

O/856/21

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 6070647
IN THE NAME OF JANET ELIZABETH RIVETT
IN RESPECT OF THE FOLLOWING DESIGN:**



**AND
A REQUEST TO INVALIDATE (NO. 04/20)
BY DEVANET UK LTD**

Background and pleadings

1. The registered design the subject of these proceedings was filed by Janet Elizabeth Rivett (the proprietor) on 11 September 2019. The registered design is described as a 'belt'. It is depicted as follows:



2. The registration includes a disclaimer which reads: “No claim is made for the colour shown in the illustrations”.

3. On 22 January 2020, Devanet UK Ltd (the applicant) applied for the registration of the design to be declared invalid. The application is based on section 1B¹ of the Registered Designs Act 1949 (the Act) which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The applicant relies upon its own business and the existing design corpus.

¹ This is relevant in invalidation proceedings due to the provisions of 11ZA which gives the grounds for invalidation of a registered design.

4. The applicant submits (reproduced as written):

“The design registration 6070647 is invalid for several reasons and one in particular which infringes the copyright of designs in the public domain which have been for over 12 years. Furthermore, Devanet has been designing and producing various designs of Alphabet belts and buckles since 2016. In addition Janet Elizabeth Rivett approached our company on the 19th February 2019 to design a range of letters for belts as a replacement for Chinese imported letters - which the registrant is still importing and passing off as British Made.

Devanet is a UK designer and manufacturer of metal buckles and leather goods since its incorporation in 2014, the company designs and manufactures all types of letters and names for belts and is the only UK producer of alphabet letters for belts. Our website clearly illustrates the comprehensive range of alphabet letters and belts we offer to customers all of which are UK manufactured. link here: https://devanetbelts.co.uk/alphabet_buckles.html.”

5. The proprietor filed a counterstatement denying the claims. She submits the following (reproduced as written):

“I describe my design as being a leather belt strap in which personalised letters and characters slide along the leather belt strap and are secured in place by a leather keeper with hidden stud-fastener, designed to create a unique sleek personalised fashion accessory.

The objections made by Devanet UK relate to fixed buckles in which the fixed buckle is a letter or word. The design is different than mine as my design can be altered very simply by changing the letters by personal preference, whereas Devanet UK always refer to their examples as being a buckle or buckles.

My design concept is not a buckle and is secured by a simple studfastener, the uniqueness of the appearance of my design is the ability to interchange any letter or character along the belt strap. For example, my design can say any word you desire and can be changed each time the belt is worn giving total flexibility to the appearance of the design.”

6. Neither side requested a hearing. Both sides filed evidence. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties are representing themselves.

Decision

Section 1(B)

7. Section 11ZA of the Act provides the capability for a registered design to be invalidated under section 1B of the Act on the ground that it was not new or that it did not have individual character at the relevant date. Section 1B 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) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or

is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8)..."

What is the scope of the registered design?

8. The Registered Designs Act 1949, section 1(2) reads:

"In this Act 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation."

9. It is clear from the case law that what counts for the purpose of design registration is what can be seen. In *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat), HHJ Birss QC (as he then was), sitting as a Deputy Judge of the Patents Court, said:

"31. I start by reminding myself that what really matters is what the court can see with its own eyes (per Jacob L.J. in *Dyson Ltd v Vax Ltd* [2011] EWCA Civ 1206 at [8] and [9], emphasising a passage from his judgment in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936; [2008] ECDR 3; [2008] FSR 8 (at [3] and [4])). The most important things are the registered design, the accused object and the prior art and the most important thing about each of these is what they look like.

32. I also remind myself that while the exercise is a visual one, judgments have to be written and reasons necessarily expressed in words. However I must bear in mind that it is the overall impression which counts and not a verbalised list of features, see [46] of the judgment of Arnold J at first instance in *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat); [2010] ECDR 18; [2010] FSR 39 and his reference there to the observations of Mann J in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] ECDR 13 (at [123], [125] and [126]). As Mann J said,

‘one of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities.’”

