

O-636-17

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF

REGISTERED DESIGN NO 5002784

OWNED BY DEXIL LIMITED

FOR THE FOLLOWING DESIGN:

SERVICE DOG

AND

AN APPLICATION (No. 03/17) FOR INVALIDATION BY BAMBOO TOOLS S.L.

The background and the claims

1. The registered design the subject of these proceedings was filed by Dexil Limited (“the proprietor”) on 6 May 2016. The design, which is described as a “logo for use on dog/animal clothing, saddlery and apparel”, looks like this:



SERVICE DOG

2. The proprietor included a disclaimer on the form of application reading “No claim is made for the colour(s) shown”.

3. The applicant for invalidation is Bamboo Tools S.L. (“the applicant”). It claims that the design is not new because:

“[t]he term “SERVICE DOG” was already widely used worldwide to identify or label dogs which were making public services much before the registration of [the design]. Moreover, the term “SERVICE DOG” was used in legal documents before that date”

4. The above claim relates to section 1B of the Registered Designs Act 1949 (“the Act”). Evidence accompanied the applicant’s statement of case which I will summarise later in this decision.

5. The proprietor filed a counterstatement denying the grounds on which the application is made. It makes particular points about the evidence provided by the applicant, which I also return to later.

6. Both sides filed evidence, which included submissions. Neither side asked to be heard. Both sides have represented themselves throughout the proceedings.

Section 1B of the Act

7. 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.

(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)--”

8. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*¹. The most relevant parts 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, 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);

¹ [2012] EWHC 1882 (Pat)

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.”

The relevant date

9. The relevant date is the application date of the registered design, namely 6 May 2016.

The informed user

10. Given the purpose of the articles on which the design is to be applied, the informed user will be a user of dog/animal clothing, saddlery and apparel.

The evidence

11. The applicant has provided various prints showing the use, in some form or another, of the words SERVICE DOG. It is claimed that such use destroys the novelty in the registered design. The first task for the tribunal is to assess whether a relevant disclosure has been made to the public before the relevant date, and to determine what has been disclosed. I set out first what was contained in the applicant’s statement of case (which was filed by a Mr Xavier Rodriguez), of which there were five sources of claimed prior art:

- i) An extract from the website www.brietbart.com featuring an article titled “AMERICAN AIRLINES TELLS VET WITH PTSD HIS SERVICE DOG IS NOT ALLOWED ON FLIGHT”. The content of the article is self-explanatory. There is a date within the URL of the web address reading 23 September 2015. The article also contains a picture of the dog in question which looks like this:



- ii) An extract from the US Department of Justice’s website about service animals. I need say no more about this extract because it does not actually use the words SERVICE DOG.
- iii) Prints from the website lifechangingservicedogsforveterans.org which features a number of what are described as “success stories”, focusing on individuals who have been paired with service dogs to assist with conditions such as PTSD. The words “service dog” are used a number of times such as “...he was paired with his service dog...”. There are pictures within the extract, the one which features the words SERVICE DOG the clearest is depicted below. Although the success stories are from before the relevant date, there is nothing to show that the article itself was published before then:



- iv) An extract from www.federalregister.gov headed "Service Dogs". The article, which was published in 2012, relates to the rules concerning veterans in need of service dogs.
- v) An extract from awaonline.org, the website of the Animal Welfare Institute. It uses the words "service dog" a number of times. It contains a link to the preceding source, although, the extract itself is not dated.

12. The applicant filed further evidence under cover of what was a counterstatement (to the proprietor's counterstatement). However, as it contains a statement of truth (from Mr Rodriguez) I will give it evidential weight. The additional sources are:

- vi) An extract from the website bbc.com titled "Advocates fight against fake service dogs". There are frequent references to the words Service dogs/service dogs/service dog throughout the article, which is about handlers who are falsely claiming that their dog is a service dog and that items such as tags and harness are sold to support his. The article is dated 26 March 2015. The story itself has a US focus. Some dogs are depicted wearing harness, the clearest of which looks like this.



- vii) An extract from www.gov.uk titled "MOD Police Dog scoops top canine award". The article was published on 30 July 2013. It contains the words Service Dogs/service dog a number of times. There is a photograph of a dog wearing an item of dog apparel which reads: "RSPCA Service Dog of the Year".

- viii) A Wikipedia entry headed “Service dog”, about service dogs. It is not clear when this entry was added to Wikipedia.

13. Although not filed as a source of prior art, Mr Rodriguez also provided a copy of a take-down email issued to the applicant on behalf of the proprietor in respect of an item consisting of a patch containing the plain words SERVICE DOG. The email is dated 16 December 2016. The point made by Mr Rodriguez is that the font used differs from that of the proprietor’s design (although both are unremarkable) and, so, the proprietor was really just attempting to register the words themselves.

14. Two counterstatements were filed by a Mr Johnathan Saville on behalf of the proprietor. Much of what he says consists of submission and/or a critique of the applicant’s evidence. The following points are those which are relevant, or potentially relevant, to the matters at hand:

- i) Points are made about the applicant’s evidential sources being downloaded from the Internet and that dates/content could have been modified.
- ii) That the actual dates, even if they were not modified, could in fact be wrong.
- iii) That the registered design is for a “logo picture design” which should not be compared to standard wording used in articles.
- iv) That the websites are mainly US based.
- v) That where SERVICE DOG is used on an item worn by a dog, the font and colours are different and the words are accompanied by other words such as “DO NOT PET” and “IN TRAINING”.

Dates/modifications

15. I deal first with the proprietor’s points about the dates/contents of the Internet prints and whether they could have been modified, and, also, whether the dates themselves could in any event be wrong. I note that in response to the proprietor’s

points, the applicant states that the prints were simply obtained from the Internet and he highlights, for example, that some of the sources are official government ones.

