

O-186-04

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF AN APPLICATION UNDER
SECTION 11(2) BY JASON PLASTICS LIMITED
FOR CANCELLATIONS OF REGISTERED DESIGN
NUMBER 2083552 IN THE NAME OF
HEARNGRANGE TRADING LIMITED**

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IN THE MATTER OF AN APPLICATION UNDER SECTION 11(2) BY JASON PLASTICS LIMITED FOR CANCELLATIONS OF REGISTERED DESIGN NUMBER 2083552 IN THE NAME OF HEARNGRANGE TRADING LIMITED

BACKGROUND

1. On 19 May 1999 Hearngrange Trading Limited applied under the Registered Designs Act 1949 (as amended) to register a design with the statement of article “A bag”. The registration was granted.
2. The statement of novelty for which registration is claimed is as follows:

“The novelty of the design resides in the features of shape and configuration of that part of the article shown in full lines in the representations”.
3. A copy of the representation of the design is at Appendix One to this decision.
4. On 18 June 2003 Jason Plastics Limited filed an application under Section 11(2) of the Act to cancel the registered design on the grounds that “Bags in these styles were in the public domain for many years prior to the designs being registered, these being sold and/or utilized within the retail and promotional sectors.”
5. 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.”
6. 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, of it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.
7. The registered proprietor filed a counterstatement denying the grounds of cancellation.

Applicant's Evidence

8. The applicant's evidence consist of a witness statement dated 22 October 2003 by Darren Walshaw, the Managing Director of Jason Plastics Limited (the applicant).

9. The evidence contains the following alleged prior publication or prior art –

- (i) A “satchel type bag” referred to by the applicant as a “record bag”, for containing 12 inch audio records. Mr Walshaw states that record bags of this type have been produced by a UK company, Brenton Handbags Limited, for at least fifteen years, and before May 19, 1999 (the relevant date). He adds that Brenton Handbags Limited have been established for approximately 30 years and have been supplying record bags for between ten and twenty years. Mr Walshaw states that these bags have features of:
- Side panels which are collapsible by a fold extending between an upper portion and a lower portion of the side panel and substantially parallel to the edges of the front and rear panels of the record bag; and
 - An openable flap which extends from an upper portion of a back panel of the record bag, over an opening of the record bag, and down parallel to a front side of the record bag, to attach as by way of a Velcro fastening such that the flap attaches to a lower portion of the front panel of the record bag.

Copy photographs of the record bag” (Bag 1) are at Exhibits 1 to 3 of Mr Walshaw's statement and are shown at Appendix Two to this decision.

- (ii) A second “type of satchel”, also referred to as a “record bag”. Mr Walshaw states that this bag has been publicly available since before the relevant date in the UK and has been sold by ‘Brenton Handbags Limited’. He adds that this bag has a front panel, a back panel, a lower base panel, first and second side panels, and a flap extending from an upper portion of the back panel and which folds over a opening at the top of the bag, and extends downwardly along the front panel of the bag. The flap attaches to the front panel of the bag at a lower portion of the front panel. Copy photographs of this bag (Bag 2) are at Exhibits 4 and 5 of Mr Walshaw's statement and are shown at Appendix Three to this decision.

10. Going to a comparison of the respective designs Mr Walshaw submits that the bag illustrated by his Exhibit 2 has side panels which are foldable in the same manner as the design in suit, such that: the case portion twists relative to the front and rear panels, such that it can extend substantially parallel to the front and/or back panels; and the side panels are each designed to be foldable so that when the bag is flattened, they fold inwardly towards the inside of the bag in the manner shown in GB 2083552. He adds that with

regards to the seam, this is part of the make up of any bag, which is provided for the purpose of finishing, especially around the edging and flaps.

11. Next, Mr Walshaw refers to Exhibit 6 to his statement, which is a copy of an invoice to Ted Baker Limited for 1000 record bags which was sent by Brenton Handbags Limited, dated October 20, 1997. Mr Walshaw states that the record bags were the satchel type bags shown in Exhibits 1 to 3 to his statement. He also draws attention to Exhibit 7 to his statement which is a copy of an invoice to Ted Baker Limited from Brenton Handbags Limited sent in November 1997, for duffel bags. Mr Walshaw states that these duffel bags had a front panel, a back panel, a lower base panel, first and second side panels, and a flap extending from an upper proportion of the back panel folded over an opening at the top of the back and extended downwardly along the front panel of the bag. The flap attached to the front panel of the bag at a lower portion of the front panel.

