

O/0117/23

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NOS 90082859930001, 90082859930002,
90082859930003, 90082859930004, 90082859930005 &
90082859930006**

IN THE NAME OF KAI COLLECTIVE LTD

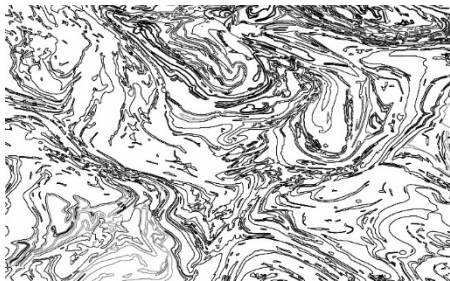
AND

**APPLICATIONS FOR INVALIDATION THEREOF NOS 96/21, 98/21,
99/21 100/21, 101/21 & 102/21
BY HONEYGIRL CO LTD**

BACKGROUND AND PLEADINGS

1. These proceedings concern the applications by Honeygirl Co Ltd (“the applicant”) for a declaration of invalidity of six UK registered designs owned by Kai Collective Ltd (“the registered proprietor”). As a result of the registered proprietor’s Registered Community Designs Nos 8285993-0001 to 8285993-006 being protected at the end of the Implementation Period (11pm on 31 December 2020), the UK registered designs at issue were created pursuant to Article 54 of the Agreement on the Withdrawal of the United Kingdom from the European Union. The designs have the same legal status as if they had been applied for and registered under UK law and retain their original filing dates. All the designs were filed in Class 32, Sub-class 00 of the Locarno Classification (Graphic Symbols and Logos, Surface Patterns, Ornamentation) on 26 November 2020, which is the relevant date for these proceedings. They were registered with effect from that date and are depicted in the following representations:

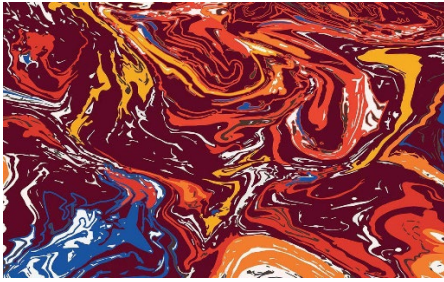
No. 90082859930001 (“the 001 design”)



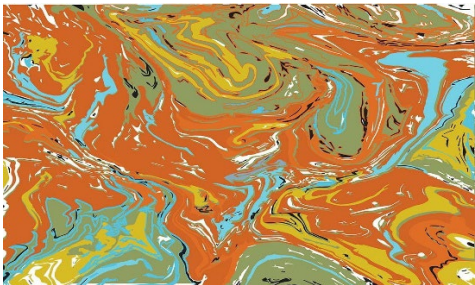
No. 90082859930002 (“the 002 design”)



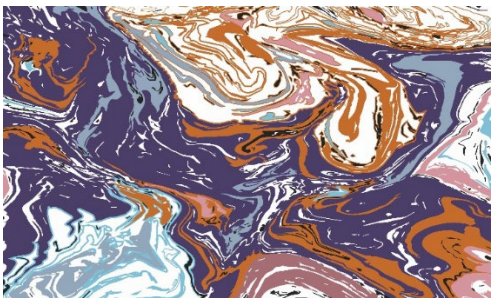
No. 90082859930003 (“the 003 design”)



No. 90082859930004 (“the 004 design”)



No. 90082859930005 (“the 005 design”)



No. 90082859930006 (“the 006 design”)



2. The differences in the designs come down to the shading and colour used.
3. On 10 January 2022, the applicant made applications for the registered designs to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the designs did not meet the requirements of section 1B of the Act that a design shall be new and have individual character. The applicant provided details of over 50 separate designs which it claimed were made available to the public before the application date for the registered designs and which either differed only in immaterial details or gave the same overall impression as the contested designs.
4. The registered proprietor filed a defence and counterstatement to all the applications for invalidation on 8 May 2022, denying the applicant’s claims.
5. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Lawrie IP Limited and the registered proprietor by Dynham.

Evidence and Submissions

6. The applicant also filed evidence during the evidence rounds. This comes in the form of witness statements dated 9 August 2022 from Rachel Denholm, a Chartered Trade Mark Attorney at Lawrie IP. These are vehicles for exhibiting evidence of the disclosure of all the claimed earlier designs.
7. The proprietor filed brief submissions during the evidence rounds. These are dated 20 September 2022 and are entitled “Counterstatement”.
8. The applicant filed written submissions in lieu of requesting a hearing. These are dated 14 November 2022.
9. I shall not summarise the evidence and submissions here but refer to it where appropriate during the course of my decision.

DECISION

10. 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”.

11. 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 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 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.

...”

