

O-445-13

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO:
4023950
IN THE NAME OF SYNERGY ARCHITECTURAL HARDWARE LTD**

AND

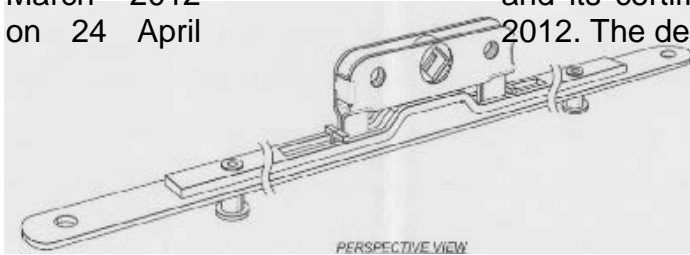
**A REQUEST TO INVALIDATE (NO. 33/12)
BY SPIRE HOMEWARES LTD T/A ARCHIBALD KENRICK & SONS LTD**

The

background and the pleadings

1) The proceedings Hardware Ltd “espagnolette” March 2012 on 24 April

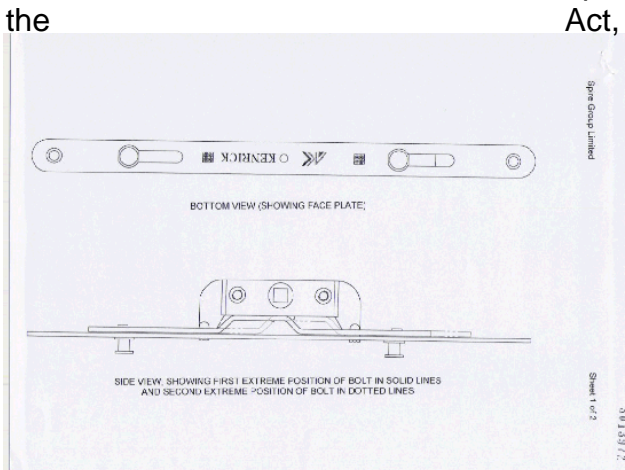
registered design the subject of these stands in the name of Synergy Architectural (“Synergy”). The design is in respect of an mechanism”. The design was filed on 15 and its certificate of registration was granted 2012. The design looks like this:



Other views will depict depicted

of the design are provided in the registration, I these later. In the above view, and in those later, the registered design includes two wavy lines. I do not regard the lines as part of the design. It appears that they are intended to indicate that the length of the article may vary but that the other features remain the same. Neither party has stated that the wavy lines form a characteristic of the design so my thinking appears to be in line with the parties.

2) Spire Homewares Ltd t/a Archibald Kenrick & Sons Ltd (“Spire”) has requested that the above design be declared invalid. The claim is made on the basis of section 1B(1) of the Registered Designs Act 1949 (“the Act”), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The prior art which, it is claimed, destroys the novelty of the registered design is based upon an earlier design registered under Act, namely: design registration 3013973:



3) The earlier design was filed on 7 August 2003 and its certificate of registration was granted on 7 October 2003. The earlier design has now expired; however, this does not matter when it comes to assessing the novelty of the later design. The later design is either novel (compared to what has gone before) or it is not. Spire's claim is also based upon similar articles to the above prior art which, it states, have been made available to the public via sales. A further aspect of Spire's case is that espagnolette mechanisms are designed to fit into a window profile and, consequently, that only the part of the registered design which is visible in normal use is to be considered when carrying out the novelty assessment; this is a reference to section 1B(8) of the Act.

4) Synergy filed a counterstatement denying the claim. It considers that the whole of the design must be considered when making the novelty assessment because the article is not part of a complex product but is an accessory or fitting for another product. It considers that the degree of design freedom is restricted. It considers that the differences between the designs mean that they have a different overall impression.

5) Neither side requested a hearing.

