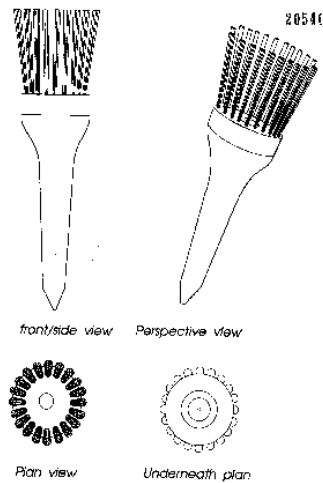


O-023-09

REGISTERED DESIGNS ACT 1949 (AS AMENDED)
IN THE MATTER OF REGISTRATION NO 2054094
IN THE NAME OF MICHAEL JOHN ST JOHN
IN RESPECT OF THE FOLLOWING DESIGN APPLIED TO A GOLF TEE:



AND

AN APPLICATION TO INVALIDATE
BY SHEILA MARY FRISK

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF Registration 2054094
In the name of Michael John St John
In respect of a design applied to a golf tee**

and

**IN THE MATTER OF an application to invalidate
By Sheila Mary Frisk**

Background

1. The registered design the subject of these proceedings was applied for on 14 February 1996. However, as the design was a division of an earlier application¹ that was said to consist of more than one design, the design must be taken (for the purposes of assessing novelty) as having been made on 26 July 1995; this is in accordance with the “divide-out” provisions² applicable at that time. The registration concerns a design for a golf tee.

2. The design was initially in the joint proprietorship of Mr Michael John St John and Mr Eric Oscar Frisk. However, following an assignment made in writing on 21 May 2004, Mr Frisk assigned all rights in the design to Mr St John. Nothing turns on this.

3. Ms Sheila Mary Frisk made her request to invalidate the design registration on 15 October 2007. Ms Frisk claims that the registered design is invalid because the design was not new at the time of its application. The prior art said to give rise to this claim is an earlier patent publication for a golf tee (GB Patent 236132 – 1925). She claims that the overall impression of the golf tee depicted in the patent is not different from the design and could be judged by the eye as being the same. A copy of the patent publication was included as part of her statement of case.

4. Mr St John filed a counterstatement denying the grounds on which the application for invalidation was made.

5. Other than the copy of the patent publication and both sides respective claims and counterclaims, no further evidence or submissions were received, neither did either side request a hearing. Therefore, I will determine the matter based on the papers and documents before me.

¹ Design registration 2049039

² Section 3(4) of the Registered Designs Act 1949 (as amended).

The relevant legislation

6. The Registered Designs Act 1949 has been amended on a number of occasions. Recent amendments have been made by virtue of The Registered Designs Regulations 2001³, The Registered Designs Regulations 2003⁴ and The Regulatory Reform (Registered Designs) Order 2006⁵. However, these amending instruments came into force after the registration of the design in question. To this extent, I note the following from The Registered Design Regulations 2001:

“Transitional provisions: post-1989 registrations

12. - (1) This Regulation applies to -

(a) any registration under the Registered Designs Act 1949 which -

(i) has resulted from an application made on or after 1st August 1989 and before the coming into force of these Regulations; and

(ii) has given rise to a right in a registered design which is in force at the coming into force of these Regulations;

(b) any registration under the Act of 1949 which -

(i) has resulted from an application made on or after 1st August 1989 and before the coming into force of these Regulations; and

(ii) has given rise to a right in a registered design which is not in force at the coming into force of these Regulations but which is capable of being treated as never having ceased to be in force by virtue of section 8(4) of the Act of 1949 or of being restored by virtue of sections 8A and 8B of that Act; and

(c) any registration which subsequently ceases to fall within subparagraph (b) because the right in the registered design has been treated or restored as mentioned in paragraph (ii) of that subparagraph.

(2) The Act of 1949 as it has effect immediately before the coming into force of these Regulations shall continue to apply in relation to

³ SI 2001 No. 3949

⁴ SI 2003 No. 550

⁵ SI 2006 No. 1974

registrations to which this Regulation applies ("post-1989 registrations") so far as the Act relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of section 11(3) of that Act and by reference to an expiry of copyright occurring on or after the coming into force of these Regulations).

(3) Accordingly the amendments and repeals made by these Regulations shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to post-1989 registrations."