The Contested Designs

12. In *Sealed Air Limited v Sharp Interpack Limited & Anor*, [2013] EWPC 23, Birss J (as he then was), sitting as a judge of the Patents County Court, said that

“... in my judgment the determination of what design is actually registered is a matter for the court. Once the design has been identified, then questions of overall impression and so on are matters to be decided by reference to the informed user”.¹

13. The representations of the design are all rectangles containing a marbled pattern. There is nothing to tell me whether the rectangular shape is part of the design or rather a convenient way of depicting the design for the purposes of the registration. In this decision, I shall not take account of the rectangular border and proceed on the basis that the designs consist of the lines, shapes and colours shown in the rectangles. This is because the design is for a pattern that could be applied to a product of any shape. The prior art could therefore be relevant, provided that the pattern shown within the rectangular border of the registered designs, or a pattern creating the same overall impression, would have been perceptible to the relevant informed user from the prior art.

14. Four of the contested designs are in colour, while the first is a line drawing and the second contains shading in greyscale. In *Magmatic Ltd v PMS International Ltd*, [2016] UKSC 12, the Supreme Court stressed that “... *an applicant should appreciate that it will almost always be those images [i.e. the representations] which exclusively identify the nature and extent of the monopoly which he is claiming*”.² The 001 design is

¹ Paragraph 20.

² Paragraph 31.

therefore the pattern resulting from these lines and I shall therefore disregard the particular colours shown in the prior art. The 002 design may appear in different colours but the tonal variation would have to be the same. Again, I shall disregard the particular colours shown in the prior art, except to the extent they confirm or contradict the tonal variation shown in the registered design. Colour will, of course, be a relevant consideration for the remaining designs.

15. At this point, I want to say something about the orientation of the representation. The General Court (“GC”) stated that the overall impression of a design must be determined in the light of the manner in which the product at issue is used, including the handling to which the product is normally subject: see *Shenzhen Taiden Industrial Co. Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-153/08, paragraph 66.³ A pattern can frequently be viewed from multiple angles, for instance, when applied to a scarf or a rug. I shall bear this in mind when making my comparisons and not regard the orientation of the representation as excluding the relevance of prior art, provided that it could be viewed from multiple angles, including the orientation shown in the registered designs.

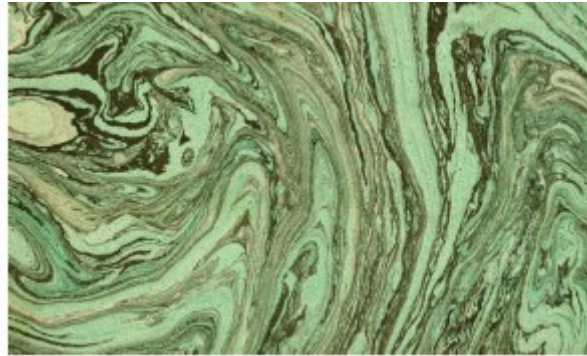
The Prior Art

16. The claimed prior art includes examples of marbled patterns used in books, paper, fashion, homewares and art. In *Senz Technologies BV v OHIM*, Joined cases T-22/13 and T-23/13, the GC held that “A design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure.”⁴ Where I refer to an earlier design for the purposes of comparison, I will set out what the evidence tells me about its disclosure. I remind myself that a qualifying disclosure is one where none of the exceptions set out in section 1B(6) of the Act applies.

³ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the Brexit transition period. The provisions of the Registered Designs Act 1949 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the design case law of the EU courts.

⁴ Paragraph 26.

17. The earliest design was used in a book entitled *Recebimiento que hizo la mvy noble y muy leal ciudad de Seuilla* by Juan de Mal Lara, produced in Spain in 1570. The evidence given of the disclosure is an entry from Wikimedia Commons showing the image reproduced below and giving bibliographic details of the book.⁵



18. One of the exceptions in section 1B(6) applies where a design could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the UK and EEA and specialising in the sector concerned (sometimes called the “obscure disclosures exception”). The sector concerned is the sector of the alleged prior art: see *Green Lane Products Ltd v PMS International Group Ltd* [2008] EWCA Civ 358, paragraph 79; *Easy Sanitary Solutions BV v European Union Intellectual Property Office*, Joined Cases C-361/15 P and C-405/15 P, paragraph 96. In the case of the design shown above, that would be book design. The prior designs adduced by the applicant are drawn from a wide range of different sources, some of which (such as newspaper websites) are likely to be more accessible, and accessed, than others. Nevertheless, the registered proprietor has not claimed that any of these prior designs are caught by any of the exceptions, including the obscure disclosures exception. Arnold J (as he then was) held in *Magmatic Limited v PMS International Limited* [2013] EWHC 1925 (Pat) that the burden of proof lay with the party alleging that the exception applied.⁶ Consequently, provided that the applicant has filed evidence to show that the design has been disclosed before the relevant date, I will accept it as prior art.

⁵ Exhibit RD2, pages 1-2.

⁶ Paragraph 41. This part of the decision was unchallenged on appeal.

19. What is apparent from the evidence is that there are different forms of marbling. As well as the swirling pattern shown above, the prior art includes the following:

- patterns that replicate the veining in natural marble, as used, for example, on this Balenciaga satchel bag:⁷



- feathered patterns:⁸



- pebbled effects, as in the boxes second from the top and at the bottom from Matches Fashion:⁹

⁷ Exhibit RD1, page 26.

