

O/569/21

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6017585

IN THE NAME OF INTERVINO LTD

AND

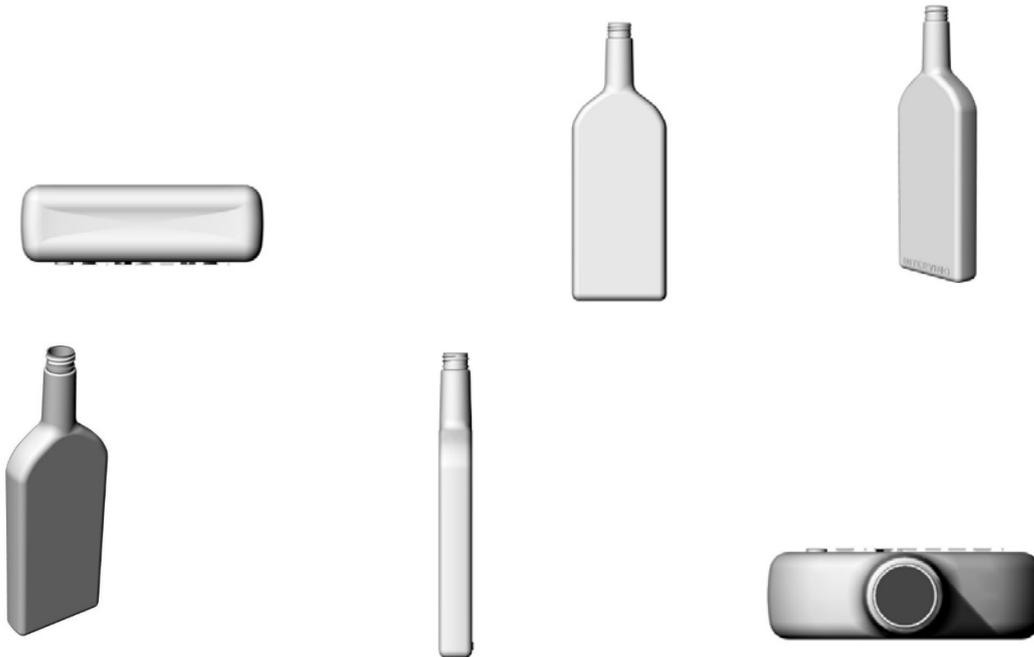
AN APPLICATION FOR THE INVALIDATION THEREOF

UNDER NO 29/20

BY DELIVERING HAPPINESS LIMITED

Background and pleadings

1. Intervino Ltd (“the registered proprietor”) filed application no. 6017585 for a registered design for a bottle in Class 9, Sub class 1 of the Locarno Classification (Bottles, flasks, pots, carboys, demijohns, and containers with dynamic dispensing means) on 29 August 2017. It was registered with effect from that date and is depicted in the following representations:



No claim was made for the closure, lettering or features on the bottom of the bottle. Larger images can be found in Annex A to this decision.

2. On 29 April 2020, Delivering Happiness Limited (“the applicant”) applied for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design was neither new nor did it have individual character and so did not fulfil the requirements of section 1B of the Act.

3. The applicant claims that it is the owner of prior registered designs that were made available to the public before the relevant date and which differ only in immaterial details from the contested design. It also claims that the contested design creates the same overall impression on the informed user as those of the prior designs. The

numbers of the registered designs are as follows: 6003564, 6003565, 6003568, 6003569, 6003572 and 6003573. They all have an application date of 27 November 2016 and are shown in Annex B to this decision.

4. The registered proprietor filed a counterstatement to the application for invalidation on 24 September 2020, denying the applicant's claims.

Evidence, Submissions and Legal Representation

5. The applicant's evidence in chief comes in the form of a witness statement from Olivier Santiago Navarro, Chief Executive Officer, co-founder and Director of Delivering Happiness Limited, trading as Garçon Wines. His witness statement is dated 24 November 2020.

6. The registered proprietor filed two witness statements. One is from Geoffrey Lennox, Chairman and Director of Intervino Ltd and is dated 6 January 2021. The second witness statement has the same date and is from Michael David Williams, Chief Executive Officer and Director of The British Honey Company Plc, a customer of Intervino.

7. The applicant's evidence in reply is a further witness statement from Mr Navarro dated 10 March 2021. There is also a witness statement with the same date from Aude Marie Françoise Grasset, a sustainability consultant and director of Uncle Limited.

8. Neither side requested a hearing, but both filed written submissions in lieu of a hearing on 12 May 2021. The applicant's submissions came from Mitchell Beebe of Counsel, instructed by Briffa Legal Limited, who have represented the applicant throughout these proceedings. The registered proprietor is represented by Tim Johnson/Law. I have taken this decision after a careful consideration of the papers before me.

9. I need to say a few words about the evidence before going any further. The applicant submits that the registered proprietor's evidence is inadmissible, or alternatively evidence on which I should place little weight. I agree that most of

Mr Lennox's witness statement consists of opinion, rather than matters of fact. Paragraphs 7-9 do give an account of the commissioning and development of the contested design. However, I recall the comments of Jacob LJ in *The Procter & Gamble Company v Reckitt Benckiser (UK) Limited*, [2007] EWCA Civ 936, the first part of which was quoted by the applicant in paragraph 21 of its written submissions in lieu of a hearing:

"3. The most important things in a case about registered designs are:

- (i) The registered design;
- (ii) The accused object;
- (iii) The prior art.

And the most important thing about each of these is what they look like. Of course parties and judges have to try to put into words why they say a design has 'individual character' or what the 'overall impression produced on an informed user' is. But 'it takes longer to say than to see' as I observed in *Philips v Remington* [1998] RPC 283 at 318. And words themselves are often insufficiently precise on their own.

