

**O/066/17**

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

**REGISTERED DESIGN No. 500032**

**OWNED BY 'I WANT A STANDING DESK LIMITED'**

**AND**

**APPLICATION No. 2/16 BY MR RYAN ROBERTS**

**TO INVALIDATE THE REGISTERED DESIGN**

## The claims and the counterstatement

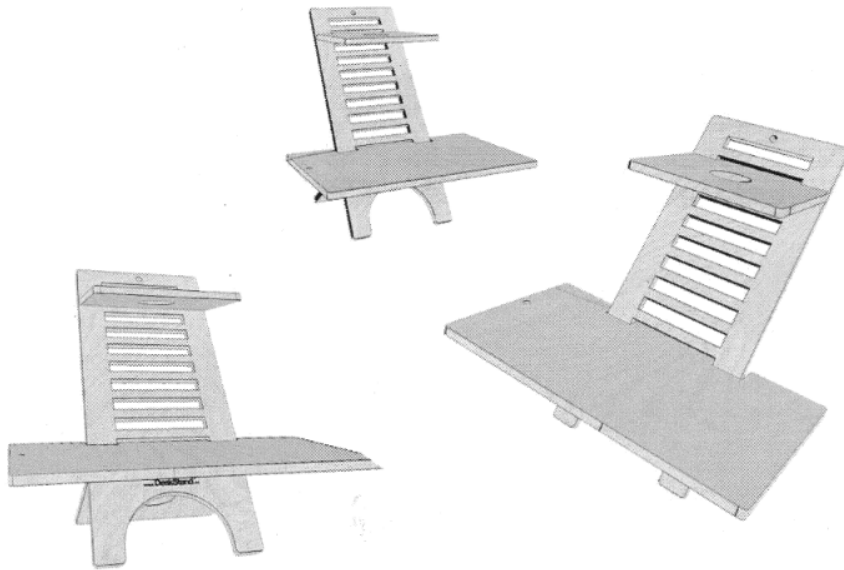
1. The registered design the subject of these proceedings was filed by I Want A Standing Desk Ltd (“IWASD”) on 6<sup>th</sup> October 2015. The design was subsequently registered with effect from that date. The design is depicted in the following representations.



2. The application form confirms that the design is for a “*retrofit standing desk*”.

3. No disclaimers were entered on the application form. This means that the wood/wood effect surfaces are part of the design.

4. On 1<sup>st</sup> March 2016, Mr Ryan Roberts of Cape Town, South Africa, (“the applicant”) applied for the registration of the design to be invalidated. The applicant claims that the registered design lacks individual character compared to a design for a product he calls the DeskStand. He says that he created the design for the DeskStand and first showed it to the public at an exhibition in South Africa called Design Indaba, which was held on 26<sup>th</sup> February 2015. A representation of DeskStand is shown below.



5. According to the applicant, the registered design should therefore be declared invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the ground that the design did not fulfil the requirements of section 1B (i.e. the contested design did not have the necessary “individual character”).

6. The applicant says that Mr Nick White, a director of IWASD, contacted him on 2<sup>nd</sup> June 2015 to enquire about becoming a distributor for the applicant’s products. Therefore, IWASD was aware of the DeskStand when it applied to register the contested design on 6<sup>th</sup> October 2015.

7. The applicant claims that he, and not IWASD, is the proprietor of the contested design. Therefore, the registration of the design in the name of IWASD should be declared invalid under s.11ZA(2) of the Act.

8. IWASD filed a counterstatement in which it:

- (i) Admitted that IWASD was aware of the DeskStand when it filed the application to register the contested design;
- (ii) Claimed that this was because IWASD had been following the applicant on social media;

- (iii) Accepted that desk stands embodying the DeskStand design were made available to the public in South Africa prior to IWASD's application for registration;
- (iv) Denied that persons carrying on business within the relevant sector of the market in the European Economic Area could have reasonably known of the existence of the applicant's DeskStand design;
- (v) Claimed that there are material differences between the registered design and the DeskStand design which mean that the designs are not identical and would not create the same overall impression on an informed user;
- (vi) Claimed that the relevant informed user is a user of desks and computer equipment, or a buyer of such goods;
- (vii) Claimed that the designer's freedom is limited by the requirement for the product to (a) sit on a desk, (b) be adjustable for people of different heights, (c) have a moveable flat surface for a computer to sit on, and (d) be solid enough to hold computer equipment;
- (viii) Denied that the DeskStand design played any part in the creation of the contested design;
- (ix) Put the applicant to proof of ownership of the DeskStand design, pointing out that the applicant's website states that it is "*a product of RC Agency*".

