

BL O/323/19

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN No. 6027306

IN THE NAME OF FIL BALDOWSKI

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION (No 11/18)

BY GORDON MCSHERRY

The background and the claims

1. These proceedings concern an application by Mr Gordon McSherry to declare the above registered design invalid. Mr McSherry's claim is based on section 1B¹ of the Registered Designs Act 1949 ("the Act") which requires that a registered design be new and have individual character.

2. The design registration Mr McSherry seeks to invalidate is owned by Ms Fil Baldowski, who filed it on 10 February 2018. Ms Baldowski described her design as a "folding dice tray" and also entered a disclaimer in relation to the colours depicted in the design. A number of illustrations of the design were provided, showing it from different perspectives and in different stages of folding/construction, as follows:



¹ Which is relevant in invalidation proceedings given the provisions of section 11ZA(1)(b) of the Act.

3. In his statement of case, Mr McSherry provides a number of pieces of evidence which he says show almost identical designs being sold by different companies. I will detail these later. Ms Baldowski filed a counterstatement in which she explains what the unique design features of her design are. She also provides comments on the differences between her design and the prior art (including the materials and construction used, the impact of internal stitching and sharper corners). Finally, she comments on what she considers to be the motive of the applicant and what led to the dispute between the parties. I should add that the materials provided with the statement of case/counterstatement (those which have been accepted into the proceedings), is to be treated as evidence in these design proceedings, as per rule 21(1) of the Registered Design Rules 2006.

4. No further evidence was filed by either party. Neither party requested a hearing or filed written submissions in reply.

The legislation and leading case-law

5. 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...”

6. Section 1B 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.”

7. 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.”

The Relevant Date

8. The relevant date is the application date for the registered design, namely 10 February 2018.

What features form part of the registered design?

9. Before considering the claimed prior art, it is important to answer the above question, in order to decide what aspects of the registered design should be compared to the prior art. I flag this here because it is notable from just a brief analysis of the prior art that they all contain surface ornamentation, whereas the registered design is much plainer. Should such a difference form part of the analysis?

10. In *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat) (11 July 2013) (“Trunki”), Arnold J dealt with a case involving designs for children’s suitcases, with the claimed infringing design having additional graphics not contained in the earlier registered design. Arnold J stated:

“67. A similar issue arose in *Procter & Gamble*, where Jacob LJ said at [40]:

“... I should record that [counsel for the defendant], under a little pressure from the Court, abandoned his point about decoration, rejected by the judge at [71]–[73]. He was right to do so. The registration is

evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant."

68. Against this, counsel for PMS relied on what Jacob LJ had said in *Samsung v Apple* at [15]-[20]. As counsel for Magmatic pointed out, however, in that case Apple contended, and it was common ground, that an important feature of the registered design was the absence of ornamentation. In those circumstances Judge Birss held, and the Court of Appeal agreed, that the informed user would take the presence of Samsung's trade mark on the alleged infringement into account, but would only give it slight weight.

69. In my judgment, the position in the present case is the same as in *Procter & Gamble*. The CRD is evidently for the shape of the suitcase, and the proper comparison is with the shape of the Kiddee Case."

11. The *Trunki* case was appealed to the Court of Appeal². The leading judgment was given by Lord Justice Kitchen, from which I note the following guidance:

"36. On appeal to this court (*Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 8), the defendant abandoned the point, as recorded by Jacob LJ:

"40. Before going on to consider this argument in detail, I should record that Mr Carr, under a little pressure from the Court, abandoned his point about decoration, rejected by the Judge at [71-73]. He was right to do so. The registration is evidently for a shape. The proper comparison is with the shape of the alleged infringement. Graphics on that (or on the physical embodiment of the design) are irrelevant."

37. If I might respectfully say so, this observation of Jacob LJ seems to me to be entirely right in the context in which it was made. Before carrying out any

² *Magmatic Ltd v PMS International Ltd* [2014] EWCA Civ 181

comparison of the registered design with an earlier design or with the design of an alleged infringement, it is necessary to ascertain which features are actually protected by the design and so are relevant to the comparison. If a registered design comprises line drawings in monochrome and colour is not a feature of it, then it cannot avail a defendant to say that he is using the same design but in a colour or in a number of colours. As Lewison J observed, were it otherwise, the practical effect of not claiming a colour would be to limit the scope of protection to the colour white, and that would defeat the purpose of not claiming colour in the first place.”

