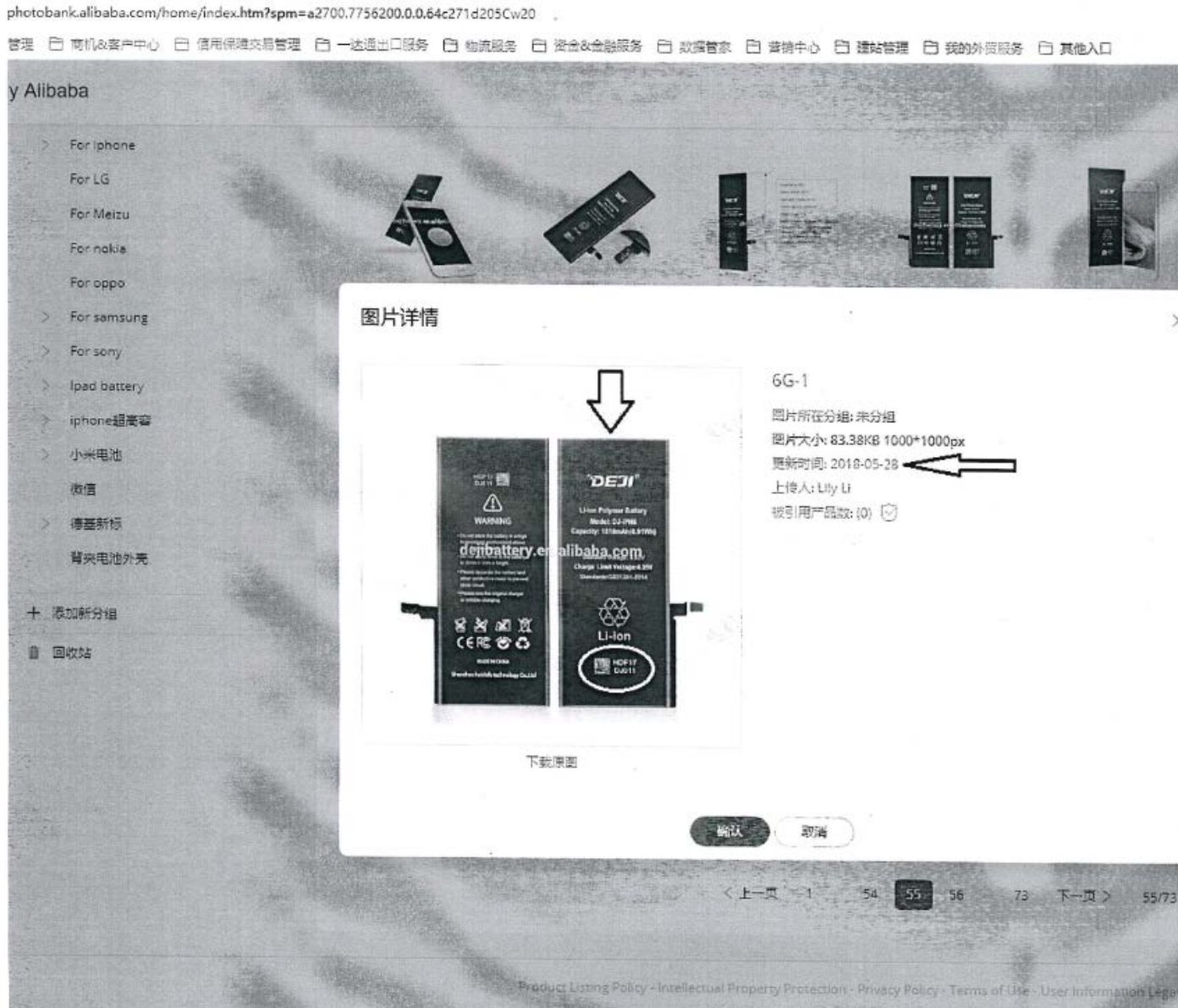
13. In the absence of evidence addressed to the design corpus it is difficult to make a finding about the design corpus. No evidence is provided about whether there are restrictions to design freedom in respect of mobile phone batteries. However, I will treat it as a notorious fact that mobile phones are rectangular in shape and are much thinner than they are long. This would make it difficult for a battery to be, for example, circular, hexagonal, a cube or a sphere. I infer that there is a certain amount of design restriction in that batteries for mobile phones are likely to be cuboid; i.e. rectangular or square, being thin enough to fit inside the phone.

