

O/039/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGNS 6039901, 6039907 AND 6039908

IN THE NAME OF WILD BOARDS LIMITED

AND

APPLICATIONS FOR INVALIDATION (NOS 11/19, 17/19 AND 18/19)

BY LIN BING

Background and pleadings

1. Wild Boards Limited (“the registered proprietor”) filed application no. 6039901 for a registered design for a sphere cube in Class 21, Sub class 01 of the Locarno Classification (Games and Toys) on 25 July 2018. It was registered with effect from that date and is depicted in the following representations:



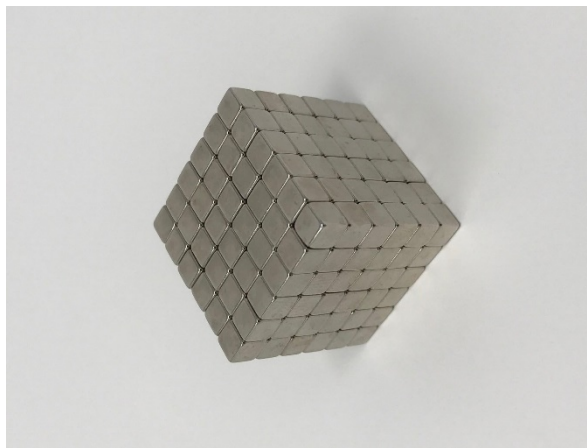
2. The following disclaimers were entered on the register:

No claim is made for the colour shown; No claim is made for the pattern of the spheres.

3. On the same day, the registered proprietor also filed application no. 6039907 for a registered design for a silver cube of spheres in the same sub-class of the Locarno Classification. It was also registered with effect from 25 July 2018 and is depicted in the following representation:



4. The registered proprietor made a third application (no. 6039908) on the same day and in the same sub-class of the Locarno classification for a metal cube made of cubes. It was registered with effect from 25 July 2018 and is depicted in the following representation:



5. No disclaimers were entered for either design no. 6039907 or design no. 6039908.

6. On 26 March 2019, Lin Bing (“the applicant”) made applications for each of the registered designs to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the designs did not fulfil the requirements of section 1B of the Act, as they were not new nor did they have individual character compared to other designs that had been made available to the public before the application date of the designs. The applicant claims that those designs first appeared on Wikipedia in 2009 and were the subject of an article on the website of *The Daily Mail* (“MailOnline”) in 2014.

7. The registered proprietor filed counterstatements to all three applications for invalidation on 17 May 2019, denying the applicant’s claims. In particular, it states that:

- the colour pattern of design 6039901 is a “unique” pattern of six colours, not seen in any of the evidence shown in the statement of case;
- design 6039907 is a “unique silver coloured design” not seen in the evidence shown in the statement of case and that confirmation of the colour can be provided by spectrophotometric testing if required;
- design 6039908 is a different shape from any design in the statement of case, as it consists of a cube made of smaller cubes, and that confirmation of the colour can be provided by spectrophotometric testing if required; and
- Wikipedia and other internet sources are not reliable evidence as the dates of an entry or an article can be modified.

8. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Isabelle Bertaux and the registered proprietor represents itself.

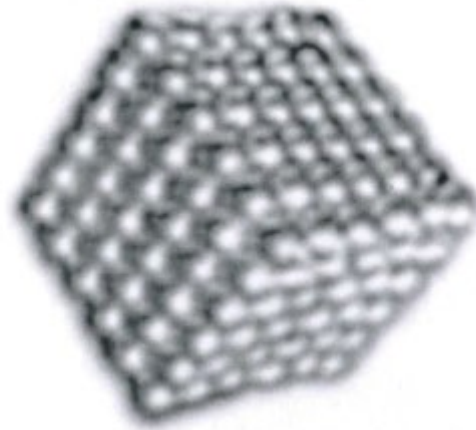
Evidence

9. The applicant submitted very brief evidence alongside its statement of case. It is the same for all three invalidation requests and consists of two items. The first is the Wikipedia entry for “Neodymium magnet toys”. This entry contains several images, including one of spheres constructed in the shape of a cube. The applicant states that this shows that the products first appeared on Wikipedia in 2009. The entry reports that sphere magnets sold as toys were launched at the New York International Gift Fair in 2009.

10. This piece of evidence does not help the applicant. There is nothing to suggest that the cube image represents the product that was launched in 2009, nor does it indicate when that image was made available to the public. The Wikipedia entry was last updated on 27 January 2019, which was after the date of application. It is impossible to tell when the image was added.

11. The second item is an article from MailOnline: “Magnet toys to be banned after toddler died swallowing seven balls and 7,700 children were admitted to hospital”. The

article is dated 5 September 2014 and was updated later the same day. It contains an image of the magnets in several different shapes, with what appears to be a 6 x 6 x 6 cube in the top right. Unfortunately, the image (reproduced below) is a little fuzzy but the spherical nature of the magnets is identifiable.