9. Both sides seek an award of costs.

### **The evidence**

10. The applicant filed three witness statements. It is convenient to start with Mr Roberts' third statement, which in contrast to his first two statements, appears to have been prepared with the benefit of legal advice.

11. The applicant says that he is the Director of Desk Stands (Pty) Ltd and the owner of RC Agency. According to Mr Roberts, he is the author of the DeskStand design. He claims that on or around February 2015 desk stands embodying the DeskStand design were made available to the public through the Facebook pages of Desk

Stands (Pty) Ltd. Some date stamped examples are in evidence.<sup>1</sup> Products embodying the DeskStand design were launched at the Indaba Design exhibition held in Cape Town on 26<sup>th</sup> February 2015. The applicant says that this is an international event which attracts 2500 delegates.<sup>2</sup> The DeskStand design became a finalist for an innovation award.

12. The applicant claims that following the event he received a number of enquiries from the UK, Netherlands and Germany. One of these was from Mr White of IWASD who emailed Mr Roberts on 2<sup>nd</sup> June 2015. A copy of the email communication is in evidence.<sup>3</sup> The email confirms that IWASD became aware of the applicant after he 'followed' the company on Twitter. Mr White's email says that *"I really like your product...I think the A stand is great."* He asked about selling the product in the UK and Europe. Mr Roberts replied on 4<sup>th</sup> June 2015 saying *"we currently wholesale export to the USA, UK, Europe and Australia"*. However, he was willing to discuss *"new opportunities"*.<sup>4</sup>

13. Mr Roberts provided copies of invoices dated in February/March and August to October 2015 for 'The Original DeskStand' addressed to customers in the UK, the USA and Europe.<sup>5</sup>

14. The applicant also provided 7 pages of images of 'desk stands' obtained from searching on those words on Google and other internet shopping sites.<sup>6</sup> The purpose of this was to show that that the DeskStand design was novel and stood out from the prior art.

15. IWASD's evidence consists of two witness statements by Mr Nicholas White and one by Mr Paul Galley of Antelope Design Ltd. Mr White's evidence is that Antelope Design Ltd created the contested design (which he calls the Eiger design) in September 2015 based on instructions he gave them in June 2015. He says that this is when the *"conceptualisation"* of the design began after he learned of a need for a

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<sup>1</sup> See exhibit 1 to Roberts W/S 3

<sup>2</sup> This is borne out by the contents of exhibit INT1 to Roberts W/S 1

<sup>3</sup> See exhibit EM1 to W/S Roberts 1

<sup>4</sup> It is common ground that this dialogue went nowhere, although the parties disagree why.

<sup>5</sup> See exhibit 2 to W/S Roberts 3 and exhibit INT1 to W/S Roberts 1

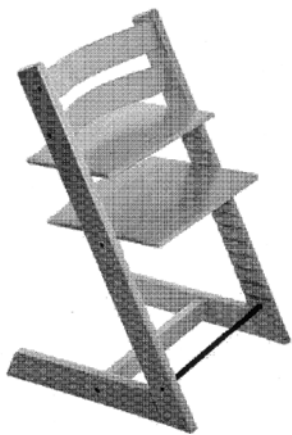
<sup>6</sup> See exhibit 4 to W/S Roberts 3

'retrofit' design that could be used with existing computer desks. Mr White says that he wanted a design that had a nautical 'sail like' effect and that was strong and eco-friendly. He denies that he took any inspiration from existing designs, including the applicant's DeskStand design.

16. Mr White says that he was not aware of the applicant's DeskStand design until June 2015 when the applicant's company followed his company's page on Twitter. He says that he approached the applicant's company about distribution because he *"wanted to evaluate any business competition in our core UK market and because the company did not seem to have sold many of its items through its ETSY retail page."* According to Mr White, the applicant's company was initially *"quite aggressive"* in response to his approach and asserted a collection of intellectual property rights which, despite his requests, it never substantiated. Mr White denies that he was ever truly interested in becoming a distributor for the DeskStand product.