List of documents

6) Rather than provide a stand-alone summary of the evidence and submissions filed in the proceedings, I will instead draw from the materials when it is necessary and pertinent to do so. For the record, a list of the documents filed is set out below:

- *From Spire:* Claim form DF19A dated 23 November 2012 together with i) accompanying statement of case and, ii) a witness statement from Stephen G Jones (Spire's Managing Director) dated 21 November 2012 with exhibits A to E.
- *From Synergy:* Notice of counterstatement (Form DF19B) dated 14 January 2012 together with written counterstatement of Andrew Hartley of Mathisen & Macara LLP (Synergy's representatives in this matter). The counterstatement is largely argument/submission, but it contains some factual evidence.
- *From Spire:* Submissions from Spire's representatives (DW & SW Gee) dated 15 March 2013 and a further witness statement (and exhibits F & G) from Mr Jones dated 14 March 2013.

- *From Synergy*: Further submissions dated 18 April 2013 from Mr Hartley of Mathisen & Macara LLP.
- *From Spire*: Further submissions dated 7 June 2013 from DW & SW Gee, together with a third and final witness statement (and exhibits H to J) from Mr Jones dated 7 June 2013.

The legal background

7) Section 1B of the Act 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 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 consideration.
- (5) For the purposes of this section, a design has been made available to the public before the relevant date if-
- it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
 - the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
- it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in 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) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –
- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
 - (b) to the extent that those visible features of the component part are in themselves new and have individual character.
- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

8) In terms of the legal principles, guidance on the various relevant issues can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”). Some of the key points from this are that:

- a) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional

aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.

b) In terms of design freedom, this may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.

c) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.

d) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more

than a comparison of verbalised similarities means that the machines give the same overall impression. ...”

9) An appeal was made against Mr Justice Arnold’s decision which was dismissed by the Court of Appeal (case [2011] EWCA Civ 1206). Worth mentioning here is some additional commentary provided by Sir Robin Jacob in the Court of Appeal’s judgment, namely that:

“30.....Moreover the list of nine features relied upon by Dyson is far too general. Thus it is no good saying "both have transparent bins through which the cyclone shroud is visible" when the reality is that both the bins and shrouds are very different in shape. You cannot take features of a design, turn them into general words and then treat those words like a patent claim.”

And

“34. I would only add one matter, irrelevant in this case. In *P&G* I drew attention to the difference between Recital 14 and Art. 6 of the Design Regulation (EC 6/2002). The former uses the expression "the design clearly differs" whereas the latter merely says "differs." "Clearly" does not reappear. I thought the difference was deliberate and so had some significance. I was wrong, though that does not affect the main reasoning in *P&G*. The difference in wording is merely the result of sloppy drafting as has been pointed out by Dr Alexander von Mühlendahl in *Design Protection in Europe, 3rd Edn.* (2009 at pp.232-3). The same of course applies to the identical wording in the Directive (Recital 13 and Art. 9).”

10) Matters must be judged from the perspective of an informed user. In case C281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA, OHIM*, it was stated:

“It should be noted, first, that Regulation No 6/2002 does not define the concept of the ‘informed user’. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.”

11) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user. Synergy argues (in its counterstatement) that the informed user is a window fitter, a point that Spire has accepted (in its submissions dated 15 March 2013). Whilst it is not always

necessary to pin the informed user down to one specific notional type of person, the characterisation the parties have agreed upon is as good as any; such a person will possess the characteristics (knowledge/experience) set out in the preceding case-law.

Is the design a “component part” of a “complex product”?