10. When it comes to interpreting the representations of the contested design, I bear in mind *Magmatic Ltd v PMS International Ltd*, [2016] UKSC 12, in which Lord Neuberger (with whom the rest of the Supreme Court agreed) held that:

“30. Article 3(a) of the Principal Regulation [Regulation No 6/2002] identifies what is meant by ‘design’, and, unsurprisingly, it refers to the appearance, which is expressed to include a number of different factors, all, some or one of which can be included in a particular registered design. It is, of course, up to an applicant as to what features he includes in his design application. He can make an application based on all or any of ‘the lines, contours, colours, shape, texture ... materials ... and/or ... ornamentation’ of ‘the product’ in question. Further, he can make a large number of different applications, particularly as the Principal Regulation itself provides that applications for registration have to be cheap and simple to make. As Lewison J put it in *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 13, para 48, ‘[t]he registration holder is entitled to choose the level of generality at which his design is to be considered. If he chooses too general a level, his design may be invalidated by the prior art. If he chooses too specific a level he may not be protected against similar designs’. So, when it comes to deciding the extent of protection afforded by a particular Community Registered Design, the question must ultimately depend on the proper interpretation of the registration in issue, and in particular of the images included in that registration.

31. Accordingly, it is right to bear in mind that an applicant for a design right is entitled, within very broad limits, to submit any images which he chooses. Further, in the light of article 36(6), an applicant should appreciate that it will almost always be those images which exclusively identify the nature and

extent of the monopoly which he is claiming. As Dr Martin Schlötelburg, the co-ordinator of OHIM's Designs Department has written, 'the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them' – *The Community Design: First Experience with Registrations* [2003] EIPR 383, 385. And, as Dr Schlötelburg went on to explain, an applicant is free to indicate which, if any, aspects of the images of a Community Registered Design are disclaimed:

'Where an applicant wishes to exclude features which are shown in the representation for explanatory purposes only, but do not form part of the claimed design, he may disclaim those auxiliary features by depicting them in broken lines (for drawings) or by means of colouring them (for black and white drawings or photos) or encircling them (for any drawing or photo).''

11. I also take note of *Sealed Air Limited v Sharp Interpack Limited & Anor* [2013] EWPC 23, in which Mr Justice Birss sitting as a judge of the Patents County Court held that the interpretation of the design representations is a matter for the court and not the informed user.²

12. The proprietor describes her design in the following terms:

"My design concept is not a buckle and is secured by a simple studfastener, the uniqueness of the appearance of my design is the ability to interchange any letter or character along the belt strap. For example, my design can say any word you desire and can be changed each time the belt is worn giving total flexibility to the appearance of the design."

13. The proprietor includes images of some of her designs which she submits are protected by her contested design registration:

² See paragraphs 20-21.



14. The representations of the proprietor's design shown in the registration are the letters ABC attached to a strip of material, specifically:



15. It is the images which make up the registered design which define the scope of the design. This means that the proprietor's design is only be protected in respect of the three letters, ABC, shown in the design representations. If the proprietor were to have protection for all letter combinations simply by filing a design which includes the first three letters of the roman alphabet, the level of protection would be enormous and would extend to designs which are very different from the one depicted in the registration. The examples provided by the proprietor of some of her designs which show, inter alia, DADDY, BETH and CLAUDIA are clearly not protected by the ABC design as registered.

16. Many of the submissions and much of the evidence filed by both sides concerns the nature of the letters and whether they are fixed or interchangeable. One of the design images shows the letter A separated from the belt. If I take this to mean that the letters shown are able to be separated in use and are therefore interchangeable (which is a very generous reading of the design representations as they appear in the registered design), then the full extent of the protection shown by the proprietor's

design is a belt with the letters ABC (and only those letters), where those letters can be removed or re-ordered on the belt.

17. Nothing about the registered design at issue in this case indicates that the protection extends to a belt with any letters other ABC, which are those depicted in the registration.

Preliminary issues

18. The applicant has filed evidence concerning a prior business relationship between the proprietor and the applicant. In February 2019 the proprietor approached the applicant to request quotes and to discuss designs relating to the applicant's 'customised belt concept'.³ Discussions were ongoing for a few months until the proprietor decided to source letters for her belts from elsewhere. None of the correspondence between the parties relates to the contested ABC belt design, the scope of which I have identified in the previous paragraphs.

