

O/713/19

REGISTERED DESIGNS ACT 1949

**IN THE MATTER OF:
REGISTERED DESIGN No. 4009288
IN THE NAME OF PETER S MAGEE**

AND

**AN APPLICATION FOR INVALIDATION (No 27/18)
BY BVG GROUP LIMITED**

1) On 25 October 2008 Mr Peter S Magee (“the proprietor”) applied for the following design for a “display unit for potted plants” (“the registration”). It was appointed design number 4009288 and registered on the same date:



Display unit folded flat
No claim is made for the colour or colours shown



Display unit folding flat
No claim is made for the colour or colours shown



Front view of display unit
No claim is made for the colour or colours shown



Side view of display unit (Wall mounted)
No claim is made for the colour or colours shown



Side view of display unit
No claim is made for the colour or colours shown



2) On 2 November 2018, BVG Group Limited (“the applicant”) filed a Form DF19A (Request to invalidate a design registration) together with its statement of case. The applicant’s case is pleaded under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the contested design did not fulfil the requirements of sections 1B and 1(C)(1) of the Act. I summarise the applicant’s claims as follows:

- Section 1(B) – new and individual – the design “does not have individual character compared to other designs that have been made available to the public before the filing date”. I shall show the prior art relied upon later in this decision.
- Section 1C(1) – technical function – the applicant argues that the shape of the design is necessary for carrying out its function as a display unit and that the design has no ornamental features. The applicant argues that the design is dictated by technical function.

3) The proprietor filed a counterstatement. It claims that the design is validly registered. The proprietor admits that the design “is a display unit for potted plants”. The proprietor makes various submissions as to why it believes the application for invalidation to be

unfounded, which I shall not summarise here but will refer to where necessary in my decision.

4) The applicant is represented by Richard R Halstead & Co Ltd and the proprietor by McDaniel & Co. Only the applicant filed evidence. Both parties filed written submissions which I shall not summarise but confirm that I have read and shall refer to them where necessary in this decision. Neither party requested to be heard.

5) The relevant date for the assessment is the date of application of the contested design, namely 25 October 2008.

PRELIMINARY ISSUE

6) The proprietor claims that the applicant's claim, insofar that it relies upon section 1(B) (new and individual), should not be considered since it was not correctly pleaded in the applicant's original statement of case. Part of the basis for this is that it had not ticked the relevant box. However, in the proprietor's counterstatement it states that "The Applicant has also argued that the Registered Design should be declared invalid to the extent that the design does not individual character", which is reference to section 1(B).

7) I do agree that the section 1(B) claim was not well particularised, and the relevant box should have been ticked. However, it seems to me that the proprietor knew the claim being made against him, otherwise he would not have been able to respond in the manner he did. I therefore reject this argument.

EVIDENCE

Applicant's evidence

8) The applicant's evidence consists of a witness statement in the name of Mr Daniel Price and annexes 1 – 3.

9) Mr Price has been employed by the applicant since 1996, firstly as a sales manager. He subsequently gained promotion to sales director and then, in March 2014, he became managing director.

10) Mr Price states that the applicant is the parent company of Esher Mail Order Limited (“Esher”) who have been involved in separate legal proceedings with the proprietor. This presumably explains why the invalidation action has been filed.

11) Mr Price refers to the certificate for the registration which includes the description being a ““display unit for potted plants”, which I consider to be an accurate and complete description of the design, including its stated function for displaying potted plants”¹.

12) In the witness statement he describes the “informed user” for the registered design: “purchasers or users of display units for potted plants will include amateur or professional gardeners and manufacturers and vendors of gardening equipment and apparatus, including plant pot holders, planters and plant stands.” I shall address this later in my decision.

13) Paragraph 5 of the witness statement states that: “The Registered Design has no ornamentals features and neither is the overall impression itself ornamental. All of the features, whether taken singly or in combination, are purely functional and commonplace, the Registered Design comprising simply a foldable or collapsible shelf unit in the nature of an etagere or plant display of the type commonly used in Victorian times and still in use to this day. Although by no means definitive, a typical example of such a foldable display unit is shown below:

¹ Para. 2 of the witness statement

United States Patent [19]

Valero

[11] Patent Number: **4,582,003**

[45] Date of Patent: **Apr. 15, 1986**

[34] **FOLDING CORRUGATED BOARD DISPLAY SHELVING**

Attorney, Agent, or Firm—Stoll, Wilkie, Previto & Hoffman

[75] Inventor: **Kenneth W. Valero, Poquannock, N.J.**

[57] **ABSTRACT**

[73] Assignee: **Ultimate Display Corporation, Englewood, N.J.**

A unitary multiple-shelved folding display stand intended to be made principally from corrugated board comprising a pair of triple-layer board side wall members hingedly affixed to a double-board rear wall panel and able to fold backwardly flat against the back side of the rear wall panel. The side wall members are joined by a plurality of elastic bands removably affixed near the forward edges of the side wall members by means of formed shelf support members removably secured to the side wall members. A plurality of triple-layer board shelves are hingedly secured to the front of the rear wall panel so that they may fold flush against the rear wall panel for storage or transportation and be unfolded down against the formed shelf support members for horizontal location and load-bearing support. When the side wall members are folded rearwardly against back of the rear wall panel the shelves are held in folded position against the front of the rear wall panel by means of the stretched elastic bands extended against them.

