

O-598-15

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF:

REGISTERED DESIGNS

**4032591, 4032592, 4033463, 4033464, 4033465, 4033466, 4033467, 4033469,
4032574, 4032575, 4032576, 4032577, 4032580, 4032581, 4032582, 4032583,
4032584, 4032585, 4032586, 40325898 & 4032590**

OWNED BY YAOJIE LIU

AND

APPLICATIONS BY ORIGAMIC LTD TO INVALIDATE THE DESIGNS

The background and the claims

1. This dispute concerns the validity of twenty one registered designs which stand in the name of Mr Yaojie Liu. All of the designs consist of “pop-up greetings cards”¹ of one form or another. The designs were filed on 26 November 2013.
2. Origamic Ltd (the applicant) requests the invalidation of the designs. Of the twenty one requests for invalidity, all except one (4032592) contains a ground based upon section 1B of the Registered Designs Act 1949 (“the Act”), the claim being that the designs lack novelty and individual character. Two cases (4032583² & 4033466) plead, in addition to section 1B, a ground under section 11ZA(2), the claim being that Mr Liu is not the true proprietor of the designs. One case (4032592) is pleaded under section 11ZA(2) only.
3. I note from the applicant’s evidence that some of the designs are requested to be invalidated on grounds that were not pleaded. For example, registration 4032592 is sought to be invalidated under both section 1B and 11ZA(2) despite only the latter ground being pleaded, and registration 4032591 is also sought to be invalidated under both section 1B and 11ZA(2) despite only the former being pleaded. I will come back to this point later.
4. The proprietor filed counterstatements and the cases were consolidated.
5. Both sides have represented themselves throughout the proceedings. Both sides filed evidence³. Neither side requested a hearing.
6. I will begin by dealing with the grounds pleaded under section 11ZA(2) of the Act.

Section 11ZA(2) of the Act

The law

7. Section 11ZA(2) of the Act 1949 states:

“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 registered design objecting”.

8. Proprietorship of designs registered under the Act are dealt with in section 2, the relevant parts of which read:

“2. Proprietorship of designs

¹ This is how Mr Liu described the designs when he applied for them.

² In relation to this case, the second ground was added following a clarification (sought by the tribunal) from the applicant. Clarification was sought because the claim as initially worded appeared to relate to both grounds but only one had been formally pleaded.

³ The applicant’s evidence comes from Mr Piotr Zipser, Director of Origamic Ltd. The owner’s evidence is from Mr Liu.

(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.

(1A) Where a design is created in pursuance of a commission for money or money's worth, the person commissioning the design shall be treated as the original proprietor of the design⁴.

(1B) Where, in a case not falling within subsection (1A), 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)_"

9. The essence of a claim under section 11ZA(2) is a dispute over the proprietorship of a design, the claim being that the person who registered it (in this case Mr Liu) is not, in accordance with the ownership provisions set out above, the true proprietor. However, there is one further part of the law that needs to be highlighted, namely, section 11ZB(5), which reads:

"(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."

10. The net effect of sections 11ZA(2) and 11ZB(5) is that a request to invalidate a registered design on the issue of proprietorship can only be made by the person claiming to be the true proprietor of the design.

Analysis and findings

11. The section 11ZA(2) pleading was made in relation to registered designs 4032592, 4032583 and 4033466. However, in evidence, Mr Zipser states that 11ZA(2) also applies to designs: 4033466, 4032583, 4032582, 4032585, 4032592, 4032591, 4032574, 4032575, 4032586, 4033463, 4032590 & 4032581. As the ground was not pleaded in relation to these further 12 designs and no request for leave to add such a ground was made, this is reason enough for the claims to be dismissed. However,

⁴ It should be noted that this provision has now changed as a result of the Intellectual Property Act 2014. The position now is that the commissioned person is the owner of the design unless there is an agreement to the contrary. However, this does not apply to designs created before October 2014, so it is therefore not relevant in these proceedings.

what I come on to say in relation to the designs where the ground was properly pleaded will apply in equal measure to the other designs.

12. In his evidence Mr Zipser states that the designs were created by Mr Ho Huu An “which interest in United Kingdom represents Origamic Limited”. It is not clear what type of “interest” is being referred to. In his reply evidence Mr Zipser states that Mr Ho Huu An is a world class graphic designer. Apparently, further information can be found out about Mr Ho Huu An by conducting a *Google* search. It is not the job of the tribunal to conduct internet searches on behalf of a party. If any material regarding Mr Ho Huu An was to be relied upon then Mr Zipser should have filed it.

