

O/414/21

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**REGISTERED DESIGN NO. 6038349
IN THE NAME OF DENIS LAU S YUNG**

AND

**APPLICATION NO. 47/19
BY BEIJING CHOICE ELECTRONIC TECHNOLOGY CO. LTD
TO INVALIDATE THE REGISTERED DESIGN**

Background and claims

1. The registered design the subject of these proceedings was filed by Denis Lau S Yung (“the proprietor”) on 27 June 2018 and was subsequently registered with effect from that date. The design is shown in the following representations:



2. The application form confirms that the design is for a “pulse oximeter”. When filing the design, the proprietor stated that no claim is made for the colour shown.

3. On 25 July 2019, Beijing Choice Electronic Technology Co. Ltd (“the applicant”) applied for the registration of the design to be declared invalid. Two grounds are relied upon. The first is that the contested design lacks novelty and individual character and should be declared invalid under s. 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”) on the ground that the contested design did not fulfil the requirements of s. 1B. The prior art upon which the applicant relies is its own C15D product, which it asserts has been sold in the UK, on Amazon, since 26 March 2015. The second ground relied upon is s. 11ZA(2), i.e. that the proprietor is not the proprietor of the design. The applicant asserts that it is the owner of the design, which was patented in China in 2011.

4. The proprietor filed a counterstatement denying the grounds for invalidation.

5. Neither party is professionally represented. Only the applicant filed evidence, with its statement of case.¹ Neither party requested to be heard or filed submissions in lieu of a hearing. This decision is taken following a careful reading of all of the papers.

¹ Rule 21(1)(a) of the Registered Designs Rules 2006 permits evidence to be filed with a statement of case. Although the proprietor filed a witness statement with his defence, it contains no evidence of fact.

6. The relevant date for the assessment is the date of application of the contested design, namely 27 June 2018.

Evidence

7. The form DF19A contains a statement of truth concerning the statement of case and was signed by Xu Yongju. The documents attached to the statement of case can be considered their evidence.

8. A print is provided from amazon.co.uk which shows a fingertip pulse oximeter for sale. The main image is as follows:



9. The following images are also shown; they are not especially clear either in reproduction or the original:



10. The print is not itself dated but the product information gives the date first available on the site as 26 March 2015. A number of reviews, all said to be 'verified purchases', are visible, the earliest of which is dated 4 September 2015 and the latest 26 October 2018.

11. I note that there are "customer images" also visible. The date on which these images were taken or provided to Amazon is not given. Two of the images are reproduced below:



12. A print from the CNIPA (China National Intellectual Property Administration) website is also provided. It shows the results of a patent search. It is said to show “our patent of the design in China”. The patent number is given as CN201130197485.1 and its description is “hand-held pulse oximeter [sic]”. The following image is shown:



13. The application date is recorded as 29 June 2011 and the publication date 23 November 2011. The applicant in these proceedings is given as the applicant/assignee. Four designers are also named; the proprietor is not among them.

14. That concludes my summary of the evidence, to the extent I consider it necessary.

Sections 11ZA(1) and 1B

15. Section 11ZA of the Act (so far as it is relevant) reads:

“11ZA Grounds for invalidity of registration.

(1) 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; [...].”

16. Section 1B of the Act (so far as it is relevant) reads:

“(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if-

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if-

a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business

in the European Economic Area and specialising in the sector concerned.

(b) 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.

(8) [...]”

Prior art

17. The applicant relies under this ground on the prior art shown in images from amazon.co.uk of its C15D product. The design is shown in the evidence as having appeared on that site from 2015. The appearance of the design on a retail website constitutes public disclosure. Prima facie, the design constitutes prior art.