16. I come to the view that there is no reason to believe that the applicant has modified the date of the prints or any of the content therein. What the proprietor states is purely speculative. It is not as though, for example, that the proprietor has checked the sources on the Internet (or at least there is no evidence showing that it has) or sought any form of verification. Therefore, beyond such speculation, there is nothing to cast any doubt on the veracity of the prints. In terms of the correctness of the dates themselves, again, there is no reason to suppose that they are wrong and nothing provided to call the evidence into doubt. Thus, for prints which can be placed before the relevant date, I accept their content as fact.

US websites

17. The next point I consider relates to the largely US origin of the Internet prints. Put simply, whether something has been disclosed to the public is not geographically limited. Although this matter relates to a UK registered design, the novelty of that design can potentially be destroyed by a relevant disclosure anywhere in the world. There is one exception to this (see section 1B(6)(A)) which relates to what is often termed “obscure disclosure”, the effect of which is that a disclosure is to be ignored 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”

18. However, the proprietor’s point appears to be simply based on the fact that the sources are from the US, as opposed to them being obscure. Therefore, the exclusion is not applicable. Even if one were to construe the proprietor’s comments as a reference to obscure disclosure, the Internet extracts are from publically available and well-known websites, including a US Government website, which contains articles and information about service dogs. Thus, I do not regard these as sources that could not have become known in the normal course of business to a person carrying on the relevant business in the EEA and specialising in the sector concerned.

What prior art can be considered?

19. I will return to the other points made by the proprietor shortly. For the time being, I set out below what I accept as the relevant prior art, although, as some forms duplicate others, I list only one type of each:

i) The following image, disclosed on the BBC website:



ii) The words “service dog” used in a number of sources as part of various pieces of information.

iii) The words SERVICE DOG as part of the title in the Brietbart article.

20. There are, of course, other variations of use set out in the evidence, but none which take the applicant any further forward.

The comparison

21. In terms of design freedom, the designer was not constrained in any material way in creating a “logo for use on dog/animal clothing, saddlery and apparel”. A logo could comprise anything. Even if the logo was intended to also provide an informative message (which the design clearly does), this could, again, have been achieved in a whole host of ways.

22. Beyond the prior art, there is no evidence about the design corpus as a whole. However, I still think it fair to say that the two words of which the design comprises are

represented in a quite minimalist way, with little by way of stylisation. Thus, it is unlikely that the design stands out from the crowd to any material extent.

23. I will come onto the point shortly about additional words being used with the prior art, but if one were to compare the registered design with the words SERVICE DOG in the picture that forms part of the BBC Article, the relevant comparison looks like this:



24. I should firstly say that despite the S and E in the prior art being partially masked, it is clear to me that it still consists of the words SERVICE DOG in plain letters as per the rest of those words. In terms of the comparison, both comprise the word SERVICE DOG depicted upon a plain rectangular border. The border is in a contrast colour to the words. Both use an extremely plain, albeit slightly different, font. Both are presented in capital letters. I take the view that the differences are so small that they ought to be regarded as immaterial. A design must be new to qualify for protection, with section 1(B)(2) defining what it meant by this:

“...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.”

25. Given my view that the differences are immaterial, the prior art is considered identical which, in turn, means that the registered design was not new when it was filed. However, even if am wrong on whether the differences are immaterial, to be novel the registered design must also have individual character. In relation to this, section 1(B)(3) states:

“...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.”

26. The overall impression of the registered design does not, in my view, differ from the prior art depicted above. The overall impression of both will be based upon the plain words SERVICE DOG on a rectangular border.

27. The proprietor points out that the prior art is accompanied by other words, in the case of the picture above, the words DO NOT PET. Whilst this is noted, I do not consider that this assists. First, in the actual photograph above, the words DO NOT PET appear on a separate rectangular border. Whilst the co-affixing of both produce an overall informative message, the SERVICE DOG element is a self-standing design. Second, the whole point of design protection is to reward (through protection) a designer who has created something new (or which has individual character) compared to what has gone before. The registered design, as per my findings, has gone before. A designer should not be rewarded with protection when what has gone before simply happens to be presented alongside something else.

28. My finding is that the claim under section 1(B) succeeds on the basis of the above prior art.

The other prior art

29. It is not strictly necessary to consider the other forms of prior art. However, I express my view briefly that the disclosure of the word SERVICE DOG (in the Brietbart article) and service dog (in various sources) also destroys the novelty of the registered design. The comments I made earlier about the prior art being used with other words is applicable here also. The proprietor also commended that the words in articles should not be compared because they are not being used as logos etc. on articles. Whilst this point is noted, I do not consider that the use of something, including words, in an article is excluded from constituting a relevant disclosure and prior art.

30. In essence, the proprietor’s case is flawed because its registered design is so simple in nature. The informed user will see little else in the design other than the

words, with the consequence that the design does not differ in overall impression from the words themselves. The font is so basic that this will play little role. The border is simply something upon which the words have been placed. Given this, the claim under section 1(B) succeeds also on the basis of the other prior art.

Outcome

31. The grounds have succeeded. Therefore, subject to appeal, the design is to be invalidated.

Costs

32. At the end of the proceedings the parties were sent a letter (on 13 September 2016), indicating that if they wanted to claim costs they should complete a costs proforma, setting out the hours expended in dealing with the proceedings, otherwise no costs would be awarded. The proprietor responded, the applicant did not. The proprietor is not entitled to costs because it was the unsuccessful party. The applicant was the successful party, but because it has made no claim, I can make no award other than in relation to the cost of filing the form requesting invalidation, a fee of £48.

33. I order Dexil Ltd to pay Bamboo Tools S.L. the sum of £48 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th Day of December 2017

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