

O/030/22

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 90082242570001

OWNED BY ENETWOKS LTD

AND

APPLICATION NO. 11/21

BY TRADING CIRCLE LIMITED

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The contested design which is the subject of the dispute was filed by ENETWOKS LTD (“the registered proprietor”) on 1 November 2020. The contested design is for “hooks for hanging, hangers for bathrooms” and is depicted in the following representations:



2. On 26 February 2021, TRADING CIRCLE LIMITED (“the applicant”) applied for the registration of the design to be declared invalid. The applicant claims that the design has been available on Amazon.co.uk since 2017. The applicant filed a number of documents with its Form DF19A, intended to show that the design had been available prior to the application date for the contested design. However, these were duplicated in the applicant’s evidence in chief and so I will refer to them only as part of the substantive evidence.

3. The applicant claims that the contested design should be declared invalid and cancelled under section 11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“the Act”). 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...”

4. The applicant claims that the contested design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character.

5. The registered proprietor filed a counterstatement denying the grounds of invalidation.

6. The applicant is represented by London IP Ltd and the registered proprietor is represented by United Legal Agents. Both parties filed evidence in chief. The applicant elected not to file evidence in reply. Neither party requested a hearing and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. The applicant filed evidence in the form of the witness statement of James Mitchiner dated 20 July 2021, which is accompanied by 3 exhibits. Mr Mitchiner is the applicant’s representative in these proceedings.

8. The registered proprietor filed evidence in the form of the witness statement of Shahzaib Amin Malik dated 30 August 2021, which is accompanied by 4 exhibits. Mr Malik is the representative of the registered proprietor in these proceedings.

9. Whilst I do not propose to summarise the evidence here, I have taken it into consideration and will refer to it below where necessary.

DECISION

10. Section 1B of the Act reads 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 whose features differ only in immaterial details has been made available to the public before the relevant date.

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

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

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

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

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

(6) A disclosure falls within this subsection if –

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

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

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

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

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

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

...”

11. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EQHC 1882 (Pat):

“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).

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 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.”

Relevant date

12. The relevant date is the application date for the contested design i.e. 1 November 2020.

The Informed User

13. The design is for a set of coat hooks. The informed user is, therefore, a member of the general public. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

14. No evidence has been filed regarding the type, range of variety of coat hooks that were available at the relevant date. However, I am prepared to take judicial notice of the fact that they are typically of a shape that facilitates the easy and secure hanging of clothes/hats and may be mounted on to a bracket of some form or be free-standing (either individually or as part of a set).

Design Freedom

15. There is limited design freedom in terms of the construction of the hooks themselves to the extent that they must all be of a shape that facilitates the secure and easy hanging of clothing/hats. However, there will of course be design freedom in that hooks could be configured in any number of ways (for example, with variety in curve, size and finish), with different numbers of hooks within a set, mounted on different materials/backgrounds and presented with different surface patterns.

The Comparison

16. 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 an design which has been made available to the public before the relevant date”. For the application to succeed, the contested design must not be new and/or must not have individual character, when compared with the prior art.

17. In order to be considered prior art, the designs depicted in the evidence will need to have been disclosed prior to the relevant date and must not be excluded disclosures under section 1B(6). I note the following from the applicant's evidence:

- a. A printout from Amazon.co.uk for "HOMFA Coat Hook Rack Wall Mount Stainless Steel Hanger Heavy Duty Clothes Hat Holder" which, it states, was first available for purchase on 14 February 2017.¹ I note that there are reviews dating back to 17 January 2019. The page displays the following image:



- b. A printout from Amazon.co.uk for "Dripex Coat Hook Rack Wall Mounted 304 Stainless Steel Hanger Heavy Duty Clothes Hat Holder (6 Hooks)" which, it states, was first available to purchase on 7 December 2017.² I note that there are reviews dating back to 2 March 2019. The page displays the following image:

¹ Exhibit 2

² Exhibit 3



18. The applicant has also provided a copy of a review for this product (it displays the same product number) dated 21 December 2018. The review includes the following image:³



19. The registered proprietor has contested that these images constitute prior art. I note the following from the evidence of Mr Malik:

- a. He claims that the listings on Amazon are easily editable from a central seller area; in particular, he notes that the date on which a product was first available can be amended. In this regard he has provided the following images:⁴