⁸ Exhibit RD1, page 29.

⁹ Exhibit RD1, page 27.



20. The submissions concerning each of the invalidation applications contain a selection of the more than 50 examples of prior art. However, the applicant submits that each of the earlier designs shown in evidence is identical to, or creates the same overall impression as, the contested design. In making my comparisons, I will take the applicant's selections as my starting point on the basis that these are likely to represent what the applicant believes to be its best cases, but I shall also include other examples where I see fit.

Novelty and Individual Character

21. A design may not be registered if it is not new and/or does not have individual character.

22. 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:

“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.”¹⁰

23. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

- (a) the degree of the informed user’s awareness of the prior art and
- (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

- (a) the sector in question,
- (b) the designer’s degree of freedom, and
- (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

¹⁰ Paragraph 26.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

24. I also bear in mind the comments of HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“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.”¹¹

The industrial sector

25. The applicant submits that the industrial sector is very broad. I agree. All the contested designs are for patterns that could be applied to the surface of a wide range

¹¹ Paragraph 58.

of different products, including clothing, furnishings, homewares, printed matter, and so on.

The informed user

26. In *Samsung*, 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)."

27. The informed user is an individual who is interested in the ornamentation used on products. They will be interested in surface design and pay a relatively high degree of attention when looking at patterns. They will know about the history of design and be aware that marbling patterns have been used previously on a variety of products, but will not be a professional designer or someone who uses marbling techniques themselves. The applicant submits that the informed user will not examine the exact pattern formations in great detail, particularly where those patterns are irregular or inspired by nature, "*given patterns in nature are unique and vary slightly on each occasion*".¹² I do not consider that this is a point I can accept without evidence to support it, and I have none before me. I will therefore apply the case law I have already cited and find that the informed user would pay attention to the details of the design, but not subject to them to a forensic analysis.

The degree of design freedom

28. The designer of a pattern or ornamentation has a huge degree of design freedom. They can use any combination of lines, shapes and colours, and there are no technical constraints limiting their choices. Even within the corpus of marbled patterns, the evidence demonstrates that designers can choose between a range of different types of marbling and colour combinations.

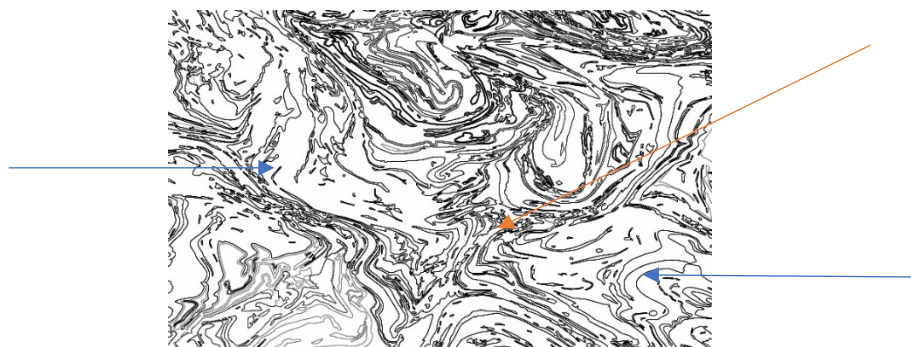
¹² Written submissions, paragraph 18.

Comparison of the Designs

Registered Design No. 90082859930001

29. The registered proprietor submits that *“The patterns, swirls, colours, gradient, tone in the designs as registered are significantly different to the comparable earlier designs”*.¹³ For the reasons I have already explained, the colours are not relevant to this particular comparison, although I will take account of them when I consider the third, fourth, fifth and sixth contested designs. The registered proprietor does not elaborate further on how it believes any of the earlier designs differ from the contested designs.

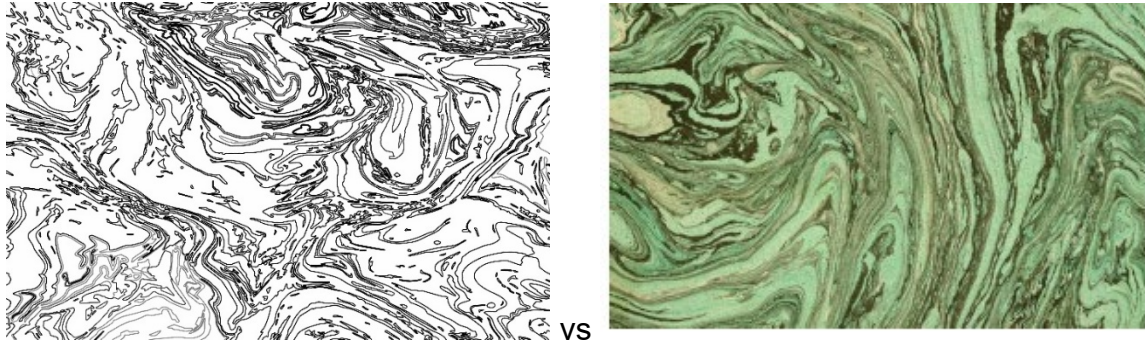
30. The pattern of the contested design consists of swirling lines producing a marbled effect. Sometimes, these lines are close together, for example in the upper right-hand corner; elsewhere, they are further apart. The lines themselves appear in various shades, from light (bottom, mid-left) to dark (top, right). In a diagonal line from the top left to the bottom right, there can be seen what appear to be two fairly large irregular shapes with expanses of white (although I accept these could be any colour), within which there are lines or smaller shapes. I have marked these with blue arrows below.



