

O/374/20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN Nos. 6007308 & 6007309

OWNED BY COREGRAVEL UK LIMITED

AND

APPLICATIONS No. 37/19 & 38/19

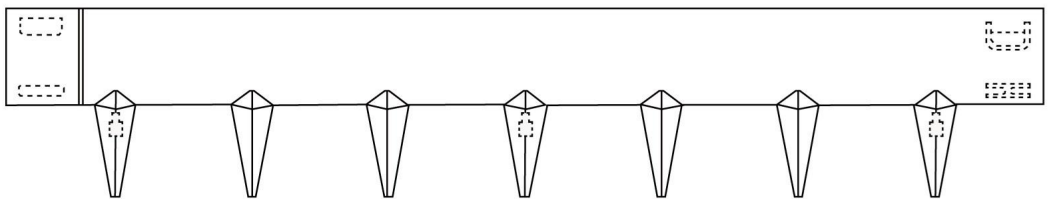
BY AGGREGATES INTERNATIONAL B.V.

TO INVALIDATE THE REGISTERED DESIGNS

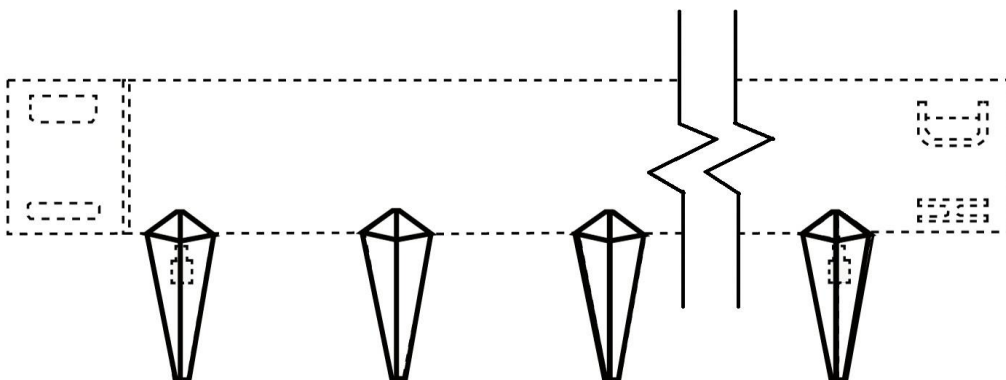
Basic facts and pleadings

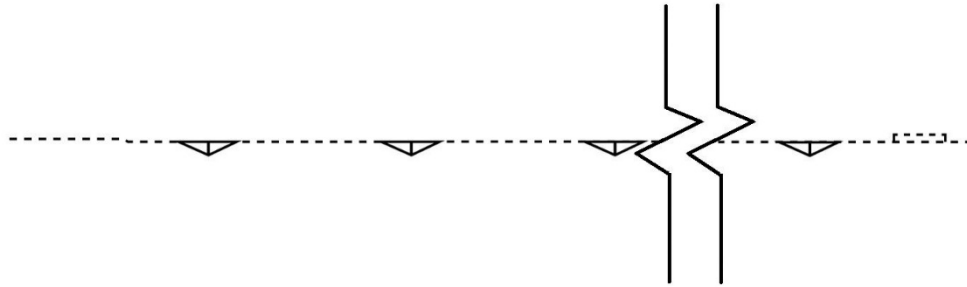
1. The registered designs the subject of these proceedings were filed by COREgravel UK Limited (“the proprietor”) on 15th February 2017. The designs were subsequently registered with effect from that date. The designs are depicted in the following representations.