12. The Court of Appeal overturned the judgment of Arnold J, principally because his assessment as to the scope of the earlier registered design did not include two aspects: i) that it was intended to represent a horned animal and, ii) that although colour was not a feature of the earlier design, its colour contrast was. Both these factors contributed to the overall impression of the earlier registered design and, thus, it was wrong to have conducted the comparison purely on the basis of the outline shape of the earlier registered design (compared to the outline shape of the alleged infringing design). What is being referred to above represents what is often called the “like for like” test. It should be noted that the *Trunki* case was appealed to the Supreme Court³. Its judgment casts no doubt on the “like for like” test. The judgment was more about how the earlier design in that case was to be interpreted (it agreed with the Court of Appeal that the earlier design was for more than just shape and configuration).

13. Following the *Trunki* judgments, the IPO issued guidance to potential design applicants by way of DPN 1/16. The DPN made a number of recommendations for the way in which a design was to be filed if the applicant wished to protect just the shape and configuration of the design put forward for registration. For example, in paragraph 12 it was stated:

“....when seeking to protect shape-only, applicants are advised to use simple line drawings, without any colour or tonal differences, and without any visible surface features or decoration.”

³ [2016] UKSC 12

and in paragraph 15:

“Where an applicant seeks to protect shape only, the Registrar recommends the use of written limitations/disclaimers in order to define the intended protection as explicitly and as accurately as possible. Therefore, in addition to following the advice provided at paragraph 12 above regarding the use of simple line drawings, an applicant may also wish to submit a written disclaimer or limitation such as, for example, ‘protection is sought for the shape and contours alone’

14. When the subject design was filed, the applicant disclaimed the colours, but nothing else. There is no specific indication that the design was filed in respect of just its shape and configuration. Indeed, I note that, although faint, one of the views of the designs (the bottom view, unfolded) depicts what I take to be a trade mark. There is also a notable contrast in colour between the top and the bottom of the design. Whilst this may be down in part to the choice of materials used, that contrast nevertheless contributes to the look of the design.

15. In her counterstatement, Ms Baldowski details what she considers to be the unique features of her design. A number of these are based on the materials used which produce a number of functional benefits. Whilst a particular material used in a design does not form part of its protection per se, the look of a particular material may contribute to its overall impression. So, for example, the choice by Ms Baldowski of the particular “noise dampening” materials and, also, “hardwearing” materials, may impact on the overall impression of the design due to the resultant look of such materials, as does its relatively minimalist look. For all these reasons, I come to the view that the registered design covers not just the shape and configuration of the design, but also its minimalistic ornamentation, including its contrasting colours (but not the exact colours depicted because of the disclaimer).

The prior art

16. I now return to the evidence to assess what has been disclosed to the public and whether such disclosures took place before the relevant date.

Prior art 1

17. Mr McSherry provides a print from the website Etsy. The clearest image of the claimed prior art can be seen below:



18. The print states that the item is a collapsible dice tray that can be folded or rolled up, that each corner has snap buttons which can be assembled on all sides to form a tray, or, on one end only, a wall against which to roll the dice; and that the trays are lined with felt for a nice rolling cushion. There are other smaller pictures on the print, but they are so small it cannot be ascertained what they show. There is, therefore, nothing to show the design from other perspectives, or in folded position.

19. There are reviews on the website dating from May and June 2017. There is also an exchange between Mr McSherry and someone from the trader responsible for the item to explain when it was first sold. As Ms Baldowski states in her counterstatement, it is not helpful that only a partial extract from the conversation is given, which concludes “May second was my first sale for that item”.

Prior art 2

20. Prior art 2 also comprises a print from Etsy. The clearest image looks like this:



21. There are references in the accompanying text to the size of the item (a portable dice or jewellery tray) whilst “snapped”, that it folds easily and can “even lay practically flat”. There are, again, product reviews, the earliest dating from August 2017. Another partial extract from a conversation with the seller is provided, with the seller saying that “I began selling my dice trays in July of 2017”.

Prior art 3

22. Prior art 3 also comprises a print from Etsy. The clearest image looks like this:



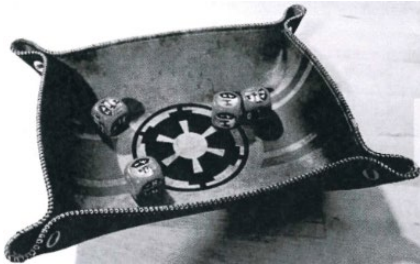
23. There are references in the accompanying text to it (a dice tray) being lightweight, compact and folded flat, and that they snap up or down in seconds. There are product reviews, the earliest from 9 February 2018. Again, another partial extract from a conversation with the seller is provided, who confirms:

“I can’t find the date when I first listed the dice trays but my first sale on Etsy was the 12 Jan. I had been selling them locally prior to this though”.

