

1 **REGISTERED DESIGNS ACT 1949 (as amended)**

In the matter of applications under
Section 11(2) by J Howitt & Son Ltd
for cancellation of Registered Designs Nos. 2063717 & 2061816
6 in the name of Megaprint Group Ltd

DECISION

The designs in suit were registered on 16th December 1996 and 28th February 1997 and the
11 article in respect of which each design is registered is a “Folding Card”. The proprietor is
Megaprint Group Ltd.

The statement of novelty in each case is as follows:

16 "The novelty of the design resides in the features of shape and configuration of the article
as shown in the representations."

Representations of the registered designs are shown at Appendix One and Appendix Two.

21 Applications for cancellation were filed on 29th April 1998 by J Howitt & Son Ltd under
Section 11(2) of the Registered Designs Act 1949 (as amended), on the grounds that the
designs were not new or original at the date of registration, that the articles comprised features

solely dictated by the function which the article has to perform, that the designs are the same as a number of previously published designs, and that the design differ from previously published designs only in immaterial details and features which are common variants in the trade. A request was made for costs in favour of the applicant.

Section 1(2) of the Registered Designs Act 1949, as amended, provides:

"A design which is new may, upon application by the person claiming to be the proprietor, be registered under this Act in respect of any article, or set of articles, specified in the application."

Section 1(4) of the Act goes on to say that a design shall not be regarded as new for the purposes of this Act if it is the same as a design registered in respect of the same or any other article in pursuance of a prior application, or published in the United Kingdom in respect of the same or any other article before the date of application, or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

Section 1(1)(b)(I) of the Act states that a design may not include "features of shape or configuration of an article which are dictated solely by the function which the article has to perform."

The proprietors filed counterstatements under Rule 53 on 3rd July 1998, refuting all the above claims and requesting costs in their favour. They also requested that the application be

dismissed on the grounds that the Statement of Case was devoid of any indication of the basis of the application. This request was refused as it was felt that on current practice, the requirements of Rule 52(1) had been met by the Statement of Case, and the applicants were invited to submit evidence in support of their case. On this issue, I would add that over the
51 years a practice has built up whereby a Statement of Case has often been, to a large extent, a recitation of the particular sections of the legislation under which an action was to proceed, with no particularisation of the case. This practice is currently under review by the Patent Office and it is likely that, in future, the recitation of sections of the Act will not be enough to mount an action and it will be necessary for a litigant to provide a degree of particularisation
56 for the other side (and the Patent Office) to have a clear view of the nature of the dispute and have sufficient detail of, for example, the previously published designs or prior art on which the litigant intends to rely.

The applicants filed evidence under Rule 54 on 8th December 1998, comprising a Statutory
61 Declaration by Thomas Graham Hulse of Eversheds. It was claimed that the representations of the registered designs showed merely squares of card with rounded or bevelled corners which are common in the trade, and that the designs lacked eye appeal, having only features which are dictated by function - ie to fold and unfold. Exhibits TGH1 (sample beer-mats) were enclosed.

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The proprietors chose not to submit evidence under Rule 55(1). Rule 55(2) evidence in reply was therefore not applicable but Eversheds requested leave to file further evidence under Rule 56. This was granted and Rule 56 evidence was submitted on 9th June 1999, comprising a

Statutory Declaration by Niall Andrew Head-Rapson of Eversheds. This included Exhibit
71 NAHR1, Patent Application 88201838.5 (published 9.3 89), from which, it was claimed, the
designs were clearly identifiable. Also included at NAHR2 was a photocopy of the “Abbey
National Card” (allegedly published prior to January 1996) which, it was claimed, showed all
the configurations of the designs. At NAHR3 were copies of correspondence which, it was
claimed, showed that the proprietor knew the designs were not new at the time of the
76 application.

The proprietors responded on 9th August 1999, stating that the Rule 56 evidence constituted
mere assertions and opinions, accepting only the prior publication of the Patent Application.
They requested that specific assertions regarding the belief of the proprietors, in particular the
81 last 22 words of paragraph 7 and paragraphs 8 to 10 of Mr Head-Rapson’s Statutory
Declaration of 8th June 1999, should be struck out.

At the hearing before me on 14th January 2000, the applicants for cancellation J Howitt & Son
were represented by their counsel Ms D McFarland assisted by Mr Bruton of Eversheds.

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The proprietors were represented by their counsel Mr G Hamer, assisted by Mr Votier of
Carpmaels and Ransford. Mr D Holberton of Megaprint Group was also present.

The hearing commenced with the consideration of whether the proprietor’s request to strike
91 out specific part of the applicant’s evidence should be considered in a preliminary hearing. At
the request of Ms McFarland and Mr Hamer, I agreed to this issue forming part of the main

hearing, and that it was acceptable for the proprietor's counsel to speak first.

