

O/830/21

REGISTERED DESIGNS ACT 1949

REGISTERED DESIGN No. 6090470

IN THE NAME OF NH UNIVERSAL LIMITED

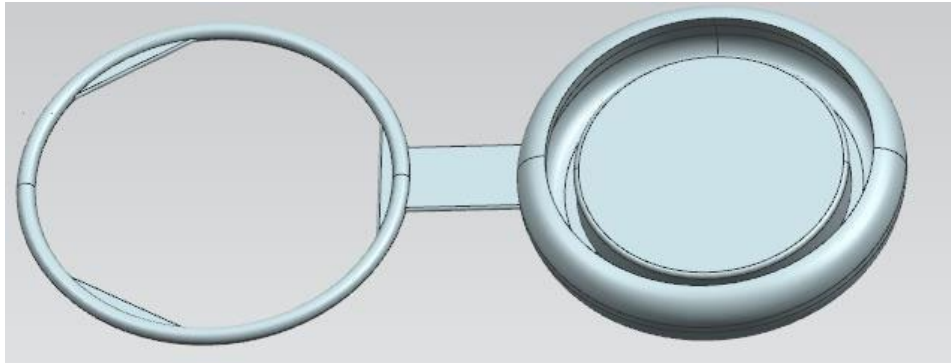
AND

AN APPLICATION FOR INVALIDATION No. 37/20

BY CAPTIVE CLOSURES LLP

Background and pleadings

1. The design shown below is registered with effect from 25th May 2020 in the name of NH Universal Limited (“the proprietor”).



2. The design is described as a “*milk bottle top*.” It is registered in sub-class 7 of class 9 of the Locarno Classification system, which covers “*Closing means and attachments*.”

3. On 30th September 2020, Captive Closures LLP (“the applicant”) applied for the registration of the design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”). The applicant claims that the design is not new and/or does not have individual character compared to a design disclosed in a UK patent application in 1992. Further, the applicant claims that products embodying the earlier design have been on the UK market since that time. According to the applicant, the registered design represents an “*almost exact copy*” of these products.

4. The proprietor filed a counterstatement denying the applicant’s claims. The proprietor accepts that the designs are similar, but claims that the registered design has individual character over the earlier design. In particular, the proprietor draws attention to the “*unique raised underside*” of the registered design, which contrasts with the flat clip-on arrangement in the corresponding part of the earlier design. The proprietor claims this “*unique feature*” enables it to offer a “*leak proof guarantee*” for products made to its design.

Representation

5. Neither side is legally represented. Mr Richard Chadwick, a partner in the applicant's business, acts on its behalf. Mr Nathan Haigh, a director of the proprietor's business acts for it. Both sides filed documents supporting their positions with their statement of case and counterstatement, respectively. As these documents are covered by statements of truth, I will accept them as evidence. In addition, both sides filed subsequent written submissions and witness statements from Mr Chadwick and Mr Haigh, dated 16th February 2021 and 21st March 2021, respectively. Neither party requested a hearing. I have therefore taken this decision from the papers before me.

Evidence

6. The applicant filed a copy of UK patent No. 2272209B, which was filed on 28th October 1992. The patent was granted in 1996 and expired in 2012. The invention was for a captive closure member for a bottle or like cylindrical container. According to the patent, captive closures were not new in 1992 but suffered from a number of disadvantages, such as:

- (i) The collar could have such a tight fit with the container neck that it was difficult to install, or remove;
- (ii) Alternatively, if too loose, the closure could become detached from the container or could rotate around the container neck thereby interfering with the pouring of the container's contents.

7. The invention provided a captive closure with:

- (i) A cap flexibly connected by a relatively thin web of plastic to a collar dimensioned to fit closely around the container neck;
- (ii) A collar with a plurality of segmental flats positioned around its internal surface to prevent rotation of the collar.

