

O/372/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF:

REGISTERED DESIGN No. 6017464

IN THE NAME OF R&K WORLDWIDE LIMITED

AND

AN APPLICATION FOR INVALIDATION (No 21/18)

BY MR J PARKER-BISHOP

Background and pleadings

1) On 25 August 2017 R&K Worldwide Limited (“the proprietor”) applied for the following design for a “twin action stove fan” (“the registration”). It was appointed design number 6017464 and registered on the same date. The registration includes the following disclaimer: “No claim is made for the colour shown, the motor, the fan blades or the thermal plate”:



2) On 17 September 2018, Mr J Parker-Bishop (“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 (as amended) (“the Act”), on the grounds that the contested design did not fulfil the requirements of sections 1B of the Act. The applicant claims that:

“The design 6017464, proposed for cancellation, strongly resembles and duplicates key design features of our earlier registered design as below:

Design Number: 5003364

Product Name: Multi Blade Heat Powered Stove Fan

Owner: RGS Technical & Engineering Services Limited

Date of Registration: 14th June 2016

This design was made available to the public in 2016 through online sales channels including eBay, Amazon and partner websites. A total of 1,440pcs were sold between 22/08/2016 and 13/12/2016”.

3) The proprietor filed a counterstatement. It claims that the design is validly registered. 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) Neither party is professionally represented, nor did they file 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 August 2017.

The law

6) 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...”

7) 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

8) The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*¹. The most relevant parts are reproduced 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; Shenzhen paragraph 46).

¹ [2012] EWHC 1882 (Pat)

- 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 does the contested design consist of?

9) The respective designs consist of twin fans. The prior art consists of three individual blades per fan and the contested design has four blades per fan. Each fan in the respective designs are within circular casing. The blades for each of the fans protrude outside of the circular casing. Both designs also have a handle at the top and between each fan and they are placed on a base which appears to have the same depth as the fans but not as wide. This is the same for both designs.

10) The contested design also includes the following disclaimer: "No claim is made for the colour shown, the motor, the fan blades or the thermal plate". The effect of the

disclaimer is that it identifies which aspect of the representations shown are not covered by the protection of the registered design. That means, for these purposes, that any differences or similarities created by the colour, motor, fan blades and thermal plate used in the contested design and the prior art are not relevant to my assessment.

The informed user

11) The design is of a stove fan which is likely to be placed on a wood burner to evenly distribute the heat generated by the wood burner. The informed user is, therefore, an owner of a wood burner. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design freedom

12) 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)."