14. Individual character must be assessed through the eyes of the informed user. The informed user of the designs at issue is a person who uses and is familiar with mobile phones and their batteries. The informed user is not an ‘average’ consumer but is someone who will have an interest in such products. However, they will not examine the designs with forensic attention to detail.

15. Mr Mahomed provides details in his witness statement about what amounts to a claim to a pattern of behaviour by Ms Wong, of registering other people’s designs, removing their brand names and logos. I can only consider the prior art provided in the evidence against the registered designs which are contested. Communications sent to Ms Wong about her behaviour are not relevant to the assessment.

## The claimed prior art

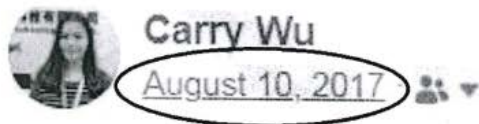
16. Some of the images in the evidence are not of the clearest quality. Some of them are undated. One of the documents attached to the statements of grounds for 6064061 and 6064060 is the following image from the Alibaba website:



17. The writing is in Chinese but Mr Mahomed has highlighted a date of 28 May 2018 and states that this is Shenzhen's listing on Alibaba. He states that the right-hand image (highlighted with an arrow) is the front of the battery corresponding to designs 6064061 and 6064060. He points out that the small oval circle at the bottom of the battery highlights the battery code, HDF17 DJ011; stating that 'HDF' represents

Huidafa, part of Shenzhen's company name, and 'DJ' represents Deji, the brand name of Shenzhen's battery.

18. There is a single attachment to the statement of grounds for 6060604:



Higher Capacity DEJI iPhone battery details as below:

iPhone 6: 2200mAh (Original:1810mAh)

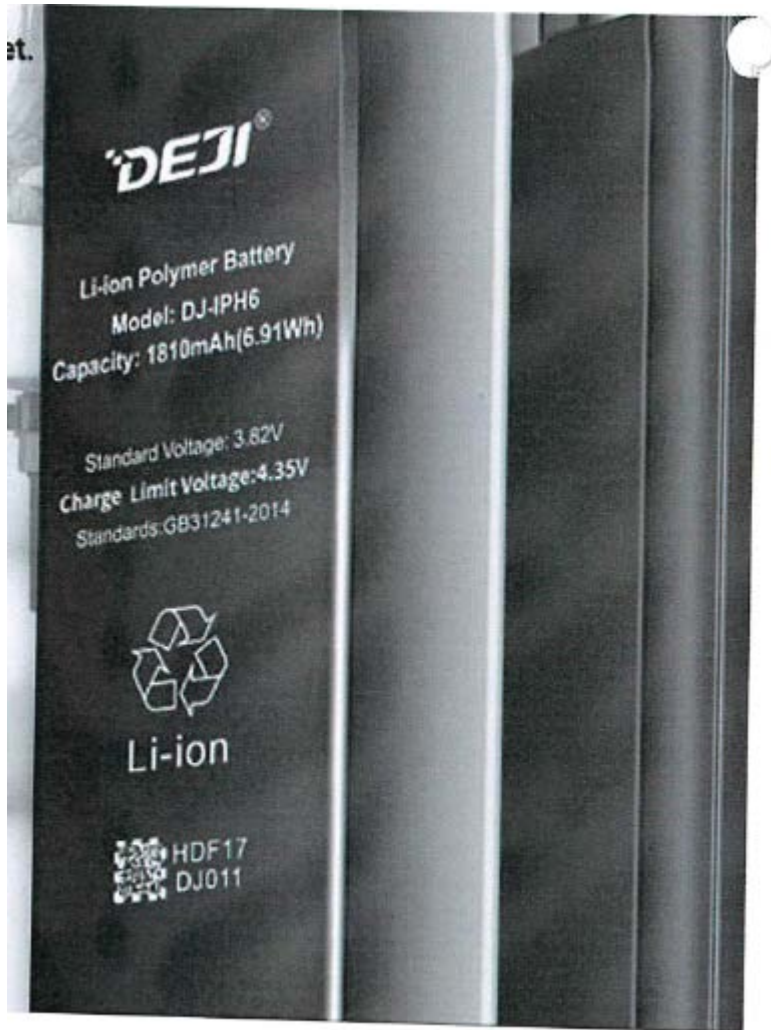
iPhone 6S: 2200mAh (Original:1715mAh)