[21] Appl. No.: **658,486**

[22] Filed: **Oct. 9, 1984**

[51] Int. Cl.⁴ **A47B 3/00**

[52] U.S. Cl. **108/111; 108/3; 211/132; 211/195**

[58] Field of Search **211/195, 149, 132; 108/111, 112, 3, 2; 312/262, 259**

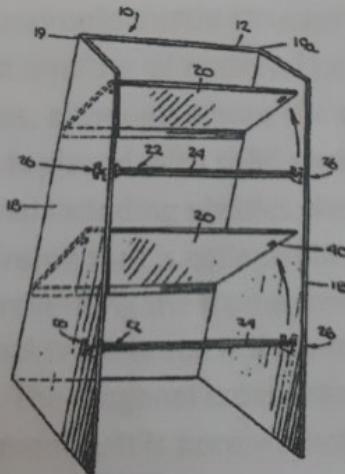
[56] **References Cited**

U.S. PATENT DOCUMENTS

1,559,878	11/1925	Humphreys	312/262
4,271,766	6/1981	Schmiedler	108/111
4,415,090	11/1983	Bustos	211/195
4,493,424	1/1985	Smith	211/132

Primary Examiner—James T. McCall

3 Claims, 9 Drawing Figures



14) Mr Price also annexes three further registered designs which he relies upon as prior art. These are duplicated at annex 1 and in the comparison of designs.

DECISION – SECTION 1B

15) Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a)...

(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:

“1B Requirement of novelty and individual character.

(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 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) [...]

The case-law

17) The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*². The most relevant parts are reproduced below:

“The informed user

² [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, 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).
- ii) 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 the 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 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.”

What remaining prior art can be relied upon?

18) The applicant relies on various prior art, as shown in annex 1 of this decision. Prior art 1 is a US patent publication and 2 is a US design. Both have been published prior to the relevant date.

19) Section 1B(6)(a) of the Act states that disclosure of a design falls within the scope of section 1B(5)(a) unless, inter alia, “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.” No evidence has been filed as to whether the design has been used in the marketplace. However, In *Senz Technologies BV v OHIM*, joined cases T-22/13 and T-23/13, the General Court of the European Union (“GC”) upheld the EUIPO’s decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry. The onus is on the registered proprietor to explain why this could not reasonably have become known in the EEA in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned. Therefore, despite being US patent and design publications, the applicant may rely upon prior art 1 and 2.

20) I now turn to prior art 3 and 4, the former being UK design number 2104312³. The design was applied for on 23 August 2001 and would have been published around this time. It is therefore before the relevant date. The design qualifies, and may be relied upon, as prior art. The latter (prior art 4) is European Union design number 665005 which was applied for on 17 January 2007, which is prior to the relevant date.

³ The design has since expired but this does not affect the applicant’s right to rely upon it as prior art.

21) To summarise, the proprietor may rely upon all of the earlier prior art.

The informed user

22) The registration is of a display unit for potted plants. In Mr Price's witness statement he describes the informed user as being amateur or professional gardeners plus manufacturers and vendors of gardening equipment and apparatus, including plant pot holders, planters and plant stands. I agree and would add that the informed user is a knowledgeable and observant user who possess the various characteristics set out in the preceding case law.

Design freedom

23) There is limited design freedom in terms of the construction of a display unit for potted plants. The unit will need to have shelves or something similar in order for the pots to be safely balanced. Further, it would need to be relatively robust in order to hold the weight. There are elements which do carry a reasonable degree of design freedom such as the size and position of the shelves, plus the surface decoration.

Design corpus

24) The evidence filed by the applicant claims that that there were different plant pot display units were available at the relevant date. However, it appears to me that only prior art 1 and potentially 2 can operate in this manner. Both of these are prior to the relevant date. Accordingly, I am unable to determine the design corpus based on one or possibly two examples.

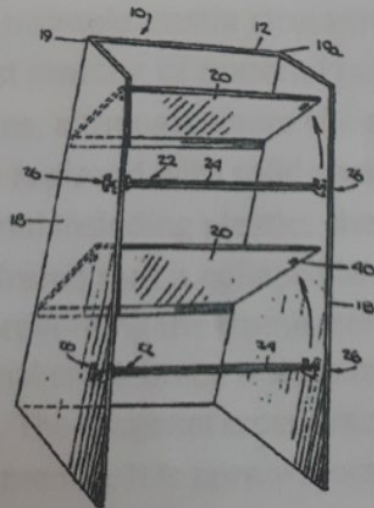


What does the Registered Design consist of?

25) It is not in dispute that the registration is best described as a display unit for potted plants. Further, the proprietor does not deny the applicant's claim that it is a "collapsible

shelf unit and a feature of the design is that the slats on the unit are arranged in an etagere manner.” The pictures provided with the application to register the registered design confirm that no claim is made to colour (as shown at paragraph 1 of this decision).