31. The combination of these shapes and the lines between them, in my view, results in the focus of the design being slightly off centre, marked above with an orange arrow. The eye is drawn to this part of the design.

¹³ Written submissions, entitled “Counterstatement”, paragraph 2.

32. The applicant highlights four examples of prior art, the first of which is the design from the book shown in paragraph 17 above. I reproduce it here for ease of comparison.



33. I remind myself that for the purposes of this comparison I will ignore the colours used in the earlier design. This design consists of swirling lines with some very roughly vertical lines just right of the middle. Incomplete elliptical shapes can be seen on the left of the design. From the bottom right, the lines rise to a peak towards the top of the design, while there are a further two peaks in the middle. The direction and energy of the design is towards the top. This design does not contain the larger shapes identified above with the arrows and I consider that this difference would not go unnoticed. I find that the 001 design is not identical to this prior art.

34. In the context of an assessment of the individual character of the contested design, the applicant refers me to the decision of the GC in *Kwang Yang Motor Co Ltd v OHIM*, Case T-10/08, in which the court said:

“Therefore, the greater the designer’s freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer’s freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion

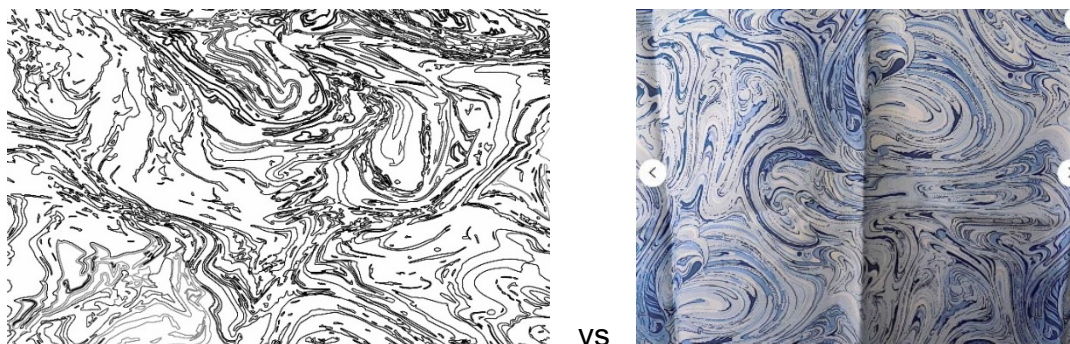
that the designs which do not have significant differences produce the same overall impression on an informed user.”¹⁴

35. I have already found that the designer had a significant degree of freedom in developing the contested design. However, I consider that the differences outlined above are more than minor and I find that the 001 design has individual character when compared with this earlier design.

36. The next earlier design is a scarf by Diane Von Furstenberg which was offered for sale as a vintage piece on etsy on 9 March 2018. The listing states that it originally dates from the 1970s.¹⁵ It qualifies as a prior disclosure.



37. The applicant has also provided a magnified version of this design:¹⁶



38. I take it that the small circles with arrows are not part of the earlier design, but instead enable the internet user to move between different views of the product.

¹⁴ Paragraph 33.

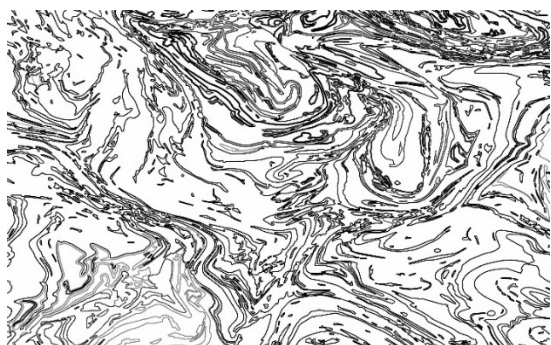
¹⁵ Exhibit RD2, pages 9-10.

¹⁶ Exhibit RD1, page 4.

39. The pattern on the scarf is marbled, and overlaid with the borders of a square, which themselves have borders on either side. I shall base my comparison on the background marbled pattern, which contains swirling lines, some of which curve round to form C-shaped curls. The use of darker lines at the edges of these curves emphasises their role in the design as a whole. They are the most striking parts of the marble pattern and have no counterpart in the 001 design. I find that the designs are not identical and their overall impressions are different.

40. The third earlier design is found on grey marbled print “So Kate” high-heeled shoes from the designer Christian Louboutin. The applicant states that these were disclosed since at least as early as 21 July 2015. The evidence is an undated screenshot from theluxurycloset.com, and information from an image search on the Bing search engine which purports to show that the image of the shoes first appeared online on or before 21 July 2015.¹⁷ These are not the same shoes. The shoes featured on the image search are described as “Pigalle Follies Marble Swirl”. I have no evidence, then, that the grey marbled So Kate shoes were disclosed before the relevant date.