iPhone 6P: 3300mAh (Original:2915mAh)... See More



19. Mr Mahomed explains that this is a screenshot of Carry Wu's Facebook post, Ms Wu being a supervisor at Shenzhen. Mr Mahomed states that the arrowed images are the front of the battery and that this shows that Shenzhen made the design public on Facebook on 10 August 2017.

20. Attached to the statement of grounds for 6064061 and included in Exhibit JM6 is a copy of an email dated 29 December 2017 from 'Carry' at Shenzhen, to a customer, explaining that Shenzhen makes batteries for various well-known third-party companies. The email includes the following image:



21. In his witness statement, Mr Mahomed states that Shenzhen has been selling the products the subject of the contested designs since about 2016. Exhibit JM2 comprises a copy of an email from Carry Wu, dated 12 November 2016. The images of the batteries are very small:

12 Kes 2016 11:03 tarihinde : [sales4@d278battery.com](mailto:sales4@d278battery.com) > yazdı :

Hi,

Thank you very much for your inquiry of the iphone batteries.

This is Carry from Huldefa Technology Co., Ltd, located in Shenzhen, China. We have manufactured battery for over 15 years and power be price. DEJI is our logo brand and quality is our culture.

In our factory, we are mainly producing the iphone batteries and some of samsung batteries with high quality and real capacity . There are 7P and battery for samsung S3, S4, Note 2 and note 3.

May I know which model batteries will you need please ? And how many pieces ?

And also will you need the batteries with our DEJI logo or without DEJI logo ?

Hope to hear from you soon .

Thanks a lot & best regards,

Carry Wu

 Shenzhen Huldefa Technology Co., Ltd  
Company website : [www.szdeji.com](http://www.szdeji.com)  
Alibaba : <http://huldefa.en.alibaba.com>  
Global Sources : <http://shenzhen-huldefa-manufacturer.globalsources.com>  
Email : [sales4@d278battery.com](mailto:sales4@d278battery.com)  
Skype : hd/sale4  
Whats app : [+86-13715028408](tel:+86-13715028408)  
Phone number /Wechat: [+86-13715028408](tel:+86-13715028408)

THIS IS A SCREENSHOT OF AN EMAIL WHICH SHOWS THAT THE DESIGN WAS MADE PUBLIC BEFORE WONG SUI LIN REGISTERED THE DESIGN. THE DATE ON THIS EMAIL IS 12TH NOVEMBER 2016. PLEASE NOTE THE DATE ABOVE IS THE TURKISH LANGUAGE.



22. Exhibit JM6 comprises copies of several emails. One is dated 18 May 2017, from Carry Wu, responding to a customer enquiry about batteries. The images shown at the bottom of the email are as follows:

Thursday, May 18, 2017 12:23 PM "sales4@d278battery.com" <sales4@d278battery.com> wrote:

Hi,

Thank you very much for your inquiry of the battery .

