

O-431-13

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

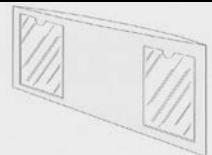
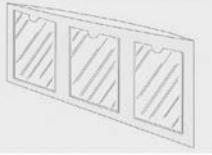
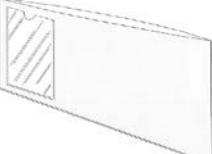
**IN THE MATTER OF REGISTERED DESIGN NOs:
4018454, 4018455, 4026498 & 4019846
IN THE NAME OF REGISTERED DESIGNS LIMITED**

AND

**A REQUEST TO INVALIDATE (NO. 28/12, 29/12, 30/12 & 31/12)
BY DARREN GRAHAM**

The background and the pleadings

1) The four registered designs the subject of these proceedings stand in the name of Registered Designs Limited ("RDL"). They consist of designs for driving license wallets. The details of the designs are set out below:

Design no.	Representation	Date of filing
4018454		20/1/2011
4018455		20/1/2011
4026498		27/9/2012
4019846		3/5/2011

2) Mr Darren Graham has requested that the above designs be declared invalid. There are two grounds in play. Firstly, invalidation is sought on the basis of section 1B(1) of the Registered Designs Act 1949 ("the Act"), which relates to the requirement that designs must be novel in comparison to others that have been made available to the public. The prior art which, it is claimed, destroys the novelty of the designs is based upon:

- A plastic driving licence wallet that is claimed to have been issued by the Driver and Vehicle Licensing Agency ("DVLA") and Driver and Vehicle Licensing Northern Ireland ("DVLNI") in 1999. Letters (which I discuss in more detail later) have been provided from these agencies.
- Earlier designs (one of which have been invalidated) in the name of RDL.

3) The second ground is under section 1C(1) of the Act. The claim is based upon the designs subsisting in features of appearance which are solely dictated by technical function. The claim is made on the basis that the designs have been produced to meet the technical requirements of the Community Model Driving Licence, the requirements for which are set out in European Communities

Council Directive 91/439/EEC of 29 July 1991 ("the Directive"). For sake of completeness, I should add that a further ground was initially pleaded under section 11ZA(1A) of the Act. This section can only be relied upon by the owner of an earlier registered design (but which was published after the registered design being attacked). The claim was made on the basis of designs in the name of RDL or persons connected with it. The ground was struck out because Mr Graham was not the owner of the designs relied upon so he has no standing to apply for invalidation under this part of the Act.

- 4) RDL filed counterstatements denying the claims. The counterstatements were made by Mr Adnaan Solomon who states that the claims are invalid and have no relevance. It is stated that DVLA (or any other agency) has not instructed Mr Graham to act on its behalf. He asks Mr Graham to disclose where he obtained the sample wallet he included with his statement of case. Mr Solomon states that he will be asking DVLA to elaborate on the response it made to Mr Graham.
- 5) The cases were consolidated. Only Mr Graham filed evidence. Neither side requested a hearing. A decision is therefore made after duly considering all of the material on file.

The novelty ground

The legal background

- 6) Section 1B of the Act reads:

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

- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
 - (b) the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
- (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
 - (b) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);
 - (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
 - (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
 - (e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.
- (7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
 - (b) to the extent that those visible features of the component part are in themselves new and have individual character.
- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

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

- a) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.
- b) In terms of design freedom, this may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.
- c) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.
- d) In terms of overall impression, Mr Justice Arnold stated:

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

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

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

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

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

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

and

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

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

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

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

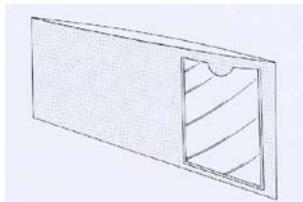
- 10) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user of driving license wallets and will possess those characteristics (knowledge/experience) set out in the preceding case-law.

The prior art

- 11) The first task of the tribunal is to consider the claimed prior art and the evidence relating to it. The purpose of this is to ascertain what has been disclosed to the public and when.