³ Exhibit 4

⁴ Exhibit SAM1

Picture 1

Product information
Colour Name: Silver | Size Name: 8 hooks

Technical Details

Manufacturer	Homephix
Size	8 hooks
Colour	Silver
Material	Stainless Steel
Plug profile	Door Mount, Wall Mount
Batteries Required?	No

Additional Information

ASIN	B08XBPJ94G
Customer Reviews	★★★★☆ - 125 ratings 4.7 out of 5 stars
Best Sellers Rank	608 in DIY & Tools (See Top 100 in DIY & Tools) 3 in Over Door Hooks
Date First Available	31 Aug. 2019

Warranty & Support
Amazon.com Return Policy: Regardless of your statutory right of withdrawal, you enjoy a 30-day right of return for many products. For exceptions and conditions, see Return details.

Feedback
Would you like to tell us about a lower price? -

Colour Name: Silver | Size Name: 8 hooks

Picture 2

Product information
Colour Name: Silver | Size Name: 8 hooks

Technical Details

Manufacturer	Homephix
Size	8 hooks
Colour	Silver
Material	Stainless Steel
Plug profile	Door Mount, Wall Mount
Batteries Required?	No

Additional Information

ASIN	B08XBPJ94G
Customer Reviews	★★★★☆ - 125 ratings 4.7 out of 5 stars
Date First Available	1 Nov. 2022

Warranty & Support
Amazon.com Return Policy: Regardless of your statutory right of withdrawal, you enjoy a 30-day right of return for many products. For exceptions and conditions, see Return details.

Feedback
Would you like to tell us about a lower price? -

Colour Name: Silver | Size Name: 8 hooks

Picture 3

Product information
Colour Name: Silver | Size Name: 8 hooks

Technical Details

Manufacturer	Homephix
Size	8 hooks
Colour	Silver
Material	Stainless Steel
Plug profile	Door Mount, Wall Mount
Batteries Required?	No

Additional Information

ASIN	B08XBPJ94G
Customer Reviews	★★★★☆ - 125 ratings 4.7 out of 5 stars
Best Sellers Rank	608 in DIY & Tools (See Top 100 in DIY & Tools) 3 in Over Door Hooks
Date First Available	23 Feb. 2021