13. Mr Zipser makes a bare assertion that Mr Ho Huu An created the designs, but there is no evidence to support this. Whilst he provides screen shots of computer files of various designs, they shed no light on the act of creation. The only potential exception is that in relation to design 4032583 there is copy of a copyright certificate issued by the Vietnamese Ministry of Sport, Culture and Tourism in the name of Mr Ho Huu An. However, the work the subject of the copyright is not set out in the certificate. There is no evidence from Mr Ho Huu Ann himself. Mr Zipser does not explain the relationship between Origamic Ltd and Mr Ho Huu Ann. In my view, the evidence does not establish that Mr Ho Huu An created the designs.

14. There is a further reason to dismiss the claim. As stated in paragraph 10 above, only the person claiming to be the proprietor of the designs can make an application under this ground. The applications were made by Origamic Ltd. Therefore, even if it had been established that Mr Ho Huu An created the designs, Origamic Ltd would need to have established that it owned the designs, for example, because Mr Ho Huu An was employed by it and the designs were created as part of the normal course of his employment (section 2(1B)) or that the designs were assigned to Origamic Ltd (section 2(2)). Neither scenario has been made good.

15. At various times in his evidence Mr Zipser states that it is for Mr Liu to prove his ownership. However, this is not pertinent because the claim does not even get off the ground (because it was not made by the person claiming to be the proprietor) and, furthermore, the evidence does not even present a *prima facie* case that Mr Ho Huu An created the designs.

16. For sake of completeness, I note that in relation to some other designs (nos. 4033464, 4033467 and 4033469) Mr Zipser states that they were created by Mrs Hiroko, a “Japanese world class designer”. However, the same problem I have already opined upon also applies here.

17. All of the claims made under section 11ZA(2) fail. I now turn to consider the grounds pleaded under section 1B

Section 1B of the Act

The law

18. 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) -

(c) -

(d) -

(e) -

(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)--”

19. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*⁵. The most relevant parts are re-produced below.

“The informed user

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

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

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

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

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

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

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

Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In Dyson Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features

⁵ [2012] EWHC 1882 (Pat)

common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of “different overall impression” is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree

from 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.”

20. The relevant date is the date on which the proprietor applied to register the respective designs, namely: 26 November 2013.

Analysis and findings

The inclusion in the registered designs of the front view of the greetings card

21. In his evidence, Mr Zipser provides various pieces of evidence in an attempt to show that the respective designs have been publically disclosed. I will return later to whether public disclosure has been established for some of the designs, but begin by considering the fact that for most of the designs, the evidence of the claimed prior art does not show what is on the front of the greetings card that is claimed to have been disclosed. This is in contrast to the representations of the registered designs where the front cover is shown. By way of example, in relation to registered design 4032592, the following images represent what the registered design looks like; the representation on the left is the front of the card, the representation on the right shows the card when open, with its pop-up effect⁶:



22. The prior art looks like this; as already stated, the front is not depicted:

23. In response to Mr Zipser’s evidence, Mr Liu highlighted in his evidence that the photograph(s) of the prior art do not show the front of the greetings card(s). In reply, Mr Zipser stated that the front cover is, essentially, a different design and that changing the cover of the card is like changing the cover of a book.

⁶ Each of the designs show additional views of the pop-up aspect, but it is not necessary to detail them here.

24. A design can be registered for the appearance of the whole of a part of a product⁷. In this case, the registered design must be taken to be registered for the parts of it which are visible in the representations filed, namely, both the front of the card and its internal pop-up effect. Both aspects contribute to the scope of the design and its overall impression. The question of novelty and individual character must be considered on the basis of the design as a whole.

25. To further illustrate the point, a design must firstly be new, which means that no identical design (or one differing in immaterial details) has been made available to the public. Clearly, if the prior does not show the front of the card then it cannot be said that an identical design has been disclosed. Neither can the addition of a front cover with its own graphic element be said to be an immaterial difference. This is particularly so when one bears in mind that the front cover of a greetings card is likely to make a significant impact on the overall impression created on an informed user, after all, it is the front of the card that the user sees first. Consequently, the registered design (as a whole) is new.

26. In terms of the requirement that a registered design must possess individual character, this is met if the new design (as a whole) differs in its overall impression from what has gone before. The overall impression of the registered design(s) must, therefore, take into account its front. The overall impression of the prior art is based purely on its internal pop-up effect.