96 **Mr Hamer**, on behalf of the proprietor, referred to the Rule 54 evidence, stating that no prior art had been identified to support the claim that the designs were not new or original, and that the claim that features were dictated solely by function was not valid. He expressed the opinion that Mr Hulse was not an appropriate expert, having no experience or qualifications in the field of expertise under discussion, and that his evidence overlooked material features of the designs - particularly the fold lines, which make a major contribution to the overall appearance of the articles. Mr Hamer then referred to the Rule 56 evidence. He questioned Mr Head-Rapson's suitability as an expert and described his evidence as mere allegations and assertions. He expressed the view that the correspondence failed to support the applicant's claim that the proprietor knew the designs were not new at the time of registration. He drew particular attention to paragraph 8 and the last 22 words of paragraph 7 of the Statutory Declaration, 106 asking that these sections should be struck out.

While Mr Hamer agreed that the one of the drip-mats put forward as prior art bears a resemblance to the first aspect of one of the registered designs, he pointed out that it has no reference to the other aspects or configurations and has no fold lines. He did not dispute that 111 drip-mats of the type claimed as prior art were well established in the public domain prior to the dates of application for the registered designs, but argued that the clear differences in appearance were such that the novelty of the registered designs was not prejudiced.

In considering the Patent specification, Mr Hamer stated that, while the principles of such

116 items may be disclosed in a Patent specification, Design registration is concerned with features of shape and configuration. The Patent specification shows certain shapes and configurations, but not those of the registered designs. The articles shown differ from the registered designs in several respects, in particular the configuration of the fold lines.

121 Mr Hamer stated that the “Abbey National” card also differed materially from the registered designs. The applicants had claimed that this card must have been available before January 1996, but in his view the wording on the card suggested a later publication date, and that publication was limited to Ireland in view of the references to the Bank of Ireland. Mr Hamer concluded that there was no proof of prior publication; the claim that features were dictated
126 by function was not substantiated; and that the designs were different in material details to the registered designs.

Ms McFarland began her submission by addressing the “strike-out” request, which she stressed was only levelled at certain parts of Mr Head-Rapson’s evidence. The proprietors
131 were not, she believed, in a position where they were unable to respond because they knew the case they had to address. She argued that the correspondence proved that the parties were in communication about the allegations of lack of novelty, so they could be in no doubt about the nature of the case; that it was too late in the day to attack the pleading; and that the proprietors had ample opportunity to clear up any doubts in correspondence prior to the
136 hearing and had chosen not to do so. In response to Mr Hamer’s comment that Mr Hulse was not an expert, she stated that the field of trading activity under consideration (paper folding, packaging) did not require any technical expertise. Mr Head-Rapson’s evidence, she claimed, was

based on reasonable assertions and interpretations of established facts, and the proprietors had not established any grounds for striking out.

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Ms McFarland stated that the prior availability of the generic beer-mats was not in dispute. She stressed the need to consider the issue of prior publication by a fair and objective consideration of prior art. She went on to suggest that the beer-mats clearly anticipate the registered designs, particularly as the statement of novelty refers to shape and configuration rather than pattern and ornament. She also expressed the opinion that the fold lines on the registered designs serve no aesthetic purpose and are purely functional.

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The prior availability of the patent specification was also not in dispute. Ms McFarland gave a detailed summary of the patent specification, stating that it established the shape and configuration of the design both in pictures and in words, and that it described the functional ie folding, aspects of the design, proving that the fold lines are purely functional. She argued that although not all of the registered design views were illustrated in the patent specification, the written descriptions of the various folding functions established all possible configurations in the mind of the reader. The combination of views and text, she stated, constituted valid prior art which anticipated the registered designs.

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On the subject of the Abbey National card or tumblecard, Ms McFarland argued that a building society or bank would be most unlikely to publish out of date data, and that no evidence had been provided to suggest the tumblecard had been published later than the registration date of the designs. Also there were no grounds for supposing it had only been

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published in Ireland as reference was made on the card to the Abbey National and its London address.

166 **Mr Hamer** in response, stated that when comparing registered designs specific differences must be assessed to determine whether they are material. He repeated that Mr Head-Rapson's beliefs regarding the proprietor's beliefs should be struck out from the evidence.

171 Mr Hamer argued that the fold lines on the registered designs have a material impact on the eye, in that apart from their own appearance, they indicate the alternative configurations available. This, in addition to the overall differences in shape, distinguished the registered design from the beer mats.

176 On the published patent, Mr Hamer argued that the specification could be expected to concentrate on the functional aspects, but this does not mean that designs of this nature, ie. folding cards, have no eye appeal. In support of this argument he drew my attention to the decisions in *Amp v Utilix Pty Ltd* (1970) RPC 397 and *Interlego AG v Tyco Industries Inc* (1988) RPC 343. Mr Hamer concluded that where differences exist, the onus is on the applicant to prove those differences are immaterial and he stated that there had been no such evidence in this case.