This is Carry from Huldefa Technology Co., Ltd, located in Shenzhen, China. We have manufactured battery for over 15 years with top quality and factory price . DEJI is our logo brand and quality

In our factory , we mainly produce iphone batteries from iPhone 4 to iPhone 7 plus with grade A quality real high original capacity and with 500 cycle new battery famous brand battery cell .

Whether do you need the total 100pcs batteries for iPhone 4S only ?

Do you need that too? like for iPhone battery ?

Hope to hear from you soon .

Thanks a lot & best regards,

Carry Wu

 Shenzhen Huldefa Technology Co., Ltd  
Company website : [www.szdeji.com](http://www.szdeji.com)  
Alibaba : <http://huldefa.en.alibaba.com>  
Global Sources : <http://shenzhen-huldefa-manufacturer.globalsources.com>  
Email : [sales4@d278battery.com](mailto:sales4@d278battery.com)  
Skype : hd/sale4  
Whats app : [+86-13715028408](tel:+86-13715028408)  
Phone number /Wechat: [+86-13715028408](tel:+86-13715028408)

THIS PICTURE SHOWS THIS DESIGN WAS MADE PUBLIC BEFORE WONG SUI LIN REGISTERED IT. THE DATE ON THIS EMAIL IS 18TH MAY 2017



- An email, dated 22 November 2017, which is an enquiry to Shenzhen via the Alibaba website, shows the following images:

Re: Re: [Alibaba Inquiry Notification] Huidafa iPhone Battery from DEJI Carry -20...



THIS PICTURE SHOWS THE DESIGN WAS MADE AVAILABLE TO THE PUBLIC BEFORE WONG SUI LIN REGISTERED IT.

Original

From: [fsq@haido@alibaba.com](mailto:fsq@haido@alibaba.com)  
 Send time: Wednesday, November 22, 2017 09:19 AM  
 To: sales4 <[sales4@alibaba.com](mailto:sales4@alibaba.com)>; [fsq@haido@alibaba.com](mailto:fsq@haido@alibaba.com)  
 Subject: [Alibaba Inquiry Notification] AKMAL HAKTM has sent you an inquiry

- An email, dated 29 January 2018, which is a reply to a customer from Shenzhen, shows the following images:

Re: Re: Tracking Number of 70pcs iPhone 7 Batteries from DEJI Carry-2018.01.30

Sebastian Weyh

Am 29.01.2018 um 10:22 schrieb [sales4@dj278battery.com](mailto:sales4@dj278battery.com):

THIS PICTURE SHOWS THIS DESIGN WAS MADE PUBLIC BEFORE WONG SUI LIN REGISTERED THE DESIGN. THIS EMAIL IS DATED 29TH JAN 2018

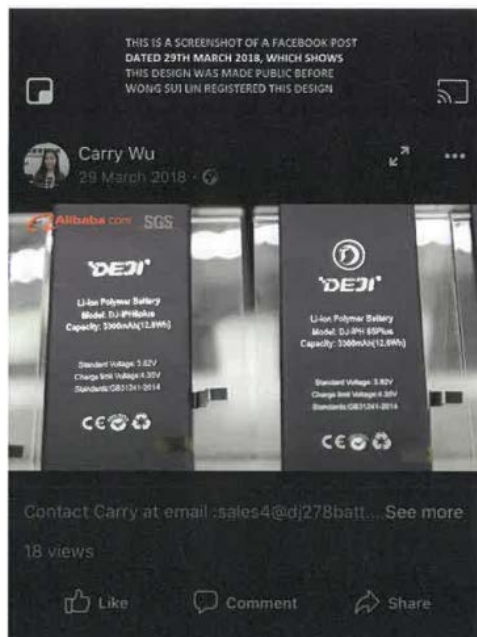
Hi Sebastian,

You are welcome. And hope it can reach you soon.

By the way, may i know whether do you need to make OEM battery for iPhone 7 or use our DEJI logo will be OK ?