41. The fourth, and final, earlier design featured in the applicant’s submissions is a marbled rug, which was first disclosed at least as early as 1 July 2019 on the RugsUK.com website.¹⁸ This time the product shown on the Bing image search is the one relied on.



vs



42. The earlier design contains large shapes within which can be found smaller shapes and lines, as in the contested design. These are, however, configured differently in the

¹⁷ Exhibit RD3, pages 79-80.

¹⁸ Exhibit RD4, pages 100-102.

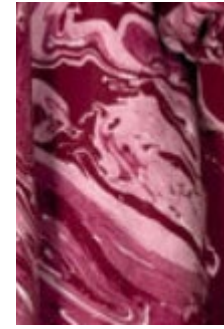
earlier design, with one above the other, and a darker shape in between. Towards the top of the earlier design is an arrangement of lines and shapes that bears some resemblance to a face (shown by the arrow). The designs are not, therefore, identical. The configuration of the large shapes and the face-like shape in my view gives the earlier design a different overall impression than the contested design.

43. I have carefully looked through the remaining prior art to see whether any of them warrant a closer comparison. I have discounted those patterns that are not swirls, because the contested design is a line drawing, and the swirling lines are the only features to take into consideration. I shall compare the contested design to the dress shown below. The short description of the webpage indicates that the dress was disclosed at least as early as 2018.¹⁹



44. The pattern on the dress is marbled, consisting of swirling lines and shapes of different widths and shades. The informed user will observe that some of the larger shapes contain smaller shapes or lines, as shown in the magnified sections below:

¹⁹ Exhibit RD4, pages 158-162.



45. The next question is whether parts of the dress’s pattern, such as those shown above, could amount to a prior disclosure separate from the entire pattern. In *Karen Millen Fashions Ltd v Dunnes Stores & Anor*, Case C-345/13, the Court of Justice of the European Union (“CJEU”) said:

“The reference to the overall impression produced on the informed user by ‘any design’ which has been made available to the public indicates that article 6 must be interpreted as meaning that the assessment as to whether a design has individual character must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously.”²⁰

46. From this case, I take it that a part of a pattern must be clearly discernible if it is to be relied on as acceptable prior art. In identifying the parts of the pattern to magnify, I examined the image of the dress very closely. I have already cited the case law that says that the informed user will look at the detail of the design, but not subject it to minute scrutiny.²¹ In my view, identifying the elements of the patterns above and comparing them to the contested design requires a greater level of attention to the small details of a pattern than is to be expected even from an informed user. Neither the pattern as a whole, nor readily discernible details, create the same overall impression on the informed user as the contested design.

²⁰ Paragraph 25.

²¹ See paragraph 24 above.

47. I do not consider that the applicant's case is improved by any of the other designs shown in the evidence. The application for a declaration of invalidity against the 001 design has failed.

Registered Design No. 9082859930002

48. The representation of the 002 design (see paragraph 50 below) is in greyscale, showing contrasting lines and different shapes producing a swirling marbled effect. The dark shapes are arranged largely diagonally from top left to bottom right. Within the very dark shapes can be seen pale lines and small shapes. Further lines and shapes appear to be in less pale shades or midtones. As with the first contested design, I shall disregard the particular colours shown in the prior art.

49. In its submissions, the applicant gives the same examples as it did for the application for a declaration of invalidity against the 001 design. I consider that they do not assist the applicant any more in this instance than they did for the first contested design. My attention is drawn towards three other earlier designs, including the dress considered in paragraphs 43 to 46 above. The findings I made there apply equally here.

50. I shall now deal with the example disclosed on Pinterest on or before 12 August 2017, is shown below right: ²²



vs



51. This example is described on Pinterest as "Psychedelic Art" and there is no evidence it has been applied to any product. It is not entirely clear whether a work of

²² Exhibit RD4, pages 88-89.

art can be an earlier design for the purposes of section 1B of the Act, as explained by the editors of *Russell-Clarke and Howe on Industrial Designs*, 10th edition:

“... The disclosure need not be an exposure of an actual product, but could, for example, be a photograph of a product or a drawing of an intended product. However, what if no product at all is involved in the disclosure? For example, a painting is published and the subject of the painting is later applied as surface decoration to a product. Will the earlier publication of the painting as such invalidate the later registered or unregistered right in respect of the picture in the painting applied to the surface of the product? Under the old UK law, to count as prior art the earlier design must have been published ‘in respect of the same or any other article’, so that the publication of a pattern would not invalidate a later design registration if it did not suggest the application of a pattern to an article at all. Although the law has been changed so that a design right now covers any product, rather than a specific article, it would seem that similar logic ought still to apply under the new law when an earlier publication does not relate to any product at all.”²³

52. An earlier design does not have to be applied to a product in the same sector as the contested design to destroy novelty: see *Easy Sanitary Solutions BV*, paragraphs 89-96. It does, however, need to be a design, which is defined by the Act as “*the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation*”.²⁴ Bearing in mind, the commentary reproduced above, I find that the marbling pattern shown in paragraph 50 above is not acceptable prior art.