17. Mr Galley's evidence is that he started working with Mr White of IWASD on 11<sup>th</sup> June 2015 and that the contested design *"was created purely from Mr White's instructions and having taken inspiration from modular chairs on the market as well as accounting for aspects necessary for functionality...."*

18. Mr White's second statement clarifies that the chairs he claims inspired the contested design were the historical and well known Tripp Trapp chairs. He provides some pictures of them, one of which is shown below.



19. Mr White also says that Baltic birch plywood is used for the Eiger design because of its strength, affordability and eco-credentials. He says that it is very commonly used in this marketplace and he exhibits some pictures of various pieces of furniture as well as some articles which bear this out.<sup>7</sup>

## **Representation**

20. IWASD is represented by Mathys & Squire. The applicant is a litigant in person. Neither side asked to be heard, but I have had the benefit of their written arguments.

## **Was the registered design new and possessed of individual character at the relevant date?**

### The relevant legislation

21. Section 1B of the Act (so far as it is relevant) 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.

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<sup>7</sup> See exhibit NW8

(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) -

(c) -

(d) -

(e) -

(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)--”



Section 1C(1) states:

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.”

The thirteenth recital to the Designs Directive 98/71/EC states that:

“(13) Whereas the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design”

22. The relevant date is the date of the application to register the contested design, i.e. 6<sup>th</sup> October 2015.

23. The application form identifies the product as a “*retrofit standing desk*”. I am not clear what that means, but it seems to be common ground that the relevant product is a desk stand. IWASD says that the relevant informed user is a user of desks and computer equipment, or a buyer of such goods. The applicant appears to broadly agree, except he says that limiting the relevant user to one who uses computer equipment is too narrow, the products at issue could be used for other desk equipment. In fact all the evidence shows the products at issue being used with computer equipment. This is plainly what the higher shelf is intended for. I therefore prefer IWASD’s submission on this point. In any event, I doubt that there are many work desks that do not have to accommodate a computer of some sort, so even if there is a real difference, the informed user of desk stands is probably also an informed user of desk stands for holding computer equipment. Therefore nothing turns on this distinction so far as the identification of the relevant informed user is concerned.

Prior art not disclosed to the public in the EEA

24. IWASD submits that the prior art has not been disclosed to the public in the EEA. Therefore, s.1B(5)(b) applies and the applicant's disclosure of the DeskStand design in South Africa does not count. This is right if the disclosure:

“...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.”

25. In *H. Gautzsch Großhandel GmbH & Co. KG v Münchener Boulevard Möbel Joseph Duna GmbH*<sup>8</sup> the Court of Justice of the European Union (“CJEU”) was asked the following preliminary questions.

“1. Is Article 11(2) of Regulation ... No 6/2002 to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders?

2. Is the first sentence of Article 7(1) of Regulation ... No 6/2002 to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if:

(a) it is made available to only one undertaking in the specialised circles,  
or

(b) it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?”

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<sup>8</sup> Case C-479/12

26. The CJEU answered these questions as follows:

“..... on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it”.

“... The same is true of the question whether the fact that a design has been disclosed to a single undertaking in the sector concerned within the European Union is sufficient grounds for considering that the design could reasonably have become known in the normal course of business to the circles specialised in that sector: it is quite possible that, in certain circumstances, a disclosure of that kind may indeed be sufficient for that purpose.

In the light of the foregoing, the answer to the second question is that, on a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.”

27. The facts in that case were that the prior art had been shown in showrooms in China and the design disclosed to a single undertaking in Belgium. The CJEU answers are, in effect, that disclosure in the EEA is a question of fact for national courts and tribunals to determine. However, it is clear that a single disclosure to a person in the relevant circles in the EEA may, on occasions, be sufficient to prevent article 7(1) of Regulation 6/2002 from applying. The same must be equally applicable

to the corresponding identical provisions of the EU Designs Directive<sup>9</sup> and the implementing national legislation, which includes s.1B(5)(b) of the Act.