Prior art 1 (consisting of earlier registered design 3015045)

- 12) This prior art is relied upon to invalidate all of the designs the subject of the proceedings. The prior art consists of the following design:

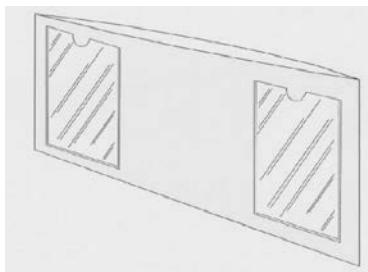


- 13) The design was filed on 5 November 2003 and its certificate of registration was granted on 20 January 2004. Given these dates, the design would have been published in the Designs Journal before 20 January 2004. Publication in the Designs Journal undoubtedly counts as making available to the public, indeed, the primary purpose of the journal is to inform designers and the users of designs what designs are being registered. The design has, therefore, been made

available to the public well before the relevant dates (which correspond to the dates of filing) of the four designs the subject of the proceedings. It does not matter that RDL were the proprietors of the prior art. A disclosure by the proprietor can count against itself. There are, though, certain safeguards against self disclosure as contained in sections 1B(6)(c) - (e) of the Act, but these relate to disclosures which have taken place in the 12 months preceding the relevant date. This is not the case with the prior art under discussion. **Prior art 1 may be taken into account to assess the novelty of all four designs the subject of the proceedings.**

Prior art 2 (consisting of earlier registered design 4018454)

14) This prior art is relied upon to invalidate designs 4018455, 4019846 & 4026498. The prior art consists of the following design:

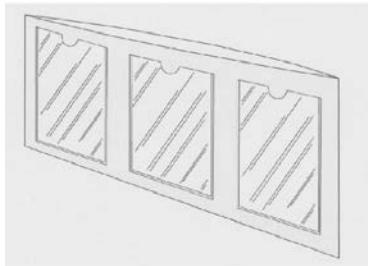


15) The design was filed on 20 January 2011 and its certificate of registration was granted on 11 February 2011. Given these dates, the design would have been published in the Designs Journal (which I have already said constitutes an act of making available to the public) after 20 January 2011, but before 11 February 2011; this has a number of consequences:

- i) The prior art **cannot** be relied upon to invalidate 4018455 as the relevant date for this design is 20 January 2011 and, thus, the prior art was not published **before** the relevant date.
- ii) The prior art **cannot** be relied upon to invalidate 4019846 as the relevant date for this design is 3 May 2011, which means that the disclosure fell within the period of 12 months preceding the relevant date. As already stated, self disclosure, or disclosures that have resulted from the acts of the proprietor, do not count within this period.
- iii) The prior art **can** be relied upon to invalidate 4026498 as the relevant date for this design is 27 September 2012, which means that the disclosure took place before the relevant date and also before the 12 month period preceding the relevant date.

Prior art 3 (consisting of earlier registered design 4018455)

16) This prior art is relied upon to invalidate designs 4019846 & 4026498. The prior art consists of the following design:

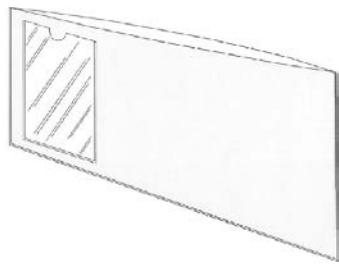


17) The design was filed on 20 January 2011 and its certificate of registration was granted on 11 February 2011. Given these dates, the design would have been published in the Designs Journal (which I have already said constitutes an act of making available to the public) after 20 January 2011, but before 11 February 2011. This has two consequences:

- i) The prior art **cannot** be relied upon to invalidate 4019846 as the relevant date for this design is 3 May 2011, which means that the disclosure fell within the period of 12 months preceding the relevant date.
- ii) The prior art **can** be relied upon to invalidate 4026498 as the relevant date for this design is 27 September 2012, which means that the disclosure took place before the relevant date and also before the 12 month period preceding the relevant date.

Prior art 4 (consisting of earlier registered design 4019846)

18) This prior art is relied upon to invalidate design 4026498 only. The prior art consists of the following design:



19) The design was filed on 3 May 2011 and its certificate of registration was granted on 17 May 2011. Given these dates, the design would have been published in the Designs Journal (which I have already said constitutes an act of making available to the public) after 3 May 2011, but before 17 May 2011. This has the consequence that:

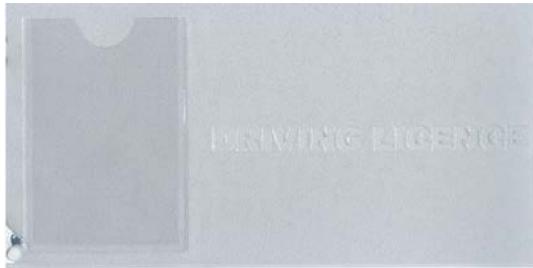
- i) The prior art **can** be relied upon to invalidate 4026498 as the relevant date for this design is 27 September 2012, which means that the disclosure took place before the relevant date and also before the 12 month period preceding the relevant date.

