

**BL O/0120/23**

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

**IN THE MATTER OF REGISTERED DESIGN No. 6132673**

**IN THE NAME OF LANXI YICHAO ELECTRONIC BUSINESS COMPANY LIMITED**



**AND**

**THE APPLICATION FOR INVALIDATION THERETO (No. 82/21)**

**BY LIMAR TRADING LIMITED**

## Background and pleadings

1. Lanxi Yichao Electronic Business Company Limited (“the proprietor”) filed application no. 6132673 for a registered design for a “notebook bag” in Class 03, Sub class 1 of the Locarno Classification (trunks, suitcases, briefcases, handbags, keyholders, cases specially designed for their contents, wallets and similar articles) on 23 April 2021. It was registered with effect from that date and is depicted in the seven representations shown later in this decision.

2. The registration specifies the following disclaimer:

“No claim is made for the colour shown; no claim is made for the material shown.

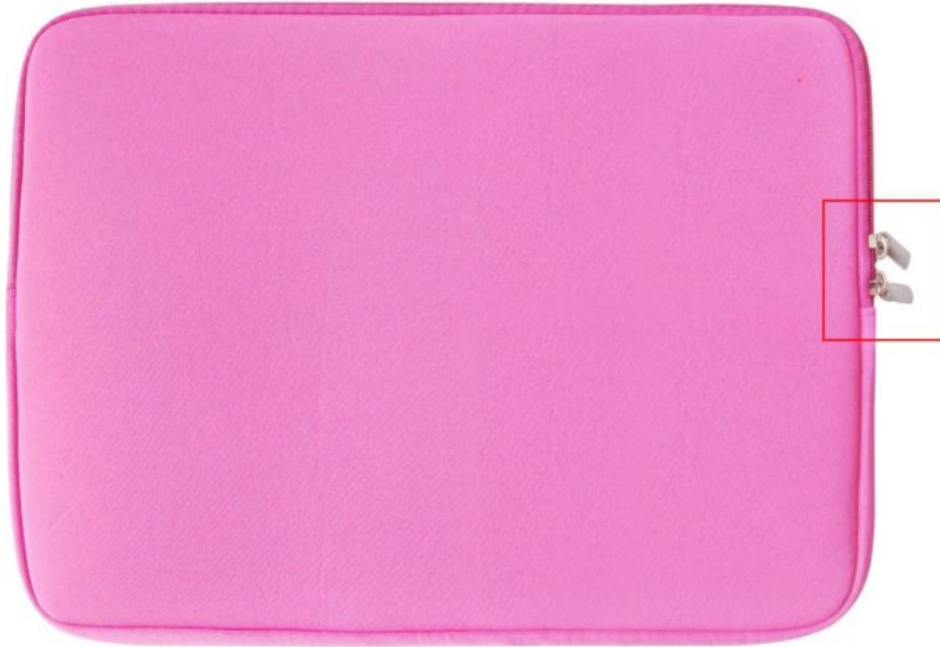
3. On 23 September 2021, Limar Trading Limited (“the applicant”) requested that the registered design be declared invalid under Section 1B/11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”), which requires that a registered design be new and have individual character. The applicant depicts what it claims to be prior art which destroys the novelty of the registered design, as follows:



4. The applicant states that “[the] product subject of the design was available on eBay under item no. 391838017815 in the UK in July 2017. In our evidence we will provide details.”

5. A notice of defence and counterstatement was filed by the proprietor, signed with a statement of truth by Yichao Wang, denying the claim. It is claimed that the contested design is different to the claimed prior art. The proprietor claims that its

design has a different zip, is in multiple colours and sizes, and the internal colour is consistent with the external colour, unlike in the prior art. The following images are provided, reproduced exactly as they appear in the counterstatement:





The pic in eBay ID 391838017815 in the DF19A:

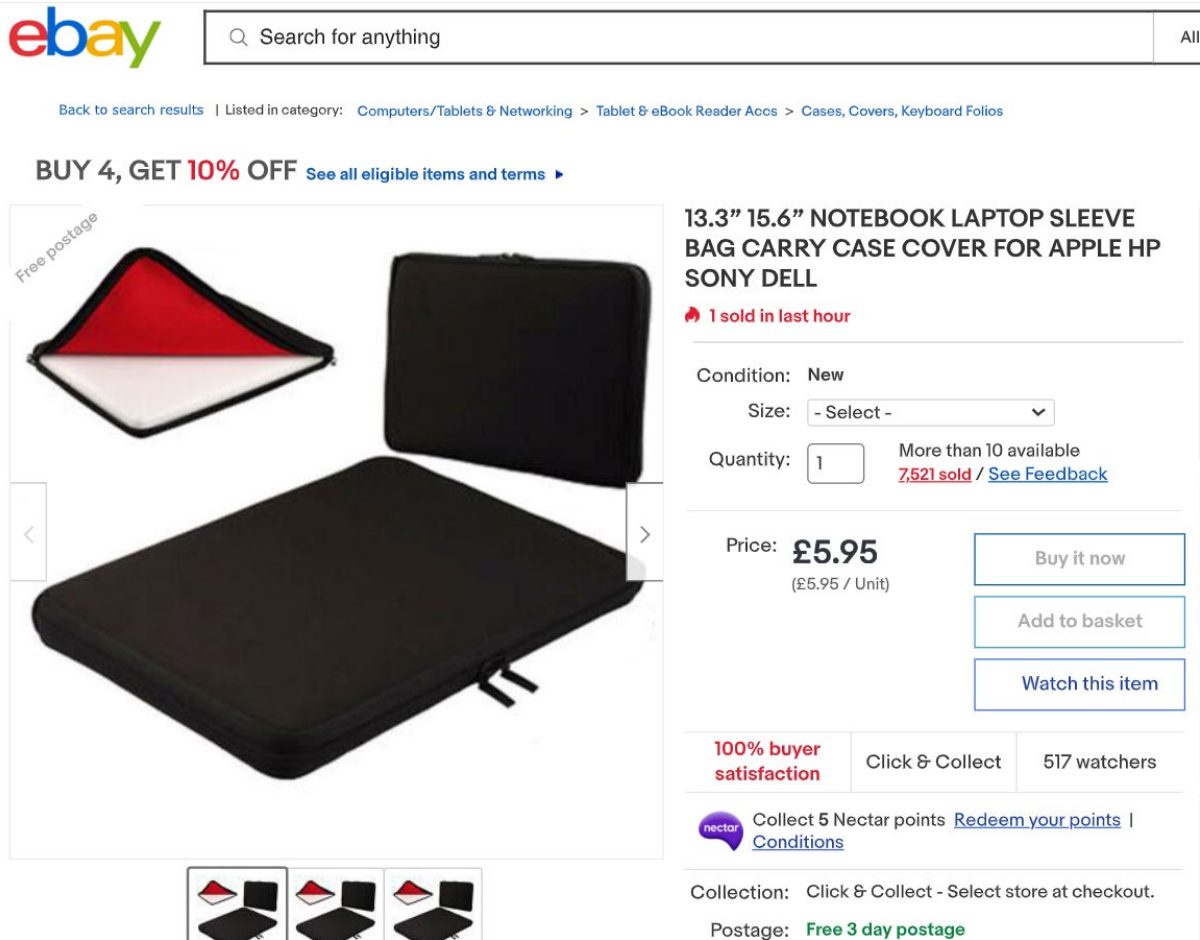


## Evidence

6. The applicant is professionally represented by Wilson Gunn. The registered proprietor represents itself. The proprietor filed a document which was not in correct evidential format because the writer had not been identified and there was no statement of truth, despite the heading of Witness Statement. A preliminary view was given by the Tribunal that the document could be admitted as written submissions and the proprietor was given an opportunity to amend the document to put it into correct evidential form, but did not do so. The document it filed was the same as that described above, in the counterstatement. The counterstatement was signed with a statement of truth and its contents can be treated as evidence, in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 (“the Rules”).

7. The applicant’s evidence was filed by its professional representative, Andrew Marsden who is a Trade Mark attorney at Wilson Gunn. His witness statement is dated 14 April 2022. Mr Marsden states that the information contained in his witness statement is from his own knowledge, or from information which is in the public domain or has been provided to him by the applicant. The purpose of his witness statement

is as a vehicle to adduce a single exhibit comprising 17 pages.<sup>1</sup> The only product image is shown below, for an item which the proprietor also showed in its counterstatement:



Free postage

BUY 4, GET 10% OFF [See all eligible items and terms](#)

13.3" 15.6" NOTEBOOK LAPTOP SLEEVE BAG CARRY CASE COVER FOR APPLE HP SONY DELL

1 sold in last hour

Condition: New

Size: - Select -

Quantity: 1 More than 10 available  
7,521 sold / [See Feedback](#)

Price: **£5.95**  
(£5.95 / Unit)

Buy it now

Add to basket

Watch this item

100% buyer satisfaction

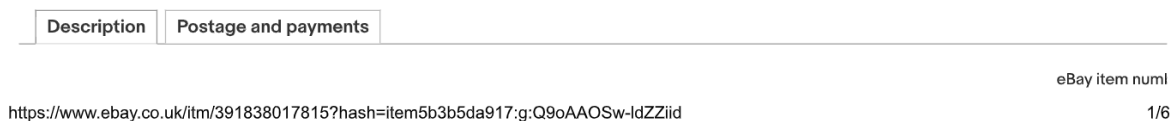
Click & Collect 517 watchers

Collect 5 Nectar points [Redeem your points](#) | [Conditions](#)

Collection: Click & Collect - Select store at checkout.

