

# Review

## Intellectual Property



## Caselaw - Blackberry applications for invalidation bear limited fruit

In *Blackberry International Limited v Wittaya Asawasuwannakul* (Case O-074-09, 19 March 2009) the Comptroller has held that UK registered designs nos. 4002804, 4002809 and 4002814 were invalid on the grounds that they were not new and did not possess individual character.

### BACKGROUND

In April 2007, Wittaya Asawasuwannakul (WA) applied to register thirteen designs 4002803-4002815, all in respect of women's clothing. In June 2007, Blackberry International Limited (Blackberry) applied for invalidation of the designs on the grounds that they were not new at the date of application. In December 2008, the hearing took place before the Comptroller. WA did not attend.

### THE CASE BEFORE THE COMPTROLLER

Blackberry argued that its articles of clothing had been made available to the public prior to the application date of WA's designs and that WA's designs did not differ from the overall impression created by Blackberry's designs.

WA tried to highlight in his counterstatements the differences between the designs of the two parties. Moreover, he questioned the reliability of Blackberry's evidence since it came from the internet, and thus could easily be altered.

### THE COMPTROLLER'S DECISION

Acting for the Comptroller, Oliver Morris first referred to the two fundamental requirements in order for a design to be registrable, namely its novelty and individual character. He emphasized that when assessing the novelty of a design there should be no identical design whose features differed only in immaterial details and which had been made available to the public before the application date of the registered design.

He added that the individual character of a design should be assessed by comparing its overall impression produced on the informed user with that created by other designs that had been made available to the public before the relevant date.

By taking into account the fact that the design should be new at the date of application, Mr Morris highlighted that prior art in the form of existing designs could invalidate registered designs only if it had been disclosed to the public prior to the application date of the registered design.

Following this logic, Mr Morris reiterated the case law on the comparison of designs at an appropriate level of generality, namely that the overall impression, which nevertheless had to be clearly different, should be assessed by the design as a whole and only when viewed carefully through the eyes of an informed user of the product.

However, smaller differences were sufficient to create a different impression where the freedom for design was limited. With reference to case law relating to "the informed user", Mr Morris noted that an informed user was a regular user of articles which were the subject of the registered design in issue and also imported a notion of familiarity above the average consumer combined with awareness of product trend.

---

In the present case, he felt that the registered designs should be examined under the criterion of eye appeal and that the “informed user” was likely to be a user of women’s clothing who also possessed a keen interest in design matters in the fashion field. Consequently, he examined each application for invalidation by comparing the prior designs with the registered designs in order to assess whether or not the latter were new and had individual character and concluded that three of the registered designs were invalid on the grounds that they lacked novelty and individual character. Blackberry was entitled to costs of £900 because of the nine unsuccessful applications and WA to costs of £1000 because of the three successful applications. In effect, Blackberry therefore had to pay costs of £100 to WA.

## COMMENT

This case appears to arise from a dispute because the companies both sell women’s clothing on eBay. However, it of course remains for the Comptroller or the courts to carry out a comparison between earlier published or registered designs and later registered designs to assess novelty and individual character.

---

## FURTHER INFORMATION

For more information relating to this article, please contact:

**Chris McLeod**

**Director of Trade Marks for the UK**

T: +44 (0)20 7655 1590

M: +44 (0)782 520 4465

E: [chris.mcleod@hammonds.com](mailto:chris.mcleod@hammonds.com)

---

## WWW.HAMMONDS.COM

If you do not wish to receive further legal updates or information about our products and services, please write to: Richard Green, Hammonds LLP, Freepost, 2 Park Lane, Leeds, LS3 2YY or email [richard.green@hammonds.com](mailto:richard.green@hammonds.com).

These brief articles and summaries should not be applied to any particular set of facts without seeking legal advice. © Hammonds LLP 2009.

Hammonds LLP is a limited liability partnership registered in England and Wales with registered number OC 335584 and is regulated by the Solicitors Regulation Authority of England and Wales. A list of the members of Hammonds LLP and their professional qualifications is open to inspection at the registered office of Hammonds LLP, 7 Devonshire Square, London EC2M 4YH. Use of the word “Partner” by Hammonds LLP refers to a member of Hammonds LLP or an employee or consultant with equivalent standing and qualification.