

**O-262-16**

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

**IN THE MATTER OF REGISTERED DESIGN NO 4040685  
IN THE NAME OF DEXIL LIMITED**

**AND**

**APPLICATION No. 21/15 BY PETER BRYANT  
TO INVALIDATE THE DESIGN**

## Background and pleadings

1. The registered design which is the subject of this dispute was filed by Dexil Limited (“Dexil”) on 29 April 2015. The design is described in the application form as “Dog bandana/dog clothing with wording to show a dogs’ temperament/nature/ability/disability.” The representation of the design as registered is shown below:



2. Peter Bryant has requested the invalidation of the design registration under section 1B(1)<sup>1</sup> of the Registered Designs Act 1949 (as amended) (“the Act”). This section 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 Mr Bryant claims destroys the novelty of the registered design is his own design registration number 4035619, which he claims was sold on 11 June 2014 on the internet:



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<sup>1</sup> Which is relevant in invalidation proceedings due to the provisions of section 11ZA of the Act.

3. Mr Bryant applied for his design on 28 May 2014 and registration was granted on 10 June 2014. The design is described on the application form as “Dog bandana with embroidered wording”. Documentation was attached to his amended application for cancellation which may be treated as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006.

4. Dexil also attached documentation to its notice of defence and counterstatement, which was filed by Jonathan Saville. Dexil/Mr Saville denies the grounds. I will describe the contents of the defence, and the attached documents, in the evidence summary.

5. Both parties also filed additional evidence. Neither requested a hearing, although they were given the option of a hearing if they wished, prior to this decision being made. Neither party filed written submissions in lieu of a hearing. I make this decision on the basis of the papers filed by both parties.

## Evidence

6. Mr Bryant has filed a witness statement dated 9 November 2015 and exhibits. He states that Dexil has copied the shape of his bandana to the millimetre; if one is placed over the other, the top stitching of both is in the same position. Mr Bryant states that Dexil must have known that the design was registered as Dexil bought a bandana from him. The exhibits comprise:

- Pages 3 and 4: representations of the parties’ products, showing the stitching detail at the top of the bandanas.
- Pages 5 to 12: representations of the parties’ products showing comparable dimensions.
- Pages 16 and 17: a copy of the cover page and an internal page from the August 2014 edition of a magazine called *Dogs* (priced at £3.99) showing the following article:



**Useful product**

**Get the message across!**

This new and innovative range of canine bandanas could be just the thing if your dog has a particular behavioural problem he needs to 'voice'. With slogans including 'I don't like other dogs' and 'I'm nervous', the range has been created by dog-lover Denise Bryant, who was inspired by her own dog's dislike of other dogs running up to him.

You can choose from a set message or create your own, up to 20 characters. The 100 per cent cotton bandanas are available in one size (adjustable with Velcro), are machine washable and come in green, red, orange, yellow, pink, baby blue or royal blue. They cost £7 – email [tazsembroideryshop1@gmail.com](mailto:tazsembroideryshop1@gmail.com) to order or visit [www.tazsembroideryshop.co.uk](http://www.tazsembroideryshop.co.uk) to find out more.

Rescue Dog I Am Nervous  
I Am Friendly  
Please Don't Touch Me  
I'm Nervous  
Please Adopt Me  
I Don't Like Other Dogs

I Don't Like Other Dogs

- Pages 18 and 19: a copy of the cover page and an internal page from the August 2014 edition of the magazine called *Your dog* (priced at £3.70), showing the following:



7. Relevant documents attached to the application form comprise:

- copies of pages 18 and 19 described above;
- A print of an eBay order confirmation to Mr Bryant from Mr Saville, user name 'jazzo-sazzo', dated 4 October 2014, for a 'personalised dog bandana embroidered message walks warning training high quality [Yellow, Black I'm Nervous]';
- A print of an email dated 6 October 2014 from 'jazzo-sazzo' (aka Mr Saville) to 'denise bryant' referring to Ms Bryant having cancelled Mr Saville's eBay order

for a 'dog bandana with Nervous embroidered onto it'. The item number is the same as for the eBay order print confirmation.

- A print showing Mr Saville's negative eBay feedback which he left.

8. Dexil's evidence comprises a witness statement of 16 January 2016 from Mr Saville, exhibits, and the documents attached to the counterstatement. I will describe those parts of it which are relevant to the issues to be decided in this case. Reputation and whether Mr Bryant's design is, itself, invalid, are not relevant to the matters which I must decide.

9. Mr Saville states that he/Dexil registered designs for dog collars, leads and harnesses which carry slogans in 2010. Mr Saville denies that he copied the bandana which he tried to purchase from Mr Bryant. He states that he tried to buy a bandana to use for a court case, but that Mr Bryant would not send it, cancelled the order and refunded Mr Saville's money. He exhibits a print of the refund confirmation on 6 October 2014.

10. Mr Saville states that the bandanas exhibited by Mr Bryant are different in that they bear different wording, are shown in different tones of red, and have either black or white fastenings. Dexil's bandanas include the 'Dexil' trade mark.

11. The pages attached to the counterstatement do not add anything further to the evidence (they deal with the eBay transaction and show other bandanas which Mr Saville claims show that Mr Bryant's design is invalid).

## **Decision**

12. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. 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 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-

- (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 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 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. This means that the relevant date for my assessment is 29 April 2015.

Scope of the registered designs

14. Dexil’s design application form describes the design as:

“Dog bandana/dog clothing with wording to show a dogs’ temperament/nature/ability/disability.”

The design was applied for as part of a multiple design application, for ten bandanas, each of a different colour and with a different slogan (e.g. 'Caution', 'Friendly', 'Nervous' etc.). (There is no claim to the trade mark Dexil as forming part of the registered design.)