12) One of the main areas of dispute is whether all of the registered design should be taken into account in the novelty assessment, or only the parts of it which remain visible in normal use. The relevant provision reads:

“(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

Section 1(3) of the Act is also relevant because it defines what a “complex product” is:

“a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product”

13) In his witness statement Mr Jones states that the products in question are espagnolette mechanisms, a type of locking mechanism designed to be fitted to an opening panel such as a window, to secure it in a closed position. It is stated that with Upvc windows in particular, most manufacturers of window profiles include a groove (known as the “Euro-groove”) of known dimensions and which can accommodate any of the available espagnolette mechanisms which Synergy and other companies supply to match those dimensions. Mr Jones attaches a publicity sheet for what he calls the “Espagnolette 22”, which is based on a design Spire created in 2005 and which is available in a number of variants but which share similar features. The publicity sheet shows the product fitted into a window:



14) In Spire's statement of case it is stated that:

“Products of this type are designed to be fitted into the profile of a window. The window is a “complex product” according to [the Act], and the registered design comprises a component part of the complex product. According to Section 1B(8) of the Act only those parts of the product which remain visible during normal use of the complex product shall be considered relevant for the novelty and individual character assessment. The assessment of novelty and individual character should therefore be based only upon the face plate and the projecting mushroom heads. Neither the face plate nor the projecting mushroom heads possess novelty or individual character.”

15) Counter-arguments to the above are provided in Synergy's counterstatement. The nub of its argument is that a window is still a window and a door is still a door regardless of whether it has an espagnolette mechanism. I note the following points/arguments:

- That the test for whether something is a “component part” is whether the larger product is a complete product without the part.
- That someone can choose a window or door without the mechanisms, but they are still windows or doors. This is contrasted with a spark plug for a car, as a car is not complete without spark plugs.
- That one must distinguish between a true component part and a highly desirable accessory or fitting (the product is said to the latter).
- That even for windows with a Euro-groove, an espagnolette mechanism need not necessarily be used.

- That it is irrelevant that some window manufacturers fit such mechanisms as standard. To illustrate the point, reference is made to car manufacturers that fit tracking devices as standard, but this is not a component part of a car.
- That the French for espagnolette is “a bolt for French casements”, thus showing that it is an accessory or fitting not a component of a window.
- That on the website of a manufacturer called Triton it is stated that the mechanisms are “for use on PVCu, timber or aluminium windows” again indicating that an espagnolette mechanism is an accessory or fitting not a component part.
- That a window is not a “complex product”, the argument being that a complex product would be regarded as having many parts which interact with each other. A key aspect is said to be that interaction.
- That a window would not be regarded as a complex product on account of its simplicity and the simple mechanical interaction any parts in them have.

16) In its submissions in response Spire refers to the Act’s definition of “complex product” and that windows (but especially those designed to be fitted with a espagnolette mechanism) fall within this definition. It is stated that the complete window can be disassembled and reassembled. It is added (although it says that this is not entirely relevant to this case) that all windows contain either hinges or other hardware so would all fall within the definition. It is considered that the mechanism is clearly a component part of any window to which it is fitted.

17) Whilst it is true that some windows or doors do not need to have an espagnolette or similar mechanism (for example, if they are fixed windows or doors), that does not apply to all windows or doors. If an end user wishes to obtain a closable window or door then it is not complete unless an espagnolette or similar mechanism is present. This means that the mechanism is more than a simple accessory; it is, instead, an essential ingredient for that type of window/door. Whilst the points made by Synergy have been noted, they do nothing, in my view, to suggest that the opposite view should be taken. The examples given are not on a par and regardless of the French for espagnolette and regardless of how Triton explain the use of such mechanisms, the realistic view of the matter is that the mechanism concerned is a component of an opening window or door.

18) In terms of whether a window can be said to be a “complex product”, I should start by saying that the definition of complex product is reasonably broad. The provisions may well have been aimed at the car spare parts issue, but there

is nothing in the Act or the Directive¹ (or the recitals to the directive²) on which the Act is based which limits the scope of the provision to cars or, indeed, to products of a degree of complexity akin to cars. To be classed as a complex product it must have “at least two replaceable component parts permitting disassembly and reassembly of the product”. An opening window will have multiple parts. The closing mechanism and the glass panel, the frame, seals, and even handles. All these parts can be disassembled and reassembled into the finished product. On my reading of the definition, an opening window or door is a complex product as defined by the Act. This is sensible given that the whole point of design registration is to reward designers for good design. Designers are not in the habit of bringing design aesthetics to items which will never be seen (or to parts of items that will never be seen) because they will be used as non-visible parts of a larger product – why would they? The consequence of my finding is that I agree with Spire that it is only the flat bottom surface of the mechanism (and the protruding heads) that will be taken into account in the novelty assessment.