Prior art 5 – the DVLA/DVLNI wallet

20) A claim is made on the basis of wallets which Mr Graham states were issued by the DVLA and the DVLNI (or the linked Drivers and Vehicle Agency Northern Ireland ("DVANI")). In his statement of case (which counts as evidence in these proceedings¹) Mr Graham states:

"I enclose a Plastic Driving Licence cover/wallet at Appendix – A1 (Pg. 10), of the type issued by [DVLA] in Swansea.... and also of the type issue by [DVANI] from 1999 until 2002 for DVLA, from 1999 and 2007 for DVANI"

21) The sample he provides is depicted below:



22) Mr Graham goes on to explain why the above design was produced in the form above, namely, to provide customers with a wallet to hold the new [at that time] style driving licences following the implementation of the directive. The wallets were designed to hold both the photocard part of the licence and the paper counterpart. The paper counterpart was folded by both authorities to "DL" size which I assume is represented by the above outline shape. Mr Graham also provides the following appendices:

- A5 – An email response from DVLA to Mr Graham dated 8 December 2011. The email from Mr Graham which generated the response is not provided. DVLA (through L Hodgetts of the Customer Enquiries Group) states that DVLA provided plastic wallets for photocard driving licences from their launch in 1998 until April 2002. Prior to this plastic wallets for old paper licenses were issued. DVLA no longer supply plastic wallets and cannot advise if they are still available.

¹ See rule 21(1)(a) of the Registered Designs Rules 2006

- A6 – This consists of a letter sent by Mr Graham to DVLA (on 5 October 2012) and DVLA's response (on 17 October 2012). Mr Graham's letter is written on (what I assume is) a pretence of him undertaking some research for an environmental conservation project. He writes that he is aware that DVLA used to issue plastic driving licence wallets with the European style licences but they no longer do so. He then asks the following questions:
 - 1) Can you confirm if the attached scan is the type of plastic wallet that you used to issue? Please stamp and/or sign & date the scan to confirm this.
 - 2) If it isn't the same type, can you provide an example of the type of wallet that was issued?
 - 3) How long were they issued to the public?
 - 4) From what date and until when were they issued?
 - 5) Who was your supplier for these wallets?

The scan he attaches to his letter is depicted below:



The response from DVLA (from Mr Emma Davies, an administrative assistant in CCU Drivers Business Support) states:

"I can confirm the photo you attached to your letter is indeed the type of wallet that was issued with photocard licences.

Plastic wallets were issued with licences from 1976, but the style you are referring to were issued when photocard licences were introduced in 1999. DVLA ceased to issue wallets in April 2002.

In line with our document retention policy, we no longer retain information on the suppliers or the costs involved with these wallets."

- A7 - A similar exchange with DVANI also took place, under the same pretence (although Mr Graham uses the name of Andrew Cooper on this occasion) supplying the same scan. DVANI (Liam Downey of the Licensing Enquiry Team 2) responds:

"I can confirm that the enclosed scanned picture is a plastic wallet, once issued by DVA. These were first issued along with licences in 1999. The Department stopped issuing them in May 2007."

The scan was signed, dated and returned.

23) Mr Graham also refers to McIvor Plastics of Londonderry who he says supplied plastic wallets to DVANI of the type in Appendix A1. He approached this company with the same pretence but he got no response as the company did not wish to breach customer confidentiality and so could not supply any information. They did, though, subsequently agree to provide wallets of the Appendix A1 type and a quotation is provided in evidence. Mr Graham also provides the insert to the wallets that were issued by DVANI which highlights that "the enclosed plastic wallet" is for both parts of the licence.

24) Further evidence was filed by Mr Graham showing that Mr Adnaan is involved with various companies (including RDL and a company called Klayzer) which continues to sell wallets made to the various designs including ones made to the original DVLA design. Mr Graham states that he was asked by EBay to remove a listing because it breached Mr Adnaan/RDL's design registration(s). He also provides prints of various "threads" from message boards referring to plastic wallets being issued by DVLA (although the wallets themselves are not depicted). Also highlighted is that Mr Adnaan is referred to on a website as owning the original DVLA design (although, again, the actual design being referred to is not depicted). I do not consider it necessary to summarise this further evidence in any greater detail.

