

O-471-13

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 4025232
IN THE NAME OF PETER HUNT'S BAKERY LIMITED
IN RESPECT OF THE FOLLOWING DESIGN:**



AND

**A REQUEST TO INVALIDATE (NO. 27/12)
BY VOLVERE CENTRAL SERVICES LIMITED**

The background and the pleadings

1) The registered design the subject of these proceedings was filed by Peter Hunt's Bakery Limited ("PHB") on 25 June 2012 with its certificate of registration being granted on 9 August 2012. The design is described as a "teardrop pie" and is depicted below:



Further representations of the design were provided with the application for registration; these will be depicted later.

2) On 19 November 2012 Volvere Central Services Limited ("VCS") requested the invalidation of the design under section 1B(1)¹ of the Registered Designs Act 1949 ("the Act"), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The design which, it is claimed, destroys the novelty of the registered design is an earlier registered design under the Act, namely: registration no. 3024151 for:



It is stated that the earlier design was published by the Designs Registry on 11 April 2006. It is claimed that the respective designs are "substantially identical" taking into account "the practical constraints and tolerances in the production of baked short-crust pastry items". If the designs are not considered identical, it is claimed that the later design does not produce a different overall impression on the informed user, the overall impression of both being of a "pie baked in the shape of a cut segment".

3) PHB filed a counterstatement denying the claims. Whilst it accepts that certain aspects of a cooked pie have uncontrollable tolerances (such as surface irregularities), the rest of the shape and configuration can be carefully controlled

¹ Which is relevant in invalidation proceedings due to the provisions of section 11ZA.

during the cooking process by the use of trays and moulds. Further comments are made regarding novelty which I will bear in mind, but will not rehearse here.

4) Both sides filed evidence. A hearing took place before me on 20 September 2013 at which PHB was represented by Ms Sophie Holcombe, of counsel, instructed by Bailey Walsh & Co; VCS was represented by Mr Michael Downing of Downing Intellectual Property LLP.

VCS' evidence

Witness statement of Michael Tzirki

5) Mr Tzirki works in the pie industry. He is the managing director of Shire Foods Limited, a company engaged in this field. There is no indication in his evidence as to whether Shire Foods Limited has any form of relationship with VCS. The thrust of his evidence is as follows:

- That mass produced pies are, generally speaking, available in either round or oval shapes.
- That the above is largely dictated by the availability of foil trays used in the pie making industry; there are only a relatively small number of firms making the standard foil trays which are used.
- There has been one recent change to the above, namely, the introduction of square shaped foil trays in around 2006 leading to the introduction of square shaped pies.
- That VCS' pie is a departure from the norm (and would have been at the relevant date) as it is shaped as a cut segment as if from a larger "plate pie", but with pastry on the sides.
- That PHB's design is very similar in shape and profile and also looks like a cut segment; it differs only in having a slightly rounded short (or back) edge.
- That an average consumer would not perceive a difference upon encountering the pies on subsequent days and that the designs would be considered as having the same overall impression; I observe that the question is to be determined not from the perspective of an average consumer but instead from the perspective of an informed user as I will set out shortly.