7. Taking the above into account, the design in question is a post 1989 registration in the terms set out in regulation 12(1)(a) above. In accordance with regulation 12(2), this invalidation request must be determined on the basis of the law as it was before the coming into force of The Registered Design Regulations 2001, that is, by virtue of the Registered Designs Act 1949 as amended at that point in time, namely, by the Copyright, Designs and Patents Act 1988. This is the relevant legislation to be considered in these proceedings which, from this point on, I will refer to as "the Act".

8. A claim to not being new is based on section 1(4)(b) of the Act. This reads:

"1(4) A design shall not be regarded as new for the purposes of this Act if it is the same as a design-

(a).....

(b) published in the United Kingdom 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 features which are variants commonly used in the trade."

9. Ms Frisk refers to section 1(1) of the Act to support her proposition that the designs should be judged and compared by the eye. This is not a separate ground of invalidation, but instead relates to the approach that I should adopt; section 1(1) reads:

"1(1) In this Act "design" means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye,....."

Legal principles

10. There are a number of principles to consider. Firstly, it is clear from the case-law that Ms Frisk is correct in that matters must be judged by the eye and, furthermore, the eye is that of the customer or trader⁶; I will refer to this person as the “relevant person”. To illustrate the point, in *Household Articles Ltd’s Registered Design* [1998] FSR 676 (“*Household*”), Mr Justice Laddie stated at paragraph 19:

“Novelty of a registered design is to be assessed by the court as if through the eye of the customer for or trader in the relevant goods. Evidence from experts may sometimes assist the court to understand the designs but the court does not delegate the task of assessing novelty to the experts. In some respects the experts are poorly equipped for that task. Their training is likely to provide them with a much more profound appreciation of the similarities and differences between designs than customers or members of the trade would have and they are likely to be less impressed by designs containing many features which individually they have seen before.”

11. The second principle relates to functional aspects of the designs and the impact of this on my analysis. It is also relevant to consider whether the design is the shape of a particular item and, consequently, whether the prior art relates to the same item. At paragraph 22 of *Household* Mr Justice Laddie stated:

“The same point was put clearly by Bollen J. in *Dalgety Australia Operations Ltd v. FF Seely Nominees Pty Ltd* (1985) 68 A.L.R. 458; 5 I.P.R. 97 (Aus.). Where different designs are applied to the same functional items, the overall appearance of the complete products are likely to look similar. But for design purposes attention must be concentrated on the eye-appeal features and much less regard be paid to the common functional parts. This is consistent with the wording of section 1 itself. The Act is only concerned with “designs” and they are defined as *not* including “features of shape or configuration of an article which are dictated solely by function which the article has to perform” (section 1 (b)(i)). There has been extensive authority over very many years which supports this principle”

12. Attention should, therefore, be focused upon aspects where there is some design freedom. In paragraph 28 of *Household* Mr Justice Laddie stated:

“...My first impression on comparing the registered design with the Bistro was that, although they had many features in common, in virtually all those

⁶ See *Amp Inc v Utilux Pty Ltd* [1972] RPC 103; *Kevi A/S V Suspa-Verein UK Ltd* [1982] RPC 173; *Interlego AG v Tyco Industries Inc* [1988] RPC 343.

areas where the designer had a freer hand to modify and add eye appeal to the shape and configuration of the coffee maker, they were noticeably different both in detail and overall effect....”

13. The third principle relates to section 1(4) itself and the tests to be applied. On this, it is useful to consider what Mr Justice Laddie stated in *Household*:

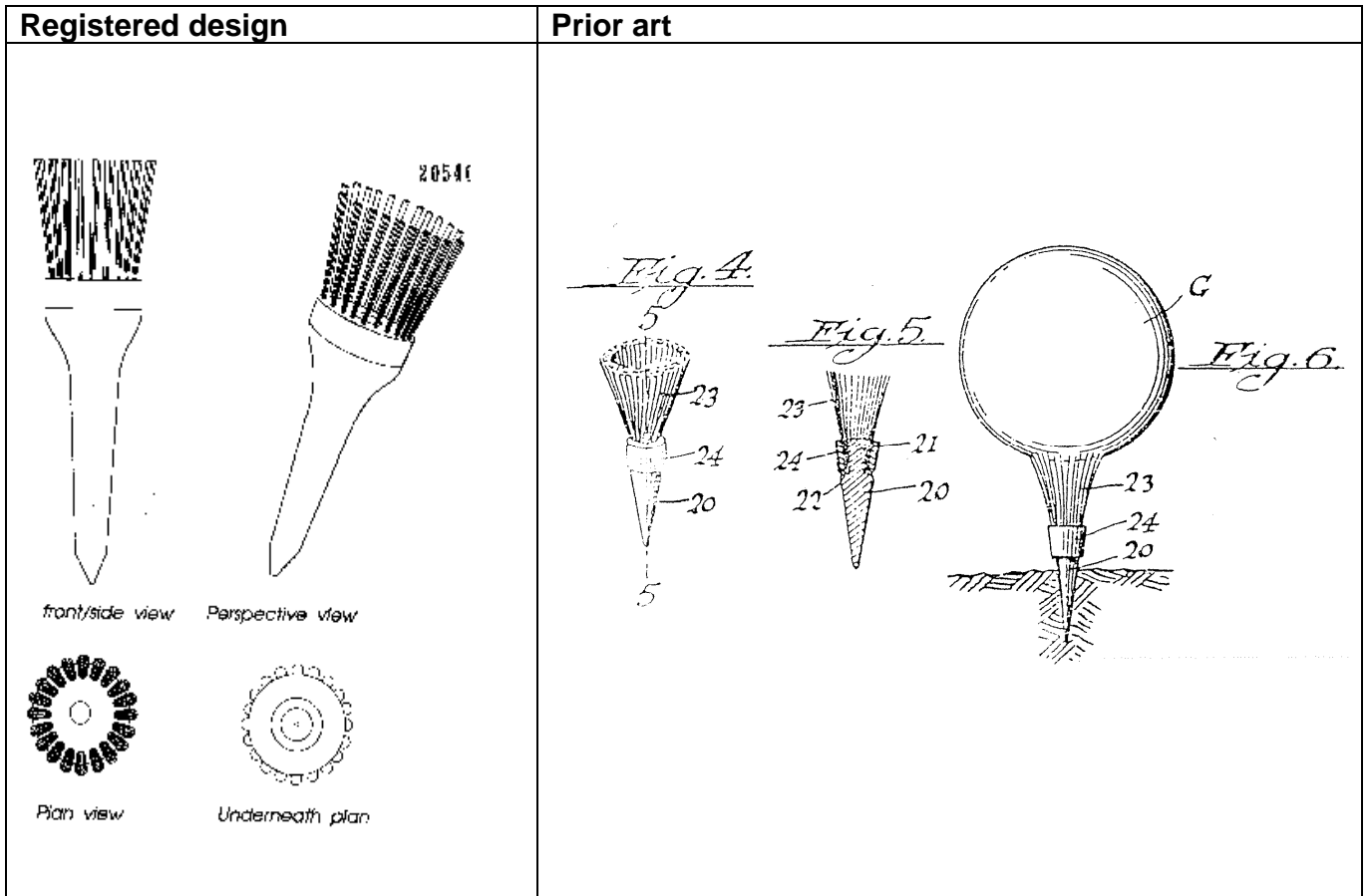
“25. This leads to a consideration of section 1(4). As noted above, the general requirement of novelty is imposed by section 1(2). Furthermore certain features which may be visually significant are excluded from consideration under section 1(1). In addition to these, section 1(4) stipulates that where the design in issue is the same as a prior art design or if it differs from such design "only in immaterial details or in features which are variants commonly used in the trade" it is not to be treated as novel. The first of these needs little explanation. If the design is the same as a prior art design it will be invalid. This is similar to the concept of anticipation in patent law. The second, however, deserves closer examination. Even when the prior art design is not identical to the design in suit, it is deemed to be novelty-destroying where the differences between them "only" reside in immaterial details or features which are common trade variants. In other words if *all* the differences between the prior art and the design in suit are immaterial or common trade variants then the design in suit is deemed not to be novel. Immaterial details are features which make no significant visual impact on the design. On the other hand the contradistinction in section 1(4) between immaterial details and common trade variants indicates that the latter may be visually significant. As Gummow J. said in *J. Rapee & Co. Pty Ltd v. Kas Cushions Pty Ltd* (1989) 15 I.P.R. 577 at 590:

Both this case and Lloyd-Jacob J.'s decision in *Sebel & Co. Ltd's Application* (No. 2) [1959] R.P.C. 19 at 24, indicate that a feature of a design which is not an immaterial detail may still be a variant commonly used in the trade.

26. 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.”

Application of principles

14. For ease of reference, the registered design and the prior art are shown below:



15. The prior art consists of a patent publication from 1925. There is no dispute between the parties over whether such a document constitutes a valid publication in the UK. Section 1(4)(b) requires something which has been “published in the United Kingdom in respect of the same or any other article before the date of the application”. The prior art certainly meets this criterion.