Comparison of designs

26) The designs to be compared are:

The prior art	Contested design
<p><i>Prior art 1</i></p> 	 <p>Display unit folded flat No claim is made for the colour or colours shown</p>
<p><i>Prior art 2</i></p>	 <p>Display unit folding flat No claim is made for the colour or colours shown</p>



Front view of display unit
No claim is made for the colour or colours shown

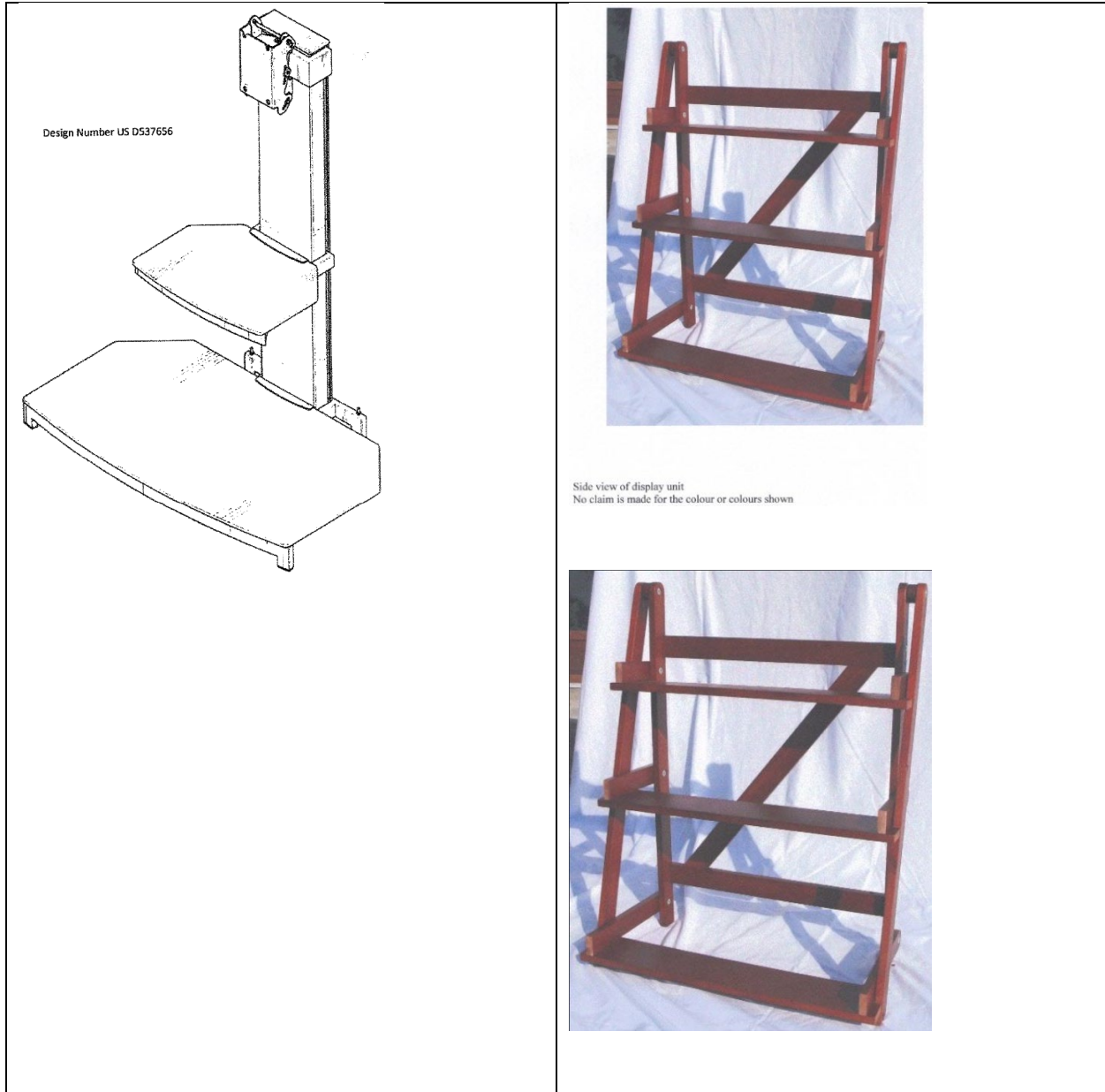
Prior art 3



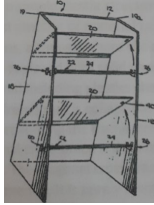
Prior art 4



Side view of display unit (Wall mounted)
No claim is made for the colour or colours shown



27) 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” and it 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.



Prior art 1

28) The applicant argues that the respective designs are similar since they comprise a set of shelves supported on either side by hinged side walls and at the back by rear walls, with each of the shelves hinged from the back in order to rest, in use, on shelf support rails. I agree that 1) the respective designs include shelves, 2) the shelves are supported on the either side by hinged side walls and, 3) further hinges are at the back to support the shelves when rested. However, they differ insofar:

- a) The prior art includes one shelf, whereas the registration has two.
- b) The prior art has side walls, unlike the registration.
- c) The registration includes an A-frame for support which is not present in the prior art.

