

# O/374/21

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

**IN THE MATTER of Registered Designs Nos. 5002463, 5002464,  
6009459 & 5002467 in the name of H&S Alliance Ltd in respect of  
Castor Wheel Sets**

**and**

**APPLICATIONS TO INVALIDATE (Nos. 29-32/18) by GBL UK  
Trading Limited**

## DECISION

1. This is an appeal from decision O-699-19 dated 18 November 2019 by the Hearing Officer (Mr Oliver Morris) acting for the Registrar of Designs. He upheld an application by GBL UK Trading Ltd to invalidate four registered designs relating to castor wheels. The registered proprietor H&S Alliance Ltd appeals against that decision, in respect of all four of the designs.
2. The proprietor is represented on this appeal by Mr David Harris, chartered patent attorney, of Barker Brettell LLP, while the respondent GBL UK Trading Ltd is represented by its director, Mr Mansour Malik.
3. The hearing of this appeal took place on 3 April 2020, via video link. As a result of the way in which the argument on the appeal developed, I gave permission for the Respondent to extend its grounds of invalidity by

adding a ground that each of the registered designs in issue is not in respect of the design of a single product, but contains multiple products, in that each depicts not a single castor wheel but a “set” of two or more.

4. My reasons for taking the unusual course of allowing the introduction at the appeal stage of a fundamental ground of invalidity are more fully set out in my interim decision O-217-20 dated 8 April 2020. Briefly, I considered that in order to deal properly with the grounds of novelty and individual character which were already in issue on the appeal, it was highly desirable to work out the basis on which each of these registered designs containing multiple items was valid, if it was valid. Once the reasons for validity were established, it would then be possible to elucidate the correct basis on which the informed user ought to compare the “sets” within the registered designs with sets or groups of castor wheels in the prior art.
5. At Mr Harris’s suggestion, I invited the Office to make submissions, if it so desired, on Registry practice relating to “sets of articles” as explained in paragraphs 2.14-16 of the Registered Designs Examination Practice guide and on the legal basis for that practice. The Office duly made such submissions, for which I am grateful. I also invited the parties to lodge additional submissions and/or evidence if they wished, to deal with this ground. The Appellant duly filed written submissions and evidence on the subject of “sets”, but Mr Malik for the Respondent was content to rest on the existing materials. Neither party thought that an additional hearing was required, so I have reached this final decision on the basis of the additional written materials which were filed after the hearing.

## 1. The issue of “sets” on this appeal

6. This can be explained by reference to one of the designs in suit, No. 5002464. Its representations include the following view:-



7. At first sight this might appear to be an attempt to include within a single registration the designs for two different products, one with a brake and the other without. Section 1(1) of the Registered Designs Act 1949 as amended (“the Act”) states that “*In this Act ‘design’ means the appearance of the whole or part of a product resulting from the features of...*” (emphasis added). This is not a context where the singular “a product” can plausibly be read as encompassing the plural “products”.

## 2. Current Registry practice and historic protection for “sets of articles”

8. Chapter 2 of the UK IPO’s Registered Designs Examination Practice guide, published on 16 March 2017, contains the following subsection:-

### **Products consisting of multiple components**

2.14 A set of articles can be a 'product' in its own right, and can be represented in a single design application if the articles making up the set are linked by aesthetic and functional complementarity and

are, in normal circumstances, sold together as one single product. Examples would include a chess set consisting of a board, pieces and packaging, or a canteen of cutlery consisting of various knives, forks and spoons, which are specifically adapted to store and display its contents.

2.15 An objection will be raised against applications which are not linked. An example of this would be a toy and its packaging. This is



because the function of a cardboard box has nothing to do with the function of the toy. It is just packaging which will usually be thrown away, or recycled, once the toy has been unpacked. In these circumstances, the packaging and the toy cannot be regarded as a single product.

2.16 Amongst the twelve views permitted in the application form, applicants must submit at least one view showing the set of articles in its entirety (see acceptable and unacceptable examples below).

9. The registrability of a “set of articles” was long established under pre-harmonised UK registered designs law. The practice of accepting registrations for sets goes back at least to the Patents, Designs and Trade Marks Act 1883, where there was special provision for sets of articles within the Comptroller’s fees rules, although I cannot find a reference to sets of articles in the statute itself.

10. Section 1(2) of the Registered Designs Act 1949, in its form before it was amended to adopt European harmonised law, explicitly provided that a design could be registered “*in respect of any article, or set of articles, specified in the application.*” That provision was accompanied by a statutory definition of a “*set of articles*” in s.44(1):

"set of articles" means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

11. However, the statutory basis for the registrability of a set of articles under the current European harmonised law is far less clear. The Designs Directive 98/71/EC contains no express reference to sets of articles. The word “article” itself is a term of art under the UK 1949 Act from pre-harmonisation days. It has been effectively replaced by the word “product” in the Directive. The 1949 Act was extensively amended in order to conform UK domestic law with the provisions of the Directive. As part of those changes, the word “article” was systematically replaced with “product”, and the definition which I have quoted above of a “set of articles” in section 44(1) was explicitly repealed.

12. It seems to me that under the terms of the Act as now amended, a design registration can only contain representations of a single “product”. However, it may be that in some circumstances, a set of physically separate items might be regarded as being a single “product”, as suggested by the IPO Practice Guide quoted above.