27. There is no evidence about the design corpus so this factor is a neutral one. In terms of design freedom, this must be wide. Irrespective of this, I come to the view that the absence/presence of the front of the greetings cards means that the overall impression of the registered design (as a whole) is different from the prior art. Therefore, the claim under section 1B must fail even if I had been satisfied that the evidence showed that the prior art had been publically disclosed.

28. This finding extends to all of the designs in which the prior art relied upon consists simply of the internal pop-up part of the card. This is the case with regard to all of the designs except: 4032577, 4032575, 4033463 & 4032581.

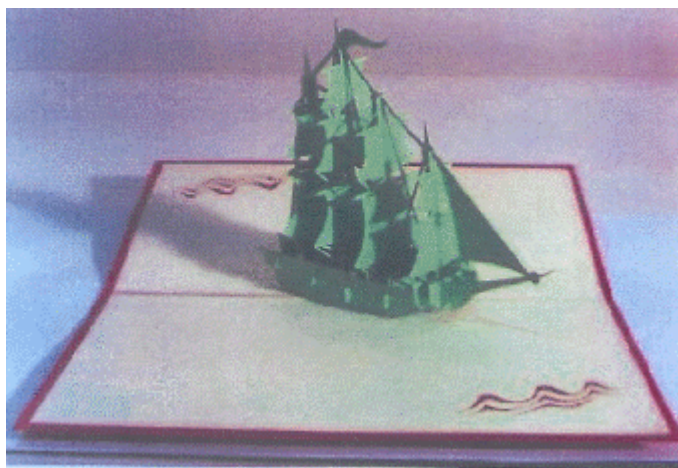
Does the evidence show that the designs have been made available to the public?

29. I will now concentrate on the four designs identified in the preceding paragraph because these are the only designs where the claimed prior art shows the front of the greetings card. I will go through each in turn.

Registered design 4032577

30. The registered design looks like this:

⁷ See section 1(2) of the Act.



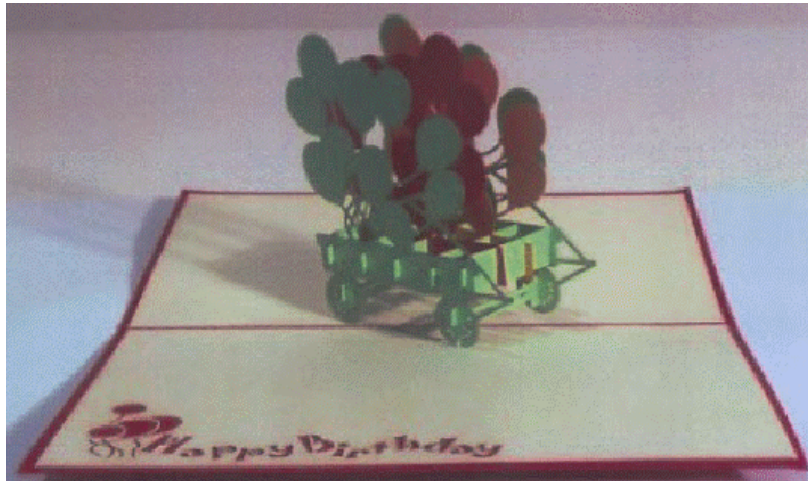
31. In his evidence Mr Zipser states that he is in possession of a picture “made on 3 April 2013”. Exhibit DF19 simply contains the photograph, whereas DF18 contains a computer screen-shot showing a thumbnail of the photograph (and others) together with its file properties. The photograph shows the inside and front cover of a greetings card. It is fair to say that the greetings card depicted in the photograph appears identical to the registered design.

32. The file properties state that the photograph was created on 5 January 2015 but modified on 26 March 2014. It is not explained why the file was apparently modified before the date on which it was created. Mr Zipser states that the picture was taken “not too long after it was created it is impossible to deliver photo older than year from registration date”. This statement is not easy to follow, but, regardless, nothing he has stated establishes the date on which the photograph was taken. The best one can take from the evidence is that the photograph was taken on 25 March 2014. However, as this was after the relevant date, the evidence does not help. In any event, the simple possession of a photograph on a computer does not demonstrate that the greetings card has been made available to the public. For these reasons, I hold that Mr Zipser has failed to establish that the prior art was disclosed to the public at all, and certainly not before the relevant date.