18. In his counterstatement, the proprietor criticises the applicant’s evidence as “flawed”, because “I have to point out that the seller on Amazon can alter or revise the image of the product after the item was listed on Amazon”. I accept that it may be possible for a seller to amend the image of a product. However, the proprietor has

advanced no evidence or submissions which point to that having been the case in relation to this product. The applicant's statement of case clearly states that the prints "[show] the product with the design has been sold in Amazon in the UK as early as March 26, 2015". That is not mere assertion but is evidence given under a statement of truth. Absent any obvious inconsistency with the documentary evidence, it is not open to me to question the veracity of what has been said on the basis of no more than an assertion by the proprietor that it is possible to amend an image. The design may be relied upon as prior art.

19. I am not so persuaded by the other representations of the prior art visible on the Amazon prints, which appear to be photographs taken by customers and posted in reviews. These images are undated. The applicant states that the customer reviews are dated between June 2015 and June 2019 (the evidence before me, which does not show all 40 reviews, has the last review on 26 October 2018). As both of the later dates are after the relevant date, it cannot be inferred that the photographs were either taken or posted prior to the relevant date. Further, the photographs show an on/off marking on the button, which is not present on the main image, and what appears to be a strap. It therefore appears that there have been different iterations of the design and, in the absence of better evidence as to the precise designs made available and when, I am not prepared to infer either that the customer photographs are an accurate representation of the design relied upon by the applicant as disclosed in 2015, or that the designs visible in the photographs constitute prior art.

20. The applicant has also provided images of its alleged earlier Chinese patent registration. Although it does not refer explicitly to the patent under s. 1B, the applicant makes no distinction between the design which appears in the Amazon prints and the patent, which are said to be "the design of our company" and "completely designed by our company", respectively. In the circumstances, as the applicant filed all of the evidence at the same time with its pleadings and the significance of the patent to the novelty/individual character ground was abundantly clear, I consider that the patent may be relied upon as prior art and taken into account under this ground as supplementing the images of the design shown in the Amazon prints.

Case law

21. The correct approach to determining whether a design has individual character was considered in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat) where HHJ Hacon (sitting as a Judge of the Patents Court) said:

“181. I here adapt the four-stages prescribed by the General Court in *H&M Hennes* [Case T-525/13 *H&M Hennes & Mauritz BV & Co KG v OHIM* EU:T:2015:617; [2015] ECDR 20] for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide (a) the degree of the informed user’s awareness of the prior art and (b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account (a) the sector in question, (b) the designer’s degree of freedom, and (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters”.

22. In relation to the informed user, HHJ Birss QC (as he then was), sitting as a Judge of the Patents Court, set out the following helpful summary of the informed user in *Samsung Electronics (UK) Limited v Apple Inc* [2012] EWHC 1882 (Pat):

“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, BAILII: [2010] EUECJ T-153/08 , 22 June 2010. 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).

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)".

23. In *Grupo Promer* the General Court ("GC") addressed design freedom in paragraphs 67-70. In *Dyson Limited v Vax Limited* [2010] EWHC 1923 (Pat), Arnold J. summarised that passage from *Grupo Promer* as follows:

"34. [...] 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)".

24. It is important to determine whether (or to what extent) the relevant features of appearance of a product are dictated by its technical function. Having done so, I must factor that into my assessment of the overall impression created by the designs on an informed user of the products at issue. In *Doceram GmbH v CeramTec GmbH*, Case C-395/16, EU:C:2018:172, the Court of Justice of the European Union held that:

"Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.

Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective

circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an ‘objective observer’”.

25. Accordingly, although the existence of alternative designs for the product does not preclude a finding that the features of a design are dictated by function (and therefore not protectable), the existence of alternative designs may shed some light on whether aspects of appearance play some role in the design.

Assessment

26. The sector concerned is pulse oximeters. Although there is some evidence of other pulse oximeters, visible in the Amazon prints, this evidence is not clearly dated. There is, therefore, no reliable evidence to show what the design corpus was at the relevant date.