6007308



6007309





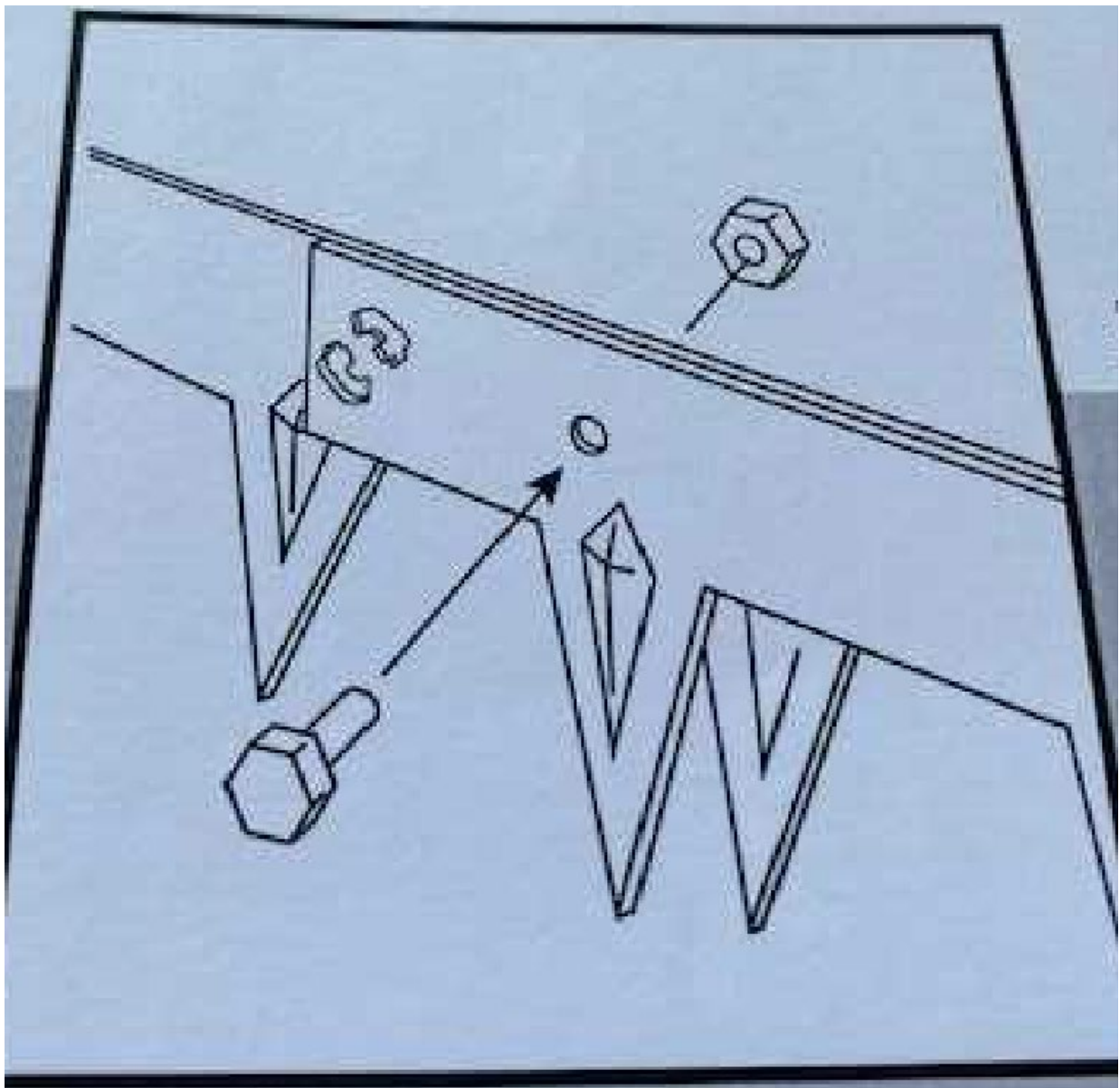
2. The application form confirms that the designs are for “*Garden edging.*” The same disclaimer was entered in respect of both designs; namely, “*No claim is made for the features shown in broken lines.*”

3. On 21st May 2019, Aggregates International B.V. (“the applicant”) applied for the registration of the designs to be declared invalid. There are two grounds for invalidation. Firstly, that the designs were not new and did not have individual character compared to previous designs made available to the public prior to the date on which they were applied for and registered. Secondly, that the designs consist of features of appearance of products which are solely dictated by their technical function. As regards the second ground for invalidation the applicant contends that:

- (i) Garden edging forms an edge between a lawn and another part of the garden and therefore must be rectangular in shape;
- (ii) In order for the edging to be used both for straight and curved edges, the product must have a flexible flat surface that can be bent to the desired shape;
- (iii) The joining mechanism shown in the registered designs is functional because it allows sections of edging to be easily interlocked by means of the alternating opening and locking elements depicted at each end of the designs.

4. The applicant therefore claims that registration of the designs was contrary to sections 1B and/or 1C(1) of the Registered Designs Act 1949 (as amended) (“the Act”) and should be declared invalid under section 11(ZA)(1)(b).