8. The invention provided a means to securely fasten the closure member to the neck of the container without requiring an excessively tight fit. The patent indicates

that the preferred number and position of segmental flats was three, equiangularly spaced around the collar.

9. The patent states that *“The cap portion of the closure may be generally conventional, conveniently having a snap fit with the container neck.”* Claim 10 is to *“A captive closure member....wherein the cap portion of the closure has a snap fit with the container neck.”*

10. The illustrations of the invention in the published patent look like this.

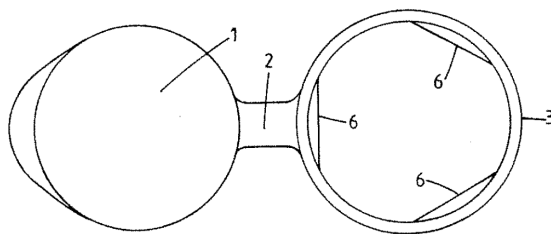


FIG. 1.

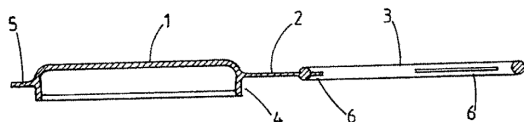


FIG. 2.

11. Mr Chadwick states that his company has been manufacturing and selling products embodying the invention since 1992. The products were sold to large dairies, such as Express Dairy and Dairy Crest, in the 1990s as promotional items. The products are also sold on eBay and Amazon. Mr Chadwick says that he also found the proprietor’s product for sale on Amazon.

12. Mr Haigh provides examples of the two products and draws attention to the unique raised underside of his company’s design which allows bottles to be stored on their

sides and transported without fear or leaks or spillage. Mr Haigh says the raised underside of the cap of shown in the registered design is a key design feature and the reason he registered the contested design. He contrasts this with the underside of the applicant's product, as shown below.



13. Mr Haigh also draws attention to the thumb tab on the cap of the earlier design, which is absent from the registered design, and claims that the strip of material linking the cap to the collar is longer in the registered design than the linking strip shown in the prior art.

The Law

14. Section 1(2) of the Act is as follows:

“In this Act ‘design’ means the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.”

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

“The registration of a design may be declared invalid –

...

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

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

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

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

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

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

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

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

(b) -

(6) -

(7) In subsections (2), (3), (5) and (6) above ‘the relevant date’ means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above ‘normal use’ means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

17. Section 1C of the Act is as follows:

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in,

around or against, another product so that either product may perform its function.

(3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.”

Identification of the features protected by the registered design

18. The single view of the registered design shown on the register reveals:

- (i) There are two circular parts to the design;
- (ii) The one on the left is a thin hollow collar with three equiangularly spaced segmental flats on the internal surface of the collar;
- (iii) The one on the right is a deeper solid cap with a raised underside with a flat surface
- (iv) The raised flat surface of the protrusion extends downwards from the top of the cap to a point just below the tip of the outside lip;
- (v) The outside lip of the cap curves inwards so as to meet the side of the neck of the container to which the cap is applied;
- (vi) The two circular parts of the design are linked by a thin strip of material;
- (vii) The design is silver/blue in colour.

19. The representation of the registered design does not show what it looks like from above, or from the side. One can see enough of the design to establish that the collar is uniform in shape and will look the same from above as from below. One can also see enough to know that the cap will still look round when viewed from above. However, the exact profile of the cap is not clear. Therefore, it cannot be assumed that the top of the cap is (or is not) completely flat, or whether it joins the side wall of the cap at a sharp 90 degree angle, or has a chamfered or rounded edge (like the base of the cap shown in the representation). Consequently, these features are not protected by the registered design and cannot be included in the comparison with the prior art.¹

¹ See *Framery Oy v EUIPO* (Transportable building), T-373/20

Novelty

20. Section 1B(2) of the Act states that a design is new if no identical design, or no design differing only in immaterial details, has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor*,² HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”

