

O/434/21

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

REGISTERED DESIGN NO. 6071816

OWNED BY WESTWOOD FOX LTD

AND

APPLICATION NO. 52/20 BY MUHAMMAD SAJID

TO INVALIDATE THE REGISTERED DESIGN

BACKGROUND AND PLEADINGS

1. The contested design which is the subject of the dispute was filed by Westwood Fox Ltd (“the proprietor”) on 21 September 2019. The contested design is for “motorbike gloves” and is depicted in the following representations:



2. On 4 December 2019, Muhammad Sajid (“the applicant”) applied for the registration of the design to be declared invalid.

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

“(1) The registration of a design may be declared invalid

(a) [...]

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

4. The applicant claims that the contested design does not fulfil the requirements of section 1B of the Act, which requires that a registered design be new and have individual character. In this regard, the applicant claims that the contested design “was listed long time ago on amazon for sale”. The applicant filed a number of documents with its application for invalidity, all intended to show that the contested design had been made available to the public prior to the relevant date. I will return to this evidence below.

5. The proprietor filed a counterstatement denying the grounds of invalidation. The proprietor states as follows:

“All of the designs attached in so-called proof (statement) are actually different designs. Some are slightly different & some are completely different but Different. Hence Westwood Fox ® have registered designs. [...]”

There were also two documents filed along with the proprietor’s counterstatement, which I shall refer to below.

6. Only the applicant filed evidence during the evidence rounds. Both parties are unrepresented. This decision is taken following a careful perusal of the papers.

EVIDENCE

Documents filed with the Application for Invalidity

7. As noted above, the applicant filed a number of documents with its Request to Invalidate a Design Registration. In particular, I note as follows:

a) Undated screenshots from Amazon.co.uk which display the following images:



The same identifying number B01M2C23XP appears in the domain name details for both screenshots. Another screenshot with the same identifying number confirms that the product has been available for sale since 1 November 2016.

- b) An undated screenshot from Amazon.co.uk which displays the following image under the identifying number B07H4GB7N7:



Another screenshot with the same identifying number confirms that the product has been available for sale since 4 September 2018.

- c) An undated screenshot from Amazon.co.uk which displays the following image under the identifying number B0190M646W:



Another screenshot with the same identifying number confirms that the product has been available for sale since 6 December 2015.

d) An undated screenshot from Amazon.co.uk which displays the following image under the identifying number B07DYRXWT4:



Another screenshot with the same identifying number confirms that the product has been available for sale since 1 December 2016.

e) An undated screenshot from Amazon.co.uk which displays the following image under the identifying number B07LQ4W7V:



Another screenshot under the same identifying number confirms that the product has been available for sale since 19 December 2018.

Documents filed with the Counterstatement

8. Similarly, the proprietor also filed two documents with its counterstatement. These were as follows:



The proprietor does not seem to have commented upon the relevance of these documents in its counterstatement. The documents are undated and no explanation is provided as to where these documents were obtained from.

The Applicant's Evidence in Chief

9. As noted above, the applicant also filed evidence during the evidence rounds in the form of his own witness statement dated 3 February 2021. In his statement, the applicant states:

“Design number 6071816 was Not new at time of registration. It was first available on amazon UK in 2016. Many sellers have been selling this since 2016. I witnessed myself on www.amazon.co.uk. Please see attached counter argument as Exhibit 1.”

10. The applicant’s evidence is accompanied by 1 exhibit. The exhibit goes into further detail as to why the applicant considers the contested design should be declared invalid. It states:

“The glove is almost same to many introduced on amazon in 2016. Top side is exactly same 100%. However, palm side has slight variations. All sellers have gloves with minor variations on palm.”

11. The applicant has put some examples side by side to demonstrate this point:

 <p>design Number .6071816 Registered in 21 September 2019</p>	 <p>ASIN: B01M8PPMBK Date First Available 1 Nov. 2016 Amazon UK</p>
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 <p>The only difference is hook and slight change in design of palm side layer.</p>	 <p>ASIN: B01M8PPMBK Date First Available 1 Nov. 2016 Amazon UK</p>

12. The applicant goes on to state:

“Registered design is almost same to one that was already available in the market.