Decision

12. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid –

...

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act”.

13. Section 1B of the Act is as follows:

“(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 or no 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 account.

(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 conditions 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 period of 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 to 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.”

14. I shall first consider what, if any, prior art the applicant may rely upon. The prior art must have been made available to the public by the relevant date, which is the date of application (25 July 2018), and its disclosure must not fall within one of the exceptions set out in section 1B(6) of the Act. I have already noted the limitations of this evidence from Wikipedia.¹ The applicant may not rely on this evidence as a disclosure under section 1B of the Act.

15. The registered proprietor also casts doubt on the probative value of the second item adduced by the applicant. The registered proprietor is correct that it is possible to amend articles. However, I must be guided by a consideration of the balance of probabilities. The article in question was, as I have already noted, published on 5 September 2014 and updated later the same day. Both these dates are clearly visible on the print-out. It does not seem to me probable that these dates have been changed. An article appearing on MailOnline could, in my view, reasonably have become known before the relevant date to persons specialising in the toys and games sector in the European Economic Area (EEA). I find that the applicant may rely on this evidence as a disclosure under section 1B of the Act.

16. I must now decide whether the designs have the required novelty and individual character when compared with this disclosure. The relevant case law was conveniently set out by HHJ Birss (as he then was) in paragraphs 31 to 59 of his judgment in *Samsung Electronics (UK) Ltd v Apple Inc.* [2012] EWHC 1882 (Pat). I have reproduced the most relevant parts 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-281/10 P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

¹ Paragraph XX.

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, *Shenzhen* 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.”

Informed user

17. The designs are described as a sphere cube (no. 6039901), a silver cube of spheres (no. 6039907) and a metal cube made of cubes (no. 6039908). All three designs are classed as Games and Toys. The informed user is, therefore, a person who uses games and toys and takes a particular interest in their features. They may also be a parent, relative or carer who chooses and buys games and toys to give to children.

Design freedom

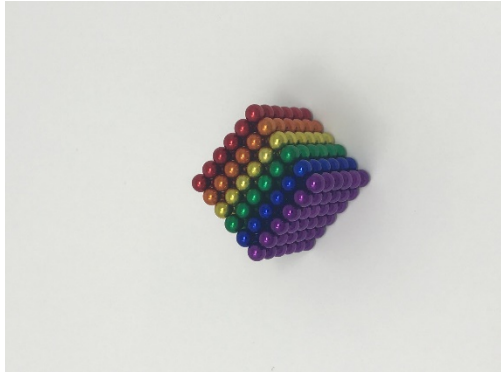
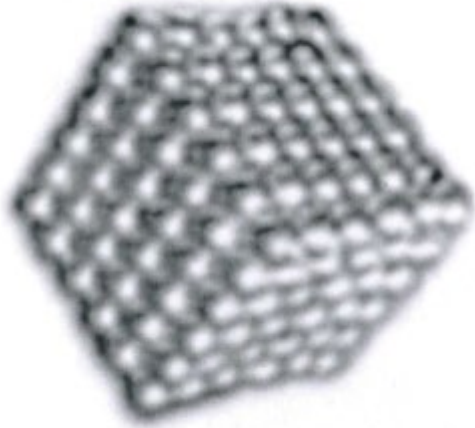
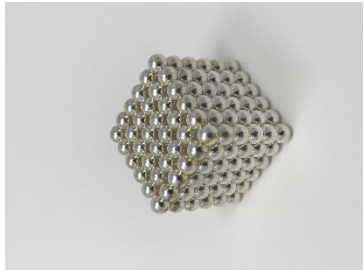
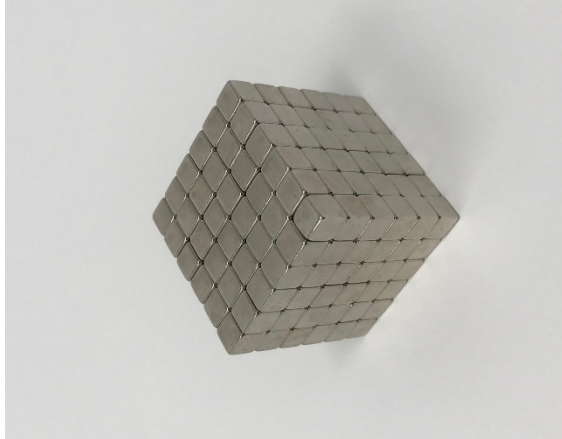
18. The designer has limited freedom in terms of the shape: all are cubes, which means that the height, width and depth of the design must be identical. The shape of the components that make up the design as a whole is also specified. However, the number and size of these components may differ. The designer may also choose to include surface decoration, although I note that in the case of design no. 6039901 the registered proprietor has disclaimed both the colour and the pattern of the spheres.