The prior art – what has been made available to the public?

19) In its counter-statement Synergy accepts that earlier design 3013973 represents relevant prior art. This is sensible because the design was granted registration on 2 September 2003 and, thus, it would have been made available to the public via the Designs Journal before this date which, in turn, is well before the relevant date in these proceedings.

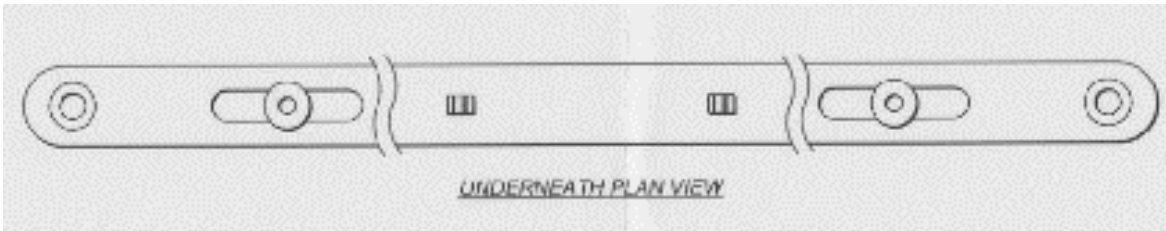
20) Spire’s statement of case and initial evidence also refers to espagnolette mechanisms that have been made available to the public through sale and examples of engineering drawings, promotional sheets and invoices are filed in support. Much of both parties’ evidence/submissions focus on what these documents establish, with Synergy questioning their probative value. I do not consider it necessary to probe these matters. Spire can rely on prior art 3013973. The other examples of claimed prior art are extremely similar to prior art 3013973 and having carefully considered them, I do not consider that they place Spire in any better position. I will consider the matter solely on the basis of prior art 3013973.

The designs compared

21) The underneath plan view of the registered design is the one which best represents what can be seen in normal use:

¹ Directive 98/71/EC of the European Parliament and of the Council 13 October 1998.

² The relevant recitals would be recitals 11 & 12.



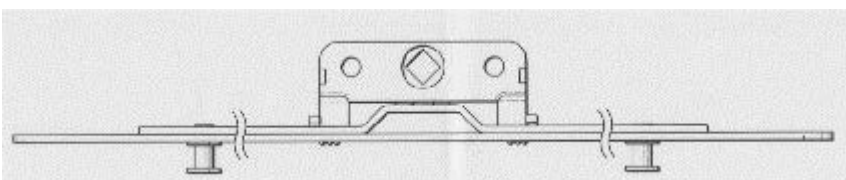
The equivalent view of the prior art can be seen below:



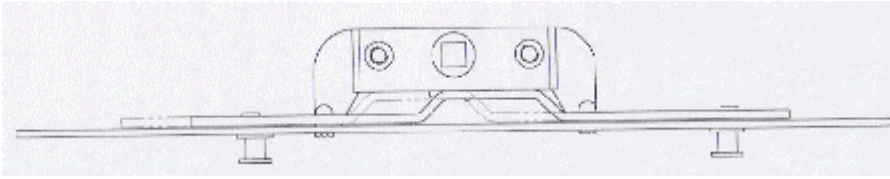
22) The prior art contains a decorative/informative embellishment which indicates trade origin (the word Kenrick and a stylised letter K) whereas the registered design does not. However, the absence of this from the registered design does not assist in the determination. The novelty and individual character of the registered design must be based upon its shape and configuration and, so, if the shape and configuration lacks novelty due to the shape and configuration of something that has gone before then that is enough to render the registered design as lacking novelty and individual character.