There is also reference in this conversation to tutorials for making such items, posted “years ago”. A weblink to an example from 2011 is given.

Prior art 4

24. Prior art 4 also comprises a print from Etsy. The clearest image looks like this:



25. References in the accompanying text include that it uses the same rubber material as gaming playmats, that the edges pinch together to form a tray and that it features a sewn edge for durability, and that it “folds easily in half for storage”. The earliest product review is from December 2017. Again, another partial extract from a conversation with the seller is provided, who states that “we started selling these about a year ago”, the comment is dated 15 March 2018.

Other potential prior art

26. The prior art detailed above comes from an amended statement of case, earlier versions of which were not accepted into the proceedings. The earlier versions (which contained further dice tray designs) were not accepted because the claim was lacking in terms of when the disclosure took place. Thus, I will only have regard to the prior art as pleaded above, taken from the statement of case that Mr McSherry refiled. I also note that in his statement of case Mr McSherry mentions two websites on which videos of similar designs were disclosed. In response to the inclusion of such weblinks in his first statement of case, Mr McSherry was informed that if the contents of such videos were to be relied upon, some form of media file would need to be provided and that this could be done during the evidence rounds. No evidence of this type was filed, indeed, neither party filed any further evidence during the evidence rounds. Again, it is only the above prior art that has been properly placed before the Tribunal and it is this that I will consider.

The dates of the prior art

27. Mr McSherry has attempted to obtain the first dates of sale of prior art 1-4. Although Ms Baldowski comments on the partial nature of the conversations with the sellers of the prior art, nothing turns on this because in her counterstatement she accepts that the four designs were all commercially available before she applied for her design. All four pieces of prior art can therefore be taken as having been made available to the public before the relevant date.

28. Ms Baldowski goes on to say that she put her design in the public domain before the first dates of sale of the prior art, and that she gave permission for an Etsy designer to use it (a Mr William Meddis). However, this does not change the relevance of the prior art. The question to be determined is whether relevant designs were disclosed before the relevant date. It does not matter that Ms Baldowski may have disclosed even earlier. The only argument that could potentially have been made by Ms Baldowski is that the prior art copied her design and, hence, such disclosures should be disregarded as an abuse of her design (see section 1B(6)(e) of the Act), however, such a defence has not been pleaded and, even if it was, there is no evidence that would get close to such a conclusion.

29. I also observe that had Ms Baldowski disclosed her design more than 12 months before the relevant date, this would have given grounds for invalidation based on her own disclosure. However, the exact date of Ms Baldowski's own disclosure is not clear, so this is not open as a finding in the current proceedings.

30. The net effect of the above is that all 4 items of prior art detailed above have the potential to invalidate the registered design, subject to the comparisons I come on to make.

The Informed User

31. The design is of a dice tray. The informed user is, therefore, a user of such an item albeit a knowledgeable/observant user, possessing the type of characteristics set out in the preceding case law.

Design freedom

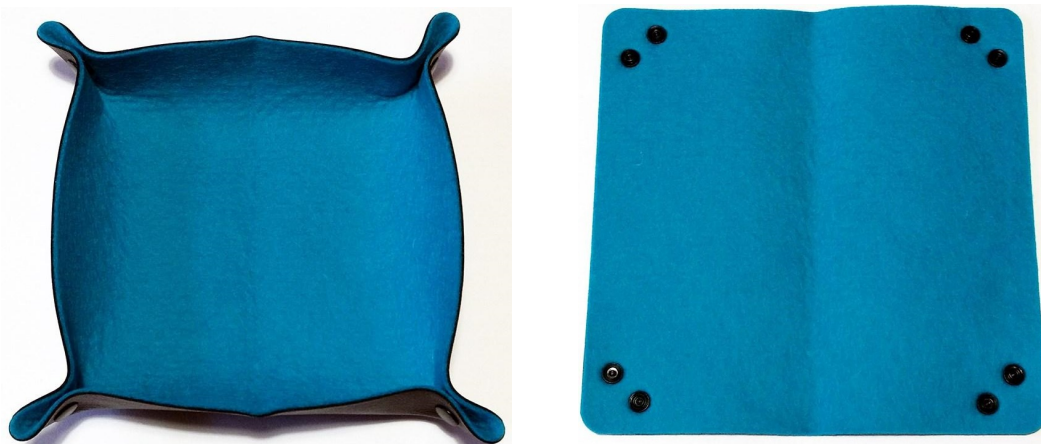
32. A dice tray, foldable or otherwise, will have some constraints in terms of how they are designed. They will need to have walls of some form to prevent the dice from escaping the tray, they will need to have a fairly flat bottom to allow the dice to roll freely. For portable/foldable versions, they will need to have some way of collapsing the walls and the ability to fold. That said, I consider there to be a reasonable degree of design freedom in how these features are designed and incorporated into the overall design. There is also a large degree of freedom in what surface ornamentation is applied.