Registered design is NOT creation of the West wood Fox Ltd.

Westwood Fox copied existing design, made minor changes to palm side and got it registered.

Gov.uk website clearly states that design must be new at time of registration.”

13. The applicant continues:

West wood fox got our ebay listing down for this glove. Here are pictures of my glove. My glove is similar to ones available on amazon and to West wood fox. Top side is same. Palm side is different to that of West wood and other brands.

Now westwood fox is saying that his product is new because it has different palm side. Same applies to my glove. But he still thinks that I have no right to sell my glove because he owns this design.

I mean what part of design he Owns? Top side or palm side

He is abusing design registration platform.

I have strong intentions to pursue for loss of revenue caused by West wood fox.

What is the policy

- Your listing was reported by WESTWOOD FOX LTD for violating their design rights. eBay's Verified Rights Owner (VeRO) programme offers intellectual property owner(s) a way to report listings that they believe infringe on their rights

- Offering a product that infringes on design rights is not allowed

- If you believe a mistake has been made, you will need to contact the rights owner directly. If the rights owner approves your appeal, please have them contact us directly to reinstate your listing(s)

You can send an email to:

infowestwoodfox@gmail.com



DECISION

14. 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.

...”

15. 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

16. The relevant date is the application date for the contested design i.e. 21 September 2019.

The Informed User

17. The contested design is for a pair of motorcycle gloves. The informed user is, therefore, a member of the general public who rides a motorcycle. The informed user is a knowledgeable, observant user, possessing the type of characteristics set out in the preceding case law.

Design Corpus

18. No evidence has been filed regarding the type, range or variety of motorcycle gloves that were available at the relevant date. However, I am prepared to take judicial notice of the fact that there is likely to have been a reasonable range of motorcycle

gloves (at least in terms of colour and surface decoration) on the market at the relevant date.

Design Freedom

19. In *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat), Arnold J (as he then was) stated at paragraph 34 that:

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

20. The designer of motorcycle gloves will, to some extent, be constrained as to the size of the product as it will have to fit comfortably onto the user’s hands without overly restricting movement. Similarly, there is likely to be some constraint as to material due to the need to provide adequate protection to the user and to ensure that there is adequate grip. However, even within those constraints, there is likely to be a significant amount of design freedom in terms of surface pattern, colour and material.

The Comparison

21. As noted above, a design will be considered new if “no identical design whose features differ only in immaterial details has been made available to the public before the relevant date” and it will be considered to have individual character if “the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date”. For the application to succeed, the contested design must not be new and/or must not have individual character, when compared with the prior art.

22. In order to be considered prior art, the designs relied upon will need to have been disclosed prior to the relevant date and must not be an excluded disclosure under section 1B(6). The designs relied upon were disclosed on 1 November 2016, 4

September 2018, 6 December 2015, 1 December 2016 and 19 December 2018 respectively. As the designs relied upon were published prior to the relevant date they can be considered prior art. They are not excluded disclosures.

23. Although the applicant has submitted multiple examples of prior art, there is only one that displays both sides of the glove. I will use this for the purposes of my comparison as it provides me with the fullest picture as to the nature of the designs already on the market. The designs to be compared are as follows:

The Prior Art	The Contested Design
	



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

- a) They share the same four oval structures at the base of each finger;
- b) They share the same oval cut out in the outer layer of the glove over the knuckles, which contains an indented stripe between each knuckle;
- c) They are black in colour;
- d) They share the same horizontal strip formed of a layer of differing material above the wrist section which is differentiated from the rest of the glove by stitching;
- e) They share the same horizontal wrist band, which is secured by a Velcro fastening at the underside;

- f) They share the same double stitched section half-way down each finger, although in slightly differing positions;
- g) They share the same curving differentiation between the material on the palm side of the fingers and the palm of the glove;
- h) Both designs have a horizontal line that extends part of the way across the centre of the palm.