13. The Commission's 1991 Green Paper on the Legal Protection of Industrial Designs, which preceded the drafting of the Directive, indicates that the Commission was aware of the UK practice of registering a "set of articles". At para 8.7.2 it deals with the desirability of including a procedure for multiple applications within the new harmonised system, and notes that *"there should be no limitation of the type [of product] resulting from the present UK legislation, where only designs applied to a given set of articles (e.g. cups, dishes and tea-pot of a tea-set) could benefit from a combined deposit."* It might be argued from this that the appropriate way of registering what were previously "sets of articles" under UK law is to register each item in the set separately but as part of a multiple application. This however would result in each item in the set giving rise to a legally separate registration.
14. The definitions of "product" in Art.1(b) and of "complex product" in Art.1(c) of the Directive are as follows:-
  - (b) 'product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
  - (c) 'complex product' means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.
15. The above definitions have been reproduced into section 1(3) of the Act, with some rearrangement of, and other small changes to, the wording.

### **3. Submissions on sets of articles**

16. Following the hearing, the Office lodged written submissions which essentially supported the practice as set out in the section of the

Examination Practice guide set out above. The submissions also referred to the guidance on this point by the EUIPO in section 5.2.8<sup>1</sup> of its design guidelines:

“A set of articles is a group of products of the same kind that are generally regarded as belonging together and are so used. See the example below.



Sets of articles should not be confused with variations of a design. Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own. See paragraph 5.2.2. Views relating to more than one design, above.

The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a ‘set of articles’ are not mechanically connected.

A set of articles can be a ‘product’ in itself within the meaning of Article 3 CDR. It can be represented in a single design application if the articles making up this set are linked by aesthetic and functional complementarity and are, in normal circumstances, sold together as one single product, like a chess board and its pieces, or sets of knives, forks and spoons.

It must, however, be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set, and not for each article separately.”

17. Neither the guidance of the UK IPO nor of the EUIPO are judicially authoritative. However, the Office in its submissions helpfully identified a relevant case in the EU General Court, of which neither Mr Harris nor I had been aware at the time of the hearing. This is Case T-9/15 *Ball*

---

1. Re-numbered as section 5.3.7 in the 2021 edition of the guidelines.

*Beverage Packaging Europe Ltd v EUIPO*, judgment of 13 June 2017.<sup>2</sup> The Office particularly relied on paras [60-62] of that judgment, to which I shall come below, and summarised its submissions as follows:

- A set of articles can be a product in its own right;
- It can be represented in a single design if those articles have aesthetic and functional complementarity, and are normally sold together as a single product; and that
- This practice is consistent with the provisions of the current European harmonised legislation, as confirmed by the General Court in *Ball Beverage Packing Europe Ltd v EUIPO*, Case T-9/15.

18. Mr Harris's written submissions for the Appellant criticise the Office's conclusions and the EUIPO examination guidelines on which they are based. In particular, Mr Harris submits that the test of aesthetic or functional complementarity is not found anywhere in the Act or in the Designs Directive. He argues first for a broad interpretation under which there is no limitation on disparate items being included together as a single product within a single design registration, and gives an (admittedly somewhat extreme) example of the registration of a cat flap and a nuclear bomb within the same registration. He bases this example by analogy on a patent apparently granted to a somewhat eccentric applicant under the Patents Act 1949.<sup>3</sup> Without unnecessarily diverting from designs into the intricacies of patent law, I note that there are

---

2. Reported at [2018] ECDR 8.

3. Complete Specification No. 1 426 698, published 3 March 1976, for an invention entitled "Photon Push-Pull Radiation Detector for Use in Chromatically Selective Cat Flap Control and 1.000 Megaton, Earth-Orbital, Peace-Keeping Bomb". The applicant, Arthur Pedrick, was a former Patent Office examiner who apparently spent much of his retirement filing unusual patent applications.



limitations against including in one patent application matters that do not relate to a single inventive concept.<sup>4</sup>

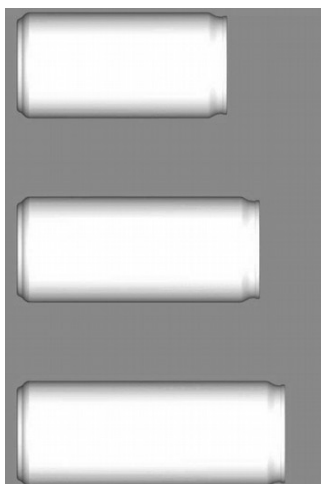
19. Mr Harris submitted that I am obliged to determine questions of interpretation of the Designs Directive, and therefore of the corresponding provisions of the Act which implement the Directive, in accordance with principles laid down by and any relevant decision of the European Court, which includes for this purpose the General Court. However, he points out that in the *Ball Beveridge Packaging* judgment, the need for a set of items to have some functional and aesthetic complementarity and to be sold as a unitary product was not challenged by any of the parties, and there was no analysis in the judgment of whether that statement of the definition of “product” was legally correct. He also points out that the ground upon which the design was actually held invalid in that case was lack of individual character, not on the basis of failure to comply with the definition of a design.
20. I will now deal first with Mr Harris’s broader argument about the width of the word “product” and with the *Ball Beveridge Packaging* case. I will then go on to consider the evidence filed by the Appellant, and Mr Harris’s further narrower argument based on “parts intended to be assembled into a complex product”.