33. I note that Mr Zipser states that registration 4032577 is simply a variation of design 4033466. The prior art relied upon by Mr Zipser in relation to 4033466 is another photograph (but the inside of a card only) and computer file, albeit this time with a modified date of 18 November 2011 (before the relevant date). He also provides a spreadsheet of what he says is a pricelist for a company called Ningbo Breeze Manufacturing Co (“Ningbo”). The spreadsheet’s file properties show a creation date of 25 July 2013 (again, before the relevant date) and depicts a pop-up ship, but it does not even show the full inside of the card, let alone its front. As neither prior art shows the front of the greetings card, the reference to the design being a variation of design 4033466 does not take the applicant any further forward because the prior art relied on to attack 4033466 does not show that it lacks novelty (as a whole).

Registered design 4032575

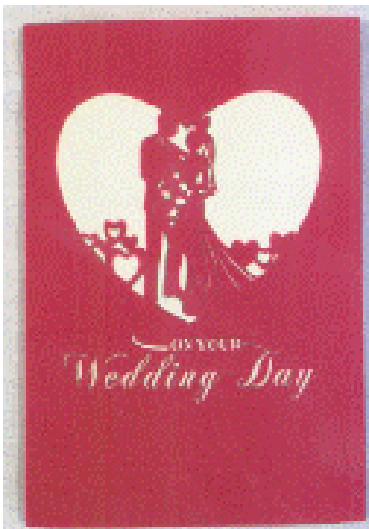
34. The registered design looks like this:



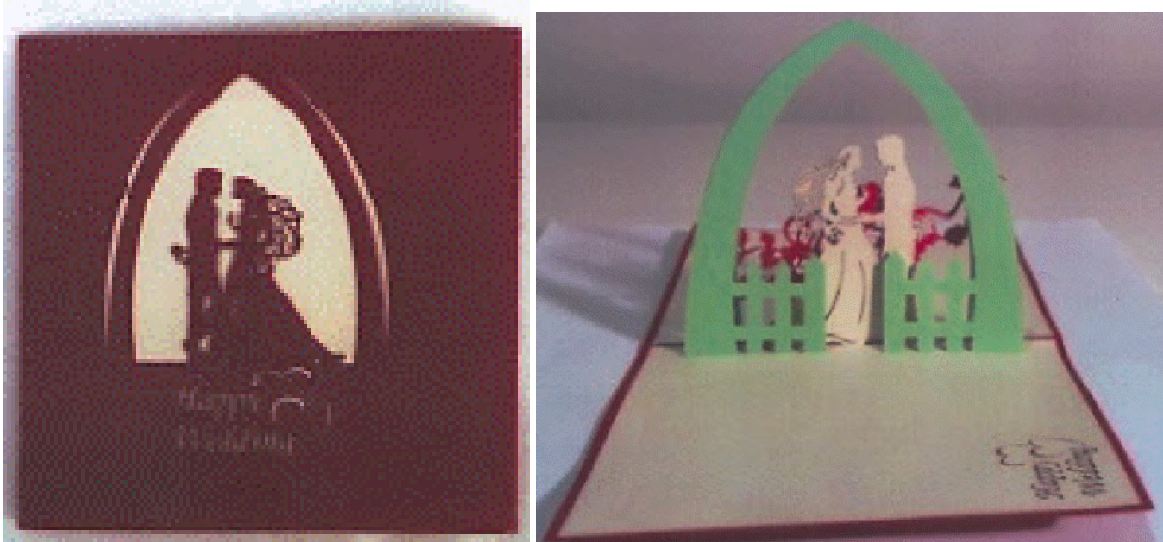
35. Mr Zipser, again, relies on a photograph in his possession (Exhibit D17) and accompanying file properties (Exhibit D16). The file properties show that it was created on 23 March 2015 and last modified on 26 March 2014. Whilst the photograph does, again, appear to be identical to the registered design, it suffers the same flaw as 4032577 given that the modified date is after the relevant date and, furthermore, the presence of a photograph on a computer does not, in any event, count as a disclosure to the public.