Design corpus

33. There is no evidence of the design corpus for dice trays, beyond the specific prior art identified above. What is provided shows that there were a number (five at least, including the registered design) of designs used in trade before the relevant date which at least have some degree of similarity to each other. Thus, the registered design does not materially stand out from the crowd of what has been evidenced, but how far it stands out from the crowd of other dice trays is not known.

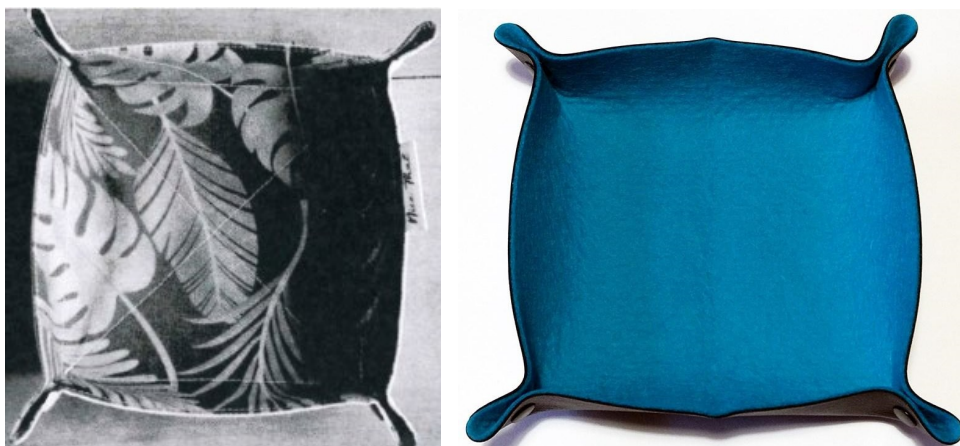
The Comparison – prior art 3

34. I begin by comparing prior art 3 with the registered design. It is not necessary to replicate all of the illustrations of the registered design, the following is sufficient:





35. No representations showing the prior art folded up, or flattened out, are provided. I return to this point below. I begin by examining the designs in constructed form, when dice can be thrown into them. I set them out side by side:



36. I accept that the shape and configuration of the designs from this perspective have some key similarities. They both have a roughly square configuration, with slightly bowed (outward) sides. They both have what seem to be fairly flat bottoms. They both have a similar corner characteristic whereby each corner is brought together with fasteners to produce almost a pinch like effect. However, the prior art also has a striking leaf like surface ornamentation as opposed to the much plainer contrasting scheme of the registered design.

37. The prior art has what appear to be faint lines or creases running diagonally. Whilst the informed user will not place much weight on this in terms of design impact (because the creases will be assumed to play a functional role, assisting with the folding of the product), they do however signify that the prior art is folded diagonally on itself which therefore creates a difference when the respective trays are folded, one being folded horizontally creating an oblong, the other diagonally creating a triangle. Such a difference is a relevant consideration given that the registered design includes various views in its portable state. Whilst I accept that a dice tray will be used most often in its constructed form, the way in which it can be folded up and carried around is also important.

38. The designs are clearly not identical. In terms of whether they have the same overall impression, in my view they do not. This is on account of the different surface ornamentation, together with the difference in the way that the designs would look when folded. The claim on the basis of this prior art fails.