25. However, they differ in the following ways:

- a) The prior art appears to include a small hook at the centre base of the glove on the palm side which is absent from the contested design;
- b) The material used on the palm and inside finger section of the designs appears to be slightly different in shade and texture;
- c) The shade of the oval cut out in the outer layer of the glove over the knuckles appears to be a slightly darker shade in the prior art than it is in the contested design;
- d) The indented strip between each knuckle appears to be accentuated by a line of stitching in the prior art which is absent from the contested design.

26. Clearly, there are some differences between the designs. Indeed, this is acknowledged by the applicant in his evidence. In my view, these differences are more than immaterial. Consequently, the claim that the contested design is not new fails. However, I must also consider whether these differences are enough to create a different overall impression. In *Samsung*, Birss HHJ set out the correct approach to the comparison in an infringement case. The same approach also applies to invalidity. At paragraph 58, he stated:

“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."

27. In my view, the marks share the same overall impression. The prior art uses the same colour, similar materials (although, in some parts of the glove, the materials appear reversed) and provides grip and protection in the same places and shapes. The stitching is very similar and both share the same horizontal strip across the palm, although they differ in length. They are both fastened in the same way and both have an oval cut out layer over the knuckles. I do not consider the differences identified above to be sufficient to create a different overall impression. Consequently, the contested design does not have individual character.

The remaining prior art

28. As noted above, there were other examples of prior art filed by the applicant. As I have found in favour of the applicant, I do not consider it necessary to make a finding in relation to these designs. However, the fact that only one side of the remaining prior art designs has been provided (the front side as opposed to the palm) would, in any event, have prevented me from finding in the applicant's favour. Clearly, it is possible for there to be differences between the gloves by virtue of the material and stitching used on the palm. I see no reason to find that the underside of the glove would play a lesser role in the overall impression of the design, given that it is likely to be visible when the item is purchased and when in use. Without being able to view the full designs, it would not be possible for me to undertake any meaningful comparison. Consequently, these would not have put the applicant in any stronger position.

CONCLUSION

29. Registered design no. 6071816 is declared invalid under section 11ZA(1)(b) of the Act.

COSTS

30. The applicant has been successful and is entitled to a contribution towards his costs. The applicant is unrepresented and has submitted a costs proforma outlining the number of hours spent in these proceedings.

31. The applicant has claimed the following:

Notice of Opposition	5 hours
Notice of Cancellation	5 hours
Notice of Defence	5 hours
Considering forms filed by the other side	2 hours
Looking on internet at government website	5 hours
Taking pictures and listing info	5 hours
Compiling information in a file	5 hours
Compiling file for counter arguments	5 hours

32. The applicant has claimed time for filing a Notice of Opposition and a Notice of Defence. However, neither was filed during these proceedings; the only form filed by the applicant was a DB19A. In my view, 5 hours is reasonable for preparing the necessary form and 2 hours is reasonable for considering the Form DB19B filed by the proprietor.

33. The activities of looking on the internet at the Government website, taking pictures and listing information, compiling information in a file and compiling a file for counter arguments I take to relate to the preparation of evidence. The evidence in chief filed in this case is limited, with the applicant's narrative evidence amounting to only 2 paragraphs, accompanied by 1 exhibit. In addition to this, a small number of

documents were filed with the Form DB19A. Consequently, I consider 10 hours to be a reasonable amount of time to have spent on the preparation and filing of evidence.

34. The applicant has also claimed £50 for the official fee. However, I note that the official fee is only £48.

35. Taking all of this into account, I consider the following to be reasonable:

Preparing and filing of Notice of Cancellation	5 hours
Considering the proprietor's Counterstatement	2 hours
Preparing and filing evidence	10 hours
Total	17 hours

36. In relation to the hours spent on these proceedings, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the applicant the sum of £323 (17 hours at £19 per hour) plus £48 official fee. **The total award is, therefore, £371.**

37. I hereby order Westwood Fox Ltd to pay Muhammad Sajid the sum of £371. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of June 2021

S WILSON

For the Registrar