

O/749/18

REGISTERED DESIGNS ACT 1949

REGISTERED DESIGN No. 2086306

IN THE NAME OF JAGUAR LAND ROVER

AND

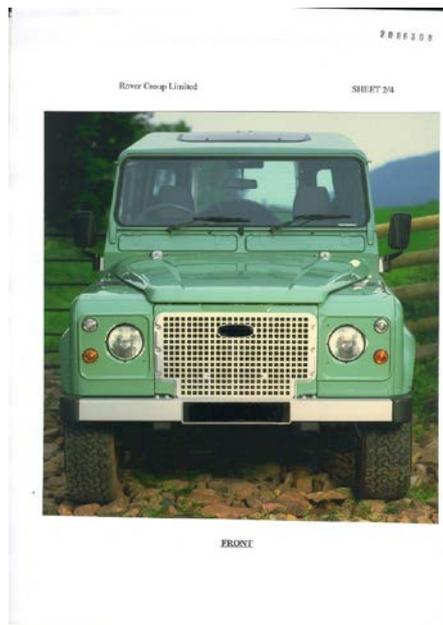
APPLICATION No. 51/17

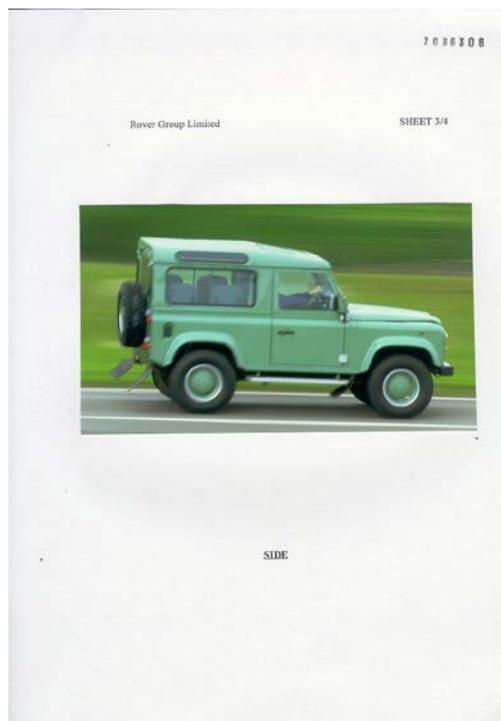
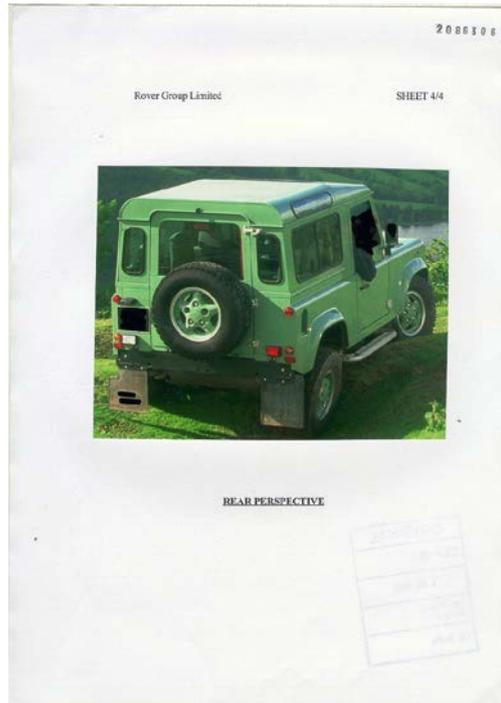
BY INEOS INDUSTRIES HOLDINGS LIMITED

TO CANCEL THE REGISTERED DESIGN

Background and pleadings

1. This is an application by Ineos Industries Holdings Limited (“the applicant”) to cancel UK registered design No. 2086306. The contested design is registered in the name of Jaguar Land Rover (“the proprietor”). The design is shown below.