The design corpus

19. Beyond the designs that the applicant has sought to rely on as disclosures, no other evidence of the design corpus has been provided. It is, therefore, difficult to make an assessment of how far these designs stand out from other cubes, made up of spheres or cubes, in the public domain at the relevant date. Consequently, this factor is neutral.

Comparison of the designs

20. In the table below I show the registered designs alongside the prior art upon which the applicant may rely:

The Registered Designs	The Prior Art
<p data-bbox="204 253 389 286">No. 6039901</p> 	
<p data-bbox="204 752 389 786">No. 6039907</p> 	
<p data-bbox="204 1149 389 1182">No. 6039908</p> 	

Design no. 6039907

21. I shall consider first design no. 6039907. This is a cube made up of silver spheres, with each of the six faces consisting of 36 spheres (6 x 6). Despite the fuzziness of the applicant's image, it is clear that the number of spheres is the same. The article

contains other images, so the product referred to in the article may not have been sold in this form. Nevertheless, the 6 x 6 x 6 cube was in the public domain. The colour of the prior art cube is not clear, although it appears to be a uniform, fairly light colour.

22. At this point, it is appropriate to consider whether the shiny silver colour forms part of the registered design, and so should be compared with the prior art. As the Supreme Court confirmed in *Magmatic Limited v PMS International Limited* [2016] UKSC 12, an applicant for a design may – within broad limits – submit any images they choose to represent the design, and it will almost always be those images that determine the scope of the protection.

23. In its counterstatement, the registered proprietor states that it considers the silver colour to be a unique feature of the design. The representation shows the product as silver in colour. Consequently, I come to the view that the registered design covers not just the shape and configuration of the design, but also its colour. I am therefore unable to find that the designs are identical, which is what is required for there to be a lack of novelty.

24. When assessing whether the registered design has individual character, I must take into account the factors that I have considered above (the informed user, the degree of design freedom and the design corpus), as well as an analysis of the overall impression of the designs. The configuration of the design and the light-ish colour, to my mind, would create the same overall impression in the eyes of the informed user. Consequently, I find that design no. 6039907 did not have individual character at the relevant date and the application for invalidation of this design under section 11ZA(1)(b) of the Act succeeds.

Design no. 6039901

25. In its counterstatement, the registered proprietor drew attention to the “unique” colour pattern of this design. However, when applying for the design, the proprietor made the following disclaimers:

No claim is made for the colour shown; No claim is made for the pattern of the spheres.

26. Rule 6 of the Registered Designs Rules 2006 (SI 2006/1975) provides that:

“An application for the registration of a design may be accompanied by a disclaimer which –

(a) limits the scope or extent of protection being applied for in relation to the design; or

(b) ...”

27. I must therefore disregard the particular colours shown in the registration. It is less clear what the registered proprietor meant by the second disclaimer, and it has not provided any clarification in his counterstatement. The only pattern I can discern is the arrangement of six different colours in equal bands in the order in which they appear in the colour spectrum. The individual spheres do not appear to have any surface decoration.

28. If I disregard both the particular colours and the bands of colour pattern, what remains is the same shape and configuration as shown in design no. 6039907. As I found that that design lacked individual character, so I find that design no. 6039901 also lacks individual character. The application for invalidation of this design under section 11ZA(1)(b) of the Act succeeds.

Design no. 6039908

29. Instead of spheres, design no. 6039908 comprises smaller cubes, which together make a larger 6 x 6 x 6 cube. This is not identical to the prior art. In my view, the overall impression of the two designs is also different. The informed user is, it must be remembered, knowledgeable and observant, and attention to detail matters. A cube constructed from cubes has a different look to a cube constructed from spheres. The application for invalidation of this design under section 11ZA(1)(b) fails.

Conclusions

30. The registered designs nos. 6039901 and 6039907 are declared invalid under section 11ZA(1)(b) of the Act.

31. Registered design no. 6039908 remains registered.

Costs

32. Both parties have had some success in these proceedings, with the greater part going to the applicant. In the circumstances, the applicant is entitled to a contribution towards the costs of the proceedings in relation to the applications in which it was successful, in line with the scale of costs set out in Tribunal Practice Notice 2/2006. I have taken account of the fact that the same pleadings and statements were made in relation to all three applications. I award the applicant the sum of £246 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fees (INV 11/19 and 17/19): £96

Preparing a statement of case and considering the other side's statement: £150

Total: £246

33. I order Wild Boards Limited to pay Lin Bing the sum of £246. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 20th day of January 2020

Clare Boucher

For the Registrar,

The Comptroller-General