4. It follows that a place for evidence is very limited indeed. By and large it should be possible to decide a registered design case in a few hours. The evidence of the designer, e.g. as to whether he/she was trying to make, or thought he/she had made, a breakthrough, is irrelevant. The evidence of experts, particularly about consumer products, is unlikely to be of much assistance: anyone can point out similarities and differences, though an educated eye can sometimes help a bit. Sometimes there may be a piece of technical evidence which is relevant – e.g. that design freedom is limited by certain constraints. But even so, that is usually more or less self-evident and certainly unlikely to be controversial to the point of a need for cross-examination still less substantial cross-examination."

10. Mr Williams's witness statement provides factual information on the British Honey Company Plc and how it came to be a customer of the registered proprietor. The

exhibits to his witness statement are photographs of one bottle each from the applicant and the registered proprietor (Exhibit MDW01) and an email from Ms Kirsty Holton, described by Mr Williams as “our Design Agency Manager”, dated 5 January 2021, in which she compares the two bottles. As I have already noted, Jacob LJ held that this type of evidence was unlikely to be of much assistance, and I shall make my own comparison of the designs at issue, using the representations placed on the register, which comprise the prior art relied upon by the applicant.

11. The applicant anticipated possible criticisms of part of its own evidence, namely the witness statement by Ms Grasset, by saying that this evidence is of secondary significance, in the sense described by Jacob LJ in paragraph 5 of his decision in *Procter & Gamble*, quoting his own judgment in *Thermos v Aladdin* [2000] FSR 402 at 404:

“One area of evidence which I think is admissible, and is of some secondary assistance, is the reaction of the public and trade (who expect to sell to the public) to the design.”

12. The registered proprietor submits that Ms Grasset’s evidence does not qualify as the evidence of an “informed user”: that, at best, she is an ordinary user who has, in the view of the registered proprietor, not identified a number of the differences between the designs. Both parties made submissions on the identity of the informed user and I shall consider these in more detail later in my decision. Returning to Ms Grasset’s witness statement, this is the impression of one individual and is an assessment that appears to me to have been produced for the purposes of these proceedings. For these reasons, I will give it a fairly low level of weight.

Decision

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Registered Designs Act relied on in these proceedings are derived from an EU

Directive. This is why this decision continues to make reference to the registered design case law of EU courts.

Legislation

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

“The registration of a design may be declared invalid –

...

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

15. Section 1B of the Act is as follows:

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

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

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

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

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

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

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if –

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

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

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

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

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

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

...”

Prior Art

16. The applicant relies on six earlier registered designs, the numbers of which are given in paragraph 3 above. The registered proprietor admits that these are not exempt disclosures under section 1B(6).

17. The registered proprietor submits that the applicant cannot rely on them all, and says that it is not clear which prior design the applicant relies on to prove its case. It claims that it has identified differences between all six prior designs and submits that these differences are material.¹ The fact that they are the subject of six separate registrations, the registered proprietor contends, suggests that this is the case. It notes that the applicant has not filed any evidence to show that the prior designs create the same, or almost the same, overall impression on the informed user. I have, however, already referred to the limited role for this type of evidence in proceedings such as these.

18. The applicant is entitled to rely on more than one prior design and does not have to narrow its claim down to what it perceives as its single best case. The approach I must take is to compare the contested design with – if necessary – each prior design. If any of the prior designs is identical to the contested design, or different only in immaterial details, or if those designs create the same overall impression on the informed user, I will find the contested design to be invalid.

19. The registered proprietor submits that the greyscale used in the representations and the word “INTERVINO” are material differences between the contested and the prior designs. However, I note that the lettering (along with the closure and the features on the bottom of the bottle) is disclaimed, and so will not be part of my comparison.

¹ See paragraphs 13.1-13.10 of the registered proprietor’s written submissions in lieu of a hearing.

The use of greyscale in the representations shows the contours of the bottle as well as the shape and so, it is my view, this is what the contested design covers. The line drawings used in the prior designs show the shape of the bottle. I shall therefore be comparing the shapes of the respective designs.

Novelty

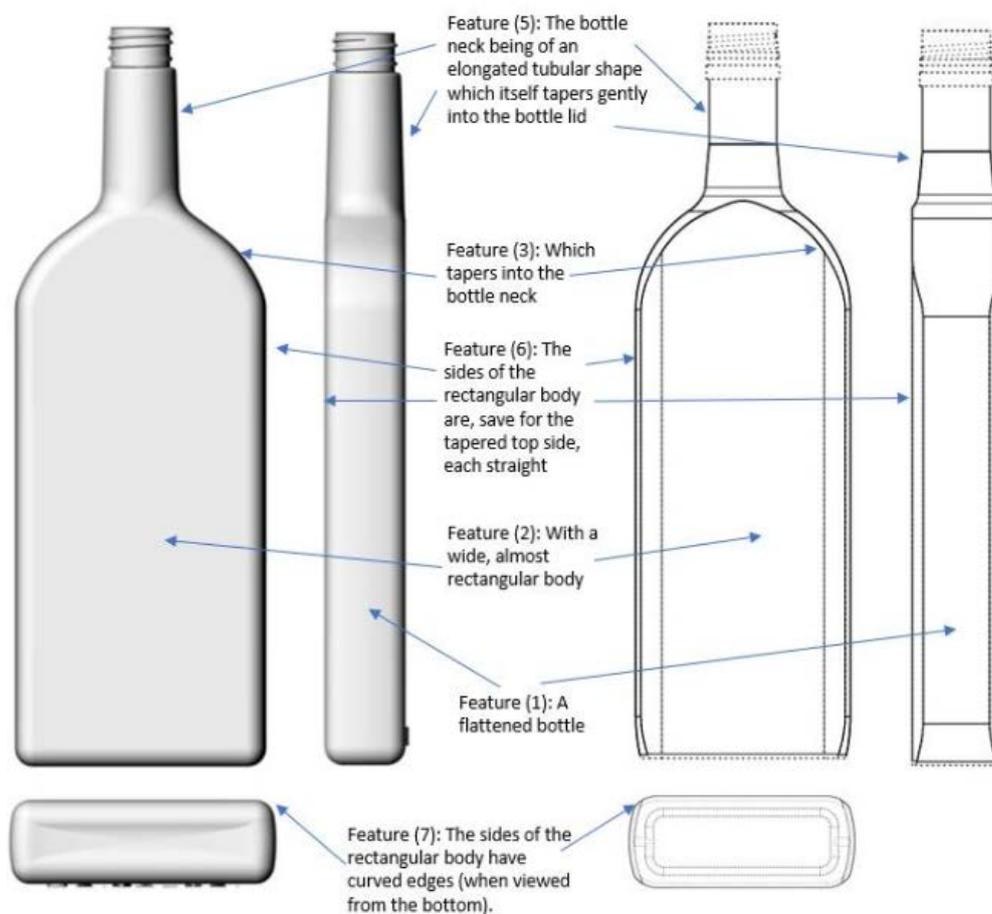
20. Section 1B(2) of the Act states that a design has novelty if no identical design or no design differing only in immaterial details has been made available to the public before the relevant date. In *Shnuggle Limited v Munchkin, Inc & Anor* [2019] EWHC 3149 (IPEC), HHJ Melissa Clarke, sitting as a Judge of the High Court, said:

“‘Immaterial details’ means ‘only minor and trivial in nature, not affecting overall appearance’. This is an objective test. The design must be considered as a whole. It will be new if some part of it differs from any earlier design in some material respect, even if some or all of the design features, if considered individually, would not be.”²

21. The applicant accepts that the designs are not identical but submits that the differences are immaterial. The registered proprietor, on the other hand, asserts that the differences are significant and that the only similarity between the prior and the contested designs is that they are flat bottles with straight sides.

22. Both parties have provided images to support their points. The applicant’s compares the contested design with (as an example) registered design no. 6003569 and highlights what, in its view, are the similarities between them:

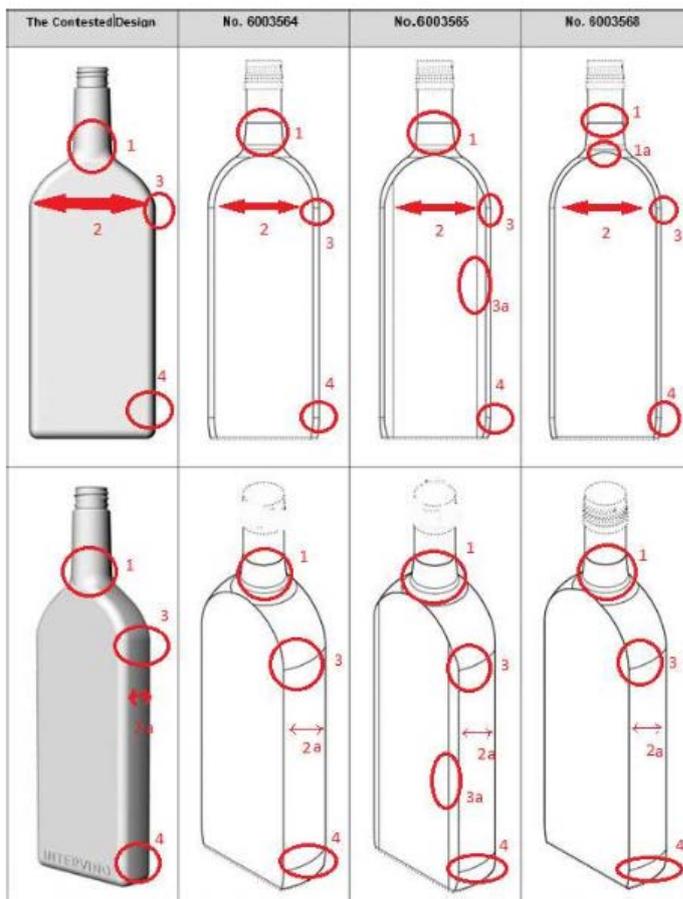
² Paragraph 26.