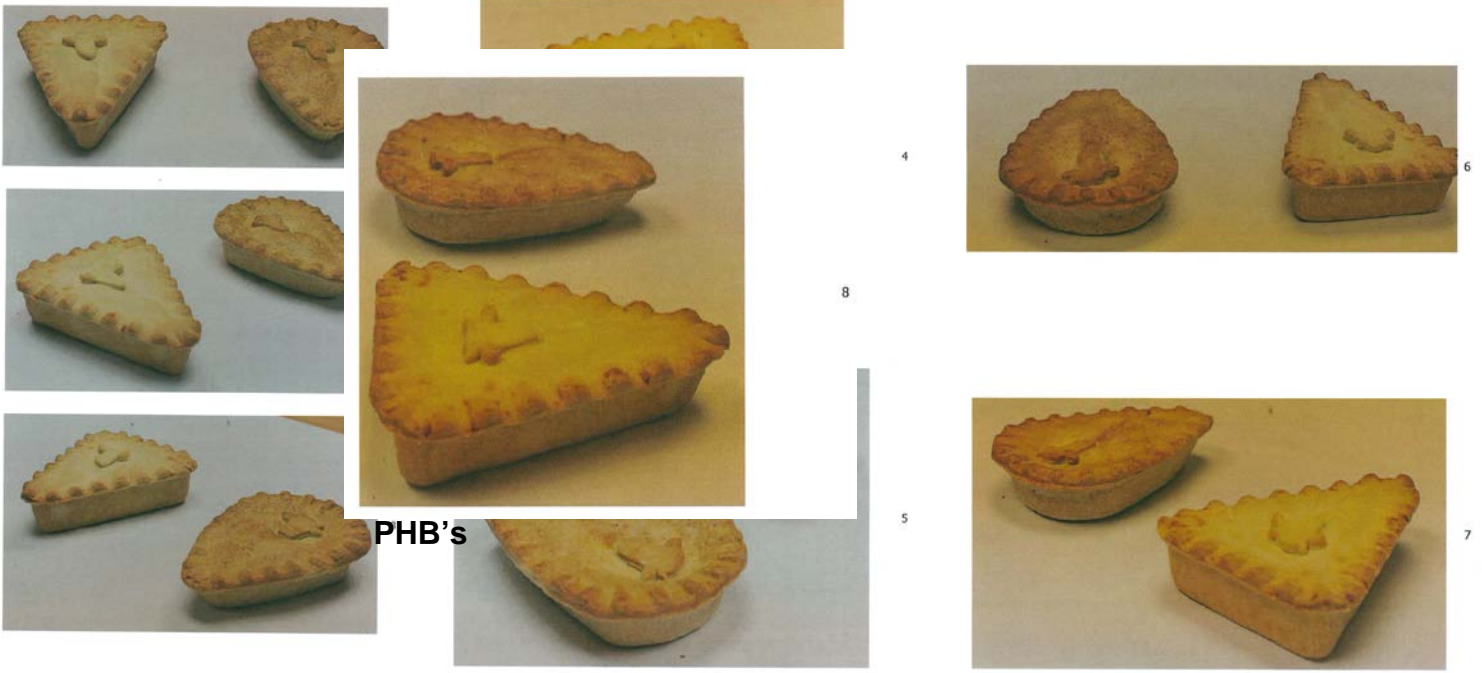
Witness statement of Nicholas Lander

6) Mr Lander is the Chief Operating Officer and Chief Financial Officer of Volvere Plc, VCS' parent company. He explains that there is a link between VCS and Shire Foods Limited. Volvere Plc owns a majority holding in Shire Foods Limited and the latter produces, under license, a pie made according to design 3024151. He provides in Exhibit NL3 photographs of pies made according to design 3024151 and he highlights that each is cooked in the form of a wedge or segment (akin to a portion from a complete pie, but with side walls), that a crimp

pattern is visible around the whole upper circumference and that each has a pastry shape on its lid in the form of an animal so as to denote content.

7) Mr Lander states that PHB's pies are currently sold by Morrison's Supermarket. He states that employees of Shire Foods Limited purchased examples of the pie that is the subject of design 4025232 and photographs are provided in Exhibit NL4. He states that these are also cooked in the form of a wedge or segment, also has a crimp pattern around the upper circumference and each has a pastry shape on the lid denoting content.

8) Exhibit NL5 contains a series of photographs of the competing pies next to each other. He states that this is to highlight the one difference between the designs, in that the short edge of PHB's pie is rounded whereas VCS' is straight. He states that this is most notable in photographs 4 and 8. He adds that photographs 4 and 8 are side views of the pies which, in his experience, are rarely presented to the public. It is more common, Mr Lander states, for the public to see pies in a display cabinet from a "frontal oblique view" as in photograph 1, from which perspective he considers any difference to be diminished. He considers the overall impression of both to be the same. The photographs in Exhibit NL5 are set out below:



evidence

Witness statement of

David Wood

9) Mr Wood is PHB's Managing Director. He is also Managing Director of David Wood Baking Limited. Mr Wood sets out his background in the pie making and bakery business in which he has been working for more than 25 years. The thrust of Mr Wood's evidence is:

- If pies made to the earlier registered design were arranged to form a larger pie, it would not be round in shape but would create some form of polygon; it is argued that this defeats the suggestion that only round or oval pies are the norm.
- In plan view the triangular earlier design is different from the shape of the later design, which is reminiscent of a guitar plectrum.
- It is not just the short edge of the later design which is curved, the two remaining sides have distinct outward curves.
- It would not be possible to form a larger pie from individual pies made to the later design as the curves would leave gaps.
- Mr Wood is the designer of PHB's pie. He wanted to create a novel pie and was inspired by the shape of the emblem of Leeds United Football Club. The emblem, which Mr Wood says his design mirrors, is depicted below:



- Once the basic plan shape of the pie had been devised, standard pie making techniques were employed to define the side walls akin to the standard side walls made through the use of foil trays.
- Other products are available in the bakery field which incorporate meat in a pastry shell beyond round, oval or square items. He highlights the Cornish Pasty, which has a relatively straight edge with the end being joined by a curved edge; it is essentially D shaped with a crimped pattern along the curve. Also highlighted is the samosa which is essentially triangular shaped.
- That departures from oval/round pies are not uncommon. He refers to a website at www.piedesigns.co.za which relates to a company started in 1993 which markets the production of pies of varying shapes and designs. I note from this website the text “who said pies have to be round anyway?”. Two pies are depicted, one is heart shaped the other flower shaped.
- That there is a long history of producing pies in different shapes. Exhibited is an extract from www.historiccookery.com showing a tudor meat pie which is very ornate in design.
- That given the varying designs from over the years, any clear visible differences between the designs will produce a different overall impression.
- That the earlier design has definable straight edges (and a triangular nature) as opposed to definable curved edges.
- That the photographs provided by Mr Lander show aspects of the earlier design which are not part of the registration. However, he nevertheless considers that the photographs demonstrate the significant differences between the pies.

CVS' reply evidence

Second witness statement of Mr Lander

10) Mr Lander's second witness statement can be summarised as follows:

- That despite the comments about geometry, the shapes still look like (albeit imperfectly) a segment of a larger pie
- That Mr Wood's degree of analysis is too deep. He believes, regardless of Mr Wood's intention, that the later design is of a segment.

- That Morrisons Supermarket was previously Shire Foods' principal customer so the later design is now being offered as a substitute for the earlier design – he does not consider that customers will notice the difference and will not view it as a departure in design terms.
- That David Wood Baking Limited has filed a trade mark application for the mark WEDGE PIE, so demonstrating that the later design is a wedge.
- That pasties and samosas are not pies, they are different products.
- That the heart shaped and flower shaped pies come from a South African website and was not known to Mr Lander. Mr Lander did not know of the Tudar pie either. He argues that they fail to show that such alternative pie designs have been sold in the UK at present or within living memory. He considers this to demonstrate the uniqueness of the earlier design.
- That the tagline “why should pies be round anyway” illustrates that pies are typically round. He notes from the same website that “this is a unique innovation...”
- That there is no evidence of the company behind the website selling pies since 1993. Whois information shows that the website was not registered until March 2007. The copyright date on the website is 2010, and references to 2009 and 2008 are also made.
- That the photographs provided illustrate the designs adequately and that they conform to the designs. He does not agree that they show significant differences.

The legal background – the novelty ground

11) Section 1B of the Act reads:

- “(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.
- (3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.
- (4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

- (5) For the purposes of this section, a design has been made available to the public before the relevant date if-
- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
 - (b) the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
- (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
 - (b) 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.
- (8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

12) In terms of the legal principles, guidance on the various relevant issues can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”). Some of the key points from this are that:

a) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.

b) In terms of design freedom, this 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). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.

c) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.

d) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised similarities means that the machines give the same overall impression. ...”