2. The application to register the design was filed on 1st September 1999 (“the relevant date”) and entered in the register on 5th November 1999. The application included a statement of novelty to the effect that *“The novelty in the present design resides in its shape and configuration of the article depicted in the representations.”*

3. The article to which the design is applied or embodied is described as *“a vehicle miniature.”*

4. The application to invalidate the registered design was filed on 11th December 2017.

5. The Registered Designs Regulations 2001 came into force on 9th December 2001. The Regulations amended the Registered Designs Act 1949 (“the Act”) to bring it into line with the requirements of the EU’s Designs Directive. However, article 12 of the Regulations provides that the Act as it had effect immediately prior to the coming into force of the Regulations continues to apply to registrations of designs:

- (i) resulting from an application made on or after 1 August 1989, and
- (ii) subsisting at the coming into force of the Regulations.

Therefore, in assessing the application for cancellation of the contested design, I must apply the relevant provisions of the Act as they stood on 8th December 2001.

6. These provisions are as follows.

(i) Section 1(1) of the Act defined “design” to mean *“features of shape, configuration, pattern or ornament applied to an article”*.

(ii) Section 1(4) of the Act stated that:

“[a] design shall not be regarded as new for the purposes of [the] Act if it is the same as a design –

(a)-

(b) published in the United Kingdom in respect of the article or any other article before the date of the application, or if it differs from such a design only in immaterial details or in features which are commonly used in the trade.”

(iii) Section 11(2) of the Act stated that:

“At any time after a design has been registered any person interested may apply to the registrar for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration thereof, new....; and the registrar may make such order on the application as he thinks fit.”

7. The applicant claims that, inter alia, the contested design was made available to the public in August 1999 when Land Rover (the original applicant) made the design

for the Land Rover Defender 90 Heritage vehicle available to the public. Consequently, it was no longer a new design at the relevant date.

8. The proprietor filed a counterstatement denying the applicant's case. The proprietor required proof that the design for the Land Rover Defender 90 Heritage vehicle was made available to the public prior to the relevant date.

9. The counterstatement also took issue with the applicant's claim that the only differences between the contested design and the designs said to have been disclosed for the Land Rover Defender 90 Heritage vehicle were immaterial or irrelevant. The differences are that (a) the prior disclosures identified by the applicant showed the vehicle with a roof of a contrasting colour to the rest of the body, which is absent from the contested design, and (b) some of the prior disclosures showed the vehicle with an air intake on the off-side wing, which is absent from the contested design.

The evidence

10. Only the applicant filed evidence. This consists of two witness statements (with 27 exhibits) by Ms Caroline Marshall, who is a Chartered Patent Attorney with Potter Clarkson LLP and a witness statement by Mr Stephen Harper, who is a design consultant with experience of automotive design.

Representation

11. The applicant is represented by Potter Clarkson LLP. The proprietor has responded through its patents department. A hearing took place on 31st October 2018. Mr Michael Bloch QC appeared as counsel for the applicant. The proprietor was represented by Mr Alan Bhimani and Mr Ben Wright from its patents department.

Discussion

12. The applicant relies on prior disclosures through the marketing of several earlier Land Rover vehicles. However, it is only necessary to examine the disclosures relating to the Land Rover Defender 90 Heritage vehicle. These fall into three categories. Firstly, photographs of the Land Rover Defender 90 Heritage vehicle which are claimed to have appeared in the 28th July 1999 edition of Autocar

magazine.¹ Secondly, the public launch of the vehicle itself, which is claimed to have occurred on or before 5th August 1999.² And thirdly, an advertising flyer for the vehicle, which is said to have been disclosed to the public around the time of the launch.³

13. The pictures of the vehicle in the Autocar magazine, and in the flyer, show the vehicle with a roof in a contrasting colour to the rest of the body of the vehicle. In his comprehensive skeleton argument, Mr Bloch carefully examined the authorities on this matter. He pointed to the statement of novelty associated with the contested design which identified the subject matter as being the “*shape and configuration*” of the vehicle shown in the pictures. In this connection, he drew my attention to the following words of Aldous J. in *Valeo Vision Societe Anonyme v Flexible Lamps Limited*:⁴

“On behalf of the plaintiffs, it was submitted that it was permissible and correct in this case to take into account the colours of the screens as shown in the registered designs. I cannot accept that submission. Section 1 of that Act defines a design as “features of shape, configuration, pattern or ornament”. The statement of novelty of both registrations limits them to features of shape and configuration. Colour is not a feature of shape nor is it a feature of configuration. It may form part of pattern or ornament.