53. However, even if I were to consider that in principle the artwork shown above could invalidate a later design registration, I find that it creates a different overall impression from the 002 design. As it is a work of art, I shall assume that under normal use it is viewed as it appears in the image I have reproduced and not in any different

²³ Section 2-123.

²⁴ Section 1(2).

orientation. A dark shape is to be found in the middle of the artwork, aligned roughly vertically. To its right is a thin light line starting from the top and ending around two-thirds of the way down. The very darkest parts of the pattern are small shapes distributed all over the image. The pattern of swirling lines is also different,

54. I consider the same applies in the case of the applicant's other new example. This is the following marble pattern disclosed on the website of an Australian artist in 2012, but the provenance of which is unknown.²⁵ It is not stated anywhere that the pattern has been applied to a product, but even if that is not a barrier to the pattern being identified as a prior design, I find that the overall impression it creates is different from that of the 002 design. The pattern of tonal variation is different.



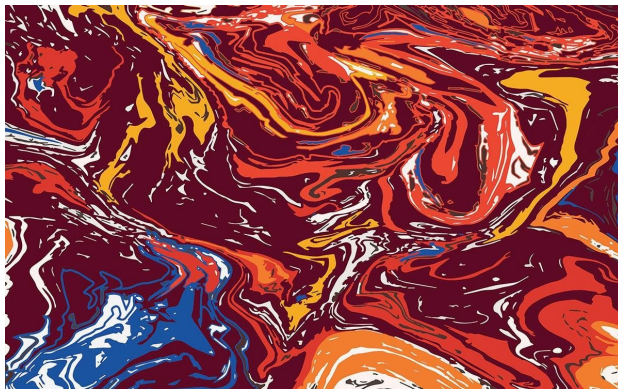
55. In my view, the applicant's case is not improved by any of the other designs shown in the evidence. The application for a declaration of invalidity against the 002 design has failed.

Registered Design No. 90082859930003

56. The 003 design is shown in colour and can be seen in the following paragraph on the left. The different colours (dark blue, yellow, orange, red, burgundy and white) make a significant contribution to the overall impression of the design. Therefore, for the first time in my comparisons, the colour of the earlier designs will be important.

²⁵ Exhibit RD3, pages 54-59.

57. The first example that the applicant draws to my attention is marbled paper taken from the Manly Palmer Hall collection of alchemical manuscripts, held at the Getty Research Institute. Wikimedia Commons screenshots provide bibliographic data and suggest that the manuscript from which the paper comes dates from 1600. The flickr image was posted on 30 July 2014.²⁶ This is shown below on the right:



vs



58. It will immediately be apparent that the earlier design has a more restricted colour palette, resulting in the designs having different overall impressions.

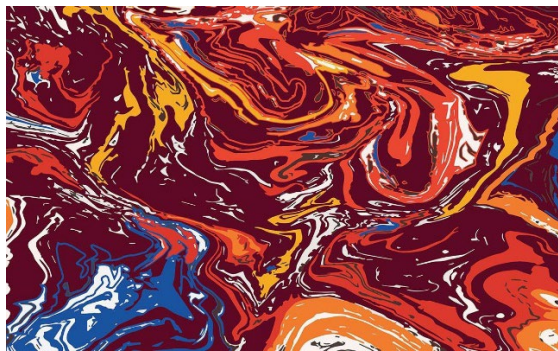
59. The same considerations apply with respect to the marbled paper disclosed in 1650 and published in *A ternary of paradoxes: the magnetick cure of wounds, nativity of tartar in wine, image of God in man*.²⁷ There are significant differences in colour and in the arrangement of the lines.



²⁶ Exhibit RD1, pages 3-4.

²⁷ Exhibit RD1, pages 5-6.

60. The next example is another marbled design applied to paper. The evidence says that it dates from the 19th century. It appears on a blog called “BibliOdyssey” and the post was published on 26 November 2010.²⁸ The colour palette is more subdued than in the contested design and the pattern contains a rippling effect which makes the design appear in places to be pleated. I find that the designs are not identical and create different overall impressions.



vs



61. The design shown below was used in a book published on 1 March 2014 by Rizzoli International Publications.²⁹ The screenshot in the exhibit is from a US bookshop and does not show the full images that are present in the index in Exhibit RD1.³⁰ It is not clear how widely available this book was in the United Kingdom and the European Economic Area (EEA). The bookshop entry states that the volume contains a restored DVD version of the film “*available exclusively in the US as part of this book*”. However, the test is not whether the design was available in the UK and EEA, and I remind myself that the registered proprietor has not claimed that any of the exceptions apply.

²⁸ Exhibit RD2, pages 14-23.

²⁹ Exhibit RD3, pages 63-64.