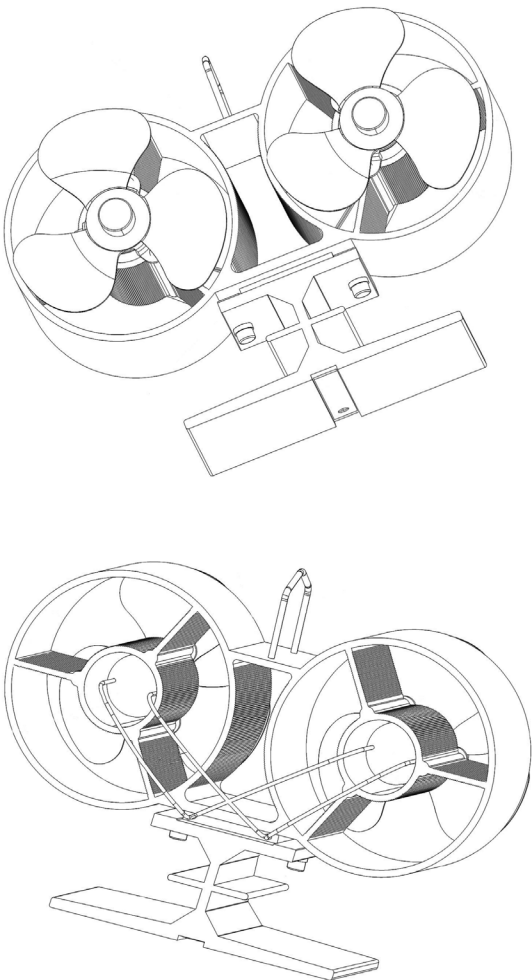

13) Neither party made specific submissions relating to the design freedom. Due to the disclaimer placed on the contested design, the design freedom does not include the colour, motor, fan blades or the thermal plate. However, there is design freedom in the base size and shape, also the housing of the fans may differ and the fans themselves may be in different shapes, i.e. they do not need to be circular to fulfil the technical function. Therefore, there is a fair degree of design freedom.