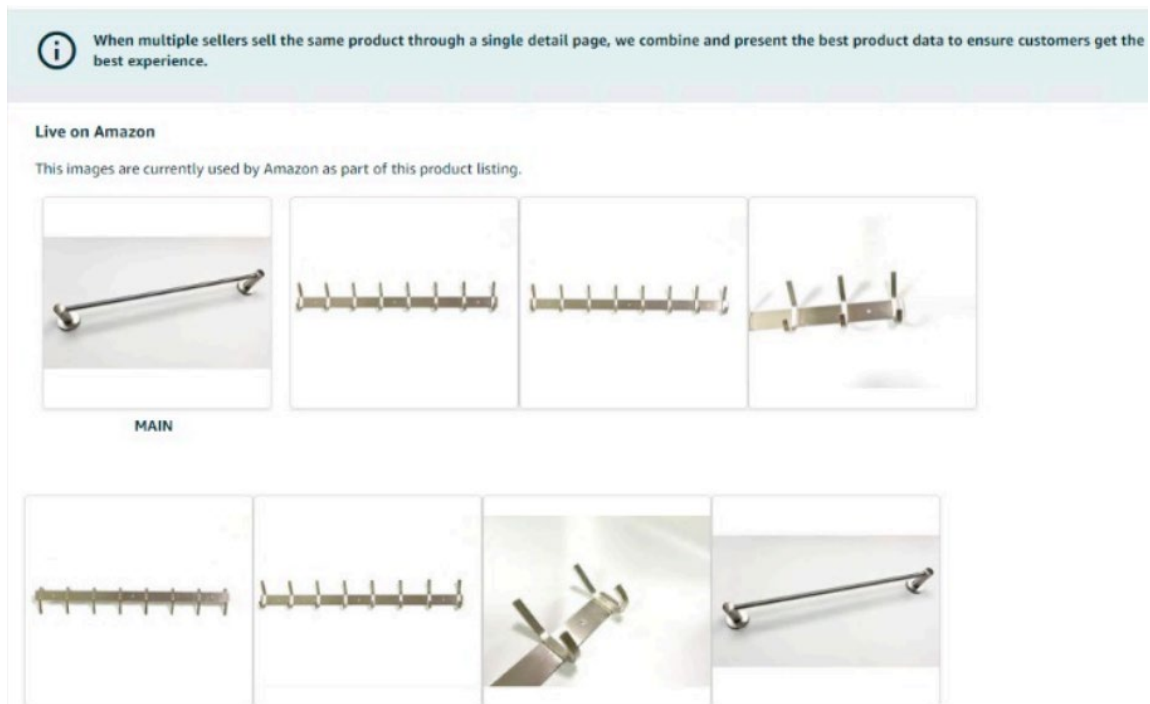
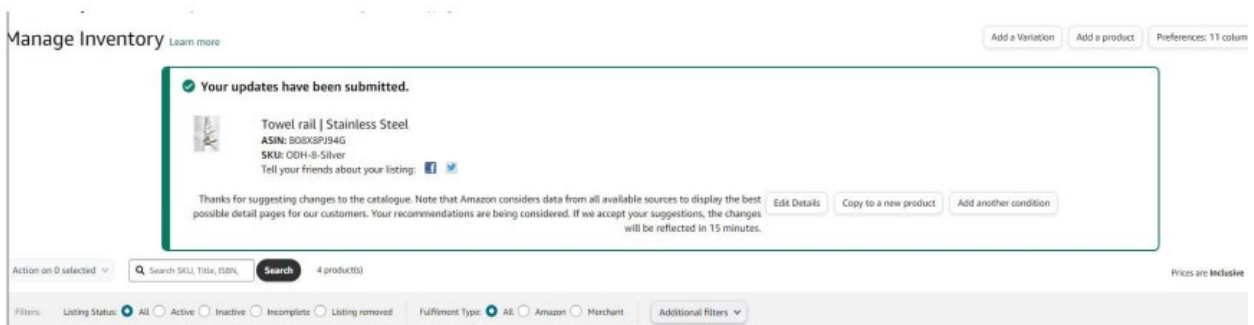
Warranty & Support
Amazon.com Return Policy: Regardless of your statutory right of withdrawal, you enjoy a 30-day right of return for many products. For exceptions and conditions, see Return details.

Feedback
Would you like to tell us about a lower price? -

Colour Name: Silver | Size Name: 8 hooks

Mr Malik states that these screenshots reflect the fact that it is possible to amend the date first available for the same product on Amazon. He notes that the original date was 31 August 2019, which was then amended to 1 November 2022 and then again to 23 February 2021.

- b. Mr Malik has filed evidence which he states shows that it is possible to amend the Amazon Standard Identification Number for products (and to assign it to a different product at a later date), although there does not appear to be any evidence demonstrating this.
- c. Mr Malik states that it is possible to amend the images available for a particular product. The evidence provided to support this is as follows:⁵



⁵ Exhibits SAM3 and SAM4

20. It seems to me that whilst this evidence shows that it is possible to amend the date first available to make it more recent, it does not show that it is possible to make the date earlier than first recorded. Further, the evidence does not appear to me to demonstrate that it is possible to amend the images associated with a particular listing after it has been published. Even if that were possible, it does not demonstrate that the listings relied upon by the applicant have been amended. The review provided by the applicant from December 2018 appears to show an image of a product which is the same (from the part of it that can be seen) as that displayed in the current images on the listing. I note that the sellers of these listings are not parties to these proceedings, and so I see no reason why they would have chosen to amend the listings to fit with the applicant's case, as appears to be suggested by the registered proprietor. I note that the registered proprietor states, in its Form DF19B that it requests I "call an Amazon expert in this matter to assist Examiner, how Amazon listings can be easily manipulated and are not reliable to use as evidence for such a sensitive legal matter". However, no permission has been sought to adduce expert evidence and no such evidence has been filed by the registered proprietor. Taking the evidence as a whole into account, I am satisfied that the Amazon listings included in the applicant's evidence in chief were published prior to the relevant date.

21. The sellers for the Amazon listings are not the registered proprietor. I can see no reason why these listings would be excluded disclosures under section 1B(6). Consequently, I am satisfied that they constitute prior art.