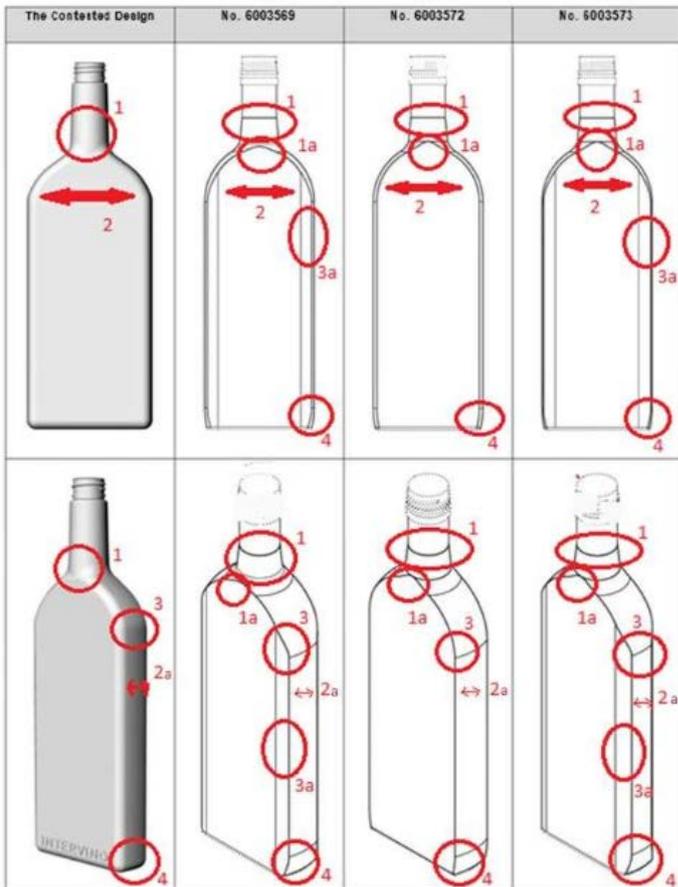
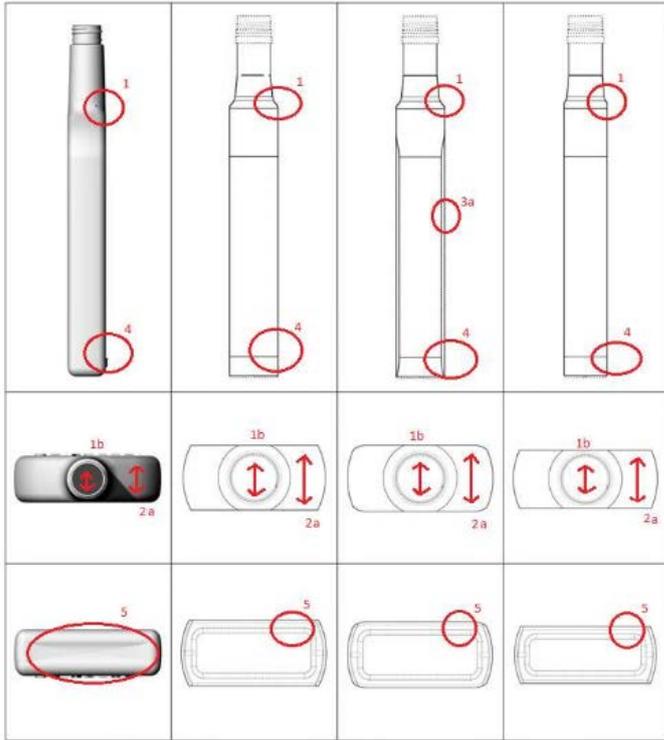


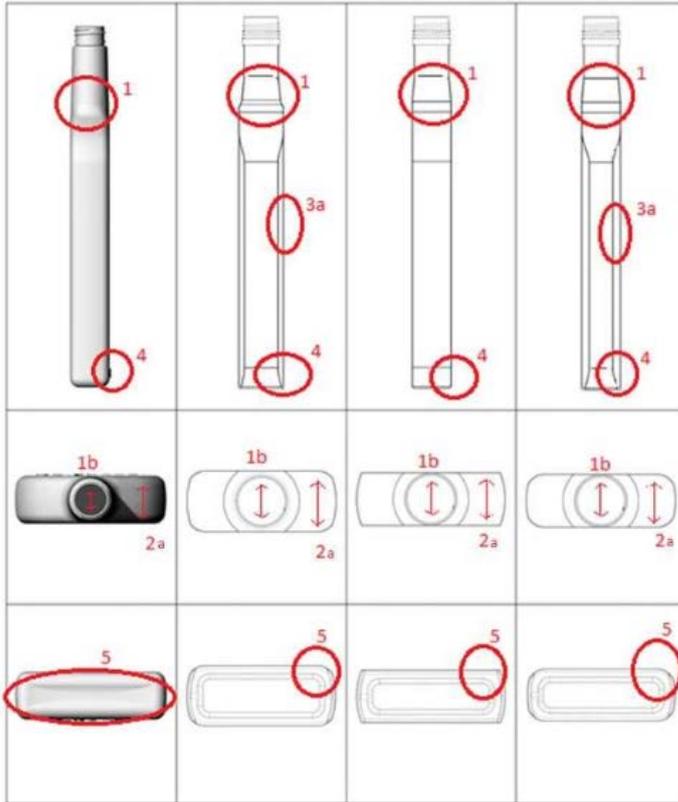
23. The registered proprietor sets out what it sees as the differences between the designs as follows:

- **Bottle neck (marked 1 in the images below):** The neck of the contested design continues down into the body of the bottle in a “V” shape, while the body of the prior designs continues up into the neck, resulting in an upside down “V” shape. The prior designs also have two or three lines at the base of the neck (“neck rings”). The contested design has no neck rings.
- **Bottle Neck’s Foundation (marked 1a):** Prior designs nos 6003568, 6003569, 6003572 and 6003573 have the top part of the shoulders protruding into the bottle neck and appearing sharper. The top of the shoulders of the contested design has a semicircular shape.
- **Bottle Neck’s Width (marked 1b):** The contested design has a narrower bottle neck than the prior designs.
- **Bottle Width (marked 2):** The contested design is considerably wider.

- **Bottle Thickness (marked 2a):** The contested design is slimmer when compared to the prior designs and viewed from above.
- **Shoulders (marked 3):** The prior designs' shoulders are more rounded and slope at a different angle from those of the contested design.
- **Body (marked 3a):** Some of the prior designs have protruding lines on their bodies, making the surface uneven, while the surface of the contested design is smooth.
- **Heel (marked 4):** The prior designs have a slightly tapered heel, which is absent in the contested design.
- **Base (marked 5):** The base of the contested design has a letter "X" on it, which is absent in the contested design. (I note, though, that the features on the bottom of the bottle are disclaimed.)
- **Closure:** The contested design has details of the closure, which are not claimed in the prior design.







24. Having considered both sets of submissions and the representations, I find that the contested design is a flattened bottle with the following features:

- A wide, almost rectangular body;
- Slight rounding and tapering at the bottom (what the registered proprietor refers to as “the heel”);³
- Straight sides;
- Rounded edges on each of the sides;⁴
- Slightly rounded shoulders;
- An elongated tubular neck with very slight tapering into the top;
- Neck joining the body of the bottle in a contoured “V” shape;⁵
- The depth of the bottle is no greater than the outer diameter of the base of the neck; and
- A smooth surface.

