

O/571/19

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN No. 6038767

IN THE NAME OF CO STARS LONDON LTD

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION (No 26/18)

BY HONG ZHANG

1. These proceedings concern an application by Hong Zhang (“the applicant”) to declare the above registered design (“the UK registered design”) invalid under section 1B of the Registered Designs Act 1949 (“the Act”). This design had been applied for on 6 July 2018.
2. The applicant claimed that the design was not new and/or lacked individual character, in terms of the shape, liner pattern and function, when compared with an earlier Registered Community Design (“RCD”) (No. 004142297-0001), of which it is the proprietor.
3. Co Stars London Ltd (“the proprietor”) filed a defence, claiming that it had been importing products made to the UK registered design since 17 May 2017, and that the applicant’s RCD was in fact a copy of these products. A bill of lading and invoices were supplied as evidence.
4. After considering the evidence, the Tribunal wrote to the parties, highlighting that the proprietor had confirmed that the design it had registered was in fact disclosed in May 2017, more than 12 months before the application was filed in the UK. As a consequence, the Tribunal advised the parties that a short decision may be issued invalidating the design on the basis of prior disclosure.
5. The parties were given an opportunity to request a hearing if they disagreed with the Tribunal’s preliminary view. No such request was received.
6. Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a) ...

(b) ... on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

7. Section 1B of the Act reads as follows:

“(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. As can be seen, the novelty in a design is destroyed if an identical design (or one having the same overall impression) has been made available to the public before the relevant date. The relevant date is the filing date of the design: 6 July 2018. Some disclosures are excluded from the assessment as per section 1B(6), which deals with disclosures in the 12 months before the relevant date (which does not apply here given that the design was disclosed 14 months before the relevant date) or disclosures made under condition of confidentiality, or disclosures that are very obscure, none of which has been claimed. It is important to note that it does not matter who made the disclosure. A novelty-destroying disclosure can be made even by the rightful owner of the design (unless one of the exceptions apply).

9. In view of the fact that the proprietor has claimed (and provided evidence) showing that the design was disclosed and in the absence of any reason to exclude the disclosures made, it follows that the registered design must be declared invalid. It was not novel when the design was filed.
10. The design registration is hereby declared invalid.

Costs

11. As the applicant has been successful, it is entitled to an award of costs. My assessment is as follows:

Official fee for application to invalidate: £48

Statement of case and considering the counterstatement: £300

Total: £348

12. I order Co Stars London Ltd to pay Hong Zhang the sum of £348. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of September 2019

Clare Boucher
For the Registrar,
the Comptroller-General