25) In a previous decision in relation to one of RDL's designs (no. 3015045 - BL O/288/12), I rejected a request for invalidation on the basis that the prior art there had not been established. As in this case, a letter was provided from DVLA. I commented as follows:

"8) In his counterstatement, Mr Solomon makes a number of valid criticisms about Mr Saville

"s evidence, the

letter from DVLA fails to set forth any particular design that was made available to the public, nor is the "advertisement" sent to DVLA by Mr Saville depicted from which Ms Clark makes her statement that the DVLA one was similar. In any event, even if the tribunal knew what she had seen, this, without a representation of the DVLA licence holder, would have told me little as it is the job of the tribunal to consider the similarities and differences between various designs and to then decide whether the registered design is new and/or has individual character. There is no real commentary in Mr Saville

~~is evidence beyond that s~~

no explanation about the scans/photos. If they are meant to be the DVLA licence holders then not only should this have been made explicit, but the evidence should have clearly tied the designs to the public disclosure by

DVLA. Ms Clark "s letter, being furthermore, hearsay evidence; this does not improve matters for Mr Saville. **My finding is that Mr Saville's evidence fails to establish that the scans/photos were publically disclosed before the relevant date. Mr Saville provides no other prior art.**"

26) However, in the case before me Mr Graham has been more forthright in his commentary, stating that the design he has provided in his evidence is the original one issued by DVLA/DVANI, he has explained why the design is configured as it is, and the letters from DVLA/DVANI (even though they are still hearsay) are more certain that the design they were shown (what they are shown is also depicted) is the type of wallet that was issued. **On the basis of the evidence before the tribunal, I am prepared to accept that the sample provided represents the original DVLA/DVLNI design that was made available to the public in 1999. It can be relied upon as prior art in these proceedings in respect of all the designs the subject of this dispute. It is also borne in mind that whilst Mr Solomon denied the claims in his counterstatement, he has provided no evidence himself. Mr Graham's evidence is to be believed.**

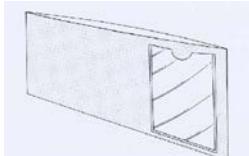
Comparison of designs

27) I will go through the designs one by one.

Registered design 4026498



28) The two closest forms of prior art that may be relied upon are 3015045:



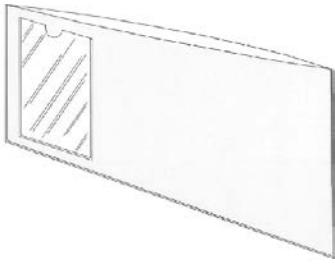
and the DVLA/DVANI wallet:



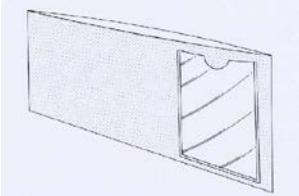
29) I consider that both designs destroy the novelty of the registered design. In respect of prior art 3015045, both this and the registered design are oblong wallets with a space to put something inside (the actuality is that the space is for the paper counterpart of a driving licence) and both have a further slot of narrower proportions on the outside (right hand side) of the wallet for a further item (the actuality is that this is for the photocard part of the licence). The configuration and shape is identical. If they are not identical then my eye has failed to spot any difference. The only difference between the designs is that the registered design has the words DRIVING LICENCE on it and some other (smaller) writing in the bottom left, whereas design 3015045 has no writing at all. This is immaterial given that designs are not protected with regards to any wording they may contain and it is not as if the words are forms of ornamentation that could otherwise be taken to contribute to the novelty of the registered design. The comparison is, therefore, between the shape and configuration of the designs which are identical. **The designs are considered identical and, thus, the registered design is not new.**

30) In relation to the conflict with the DVLA/DVANI wallet, the only difference is that the slot for the photocard has been moved from the right to the left. This is, in my view, immaterial. The registered design is not new. Even if the difference is not immaterial, the overall impression does not differ even though the slot has been moved to the opposite side. The overall impression of the oblong outer shape with an identically proportioned and shaped slot on one side remains the same. **The claim also succeeds on the basis of this prior art.**

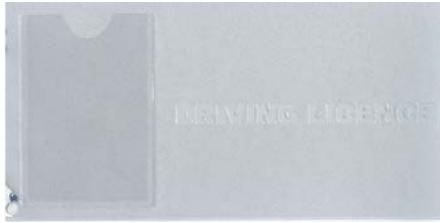
Registered design 4019846



The two forms of prior art that may be relied upon are design 3015045:

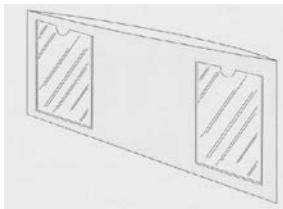


and the DVLA/DVANI wallet:

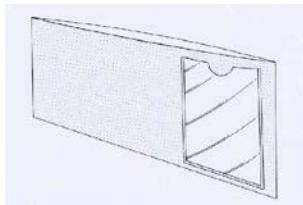


31) By parity of reasoning with my decision in relation to 4026498, the claim succeeds. The DVLA/DVANI design is identical save for the addition of the words DRIVING LICENCE. The only difference between the registered design and prior art 3015045 is the swapping of the slot from the left hand side to the right hand side. **The claim succeeds in relation to this registered design – there is no need to consider the other prior art.**

Registered design 4018454



The two forms of prior art that may be relied upon are design 3015045:

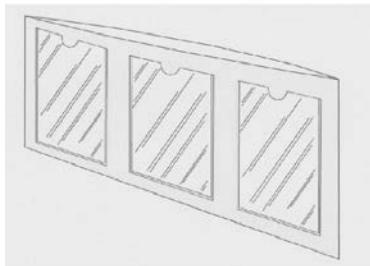


and the DVLA/DVANI wallet:

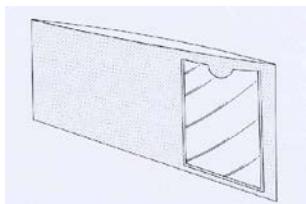


32) The main difference here (in comparison to both forms of prior art) is that whilst the outline shape of the wallet is the same and that it has a space for a document such as the paper counterpart, there is an additional slot on the opposite side of the first slot, i.e. the registered design has two slots as opposed to one on the prior art(s). Although the extra slot is no doubt functional, a point I will come to later, the informed user will clearly notice this difference and it will impact upon the overall impression taken. I consider this to be sufficient to create a different overall impression when such a simplistic design is considered. The design is novel and the claim under section 1B of the Act fails.

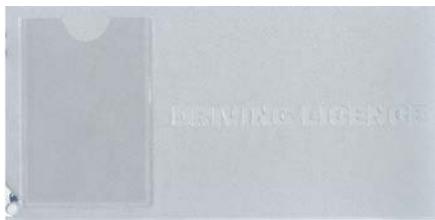
Registered design 4018454



The two forms of prior art that may be relied upon are design 3015045:



and the DVLA/DVANI wallet:



33) The analysis is similar to the above, albeit that there are now three slots as opposed to one. By parity of reasoning with my previous finding, the above is sufficient to create a difference in overall impression. **The design is novel and the claim under section 1B of the Act fails.**

The technical function ground

34) The relevant legislation reads:

“1C Designs dictated by their technical function

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

35) In the *Dyson* case Mr Justice Arnold undertook a thorough review of the relevant case-law:

“23 Article 7(1) of the Designs Directive excludes from protection “features of appearance ... which are solely dictated by its technical function”. The parties were divided as to the correct interpretation of this provision.

24 Counsel for Dyson relied upon the decision of the Court of Appeal in *Landor & Hawa International Ltd v Azure Ltd [2007] F.S.R. 9, CA*. That case concerned a claim for infringement of unregistered Community design right under the Community Designs Regulation (and a parallel claim for infringement of domestic unregistered design right) in certain features of a design for a suitcase. The defendant contended, *inter alia*, that those features were excluded from protection by art.8(1) of the Community Designs Regulation , which corresponds to art.7(1) of the Designs Directive

25 At first instance H.H. Judge Fysh QC sitting in the Patents County Court rejected this contention for reasons he expressed as follows:

“The question is therefore: is the *appearance* of Landor’s design *solely dictated* (i.e. driven without option) by the technical function? In my view, the answer is ‘no’. I say this because of the spatial position of the constituent elements (big piping/zip/normal piping/zip/big piping) and by the presence of the piping elements themselves which introduce an essentially non-functional and even capricious element to the final appearance of the ensemble.”

26 In the Court of Appeal the defendant attacked this conclusion on the grounds that (i) the judge had been wrong to construe art.8(1) so narrowly and (ii) the features in question were purely functional.

27 So far as the construction of art.8(1) was concerned, the defendant argued that the judge ought to have held that “dictated solely by function” meant “attributable to function”, so that if more than one shape could perform the same function then all such shapes were excluded from protection. In support of this argument the defendant relied upon the decision of the Court of Justice of the European Communities (as it then was) in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd (C-299/99) [2002] E.C.R. I-5475; [2003] R.P.C. 2 at [78]–[79]* interpreting art.3(1)(e) of Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks (“the Trade Marks Directive”) and on the decision of the House of Lords in *Amp Inc v Utilux Pty Ltd [1971] F.S.R. 572; [1972] R.P.C. 103* interpreting s.1(3) of the 1949 Act as it then stood.