Registered designs 4033463 and 4032581

36. Registered design 4033463 looks like this:



registered design 4032581 looks like this:



37. Mr Zipser states that these designs were sold by Ningbo in China before the registration date of the designs. He provides a spreadsheet in Exhibit D21 showing photographs of what he says are the designs. There is nothing to date this particular spreadsheet which is entitled “3D GREETING CARD”. Mr Zipser does refer to another pricelist from Ningbo in Exhibit D3 (which has a created date in July 2013, before the relevant date) but this shows other designs not the two above. It cannot be the case that the spreadsheet in Exhibit D21 is simply another page of the spreadsheet in Exhibit D3 as it has a different name (D3 is entitled “Ningbo Pricelist July”). The consequence of this is that there is no evidence to show that the pricelist was dated before the relevant date. Mr Zipser does state that:

“The earliest file what I am in possession is price list moderated on 25 July 2013 and email confirmation of company representative that this pricelist was actual on beginning of May 2013, but they believe these designs were sold as far as July 2012” [sp]

38. None of the material referred to above is provided. The statement claimed to have been made by a company representative is hearsay. Whilst hearsay evidence is not to be ignored simply because it is hearsay, I do not consider that it should be given any real weight here because the detail of the various exchanges is so lacking in detail. In short, the evidence provided by Mr Zipser does not establish that the designs have been disclosed to the public before the relevant date.

Other evidence

39. Much of what I have said above is based upon the evidence provided by the parties during the course of the evidence rounds. I must, though, also consider the material filed with the statements of case because such material can be taken into account as evidence⁸. Whilst Mr Zipser makes some broad assertions about the designs, it lacks specificity in relation to them given that, at times, he is commenting upon all 21 registered designs. He does, though, provide photographs of what he says is his stall on which various greetings cards are sold. The file properties of these

⁸ As per Rule 21(1)(a) of the Registered Designs Rules 2006.

photographs are not provided. Instead, they have hand-written dates and information. Of the four photographs provided, my observations are as follows:

- i) There is a handwritten date of 20 July 2013 on the front of the photograph. On the rear there is a list of eight design numbers plus the text "Picture of our market stall on Tavistock Square (Portobello Road Market) on 20th July 2013". The problem with this photograph is that it does not show the fronts of any cards so does not assist for the reasons I have already given.
- ii) This photograph contains similar hand-written text. The claimed date of taking is 18 September 2013. Most of the greetings cards depicted in this photograph show them in open format (so the front cover cannot be seen) so do not assist. There are some additional greetings cards dotted around the table showing a front cover, but it is very difficult to see what they depict and no form of objective comparison can be made with the registered designs. Furthermore, it is not clear whether the cards showing the front cover have necessarily been placed upon (or near) a card which shows its respective inside. For these reasons, this second photograph does not assist.
- iii) This photograph has handwritten text stating "Picture made by Tony Annis (Portobello Road Market) of Portobello Road Market. Picture was sent to us on 30 November 2013 [after the relevant date] but was taken around three weeks before". I do not consider this evidence to be compelling. There is no precision as to the date. No information is provided about the photo taker or whether Mr Zipser was aware of when the photograph was taken or whether he is relying on information provided to him by Mr Annis. To rely on such evidence as the only source of evidence to invalidate a registered design is not appropriate, particularly when one bears in mind that Mr Liu, when filing his counterstatement, questioned the probative value of all of what had been provided and requested that better evidence be filed.
- iv) The fourth photograph falls in the same category as above.

Conclusion

40. For a mixture of reasons, all of the applications requesting invalidity are dismissed. I note that Mr Zipser states that the registrations should be invalidated because Mr Liu failed to send copies of his counterstatements to the applicant. This point does not appear to have been raised before. Whilst it is not clear whether the counterstatements were copied to Mr Zipser by Mr Liu, he is clearly aware of the counterstatements given that they were sent to him by the tribunal. That the tribunal copied them to the applicant was for ease of administration and should not be used as a tactical reason to knock out the defences.

41. I also note in concluding that when Mr Liu originally filed his defences he used forms of wordings which could have been interpreted as an acceptance that prior disclosure had taken place, albeit by Mr Liu himself. However, he subsequently clarified that this is not what he meant so there is no reason (or evidence) to show that the designs have been self-disclosed.

Costs

42. The proprietor having succeeded, he is entitled to a contribution towards costs. I have taken into account that the proprietor was not represented so would not have incurred legal fees. Furthermore, although the designs were all different, the largely similar nature of the claims and evidence, together with the fact that the cases were consolidated, means that costs were saved. My assessment is as follows:

Considering statements of case and filing counterstatements - £400

Filing and considering evidence - £300

43. I therefore order Origamic Ltd to pay Mr Yaojie Liu the sum of £700. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

Dated this 18TH Day of December 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**