29) Taking all of the differences listed above into account, I do not consider the later registration to be similar in its overall impression to prior art 1.



Prior art 2

30) The designs are similar insofar that they comprise of three shelves with the bottom shelf having the greatest depth to the two shelves above it, which have progressively less depth. Clearly, the shelves are designed in this manner to hold larger pots at the bottom with the smaller ones at the top.

31) There are a number of elements which are different. These are:

- 1) The shelves on the earlier design are slatted, whereas the shelves on the registration are solid.
- 2) The earlier design is on wheels whereas the registration is not.
- 3) The prior art's upright elements on either side are vertical with horizontal connecting pieces. These are not present in the registration.
- 4) The proportions of the prior art and registration are significantly different, i.e. the prior art is wider, comprising of, in essence, two separate shelves connected together.

32) The prior art and registration are more dissimilar than similar. Moreover, I do not consider the differences to be immaterial. They are sufficiently noticeable that they would be recognised by the informed user.



33) I now turn to prior art 3 and 4, which can be dealt with quickly. The differences are stark and apart from them being display units which are angular, I do not see any point of similarity. The differences are material. Accordingly, the contested design must be new in comparison to the prior art.

34) In view of the above, the applicant's section 1B claim is dismissed.

DECISION 1C – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

35) Section 1C of the Act, applicable in invalidation proceedings by virtue of, section reads:

“1C Designs dictated by their technical function

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

36) In the *Dyson Ltd v Vax Ltd [2010] F.S.R. 39 (“Dyson”)* case Mr Justice Arnold undertook a thorough review of the relevant case-law:

“23 Article 7(1) of the Designs Directive excludes from protection “features of appearance ... which are solely dictated by its technical function”. The parties were divided as to the correct interpretation of this provision.

24 Counsel for Dyson relied upon the decision of the Court of Appeal in *Landor & Hawa International Ltd v Azure Ltd [2007] F.S.R. 9, CA* . That case concerned a claim for infringement of unregistered Community design right under the Community Designs Regulation (and a parallel claim for infringement of domestic unregistered design right) in certain features of a design for a suitcase. The defendant contended, inter alia, that those features were excluded from protection by art. 8(1) of the Community Designs Regulation , which corresponds to art.7(1) of the Designs Directive.

25 At first instance H.H. Judge Fysh QC sitting in the Patents County Court rejected this contention for reasons he expressed as follows:

“The question is therefore: is the *appearance* of Landor’s design *solely dictated* (i.e. driven without option) by the technical function? In my view, the answer is ‘no’. I say this because of the spatial position of the constituent

elements (big piping/zip/normal piping/zip/big piping) and by the presence of the piping elements themselves which introduce an essentially non-functional and even capricious element to the final appearance of the ensemble.”

26 In the Court of Appeal the defendant attacked this conclusion on the grounds that (i) the judge had been wrong to construe art.8(1) so narrowly and (ii) the features in question were purely functional.

27 So far as the construction of art.8(1) was concerned, the defendant argued that the judge ought to have held that “dictated solely by function” meant “attributable to function”, so that if more than one shape could perform the same function then all such shapes were excluded from protection. In support of this argument the defendant relied upon the decision of the Court of Justice of the European Communities (as it then was) in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99) [2002] E.C.R. 1-5475; [2003] R.P.C. 2 at [78]-[7S] interpreting art.3(1)(e) of Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks (“the Trade Marks Directive”) and on the decision of the House of Lords in *Amp Inc v Utilux Pty Ltd* [1971] F.S.R. 572; [1972] R.P.C. 103 interpreting s.1(3) of the 1949 Act as it then stood.

28 Neuberger L.J. (as he then was), with whom May and Wilson L.JJ. agreed, held that neither of these decisions could safely be relied on in order to interpret art.8(1) and noted the comment of Advocate General Colomer in his opinion in the former case at [34] that the wording used in art.7(1) of the Designs Directive was narrower than that in art.3(1)(e) of the Trade Marks Directive. Neuberger L.J. also said at [38]:

“The judge’s conclusion as to the ambit of art.8.1 is consistent with the views expressed by the editors of Copinger and Skone James at para. 13-208. It

is true that it is there said that it is not clear whether the exclusion in Art.8.1 'will only apply to a design that is the only design by which the product in question could perform its function or whether it operates whenever a design was as a matter of fact dictated solely by the function of the product even though it was not the only design that was capable of allowing that function to be performed'. However, the editors go on to 'submit... that the former (narrower) construction of Article 8.1 is the correct one:. They draw support, rightly in my view, from recital (10) of the Designs Directive, which, they suggest, show that 'the technical function exclusion was intended to be construed narrowly and that it should be construed in a way that does not unduly restrict the availability of protection for non-aesthetic (i.e. functional) designs'."