28 Neuberger L.J. (as he then was), with whom May and Wilson L.J.J. agreed, held that neither of these decisions could safely be relied on in order to interpret art.8(1) and noted the comment of Advocate General Colomer in his opinion in the former case at [34] that the wording used in art.7(1) of the Designs Directive was narrower than that in art.3(1)(e) of the Trade Marks Directive . Neuberger L.J. also said at [38]:

“The judge’s conclusion as to the ambit of art.8.1 is consistent with the views expressed by the editors of Copinger and Skone James at para.13-208. It is true that it is there said that it is not clear whether the exclusion in Art.8.1 ‘will only apply to a design that is the only design by which the product in question could perform its function or whether it operates whenever a design was as a matter of fact dictated solely by the function of the product even though it was not the only design that was capable of allowing that function to be performed’. However, the editors go on to ‘submit … that the former (narrower) construction of Article 8.1 is the correct one’. They draw support, rightly in my view, from recital (10) of the Designs Directive , which, they suggest, show that ‘the technical function exclusion was intended to be construed narrowly and that it should be construed in a way that does not unduly restrict the availability of protection for non-aesthetic (i.e. functional) designs’.”

29 Counsel for Dyson submitted, and I accept, that it is clear that the Court of Appeal endorsed the judge’s construction of art.8(1) . Counsel for Vax, however, drew attention to what Neuberger L.J. went on to say (emphasis added):

- “40 Azure nonetheless contends that the judge should have rejected *Landor*’s case for EUUDR on the facts, namely on the basis that the Expander Design was purely functional. Apart from the fact that this is (either precisely or nearly) same argument on the facts as failed in relation to Landor’s UKUDR claim, it is inconsistent with what the judge’s findings in [42], quoted above. In that paragraph, which was directed to the EUUDR claim, the judge found that it was design with non-functional (and as the judge put it ‘capricious’) aspects.
- 41 It seems to me that this clearly disposes of the argument that the ‘features of appearance’ of the Expander Design in this case were ‘dictated solely by its technical function’. *Even if ‘solely’ is not given the limiting meaning which the judge held*, then, as I see it, the inclusion of the word in Art.8.1 nonetheless would render it difficult for Azure to contend that the design in the present case is caught by the Article, because the design has been found by the judge, in circumstances where this was open to him, to be in part ‘capricious’.”

Counsel for Vax submitted, and I agree, that it followed that the Court of Appeal's decision as to the interpretation of art.8(1) was strictly obiter.

30 For his part, counsel for Vax relied on the decision of the Third Board of Appeal of OHIM in Case R 690/2007-3 *Lindner Recyclingtech GmbH v Franssons Verkstäder AB* (R 690/2007-3) [2010] E.C.D.R. 1, *Third Board of Appeal, OHIM*. In that case the Board, whose rapporteur was David Keeling, considered the interpretation of art.8(1) of the Community Designs Regulation in a passage which merits quotation in full despite its length:

"28. The interpretation of art.8(1) CDR (and of the corresponding provision in art.7(1) of Council Directive 98/71 on the legal protection of designs [1998] OJ L289/28) is highly controversial. Similar provisions existed in the designs legislation of several Member States prior to harmonisation of the law by Directive 98/71 . The assumption has generally been made that the purpose of such provisions is to prevent design rights from being used to obtain monopolies over technical solutions without meeting the relatively stringent conditions laid down in patent law. Two contrasting views have been canvassed in the legal literature. One view holds that a technical necessity exception, such as that contained in art.8(1) CDR applies only if the technical function cannot be achieved by any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That Theory - known as the multiplicity-of-forms theory - is defended by some German authors (see, for example, P. Schramm, *Der europaweite Schutz des Produktdesigns* (Baden-Baden: Nomos Verlagsgesellschaft, 2005), pp.242 et seq., and U. Ruhl, *Gemeinschaftsgeschmacksmuster: Kommentar* (Köln-Berlin-München: Carl Heymanns Verlag, 2007), pp.169 et seq.) and was formerly followed by the French courts (see, D. Cohen, *Le droit des dessins et modèles*, 2nd edn, (Paris: Economica, 2004), p.22). Advocate General Ruiz-Jarabo suggested in *Koninklijke Philips Electronics* [2003] R.P.C. 2 at [34] of the Opinion) that art.7(1) of the Designs Directive (and therefore obviously art.8(1) CDR) should be interpreted in that manner. He stated:

'... a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.'