5. Attached to the application form were 11 attachments. Attachments 3 and 11 showed a garden edging product marketed by the applicant under the name ‘multi-edge’. Attachment 3 is undated. It looks like this on one side of the edging (the raised four-sided diamond shaped sections on the spikes are absent from the other side).



6. Attachment 11 consists of a copy of a webpage bearing the date 17th February 2017 (i.e. two days after the date of the applications for the registered designs). The webpage is from YouTube. The text on the webpage appears to be in the Dutch language. It is a promotional clip for the multi-edge product. The outline shape of the product (but not the detail of it) is visible on the webpage.

7. According to the applicant, its multi-edge product was available on the UK market at the date the applications were made for the registered designs.

8. Attachments 8 -10 relate to another garden edging product marketed by an English company called 'Ever Edge'. It looks like this.



9. The webpage from which this picture was taken indicates that it was posted by EverEdge on 17th December 2013 (i.e. over three years before the applications were made for the registered designs).

10. The proprietor filed a counterstatement denying the grounds for invalidation. I note the following:

- (i) The proprietor pointed out that the only picture with a date showing that an earlier design was made available to the public prior to the date of the registered designs, is the picture of the EverEdge product;
- (ii) There was no evidence that the applicant's own multi-edge product was made available to the public prior to the date of the registered designs;
- (iii) The proprietor claimed that the designer's freedom in developing a design of garden edger is not substantially limited, particularly with respect to its anchoring means or spikes;
- (iv) Whilst accepting that the spikes perform the technical function of anchoring the product in the ground, the proprietor claimed that this could be achieved in numerous ways, for example, the spikes could be pin-like, or curved in profile, or use parallel edges with a pointed tip, they could also be in planar rather than three-dimensional in form, or be planar with three dimensional objects added, or they could be indented with any number of patterns;
- (v) The proprietor pointed out that the spikes of the registered designs are angular, whereas the spikes of the EverEdge product are rounded;
- (vi) Further, each of the spikes in the registered designs have four defined panels, whereas the spikes of the EverEdge product comprise a single indentation with tapered sides and a curved top;
- (vii) Additionally, the tips of the spikes of the product depicted in the registered designs are flattened and therefore less pointed than the spikes of the EverEdge product;
- (viii) According to the applicant, these differences mean that the registered designs were new when they were registered and created a different overall impression to the design of the EverEdge product.

Representation

11. The applicant is represented by Koch Advocaten of the Netherlands. The proprietor is represented by Dolleymores, Patent and Trade Mark Attorneys.

Background to the application

12. It is apparent from the documents filed with the application that the proprietor considers the applicant's 'multi-edge' garden edging products infringe its UK and equivalent EU designs. It has asked the applicant to cease to market such products and reserved its right to issue proceedings if the applicant does not comply. These applications (and equivalent applications to the EUIPO to invalidate the EU registered designs) were filed in response to the proprietor's actions.

The evidence and the facts

13. Only the applicant filed evidence. The applicant's evidence consists of a witness statement (with five exhibits) by Jurgen Piessens, who is a director of the applicant. According to Mr Piessens, the 'multi-edge' garden edging product was on the market prior to the date of the applications for the registered designs. In support of this claim he provides two invoices dated 3rd August 2016 and 2nd November 2016. The first invoice is on the headed notepaper of Kranendonk B.V., which Mr Piessens says is a sister company of the applicant. The other invoice is from the applicant itself. Both invoices list 'multi-edge' products amongst those sold. The invoices appear to be in Dutch. The name and address of the customers have been completely redacted. Consequently, it is not possible to tell whether they were resident in the EU. However, I note that the prices of the products are shown in Euros.

14. As one would expect, the design of the multi-edge product is not apparent from just these invoices. The applicant therefore appears to rely on the attachments to the application for invalidation to illustrate what the multi-edge products referred to in the invoices looked like. In this connection, I note that:

- (i) The application form was signed by the applicant's Dutch lawyer and included a statement of truth;
- (ii) It therefore amounts to hearsay evidence;
- (iii) The proprietor filed no evidence in response to the applicant's evidence;

(iv) The proprietor does not appear to have disputed that the multi-edge products mentioned in the invoices were the same products shown in attachment 3 to the application.