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Turning to the Abbey National card or "tumblecard" evidence, Mr Hamer concluded that the applicant had not shown prior publication in the UK and that in any event the differences in the designs were of a material nature.

186 In my decision I will first of all consider the arguments relating to the admissibility of certain
parts of Mr Head-Rapson’s evidence. Evidence is intended to add detailed support to the nature
of the applicant’s case as set out in the Statement of Grounds accompanying an application for
cancellation. Where evidence contains arguments (rather than facts) and involves inferences
of law or fact which are for the hearing officer, not the witnesses, to decide, it is technically
191 inadmissible. In my view the assertions that the proprietor “knew the designs were not new
at the time of application” and that they do not fulfil the requirements of the Act should be
deleted from the Rule 56 evidence. I therefore direct that the last 22 words of paragraph 7 and
the whole of paragraphs 8 and 9 of Mr Head-Rapson’s Statutory Declaration are struck out.
However, the substance of the applicant’s case under Sections 1(2), 1(4) and 1(1)(b)(I) of the
196 Act must be addressed.

Turning now to the grounds on which cancellation of the registrations is claimed, I will
consider first the claims that novelty was prejudiced by the beer mats, the patent application
and the Abbey National Card.

201 In summary, Section 1(2) of the Act specifies that a design must be “new”, and Section 1(4)
states that a design shall not be regarded as new if it is the same as a design which has been
previously registered or published in the UK in respect of the same or any other article before
the date of the application, or if it differs from such a design only in immaterial details or in
206 features which are variants commonly used in the trade.

In assessing similarity it is necessary to pay regard to the features which are important for design purposes and it seems to me that, in the present case, particular regard must be given to the combined visual features of the relative designs.

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The beer-mats were, without doubt, in the public domain prior to these applications. Clear differences do exist however, between the beer-mats and the registered designs. The unfolded or alternative configurations are completely divergent, and the flat or folded configurations have different side views caused by the folded portions. The fold lines are also apparent on the front and rear views, and I believe that these qualify as features of shape and configuration. In my view these differences are material.

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The patent specification refers to an article of similar nature to the registered designs, but there are visible material differences and not all of the configurations of the registered designs are shown. Ms McFarland has argued that the text of the patent specification would enable a reader to visualise the other configurations. “Russell-Clarke on Industrial Designs”, page 62, para.3.113, states that the test to be applied in such cases is that “the prior art document must contain ‘clear and unmistakable directions’ to make an article with the shape or pattern which is the same as, or similar enough to the registered design in suit to deprive it of novelty.”

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I do not believe that the illustrations and text in the patent specification in the present case meet these requirements and in my view the text does not describe the registered designs or designs which only differ in immaterial details from the registered designs.

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Turning now to the Abbey National card, it seems to me likely that this was published in the

231 UK before the application date of the registered designs, and constitutes prior art. I take the
view that the interest rate quoted would have been operative in early 1996 and that use would
have been in the UK in the light of the references to Abbey National and the UK address.
However the card differs in overall shape and in fold details from both registered designs and
I find these differences to be material. Registered Designs are concerned with appeal to the eye
236 and my first impression when I saw the designs was that despite similarities, there were
noticeable differences in the overall effect of the designs and the individual detailing. When
I compared the designs again at a later time, my opinion did not alter.

The registered designs therefore meet the requirements of Section 1(2) and Section 1(4) of the
241 Act.

The applicant also claims that the designs principally comprise features which are dictated
solely by the function which the article has to perform. In the arguments, much emphasis has
been given to the role of the fold-lines, and whether they are purely functional or have an
246 element of eye-appeal. The case of *Cow & Co Ltd v Cannon Rubber Mfr.Ltd (1959)RPC 347*
helped to establish that functional features (in that case the ribs on the surface of a hot water
bottle) can also have some eye appeal and I find this to be so with the designs in suit. The fold
lines clearly have a function but they also contribute to the visual impact of the designs. Apart
from the question of fold lines, in order to succeed on this ground the applicants would have
251 to show that the overall shape and configuration of the folding cards was dictated by their
function. However, it is clear that there are many possible variations in shape for this type of
article.

The registered designs therefore meet the requirements of Section 1(1)(b)(I) of the Act.

256 In this decision I have considered all the arguments presented at the hearing and the evidence filed, and have decided that the designs in suit meet the requirements of Sections 1(2), 1(4) and (1)(1)(b)(I) of the Act. The application to cancel these registrations is therefore refused.

The proprietors have asked for costs.

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I accordingly award costs of £650.00 to be paid by J Howitt and Sons Ltd to Megaprint Group Ltd.

Dated this 22nd day of February 2000.

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J MacGILLIVRAY

Head of Designs, acting for the Comptroller

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