27. The informed user is a user of pulse oximeters. That user may be either a private individual or a medical professional: although the contested design is registered as “medical and laboratory equipment”, the earlier design has been available on a general consumer website, suggesting both markets are relevant. As is apparent from the above case law, the informed user is particularly observant and will pay a relatively high degree of attention but will not observe minimal differences in detail.

28. In the case of a pulse oximeter which is used by attaching the device to the fingertip, the proportions of the device, particularly where it attaches to the finger, are constrained by the shape and size of the human finger; a very large device would, for obvious reasons, be impractical. The recess at the front of the device is there to accommodate the finger and to ensure a close fit. There must be a method of opening the device and securing it to the finger: a hinged construction enables the operator to open the device for attachment to the finger and the angled shape behind the hinge allows the device to be opened wide enough to accommodate a fingertip. The presence of an on/off switch and a display screen are required to operate the device. The oximeter will also need a power source and there must therefore be provision for a battery housing. I accept that all of these features are dictated by function.

29. However, there is also potential for design choices to be made. Whether the hinge is concealed or not is a matter of choice. The size, shape and position of both the

display and the on/off switch offer some scope for design freedom. The same applies to the battery housing: whilst it must be big enough to accommodate the battery, its precise size, shape and position, as well as the means for opening it (e.g. whether it is fixed in place by a screw or whether it can be slid open and, if there is a ridged area to assist grip, its particular shape and size) allow expression by the designer. There is also scope for the designer's expression in the precise shape of the device. This includes, for example, whether the device is essentially an oblong or whether it is curved at one or both ends, whether the corners are rounded and whether the long sides of the device lie flat against one another when closed, or whether they are angled. There is further scope for design freedom in the shape of any moulding on the surface of the device casing.

30. Taking all of the above into account, I find that there is a limited degree of design freedom in the shape and configuration of the type of pulse oximeter shown in the contested design.

31. The designs to be compared are:

Prior art	Contested design
 <p>The prior art images show a pulse oximeter with a green top half and a black bottom half. The main image shows the front view with a screen displaying '98' and '80'. Below it are two smaller images showing the side profile from different angles. At the bottom is a larger image showing the side profile with a green button and a black sensor area.</p>	 <p>The contested design images show a pulse oximeter with a black top half and a green bottom half. It is shown from four different perspectives: a top-down view, a side view, a front view, and a back view. The design features a black sensor area and a green button.</p>

32. As I indicated above, the applicant appears to claim that the product shown in the Amazon prints and the patent registration are the same design. I will, therefore, treat the above images of the prior art as one product, save in relation to surface decoration, to which I will return shortly. Both earlier and contested designs appear to have the same overall outline when viewed from above. The short side at the top curves gently from the centre to rounded corners, straight sides and a more pronounced curve on

the bottom. In the earlier designs, the rounded edges of the hinge protrude slightly: in the Amazon prints they are clearly visible when viewed from above and they appear to be slightly rounded, not flush, in the patent. The same applies to the contested design: the third image shows the circular hinge piece proud of the surface. The shape, proportions and arrangement of the display screen and the on/off switch are identical in all of the designs. In addition, whilst the proprietor has disclaimed the specific colours, there is a noticeable contrast between the colour of the uppermost piece of the design and the lower body. There is also a contrast between the round hinge and the rest of the product. These contrasting features are identical in both the earlier and the contested designs. The earlier design also appears to feature two short raised lines in the moulding, above the display (the reproduction of the patent, above, is not especially clear but in the copy of the electronic evidence before me it is just about possible to discern the two small lines in the moulding above the display). These appear to be identical in length, width and position to two small raised lines in the contested design, which are not obvious from the reproductions above but are clear in the illustrations on the register. Further, the images of the patent registration show that the curved moulding on the upper sides of the product is identical to that of the contested design, with both featuring a longer curve upwards from the base, a length over the hinge which is flush with the face of the design and a short curve downwards at the top.