The Advocate General's comment is clearly an obiter dictum since *Koninklijke Philips Electronics* was a case on the interpretation of art.3(1)(e) of Council Directive 89/104 to approximate the laws of

the Member States relating to trade marks ([1989] OJ L40/1) (TMD). Article 3(1)(e) TMD excludes from trade mark protection, ‘signs which consist exclusively of the shape of goods which is necessary to obtain a technical result’.

29 The multiplicity-of-forms theory has been adopted by courts in the United Kingdom (see the judgment of July 28, 2006 of the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285; [2006] E.C.D.R. 31) and Spain (Juzgado de 10 Mercantil PTO Numero Uno de Alicante, Auto No.267/07 Silverlit Toys Manufactory Ltd v Ditro Ocio 2000 SL, Unreported, November 20, 2007 .

30 There is nonetheless a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product’s appearance is not ‘solely dictated by its function’ simply because an alternative product configuration could achieve the same function, art.8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated. That purpose, as was noted above, is to prevent design law from being used to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with. If a technical solution can be achieved by two alternative methods, neither solution is, according to the multiplicity-of-forms theory, solely dictated by the function of the product in question. This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function (see W. Cornish and D. Llewelyn, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, 5th edn, (London: Sweet & Maxwell, 2003), p.549). This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.

31 The principal alternative, discussed by academic authors, to the multiplicity-of-forms theory has its origin in English case law. The case of *Amp Inc v Utilux Pty Ltd* [1971] F.S.R. 572 concerned the interpretation of a provision of the Registered Designs Act 1949 which denied protection to the features of a design that were solely dictated by a product’s technical function. The House of Lords held that a product’s configuration was solely dictated by its technical function if every feature of the design was determined by technical considerations. The striking similarity between s.1 (3) of the 1949 Act and art.8(1) CDR does not of course mean that the approach of

the House of Lords in *Amp [1971] F.S.R. 572* must necessarily be adopted in relation to the Community provision. Indeed, as was noted above in [29], the multiplicity-of-forms theory has now been adopted by the English Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd*. Thus the Court of Appeal must have thought that the approach taken in *Amp [1971] F.S.R. 572* was no longer valid, following harmonisation, in spite of the similar wording of the Community provisions and the 1949 Act. The approach taken in *Amp* would, however, have the advantage of allowing the purpose of art.8(1) CDR to be achieved. No-one would be able to shut out competitors by registering as Community designs the handful of possible configurations that would allow the technical function to be realised. This may explain why the French courts, which formerly espoused the multiplicity-of-forms theory, began to abandon that theory at the beginning of the 21st century in favour of an interpretation which closely resembles the *Amp* approach (see the judgments cited by D. Cohen, *Le droit des dessins et modeles*, 2nd edn, (Paris: Economica, 2004), pp.23–24).

32 In addition to being supported by a teleological interpretation, the approach discussed in the previous paragraph is also supported by the wording of art.8(1) CDR . That provision denies protection to features of a product's appearance that are, 'solely dictated by its technical function'. Those words do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected.

33 Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at. In the case of some products, such as pictures and ornaments, their very function is to please the eye. In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant. That is why the Community design legislation denies protection to component parts that are not visible in normal use. In the case of most products the designer will be concerned with both the functional and the aesthetic elements. That applies also to large items of industrial equipment, such as shredders for use in recycling plants. The shredder must, in the first place, perform its function effectively and safely and without creating excessive noise, but it is also desirable that the shredder should be pleasing to the eye and thus enhance the working environment of the people who operate it and see it in use. For that reason there is no objection in principle to granting design protection to industrial products whose

overall appearance is determined largely, *but not exclusively*, by functional considerations.

34 It is often pointed out that the Community design legislation, unlike the old laws of some Member States, does not lay down any requirement of aesthetic merit, artistic creativity or eye appeal. The absence of such a requirement is expressly mentioned in the 10th recital in the preamble of Regulation 6/2002 and in the 14th recital in the preamble to Directive 98/71. Some authors infer from this that purely functional designs are protectable. That is a false analysis. Community design law is concerned with the visual appearance of products. That is clear from the definition of 'design' in art.3(a) CDR and from the requirement of visibility in normal use for component parts in art.4(2)(b) CDR . Those parts of a product that cannot be seen are of no concern to the Community law of design because no one cares what they look like. All that matters is that such parts perform their function. If the law were intended to protect purely functional designs it would not be logical to exclude the non-visible aspects of design from protection.