22. The designs to be compared are, therefore, as follows:

The Prior Art	The Contested Design
 <p data-bbox="403 539 584 573">(Prior Art 1)</p>  <p data-bbox="403 920 584 954">(Prior Art 2)</p>	  

23. In my view, the designs share the following attributes:

- a. They all appear in the near identical, brushed-silver colour;
- b. The hooks share the same shape, being made of a single piece of rectangular material folded at an approximately 45 degree angle at the top, with a straight section attaching to the mount and a curved section at approximately the same angle at the bottom;

- c. They all have six hooks attached to the mount;
- d. The spacing of the hooks appears to be equal and approximately the same for each design;
- e. The mount for each design is rectangular in shape with rounded corners.

24. In addition to this, Prior Art 1 and the contested design have holes for fixing to a wall in the same position i.e. between the first and second, and fifth and sixth hooks. However, I note that the mount in contested design appears to extend further beyond the first and sixth hooks than it does in Prior Art 1.

25. I note that Prior Art 2 and the contested design differ in that the holes for fixing to a wall in Prior Art 2 appear between the second and third and fifth and sixth hooks, which is different to the position of those in the contested design. A number – possibly 304 - appears next to the sixth hook in Prior Art 2, in very faint text. This is absent from the contested design.

26. I recognise that some of the common features are, to a certain degree, dictated by the function of the product. They are necessary to ensure that the hooks can be used for securely and easily hanging coats/hats and that they can be attached securely to a wall or other surface. However, there was, in my view, a design choice as to how these functions were achieved. For example, the appearance of the hooks could have taken any number of forms, as could the mount upon which they are displayed. The number of hooks could have varied, as could the arrangement. Similarly, the surface decoration and materials used could have varied.

27. In my view, even if the differences between the prior art and the contested design are sufficient to prevent them from being identical, they differ in only immaterial differences which, in my view, will not create a different overall impression on the informed user. In my view, the contested design does not have individual character. It therefore does not meet the requirements of section 1B of the Act and is invalid by virtue of section 11ZA(1)(b).

CONCLUSION

28. The application for invalidity succeeds.

COSTS

29. As the applicant has been successful it is entitled to a contribution towards its costs. In its Form DF19A, the applicant stated:

“19. The Registrant started selling its products incorporating the Registered Design under the brand name Homephix on or about 26 November 2019 just prior to filing its application for the Registered Design. It is highly likely that the Registrant would have been aware of the designs similar or the same as the DRIPEX Design and HOMFA Design prior to filing for the Registered Design.

20. The Applicant is the seller of a design for a wall mounted collection of clothing hooks on Amazon. On or around 20 December 2020 the Applicant received a take-down notice from Amazon of its product arising from a complaint by the Registrant the seller of the Homephix product. Acting through its representatives United Legal Experts, the Registrant repeated the claim that the Registered Design entitled the Registrant to complain to Amazon and prevent the Applicant from selling products to the public in the UK.

21. In a letter to the Registrant’s lawyers dated 30 December 2020, the Applicant’s lawyers have set out the basis for the invalidity of the Registered Design, however the Registrant has failed to respond.

[...]

23. In light of the clear invalidity of the Registered Design and as a result of the position the Registrant has put the Applicant in as set out in paragraphs 19-21 above, the Applicant has been obliged to take action in bringing this action in

order to protect its business and on the basis of the misuse of the registered design system by the Registrant requests an award costs [sic] off the scale.”

30. I have discretion to award costs off the usual scale in circumstances where there has been unreasonable behaviour on the part of one of the parties. However, it is important to note that the fact that a party has lost is not, in itself, indicative of unreasonable behaviour. In my view, the applicant has not identified any behaviour or conduct on the part of the registered proprietor which would justify a departure from the usual scale of costs.

31. In the circumstances, I award the applicant the sum of **£748**, calculated as follows:

Filing a statement of case and considering the registered proprietor’s statement	£200
Preparing evidence and considering the registered proprietor’s evidence	£500
Official fee	£48
Total	£748

32. I therefore order ENETWOKS LTD to pay TRADING CIRCLE LIMITED the sum of £748. This sum should 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.

Dated this 14th day of January 2022

S WILSON
For the Registrar