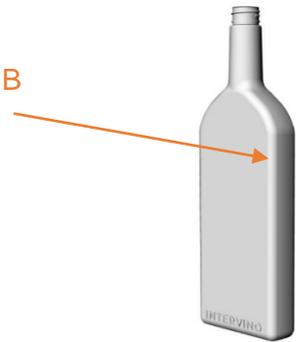
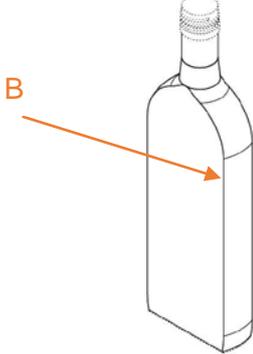
³ This is seen most clearly on the third representation in Annex A.

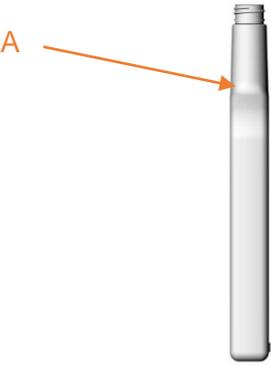
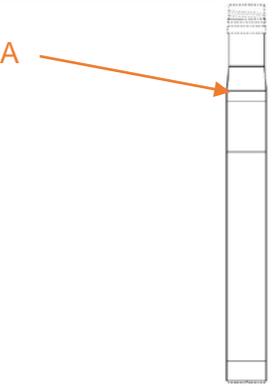
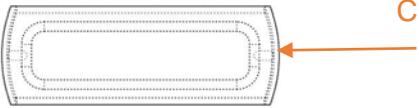
⁴ These are seen most clearly on the fourth representation in Annex A.

⁵ This is seen most clearly on the first representation in Annex A.

25. I have not listed the features disclaimed on the register: the closure, lettering or features on the bottom of the bottle.

26. I shall begin my comparison with Registered Design No. 6003572 and for convenience reproduce the representations of both this and the contested design in the table below:

The Contested Design	Registered Design No. 6003572
	
	
	<i>No comparable view</i>

The Contested Design	Registered Design No. 6003572
	
	
	

27. I find that the designs share the following features:

- Both are flattened bottles with wide, almost rectangular bodies;
- Front on, both have straight sides;
- Both have rounded shoulders and an elongated tubular neck;
- The depth of the bottle is no greater than the outer diameter of the base of the neck (see A above); and
- The faces of the bottle are smooth.

28. I find that the designs have the following points of difference:

- The width to height ratio of the contested design is greater than that of the prior design, although I consider that the registered proprietor's description of the contested design as "considerably wider" overstates the case;
- The difference between the width of the neck and that of the body is smaller in the prior design than in the contested design;

- The curve at the base of the bottle begins higher up the prior design, but it is confined to the narrow sides of the bottle;
- The straight sides of the prior design do not appear to be rounded, as in the contested design, but right-angled (see B above);⁶
- The narrow faces of the prior design are more curved than those of the contested design (see C above);
- The shoulders of the prior design are more rounded and higher than those of the contested design;
- The prior design appears to be constructed in sections (as can be seen in the 2nd representation above), while the contested design appears to be a single piece;
- The neck of the prior design is proportionately wider and the neck rings divide it into two parts of unequal height. The bottom of these two parts is gently tapered, while the top is straight. The neck of the contested design is a single piece; and
- The wide sides of the prior design are gently pointed at the top, while those of the contested design are curved.

29. I consider that the differences above are not immaterial, and so I find that the contested design has novelty when compared with Registered Design No. 6003572.

30. Registered Designs Nos. 6003564 and 6003568 are less similar to the contested design. The depth of the flattened bottle is greater in proportion to the height and the width than that of Design No. 6003572. The contested design also has novelty when compared with these designs.

31. The remaining prior designs in my view have a larger number of material differences between them and the contested design. As can be seen in the applicant's own diagram reproduced in paragraph 22 above, Registered Design No 6003569 has two thin sides at an angle of each of the wider faces of the bottle. The same is true of Registered Designs Nos 6003565 and 6003573. It is these that give it what the applicant describes as the rounded appearance of the base. However, the base is

⁶ This feature of the contested design is more noticeable in the larger representation in Annex A.

likely to be far less noticeable to the user than the body of the bottle. These additional thin faces will, in my view, not go unnoticed. The contested design has novelty compared with these three designs.

Individual Character

32. Section 1B(3) of the Act states that a design has individual character when it produces a different overall impression on the informed user than that produced by any design made available to the public before the relevant date.

33. The approach to carrying out an assessment of individual character was helpfully summarised by HHJ Hacon, sitting as a Judge of the Patents Court, in *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat). He said:

“181. I here adapt the four stages prescribed by the General Court in *H&M Hennes* for assessing the individual character of a Community design to the comparison of an RCD with an accused design, adding other matters relevant to the present case. The court must:

(1) Decide the sector to which the products in which the designs are intended to be incorporated or to which they are intended to be applied belong;

(2) Identify the informed user and having done so decide

(a) the degree of the informed user’s awareness of the prior art and

(b) the level of attention paid by the informed user in the comparison, direct if possible, of the designs;

(3) Decide the designer’s degree of freedom in developing his design;

(4) Assess the outcome of the comparison between the RCD and the contested design, taking into account

- (a) the sector in question,
- (b) the designer's degree of freedom, and
- (c) the overall impressions produced by the designs on the informed user, who will have in mind any earlier design which has been made available to the public.

182. To this I would add:

(5) Features of the designs which are solely dictated by technical function are to be ignored in the comparison.

(6) The informed user may in some cases discriminate between elements of the respective designs, attaching different degrees of importance to similarities or differences. This can depend on the practical significance of the relevant part of the product, the extent to which it would be seen in use, or on other matters.”