---

4. The statutory requirement for “unity of invention”; further, the House of Lords held in *Sabaf SpA v MFI* [2005] RPC 10, per Lord Hoffmann at [22]-[27], that combining together in a patent specification two elements which were each known in the prior art and do not cooperate together to give a new result will not lead to a valid invention.

#### **4. What is the test for a group of items to amount to “a product”?**

21. First, I reject Mr Harris’s broad submission that, in effect, any two (or more) unrelated items can be put into a design application together and must thereafter be treated as a single “product” carrying, as a necessary corollary, a single “design” embracing the features of appearance of each component. Both the ordinary meaning of the word “product” and the need for a sensible system for the protection by registration of the designs of products in my view militate against such an interpretation.
22. On the other hand, it does not seem to me that the concept of a “product” means that it must always consist of one physical object, or of objects physically joined together. The UK and EU office guidelines give examples of a chess board and pieces, or a canteen containing cutlery consisting of various knives, forks and spoons, where the canteen is specifically adapted to store and display its contents. These individual items are not only sold together as one product, but will stay together for the normal life of the product.
23. By contrast, eggs are very commonly sold in boxes of half a dozen. In my view it does not follow that 6 eggs, or an egg box together with the 6 eggs it contains, are to be regarded as a single product. This is simply a convenient number of eggs to handle, distribute and buy, and the eggs will be consumed one by one as needed and the box will then be thrown away.
24. I will now turn to the *Ball Beveridge Packaging* case, where the representation of the design was as follows:-



25. The validity of the registration was challenged on the basis of prior art. When the case reached the Board of Appeal,<sup>5</sup> it felt it necessary decide what was the object of protection in order to work out how to go about comparing the registered design with the prior art. It reasoned:

“18 It must firstly be found in this regard that only a unitary subject can be the subject of a design. Article 3(a) CDR explicitly mentions the appearance ‘of a product’. The combination of several individual products that are not associated with one another can only be protected as a subject if they are aesthetically coordinated with one another, are functionally connected and are usually marketed as a unitary product. Typical examples are cutlery consisting of a knife, fork and spoon or a set comprising a chess board and chess pieces.

19 The contested CD does not meet these requirements. In so far as beverage cans are offered for sale in packs, the cans are always of the same size; this is logical, particularly from the standpoint of transport and storage. The contested CD therefore does not meet the requirements of Article 3(a) CDR. As the applicant for a declaration of invalidity has not asserted the ground for invalidity under Article 25(1)(a) CDR, this circumstance is unable to substantiate the invalidity of the contested CD. However, it is not one unitary subject in the form of three cans that is to be taken into account for the assessment of novelty and individual character, but rather the appearance of the single can, which is represented in three different sizes.”

---

5. Third Board of Appeal, Case R 1408/2012-3, 8 September 2014.

26. The Board held the design to be invalid for lack of individual character and its decision was challenged on appeal to the General Court. The Office's submissions drew my attention to the following passage in the General Court's judgment:<sup>6</sup>

"60. As the Board of Appeal correctly notes in paragraph 18 of the contested decision, the subject matter of a design may only be a unitary object, since Article 3(a) of Regulation No 6/2002 refers expressly to the appearance of 'a product'. Moreover, the Board of Appeal correctly stated, in paragraph 18 of the contested decision, that a group of articles may constitute 'a product' within the meaning of the above mentioned provision if they are linked by aesthetic and functional complementarity and are usually marketed as a unitary product.

61. Proceeding from that premiss, which is not contested by the parties, the Board of Appeal concluded, in paragraph 19 of the contested decision, that the contested design did not satisfy the three conditions set out in paragraph 60 above and that, consequently, it could not be perceived as a unitary object. According to the Board of Appeal, when groups of beverage cans are offered, they always consist of cans of the same size, which is understandable, inter alia, in the light of transport and storage.

62. The Board of Appeal's conclusion relating, in the present case, to the lack of a unitary object is also not vitiated by error. Irrespective of the way beverage cans are marketed, it is clear that the three cans represented in the contested design do not perform a common function in the sense of a function which cannot be performed by each of them individually as is the case, for example, of table cutlery or a chess board and chess pieces, invoked by the Board of Appeal (see, to that effect, judgment of 25 October 2013, *Merlin and Others v OHIM – Dusyma (Game)*, T-231/10, not published, EU:T:2013:560, paragraph 32).

27. The General Court's function on an appeal from a EUIPO Board of Appeal is limited to pronounce on the correctness or otherwise of each of the "pleas in law" by which the Board's decision is challenged. It does

---

6. Case T-9/15 [2018] ECDR 8.

not as such re-decide the case which was before the Board on its merits. It is often necessary carefully to assess what appear to be statements of substantive law in their context within the pleas in law being considered by the Court.

28. The plea in law to which the above paragraphs relate was that the Board had infringed the combined provisions of art.25(1)(a) and art.6 of the Community Designs Regulation 6/2002 (“the CDR”). The first part of that plea alleged that the Board of Appeal incorrectly assessed the scope of the protection conferred by the contested design, in so far as it refused to find that the latter represented a group of three cans of different sizes, that is to say, a unitary object. The Court sub-divided that part of the plea into three complaints, of which the relevant one was:

“46 In the second place, the applicant contests the Board of Appeal’s finding that the contested design did not constitute ‘a product’ for the purposes of art.3(a) of Regulation 6/2002.”