21. The raised underside of the cap shown in the registered design is highly visible on the register and will still be visible when the closure is in normal use, e.g. when the closure is opened by the end user to pour the container’s contents. The raised underside of the cap of the registered design would have some effect on the informed user’s perception of the overall appearance of products made to the registered design. This part of the registered design is not part of the prior art identified by the applicant. Consequently, the registered design differs in at least one material respect from the prior art. Further, the side of the cap shown in the prior art appears to have straight sides, whereas the bottom lip of the cap depicted in the registered design curves inwards. Additionally, the cap shown in the prior art includes a thumb tab for lifting it off the container whereas the registered design has a completely round cap with no thumb tab. The registered design must therefore be regarded as a ‘new’ design.

Individual Character

22. A design may be ‘new’, but still lack the necessary ‘individual character’ compared to the prior art. This depends on whether the *“overall impression it produces on the informed user differs from the overall impression produced on such a user by [the prior art].”* The test for individual character was helpfully set out by HHJ Birss (as he then

² [2019] EWHC 3149 (IPEC)

was), sitting as a deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc.*³ as follows:

“One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of ‘different overall impression’ is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The informed user

*“33. ... The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer (C-281/10 P)* [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] EDCR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.*

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);*

³ [2012] EWHC 1882 (Pat)

ii) however, unlike the average consumer of trade mark law, he is particularly observant (PepsiCo paragraph 53);

iii) he has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (PepsiCo paragraph 59 and also paragraph 54 referring to Grupo Promer paragraph 62);

iv) he is interested in the products concerned and shows a relatively high degree of attention when he uses them (PepsiCo paragraph 59);

v) he conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (PepsiCo paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (PepsiCo paragraph 59)."

"Design freedom

40. In Dyson Ltd v Vax Ltd, [2010] FSR 39, Arnold J (as he was then) stated that:

"... 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.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.”

The informed user

23. The registered proprietor submits that the informed user is an environmentally conscious member of the public who has milk delivered in glass bottles. The closure will be used to re-seal the bottle once it has been opened and store it in any position in the fridge without fear of leakage.

24. I note that the applicant's business at one time supplied its closures to dairies. However, this appears to have been for use as promotional items rather than for use by the dairies themselves. Further, the applicant supplies businesses who sell the closures on eBay and Amazon. I infer from this that these sales are aimed at the general public. Therefore, the applicant's evidence does not appear to contradict the registered proprietor's characterisation of the informed user as a member of the public who stores milk or other liquids in bottles and requires a closure to seal and store the bottle after it is first opened. I find accordingly.

25. Such an informed user is deemed to be more observant than the average member of the public. In the context of closures for bottles, he or she is likely to pay a relatively high degree (but not the highest degree) of attention when using the product.

Functionality and design freedom

26. As noted in *Samsung Electronics (UK) Ltd v Apple Inc.*, the registered design system is not intended to protect new designs which represent advances in function. That is the purpose of the patent system, which limits the term of protection afforded to new inventions to a maximum of 20 years. Section 1C(1) of the Registered Design Act states that “*a right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.*” Hence Birss L.J. (as he is now) observation that “*Things which look the same because they do the same thing are not examples of infringement of design right.*” This is taken into account when assessing whether two designs create the same overall impression on an informed user. Specifically, the more a feature appears to be functional, the more a designer’s freedom in choosing that aspect of the design will be regarded as constrained by technical requirements, and the less attention an informed user will pay to it when it comes to forming an overall impression of the design.

27. Turning to the designs at issue, the patent documents provided by the applicant clearly show that the cap and collar of the earlier design are functional. The round collar is designed to fit snugly (but not so tightly as to make it hard to put on or remove) around the neck of a milk bottle. The segmental flats are intended to secure the collar and prevent it rotating around the neck. The positioning of the segmental flats within the collar is identified as the ideal arrangement to achieve this functional advantage. The cap is round so that it will fit the top of a bottle. The sidewall of the cap is vertical because it is part of a snap-fit design. The thumb tab is present to make it easier for the user to apply or break the snap-fit seal when closing and re-opening the closure. The thin joining strip between the collar and cap keeps them connected when the cap is opened, and keeps the cap in the same position relative to the collar once the

cap has been applied to the bottle. All the features of the prior art appear to be functional.