12. Mr Walshaw's final exhibit, Exhibit 8, is a copy of an invoice sent in December 1997 to Ted Baker Limited for some document bags. Mr Walshaw states that these bags, had a front panel, a back panel, a floor panel, first and second side panels which were inwardly foldable so that when the bag was squashed flat, the side panels could be pushed into the interior of the bag, and the flap which extended from the top of the back panel over the opening of the bag and parallel to the front panel, just like the drawing shown in the registered design GB 2083552.

Registered Proprietor's Evidence

13. The registered proprietor's evidence consists of a witness statement by Lawrence Marie Ollivry of Graffiti Art (UK) Limited, dated 18 December 2003. Mr Ollivry has been working at Graffiti Art since 1990 and has been the Sales Director since 1995. He has at least thirteen years experience in the bag industry.

14. Mr Ollivry has considered the two bags, which are alleged by the applicant as constituting "prior art". He states that:

- (i) the bags comparing the alleged prior art (Bags 1 and 2) are "handbags" whilst the registered proprietors bags are "carrier bags";
- (ii) Bags 1 and 2 are likely to be made of a soft, pliable material having a padded filling, whilst the "carrier bags" shown in the registered designs have thin walls of plastic sheet material with no padding;
- (iii) The respective bags would fold in a different manner and are accordingly quite different in appearance and the way that they collapse;
- (iv) The registered designs have a box like appearance and are formed of very thin material, different to the material used in Bags 1 and 2;

- (v) Each corner of the “carrier bags” shown in the registered designs has sharp, square corners which contrasts with those of the Bags 1 and 2;

Applicant’s Evidence in Reply

15. This consists of a second witness statement by Darren Walshaw, which is dated 25 February 2004.

16. Mr Walshaw commences by making the following points:

- (i) the use or purpose of the bags is irrelevant as registered design relates to appearance; and
- (ii) the materials, make-up and thickness of the bag walls are not relevant;

17. Mr Walshaw addresses the issue of how the bags would fold and refers to the exhibits relating to Bag 2 and states that any difference in the way the respective bags fold constitutes an immaterial detail.

18. Mr Walshaw goes on to refer to a third type of bag (illustrated at Exhibits 5 and 6 to this statement in reply) which, he states, was issued to delegates at a conference running from August 31 to September 5, 1997 in Sheffield. He describes the bag as having a front panel, a back panel, a lower base panel, first and second side panels and a flap extending from an upper portion of the back panel which folds over an opening at the top of the bag, and extends downwardly along the front panel of the bag. He adds that the flap attaches to the front panel of the bag at a lower portion of the front panel, the base of this bag when folded lies substantially adjacent to an outer surface of a side of the bag and that this bag does not comprise any padding. Mr Walshaw goes on to submit that Registered Designs 2083552 and 2083553 were therefore not new at the time of application, because the bags shown in the registered designs differ only in immaterial details from the bags shown in Exhibit 5 and 6 in both appearance and the way that they collapse.

19. This completes my summary of the evidence. I now turn to the decision.

DECISION

20. Before comparing the relevant designs, I turn first to a consideration of whether there has been prior publication.

21. The applicant claims that both bags comprising the alleged prior art (bags 1 and 2) were being produced and sold by a UK company, Brenton Handbags Limited, well before the relevant date of May 19, 1999. The evidence which is filed to support this assertion is in the form of the invoices attached at Exhibits 6, 7 and 8 to the first witness statement of Mr Walshaw. The second witness statement of Mr Walshaw also refers to a third bag.

22. Both Exhibits 6 and 8 are invoices recording bags to Ted Baker Limited in December 1997. Exhibit 7 is in relation to an invoice for duffle bags to the same company in November 1997. All the invoices are from Brenton Handbags Limited.

23. Do these invoices demonstrate prior publication of the alleged prior art? There is no independent or supporting evidence to link the goods covered by the invoices with Bags 1 and 2 shown in the applicant's evidence. There are no representations of the designs showing their existence prior to the relevant date eg in catalogues, brochures or publicity material, nor is there any cross referencing from the designs to the goods in the invoices eg label reference numbers or in precise product descriptors, shown on/in the bags or on labels thereto which link the designs to the goods in the invoices. No supporting evidence from the trade or third parties has been provided and no evidence has been submitted by or on behalf of Brenton Handbags Limited, the source of the invoices.