29. Mr Harris’s submissions make the point that the design was cancelled on the ground of lack of individual character rather than for non-compliance with the definition of a design. But paragraphs [60]-[62] quoted above constitute the Court’s reasons for rejecting the second complaint and accordingly are a necessary or essential part of the Court’s reasoning leading to the rejection of the plea in law of which it formed part.
30. However, Mr Harris’s other point has more force. The correctness of the test adopted by the Board was not contested by the parties, so the Court was not provided with arguments about what should be the correct test. Further, neither the General Court’s judgment nor the Board of Appeal

decision contain any supporting or explanatory reasoning from which one can understand how the test was arrived at, or how such a test is derivable from the wording and/or a purposive interpretation of the legislation. It appears likely that the test in para [18] of the Board's decision was simply adopted from the EUIPO guidelines at the time, which contained the test of aesthetic and functional complementarity. I have also looked at the *Merlin v OHIM* judgment cited by the Court at [62]. It notes that the pieces of a game have aesthetic and functional complementarity but casts no further light on the reasons for adopting this test.

31. Unless bound by the General Court decision, I would agree with Mr Harris's submission that the requirement for aesthetic and functional complementarity of the component items forming a single product is not to be found in, or inferred from, the legislation.<sup>7</sup> Where a product consists of a single physical item, there is no requirement that the different parts of the design should complement each other either aesthetically or by way of function even if that might be a desirable characteristic, and I do not understand the justification for imposing such requirements on a product consisting of a group of items if it satisfies the essential requirement that the items are sold together as a unitary product and remain together as a unitary product in normal use. The presence of aesthetic and/or functional complementarity may well make it easier to characterise the group of items as being a unitary product, but for myself I do not see the justification for making this a requirement, still less for

---

7. A requirement which could be called "aesthetic complementarity" in Eurospeak was present in the repealed definition of sets of articles in section 44(1) of the Act.

imposing what appear to be two cumulative requirements relating to both aesthetics and function.

32. However, I have concluded that it is not necessary for me to decide whether or not I am bound by the General Court judgment in order to dispose of this appeal. That is because I consider that each of the components within each of the registrations in issue, if they in other respects satisfy the requirements for being regarded as a single product, do possess the features of aesthetic and functional complementarity. In each registration, the braked and unbraked variants have designs which, leaving aside the presence or absence of the brake, are coordinated with each other. The items in each set will functionally complement each other, by holding up different corners of a piece of furniture, if indeed the set is used for this purpose.
33. In this appeal, I would need to decide whether or not I am bound by virtue of section 3(1) of the European Communities Act 1972. In future appeals the test would be different, namely whether I am bound under section 6 of the European Union (Withdrawal) Act 2018. One question would be whether General Court judgments interpreting the CDR form part of relevant “retained case law” under s.6(3)(a) of the 2018 Act for interpreting the Act, whose provisions are based on the Directive rather than on the CDR. There is now quite a large body of General Court decisions interpreting the CDR and an even larger number interpreting the EU Trade Marks Regulation. The question of whether and to what

extent Appointed Persons are bound by these decisions should in my view be decided as and when it becomes necessary to do so.<sup>8</sup>

### **5. The evidence, and the “parts” point**

34. The Appellant has submitted evidence in support of its case that 4-wheel and 2-wheel sets of castors are sold as unitary products, albeit without prejudice to Mr Harris’s submission that the Appellant need not submit such evidence at all because the burden of proving the ground of invalidity rests on the Respondent.
35. There is a large and convincing body of evidence, in Exhibit RJH2 to the witness statement of Mr RJ Hill of the Appellant, that castor wheels are very commonly sold in 4-wheel sets. Sets consisting of two braked wheels and two wheels without brakes are very common, sets where all four wheels are braked are also reasonably common, and there are also sets of 4 wheels where none has a brake. This evidence contains Amazon customer reviews which cast useful light on the way customers make use of these 4-wheel sets, either in the text or in photographs showing the objects to which the wheels have been attached. As one would expect, these 4-wheel sets of castors are normally attached to 4-cornered pieces of furniture, although there is one review in which the customer had used 6 wheels, of which 3 were braked, to support a small kitchen island.

---

8. If an Appointed Person is bound by a General Court decision, it might in some circumstances be appropriate to exercise the power to refer the appeal to the High Court so that the Court of Appeal could then be in a position to consider whether to exercise its power under s.6 of the 2018 Act to depart from the General Court decision.



36. The majority of these sets of 4 have flat plates with holes for screws or bolts as their means of attachment to the furniture. Some instead have screw thread attachments intended to be screwed into a threaded socket in the furniture. However in no case is the attachment type mixed within a single set.

37. This brings me to the validity of registered design No. 5002463, the only 4-wheel set in issue. I set out below two of its representations, both described as “standing view”:-



**Standing view**



**Standing view**

38. In defending this registration against prior art, Mr Harris argued that:

“53. ... in order to show a lack of novelty or individual character, the Respondent would need to provide evidence of a set of castors having mounting flanges and mounting threads, and braked and unbraked castors, in order to provide the same overall impression. Whilst in each case these are largely functional features, they do

add to the overall impression, and given the Appellant has included them in the representations, clearly some limitation is intended by their presence (especially given that the Appellant also chose to file design 5002464 without the threaded versions).”