23) There are some very clear and obvious points of similarity. The outline shape of both designs is of a very similar (perhaps even identical) narrow oval or lozenge. Both designs have two square studs of similar proportion and similar position. Both designs have, within the outer oval, two further narrow ovals inside each of which is a "mushroom head" (as one of the parties has described them) which, it is accepted between the parties, slide back and forth; it is this aspect which locks/closes the window or door in place when the mechanism is turned. In view of this, the fact that the mushroom heads are positioned centrally within the inner ovals in the registered design but to the right in the prior art is of no consequence. Both designs also have a circular hole at each end, presumably for fixing purposes; from what can be seen in the relevant representations, both are simple holes with, perhaps, a riveted look.

24) Further observation is required of the mushroom heads. The degree of protrusion and an indication of outline shape can be seen in the attached representation of the registered design:



The equivalent part of the prior art can be seen below:



25) The above representations demonstrate that the mushroom heads protrude to a roughly similar degree. The shape of the mushroom heads is also very similar, being reminiscent of a cotton reel. It may be that the upper flat part of the cotton reel in the registered design is narrower than the bottom flat part, whereas both of the flat parts in the reel of the prior art appear to be of identical width. This, though, is not only extremely difficult to spot (even for the informed user) but its significance will be regarded as immaterial in the context of the overall design. The above representations also demonstrate that the two square studs I described in paragraph 23 are in fact the elements which fix the locking mechanism or gearbox to the face plate – the degree to which these studs protrude from the faceplate is very similar (perhaps even identical).

26) In terms of the differences, Synergy highlights that the prior art has a centrally located hole which is not duplicated in the registered design. It also states that the mushroom heads in the registered design have a recess or hole (at least partially). Whilst it is not 100% clear from the representations of the registered design, the image at paragraph 21 does appear to support this. However, there is no reason why the mushroom heads in the prior art could not also have this feature, indeed, from a further representation of the prior art (which is provided to show the espagnillette mechanism once it has been installed) it is clear that this is the case:



27) The above image has a degree of inconsistency with the more technical representation of the prior art in that the diameter of the recess is narrower in the above photograph, however, it at least supports that the prior art is intended to have a recess. In any event, the publication of this picture is itself prior art.

28) The informed user will appreciate that the characteristics of the designs that I have described are largely functional. They will therefore appreciate that designers of such items have a limited scope of design freedom because the item must fit into the profile or Euro groove and that, furthermore, to perform the required functionality certain aspects must be shaped in certain ways. Nevertheless, the differences between the overall designs are miniscule. The

addition/absence of one further hole in the centre of the face plate (an addition which will be assumed to be for functional purposes) can hardly be said to create a novel design or one of a different overall impression. The difference in the width of the upper flat part of the mushroom heads can hardly be noticed so this is either immaterial or, alternatively, will not form part of the informed user's overall impression, and, even if it did, would not create a different overall impression. I have said that the mushroom heads in both designs feature recesses – whilst there could be a slight difference in the width of the recesses this, again, is either immaterial or will not form part of the overall impression. **I consider that the differences between the designs are immaterial and, thus, they can be considered as identical. Even if I am wrong on that, the differences are so small, even bearing in mind the degree of design freedom and the functionality of the various aspects of the design, the informed user will not consider the respective designs to differ in overall impression. The registered design is, therefore, invalid.**

Costs

29) Spire has been successful and is entitled to a contribution towards its costs. I hereby order Synergy Architectural Hardware Ltd to pay Spire Homewares Ltd t/a Archibald Kenrick & Sons Ltd the sum of £1250:

Preparing a statement and considering the other side's statement	£300
Filing evidence	£500
Filing submissions (at various stages of the proceedings)	£400
Official fee for filing invalidation	£50

30) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of November 2013

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