24. The onus is on the applicant to show prior publication and on the basis of the evidence filed in this case I am unable to conclude that there was publication of the alleged prior art before the relevant date.

25. Upon consideration of the evidence on the alleged prior art I have no hesitation in finding that the articles comprising Bag 1, Bag 2 and Bag 3 have not been shown to be published within the meaning of Section 1(4) of the Act. Accordingly, the application for cancellation cannot succeed.

26. However, in the event I am incorrect on my finding above, I turn now to a comparison of the relevant designs and consider whether the differences are only in immaterial details or are in features which are variants commonly used in the trade.

27. In considering the respective arguments relating to Section 1(4) I have borne in mind that the representation of the design in suit and the alleged prior art must be eyed through the eye of a notional customer which in this case, not only involves the trade, but the public at large.

28. Registered designs are concerned with appeal to the eye and in this particular case I must pay regard to the fact that the proprietor's statement of novelty consists of the following:

“The novelty of the design resides in the features of shape and configuration of that part of the article shown in full lines in the representations.”

29. The above novelty statement makes it clear that the novelty claimed in respect of the design in suit rests, in effect, with the shape and configuration of the bag as a whole.

30. The alleged prior art ie Bags 1, 2, and 3, and the design in suit comprise articles which perform essentially the same general function. They are bags on which the opening element doubles as a front and top to the bag. In such a close field of goods it is

necessary to consider the features which are important for design purposes, which must take into account the relatively simple and straightforward nature of the design in suit.

31. In my considerations I am guided by the following comments of Laddie J in the matter of *Household Article Ltd's* Registered Design No 2044802 [1998] FSR 685-686, paragraphs 26 and 27.

“The purpose of Section 1(4) is to ensure that any designer is free to take a piece of prior art and to apply to it well known and commonly used design features or visually immaterial modifications or a mixture of both without fear of falling foul of a registered design. Even if the result of his work is visually pleasing and different it cannot fall within the scope of a valid design registration. If on the other hand the design in suit contains some features which are neither immaterial nor common trade variants then it must be looked at as a whole and the question answered whether, taking all the features together, it is sufficiently different to the prior art to warrant a monopoly of up to 25 years duration. In the latter case the fact, if it be one, that many of the features are either immaterial when taken by themselves or are common trade variants is likely to make it more difficult to show novelty.

The words “commonly used” in Section 1(4) must be given effect. This statutory provision does not mean that all features which are known and in the palette of alternative available to a designer can be used with impunity. Were it so, as Mr Hacon emphasised, any design made up solely by blending together known design features would always be invalid. There is authority going back over a century showing that that has never been the law. A design can be novel even if it is made up entirely by blending together a number of old designs provided the resulting combination itself has a sufficiently distinctive appearance. It is only where all the features have been used before, and used commonly, (or are immaterial) that the Act deems them to be novelty-destroying.”

32. Registered designs are concerned with appeal to the eye. The submissions made in the registered proprietor's evidence in relation to the different material in which the respective bags are made and their different function are not of assistance. The appearance of the respective designs is paramount. Furthermore, the clarity of the applicant's representations of the alleged prior art leaves much to be desired, although it appears obvious that Bags 1, 2 and 3 all possess a functional opening element ie a front and top panel which open to enable access.

33. My first impressions on viewing the respective designs was, despite the obvious similarity between them which largely stems from their functionality and relatively simplistic or straightforward nature, that there were obvious overall differences. The design in suit has a boxy or box like appearance with sharp, “right angles” corners, whereas Bags 1, 2 and 3 have a softer, more rounded appearance. The overall differences are, in my opinion, obvious when viewing the perspective views of the respective designs and I believe they would be obvious in normal use to the relevant customer.

34. When, after considering the evidence and submissions, I returned to compare the designs again, my opinion did not alter. The designs in their totality appear different.

35. To qualify for design registration a design is not required to possess striking novelty and there are many precedents to show that a design can be legitimately registered even when it is quite close to the prior art. This is particularly so of designs in such a close field as the one in question.

CONCLUSION

36. In light of the reasons given above I have decided that the design in suit meets the requirements of Section 1(2) of the Act. The application for cancellation which is based upon Section 1(4) of the Act, is therefore refused.

COSTS

37. As the application has failed, the registered proprietor is entitled to a contribution towards costs. I accordingly order the applicant to pay the registered proprietor the sum of £900 which takes account of the fact that no hearing took place in this case. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of June 2004

JOHN MacGILLIVRAY
For the Registrar
The Comptroller General