39. At paragraph 39 of my Interim Decision, I indicated my provisional view that this design raises additional questions regarding its validity, over and above the questions which apply to the other three registrations which have two-item “sets”. There was nothing in the evidence I had looked at by then which suggested that anyone is offering for sale a “set” consisting of one each of the four types of castors as shown in this registration. While sets were offered with the flat plate fixings, and sets with a screw thread fixing, I could see no set within which different fixings were offered. Nor is it easy to think of what kind of furniture would give rise to a demand for such a set: the furniture would need to have two screw attachments and two flat plate attachments, with braked and unbraked variants needed for each type of attachment.
40. At paragraph 40 I went on to say that that and other indications in my Interim Decision were intended to assist the parties to focus their submissions and evidence on points on which I had expressed concern. Despite that indication, there is nothing in the evidence filed after the hearing which suggests that this particular combination has ever been offered for sale as a set or that it is a plausible combination to sell or to use. I take Mr Harris’s point about the burden of proof resting on the Respondent, but in my view the implausibility of this combination as a unitary product is apparent from inspection of the registration itself and the burden shifts to the proprietor to adduce evidence to show that the combination would plausibly be sold and used as a unitary product.

41. It is this very implausibility of this combination which puts the Appellant in the position of being able to point to the absence of such a combination in the prior art. So, the more implausible the combination as a product, the harder it is to attack its validity on novelty or individual character grounds. I do not agree with Mr Harris's suggestion that this does not matter because such a registration would only be infringed by a similar combination. The proprietor could well argue that differences between the combination as registered and an alleged infringement do not affect the overall impression, or use the registration in a "take down" notification to an online market place who would not necessarily analyse the registration with the degree of sophistication required to limit its impact only the instances where the whole of the combination was there.
42. Mr Harris relies on another point in support of the registrability of the sets of items which are portrayed in the registrations in issue on this appeal. He points to the reference in the definition of "product" to "*parts [plural] intended to be assembled into a complex product*". He argues that a set of castors would be assembled into a complex product, being the trolley or other item to which the castors will be attached, and that the fact that the word "parts" is plural within the definition is significant. He argues that this reveals a legislative intent to permit the registration of a group of parts for a complex product as a single "product".
43. I do not think that that argument helps him with this particular registration, because it seems to me that the castor wheels within this registration are intended for assembly not into "a" complex product, but into separate and different complex products, the screw attachment

variants into one type of furniture and the flat plate versions for attachment to another type.

44. In the upshot, I hold that the combination of items shown in the representations of design No 5002463 does not amount to a single product, and accordingly that it does not comply with the definition of “design” in s.1(2) of the Act and is invalid.
45. The Appellant also adduced some (more limited) evidence of 2-wheel sets of castors being sold, in Exhibit RJH3. This Exhibit contains rather less information about how customers deploy and use these 2-wheel sets than Exhibit RJH3 does with the 4-wheel sets. Of most significance however is the fact that there are 2-wheel sets with brakes and 2-wheel sets without brakes, but none at all where a 2-wheel set is offered consisting of one with a brake and the other without.
46. A representation from design No. 5002464 is shown at para 6 above. As can be seen, it consists of one braked and one unbraked variant. The other two registrations are the same in this regard.
47. I do not consider that a 2-wheel set as shown is a “product”, at least in the primary sense leaving aside for the moment Mr Harris’s “parts” argument. There is no evidence that braked and unbraked 2-wheel combinations are sold and it is not easy to see how such a set would be routinely deployed in use, on some furniture item which needs only two wheels only one of which needs a brake.
48. On the other hand I do consider that a 4-wheel set containing 2 braked and 2 unbraked wheels is a single product. Such sets are very commonly

sold as a group, and tend normally to be used as a set by being attached as a group to a piece of furniture. I do not think the fact that such sets may sometimes be broken up by users and deployed for different purposes destroys their unity as a product if generally in normal use they will be kept together as a set.

49. Accordingly it seems to me that each of these three registrations of 2-wheel sets is valid as regards this ground since they show the design of a part of a product, namely one half of a 4-wheel set, and therefore fulfill the definition of design in s.1(2) of the Act. Alternatively they can be regarded as depicting a part for a complex product, being the piece of furniture into which they are to be assembled, and accordingly satisfy the extended definition of “product” in s.1(3) which includes “parts intended to be assembled into a complex product”.
50. I am not convinced by the full extent of Mr Harris’s argument based on that definition, which in my view places undue weight on the word “parts” being plural in legislation where the wording is of European origin and drafting standards are different from those relating to legislation of domestic origin. I would need convincing that this aspect of the definition of “product” would sanction the inclusion within a single registration of two or more completely unrelated parts on the ground that they would end up being assembled into the same complex machine. On the other hand I think it is perfectly legitimate to describe a set of 2 wheels as being a part (singular) of a 4-wheel set which I have held qualifies as a single product.

## **6. The Hearing Officer's decision on the prior art grounds**

51. The Hearing Officer held all four of the registrations in issue to be invalid on the ground of lack of individual character, some on the basis of more than one item of prior art, in a careful and detailed decision.
52. The Appellant relies on three grounds of alleged error.