34. I also bear in mind the comments of HHJ Birss (as he then was), sitting as a Deputy Judge of the Patents Court, in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 1882 (Pat). Although he was talking about infringement, the same approach is applicable in invalidity actions:

“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.”⁷

The sector concerned

35. The applicant submits that the sector to which the products in which the designs are incorporated is that of bottles, more particularly bottles for the sale and distribution of products for home delivery. It adds that “What this means is bottles which are flat and therefore can be delivered through a letterbox.”⁸ The registered proprietor agrees that the relevant sector is bottles for the sale and distribution of products for home delivery.

The informed user

36. Earlier in *Samsung*, HHJ Birss (as he then was) gave the following description of the informed user:

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

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

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

⁷ Paragraph 58.

⁸ Written submissions in lieu of a hearing, paragraph 52.

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)."

37. The applicant submits that the informed user is the final user of the products, in other words a purchaser. It is not clear, however, whether this is intended to mean the person who buys the bottles which it then fills with liquid or some other substance to sell on to another person, or that second person who buys the goods that are supplied in the bottle.

38. The registered proprietor submits that the applicant's witnesses are not informed users but that its witnesses are. Mr Lennox, it says, is director of the registered proprietor which uses bottles to sell personalised versions of a range of food and drink products. The registered proprietor submits that he shows a high degree of attention when using the bottles and quotes his evidence on the overall impression produced on him by the contested and prior designs. Turning to the case of Mr Williams, the registered proprietor contends that he sees bottle design as part of his brand and works

with designers and manufacturers of bottles; therefore, he is interested in the products concerned and shows a high degree of attention when using them. In his witness statement, he also compared the designs and the registered proprietor draws my attention to this comparison. The registered proprietor submits that these comparisons are persuasive support for the view that the contested design does have individual character.

39. I have already referred to the role of evidence in registered design proceedings and I shall not repeat what I have already said in paragraphs 9-12 of this decision. It is important also to remember that the informed user is a legal construct. In *Utopia Tableware Limited v BBP Marketing Limited & Anor*, [2013] EWHC 3483 (IPEC), Mr Recorder Douglas Campbell, sitting as an Enterprise Judge, said:

“73. The Claimant submitted that what was important was not the identification of the real-life person to whom the informed user was most closely approximate, but the fact that such person had knowledge of the existing design corpus and of the design features usually included in it.

74. I accept the Claimant’s submission, which is supported by *Pepsi Co v Grupo Promer* [2012] FSR 5 at [59]: see also *Samsung* at [34]. I add that the informed user is also interested in the products concerned and shows a relatively high degree of attention when he uses them, and conducts a direct comparison of the designs in issue unless there are specific circumstances which make it impractical or uncommon to do so: see again *Samsung*, *ibid.*
...”

40. I find that the informed user is someone who buys bottles in which to supply goods for home delivery. They may be a sole trader or the individual who makes the purchasing decision for the business. They would be familiar with the bottles that are available for this purpose, and the features necessary to ensure that the goods reach the final consumer intact and without contamination. I accept that the bottle may make a contribution to the brand image of the product, but in my view the end-user would be less likely to be interested in, and knowledgeable about, the designs of the bottles than in their contents.

Design freedom

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

“... design freedom may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive).”⁹

42. The applicant submits that:

“Even taking the small limitation of the bottles being required to be sufficiently flat to fit through a letterbox, there is a very wide degree of design freedom in this field – the only relevant limitation is that it can hold matter, typically a liquid (or potentially even a gel, powder or any other matter) and has the ability for that matter to be added or removed (e.g. by pouring) from the bottle.”¹⁰

43. It adds that the sides of the bottle do not have to be flat and refers to the different shapes shown on the three bottles depicted in the following image from the registered proprietor’s website.¹¹ While two out of the three have straight sides, the bottle on the far left is curved.



⁹ Paragraph 34.

¹⁰ Paragraph 53.

¹¹ Exhibit OSN14.

44. The registered proprietor submits that freedom of design was more limited, although it acknowledges that there is some choice over the shape of the shoulders:

“The depth and width of the design were limited to less than the dimensions of a letterbox and practical and economic considerations made it necessary for the Contested Design to have flat sides and a flat bottom to minimise the size of the package in which it would be delivered.”¹²

45. Both sides accept that the dimensions of a letterbox pose a physical constraint on the size of the bottle. As bottles are commonly used for liquids, there would need to be a means of pouring the liquid in a controllable fashion. This would generally take the form of a relatively small opening that may be re-sealed when the user has finished. I also accept that, when viewed from the angle shown in the image in paragraph 43 above, bottles commonly have flat bottoms so that they can be placed on a surface without the need for an additional means of support. I am less persuaded that flat sides would necessarily result in smaller packages. The length of the neck of a bottle would also influence the size of the packaging, without breaking the constraint of having to fit through a letterbox.

46. In summary, therefore, there would be some degree of design freedom over the proportions of the bottle, within the constraints outlined above, the neck and shoulders, and whether the sides are curved or straight.

Design corpus

47. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) said:

“39. Recital (13) of the Designs Directive indicates that, other things being equal, a registered design should receive a broader scope of protection where the registered design is markedly different to the design corpus and a narrower scope of protection where it differs only slightly from the design corpus. Thus in *Grupo Promer (T-9/07)*, the General Court held at [72]:

¹² Paragraph 15.5.2.

‘... as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the design at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. ...’

40. Conversely, in *Proctor & Gamble* [2008] FSR 8, Jacob LJ held at [35(ii)]:

‘... if a new design is markedly different from anything that has gone before, it is likely to have a greater overall visual impact than if it is ‘surrounded by kindred prior art’ (HH Judge Fysh’s pithy phrase in *Woodhouse* at [58]). It follows that the ‘overall impression’ created by such a design will be more significant and the room for differences which do not create a substantially different overall impression is greater. So protection for a striking novel product will be correspondingly greater than for a product which is incrementally different from the prior art, though different enough to have its own individual character and thus be validly registered.’

