

BL O/043/22

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN No. 6123801

IN THE NAME OF PAUL SMITH



AND

THE APPLICATION FOR INVALIDATION THERETO (No. 41/21)

BY THOMAS REAVY

Background and pleadings

1. Paul Smith filed application no. 6123801 for a registered design for a “game controller stand” in Class 14, Sub class 6 of the Locarno Classification (holders, stands and supports for electronic equipment) on 11 March 2021. It was registered with effect from that date and is depicted in the following six representations:



2. On 27 May 2021, Thomas Reavy requested that the registered design be declared invalid under Section 1B/11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which requires that a registered design be new and have individual character. Mr Reavy attaches evidence of what he claims to be prior art which destroys the novelty of the registered design.¹

3. A notice of defence and counterstatement was filed and signed by Mr Smith, denying the claim. Several screenshots of messages between the parties are provided, but these are not relevant to whether the contested design was new and/or

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

had individual character when it was applied for. In terms of the denial of the claim, Mr Smith refers in his counterstatement to Mr Reavy not possessing a registered design and states:

“If they wish to register their design, we will have no objection as we don’t believe it contravenes our design. They are different shapes, theirs standing on feet and ours a solid stand, different fittings are also used and placed in different positions and sizes. We didn’t copy their design and we do believe our design is different, it just has the same purpose and made from the same material (I hope you agree).”

4. The only evidence in these proceedings is the documentation attached by Mr Reavy to his application for invalidation of the contested design. 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.

Decision

5. 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...”

6. 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 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 geographical area comprising the United Kingdom and 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)”.

7. According to section 1B(7) of the Act, prior art (a design which has been made available to the public before the relevant date) 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 date for my assessment is 11 March 2021. None of the exceptions apply.

8. In order for Mr Reavy to succeed in his claim, his evidence must show that the claimed prior art pre-dates 11 March 2021. I have reproduced below the entirety of Mr Reavy’s evidence:

DF19B SHEET 1 Evidence

https://www.etsy.com/your/account/payments/monthly-statement?month=5&year=2020

Date	Type	Description	Amount
2020	Transaction	Handmade Copper Pipe Docking station for Controller & Headphones transaction: 1904639692	
21 May, 2020	VAT	VAT: listing listing: 812760847	-£0.03
21 May, 2020	Listing	Handmade Copper Pipe Docking station for Controller & Headphones listing: 812760847 US\$0.20	-£0.16
21 May, 2020	VAT	VAT: renew sold renew sold: 783995032	-£0.03
21 May, 2020	Listing	Handmade Copper Pipe Towel Rail + Brass Fittings 4 Size listing: 783995032 renew sold US\$0.20	-£0.16
21 May, 2020	VAT	VAT: transaction transaction: 1901258340	-£0.12



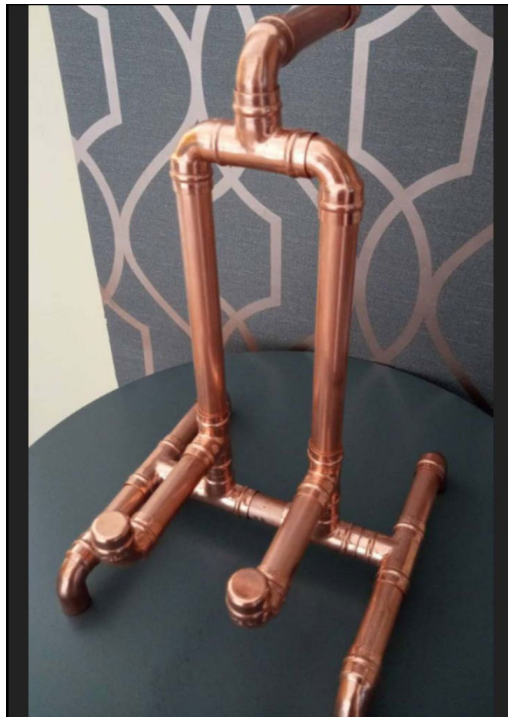
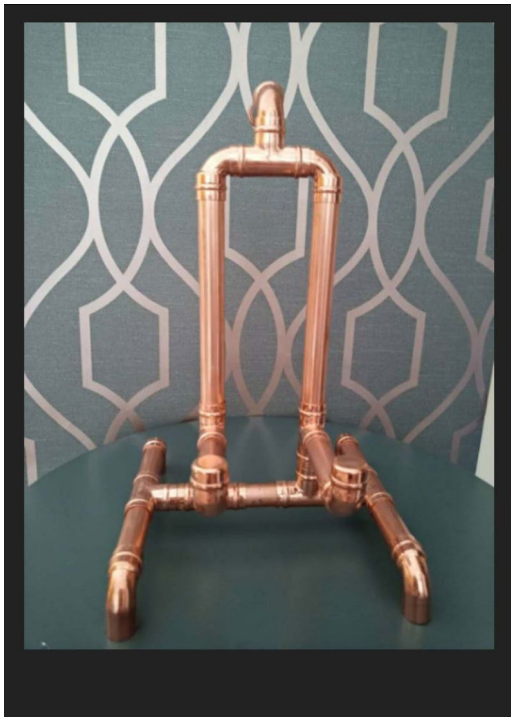
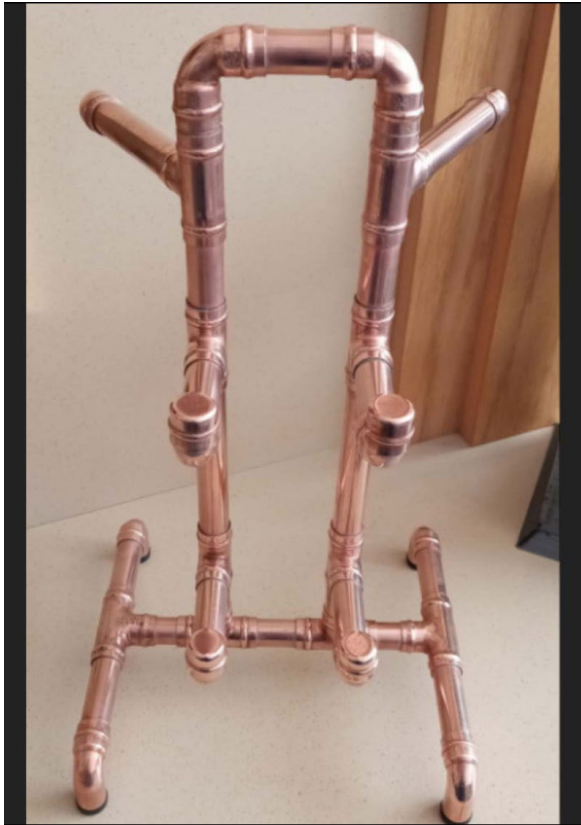
TOM R
 Barnsley, England, United Kingdom
 57 Following 10 Followers