13) An appeal was made against Mr Justice Arnold’s decision which was dismissed by the Court of Appeal (case [2011] EWCA Civ 1206). Worth mentioning here is some additional commentary provided by Sir Robin Jacob in the Court of Appeal’s judgment, namely that:

“30.....Moreover the list of nine features relied upon by Dyson is far too general. Thus it is no good saying "both have transparent bins through which the cyclone shroud is visible" when the reality is that both the bins and shrouds are very different in shape. You cannot take features of a design, turn them into general words and then treat those words like a patent claim.”

and

“34. I would only add one matter, irrelevant in this case. In *P&G* I drew attention to the difference between Recital 14 and Art. 6 of the Design Regulation (EC 6/2002). The former uses the expression "the design clearly differs" whereas the latter merely says "differs." "Clearly" does not reappear. I thought the difference was deliberate and so had some significance. I was wrong, though that does not affect the main reasoning in *P&G*. The difference in wording is merely the result of sloppy drafting as has been pointed out by Dr Alexander von Mühlendahl in *Design*

Protection in Europe, 3rd Edn. (2009 at pp.232-3). The same of course applies to the identical wording in the Directive (Recital 13 and Art. 9).”

14) Matters must be judged from the perspective of an informed user. In case C281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA, OHIM*, it was stated:

“It should be noted, first, that Regulation No 6/2002 does not define the concept of the ‘informed user’. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.”

The relevant date

15) It is the novelty of the later design that is being considered in these proceedings. The relevant date is, therefore, 25 June 2012, as per section 1B(7) of the Act. There was a discussion at the hearing about the earlier design and whether the degree to which it stood out from the norm should be assessed at the date on which the earlier design was filed or the date on which the later design was filed. It is clearly the latter. The sole question before the tribunal concerns the novelty, or otherwise, of the later design. Questions about the existing design corpus or the degree to which the prior art stands out from the norm must be made on that later date. Consequently, all matters are to be examined as of the relevant date.

The informed user

16) The informed user is not a casual user but must instead be deemed to be a knowledgeable/particularly observant user of pies and will possess those characteristics (knowledge/experience) set out in the preceding case-law. In addition to the case-law mentioned above, Mr Downing referred to the judgment of His Honour Judge Birss QC in *Samsung Electronics (UK) Ltd v Apple Inc* [2012] EWHC 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 Inc v Grupo Promer Mon-Graphic SA (C-281/10 P)* [2012] F.S.R. 5 at [53]–[59] and also in *Grupo Promer Mon Graphic SA v Office for Harmonisation in the Internal*

Market (Trade Marks and Designs) (OHIM) (T-9/07) [2010] E.C.R. II-981; [2010] E.C.D.R. 7 , (in the General Court from which *PepsiCo [2012] F.S.R. 5* was an appeal) and in *Shenzhen Taiden Industrial Co Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (T-153/08)*, judgment of June 22, 2010, not yet reported .

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 [2012] F.S.R. 5* at [54] referring to *Grupo Promer [2010] E.C.D.R. 7* at [62]; *Shenzhen (T-153/08)* at [46]).
- ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* at [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* at [59] and also [54] referring to *Grupo Promer [2010] E.C.D.R. 7* at [62]);
- iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* at [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* at [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 [2012] F.S.R. 5* at [59]).”

An appeal against the above judgment was subsequently dismissed by the Court of Appeal, and the above quotation was undisturbed. I will bear this guidance in mind when I make my assessments.

The design corpus

17) I am not persuaded that the evidence from the website at www.piedesigns.co.za should be taken into account in determining the existing design corpus. The informed user is deemed to be aware of the existing design corpus and it would be unfair, in my view, to equate such knowledge based upon the designs on this website without being in a better position to understand the degree to which they have been made available to the public. The same goes for the historic Tudor pie design. The evidence has been put forward in an attempt to demonstrate that departures from round/oval/square pies are not uncommon,

however, if this were the case then one would have expected much stronger evidence than has been filed. In relation to the submission from Ms Holcombe regarding the existence of pasties and samosas, these are different products and should not be taken into account in assessing the design corpus for pies.

18) I am left with the view that the existing design corpus is made up of predominately, oval, round or square shaped pies. Although, the informed user will be aware of the capacity to make pies in shapes other than this, but that this would not be common.

