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“Intellectual Property lies at the centre of the modern company's economic success or failure”

Lester Thurow : Economist

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Laundry balls case defines prior art in Community Registered Design (CRD) cases

[Green Lane Products Ltd –v- PMS International Group plc & others [2008] EWCA Civ 358]

by Kim Henry
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Businesses commonly register their designs to prevent competitors copying the physical appearance (lines, shape, contours, texture, colours & materials) of their products or components. Community Registered Designs (CRDs) are protected for up to 25 years and give the holder the exclusive right to use the design.

Designs must be “new” (i.e. not copied) and have “individual character” (i.e. give a different overall impression on the informed user to previous designs) to be validly registered as CRDs (Articles 5 and 6 of the Community Designs Regulation 6/2002).

Green Lane v PMS was decided at the English Court of Appeal in April of this year. The decision provides useful guidance on the definition of “prior art” in community registered design cases.

Green Lane Products Limited (“Green Lane”) owned a series of community registered designs for their spiky plastic balls, also known as “Dryerballs” to be used as “Flatirons and washing, cleaning and drying equipment” for use in tumble drying laundry. Green Lane had filed its CRDs in August 2004.

PMS had been selling spiky plastic balls in the EU since 2002, before Green Lane applied for registration. Originally, they were marketed as massage balls but later on they were packaged for further uses including laundry balls.

Green Lane sued PMS for infringement of its CRDs as PMS was selling its products for not only massage use but also laundry use. PMS counterclaimed that Green Lane’s registrations were invalid by reason of their prior sale of massage balls. Green Lane rejected this claim, arguing that PMS’ balls did not constitute prior art within the meaning of Article 7.

The case required the correct construction of Article 7 of the Community Designs Regulation 6/2002 which dealt with “prior art”. Article 7 provides that a design

shall only be deemed to have been made available to the public if:

‘it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before [the date of filing of the application for the CRD] except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.’

The key question was what is “the sector concerned?”. The case raised the problem of whether a design well known in one sector can be used to invalidate a commonly registered design registered for a design in another sector.

The parties came to an agreement before judgment but the Court of Appeal decided that judgment should be delivered as the matter was believed to be of sufficient public interest.

The Court of Appeal made a detailed analysis of the Regulation and legislative materials and upheld the preliminary ruling given at the High Court. The preliminary ruling was that the relevant sector is the sector that consists of or includes the sector of the alleged prior art. In this case the alleged prior art was the massage balls even though the design under examination was for laundry balls. The Court found that the prior art available for attacking novelty should also extend to all kinds of goods, subject only to the limited exception of prior art obscure even in the sector from which it comes.

Furthermore, the Court also confirmed that “The circles specialised in the sector concerned, operating within the Community” within Article 7 are capable of consisting of all individuals who conduct trade in relation to products in the sector concerned, including those who design, make, advertise, market, distribute and sell such products in the course of trade in the Community”.

Accordingly, however you classify a design or whichever field you use is not material to the scope of protection or its validity. More expensive and extensive searches may now need to be carried out in deciding whether to challenge the validity of a design.