³⁰ Page 20.



vs



62. The designs are not identical. The earlier designs contain a larger proportion of dark blue than the 003 design, with the upper of the earlier designs having a large patch of white in the centre of the pattern. These different proportions of colour in my view result in different overall impressions of the designs. The blue a major element of the earlier design, while in the 003 design it is largely confined to the bottom left-hand corner and appears as more of an accent. The arrangement of the swirling lines is also noticeably different.

63. Moving away from marbled paper, the applicant draws my attention to a marbled pattern on a dress designed by Stella McCartney for her Autumn/Winter 2012 collection. It is shown on the fashiongonerogue.com website.³¹ The pattern on the dress is largely orange and white. I accept that it is possible that there may be some different colours just below the front neckline of the dress, but the resolution of the image is such that I cannot say this with any certainty. The designs are not identical and in my view they do not create the same overall impression, given the differences in colour.

³¹ Exhibit RD2, page 44.



64. The next example is a lampshade available on the Wolf & Badger website and priced in sterling.³² According to the Bing search engine, the image first appeared online on or before 21 July 2020.



It is apparent that the use of colour differs significantly between the designs. The overall impression of the earlier design is of a predominantly pale exterior, with some darker swirls as contrast, and a bright red interior. The interior is not marbled so it is the exterior that is the relevant comparison. The 003 design is predominantly dark. The designs are not identical and nor do they create the same overall impression.

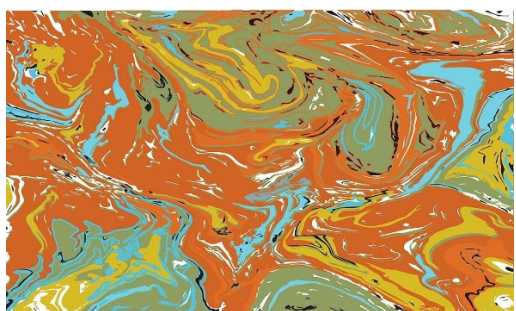
³² Exhibit RD4, pages 119-121.

65. The final example is the orange art work shown in paragraph 50 that I found to be unacceptable as prior art. If it is acceptable prior art, the differences in colour and arrangement of lines are sufficient for it to create a different overall impression from that of the 003 design.

66. In my view, the applicant's case is not improved by any of the other designs shown in the evidence. The application for a declaration of invalidity against the 003 design has failed.

Registered Design No. 90082859930004

67. The 004 design consists of the swirling lines of the 001 design shown in orange, pale green, light blue, amber and white. The applicant draws my attention to the Berretti Florentine marbled paper shown below on the right and which appears to have been pinned to a Pinterest board at least five years before the date of the Bing search. It is described as a green and orange straw blown pattern.³³ This is a feathered pattern, rather than a swirl and the light green is the dominant colour, with orange providing the highlights. In my view, it is the orange band that is the dominant feature of the 004 design, and so I find the designs are not identical and do not create the same overall impression.



vs

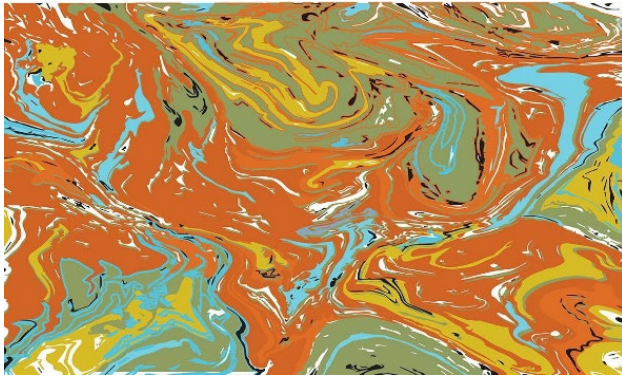


68. The next example I shall consider is the lampshade shown below on the right that was available on the Wolf & Badger website on or before 10 October 2020.³⁴ The

³³ Exhibit RD4, pages 141-142.

³⁴ Exhibit RD4, pages 122-124.

marbled design consists of swirls in orange, yellow and black, with pebble-like shapes in a light pinkish-brown. The colour palette is therefore different from that of the 004 design. I find that the designs are not identical and do not create the same overall impression.



vs



69. The remaining examples are the orange images shown in paragraphs 50 and 54 above, which I have already dismissed as not being acceptable prior art, and the images shown below. The first, “Orange Marbles”, was disclosed on the website deviantart.com on 3 November 2006.³⁵ The second appears on the same website as the image in paragraph 54.³⁶ There is no indication that either has been applied to a product and so I find they are not acceptable prior art. In any case, the colour arrangements and pattern of lines are different from those in the 004 design.



³⁵ Exhibit RD2, pages 24-25.

³⁶ Exhibit RD3, page 56.

70. In my view, the applicant's case is not improved by any of the other designs shown in the evidence. The application for a declaration of invalidity against the 004 design has failed.