29 Counsel for Dyson submitted, and I accept, that it is clear that the Court of Appeal endorsed the judge's construction of art.8(1). Counsel for Vax, however, drew attention to what Neuberger L.J. went on to say (emphasis added):

- "40 Azure nonetheless contends that the judge should have rejected *Landor's* case for EUUDR on the facts, namely on the basis that the Expander Design was purely functional. Apart from the fact that this is (either precisely or nearly) same argument on the facts as failed in relation to Landor's UKUDR claim, it is inconsistent with what the judge's findings in [42], quoted above. In that paragraph, which was directed to the EUUDR claim, the judge found that it was design with non-functional (and as the judge put it 'capricious') aspects.

- 41 It seems to me that this clearly disposes of the argument that the 'features of appearance' of the Expander Design in this case were 'dictated solely by its technical function'. Even if '*solely*' is not given the *limiting meaning which the judge held*, then, as I see it, the inclusion of the word in Art.8.1 nonetheless would render it difficult for Azure to contend that the

design in the present case is caught by the Article, because the design has been found by the judge, in circumstances where this was open to him, to be in part 'capricious'."

Counsel for Vax submitted, and I agree, that it followed that the Court of Appeal's decision as to the interpretation of art.8(1) was strictly obiter.

30 For his part, counsel for Vax relied on the decision of the Third Board of Appeal of OHIM in Case R 690/2007-3 *Lindner Recyclingtech GmbH v Franssons Verkstader AB* (R 690/2007-3) [2010] E.C.D.R. 1, Third Board of Appeal, OHIM. In that case the Board, whose rapporteur was David Keeling, considered the interpretation of art.8(1) of the Community Designs Regulation in a passage which merits quotation in full despite its length:

"28. The interpretation of art.8(1) CDR (and of the corresponding provision in art.7(1) of Council Directive 98/71 on the legal protection of designs [1998] OJ L289/28) is highly controversial. Similar provisions existed in the designs legislation of several Member States prior to harmonisation of the law by Directive 98/71. The assumption has generally been made that the purpose of such provisions is to prevent design rights from being used to obtain monopolies over technical solutions without meeting the relatively stringent conditions laid down in patent law. Two contrasting views have been canvassed in the legal literature. One view holds that a technical necessity exception, such as that contained in art.8(1) CDR applies only if the technical function cannot be achieved by any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That Theory - known as the multiplicity-of-forms theory - is defended by some German authors (see, for example, P. Schramm, *Der europaweite Schutz des Produktdesigns* (Baden-Baden: Nomos Verlagsgesellschaft, 2005), pp.242 et seq., and U. Ruhl, *Gemeinschaftsgeschmacksmuster: Kommentar* (Koln-

Berlin-Munich: Carl Heymanns Verlag, 2007), pp.169 et seq.) and was formerly followed by the French courts (see, D. Cohen, *Le droit des dessins et modes*, 2nd edn, (Paris: Economica, 2004), p.22). Advocate General Ruiz-Jarabo suggested in *Koninklijke Philips Electronics* [2003] R.P.C. 2 at [34] of the Opinion) that art.7(1) of the Designs Directive (and therefore obviously art.8(1) CDR) should be interpreted in that manner. He stated:

‘...a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.’

The Advocate General’s comment is clearly an obiter dictum since *Koninklijke Philips Electronics* was a case on the interpretation of art.3(1)(e) of Council Directive 89/104 to approximate the laws of the Member States relating to trade marks ([1989] OJ L40/1) (TMD). Article 3(1)(e) TMD excludes from trade mark protection, ‘signs which consist exclusively of the shape of goods which is necessary to obtain a technical result’.

29 The multiplicity-of-forms theory has been adopted by courts in the United Kingdom (see the judgment of July 28, 2006 of the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285; [2006] E.C.D.R. 31) and Spain (Juzgado de 10 Mercantil PTO Numero Uno de Alicante, Auto No.267/07 *Siiverlit Toys Manufactory Ltd v Ditro Ocio 2000 SL*, Unreported, November 20, 2007).

30 There is nonetheless a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product’s appearance is not ‘solely dictated by its function’ simply because an alternative product configuration could achieve the same function, art.8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated. That purpose, as was noted above, is to prevent design law from being used

to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with. If a technical solution can be achieved by two alternative methods, neither solution is, according to the multiplicity-of-forms theory, solely dictated by the function of the product in question. This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function (see W. Cornish and D. Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 5th edn, (London: Sweet & Maxwell, 2003), p.549). This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.

31 The principal alternative, discussed by academic authors, to the multiplicity-of-forms theory has its origin in English case law. The case of *Amp Inc v Utilux Pty Ltd* [1971] F.S.R. 572 concerned the interpretation of a provision of the Registered Designs Act 1949 which denied protection to the features of a design that were solely dictated by a product's technical function. The House of Lords held that a product's configuration was solely dictated by its technical function if every feature of the design was determined by technical considerations. The striking similarity between s.1 (3) of the 1949 Act and art.8(1) CDR does not of course mean that the approach of the House of Lords in *Amp* [1971] F.S.R. 572 must necessarily be adopted in relation to the Community provision. Indeed, as was noted above in [29], the multiplicity-of-forms theory has now been adopted by the English Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd*. Thus the Court of Appeal must have thought that the approach taken in *Amp* [1971] F.S.R.572 was no longer valid, following harmonisation, in spite of the similar wording of the Community provisions and the 1949 Act. The approach taken in *Amp* would, however, have the advantage of

allowing the purpose of art.8(1) CDR to be achieved. No-one would be able to shut out competitors by registering as Community designs the handful of possible configurations that would allow the technical function to be realised. This may explain why the French courts, which formerly espoused the multiplicity-of-forms theory, began to abandon that theory at the beginning of the 21st century in favour of an interpretation which closely resembles the *Amp* approach (see the judgments cited by D. Cohen, *Le droit des dessins et modeles*, 2nd edn, (Paris: Economica, 2004), pp.23-24).