19. Throughout the proceedings the parties have referred to various matters in the evidence which do not form part of the contested design. These include:

- The quality of the letters used for the belt in the contested design.
- Where the letters are manufactured.
- The range of typefaces in which the applicant's letters can be cast.

20. None of these is a factor which is relevant to my decision. It is the overall impression of the design as registered that I am required to take into account for the purposes of my assessment. Any details that are not visible from the representations of the design protected, are not relevant to my decision.

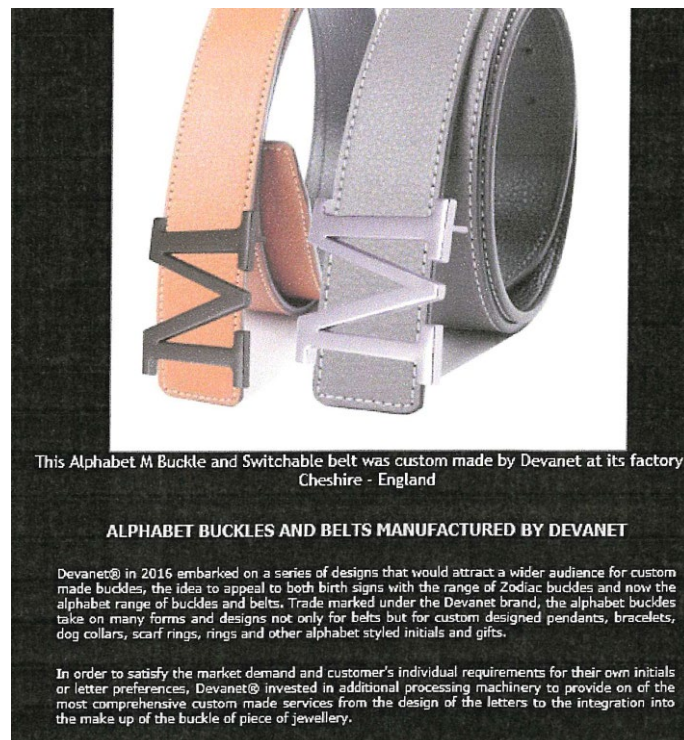
³ See the emails attached to the applicant's request for invalidation form DF19A.

Prior Art

21. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked, unless the exceptions in subsection (6) apply. This means that the relevant date for my assessment is 11 September 2019. Any prior art must have been made available to the public prior to this date.

22. The applicant's evidence of prior art is contained in its request to invalidate the contested design and further evidence is attached to the witness statements of Alan Rogers, dated 16 April 2021 and two witness statements of David Webster, dated 27 December 2020 and 16 April 2021.

23. A page from the applicant's website shows the following:



24. The page talks of the launch of birth sign belt buckles in 2016 and 'now' the alphabet range. The page is not dated, and it is not clear when 'now' is in the context of this article.

25. I note that Alan Rogers's witness statement indicates that the applicant began making letter belts in 2016 but I have no date which is more accurate than a year.

26. No more images of the applicant's finished goods are provided in evidence.

27. Mr Webster also seeks to rely on a number of trade mark registrations owned by, inter alia, Moschino, Ralph Lauren and Valentino.⁴ Each of these registrations is shown in the applicant's evidence as including an image of a belt with the trade marked word applied to it in the buckle area. For example:

UK00001042192

Status:
Registered

Mark type:
Word

Mark text:
VALENTINO

File date:
13 February 1975

Classes:
25



irio Valentino - Winter Emma
ar Belt - Black
& Returns

28. The applicant's evidence also includes a Wikipedia article about the Moschino brand. It is undated and is followed by images of a number of Moschino branded belts, which have the word MOSCHINO in the buckle area.

29. The applicant has also provided images of letter designs and castings for the types of letters that it manufactures.

⁴ See the attachments to Mr Webster's application for invalidation.