28. It therefore appears that (a) disclosure outside the EEA may be sufficient to bring the design to the attention of *the circles specialised in the sector concerned* within the EEA, (b) the extent of the disclosure required need not involve widespread disclosure to relevant persons in the EEA. This is consistent with the European Commission's 1996 Amended Proposal for the Designs Regulation, which explained the exception as follows:

“...Article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the ‘safeguard clause’. Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.”

29. This is how the provision appears to have been applied in practice. For example, in *Senz Technologies BV v OHIM*<sup>10</sup> the General Court upheld OHIM's decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry.

30. Against this background IWASD's case under this heading appears untenable. Firstly, the applicant's unchallenged evidence is that the DeskStand design was shown at an international designs exhibition in Cape Town. The whole point of such an exhibition is, of course, to bring the design to the attention of those in the relevant trade circles, which is likely to include those in the EEA. Secondly, the applicant's

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<sup>9</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

<sup>10</sup> Joined cases T-22/13 & T-23/13

unchallenged evidence is that subsequent to the exhibition, but prior to the relevant date, his company sold a number of products embodying the DeskStand design to customers in the US and Europe. Against this background, Mr White's evidence that he only became aware of the DeskStand design because the applicant was following his company on social media, even if true, cannot be enough to avoid the conclusion that the DeskStand design was disclosed to the circles specialised in the sector concerned within the EEA prior to the relevant date. Consequently, I find that s.1B(5)(b) does not apply.

31. It is therefore necessary to compare the contested design to the prior art in order to determine whether the contested design was new and possessed 'individual character' at the relevant date.

#### Comparison with the prior art

32. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>11</sup>. The most relevant parts are re-produced 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, 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:

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<sup>11</sup> [2012] EWHC 1882 (Pat)

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 the 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."

### Analysis

33. IWASD draws my attention to the following differences between the contested design and the prior art.

- (i) The contested design is thinner at the top of the central section and flares towards the base whereas the central section of the prior art design is the same width from top to bottom.
- (ii) The bottom of the contested design is flat to the ground whereas the prior art design includes a semi-circular cut-out.
- (iii) The horizontal holes down the central section of the contested design are curved at the ends whereas the corresponding holes in the prior art design are strictly rectangular.



- (iv) The top shelf part of the contested design is solid whereas the prior art design has a hole through its centre.
- (v) The shelves in the contested design have curved leading edges whereas the shelves in the prior art design are strictly rectangular with straight edges.
- (vi) The contested design shows a small rectangular device near the top of the design where the prior art design shows a faint circle.
- (vii) The back support section of the contested design has a large rhombus shaped cut-out whereas the corresponding part of the prior art design is more solid with just a circular cut-out.

34. As regards the last point above, I note that the shape of the cut-out in the back support section of the contested design cannot be fully seen from the representations of the design in the register. IWASD cannot rely on differences between the designs that are not apparent from the entry in the register. Therefore it cannot rely on the contested design having a large rhombus shaped cut-out from the back support section of the design. However, it is apparent from the representations on the register that the back support section of the contested design is not solid with a hole in the centre like the corresponding part of the DeskStand design. Therefore, this must be taken into account.

35. The first question is whether the contested design is a new design compared to the DeskStand design. This depends on whether its *“features differ only in immaterial details”*. In my view, the flared (as opposed to straight sided) profile of the central section of the design and the flat base (as opposed to the semi-circular cut-out at the base of the prior art) are not immaterial details in the sense they permit products made to the design to be distinguished to some degree from the DeskStand product.

36. Therefore, the contested design is new as compared to the DeskStand design.

37. However, in order to qualify for design protection the contested design must be both new and possessed of ‘individual character’. As Birss J. stated in *Apple v Samsung*, *“products which can be distinguished to some degree from the*

*registration*” may nevertheless create the same overall impression on an informed user and therefore lack individual character.

38. In my view, the slightly curved line of the leading edge of the shelves in the contested design and the small rectangular device near the top of the design are immaterial differences from the DeskStand design which are unlikely to impact on the overall impression created by the design on (even) an informed user.

39. The presence of a hole in the top shelf of the DeskStand design (and the absence of such a feature in the contested design) is likely to have only a minor influence on the overall impression created by the design on an informed user. When the shelf of the DeskStand is in use the hole will normally be covered by a computer. At those times this difference from the contested design will have no impact on the informed user.