The Comparison – prior art 2

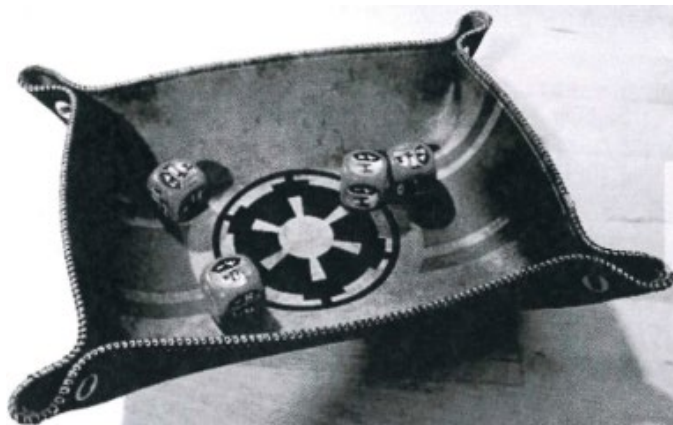
39. The competing designs look like this:



40. Comparison with this piece of prior art does not improve Mr McSherry's position. Firstly, the prior art is not the clearest in terms of being able to fully and objectively assess the relevant characteristics. In any event, the presence of a striking pattern in the prior art again creates a difference. Further, an absence of information regarding the way in which the prior art folds means that I cannot assess whether the folded versions are the same, similar or different. The absence of this information should not count in Mr McSherry's favour. The claim on the basis of this prior art fails.

The Comparison – prior art 4

41. The competing designs look like this:

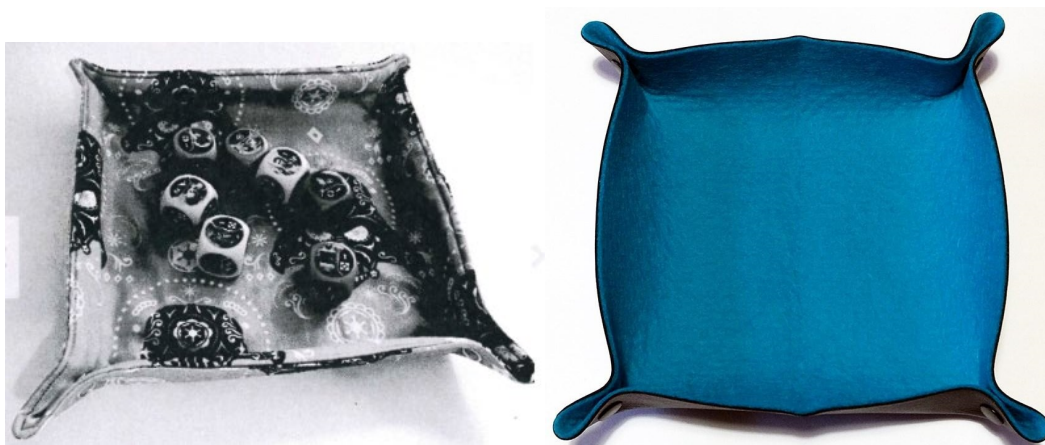


42. Even setting aside the difference in surface ornamentation, and the absence of information showing how the prior art folds up, there are clear differences in the shape and configuration of the trays as depicted above. The prior art has a more ornate and flowing design whereas the registered design is more rudimentary. The prior art also

has a noticeable stitching effect upon all sides which, whilst functional, contributes to the design characteristics of the prior art. I would have found that the differences in shape and configuration alone were sufficient to result in the designs not having the same overall impression. The claim on the basis of this prior art fails.

The Comparison – prior art 1

43. The competing designs look like this:



44. Again, even looking just at the shape and configuration, there is sufficient difference to say that the designs do not have the same overall impression. The corners appear to protrude more, the prior art has a more sophisticated contoured look and there is a clear double layer of material around the edges of each side. The claim on the basis of this prior art fails.

Final observations

45. It seems to me that Mr McSherry is seeking to rely more on the general concept and idea of these types of portable dice trays. This is not how design law works, which is focused very much on the manifestation of the concept (i.e. what the design looks like) and how a designer has gone about their task of creating a design. I should also say that because one of the differences I relied on was the respective surface ornamentations, the same will also operate in reverse. If, as I have held, the registered

design includes not just its shape and configuration but also its simplistic contrasting surface ornamentation, it follows that a later design of the type shown in the prior art would not infringe the registered design.

46. I have not touched on the evidence filed by Ms Baldowski relating to the motive of Mr McSherry in making his application for invalidation. This is because there does not seem to me to be any relevance in the evidence to the matters that need to be determined.

Costs

47. At the end of the proceedings, the parties were sent a proforma to complete if they intended to pursue a claim for costs, setting out hours expended on certain tasks. Neither party returned them, therefore, I make no award.

Dated 7 June 2019

Oliver Morris
For the Registrar,
the Comptroller-General