32 In addition to being supported by a teleological interpretation, the approach discussed in the previous paragraph is also supported by the wording of art,8(1) CDR. That provision denies protection to features of a product's appearance that are, 'solely dictated by its technical function'. Those words do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected.

33 Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at. In the case of some products, such as pictures and ornaments, their very function is to please the eye. In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant. That is why the Community design legislation denies protection to component parts that are not visible in normal use. In the case of most products the designer will be concerned with both the functional and the aesthetic elements. That applies also to large items of industrial equipment, such as shredders for use in recycling plants. The shredder must, in the first place, perform its function effectively and safely and without creating excessive noise, but it is also desirable that

the shredder should be pleasing to the eye and thus enhance the working environment of the people who operate it and see it in use. For that reason there is no objection in principle to granting design protection to industrial products whose overall appearance is determined largely, but not exclusively, by functional considerations.

34 It is often pointed out that the Community design legislation, unlike the old laws of some Member States, does not lay down any requirement of aesthetic merit, artistic creativity or eye appeal. The absence of such a requirement is expressly mentioned in the 10th recital in the preamble of Regulation 6/2002 and in the 14th recital in the preamble to Directive 98/71. Some authors infer from this that purely functional designs are protectable. That is a false analysis. Community design law is concerned with the visual appearance of products. That is clear from the definition of 'design' in art.3(a) CDR and from the requirement of visibility in normal use for component parts in art.4(2)(b) CDR. Those parts of a product that cannot be seen are of no concern to the Community law of design because no one cares what they look like. All that matters is that such parts perform their function. If the law were intended to protect purely functional designs it would not be logical to exclude the non-visible aspects of design from protection.

35 The significance of limiting protection to the visual appearance of products is that aesthetic considerations are in principle capable of being relevant only when the designer is developing a product's visual appearance. Most of the time the designer will be concerned with both elements of good design: functionality and eye appeal. In some cases functionality will be the dominant preoccupation of the designer. The need to make a product that works will be uppermost in the designer's mind and will largely determine the appearance of the product. As long as functionality is not the only relevant factor, the design is in principle eligible for protection.

It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. This is not, it must be stressed, tantamount to introducing a requirement of aesthetic merit into the legislation. It is simply recognition of the obvious fact that when aesthetics are totally irrelevant, in the sense that no one cares whether the product looks good, bad, ugly or pretty, and all that matters is that the product functions well, there is nothing to protect under the law of designs.

36 It follows from the above that art.8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen."

31 Counsel for Vax submitted that this was a compelling analysis, and in particular the point made by the Board at [30], Counsel for Dyson had no convincing answer to that point. It does not appear to be a point which was made to the Court of Appeal in *Landor & Hawa* [2006] E.C.D.R. 31. In my view the Board of Appeal's analysis is persuasive. I therefore conclude that the interpretation placed on art.8(1) of the Community Designs Regulation, and hence art.7(1) of the Designs Directive, by the Board of Appeal is to be preferred to that adopted by the Court of Appeal in *Landor & Hawa* [2006] E.C.D.R. 31 ."

37) I should also take into account the judgment in *Doceram GmbH v CeramTec GmbH*⁴, in which 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’”.

38) The applicant states that “the Registered Design is purely functional, since no part of it can be removed without affecting the function of the display unit and all parts represent the minimum requirement for a folding display unit (or even a freestanding display unit) in which a set of shelves, such as three shelves, are arranged one above the other in the typical etagere manner where the lowest shelf projects outwardly more than the or each remaining shelves, such that in the case of display units of this type used for displaying potted plants, the plants being displayed on each shelf do not interfere with each other, meaning that they can all be easily viewed or displayed.”

39) The proprietor does not deny “that the Registered Design has no ornamental features”⁵. It also argues that “For a design to be excluded from protection on the grounds