33. There are differences between the visible faces in the presence of writing on both earlier designs and the on/off or standby symbol on the button of the patent image. I accept that these are part of the prior art. The trade mark, or company name, is likely to be perceived as just that, rather than a particularly important feature of the design, and the on/off symbol will simply indicate the purpose of the button to the user. I do not consider that either makes more than a trivial contribution to the overall impression created by the prior art. The images of the patent suggest that it is possible that the prior art features the same vertical line of moulding on the upper part of its side, as is visible in the contested design but I cannot be sure that that is the case. However, whilst I recognise the difference, I do not consider that this is a particularly important feature of the contested design.

34. The contested design must be treated as protected for all of the faces visible in the illustrations. There are no images of the base of the earlier design, though it is clear that the bottom edge runs parallel to the top, as in the contested design. This is not a component part where it might be acceptable only to take into account the areas visible once integrated into a larger product. It is clear that decisive weight cannot be attached to the perspective during use and that even if only a limited perspective is visible during use, the user will be aware of the other perspectives, not least since those perspective were visible at the point of purchase and may have contributed to the purchasing decision: *Senz Technologies BV v OHIM*, Joined Cases T-22/13 and T-23/13, EU:T:2015:310.

35. I accept that the base of the device will be visible to the user during selection and when attaching the product and that, although the device is likely to be worn (or may have to be worn) with the display facing up, the natural movement of the user's hands will mean that the view during use is not exclusively of the upper and side parts of the device: the base will be seen even when attached to the finger. However, the prints from Amazon show the front and sides of various oximeters for sale, but not the base. That suggests that the upper face and sides of the device will be more important to the user than the underneath. I also bear in mind that the photographs on the Amazon web print appear to show a strap attached to one iteration of the device. Nevertheless, the base of the product, even if it did feature a fixing loop for a strap, would play a lesser role in the overall impression of the prior art. My view is that whilst any differences on the base may not go wholly unnoticed, the lesser importance of that face and the very striking similarities between all of the other faces of the prior art and the contested design—which are, apart from the words and on/off symbol, if not identical then very nearly so— will result in the contested design creating the same overall impression as the prior art. The contested design does not have individual character. The ground based upon s. 1B succeeds.

Section 11ZA(2)

36. Section 11ZA(2) reads:

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

37. The relevant part of s. 2 reads:

“2.— Proprietorship of designs.

(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

[...]

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

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the ‘*author*’ of a design means the person who creates it.

(4) [...]

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection”.

38. The only evidence in respect of this ground is a print from the CNIPA website, which shows the applicant recorded as the proprietor of the patent. As s. 2(2) makes clear, the fact that the applicant was not the designer is not necessarily a difficulty and the official record is prima facie evidence that the applicant does own the patent as claimed: I see no reason (nor has the proprietor offered one) to believe that the CNIPA record is incorrect. However, the CNIPA record does not demonstrate that the

designers assigned their UK design rights (as distinct from their design rights in China) to the applicant. In the absence of any evidence from the applicant as to whether the designers were, for example, employees, whether there was an assignment of the patent design subsequent to its creation or the territorial scope of any assignment, I cannot be satisfied that the applicant is the owner of the design in the UK. The claim under this ground is not made out. The application based upon s. 11ZA(2) fails.

Conclusion

39. The application for invalidity has succeeded. The design is invalid.

Costs

40. The applicant has been successful and would ordinarily be entitled to an award of costs. However, the tribunal wrote to the parties on 10 February 2021 indicating that, as unrepresented litigants, the parties would be required to complete a costs pro-forma if an award of costs was sought. The letter stated that if the pro forma was not completed and returned, “costs, other than official fees arising from the action [...] may not be awarded”. Neither party has filed a costs pro-forma. That being the case, I award costs to the applicant in the sum of £48, that being the official fee for filing the application for invalidation.

41. I order Denis Lau S Yung to pay Beijing choice Electronic Technology Co. Ltd the sum of £48. This sum is to be paid within 21 days 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 2nd day of June 2021

Heather Harrison

For the Registrar

The Comptroller-General