

Gimex v Chill Bag: does the indication of the product in a registered design affect validity and infringement?

A Patents County Court judgment by HHJ Birss QC in [Gimex v Chill Bag](#) provides guidance on whether the indication of the product in a registered design has any bearing when assessing validity and infringement. This decision follows this judge's earlier recent decision in a registered design dispute between Samsung Electronics and Apple relating to the Galaxy Tab and iPad products.

In this judgment the judge decided whether Gimex's Community registered design no. [616057-0001](#) was valid over inter alia their own earlier Transline Bag, and whether it was infringed by the Chill Bag product. In keeping with the speedy and relatively inexpensive procedures which this judge is keen to achieve in the Patents County Court, the trial was limited to one day, with limited disclosure and cross-examination being allowed.

For a registered design to be valid it must be novel and have "individual character" over any prior designs. According to Articles 5 and 6 of the Community Design Regulation (Council Regulation (EC) No 6/2002), a design is new "if no identical design has been made available to the public" and has individual character "if the overall impression it produces on the informed user differs from the overall impression produced in such a user by any design which has been made available to the public." In this case, the judge considered it necessary to address whether all designs qualify as prior designs and/or whether the indication of the product in the registered design, or more specifically its nature or purpose, introduces any qualification of this.

It was effectively agreed by the parties that the Gimex registered design was not identical to the earlier Transline Bag (or any other prior design) so that the Gimex registered design was new. The case therefore centred on whether it had individual character and the degree to which the earlier Transline Bag should be taken into account for this.

The judge referred to Recital 14 of the Regulation, which states a design has individual character if “the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, **taking into consideration the nature of the product** to which the design is applied or in which it is incorporated”. The judge reviewed a number of earlier cases and commented that whilst Article 36 of the Regulation states that the indication of the product in the registered design “shall not affect the scope of protection of the design as such”, the indication of the product was “a convenient place to start” when determining what the product is and therefore how the informed user would view the registered design in view of the earlier designs.

The design as registered showed a bag that could hold a wine bottle and ice cubes to cool the contents. The indication of the product in the registered design was ““Packaging, Table ornaments, Ice pails, Bags”. Interestingly, the judge commented that this was broad and decided in effect to narrow it to “bottle chillers”. The Transline Bag was simply a bottle bag. The judge commented that it could not sensibly be used as a bottle chiller (largely because it was not big enough to hold ice cubes). He then held that the informed user of bottle chillers would regard the differences in the registered design for a bottle chiller over the prior art bottle bags as significant, and enough to produce the required “different overall impression” in order for the registered design to be valid.

Thus, whilst any prior design does count as prior art, in effect the judge has identified a mechanism whereby prior designs for different products, in different fields, can be more easily overcome for validity purposes. Had for example the registered design been held more broadly to encompass bottle bags in general rather than just bottle chillers in particular, the informed user might have been held to see the differences over the earlier Transline bottle bag as being less significant such that the registered design might have been held to be invalid. The judge’s narrow characterisation of the “product” certainly assisted the case for validity.

Finally, the judge held that the Chill Bag infringed the Gimex registered design because, despite differences, the overall impression it produces on the informed user is the same as produced by the Gimex registered design. The Chill Bag and the Gimex registered design were of course both for the same product, namely a bottle chiller.

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