

O/373/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6001633

OWNED BY RAS TRADING EUROPE LIMITED

AND

APPLICATION NO. 48/19

BY SHENZHENSCHICHENGYUHANSHIYEOUXIANGONGSI

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The registered design which is the subject of the dispute was filed by RHS Trading Europe Limited (“the registered proprietor”) on 18 October 2016. The registered design is for a wallet and is depicted in the following representations:



2. On 23 July 2019, SHENZHENSHICHENGYUHANSHIYEOUXIANGONGSI (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that “the exact design has been available on Amazon.co.uk since 2014, which is well before the design application date of October 18, 2016.”

3. The applicant filed a variety of documents with its application for invalidity, all intended to show that the registered design had been made available to the public prior to the relevant date. I will return to this evidence below.

4. The applicant claims that the registered design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a) [...]

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

5. The applicant claims that the registered design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

6. The registered proprietor filed a counterstatement denying the grounds of invalidation.

7. The registered proprietor filed various documents with its counterstatement. I will return to these documents below.

8. The applicant is represented by Mr Greg Sach and the registered proprietor is unrepresented. Neither party filed evidence during the evidence rounds. Neither party requested a hearing and neither filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

EVIDENCE

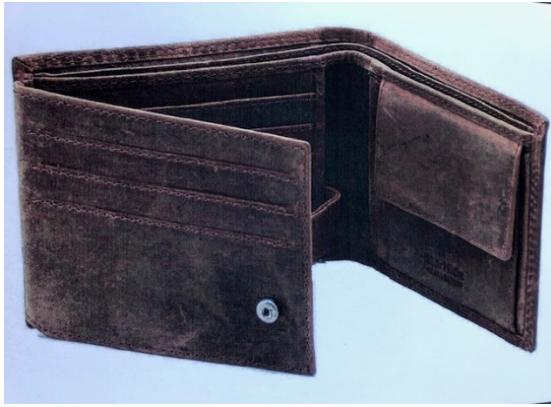
9. As noted above, neither party filed evidence during the evidence rounds. However, both parties filed documents with their pleadings. As both the Notice of Request to invalidate a design registration and the Notice of counter-statement are signed with a statement of truth, I shall accept these documents as evidence in these proceedings.

Applicant's Evidence

10. The applicant has filed various print outs from the Amazon website which all appear to show the same wallet for sale. Customer reviews for the product date back to December 2014 and the print out lists the "date first available at Amazon.co.uk" as 14 December 2014. The link details at the bottom of the print out describe the product as "STARHIDE-Blocking-Distressed-Leather-Notecase". The only image displayed alongside the reviews and product description is as follows:



11. However, in addition to this, a number of full size pictures taken from the Amazon website have also been provided. These appear to have been enlarged after clicking on a small version of the images and the link shown confirms that they relate to the same product i.e. "STARHIDE-blocking-distressed-leather-notecase":



12. These images are all undated save for the print date of 7 March 2019.

13. I note that a review dated 11 May 2015 states:

“overall a good product and well worth the money and looks like it will last for some time... only reason I didn’t give it 5 stars was because of the fact that when you fill the wallet the flap has no outside stud fastening and therefore tends not to close completely.. however, once in the pocket this problem disappears...”

Proprietor's Evidence

14. In his Notice of counter-statement, the proprietor submits as follows:

“The original design of Starhide Model No. #1060 with the Amazon identifier ASIN B00IE4H8RW was different at the time of the first available date on amazon.co.uk. In 2016, we made a design change and removed the button to close the wallet and registered a new design. Please note the old pictures.”

15. The “old pictures” described by the proprietor are set out as follows:



16. These are all undated.

DECISION

17. Section 1B reads 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 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.

...”

18. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EQHC 1882 (Pat):

“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; *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 the 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 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

19. The relevant date is the application date for the registered design i.e. 18 October 2016.

The Informed User

20. The design is for a wallet. The informed user is, therefore, a member of the general public. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

21. No evidence has been filed regarding the type, range or variety of wallets that were available at the relevant date. However, I am prepared to take judicial notice of the fact that wallets are typically pocket-sized and can be obtained with a variety of different features, such as card holders, coin purses etc.

Design Freedom

22. There is limited design freedom in terms of the construction of a wallet to the extent that they must all be of a certain size in order to fit within a pocket or bag and that they must have the necessary secure locations to store credit cards or coins. However, there will of course be design freedom in that wallets can be configured in any number of ways, with different compartments, sections and fastenings. They can also be presented with different surface patterns.

The Comparison

23. As noted above, a design will be considered new if “no identical design whose features differ only in immaterial details has been made available to the public before the relevant date” and it will be considered to have 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”. For the application to succeed, the registered design must not be new and/or must not have individual character, when compared with the prior art.



