



Recent Decisions in respect of UK and Community Design Cases

Update: February 2008

<p>October 2007</p> <p>Procter & Gamble Co v Reckitt Benckiser (UK) Ltd</p> <p>Court of Appeal [2007] EWCA Civ 936 Court of Appeal CA (Civ Div)</p>  <p>P&G design RB design “Febreze” “Air Wick”</p>	<p>In assessing the similarity between the two products, Jacobs LJ advised that according to Council Regulation (EC) No 6/2002, similarity must be judged from the viewpoint of the “informed user” who could be expected to take more time and care over such analysis, and who would be expected to hold a greater degree of knowledge of design issues than the average consumer. The standard of infringing similarity with respect to registered designs is lower than that of trade marks, and therefore the Court should look at the overall impression created by the registered design and the product alleged to have infringed. Additionally, the Court noted that the resulting impression does not need to be “clearly different” in order to determine that infringement has not occurred, and that the smallest differences between the designs will suffice to fulfil this criteria. The “informed user” should take into account where a designer has a limited choice in terms of product design to allow it to fulfil its function.</p> <p>In summary, the impression which would be given to the informed user by the Reckitt Benckiser "Air Wick" product was different from that of Procter and Gamble’s registered Febreze design. The similarities between the products were at too general a level for it to be fairly said that they would produce the same overall impression on the informed user, and therefore Procter & Gamble’s registered design had not been infringed.</p>
<p>August 2006</p> <p>Louise Block v Bath Aqua Glass</p> <p>UK Design Right</p> <p>UK Patent Office</p>  <p>Image 1</p>	<p>The claim having been referred by Bristol County Court to the Patent Office under Section 246 of the Copyright, Designs & Patents Act 1988, the claimant submitted an identification in as precise terms as possible as to what she claimed to be her original design. In this case, the claimant Ms Block claimed design right in the following terms: -</p> <p>“With reference to Annex 1, design right is claimed in the following particular aspects of shape or configuration of the Design, being an item of glass jewellery having:</p> <ol style="list-style-type: none"> a) a generally planar glass component that is substantially quadrilateral in shape having upper and lower major surfaces and at least a first set of opposed substantially parallel sides, the component being apportioned into at least two parts, each part: <ol style="list-style-type: none"> i) having different material properties such that in the visible light spectrum each part has a different colour from its adjacent part; and ii) is of a shape having a boundary with the or each adjoining part which is substantially straight, that segments the component substantially perpendicular to the two opposed parallel sides, and that connects said sides; and b) an attachment means for suspending the component from a chain or the like, the attachment means being located on and extending outwardly from a side of the component other than either of the two opposed parallel sides.” <p>A portion of Annex 1 referred to in the claim is shown left as Image 1.</p> <p>The articles in issue were items of glass jewellery which had a “stripy” effect, the stripes being of different colours, and there being usually at least two, and commonly three or more, stripes per article. The colours of the</p>

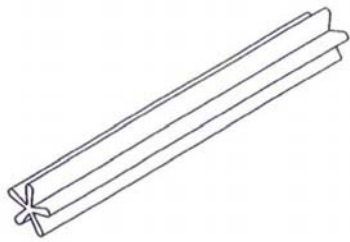
	<p>stripes, and their number could be varied, but the stripes were always horizontal with respect to the overall article, when hanging from a chain.</p> <p>Bath Aqua Glass Limited alleged that the design was both commonplace, and that it fitted into various of the exceptions to design right, such as being a method or principle of construction, surface decoration, or fitting into the “must fit”, or “must match” exceptions. The defendants were unable to prove that the design was commonplace, and neither did the Hearing Officer agree that the pleaded exceptions applied.</p> <p>Of more general interest, however, was the Hearing Officer’s finding with respect to the <i>Lambretta</i> decision discussed above that in fact the use of different colours to define the design right was acceptable. The issue of <i>Lambretta</i> was in fact raised by the Hearing Officer at the hearing, rather than by the defendants. Nevertheless, the claimant sought to distinguish her jewellery items from <i>Lambretta</i> by arguing that the features of shape and configuration of the jewellery items in issue went further than just mere colour of a known article.</p> <p>The Hearing Office, after considering <i>Lambretta</i> very carefully, came to the conclusion that the present case was distinguished from <i>Lambretta</i> as the jewellery forming the basis of the case did not include a “mere” choice of colour-ways. Instead, giving the word “configuration” its ordinary meaning in the context of this jewellery, the Hearing Officer decided that the juxta-position of two (or more) differently coloured transparent parts was in his view quite properly to be treated as an aspect of the configuration. Furthermore, the claim to design right did not specify any specific colours, but merely required the colours to be different. However, the Hearing Officer did note that he was reluctant to make much of this latter distinction because such a situation was not considered by the Court in <i>Lambretta</i>.</p> <p>For a fuller treatment of this case see the article at http://www.withersrogers.co.uk/content/view/88/45/</p>
<p>August 2006</p> <p>Mars UK Limited v Paragon Products BV</p> <p>Community Design Invalidation</p> <p>Dog chew products</p>  <p>Image 1</p>	<p>Paragon had registered the community design as shown in Image 1 under no. 000196167-0003 in relation to “animal foodstuffs”.</p> <p>Mars filed an application for invalidity on 5 August 2005 citing their earlier Benelux, UK and German design registrations for the following product, as well as photos of packaging and get-ups relating to dog chew products, as shown in image 2.</p> <p>Mars argued that the informed user would view Paragon’s design as being very similar overall to their prior designs as both products were elongated dog chew products with multiple prongs or arms. They argued that the overall size and proportions of the two designs were essentially identical and that although there were minor differences between the two designs, the overall impression produced on the informed user was the same. Mars argued therefore that the design lacked individual character in light of its earlier designs.</p> <p>Paragon argued that the shape of their product was different in that it constituted a star shape whilst the earlier designs formed an x-shape. They claimed that their design did therefore have novelty and individual character.</p> <p>The decision held that the design was valid for the following reasons:</p> <ol style="list-style-type: none"> 1. the designs differed in overall shape as one was a 5 pronged star design and the others were 4 pronged x-shaped designs;



Image 2

2. this difference is not immaterial and therefore Paragon's design was not identical to the earlier designs; accordingly the design did have novelty and individual character.

**August 2006
Honda Motor Co., Ltd v
Wuxi Kipor Power Co.,
Ltd**

**Community Design
Invalidity**



Image 1



Image 2

Wuxi was the owner of registered design no. 000171178-0005 as shown in relation to "inverter generators". (Image 1)

Honda filed an application for declaration of invalidity on the grounds that it lacked novelty and individual character. In particular, as part of their evidence, they produced a catalogue showing their model generator as seen in Image 2.

Honda alleged that the characteristic features of the designs were their approximately cuboid shape and the flattened section formed on the upper corners. In addition they alleged that there was a clear division into sections of bright and dark colouring which gave their design individual character and which appeared also on Wuxi's design. Honda argued that any minor differences were not sufficient to give Wuxi's design "an impression diverging from their generators".

Wuxi did not file any evidence in reply.

The decision held that Wuxi's design did not lack novelty on the basis that Honda's design was mounted on wheels and the upper corners of their design were slanted rather than rounded as in the case of the Wuxi design. The designs were therefore not identical and Honda's design did not form a bar to novelty of Wuxi's design.

However, the design was invalid on the grounds that it lacked individual character due to the fact that the characteristic features of Wuxi's design were all present in Honda's design - in particular both had housing of cubic form with black panels enclosing a central portion; the variation in the shape of the corners and the mounting did not alter the fact that the overall impression produced by both designs was the same.