*The plaintiffs also submitted that despite the statement of novelty stating that the features of the design for which novelty was claimed resided in the shape and configuration, it was right to take into account features of pattern and ornament. To support that submission, I was referred to *Barran v. Lomas (1880) 28 W.R. 973*. In that case there was no statement of novelty and it is therefore not an authority which supports the submission; the submission is completely untenable. The whole purpose of a statement of novelty is to confine the design to certain features. In this case, it is clear that both pattern*

¹ See exhibit CM3

² See exhibits CM1, CM2, CM3 & CM4

³ See exhibit CM16

⁴ [1995] RPC 205 at 215

and ornament are excluded from the ambit of the design by limitation to features of shape and configuration.

For the reasons I have given, the colours of the lens shown in the registered designs cannot be taken into account.”

14. I accept Mr Bloch’s submission that colour is not to be regarded as an element of the contested design, which is solely for the shape and configuration of the vehicle shown on the register. Indeed, in the light of Mr Bloch’s convincing analysis of the authorities, the proprietor’s representatives were constrained to accept that the law did not permit colour to be counted as a difference between the earlier disclosures and the contested design.

15. In any event, I find that even if it was appropriate as a matter of law to take the difference in colour into account, the contrasting roof colour of the vehicles shown in the disclosures is a difference in only “*immaterial details*” and/or “*features which are commonly used in the trade.*” Therefore, it will not make any difference if I take colour into account.

16. The pictures showing the Land Rover Defender 90 Heritage vehicle in Autocar magazine and in the promotional flyer for the vehicle, do not show an air intake on the off-side wing. I was told that this is because the vehicle shown in these photographs is the petrol version of the vehicle and the air intake only appeared on the diesel version. It does not matter whether that explanation is right. This is because the disclosures of the design in Autocar and in the flyer, are sufficient, if they are prior disclosures, to establish that the contested design was not new at the relevant date. Consequently, there is no need to consider whether the absence of the air intake in other disclosures of the vehicle relied on by the applicant makes any material difference to the design shown in those disclosures and the contested design.

17. This means that the only ‘live’ issue which remains to be determined is whether the disclosures in question took place prior to the relevant date.

18. The applicant’s evidence includes an extract from an historical article in a publication called ‘autointell’. It is from August 1999.⁵ The article reports that “*Land*

⁵ See exhibit CM1

Rover has now launched the Defender Heritage.” It includes a quote from Mr Harry Reilly, the Managing Director of Land Rover UK at the time, extolling the virtues of the new vehicle. The evidence also includes a copy of an extract from a book entitled ‘Land Rover, 65 Years of the 4 x 4 Workhorse’ by Mr James Taylor.⁶ According to the inside cover of the book, Mr Taylor is a pre-eminent historian of Land Rover products and edited Land Rover Enthusiast magazine for 10 years. Mr Taylor’s book dates the launch of the Land Rover Defender Heritage vehicle as August 1999.⁷ The relevant part of the book includes a picture of the vehicle, the shape and configuration of which corresponds to the contested design.

19. The promotional flyer also includes pictures of a Land Rover Defender Heritage vehicle with the same shape and configuration as the contested design.⁸ The flyer is undated, except for a copyright claim of 1999. It says that “[Land Rover] *are now proud to offer the discerning customer the Defender Heritage.*” The applicant invites me to infer that this flyer was circulated in August 1999, i.e. around the time of the launch of the vehicle.

20. The copy of the Autocar magazine in evidence is dated 28th July 1999, i.e. over a month prior to the relevant date. It included a five-page advertisement for the Land Rover Defender Heritage. The vehicle shown in the advertisement has the same shape and configuration as the contested design. The advertisement included prices and optional features for the vehicles.