41. Counsel for Vax accepted that in general the proposition stated by Jacob LJ would normally be correct, but submitted that it would not be correct where the striking elements of the design were ones where there was little design freedom, in particular because of technical requirements. More specifically, he argued that, if the registered design was based on a new technology bringing with it new design constraints, then differences between the registered design and an existing design corpus based on old technology might have little relevance when it came to comparing the registered design with a subsequent design based on the new technology. In principle I accept this point.”

48. The applicant has filed evidence of a number of bottles which, it submits, demonstrate a wide degree of design freedom. The first is an alternative design of the

proprietor's, shown to the right of what appears to be the contested design in photographs in Exhibit OSN06:



49. The sides of the alternative design taper upwards to straight shoulders. Mr Navarro states that these undated photographs were supplied by his company's manufacturer, Maynard & Harris Plastics, to one of his former colleagues, and so were made available to the public. The applicant accepts that this design has individual character when compared with the prior designs.

50. Further examples of flattened bottles are given in Exhibits OSN07-OSN10 and reproduced below:



51. None of the printouts showing these bottles bears any date apart from the date of printing. Furthermore, they are all described as water bottles, sold empty and intended to be filled and re-filled by the end-user. Therefore it is difficult to assess to what extent the prior designs stand out from other bottles in the public domain at the relevant date.

Assessment of Individual Character

52. I must consider the comparison that I have made between the contested design and the prior designs in paragraphs 24 to 31 above, in the light of the sector in question, the designer's degree of freedom and the overall impressions produced by the designs on the informed user, who will have in mind any earlier designs that have been made available to the public. As before, I will make my assessment on the basis

of Registered Design No. 6003572, which is the prior design I found to be closest to the contested design.

53. Mr Navarro has stated that customers are easily confused and provides evidence from 2018 of an individual tweeting a picture of one of the registered proprietor's bottles, which she had received, and tagging the applicant into a subsequent reply.¹³ However, earlier I found that the informed user – through whose eyes I must see the designs – is either a business or individual purchasing bottles in which it will supply other goods. I will consider this evidence no further.

54. Both parties accept that the flatness of the bottle is dictated by function, namely that of fitting through a standard letterbox. In my view, this is the most striking feature of both designs, but, given the position of the parties, I shall disregard it for the purpose of my assessment of individual character.

55. Both bottles have a wide, straight-sided rectangular body with an elongated tubular neck and rounded shoulders. In my view, these are the features that make the greatest contribution to the overall impression of the designs. The straight sides and rounded shoulders are in contrast to the applicant's other design, shown in paragraph 48 above. I also note that the proportions appear very similar, an effect created by the fact that the depth of the bottle is equal to the outer diameter of the neck and the relative length of the neck to the height of the bottle.

56. In paragraph 28 above, I list the differences between the designs. In my view, the prior design gives the overall impression of a flattened wine bottle, with its rounded shoulders and proportionally smaller width to height ratio, which to my eyes gives a slightly more elegant appearance than that of the contested design. The remaining prior designs are either deeper relative to the height and width of the bottle or have the narrower faces on either side of the front or back of the bottle. The increased depth gives the impression of a sturdier bottle, while the additional faces make a significant contribution to the overall impression of those designs that possess them.

¹³ First witness statement, paragraph 22, and Exhibit OSN05.

57. I find that the contested design has individual character over the prior designs.

Conclusion

58. Design No. 6017585 will, subject to a successful appeal, remain registered.

Costs

59. The registered proprietor has been successful and is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 2/2006. I award the applicant the sum of £1200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Preparing evidence and considering and commenting on the other side's evidence: £600

Preparation of written submissions in lieu of a hearing: £400

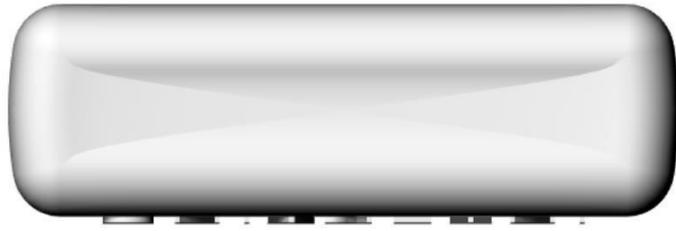
Total: £1200

60. I order Delivering Happiness Limited to pay Intervino Ltd the sum of £1200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 29th day of July 2021