15. In these circumstances I accept Mr Piessens' evidence establishes that the multi-edge products were made available to the public prior to the date of the registered designs. Further, given that the invoices are in Dutch and the prices are in Euros, I accept that these products were probably sold to customers in the EU.

16. There does not appear to be any dispute that the EverEdge product was made available to the public in the EU over three years prior to the date of the applications of the registered designs.

The designs at issue

17. It is apparent from the disclaimers entered in the register that the parts of the registered designs represented in dotted lines do not form part of the protected subject matter. Consequently, the fixing mechanisms identifiable in the designs are to be disregarded. Additionally, the rectangular section above the spikes, representing the garden edging itself, forms no part of the '309 design. It is shown merely to illustrate the position of the spikes in relation to the garden edging. It follows that the '308 design consists of the seven spikes shown in the representations of the design and the length of rectangular garden edging to which they are adjoined. The '309 design consists, essentially, of the spikes shown in the representation of that design in the position they are shown to be joined to (any) garden edging.

18. I also note that the representation of the '309 design includes two parallel vertical lines with a zig zag at the point they dissect the garden edging. This is a customary means of indicating that the design is of indeterminate length. It follows that neither the length of the garden edging, nor the number of spikes, are features of the '309 design.

19. It is clear from this analysis that the three dimensional spikes are the most important part of the '308 design. And the '309 design consists of little more than the three dimensional spikes shown in the representations of the design.

20. It follows that the elements of the designs used for joining lengths of garden edging together, as illustrated in broken lines in the representations of the designs, are irrelevant to the grounds for invalidation. Similarly, the rectangular-shaped garden edging shown in broken lines in the '309 design is also irrelevant, so far as that design is concerned.

The law

21. The relevant parts of the Registered Designs Act 1949 are shown below:

“11ZA Grounds for invalidity of registration

(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;

(c) -

(1A) -

(1B)-”

1B Requirement of novelty and individual character

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

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

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

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

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

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

(b)-

(6) –

(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.”

1C Designs dictated by their technical function

“(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.”

The ground for invalidation based on s.1C of the Act

22. The leading caselaw about this provision is *DOCERAM GmbH v CeramTec GmbH*¹. The Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) referred the following questions to the Court of Justice of the European Union (“CJEU”) for a preliminary ruling:

“(1) Are the features of appearance of a product solely dictated by its technical function, within the meaning of Article 8(1) of [Regulation No 6/2002] which excludes protection, also if the design effect is of no significance for the product design, but the (technical) functionality is the sole factor that dictates the design?”

“(2) If the Court answers Question 1 in the affirmative: From which point of view is it to be assessed whether the individual features of appearance of a product have been chosen solely on the basis of considerations of functionality? Is an “objective observer” required and, if so, how is such an observer to be defined?”

¹ CJEU, Case C-395/16

23. The court answered as follows:

“1. Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.

2. Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an ‘objective observer’.”

24. The court also provided the following guidance about which particular factors may be taken into account in determining whether the features of the appearance of a design are solely dictated by the product’s technical function:

“37. As the Advocate General stated in essence, in points 66 and 67 of his Opinion, such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.”

The ‘309 design

25. The applicant submits that spikes are functional.

26. The proprietor accepts that spikes serve a functional purpose; namely, anchoring the garden edging in the ground. However, it argues that such spikes could take many forms.

27. It is clear from the caselaw that the availability of alternative functional designs is not necessarily sufficient to defeat a claim based on s.1C of the Act. However, the availability of many different designs for the product is a factor which may be considered in deciding whether a particular design is solely dictated by its technical function.

28. It is obvious, even from the limited evidence before me, that garden spikes can take numerous forms, e.g. flat with a point, rounded with a point, or various three-dimensional forms. Additionally, as the proprietor points out, there appears to room to design spikes with parallel sides prior to the start of the point leading to the tip of the spike, and to vary the angles used to create the tip. There is also room to vary the shape of the top of the spikes where they meet the bottom of the edging. Additionally, there is also design freedom when it comes to determining the method through which the spikes are joined, or attached, to the edging they anchor. It is not, therefore, sufficient merely to point out that spikes *per se* are functional.