16. It can clearly be seen from the registered design and the prior art that they are not the same. Indeed, both parties have made observations on the differences between them. The matter, therefore, rests on whether the differences reside only in immaterial details. Although section 1(4)(b) also refers to differences that reside only in “features which are variants commonly used in the trade” no claim to this has been particularised by Ms Frisk (her claim is based on a comparison between the registered design and the prior art) neither has any

evidence been presented of any common trade variants. Before making any findings on immateriality it is, of course, necessary to accurately identify the differences between the registered design and the prior art.

What are the differences?

17. Both parties have highlighted differences in the splaying of the bristles and in the shape of the respective spikes below them. Also highlighted is the shape and configuration of the shoulder at the top of the respective spikes which secure the bristles. This seems to me to be an accurate assessment of the key differences, I can see nothing further myself. Applying my own observations, the differences can be characterised as:

- The bristles in the prior art are more outwardly splayed in comparison to those in the registered design, although, those in the registered design still display a degree of outward splaying.
- The bristles in the prior art are more upwardly and constitute a greater proportion on the overall size of the golf tee compared to the bristles in the registered design.
- The shoulder which secures the bristles is conically shaped in the prior art but cylindrical in the registered design; it also appears to protrude beyond the width of the spike in the prior art but is the same width as the top of the spike in the registered design. The shoulder is also greater in height in the prior art compared to the registered design.
- The spike in the prior art is cylindrical with only one angle of taper from its top to its tip whereas the spike in the registered design has a curved form where it connects to the shoulder and then a conical shape which itself has two angles of taper the first (top) taper (which forms the greatest proportion of the spike) being much less angular than the second (bottom) taper.

Are these only immaterial details?

18. I bear in mind that both the registered design and the prior art relate to the same item, namely, a golf tee. To that extent, there is an inevitable degree of similarity because function and purpose dictates that a golf tee must possess a spike for insertion into the ground and some device on which the golf ball is to rest. Furthermore, the bristles on each also have a functional purpose because these are plainly the device on which the golf ball is to rest, bristles being used, presumably, for the purpose of reducing resistance when the ball is stuck. Whilst these inherent points of similarity will be recognised by the relevant person, so too will their basic functional purposes. Therefore, the manner in which the respective designers have taken these components and the manner in which

design characteristics have been applied to them will be most significant to my finding. That is not to say that novelty will be found on the basis of any difference, it is still as question of materiality.

19. Looking firstly at the differences in the bristles, whilst there is a greater degree of outward splaying in the prior art, this to my mind is not a significant factor. I do not see this as an aspect that will be particularly noticed by the relevant person nor does this difference introduce any real design differentiation. I take the same view of the less upwardly form of the bristles in the registered design. The differences in the designs of the bristles are so small that, even taking into account their functional nature, the differences reside in immaterial details.

20. Considering next the differences in the spike and shoulder, I am immediately drawn to the smoother and more curved profile of the registered design compared to the more angled and straight-lined profile of the prior art. This is reinforced by the shoulder of the prior art appearing to stand out from the spike (albeit retaining the same angle) whereas the shoulder in the registered design appears to blend more into the spike. Some of the differences are less significant in isolation, for example, the second angle of taper (to the tip) in the registered design, however, this still contributes to the overall configuration of the spike and shoulder component and the smooth profile that is created. The relevant person comparing the designs is likely to notice all this and, therefore, contrary to Mr Frisk's argument, the designs will not be judged by the eye as being the same. This in itself does not answer the question as the materiality of these differences needs to be considered.

21. It is obvious that a golf tee must have a spike for insertion into the ground. Furthermore, I cannot imagine that there is a huge degree of design freedom when considering this aspect of a golf tee. A spike has to be spike-like in order to perform its function. However, despite this rather limited degree of design freedom, the spikes and the shoulders have been designed in a different manner and give a different impression from each other (as I have described). One must balance the degree of design freedom against the actual differences. Having done so, it is my view that the differences are not immaterial in detail. They have different design characteristics which contribute to the overall impressions of the respective designs.

22. In conclusion, **I cannot say that differences reside only in immaterial details**, therefore, the prior art is not novelty destroying. **The application for invalidation of the registered design must fail.**

Costs

23. Mr St John has been successful and is entitled to a contribution towards his costs. I hereby order Ms Sheila Frisk to pay Mr Michael John St John the sum of **£150**.

24. The above sum should 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 26 day of January 2009

**Oliver Morris
For the Registrar
The Comptroller-General**