Design freedom

19) Clearly, pie designs will share certain features such as pastry sides, bases and lids. From a commercial perspective, pies are normally formed and cooked in a foil tray and from an economic point of view it would be logical to assume that pie manufacturers, in order to keep costs down, will use basic shape trays for this purpose. This, therefore, has a limiting effect, although not an absolute one, on design freedom.

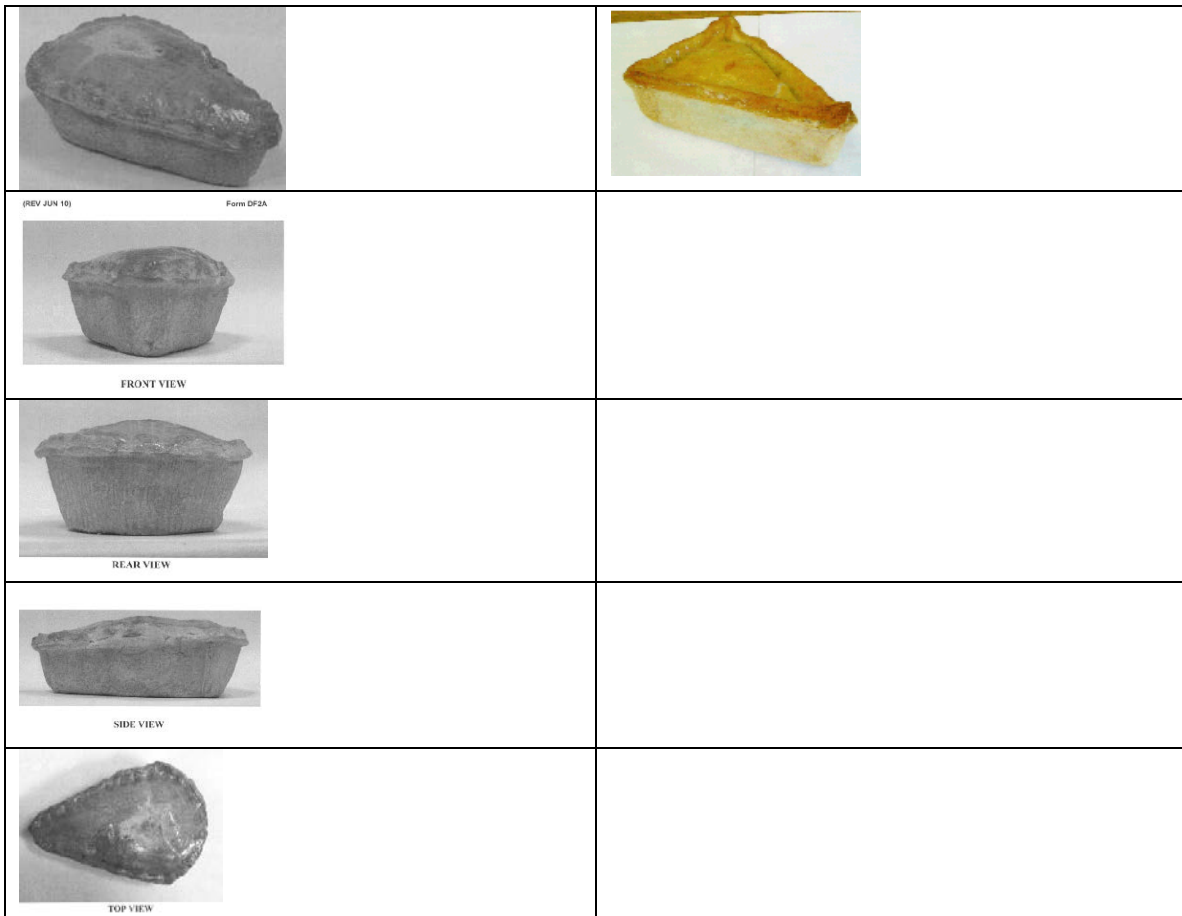
The prior art

20) There is no dispute that the prior art was made available to the public before the relevant date. There was a discussion at the hearing as to the degree to which the prior art stands out from the norm. Mr Downing considered that it was very unconventional, being triangular shaped. In my view, the design stands out to a degree (as it is not oval, circular or square-like) but should not be regarded as a huge or significant step away. The shape is still a fairly basic one.