29. The applicant has filed no evidence (or arguments) going to any functional benefit that may be derived the particular three-dimensional spikes shown in the representations of the designs, i.e. spikes that:

- (a) Are diamond-like and therefore pointed at the top with a slightly flattened point at the base;
- (b) Have a flat surface on one side;
- (c) When looked at from above (or below), have a three-dimensional profile, like an isosceles triangle, on the opposite side;
- (d) Have a three-dimensional aspect on that side of the edging composed of four flat, essentially triangular, shapes, each sloping forwards from the edges of the diamond shape to where they meet at a central line extending down the length of the spike;
- (e) Have two top triangular sections sloping forwards from the top of the spike to a point about 20% down the length of the spike, adjacent to the bottom edge of the rectangular garden edging, and two lower triangular sections which slope inwards from that longitudinal point to where they come together at the base of the spike to form the tip.

30. Looking at the design of the spikes at issue, I can see that three-dimensional spikes are likely to be stronger, and therefore more resistant to bending when being driven into the ground, than thin flat spikes. However, this would apply to many three dimensional shapes. I could also speculate that spikes of the specific three-dimensional shape shown in the '309 design might provide better resistance to unwanted movement along the length of the garden edging than is likely to be achieved with spikes with flat surfaces. The design of the spikes at issue may also provide a useful alternative upward-facing surface (to the thin top lip of the garden edging) that could be used to drive the edging firmly into the ground without damaging the top of the edging. However, I do not consider that these possible benefits are sufficiently obvious, or certain, that I can base my decision on just my own observations/speculation. In my view, the applicant has not shown that the relevant features of appearance of the product depicted in the '309 design were chosen for, or serve, solely functional purposes. I therefore reject the ground for invalidation based on s.1C of the Act in relation to the '309 design.

The '308 design

31. I have no doubt that rectangular garden edging of the shape shown in the '308 design is dictated solely by the function of garden edging, which is to provide an unobtrusive, flexible barrier which can be submerged in the ground to prevent lawns spreading into flower beds etc. It is obvious why long and thin strips of material, just deep enough to prevent the spread of grass roots, are best suited to this purpose. The '308 design also includes the shape of the spikes shown in the representations of the design. Indeed the shape of the spikes appears to be an important feature of that design. For the reasons I have already given, I am not satisfied that the shape of the spikes is dictated solely by the product's technical function. Consequently, I also reject the ground for invalidation based on s.1C of the Act in relation to the '308 design.

The ground for invalidation based on s.1B of the Act

32. The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*². The most relevant parts are re-produced below.

“The informed user

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

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

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

ii) However, unlike the average consumer of trade mark law, he (or she) is particularly observant (PepsiCo paragraph 53);

iii) He (or she) 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 (or she) is interested in the products concerned and shows a relatively high degree of attention when he uses them (PepsiCo paragraph 59);

v) He (or she) conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain

² 2012] EWHC 1882 (Pat)

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).”

“Design freedom

40. In Grupo Promer the General Court addressed design freedom in paragraphs 67-70. In Dyson Arnold J. summarised that passage from Grupo Promer as follows:

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

“Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in Grupo Promer in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a

feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.”

“The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of “different overall impression” is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

The informed user

33. The informed user will be someone who tends their own garden or is employed to tend someone else's garden.

The prior art – the EverEdge design

34. The EverEdge design is shown at paragraph 8 above. It consists of a section of rectangular edging with integral spikes for anchoring it into the ground. The shape of the edging itself reflects its function: it is much longer in length than it is deep. The number of spikes is not clear from the evidence, but there are at least 5. The spikes are joined to the edging at a similar point to that shown in the registered designs, i.e. the top of the spikes overlaps the bottom line of the edging. However, the spikes appear to be round in profile with a partial dome-like top where they overlap the bottom of the edging.

Comparison with '308 design

35. The design of the garden edging itself looks very similar to that shown in the '308 design. However, the informed user will know that this is typical of garden edging. It is therefore a banal feature of the designs. There are seven spikes in the '308 design. It is not clear whether the EverEdge design has the same number of spikes. More importantly, the spikes in the EverEdge design look very different to the spikes in the '308 design. The informed user would immediately notice the differences between the design of the spikes. These differences are not, therefore, immaterial. Consequently, the '308 design is a new design as against the design of the EverEdge product. Moreover, given the relative importance of the spikes to the overall impression created by the two designs as wholes, I find that the '308 design would create a different overall impression on the relevant informed user than the EverEdge design. The '308 design therefore has individual character over the EverEdge design.