### *(1) Reliance on "unpleaded" prior art*

53. Complaint is made that the Hearing Officer relied on certain items of prior art which were not pleaded in the Respondent's statement of grounds served under rule 15(1)(b) of the Registered Design Rules 2006. These specific items were raised later in the Respondent's "second statement of case", which, the Appellant submits, was just part of the Respondent's evidence and did not have the status of a statement of case. That was filed by the Respondent together with evidence in February 2019.
54. At paragraph 19 of his decision, the Hearing Officer declined to exclude these prior art items because he regarded them as the simple provision of further castors which are said to have the same overall impression.
55. It is pre-eminently a matter for the discretion of the tribunal hearing a case to decide whether or not strict compliance with pleading rules should be enforced. The Appellant here does not allege that the introduction of these items of prior art at the stage of the Respondent's evidence caused any substantial injustice in the sense of leaving the Appellant unable to deal with or respond to them. After these items of prior art were identified in the Respondent's evidence round in February

2019, the Appellant had the opportunity to respond as it thought fit in its own evidence round in April 2019.

56. This ground of appeal is a technical procedural criticism without substantive merit and I dismiss it.

(2) Lack of evidence that alleged prior art listings were the same before the registration dates as when included in evidence

57. This ground of appeal arises from the fact that the Respondent relied upon printouts of listings of castors on eBay and Facebook which were made at the time of filing its applications for declarations of invalidity, rather than providing the listings in the form in which they had existed before the registration dates.
58. Although the listings as such pre-dated the respective registration dates, the Appellant contends that there was either no evidence or insufficient evidence to show that the pictures of castors were the same before the registration dates as they were when printed out when the invalidation applications were launched. The Appellant relied upon evidence that these pictures can readily be changed by the owner of the listing, that one or more of the listings had in fact been changed, and criticised the Respondent for failing to produce evidence that the listings had remained unchanged even in the case of listings under its own control.
59. The Hearing Officer dealt with these arguments as follows at paragraph 18 of his decision:

“18. In relation to the amendment/modification of listings, I have greater reluctance to reject Mr Malik’s evidence. I accept the general proposition that listings can be amended, something which is aptly shown by the proprietor’s evidence of them amending their own

listings. Mr Malik also appears to accept (although his comments are made in relation to the other designs) that marketplace listings are commonly amended so as to provide the consumer with more information about products. However, it does not follow that the listings in evidence have been modified to any material extent (by that I mean modified so as to change what has actually been disclosed). The proprietor could have cast more doubt by providing evidence that the picture of the item was different, but it has not done so. I am prepared to accept the listings for what they are.”

60. The Appellant criticises this reasoning as not taking proper account of the fact that the Appellant had filed evidence that the Respondent had changed at least one listing, and that an inference could be drawn that it is likely that other listings were edited. Further, the second last sentence of paragraph 18 wrongly in effect casts a burden of proof on the Appellant to prove that the listings had changed, when it was for the Respondent to prove that the listings had not changed. The Appellant further argues that there was no evidence from Mr Malik that the listings had not changed.
61. In my assessment, Mr Malik’s evidence clearly stated that the products which were the subject of these listing had not changed since the listings had started. That is a different point from whether the photographs showing the products had or had not changed. If the products had not changed then the designs of the products depicted had not changed, even if there had been changes in the photographs which showed the products. While it is possible that other photographs could have shown the products e.g. from a different angle, or might have omitted some design features which other photographs might have shown, in my view it is likely from the nature and purpose of these listings that any photographs would have shown the essential features of the design of the products being sold.



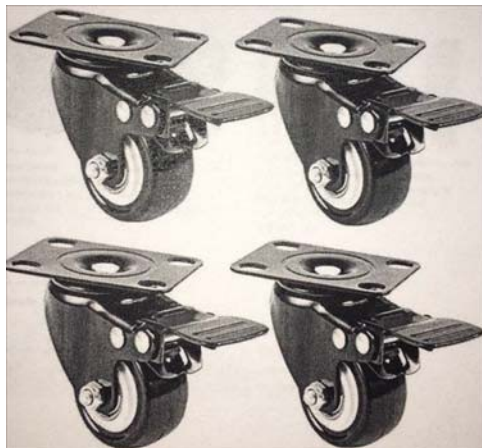
62. The Appellant chose not to put in any evidence of its own to show what these listings were like before the registration dates. I put it to Mr Harris at the hearing that it was open to the Appellant to have investigated what these listings looked like via the Wayback Machine at [www.archive.org](http://www.archive.org), which is a tool well known to intellectual property lawyers and attorneys. Mr Harris did not provide any reason why it could not have been used, but submitted that the Respondent had not got over the hurdle of showing on the balance of probabilities what the listings looked like prior to the filing dates of each of the registered designs.
63. In my view the Respondent's evidence was rather thin and could have been better supported. However it was such that, if not contradicted, it established on the balance of probabilities that the pre-filing-date listings showed the same products as shown in the listings as submitted with the Respondent's evidence. Absent other evidence, those listings are the best evidence available as to the design features that would have been apparent all along from photographs of those products, whether or not exactly the same as the photographs in the listings put in evidence. The Appellant took the course of submitting that the Respondent's evidence was insufficient without seeking to submit any evidence of their own, and thereby took the risk that the Respondent's uncontradicted evidence, even if thin, might pass the hurdle of proof on the balance of probabilities. In my judgement it does pass that hurdle.
64. I am in essential agreement with the Hearing Officer and the reasons he sets out in paragraph 18 of his decision.

*(3) Error in analysis of individual character*

65. This is not so much a single alleged error, but a fairly large number of detailed points which are said to have led the Hearing Officer to come to a wrong conclusion as regards the individual character of each of the registered designs, in respect of each of the items of prior art where he found the same overall impression to be present.