⁴ Case C-395/16

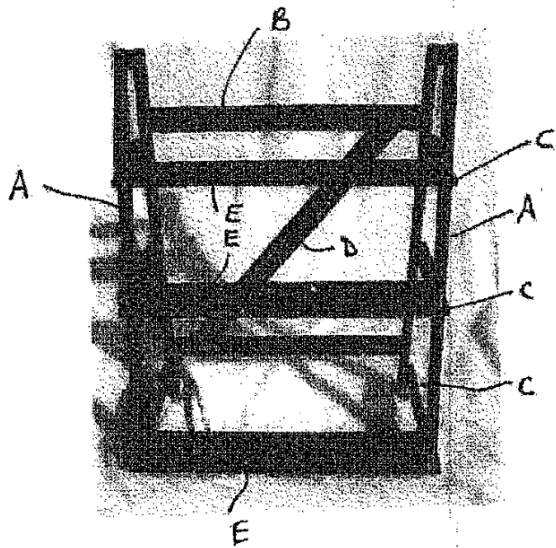
⁵ Proprietor’s counterstatement

that the design is solely dictated by function, the features of the appearance of the product must be reproduced in their exact form in order to permit the product to perform its function.”⁶ It goes on to state that “the unit covered by the Registered Design serves a specific function of displaying plants. However, the unit could be designed in a variety of ways without hampering the functionality of the design. The design is a foldable display unit, but it does not need to be designed in a certain way to carry out the function of a display unit. The features of the Registered Design are not solely dictated by its technical function because it is not necessary to adopt the same shape of the Registered Design to achieve the technical function of providing a display stand. Any other shape could have been adopted to accomplish the same function. The display unit in question will be targeted towards the public and retail outlets. The units are used to display plants and the user of the goods will be less concerned about the function of the design and more concerned that it can present plants in an attractive way.”

40) The proprietor seems to be relying upon the fact that the display unit could be made in a variety of ways without hampering the functionality of the design. The proprietor has not filed any evidence to support this argument. Further, it argues that any other shape could have been adopted to accomplish the same function as the design, the subject of the invalidation claim.

41) In my view the display unit is made up of numerous individual elements which all serve a technical purpose. In the applicant’s evidence it reproduces the following image of the design and then goes on to state that:

⁶ Ditto



“The display unit above has two side walls (A) and a rear wall (B) in the form of frames, the sidewalls (A) being of inverted “V” shape supported by three cross braces (C) and the rear wall (B) being in the form of a square frame in which trapezoidal movement is prevented by the use of a diagonal brace (D), the sidewalls and the rear wall collectively supporting three shelves (E), which appear to be planar and solid. None of these components include ornamental features, such as edge mouldings, ornate piercing or surface decoration, each element being rectilinear in section and elongate. The sidewalls (A) are intended to be foldable or collapsible as shown in the images showing the “display unit folded flat” in the Registered Design and it can be inferred that hinges are present at various points, such as at the apex of each sidewall (A), although the number and presence of such hinges are irrelevant for present purposes.”

42) 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.

⁷ Below the image is the text: front view of display all. No claim is made for the colour or colours shown.

43) In determining whether technical function is the only factor which determined the features of a particular design, national courts and tribunals must take account of “all the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence”.⁸ 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.

44) Taking all of the above into account, all of the individual elements, as described by the applicant, serve a technical function. However, the question is the overall impression created by the design on an informed user of the products at issue. In my view, the design subsists in features of appearance of a product which are solely dictated by the product’s technical function. The proprietor has not provided any plausible argument against this. The design consists of three shelves, all above one another, with the lowest shelf protruding further out from the second highest shelf which also protrudes further to the top shelf. Overall the three shelves are angular which, to my mind, are used since either the top of the pot, or the plant, would be higher than the shelf above it. In other words, if the shelves were placed one above the other then this would significantly alter the height of the pots being placed upon them.

45) In view of the above, I find that the design is purely functional and the section 1(C)(1) claim succeeds. The consequence of this is that design registration no. 4009288 is invalid.

⁸ *Doceram*, paragraph 37.

OVERALL OUTCOME

46) The application for invalidation is successful and design registration number 4009288 is invalid.

COSTS

47) The applicant has been successful and is entitled to a contribution towards its costs. The award is a contribution towards costs rather than the actual costs incurred. The award also reflects that the evidence filed by the applicant was light and was of little relevance.

Official fee	£48
Preparing a statement and considering the other side's statement	£300
Filing evidence and written submissions	£200
Total	£548

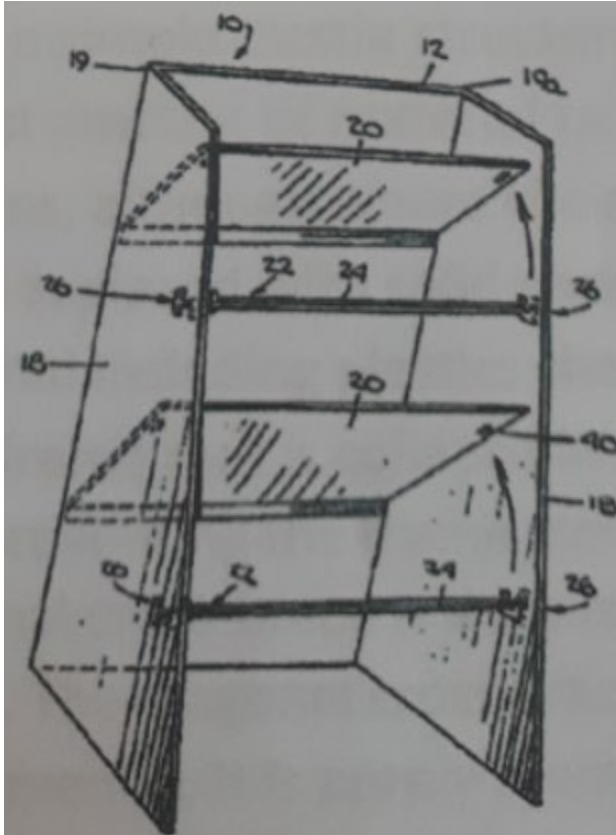
48) I therefore order Mr Peter S Magee to pay BVG Group, Limited the sum of £548. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of November 2019