Comparison with the '309 design

36. As neither the shape of the edging itself, nor the length of the edging (and therefore the number of spikes) are features of the '309 design, the only things to be compared are the shapes of the spikes and the position at which they are joined to the edging. As I have already noted, the joining position is virtually the same.

However, the shape and design of the spikes is very different. The '309 design is therefore a new design as against the design of the EverEdge product. Moreover, given the relative importance of the spikes to the overall impression created by the two designs as wholes, I find that the '309 design would create a different overall impression on the relevant informed user than the EverEdge design. The '309 design therefore has individual character over the EverEdge design.

The prior art – the multi-edge design

37. The multi-edge design is shown at paragraph 5 above. It consists of a section of rectangular edging with 5 equally spaced integral spikes for anchoring it into the ground. The shape of the edging itself reflects its function: it is much longer in length than it is deep. The spikes are the same depth as the edging, and they form a piece with it. They are about twice as long as they are wide, and they come to a sharp point. Superimposed over each of the spikes is a raised four-sided diamond shaped addition. At the widest point of the diamond, this addition is adjacent to the bottom line of the edging itself.

Comparison with '308 design

38. The design of the garden edging itself looks very similar to that shown in the '308 design. However, the informed user will know that this is typical of garden edging. It is therefore a banal feature of the designs. There are seven spikes in the '308 design. There appear to be five spikes in the multi-edge design. More importantly, the spikes in the multi-edge design look different to the spikes in the '308 design. Apart from being spikes, the main similarity is that the diamond-shaped addition to one of the sides of the multi-edge design looks very similar to the design of the (same) whole side of the spikes in the '308 design. The main differences are that:

- (a) Apart from the diamond-shaped addition to one side, both sides of the spikes in the multi-edge design are flat;
- (b) The spikes in the multi-edge design appear to form a single piece with the edging, whereas the spikes in the '308 design appear (at least from one side) to protrude from, or to be joined to, the edging;

(c) The spikes in the '308 design are around three times as long as they are wide, and therefore appear longer and thinner than the spikes in the multi-edge design.

39. In my view, the informed user would immediately notice the differences between the designs of the spikes. The differences are not, therefore, immaterial. Consequently, the '308 design is a new design as against the design for the multi-edge product. I accept that it is quite possible that an informed user will notice that the design of the diamond-shaped addition to the multi-edge product is very similar to the design of the whole of one side of the spikes in the '308 design. However, the correct test under design law is whether the designs as wholes create the same overall impression on an informed user. I find that the differences between the designs as wholes means they will create different overall impressions. The '308 design therefore has individual character over the multi-edge design.

Comparison with the '309 design

40. As neither the shape of the edging itself, nor the length of the edging (and therefore the number of spikes) are features of the '309 design, the only things to be compared are the shapes of the spikes and the position at which they are joined to the edging. I have already set out the differences between the shapes of the spikes and the different ways in which they appear to be, on the one hand, an integral part of the edging or, on the other hand, protrude from, or be joined to, the edging. In my view, the informed user would immediately notice the differences between the designs for the spikes. The differences are not, therefore, immaterial. The '309 design is therefore a new design as against the design of the multi-edge product. Moreover, I find that the '309 design as a whole would create a different overall impression on the relevant informed user compared to the multi-edge design. The '309 design therefore has individual character over the multi-edge design.

41. I therefore reject the grounds for invalidation of the '308 and '309 designs based on s.1B of the Act.

Overall outcome

42. The applications for invalidation are rejected.

Observations

43. If I am right that the registered designs create a different overall impression to the multi-edge design, then it follows that the multi-edge product did not infringe the registered designs. If I am wrong about that, but right to find that the multi-edge product was made publicly available on the EU market prior to the date of the registered designs, then the designs are invalid.

Costs

44. The applications have failed. The proprietor is entitled to a contribution towards the costs incurred defending the designs. I assess these as follows:

£300 for considering the applications and filing counterstatements;

£200 for considering the applicant's evidence.

45. I order Aggregates International B.V. to pay COREgravel UK Limited the sum of £500. This to be paid within two months of the end of the period allowed for appeal.

Dated this 30th day of July 2020

Allan James

For the Registrar