Design No. 5002464

66. The Hearing Officer held that this design also lacked individual character as a result of an item of prior art disclosed on amazon.co.uk in February 2016. This prior art is illustrated by the following photograph at para 15(vi) of the decision:



67. The Hearing Officer made the following findings with regard to this particular prior art attack:

“27. I note here that the brake is very similar indeed to the brake of the registered design. The other aspects of the design are also very similar. However, a major point taken by Mr Harris was that the prior art comprises only a braked version, whereas the registered design is a set comprising a braked and unbraked version.

28. I have strong reservations as to whether the registered design can be said to be a design, or whether it is actually two designs.

That said, as no ground for invalidation is made on this basis, I can say nothing more. However, what I can say is that whilst I agree with Mr Harris that the novelty in the registered design cannot be destroyed by two separate pieces of prior art, one destroying the novelty of the braked version, another the unbraked version, it does not follow that a single braked or unbraked version cannot destroy the novelty in what is effectively some form of composite design. In my view, the informed user will view the registered design as having the same overall impression as the prior art above, the only difference being the inclusion/omission of a largely functional brake. The novelty would, thus, still be destroyed, the overall impression still being the same.”

68. Mr Harris criticises this reasoning in his appeal skeleton argument as follows:-

“44. ... [The above] disclosure gives a different overall impression. This Design shows a set of two castors - one braked and one unbraked. As such, whilst there are clearly functional aspects to the difference between braked and unbraked castors, there are also aesthetic differences - notably the presence or lack of a brake pedal.

45. Whilst the Hearing Officer stated that he had reservations whether the Registered Design was a single design, it is settled practice that a set of components can be the "product" in its own right - see, for example the IPO's Registered Designs Examination Practice guide at paragraph 2.14. The product for this Design is described as a "set" and so it is clear that the protection is for a set of castors.

46. As such, to give the same overall impression, any prior art needs to show at least one braked castor and one unbraked castor; the informed user would recognise the presence or absence of a brake pedal would give a different impression, given that brake pedals can have aesthetic features.

47. As such, the Hearing Officer is incorrect to say that "[it does not follow that] a single braked or unbraked version cannot destroy the novelty [presumably also the individual character] in what is effectively some form of composite design". The Hearing Officer appears not to appreciate the existence of Registered Designs for sets of components and that to anticipate (or infringe) the Registered Design for such a set, there is a need to show the juxtaposition in a set of components that together give the same overall impression as the Registered Design.”

69. I have dealt with the validity issue in the earlier part of this decision and have held that this registered design, consisting of one braked and one unbraked wheel, is a valid registration of the design of part of a product; specifically it is one half of a set of 4 wheels of which two are braked and two are unbraked.
70. This leads on to the question of how one should go about comparing a product in a registered design which is a set of items with prior art; or indeed in the context of an infringement action, with an alleged infringement.
71. What if the components of the sets differ from each other? I sit on an office chair with 5 castor wheels, which seems to be a very common configuration for office chairs. I noticed within Exhibit RJH2 a small picture of a product called “Wintex Office Chair Castors, 5 pieces”. Suppose I register a set of 5 castors (all unbraked) as an office chair set, and in the prior art there is a set of 4 castors which is each of identical design to the individual castors in the registered design set. Would the informed user regard the 5-castor set as giving rise to the same or a different overall impression compared with the prior art 4-castor set?
72. In my view the informed user would understand that the two sets differ from each other by reason of functional requirements, one function (office chairs) requiring 5 pieces, while 4-cornered furniture items require a set of 4. Although having 5 rather than 4 pieces does affect the respective appearances of each set, the informed user would discount this difference because it arises from the different functional requirements and focus much more on the similarities and differences of the designs of the individual castor wheels within the respective sets.

73. Coming back to the comparison between registered design No. 5002464 and the prior art shown above, the informed user would appreciate that the absence of the brake on one of the two castors in the registered design arises as the result of a difference in functional requirements. The prior art is for a 4-cornered piece of furniture where a brake is needed on all corners, whereas the registered design pair are intended to be part of an application where brakes are only needed at two of the four corners.
74. Whilst the absence of a brake on one of the pair in itself leads to a difference in appearance of the set from the prior art, the informed user would largely discount the significance of this difference in forming an overall impression of the respective designs. In my view this difference is not sufficient, when viewed in this way, to lead to a different overall impression, any other differences being extremely minor. On this particular comparison I think it is right for me to substitute my own assessment for that of the Hearing Officer because I have had the benefit of considering the basis for the validity of sets of castor wheels, which leads on to deciding what is the proper way to go about comparing sets with each other for the purpose of deciding whether they give the same or a different overall impression. That said, although my reasoning is much more elaborately expressed than that of the Hearing Officer, I am not sure that it is in substance very different.
75. This brings me on to the remainder of the Appellant's criticisms of the Hearing Officer's decision.
76. The Appellant's grounds of appeal contain 40 paragraphs challenging the details of the Hearing Officer's assessments of the overall impression of the registered designs against the overall impressions of the items of prior

art. In addition, in the course of the hearing Mr Harris took me through the design differences on which he particularly relied for the proposition that each of the registered designs resulted in a different overall impression from the prior art.