24. In order to be considered prior art, the designs depicted in the evidence will need to have been disclosed prior to the relevant date and must not be excluded disclosures under section 1B(6). The proprietor has contested that the images displayed on the Amazon print outs were available prior to the relevant date. It is the proprietor’s case that the product for sale on Amazon at that time was a variant design, as depicted in the images shown above. The key difference claimed by the proprietor appears to be

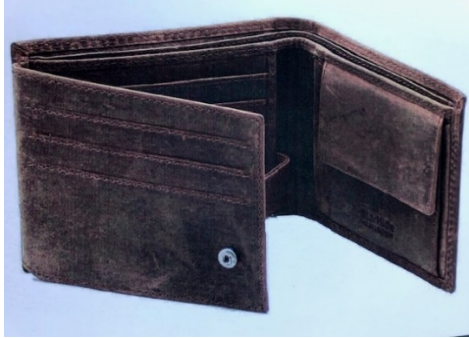
that the design that was made available to the public prior to the relevant date had a button fastening, whereas the registered design does not. For example, the additional button fastening can be seen on the following “old” image provided by the proprietor, which is absent from the Amazon print out images:



25. The photographs provided by both the proprietor and the applicant are undated (save for the print out date on the applicant’s images). However, the applicant’s images are clearly linked by the description to a product that is marked as having been available on Amazon since 2014. Further, a customer review from 2015 confirmed that, at the date, there was no outside stud fastening. Taking the evidence as a whole into account, I am satisfied that the images provided by the applicant can be considered prior art. There is nothing to suggest that this was an excluded disclosure.

26. The designs to be compared are, therefore, as follows:

The Prior Art	The Contested Design
	



27. In my view, the designs share the following attributes:

- a) They are both three panelled designs, consisting of an identification holder, a card holder and a coin holder;
- b) The identification holder in both designs is positioned in the left hand panel and consists of a clear covering with the same shaped oval window at the centre;
- c) The card holder in both designs is positioned in the centre panel and provides room for four cards to be stored one behind the other;
- d) Both designs have a securing strap along side the card holder with a button fastening to secure the identification holder in place;
- e) Both designs appear to have an additional storage space behind the card holder;
- f) The coin holder in both designs is positioned in the right hand panel and is rectangular in shape. The coin holders both appear to be embossed with the same (or similar) mark;
- g) Behind the card and coin holders in both designs is a foldable section for storing notes;
- h) Both designs fold into the same small rectangular shape;
- i) Both designs appear to have the same (or similar) mark embossed on the outside cover; and
- j) Both designs appear to be made of the same 'worn leather' or leather-look material.

28. However, the designs differ in the following ways:

- a) The colour of the wallet appears to be slightly different, with the prior art being presented in a slightly darker shade of brown; and
- b) The coin holder in the Contested Design is secured with a button fastening, but it is not clear from the prior art what is used to secure the coin holder in place.

29. I recognise that the common features are, to a certain degree, dictated by the function of the product. They are necessary to ensure that the user can securely store their belongings, whether it be coins, cards or identification cards. Further, the three panel structure of the designs is dictated by the need for the wallet to fold in order to fit into a pocket. However, there was, in my view, a design choice as to how these functions were achieved. For example, the decision could have been made to only offer the ability to hold cards, or to have only two folding panels. The decision of the registered proprietor to use the same layout and storage options as the prior art, whilst driven by functional considerations, also represents a design choice which is partly about appearance.

30. The embossing of the product with two marks, one on the coin holder and one on the outside cover, were clearly design choices. They appear in the same place and, appear to be highly similar (if not, identical).

31. Both designs have the same 'worn leather' appearance, albeit they are presented in slightly different shades of brown. Whilst it is most common for wallets to be displayed in shades such as brown, grey or black, the registered proprietor could have chosen any colour in which to register its design.

32. It is not possible for me to determine whether there was any mechanism in place to secure the coin holder in the prior art. The coin holder in the Contested Design is secured with a button fastening. It is, of course, possible that the coin holder in the prior art was not secured at all or it might have been secured by some other means (such as Velcro). However, even if that is the case, and that is sufficient to prevent the

marks from being identical, I am satisfied that they differ in only immaterial differences and that they will not create different overall impressions on the average consumer. In my view, the Contested Design does not, therefore, have individual character.

Final Remarks

33. As explained above, I have found that the images provided by the applicant can be considered prior art. The key difference claimed by the proprietor between the applicant's product available for sale prior to the relevant date, and the images provided by the applicant of the product available for sale now is the presence of an additional button fastening to hold the three-fold wallet design closed.

34. For the avoidance of doubt, even if the prior art had involved this additional button fastening, I would still have considered the designs to have only immaterial differences and my finding would have remained the same. This is because the addition of the button is functional i.e. to secure the wallet in place. Even to the extent that it represents an aesthetic consideration, it forms only a minor feature of the overall design.

CONCLUSION

35. The application for invalidity succeeds.

COSTS

36. As the applicant has been successful it is entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of **£648** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a statement of case and evidence and considering the proprietor's statement	£600
Official fee	£48

Total

£648

37. I therefore order RHS Trading Europe Limited to pay SHENZHENSCHICHENGYUHANSHIYEUOXIANGONGSI the sum of **£648**. This sum should be paid within 2 months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2020

S WILSON

For the Registrar