21. At the hearing, the proprietor’s representatives pointed out that:

- (i) The article from the August 1999 article in ‘autointell’ does not include pictures of a Land Rover Defender Heritage;
- (ii) The book by Mr James Taylor was written years after the relevant date⁹ and could not be relied upon to date the public launch of the Land Rover Defender Heritage vehicle to within the month of August 1999;

⁶ See exhibit CM2

⁷ See WS Marshall 2, at paragraph 3 and 4 and exhibit CM23

⁸ See exhibit CM16

⁹ It appears to have been first written in 2007

- (ii) The promotional flyer is not dated (except for copyright 1999) and therefore also fails to date the launch of the vehicle to August 1999;
- (iv) Ms Marshall does not explain how she obtained the copy of Autocar magazine in her evidence; therefore, her evidence does not establish that the magazine she filed was circulated to the public prior to the relevant date, or at all.

22. For his part, Mr Bloch, on behalf of the applicant, pointed out that the proprietor had served no evidence, even in relation to matters the truth or falsity of which should be expected to be within its knowledge. In these circumstances, Mr Bloch invited me to draw an inference against the proprietor in relation to such matters. In this respect he relied on the judgment of the Court of Appeal in *Wisniewski v Central Manchester Health Authority*¹⁰ where Brooke L.J (with whom Roch and Aldous LJJ agreed) said:

“(1) In certain circumstances a court may be entitled to draw adverse inferences from the absence or silence of a witness who might be expected to have material evidence to give on an issue in an action.

(2) If a court is willing to draw such inferences, they may go to strengthen the evidence adduced on that issue by the other party or to weaken the evidence, if any, adduced by the party who might reasonably have been expected to call the witness.

(3) There must, however, have been some evidence, however weak, adduced by the former on the matter in question before the court is entitled to draw the desired inference: in other words, there must be a case to answer on that issue.

(4) If the reason for the witness's absence or silence satisfies the court, then no such adverse inference may be drawn. If, on the other hand, there is some credible explanation given, even if it is not wholly satisfactory, the potentially detrimental effect of his/her absence or silence may be reduced or nullified.”

¹⁰ [1998] P.I.Q.R. P324 at 340 (CA)

23. In answer to this point, the proprietor's representatives told me at the hearing that following two changes of ownership since 1999 the proprietor had been unable to find records establishing when the Land Rover Defender Heritage was publicly launched.

24. As I indicated at the hearing, if the proprietor wanted the failure of its own searches to find relevant evidence to be considered, the proper course was for the proprietor to have provided a witness statement, statutory declaration or affidavit describing the steps that had been taken to find the relevant records and confirming that none had been found. Having filed no such evidence, it was not open to the proprietor to turn up at the hearing and seek to give such evidence through submissions.

25. However, although I see the force of the point made in *Wisniewski*, for my part I prefer to approach the evidential issue in this case on the following basis. Firstly, it is for me to assess whether the applicant has presented a *prima facie* case that the contested design was disclosed to the public prior to the relevant date. In making that assessment I must apply the usual standard of proof in civil proceedings, i.e. the balance of probability. If the applicant has established that the design was disclosed to the requisite standard, then I must assess whether the proprietor has done enough to rebut the *prima facie* case.

26. The last part is very easy here because the proprietor has not filed any evidence at all. It follows that the application will succeed if the applicant has established a *prima facie* case that the design was publicly disclosed prior to the relevant date. Further, as s.1(4) of the Act states that the disclosure may be in respect of the article identified in the design registration "...or any other article", it makes no difference that the design relied on by the applicant is in respect of an actual vehicle rather than a vehicle miniature.

27. Turning to the applicant's evidence, I see some force in the proprietor's individual criticisms about:

- (i) the absence of any representation of the design in the article in autointell;
- (ii) the reliability of the launch date for the Land Rover Defender Heritage given in Mr Taylor's 2007 book, and

(iii) the absence of a specific date on the 1999 promotional flyer for the new vehicle.