- Facebook posts, dated 29 March 2018, from Carry Wu:





21:34



Congratulations 🎉🎊🎈

⚙️ · [Rate this translation](#)

THIS IS A SCREENSHOT OF A FACEBOOK POST DATED 29TH MARCH 2018 WHICH SHOWS THAT THIS DESIGN WAS MADE PUBLIC LONG BEFORE WONG SUI LIN REGISTERED THIS DESIGN

👍 Like

💬 Comment

✉️ Send



**Carry Wu**

29 March 2018 · 🌐

Contact Carry at email :[sales4@dj278battery.com](mailto:sales4@dj278battery.com),  
Skype : hdfsale4, Whats app/Wechat :  
+8613715028408



Watch together with friends or with a group

Start

👍 You

18 views

👍 Like

💬 Comment

➦ Share



**Carry Wu**

18 January 2018 · 🌐



- A Facebook post, dated 30 August 2017, from Carry Wu:

THIS IS A SCREENSHOT FROM FACEBOOK SHOWING A FACEBOOK POST THAT WOULD BE PUBLIC ON 08/11 AUGUST 2017, HOWEVER LONG TIME BEFORE WONG HAN LIN REGISTERED THE DOMAIN

Share



ALIBABA.COM

**For Iphone 6s Battery Replacement,1715mah  
Battery For Iphone 6s 0cycle - Buy Battery For Ip...**

1

Like

Comment

Share

- Facebook posts dated 10 August 2017, from Carry Wu:

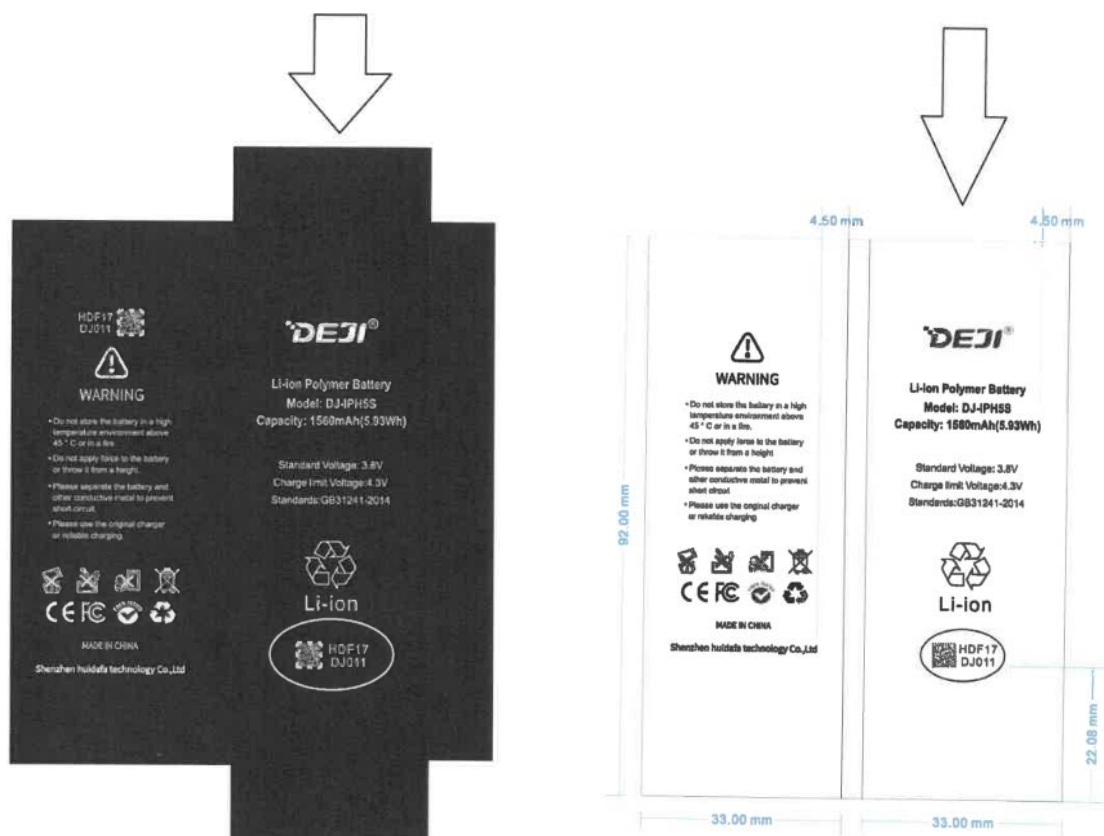


23. Mr Mahomed provides, at Exhibit JM7, prints from the UK designs register of a list of Zeltech’s registered designs for mobile phone batteries and tools. Zeltech’s registered designs were all filed in 2020, after the relevant dates, and so do not constitute prior art; further, Mr Mahomed states that he believes Ms Wong registered

her designs after seeing that the products were not already registered as designs at the IPO. He states that he/his company is protected by the unregistered design right.

### Has the claimed prior art been disclosed?

24. To constitute relevant prior art, the designs depicted in the evidence need to have been disclosed before the relevant dates (the exceptions do not apply, as above). Attached to the statement of grounds for 6064061 and 6064060, and also comprising Exhibits JM8 and JM9, are two images which Mr Mahomed states are the original artwork created by the designers before submitting for printing. Neither of these documents are dated, and Mr Mahomed does not provide a date either in the statements of grounds or in his witness statement. As the exhibits are undated, they do not constitute prior art:



25. Ms Wong has said nothing about the disclosures: specifically, it would be within her knowledge if subsections 1B(6)(b) to (e) applied. Subsection 1B(6)(a) refers to

designs which 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. Ms Wong has been silent about this potential defence. Mr Mahomed has exhibited evidence of Shenzhen's batteries on Alibaba and Facebook, presented in English, prior to the relevant dates. Both of these websites are global and mainstream; Alibaba being a major Chinese e-commerce site, comparable to ebay and Amazon.

26. Even if these disclosures were outside of the EEA, such disclosure may be sufficient to bring the designs to the attention of the circles specialised in the sector concerned within the EEA. Further, the extent of the disclosure required need not be widespread to relevant persons in the EEA. In *Senz Technologies BV v OHIM*, the General Court upheld OHIM's decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry.<sup>3</sup> Mobile phone batteries represent a huge market, and Facebook and Alibaba are common online vehicles for advertising and selling products. Alibaba is Chinese and China is one of the most important industrialised nations in the world. There is no evidence that those operating in this sector in the EEA would not have seen the designs; in fact, it is far more likely that they would have seen them, prior to the relevant date, given that they fit Samsung and Apple mobile phones. The onus is on Ms Wong to dispute the disclosures and she has not done so. Aside from the artwork referred to above, Mr Mahomed may rely upon the other prior art, which I will now compare against the three contested design registrations.

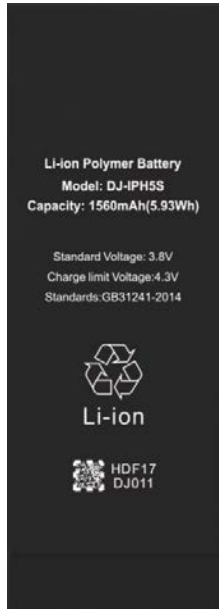
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<sup>3</sup> Joined cases T-22/13 & T-23/13.