77. I must however bear firmly in mind that I am not sitting as a tribunal conducting a primary assessment. I should only overturn the assessment of the hearing officer if there is an error in his approach. It is not the function of an appeal to run the all case over again and hope that the appellate tribunal will come to a different conclusion, particularly on matters of impression.
78. Mr Harris submitted that the characteristics of the informed user should be based on the well known passage by Birss J in *Samsung v Apple* [2012] EWHC 1882 (Pat) at [33] to [35]. This passage is quoted by the Hearing Officer in his decision at paragraph 10. As I understand Mr Harris's argument, it is not that the Hearing Officer mischaracterised the informed user but rather that he did not appreciate that certain features (such as the shape of the brake pedal, and the shading contrast of the wheels) are ones where there was design freedom so that the informed user would pay more attention to them.
79. In addition to his finding above based on the 4 all-braked set, the Hearing Officer held that registered design No. 5002464 (consisting of a braked and unbraked set of 2) lacked individual character over a prior art set of 4 (braked and unbraked) from one of the Respondent's own listings. The design and the prior are set out and can be compared on page 15 of the Hearing Officer's decision.

80. The Hearing Officer at paragraph 24 accepted Mr Harris's submission that the biggest difference was that the brake pedals in the braked version of the prior art flare out more than the brake pedals in the design registration. However at paragraph 25 the Hearing Officer concluded that the differences in the brake pedal (along with the other more minor differences) did not lead to a different overall impression. The Hearing Officer's exact words were "The differences in the brake, something which performs a specific functional requirement, the design of which could change with functional improvements, will largely be discounted in terms of the overall impression as a whole."
81. It seems to me that the Hearing Officer was fully aware that having the brake pedal was a functional requirement but that there was design freedom in the exact shape of the pedal. The informed user however would discount differences in this shape because he would perceive this design could change in order to achieve functional improvements. This is not obviously wrong nor has Mr Harris relied for example on any technical evidence that it is wrong. The length of the brake pedal and its width at its distal end may well have an impact on the leverage which can be exerted or how easy it is to push it down or up with the tip of a shoe. I cannot see that the informed user would view its shape as a matter of pure aesthetics unconstrained by functional considerations.
82. In my judgment the Hearing Officer's assessment on this item prior art is not shown to be in error, and this design is invalid for by reason of this item of prior art as well.

83. In relation to this design, the Appellant criticises the Hearing Officer for not engaging with the Appellant's own verbal description of the overall impression. That verbal description of what the Appellant asserts to be the overall impression is crafted to emphasise the aspects of appearance where the registered design differs from the prior art and leave out of account the respects in which it is the same or similar. The Hearing Officer was right to ignore it.
84. At paragraph 40 he carefully set out a number of features which he regarded as similar, and then went on to consider the points of difference, all of which built up to his assessment of overall impression.
85. The Appellant emphasises the shape of the brake pedal as being a feature to which the user would pay attention, and relies on the two-tone nature of the wheel as being an entirely aesthetic feature. It points to the fact that on the registered design, there is a darker inner ring and a lighter outer ring, whereas in the prior art the light and dark tones are reversed.
86. Each of these differences was considered by the Hearing Officer at paragraph 42, where he assessed the difference in shading as being a minor detail which does little in any event to create a different overall impression, and assessed the brake shapes overall as being similar with minor differences. The Appellant's criticisms do not come near demonstrating a basis upon which the Hearing Officer's assessment of overall impression should be set aside on appeal.



87. Regarding the comparison of this registered design with another item of prior art at paragraph 43, the Appellant criticises the fact that the Hearing Officer discounted the inclusion of the words ON and OFF on the prior art because they were “informative words relating to the function of the brake”. In my view, the Hearing Officer was right to do so.

Design No. 6009459

88. Again, the Appellant criticises the Hearing Officer for not engaging with its own proffered verbal definition of the overall impression of its registered design. Again, in my view this was not an attempt at a fair description but a forensic tool targeted as emphasising the aspects of the design where there are differences from the prior art and discounting those where it is the same. The Hearing Officer was right to disregard it.

89. There are similar differences as with No. 5002467 between this design and the prior art as regards the reversal of dark and light bands on the two-tone wheels and as regards the shape of the brake, and the Appellant makes similar criticisms of the Hearing Officer’s assessment of overall impression. For similar reasons, I reject these criticisms.

90. The Appellant also emphasises what it describes as “domed fixings” for the brake which it claims to be “an aesthetic flourish to a functional item.” As Mr Malik pointed out at the hearing, these appear to be the heads of rivets which are visible in one representation where the braked castor is viewed from its starboard side (relative to the direction of the wheel’s travel), while the tails of the rivets are visible in the other three representations where the castor is turned upside down. In the prior art the castors are photographed only from the port side and only the tails

of the rivets are visible, but the informed user would infer that a prettier head end of the rivet (not necessarily domed) would be present on the unseen starboard side of the prior art wheels.

91. The Hearing Officer cannot be criticised for discounting this difference at paragraph 50 as a minor change in the fixing mechanism, although in fact it seems that this difference either does not exist at all or would be less than was assumed by the Hearing Officer.

## **7. Overall conclusion**

92. I uphold the Hearing Officer's finding that all four registered designs are invalid, although as regards No. 5002463 on a different ground of invalidity, namely that it is not a design which relates to "a product".
93. The appeal is dismissed and the Respondent is entitled to its costs to be assessed on a scale basis. They are likely to be modest but I invite the Respondent to submit details of the costs it claims.

Martin Howe QC

Appointed Person (Designs Appeals)

17 May 2021