Postage: **Free 3 day postage**

8. The bottom of the page shows the ebay listing number 391838017815, which is the number identified in the application to invalidate the design:



Description Postage and payments

https://www.ebay.co.uk/itm/391838017815?hash=item5b3b5da917:g:Q9oAAOSw-ldZZiid

eBay item num1  
1/6

9. The ebay listing is undated. However, Mr Marsden exhibits several pages of a revision summary for the listing, which is identified by the above number, 391838017815. I have reproduced an extract from the earliest page below:

<sup>1</sup> Exhibit AM1.



All Categories

[Back to item](#)

## Revision summary for item #391838017815

The following revisions have been made:

Date	Time	Revised Information
12 Jul, 2017	14:53:43 BST	Postage Terms Description Details PictureURL: Pictures Added/Deleted for 13" 13.3" INCH, 15" 15.6" Inch
17 Jul, 2017	22:46:25 BST	Postage Terms Details PictureURL: Pictures Added/Deleted for 13" 13.3" INCH, 15" 15.6" Inch
07 Sep, 2017	18:52:00 BST	Postage Terms Description Details Buy it now price PictureURL: Pictures Added/Deleted for 13" 13.3" INCH, 15" 15.6" Inch Buy it now price for 13" 13.3" INCH Buy it now price for 15" 15.6" Inch
14 Jan, 2018	13:14:36 GMT	Postage Terms Description PictureURL: Pictures Added/Deleted Quantity Details Buy it now price PictureURL: Pictures Added/Deleted for 13" 13.3" INCH, 15" 15.6" Inch Buy it now price for 13" 13.3" INCH Buy it now price for 15" 15.6" Inch

10. The applicant filed the briefest of written submissions with its evidence which, in essence, merely repeat its claim. Neither party requested a hearing and neither filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers.

## Decision

11. 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...”

12. 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) ....”.

13. 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. None of the exceptions apply. This means that the relevant date for my assessment is 23 April 2021.

14. In order for the applicant to succeed in its claim, the applicant’s evidence must show that the claimed prior art pre-dates 23 April 2021. I am satisfied that the product shown in the applicant’s evidence dated from at least the date of the first revision of its listing on ebay, 12 July 2017. The applicant may rely upon the claimed prior art which I will now compare against the contested design registration.

15. 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 date, it cannot be new. The law on overall impression was 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.

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."

16. HHJ Birss QC (as he was then) stated in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat):

“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.”

17. 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 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 laptop/notebook bags or covers. However, I will treat it as a notorious fact that laptops are rectangular in shape and are much thinner than they are wide and long. This would make it difficult for a laptop/notebook bag or cover to be, for example, circular, hexagonal, a cube or a

sphere. I infer that there is a certain amount of design restriction in that bags or covers for laptops are likely to be rectangular and slim.

18. 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 laptop/notebook bags and covers. 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.

19. The respective images to be compared are:

Claimed prior art



Contested design illustrations on the register





20. The proprietor's claim that its design comes in multiple colours and sizes is not relevant to the comparison because it has disclaimed colour and material, and sizes do not feature in the registration.

21. The contested design is rectangular with rounded corners and much slimmer than it is wide and long. It has a padded appearance and a gusset which appears to be stitched only around one side of the design. The zip extends across one length and halfway up each side. The zip has two identical zip tags which are smooth rectangles which appear slightly convex.

22. The claimed prior art is poorly reproduced and there is a single image shown in the evidence.<sup>2</sup>



23. The claimed prior art is also rectangular, much slimmer than it is wide or long, and has rounded corners. It is not possible to see what the contours are like or any detail on the zips. The zips in the contested design have a certain tactile quality to them which is likely to be an aesthetic feature noticed by the informed user. It is not possible

---

<sup>2</sup> The image shown in the application for invalidation is even more poorly reproduced, and is only part of the single image shown in the applicant's evidence.



to see how far around the zip in the claimed prior art extends. The burden of proof is the applicant's: its evidence needs to be cogent and solid. The ebay listing is shown as belonging to the applicant. It could have filed other images of its product but has only filed the image shown in the above screenshot. Given the restrictions on the degree of design freedom, I am not prepared to find on the basis of an image which I cannot see the detail of that the prior art and the contested design produce the same overall impression on the informed user or that the registered design did not have individual character at the relevant date.

## **Outcome**

24. The application for invalidation fails for lack of evidence of prior art. The contested design will remain registered.

## **Costs**

25. The proprietor has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 2 of 2016. As the proprietor is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its 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 the proprietor 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".<sup>3</sup>

---

<sup>3</sup> By way of a letter dated 16 November 2022.

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

**Dated this 3rd day of February 2023**

**Judi Pike**

**For the Registrar**