I am a full time plumber by trade, A family man with a small family run business

[Read more](#)

Your Shop

Coppercreations20
 328 Sales Since 2020
 ★★★★★ (79)



9. The claimed prior art comprises undated photographs and a single dated thumbnail (dated 21 May 2020). The detail of the dated thumbnail is virtually impossible to see; certainly, it is impossible to discern its detail with sufficient clarity in order to make a comparison with the contested design. There is, therefore, no proof that the contested design was not new or did not have individual character at the relevant date because there is no proof that prior art existed at the relevant date.

10. That, strictly, is the end of the matter and means that Mr Reavy's application to invalidate Mr Smith's registered design must fail. However, because the parties are both unrepresented and because it may help to resolve issues between them which are misunderstood, I will, for completeness, state why Mr Reavy's application to invalidate Mr Smith's design would have failed even if the above undated photographs had been shown to have pre-dated 11 March 2021.

11. I will focus on whether the contested registered design had individual character rather than whether it was new: if it did not have individual character at the relevant dates, it cannot be new. The relevant case law in this respect was conveniently set out by Birss J. (as he then was) 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.

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.

55. Since this case is concerned with infringement only and not validity, the list of features is a list of similarities said to exist between the design and the alleged infringement. Aside from considering similarities, the differences between the design and the alleged infringement also need to be addressed and weighted. For all the similarities and differences, the weighting exercise is concerned with assessing the significance of the similarity to the informed user. Things which look the same because all the products in the class look that way do not exercise the informed user's interest to the same extent as unusual features.

56. Taking into account the similarities and differences, appropriately weighted, the court can decide whether the alleged infringement produces a different overall impression on the informed user from that produced by the registered design.

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.

13. In the absence of evidence, 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 game controller stands. It seems to me that stands for games controllers could be all manner of shapes provided there is some feature which holds the controller. I infer that there is a good deal of design freedom.

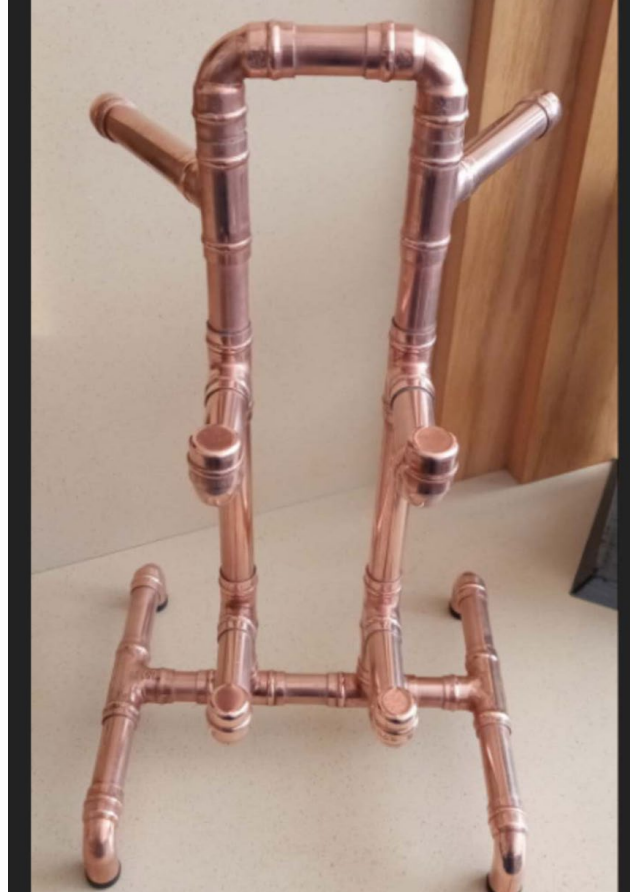
14. Individual character must be assessed through the eyes of the informed user. The informed user of the design at issue is a person who uses and is familiar with games controller stands. The informed user is not an 'average' consumer but is someone who will have an interest in such products. However, they will not examine the design with forensic attention to detail.