28. The registered proprietor claims that the thin joining strip between the collar and cap is longer in the registered design than the one shown in the prior art. This is said to allow the cap to hang lower on the bottle when the cap is removed and thereby prevent it from interfering with the pouring of the contents. In my view, the difference between the connection in the representation of the design on the register and the connecting strip shown in the prior art is so slight that not even an informed user would notice it.⁴ Further, even if they did, they would recognise it as having the purely functional advantage suggested by the proprietor, and therefore pay little attention to it when forming an overall impression of the designs.

29. The collar shown in the registered design is the same shape as the collar shown in the prior art.

30. The visible features of the cap forming part of the registered design differ from those shown in the cap in the prior art in three respects. Firstly, it has a raised underside with a flat surface protruding downward from the top of the cap to a point just below the tip of the outside lip, whereas the cap shown in the prior art has a hollow centre. Secondly, the outside lip of the cap curves inwards, whereas the cap shown in the prior art has a vertical sidewall. Thirdly, the cap is completely round,⁵ whereas the cap shown in the prior art is not completely round because of the added thumb tab.

31. These differences between the design of the caps appear to be the result of an advance in function. Although the applicant disputes it, the registered proprietor claims that the cap in the registered design works better at preventing leaks. The net effect of these observations and findings is that both designs

⁴ Some of the pictures of the registered proprietor's actual product appear to show a longer connecting strip, but this is not the design as registered

⁵ Some of the pictures of the registered proprietor's actual product appear to show a small thumb tab, but this is not the design as registered

appear to be solely functional. This is not surprising so far as the earlier design is concerned. After all, it is depicted in a UK patent, which is all about function. It is more surprising that the proprietor has chosen to protect what it considers to be a further advance in closure function via a registered design. However, there is no application to invalidate the registered design under section 1(C)(1) of the Act on the grounds it is solely dictated by function. I must therefore decide whether the designs would create the same overall impression on an informed user on the ground that has been advanced. I will approach this on the footing that although the appearance of functional features must be given less weight than arbitrary design choices in the required evaluation, this does not mean that the appearance of functional features cannot be given any weight at all (at least where there are no other design features). This seems clear from the requirement in section 1B(4) of the Act to take account of the *degree* of freedom of the author in creating the design.⁶

32. I find that the differences in the design of the cap shown in the registered design is sufficient for the design as a whole to create a different overall impression on an informed user compared to the design shown in the prior art. Apart from being functional, the thumb tab shown in the earlier design has minimal visual impact. The difference in (or, in the case of the patent documents, absence of) colour is another trivial difference. They are not material. However, the raised flat underside and the curved sidewall of the cap shown in the registered design have sufficient visual impact that an informed user would (a) notice them, and (b) form a different overall impression of the registered design than of the prior art.

33. The application for invalidation of the registered design under section 11ZA(1)(b) of the Act therefore fails.

⁶ See also *Pulseon Oy v Garmin (Europe) Limited* [2019] EWCA Civ 138 at paragraph 23 of the judgment

Costs

34. The proprietor has been successful and would usually be entitled to an order requiring the applicant to make a contribution towards its costs. The registrar wrote to the proprietor on 6th August stating that if it intended to make a request for an award of costs, it must complete and return, by 3rd September, the pro-forma provided with the letter showing how much time had been spent on the proceedings. This letter also warned that *“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”*

35. No such request for costs appears to have been received. The proprietor does not appear to have incurred any costs from paying official fees. Therefore, I order the parties to bear their own costs.

Dated 11th November 2021

Allan James

For the Registrar,

The Comptroller-General