40. The difference in the shape of the cut-outs in the back support section of the designs will also have no more than a minor influence on the overall impression created by the designs. Users normally work in front of the products. Therefore the front view of the designs will make a far bigger contribution towards the overall impression created than the shape of the cut-outs in the back support sections.

41. I am not sure whether an informed user of the products would, without minute scrutiny, notice that the horizontal holes down the central section of the contested design are curved at the ends whereas the corresponding holes in the DeskStand design are strictly rectangular. Even if (s)he would notice this detailing, it would make only a minor contribution towards the overall impression created by the designs on an informed user.

42. This means that the flared (as opposed to straight sided) profile of the central section of the contested design and the flat base (as opposed to the semi-circular cut-out at the base of the DeskStand design) are the features of the contested design which are most likely to result in the contested design creating a different overall impression compared to that created by the DeskStand design.

43. In deciding whether the cumulative effect of all the noticeable differences between the designs is sufficient for the designs to create different overall impressions on an informed user it is necessary to take into account (a) the informed users knowledge of the design corpus, (b) the extent to which DeskStand and the contested design stand out from the design corpus, and (c) the degree of design freedom of the author in creating the design(s).

44. IWASD submits the designer's freedom is constrained by the requirement for a desk stand to (a) sit on a desk, (b) be adjustable for people of different heights, (c) have a moveable flat surface for a computer to sit on, and (d) be solid enough to hold computer equipment. I accept this submission, so far as it goes. However, the applicant's evidence shows that these requirements can be met by a wide variety of designs, few of which look anything like the designs at issue in this case. The closest design for a desk stand that I can see in the applicant's evidence looks like this.



45. In my view, this design is significantly different to the designs at issue here, the striking features of which are:

- (i) The relatively tall backward leaning central section of the product with horizontal apertures for fitting height adjustable shelves;
- (ii) A back support section which fits into, and protrudes through, the bottom aperture of the front section, which it meets at a roughly 90° angle, and runs backwards to meet the work surface, thereby acting like a single wide stabilising 'leg' for the tall central section of the design;
- (iii) The presence of two height adjustable shelves which fit into the horizontal apertures of the tall central section and are supported cantilever style to project forward level with the surface of the desk below so as to provide two work surfaces, the bottom one noticeably larger than the top one.

46. IWASD filed no evidence going to the design corpus.<sup>12</sup>

47. I therefore conclude that the key features of the DeskStand design (and by extension the contested design) are quite different from the design corpus. Further, I reject IWASD's submission that the freedom of the designer in this field is particularly constrained by functional requirements. On the contrary, there appears to be considerable scope for varying designs that meet the functional requirements described in paragraph 44 above.

48. The type of wood used for the product is not part of the registered design and is therefore irrelevant. The fact that both designs have a wood finish is relevant, but given the banal nature of this feature, it is of little importance. Its only real significance is that it prevents IWASD from arguing that the wood finish of its product helps to differentiate its design from that of the DeskStand design.

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<sup>12</sup> Although it was provided for a different purpose, I have noticed that the desk stand shown on page 23 of exhibit NW7 to Mr White's statement of 21<sup>st</sup> October 2016 shows a multi-level desk stand with a certain degree of similarity to the designs at issue here, although nowhere near as much similarity as they show to each other.

49. In my judgment, the novel key features shared by the contested and DeskStand designs will contribute much more strongly to the overall impression created by the designs on an informed user of desk stands than the few noticeable differences of detail described above.<sup>13</sup> I therefore find that these designs would create the same overall impressions on an informed user. It follows that the contested design lacked individual character at the relevant date and the registration is therefore invalid.

50. In reaching this conclusion I reject IWASD's submission that such a finding effectively entitles the applicant to a right in a concept or idea for a desk stand. Strictly speaking this is irrelevant because it is IWASD that claims an exclusive right to the contested design. The applicant's claim is simply that the contested design is not novel. However, for the avoidance of doubt, I should make it clear that I have approached this case mindful of the rule that design rights entitle their owners only to protect the expression of an idea, not the idea itself. For the reasons given above, I find that the contested design takes too much of the expression of the applicant's design.