The photographs filed in evidence

21) Whilst photographs of articles made to designs can be helpful on occasion, it can also be dangerous to make comparisons based on such photographs. The fixed points of reference for the designs are as they are registered, which, in this case, actually consists of photographs. The danger I have expressed is notable in this case because the photographs show aspects which are simply not present in the fixed points of reference, namely, the animal shapes on the pastry lids. Furthermore, regardless of the point about tolerances in cooking, there seems a significant difference between the crimping on the photographs provided in evidence compared to those on the register, particularly in the case of the prior art. For these reasons, I will make my comparison on the basis of the designs as registered. The competing designs can be seen below:

The registered design	The prior art
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22) It is clear that the designs are not, literally speaking, identical. However, designs can be considered identical if the differences between them are immaterial. Whilst I bear this in mind, and despite Mr Downing's submissions that the differences are immaterial, I am not persuaded that this is so. The differences, notably the curved edges compared to the straighter edges, together with the differences between the lids, means that the submission falls a long way short.

23) That leaves whether the overall impression of the registered design produced on the informed user differs from the overall impression of the prior art. It would be the wrong level of generality to assess the overall impression based on a single concept. For example, Mr Downing focused on both designs being segment or wedge shaped whereas Ms Holcombe contrasted the shapes by referencing the registered design as being tear-drop like. A more informed analysis ought to be made.

24) In terms of overall impression, the prior art will be seen as having a three (straight) sided profile, with the two opposite sides being of equal length with the further side being shorter. The three sides are joined by roughly acute points to form a triangular shape. The overall impression will also be characterised by a crimp that has the effect of pushing the lid lower than the crimp.

25) The overall impression of the later design is also three sided with the two opposite sides being of equal length with the third side being shorter. However, the shorter side has a distinct outward curvature, with this curvature also being apparent at the place opposite the shorter side (where the two longer sides meet). The way in which the profile is set out means that it will not be seen as triangular (because of the lack of distinct angles) and will instead be seen as something like a tear-drop, a guitar plectrum, or even a bicycle saddle. The name is, of course, not important; it is what the eye sees that matters. The crimping produces an upward facing lid rather than being pushed down as in the prior art. Mr Downing put what he called the domed effect down to the cooking technique (so meaning that the degree of doming could vary), but I consider that this should be regarded as part of the shape and configuration of the design.

26) I bear in mind and accept that there will be certain tolerances created by the cooking process which means that that finished articles will not always look exactly the same. However, these degrees of tolerances cannot be taken too far. I consider that the overall impressions I have described are not ones which the cooking tolerances will significantly affect.

27) The prior art stands out somewhat from the norm. This factor goes in favour of the applicant but, as I have already said, the prior art is still of a fairly basic profile. I have already commented upon the degree of design freedom. Whilst there are some constraints, I do not consider that this should be overplayed because it is still possible, as observed earlier, to make pies in a great variety of shapes.

28) In reaching my conclusion, I have carefully considered the points made by Mr Downing in connection with the informed user and the degree to which the overall impressions (and the differences between them) will be appreciated. I have noted the level of analysis indicated by HRH Birss QC in *Samsung Electronics (UK) Ltd v Apple Inc* and, after weighing the respective factors, and notwithstanding that the informed user will not fixate on minimal differences in detail, I am satisfied that the differences I have identified mean that the overall impressions created by the designs differ from each other. I hold that the registered design is valid and may remain on the register. I add that even if I had made my assessment, at least in part, on the comparative photographs provided, I would have reached the same conclusion. The photographs, at the very least, aptly demonstrate the difference in profile shape. Further, the point made about the photographs by Mr Lander regarding the way in which pies are presented to the public (front on) is not significant. The overall impression produced on an informed user will not be based purely on a single perspective of the design, the informed user is, after all, more attentive and experienced in the field than an average consumer.

Costs

29) PHB has been successful and is entitled to a contribution towards its costs. I hereby order the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Filing evidence and considering evidence	£700
Attending the hearing	£500

30) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of November 2013

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