In contrast, the Autocar article appears to me to provide strong evidence that the contested design was disclosed or around 28th July 1999, i.e. prior to the relevant date. And if the design was disclosed in that magazine, the likelihood is that the vehicle itself was made available to the public in August 1999, as suggested by the other parts of the evidence. However, as the disclosure of the contested design in Autocar is sufficient by itself to destroy the novelty of the design at the relevant date, it does not really matter whether the vehicle itself was shown publicly prior to that date.

28. When I asked them about it the hearing, the proprietor's representatives clarified that the proprietor does not claim that the copy of Autocar in evidence is a forgery. Rather, it is submitted that in the absence of evidence as to the provenance of the document in question, the existence of this copy of a magazine does not prove that it was made available to the public, or when. In this connection, it was suggested that draft versions of magazines are sometimes drawn up, which may differ in content from the final published version.

29. I see no force in this criticism. The copy of the magazine in evidence appears to be a published document: it has a price, a date and a bar code. The copying of the document captured a circulation list which had been attached to the front cover. This is consistent with the document having been purchased and passed around within an organisation. There is absolutely nothing to suggest that the document is only a draft of an unpublished magazine.

30. As to the date of its publication, I accept that the fact that it carries a date of 28th July 1999 does not necessarily mean that it was made available on that day. However, it is reasonable to infer that it was distributed on or around that date. I take judicial notice of the fact that, if anything, magazines are usually first made available to the public prior to the official publication date. It would be very surprising if the magazine was not in fact published until September 1999.

31. I therefore find that the Autocar magazine in evidence is sufficient to establish at least a *prima facie* case that the contested design was disclosed to the UK public prior to the relevant date.

32. If the proprietor wanted to contest this evidence, but could not establish the truth from its own records, it could have sought evidence from the publishers of Autocar as to the content and date of first distribution of the July 1999 edition of the magazine. Alternatively, the proprietor could have done what the applicant has done; namely, search third party records and publications to establish that the shape and configuration of the Land Rover Defender Heritage vehicle was first made available to the public after the relevant date. It has not done so. Instead, it has chosen to rely on criticisms of the reliability of the applicant's evidence. These appear rather nit-picking insofar as they are directed at the publication of the Autocar magazine in evidence. The proprietor's overall position appears to be based on a belief that it was for the applicant to establish its case beyond any reasonable doubt. However, as I pointed out earlier, the standard of proof in civil proceedings is the balance of probability. This is all the more appropriate where, as here, a party has the task of establishing disclosures made nearly 20 years ago. The applicant's evidence easily establishes that, on the balance of probability, the contested design was made available to the UK public on or around 28th July 1999. It follows that the contested design was not new at the relevant date. Consequently, registration of the design was contrary to s.1(4) of the Act.

Outcome

33. The design registration will be cancelled with effect from 1st September 1999.¹¹

Costs

34. The application is successful and the applicant is entitled to a contribution towards its costs.

35. At the hearing the proprietor's representatives suggested that some allowance should be made for the fact that the applicant did not file all its evidence up front, but only during subsequent rounds of evidence. This criticism is misconceived. The applicant was under no obligation to file its evidence with its pleadings. The Design Rules 2008 specifically provide for evidence to be filed later. And to the extent that the criticism goes to the applicant filing two rounds of evidence instead of one, the second round was triggered by, and in reply to, the proprietor's written criticisms of

¹¹ The effective date of registration

the evidence filed in the first round. The evidence filed in the first round was sufficient to establish a *prima facie* case that the design was not new when it was registered. Consequently, no blame can be attached to the applicant's conduct. If anything, the proprietor has left itself open to the criticism that it behaved unreasonably in continuing to oppose the application after seeing the Autocar evidence, without any proper basis for doing so.

36. The applicant accepts that on-scale costs are appropriate. I therefore assess the appropriate contribution to the applicant's costs as follows:

£48 for the official fee for the application for invalidation (Form DF19A);

£400 for drawing up the statement of case and considering the proprietor's counterstatement;

£1500 for filing evidence and considering the proprietor's written submissions;

£750 for attending a hearing and filing a skeleton argument.

37. I therefore order Jaguar Land Rover to pay Ineos Industries Holdings Limited the sum of £2698. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 21st Day of November 2018

Allan James

For the Registrar