15. I note that Mr Reavy's evidence appears to show two different product images, so I will compare each with the contested design. It is convenient to compare one of the representations of the contested design with Mr Reavy's images.

Contested design



Mr Reavy's image (i)



16. There are some similarities between Mr Reavy's product and the contested design: they are both comprised of copper pipes, with two parallel uprights joined by a horizontal pipe at the top, which curves at the corners; two protrusions at the back of the uprights; and, two sets of paired protrusions at the front of the uprights which curve upwards at their ends, being roughly at the bottom and halfway up the uprights. However, there are also notable differences between them. It suffices for present purposes to list the main differences, which are:

- The base of the contested design forms an enclosed rectangle which is flush to the surface upon which the stand is situated. The base of Mr Reavy's product

is not enclosed, consisting of two parallel legs, with curved 'feet', which are raised from the surface upon which the stand is situated.

- Towards the top of Mr Reavy's product, there are two straight prongs, projecting at roughly 45 degrees in each direction from the two upright pipes. The contested design has two prongs which are curved upwards at their ends, projecting at 90 degrees from the two uprights.
- The sections of Mr Reavy's product which join the copper pipes together are ridged; they are not ridged in the contested design.
- The copper in Mr Reavy's product is highly polished, whilst that in the contested design is of a duller finish.

17. Despite the good degree of design freedom (a point in Mr Reavy's favour), I find that the overall impression of the contested design on the informed user differs from Mr Reavy's image (i) (the purported prior art). The contested design had individual character at the relevant date compared to image (i).

18. I turn now to the contested design and the other of Mr Reavy's products.

Contested design



Mr Reavy's image (ii)



19. The contested design and Mr Reavy's image (ii) are both comprised of copper pipes, and both have two parallel uprights joined by a horizontal pipe at the top, which curves at the corners. Both also have a pair of parallel protrusions at the base, which protrude at a 90 degree angle to the uprights and which curve upwards at their ends.

The main differences are:

- The base of the contested design forms an enclosed rectangle which is flush to the surface upon which the stand is situated. The base of Mr Reavy's product is not enclosed, consisting of two parallel legs, with curved 'feet', which are raised from the surface upon which the stand is situated.
- The contested design has two prongs which are curved upwards at their ends, projecting at 90 degrees from towards the top of the two upright pipes. There are no such prongs in towards the top of Mr Reavy's image.
- There is a single curved pipe which extends upwards from the middle of the top horizontal section of Mr Reavy's image, which then extends at a 90 degree angle to the top section. There is no such component of the contested design.
- The two parallel uprights in Mr Reavy's image appear to be shorter than the parallel uprights in the contested design.
- The contested design has two sets of paired protrusions at the front of the uprights which curve upwards at their ends, being roughly at the bottom and halfway up the uprights. Mr Reavy's image only has one pair, towards the bottom of the uprights.
- The sections of Mr Reavy's product which join the copper pipes together are ridged; they are not ridged in the contested design.
- The copper in Mr Reavy's product is highly polished, whilst that in the contested design is of a duller finish.

20. I find that the overall impression of the contested design on the informed user differs from Mr Reavy's image (ii) (the purported prior art). The contested design had individual character at the relevant date compared to image (ii).

21. Therefore, I find that the overall impression of the contested design on the informed user differs from the images which Mr Reavy has filed as purported prior art.

The contested design had individual character at the relevant date. This means that the application for invalidation fails for this reason, in addition to the reason explained earlier in this decision; i.e. lack of evidence of prior art.

Outcome

22. I find that design registration number 6123801 had individual character when it was filed and is, therefore, validly registered. The application for invalidation of the registered design fails.

Costs

23. Mr Smith has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 2 of 2016. As Mr Smith 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 opposition. It was made clear to Mr Smith that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”.²

25. Since Mr Smith did not respond to that invitation within the timescale allowed (nor has any response been received from him prior to the date of the issuing of this decision), and as Mr Smith has not incurred any official fees in defending his design registration, I make no order as to costs.

Dated this 20th day of January 2022

Judi Pike

For the Registrar

² By way of a letter dated 28 October 2021.