### **The claim that IWASD is not the proprietor of the contested design**

51. In the light of my finding that the contested design lacks the necessary individual character there is strictly no need for me to deal with the applicant's other ground for invalidation. I will therefore limit myself to the following points.

52. Section 11ZA(2) of the Act is as follows:

“2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

53. The relevant parts of section 4 are as follows.

“(4) The author of a design shall be treated for the purposes of this Act as the

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<sup>13</sup> The position might have been different if the prior design stood out less from the design corpus than it appears to have done.

original proprietor of the design, subject to the following provisions.

(1A) [Repealed]

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) -

(3) In this Act the “author” of a design means the person who creates it.”

54. IWASD put the applicant to proof that he is the proprietor of the DeskStand design. Mr Roberts’ evidence is that is the author of the DeskStand design. He says that he is the owner of RC Agency. There is nothing to suggest that he created the design whilst an employee of that business. Consequently, in my view, he has satisfactorily proved that he is the proprietor of that design.

55. IWASD’s primary defence under this heading is that the contested design was created independently of the DeskStand design on the basis of instructions given to Antelope Design Ltd on 11<sup>th</sup> June 2015. The fact that this was only 9 days after Mr White contacted the applicant about becoming a distributor for the DeskStand design, and 7 days after being told that the applicant already exported wholesale to Europe is said to be pure coincidence. According to Mr White, the contested design was actually inspired by the design for the well known Tripp Trapp chair.

56. I am conscious that Mr White has not been cross examined on his evidence. However, it has been clear throughout that the applicant challenged the veracity of this evidence. On the face of it, the close proximity between the timing of IWASD’s keen interest in commercialising the DeskStand design and Mr White’s instructions to Antelope Design Ltd to create the contested design, strongly suggests that the DeskStand design was, at the least, the inspiration for the contested design. In this connection, I find it significant that neither Mr White nor Mr Galley gave clear evidence as to the content of Mr White’s design instructions. Mr White’s evidence on this point focuses on what the instructions were not. Mr Galley simply says that the design he created was based on Mr White’s instructions. One would have thought that it would have been easy enough for the witnesses to show, or at least provide a full description of, Mr White’s design instructions. In the absence of such evidence,

and bearing in mind (a) the apparent degree of novelty of the DeskStand design in its field, (b) the timing of Mr White's design instructions, and (c) the striking similarity between the designs, I regard Mr White's evidence that the contested design was actually inspired by a design for a wholly different product (which had been around for decades) as incredible. I cannot therefore accept this evidence.

57. This leads me to a difficult question of law. If IWASD has taken the DeskStand design and modified it to create a slightly different design, albeit one that creates the same overall impression on an informed user as the DeskStand design, does this mean that the applicant is the proprietor of the contested design? I have not had the benefit of arguments on this point. In the circumstances, I think the answer to this legal question should await a case that requires it and where the point has been properly argued. As I have already observed, the outcome of the section 11ZA(1)(b) ground is sufficient to determine this case. I therefore make no finding on the section 11ZA(2) ground for invalidation.

## **Conclusion**

58. The contested design is invalid because, at the relevant date, it lacked the necessary individual character compared to the disclosed DeskStand design. Subject to appeal, the registration will be declared invalid and cancelled.

## **Costs**

59. The application has succeeded, Mr Roberts is entitled to a contribution towards his costs. Mr Roberts acted as a litigant in person and this has therefore limited his legal costs, although he evidently took legal advice before completing his third witness statement. I will therefore order I Want A Standing Desk Ltd to make a contribution towards the cost of filing the application and to recompense Mr Roberts for the cost of some of the time taken to present his case through his evidence. I order I Want A Standing Desk Ltd to pay Mr Ryan Roberts the sum of £550.

This is made of:

£150 for filing the application for invalidation and considering the counterstatement (official fee plus 5 hours at £20 per hour);  
£ 400 for filing evidence and considering evidence in support of the registration (20 hours at £20 per hour).

60. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

**Dated this 15<sup>th</sup> Day of February 2017**

A handwritten signature in black ink, appearing to be 'Allan James', written over a horizontal line.

**Allan James  
For the Registrar**