Clare Boucher
For the Registrar,
The Comptroller-General

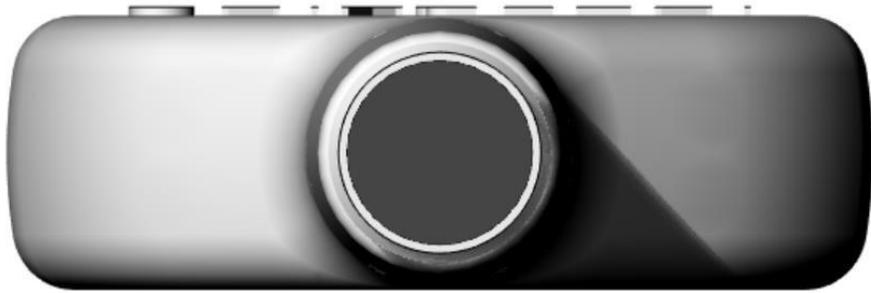
Annex A: The contested design



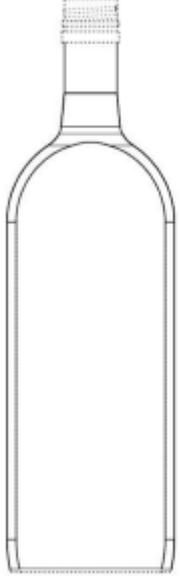
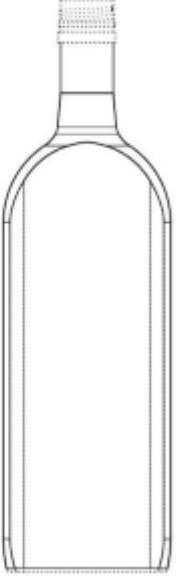
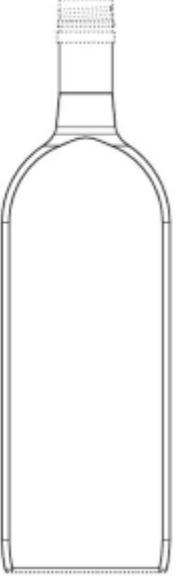
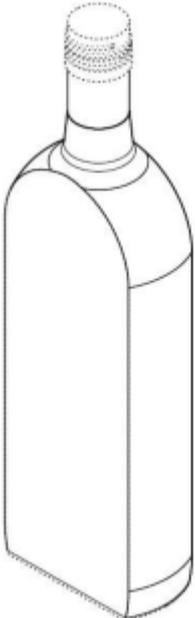
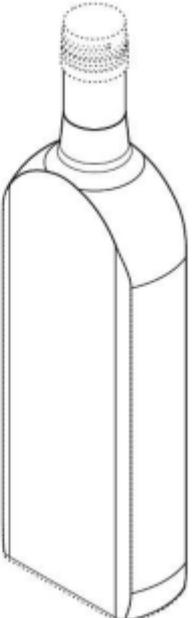
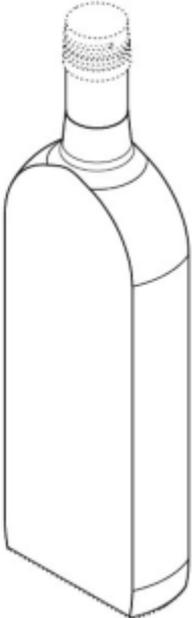


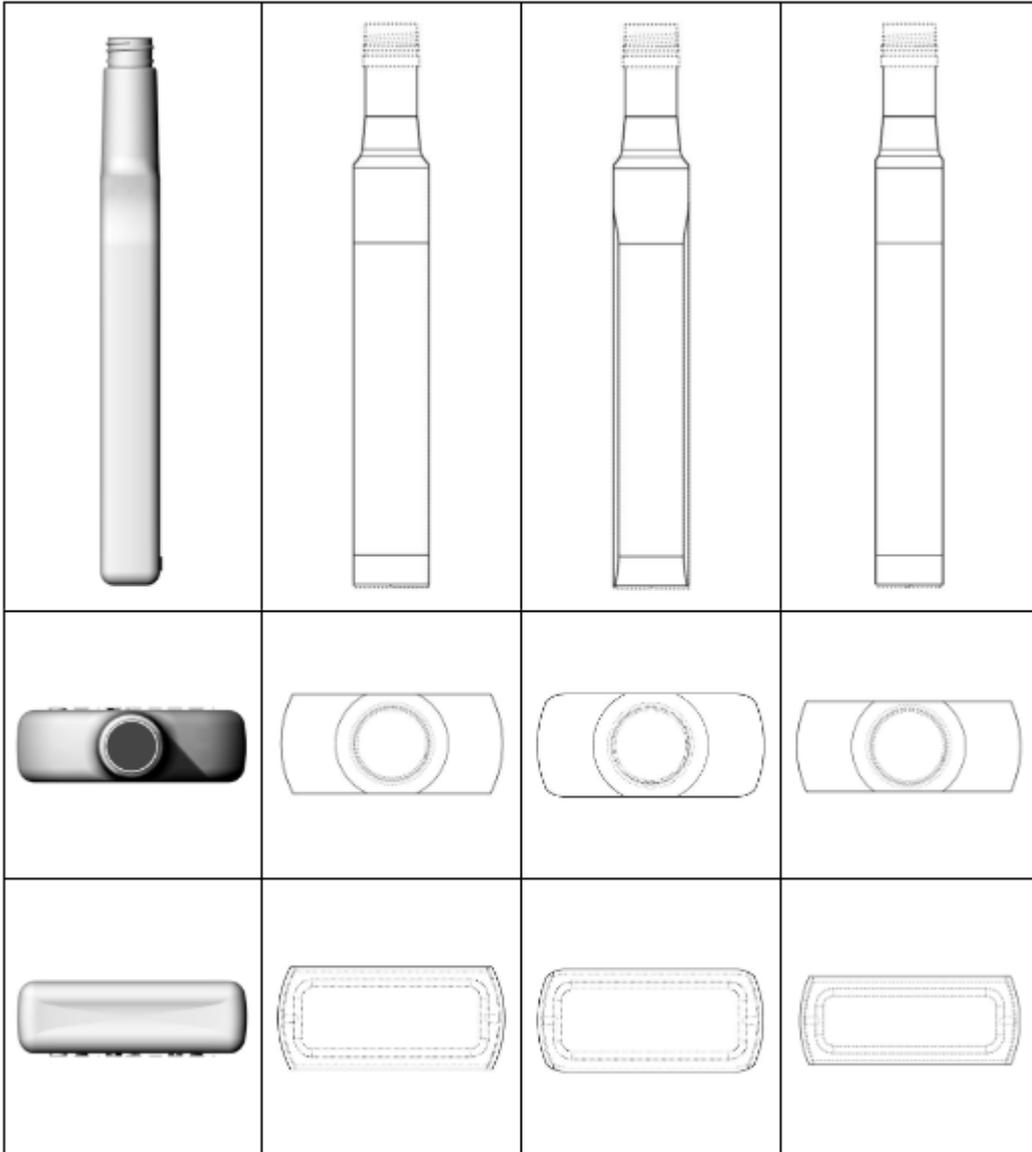






Annex B: The Earlier Registered Designs

The Contested Design	No. 6003564	No. 6003565	No. 6003568
			
			



The Contested Design	No. 6003569	No. 6003572	No. 6003573
	