15. Mr Bryant's earlier registered design is described as a "dog bandana with embroidered wording." Whilst the descriptions may be helpful, for example, to point out that the design is a bandana, 'any wording' represents an idea, or concept, without concrete identity. This is not protectable under design law. Dexil's registration, as part of a multiple series of registrations, is protected for the way the design looks; i.e. the red shape and the specific word CAUTION. Mr Bryant's design is also protected for the way the design looks; i.e. the red shape and the specific wording thereon, Rescue Dog I Am Nervous.

16. For economy of process, the focus will be on whether the registered design has individual character (rather than whether it was new; if it does not have individual character, it cannot be new). The relevant case law in this respect was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). The parts which are most relevant to these proceedings are reproduced below.

#### **"The informed user**

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, BAILII: [2010] EUECJ T-153/08 , 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

### **Design freedom**

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J summarised that passage from *Grupo Promer* as follows:

"design freedom 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)."

### **Effect of differences between the registered design and design corpus**

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

"as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements 'that are totally banal and common to all examples of the type of product in issue' and will concentrate on features 'that are arbitrary or different from the norm'."

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.



## **The correct approach, overall**

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. The informed user of dog bandanas is a consumer (i.e. a dog owner or someone who cares for dogs) as opposed to an actual designer or some other expert in the field. The informed user is not an average or standard consumer, it is instead someone who is likely to have an interest in dog clothing design; however, they will not make a forensic analysis of each and every detail.

18. The designer of dog bandanas has a very free hand in what design is actually used in terms of e.g. patterning or decoration. There is a wide degree of design freedom.

19. There is no evidence about design corpus. It would be wrong to speculate. This factor has a neutral influence on the findings I make.

### **What prior art can be relied upon?**

20. Prior art (i) is the applicant's own registered design which was filed on 28 May 2014 and it would have been published in the relevant design journal shortly thereafter. This counts as being made available to the public, with such publication having taken place during the year before the relevant date. Prior art (i) may, therefore, be relied upon in these proceedings.

21. Prior art (ii) relates to the articles in Mr Bryant's evidence which he claims have been made available to the public. The dating of the magazines and the eBay correspondence (corroborated by Mr Saville's evidence) shows that prior art (ii) was made available to the public prior to the relevant date. It may, therefore, also be relied upon in these proceedings.

22. In the counterstatement, it is claimed that Mr Bryant's registered design should be invalidated because of other bandanas, on eBay, going back to the 1990s. This, in and of itself, is not relevant. Firstly, if Dexil wishes to invalidate Mr Bryant's registered design then it must make a formal application to do so. Secondly, even if the registered design was invalid, this does not prevent Mr Bryant from relying on it as a piece of prior art. These proceedings are concerned only with whether Dexil's design lacks novelty on the basis of what was already in the public domain at the relevant date.

### **Individual character - analysis and findings**

23. The competing designs are shown below.

Prior art (i): Mr Bryant's design registration:



Dexil's design registration:



24. The shapes of the designs are very similar. They both come to a diagonal point at the base and have a slightly curved top. The length of the longer sides appear the same, although the shorter sides in Dexil's design appear proportionately slightly shorter than in Mr Bryant's design.

25. However, the designs are different in one important respect: the wording. This is highly noticeable and completely different. As I have already said, there is no protection for an idea. Protection is for the way a design looks. In this case, the designs both include prominent, entirely different, wording. When this is taken into account, the two designs have a different overall impression. The application for invalidation on the basis of prior art (i) therefore must fail.

26. Prior art (ii): the evidence:

**Useful product**

**Get the message across!**

This new and innovative range of canine bandanas could be just the thing if your dog has a particular behavioural problem he needs to 'voice'. With slogans including 'I don't like other dogs' and 'I'm nervous', the range has been created by dog-lover Denise Bryant, who was inspired by her own dog's dislike of other dogs running up to him.

You can choose from a set message or create your own, up to 20 characters. The 100 per cent cotton bandanas are available in one size (adjustable with Velcro), are machine washable and come in green, red, orange, yellow, pink, baby blue or royal blue. They cost £7 - email [tazsembroideryshop1@gmail.com](mailto:tazsembroideryshop1@gmail.com) to order or visit [www.tazsembroideryshop.co.uk](http://www.tazsembroideryshop.co.uk) to find out more.





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glossy, healthy skin and coat.

Dexil's registration:



The description of the eBay article corresponds with either the bandana shown immediately above, or the yellow 'I'm nervous' bandana in the first picture.

27. The same analysis and findings apply here as in relation to Mr Bryant's registration. Although the shapes of the articles are very similar, the wording is completely different and highly visible. The overall impressions of the designs are different. The application for invalidation on the basis of prior art (ii) therefore must also fail.

### **Outcome**

28. Dexil's design has individual character because the overall impression it produces on the informed user differs from the overall impression produced on such a user by prior art (i) or prior art (ii). The application for invalidation fails.

### **Costs**

29. Dexil has been successful and is entitled to a contribution towards its costs from the published scale (Tribunal Practice Notice 4/2007). I must, though, also take into account that Dexil has not been legally represented in these proceedings and that its costs would not, therefore, have included any professional legal fees. I therefore reduce by a half what I would otherwise have awarded.

Considering the application and filing the counterstatement	£100
Filing evidence and considering Mr Bryant's evidence	£250
Total	£350

30. I hereby order Peter Bryant to pay to Dexil Limited the sum of **£350** which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 25<sup>th</sup> day of May 2016**

**Judi Pike  
For the Registrar,  
The Comptroller-General**