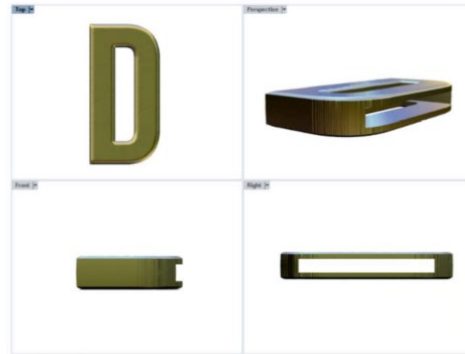
EXHIBIT 1

Illustration of open centre to facilitate slide on feature of buckles onto the belt



EXHIBIT 1A

DEVANET DEVANET



30. He provides, at exhibit 6, an article dated 5 October 2014 which discusses the MOSCHINO belt which is describes as:

“Screaming gold capitals, a 2-inch wide calf skin leather belt and zero holding-up power. To some, it’s just a belt. To others it’s daft. Either way, as accessories go, Moschino’s logo belt pulls no aesthetic punches, which explains why the belt – one of the most covetable accessories of the past 25 years – is now reportedly one of the most faked accessories too...”

Decision

31. Both parties in this case have run arguments which are extraneous to the matter to be decided. The applicant has brought its case on the basis of what the proprietor refers to as its ‘concept’ of a belt which has interchangeable letters. As I have already explained above at paragraph 15, this is not the design which the proprietor has protected. The proprietor’s design includes only the first three letters of the alphabet. Under the current registered design regime, the proprietor could protect a belt with lots of individual letters, as a set, though the number of interchangeable letters would need to be vast in order to spell any of an almost infinite number of words or names. But, in any case, the representations for this contested design mean that what is protected is a belt which has the letters ABC (and possibly a combination of those three letters in

a different order) affixed to it in the 'buckle area'. The proprietor has defended its case on the basis of that aforementioned concept which it claims to 'own'. As a result, the parties have concentrated on a claimed concept rather than the actual contested design.

32. Whilst I am content that belts which include letters from the roman alphabet pre-date the contested registration, the applicant's case gets no further than that. The evidence from its own website is not dated. Reading the text of the website page alongside a comment from Alan Rogers's witness statement⁵, it is possible to conclude that the applicant has made belts with 'alphabet buckles' since 2016. However, I have no evidence of what those belts looked like. The image of a belt with a letter M which heads the applicant's webpage may not be indicative of the belts which were being made prior to the contested design registration, since that image itself is not dated and nor is the time or date of webpage access provided.

33. Whilst it is possible to rely on a trade mark as evidence of prior art in a registered design case, these submissions do not help the applicant. This is because each of the trade mark registrations relied on relates to either a word trade mark or a figurative word trade mark. Mr Webster has himself included a picture of a belt with that word on it, next to the UK trade mark details. Mr Webster is correct that the trade marks date from the dates shown on the register, but this gives no indication of the dates when the belts were produced, the images of which he has presumably accessed from another source, the details of which are not provided. Mr Webster has simply placed undated images next to trade mark details taken from the UK register.

34. There is evidence in the form of an article about MOSCHINO and its much 'faked' belt, which has the gold letters MOSCHINO displayed prominently on its front. Again, I have no specific dates, though it is clear from the article a belt of this type pre-dated the contested design. But there are no dated images to support this or to show the extent of the design at any given point in time.

⁵ See the first paragraph of the second page of Mr Rogers's witness statement dated, 16 April 2021.

35. As noted above, a design will be considered new if “no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.” Furthermore, a design will be considered to have individual character if “the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date”. For the application to succeed, the registered design must not be new and/or must not have individual character, when compared with the prior art. As the applicant has not provided evidence to enable me to compare a design or piece of prior art to the contested ‘ABC’ design, this application is bound to fail.

Conclusions

36. The invalidation against this design has failed under section 1B of the Act.

COSTS

37. The proprietor has been successful and is, in principle, entitled to a contribution towards her costs. As the proprietor is unrepresented, at the conclusion of the evidence rounds the Tribunal invited her, in the official letter dated 22 July 2021, to indicate whether she wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the cancellation application; it was made clear to the proprietor that if the pro-forma was not completed then no costs will be awarded. The proprietor did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 23rd day of November 2021

Al Skilton

For the Registrar,

The Comptroller-General