Registered Design No. 90082859930005

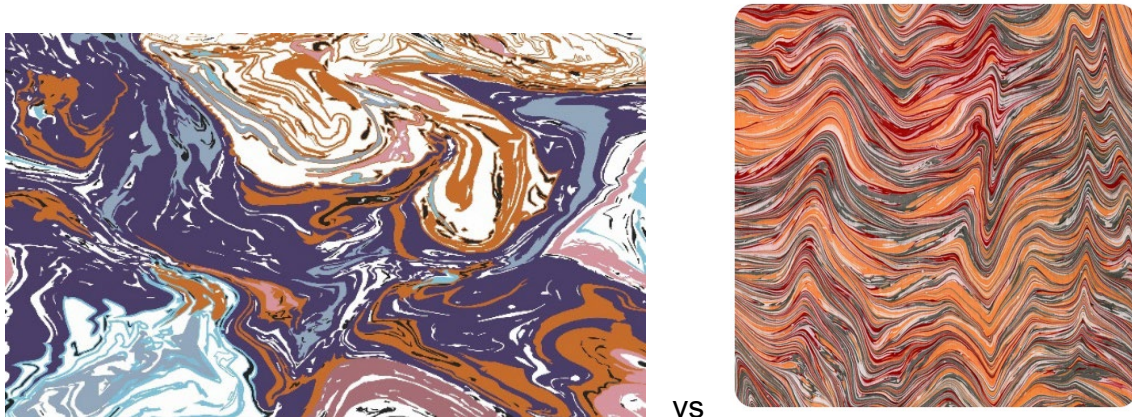
71. The 005 design consists of the swirling lines of the 001 design shown in dark and light blue, dark orange, pink, grey-blue and white. The first example the applicant highlights is a blouse sold by House of Fraser and shown in an article from Mail Online dated 31 May 2012.³⁷ The pattern on the blouse is formed by fluid vertical stripes in mid and light blue, orange and white, while at the right side of the image, there are swirls in the same colours. This different configuration would be noticed, and so I find that the designs are not identical.



72. When it comes to considering whether the designs create the same overall impression, I face the same issue as I did when I compared the 001 design to the dress in paragraphs 44 to 47 above. I must decide whether a pattern that creates the same overall impression as the 005 design is present in the earlier design. The stripes of colour in the earlier design for the most part lack the contested design's smaller lines and shapes in contrasting colours. This is particularly noticeable in the white shapes, with the colours therefore appearing more distinct than in the 005 design. I find that the designs do not create the same overall impression.

³⁷ Exhibit RD3, page 52.

73. The next example is the Berretti Florentine marbled paper shown below on the right and which appears to have been pinned to a Pinterest board at least five years before the date of the Bing search. It is described as a red and orange straw blown pattern.³⁸ While both designs feature the colour orange, the rest of the colour palette is different. In addition, the earlier design is a feather pattern, while the contested design is a swirled pattern. I find that the designs are not identical and do not create the same overall impression.



74. The applicant also directs my attention towards the rug shown in paragraph 39 above and the end papers and sleeve of the book shown in paragraph 61. The combinations of colours are noticeably different. The designs are not identical and do not create the same overall impression.

75. In my view, the applicant's case is not improved by any of the other designs shown in the evidence. The application for a declaration of invalidity against the 005 design has failed.

Registered Design No. 90082859930006

76. The 006 design consists of the swirling lines of the 001 design shown in different shades of red and black. The applicant draws my attention to the marbled paper taken from the Manly Palmer Hall collection of alchemical manuscripts that I considered in paragraphs 57 and 58 above. I can see some similarities in the colours used, with

³⁸ Exhibit RD4, pages 145-146.

blacks and reds of varying shades. The 006 design, however, still retains that central diagonal band which has no counterpart in the earlier design, which has an upward movement. I find that the designs are not identical and to my mind they do not create the same overall impression.



vs



Shown as a side view:



77. The next example is red plume agate marbled paper produced by Jemma Lewis Marbling and Design and disclosed on the designer's website on or before 27 June 2019.³⁹ The marbling in this pattern contains various shades of red and pink arranged in relatively thin swirling lines, but the speckled effect of the 006 design is absent. The designs are not identical and they do not create the same overall impression.

³⁹ Exhibit RD4, pages 97-99.



78. The remaining examples that the applicant highlights are the pleated-effect paper and the dress I considered in paragraphs 60 and 44 to 46 respectively. In my view, neither these, nor the other patterns in the evidence, improve the applicant's case, particularly in the light of the different colours and effects. The application for a declaration of invalidity against the 006 design has failed.

OUTCOME

79. All the applications for invalidity have failed and Registered Design Nos. 9008285993001-6 remain registered.

COSTS

80. The registered proprietor has been wholly successful and is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 2/2016. In calculating an appropriate award, I have taken account of the shortness of the counterstatements and submissions filed by the applicant, the level of generality of these, and the fact that they are identical across the proceedings. I award the applicant the sum of £500 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing statements and considering the other side's statements: £200

Considering and commenting on the evidence: £300

TOTAL: £500

81. I order Honeygirl Co Ltd to pay Kai Collective Ltd the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 3rd day of February 2023

Clare Boucher

For the Registrar,

The Comptroller-General