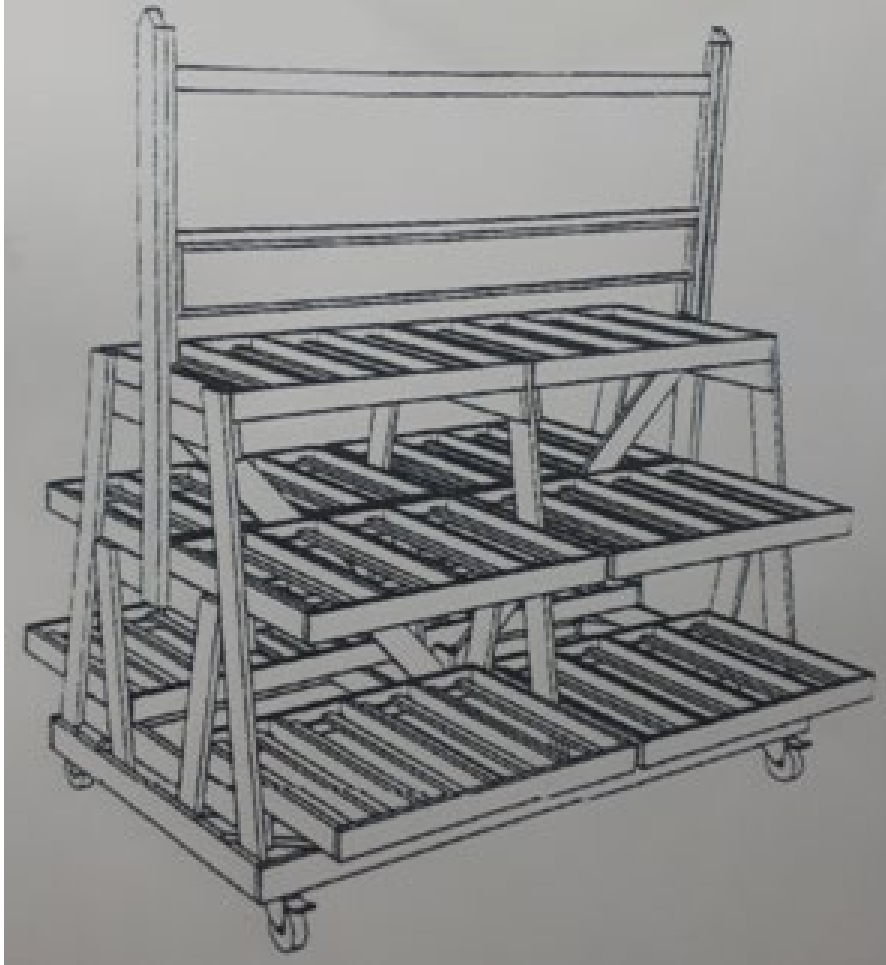
Mark King
For the Registrar,
The Comptroller-General

ANNEX 1

Prior art 1



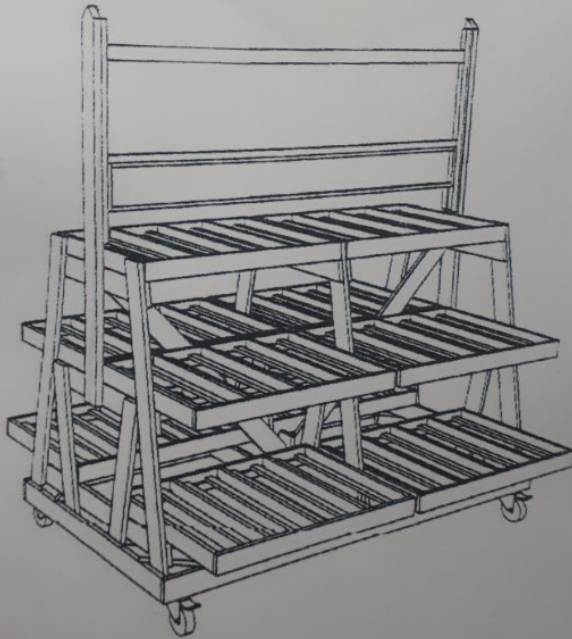
Prior art 2



2104312

CHARLES B. SHARPOON, III

SHEET 1 OF 2



PERSPECTIVE VIEW FROM THE FRONT AND TO ONE SIDE

The novelty claimed resides in the shape or configuration of the article as shown in the representations.

The wording beneath the drawing states “PERSPECTIVE VIEW FROM THE FRONT AND TO ONE SIDE” and below this it states “The novelty claimed resides in the shape or configuration of the article as shown in the representations”.

Prior art 3



Prior art 4

Design Number US D537656