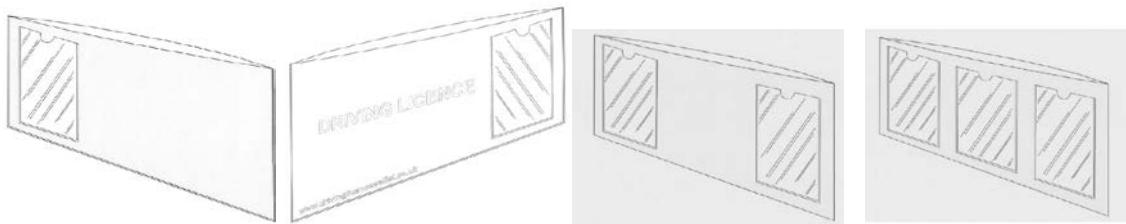
35 The significance of limiting protection to the visual appearance of products is that aesthetic considerations are in principle capable of being relevant only when the designer is developing a product's visual appearance. Most of the time the designer will be concerned with both elements of good design: functionality and eye appeal. In some cases functionality will be the dominant preoccupation of the designer. The need to make a product that works will be uppermost in the designer's mind and will largely determine the appearance of the product. As long as functionality is not the only relevant factor, the design is in principle eligible for protection. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. This is not, it must be stressed, tantamount to introducing a requirement of aesthetic merit into the legislation. It is simply recognition of the obvious fact that when aesthetics are totally irrelevant, in the sense that no one cares whether the product looks good, bad, ugly or pretty, and all that matters is that the product functions well, there is nothing to protect under the law of designs.

36 It follows from the above that art.8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually

went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen."

31 Counsel for Vax submitted that this was a compelling analysis, and in particular the point made by the Board at [30]. Counsel for Dyson had no convincing answer to that point. It does not appear to be a point which was made to the Court of Appeal in *Landor & Hawa [2006] E.C.D.R. 31*. In my view the Board of Appeal's analysis is persuasive. I therefore conclude that the interpretation placed on art.8(1) of the Community Designs Regulation , and hence art.7(1) of the Designs Directive , by the Board of Appeal is to be preferred to that adopted by the Court of Appeal in *Landor & Hawa [2006] E.C.D.R. 31* ."

36) The four designs look like this:



37) It is clear from the evidence that the introduction of the European style driving licence, consisting of a photocard and a paper counterpart, gave rise to wallets that were shaped to incorporate the two parts of the licence. I accept from the evidence that the oblong outline shape of the wallets is configured in order to carry the folded paper counterpart. The outline shape is, therefore, performing a technical function. The word "technical" does not introduce any form of heightened or highly engineered functionality, the function can be quite simple, as is the case here.

38) I also accept that the slot(s) on the surface of the wallets are that shape in order to fit the photocard part of the license. The indentation in the top of the slot serves a very clear purpose in allowing the user to more easily remove the photocard. Therefore, the shape of the slot and its relative size perform a purely technical function. Two of the wallets have multiple slots. There is nothing to suggest that driving licence wallets require multiple slots because there is, after all, only one photocard that the user will need to store. However, it seems to me that the slots could simply be used for other types of cards that the user may wish to store. The multiplicity of slots, therefore, serves an exclusively functional purpose. It would be counterintuitive to believe that the additional slots have been added for aesthetic purposes.

39) The designer obviously had a choice as to where the slots should be located. However, in all of the designs they have either been placed on one side or the other (the single slot wallets) or have been placed symmetrically and evenly across the face. None of the forms of orientation will be perceived as a design feature. The shape and configuration will be viewed as merely performing a technical function and nothing else. **All four designs are invalid on this basis.**

Summary

40) As a consequence of the above, all four designs the subject of these proceedings are hereby declared invalid.

Costs

41) Mr Graham has been successful and is entitled to a contribution towards his costs. The consolidation of the cases and the common pleadings/evidence has kept costs down. I note that Mr Graham was not legally represented so would not have incurred any legal costs; this is a factor to bear in mind in my assessment. I hereby order Registered Designs Limited to pay Mr Darren Graham the sum of £900. This sum is calculated as follows:

Preparing statement(s) and considering the other side's statement(s)	£300
Filing evidence	£400
Official fee(s) for filing invalidation	£200

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

Dated this 30th day of October 2013

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