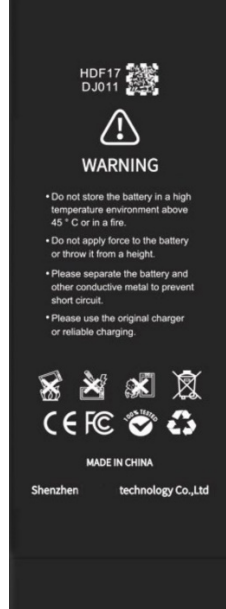
## 6064061 and 6064060

27. The designs registered under these numbers are:

6064061



6064060



28. Both designs comprise black rectangles with various words, letters, numbers and symbols centred upon each rectangle. The application forms for the designs simply state that the designs are batteries and that “no claim is made for colour”. There is, therefore, a question as to whether it is only the shape that is registered as a design, or the combination of the shape and the graphics thereon. To some extent, this makes less difference to the comparison with the prior art because a large amount of the graphics on the contested designs also appears on the surface of the prior art. For the most part, the graphics give technical and recycling information, and that the batteries are made in China.

## 6064060

29. I note that the codes HDF17 and DJ011 appear on 6064060 and in the prior art, and that Mr Mahomed has explained their derivation (as above). Contested design 6064060 includes the word ‘Shenzhen’ at the bottom, with a space, and then the words ‘technology Co.,Ltd’. Some of the prior art includes, in the same position, the words Shenzhen Huidafa technology Co.,Ltd, which is Shenzhen’s company name (the

company for which Mr Mahomed's company is the UK distributor). The only difference is that the contested design omits the word Huidafa; otherwise, the company name is the same. In particular, I note the following piece of prior art, on the left, with 6064060 shown on the right:



30. Although the graphics are somewhat blurred in the prior art, it is sufficiently clear to see that, with the exception of the word Huidafa in the company name, all the other graphics are identical. This is the piece of prior art which is closest to 6064060. The contested design is represented in 2D, whilst the prior art looks more 3D, although there is not much depth represented. The contested design is narrower than the prior art and there is more of a graphic-less gap at the bottom. The difference in width will likely be viewed by the informed user as being required to fit within a particular phone, as opposed to being driven by design. As noted, all the graphics, except for Huidafa, are identical. The graphics provide information about the product which would not make much impression on the informed user from a design perspective. Where the contested design consists of more than the shape and configuration of a product, the presence or absence of ornamentation, or different ornamentation, must be taken into account. However, it does not preclude two designs with different ornamentation creating the same overall impression on a relevant informed user.<sup>4</sup> Moreover, that may be so even where the prior art can be distinguished to some degree from the

<sup>4</sup> See *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12, at paragraph 45

registration. These graphical differences between the prior art are not so significant that the overall impression would be different, given the extent to which the graphics and the black rectangular shape of the prior art and the contested design are near-identical.

31. There is one further difference: there is an element protruding from the lower left-hand side of the prior art (a similar protrusion appears on the right of contested design number 6060604). I note that in another piece of prior art, various such protrusions are shown, in representations which appear to show the front and back of batteries, (hence the protrusions are on one side or the other) and also that for the iPhone 5S, they are lower down than for the other models:



31. This leads me to conclude that the protrusion has a technical role to play in the battery fitting inside the phone; e.g. as an electrical contact. It would not make much of an impression on the informed user from a design perspective in relation to a product in which the rectangular shape is the most important feature in order to fit inside a mobile phone. Overall, given the near-identical graphics which cover nearly the whole of the contested design and the prior art, notwithstanding their almost wholly



technical nature, I find that the overall impression of contested design 6064060 on the informed user does not differ from the prior art. 6064060 did not have individual character at the relevant date.

## 6064061

32. The graphics on this contested design do not contain Shenzhen's company name (or part of it). The graphics are technical information or are the codes HDF17 and DJ011, as described above. I note the following piece of prior art, with contested design 6064061 shown on the right:



33. Similar considerations as those described above also apply, in terms of graphical content, dimensions of the black rectangles and the protrusion (this time to the right as it is the other side of Shenzhen's (Mr Mahomed's) battery). A graphical difference is that the prior art contains "DEJI", which Mr Mahomed has explained is a brand name used by Shenzhen on its batteries. Whilst this is a point of difference not present in the previous comparison, I do not think it makes enough of a difference. The presence of a brand name on, for example, an item of fashion may make a contribution to its eye appeal as surface decoration or ornamentation. It is unlikely on the surface of a utilitarian article such as a mobile phone battery to have anything like that significance in the overall impression of the design; especially so, in this case, when the other graphics, which cover the majority of the contested design and the prior art, are the

same, or almost so. I find that the overall impression of contested design 6064061 on the informed user does not differ from the prior art. 6064061 did not have individual character at the relevant date.