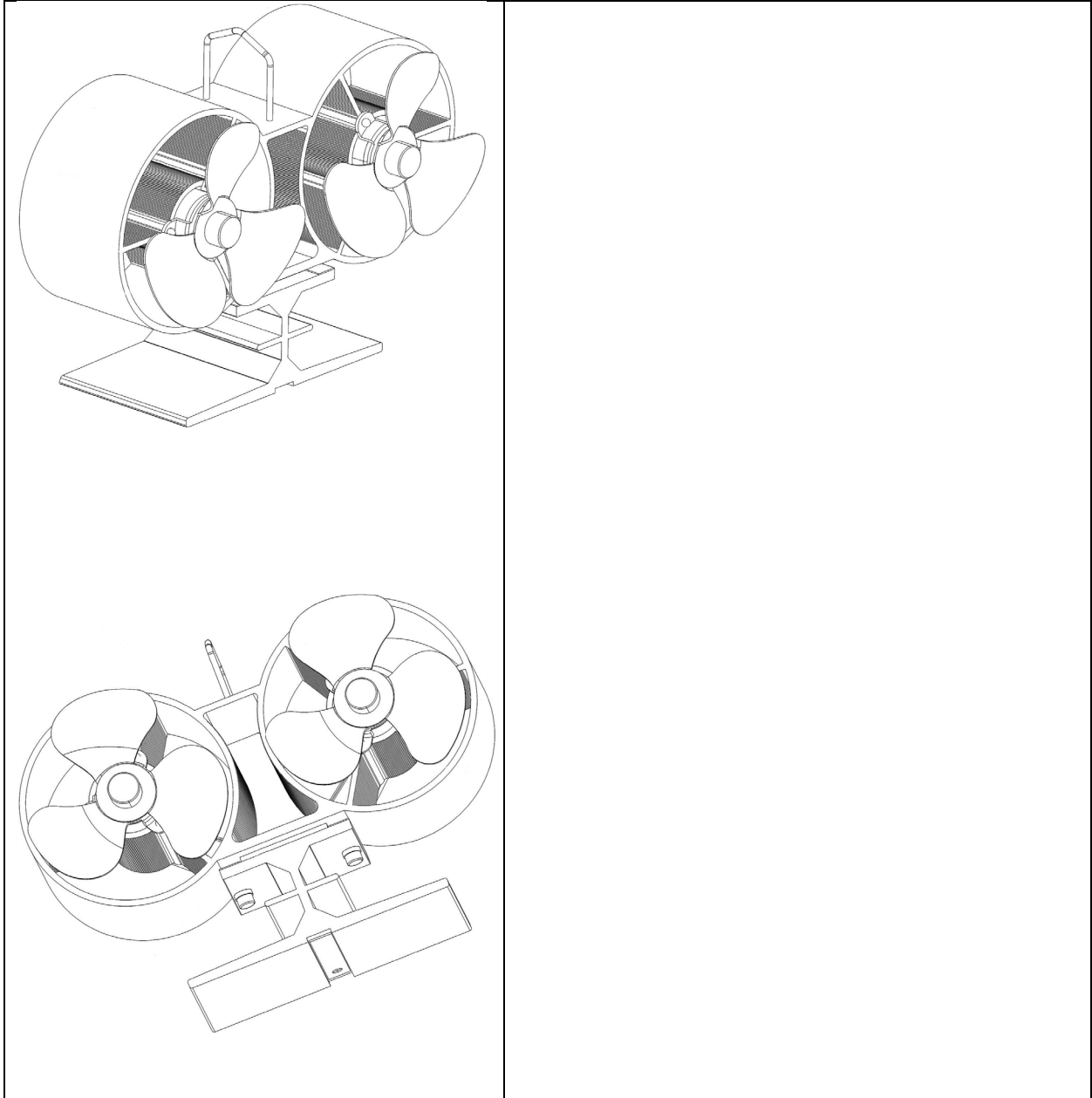
Design corpus

14) Beyond the design that the applicant has sought to rely upon, no other evidence of the design corpus has been provided. Therefore, it is difficult to make an assessment of how far these things stand out from other stove fans in the public domain at the relevant date. This factor is, therefore, neutral.

Comparison of designs

15) The designs to be compared are:

The prior art	Contested design
	



16) In Mr Parker-Bishop's statement of case he argues that the contested design "duplicates key design features of the earlier design by RGS in the following ways.

- The design duplicates the unique round shape of the motor housings and overall construction.
- The design duplicates the use of two horizontally aligned motors on a stove fan.
- The design resembles the unique overall appearance of the RGS design."

17) In reply, the proprietor argues that:

“There are some significant design differences between the design registered by Mr J Parker-Bishop and the design registered by R&K Worldwide, the base itself is of a very different design to the image submitted by Mr Parker-Bishop, the handle is differently positioned with a differently designed top to secure the handle, and the rear view of the design is different to that of R&K Worldwide as positioning of the secure pins holding the two sections together are of different designs.”

18) The designs differ insofar that:

- Whilst both the prior art and contested design include handles in between the twin fans, they differ slightly in design. The handle on the prior art is placed horizontally

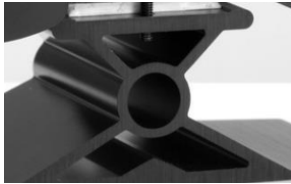


on the connecting part as follows

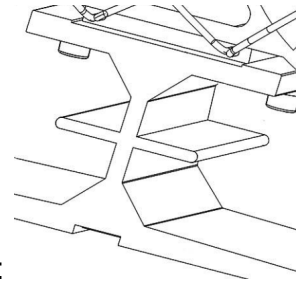


bridges across the two circular casings as follows. Further, there are two supports on which the handle sits on the contested design and only one in the prior art.

- The twin fans are connected to the base on the prior art by an axis with a circular



element in the middle, as follows: , whereas the contested



design is more vertical with a cross-section, as follows:
circular element is relatively striking and eye-catching.

- Whilst a representation of the back of the contested design has not been provided, I can see that the prior has angular linking prongs which are not present, or are not similar to, the contested design.

19) In order to determine whether the contested design has individual character I must consider the overall impression of the respective designs from the perspective of the informed user, the degree of design freedom all in light of the design corpus. Having done so, the informed user would notice certain similarities as I have highlighted above. However, whilst the differences listed above are individually minor the cumulative effect is that the overall impression, to the informed user, would be noticeable. The respective bases, with one having the noticeable circular tube with the X like axis as opposed to the prior art base is most noticeable.

20) Taking all of these factors into account, I find that the overall impression created by the respective designs are different.

21) Consequently, I find that the proprietor's design did have individual character at the date on which it was applied for and the application for invalidation of this design under section 1B of the Act fails.

CONCLUSION

22) The invalidation against this design has failed under section 1(B) of the Act.

COSTS

23) The proprietor has been successful and is typically entitled to a contribution towards its costs. On 17 April 2019 the Registry wrote to the respective parties stating that if either party intends on making a request for costs then it should complete and return the relevant proforma. The letter goes on to state that if the proforma “is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded.” Accordingly, since the proforma was not completed and returned, a costs award will not be made.

Dated this 30th day of July 2020

Mark King

For the Registrar,

The Comptroller-General