## 6060604

34. The contested design comprises a black rectangle with various words, letters, numbers and symbols centred upon each rectangle. The application form for the design simply states that the design is a battery and that “no claim is made for colour.” As for the other designs, there is, therefore, a question as to whether it is only the shape that is registered as a design, or the combination of the shape and the graphics thereon. Similarly, this makes less difference to the comparison with the prior art because a large amount of the graphics on the contested design also appear on the surface of the prior art. The graphics give technical and recycling information. The contested design also has a protrusion from the right-hand side, just under half-way up.

35. I note the following two pieces of prior art, with 6060604 shown on the right:



36. The prior art and the contested design all contain protrusions from the right hand side at proportionately the same height. All three images show black rectangles in 3-D, with curved vertical edges. Apart from the presence in the prior art of “DEJI”, all

the other graphics are near-identical between the prior art and the contested design (the model numbers differ in the last numeral). My findings in relation to the impact of DEJI also apply here; *a fortiori*, since the prior art in this comparison also includes the protrusion and the contested design is also in 3-D. I find that the overall impression of contested design 6060604 on the informed user does not differ from the prior art. 6060604 did not have individual character at the relevant date.

## **Outcome**

37. I find that design registration numbers 6064061, 6060604 & 6064060 did not have individual character when they were filed and are therefore invalid. The applications for invalidation of the registered designs succeed under section 11ZA(1)(b) of the Act.

## **Costs**

38. Mr Mahomed has been successful and is entitled to a contribution to his costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. As Mr Mahomed is unrepresented, at the conclusion of the evidence rounds the tribunal invited him to indicate whether he intended to make a request for an award of costs and, if so, to complete a pro forma indicating a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the applications. Mr Mahomed filed a completed costs pro forma identifying his costs as being:

<b>Item</b>	<b>Time spent</b>
Cancellation notices	7 hours
Considering the defences	9 hours
Collecting evidence	8 hours
Compiling witness statement	75 hours
Preparing evidence	20 hours
Emails/phone calls	3 hours

Seeking solicitor's advice	6 hours
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39. As stated above, costs are intended as a contribution, not full recompense unless costs off the scale have been requested, and allowed by the Tribunal. There has been no request for actual costs. The Litigants in Person (Costs and Expenses) Act 1975 sets the rate for unrepresented litigants at a rate of £19 per hour. Some of the time recorded in the pro forma is excessive. Preparation of evidence includes gathering it and preparing a witness statement. The pro forma hours in this respect amount to 103 hours, which is about three working weeks. Taking into account the procedural economies of consolidation and the evidence that was filed, I consider it appropriate to award an amount which reflects two days work for this task: £142.50. No award will be made for emails and telephone calls, as this type of activity is included in the items specified in the scale set out in TPN 2 of 2016. No award will be made for consulting solicitors, as Mr Mahomed has acted in these proceedings as an unrepresented litigant. I will allow 6 hours for filing the three cancellation applications as Mr Mahomed was unfamiliar with the procedure and he attached (different) evidence to the three applications. This amounts to £114. I will allow 1 hour for considering the counterstatements as they were of an extremely brief nature and the content of all three was the same: £19. The three official fees for filing the three applications are included in full, totalling £144. The total cost award is, therefore, £419.50.

### **Cost order**

40. I order Wong Sui Lin to pay to Junaid Mahomed the sum of **£419.50**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26th day of May 2021**

**Judi Pike**

**For the Registrar,**

**The Comptroller-General**