

O/652/19

REGISTERED DESIGNS ACT 1949

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN
RELATION TO REGISTERED DESIGN NO. 6038334
IN THE NAME OF DENIS LAU S YUNG**

AND

**THE APPLICATION TO INVALIDATE THE DESIGN UNDER NO. 10/19
BY ZHENZHEN YINGMEI DIKE MEDICAL TECHNOLOGY CO., LTD**

Background

1. Registered design number 6038334 is for a pulse oximeter, a device for measuring oxygen levels in the blood, as represented below:



The design was applied for on 27 June 2018 and registered on the same day. It stands in the name of Denis Lau S Yung (“the proprietor”).

2. On 22 February 2019, Bailey Walsh & Co LLP filed a form DF19A (Request to invalidate a design registration) together with a Statement of Case on behalf of Zhenzhen Yingmei Dike Medical Technology Co. Ltd (“the applicant”). The request was made under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the design did not fulfil the requirements of section 1B of the Act, which states that:

“(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.”

3. On 21 March 2019, the Registry served the form DF19A on the proprietor, who is unrepresented. The proprietor was advised that it had until 2 May 2019 to file a defence on Form DF19B and that:

“Failure to respond to this letter will result in the registration being declared invalid.”

4. On 6 June 2019, the applicant wrote to the Registry to enquire whether a defence had been filed. The Registry wrote to the proprietor on 21 June 2019, stating that as no defence had been received, it was minded to deem the opposition to the application as withdrawn, in accordance with Rule 15(5) of the Registered Design Rules 2006 (“the Rules”):

“The registered proprietor, within that period, shall (a) file his counter-statement on Form DF19B; and (b) send a copy of it to the applicant, otherwise the registrar may treat him as not opposing the application.”

5. On 27 June 2019, the proprietor contacted the Registry by email to say that it had not received the official letter dated 21 March 2019. In its response, dated 9 July 2019, the Registry confirmed that that letter had been sent by recorded delivery and that Royal Mail had confirmed that someone had signed for it. The Registry therefore considered that the document had been delivered to the proprietor. Attached to this response was a copy of the Form DF19A. The proprietor was given a period of 7 days in which to make any comments, following which the Registry would determine how to proceed.

6. The proprietor responded on 16 July 2019 with a witness statement of the same date. He explained that his mail is delivered to a third party. He had received a notification from that third party by email on 27 June 2019 that a letter had arrived and he requested that this be opened, scanned and sent to him. This correspondence was the Registry’s letter of 21 June 2019. The proprietor denies receiving any notification of the first letter, dated 21 March 2019. He spoke to a representative of the third party who confirmed that they had indeed received and signed for the Registry’s first letter.

7. On 8 August 2019, the Registry gave a preliminary view that the information the proprietor had submitted was insufficient to allow a late defence to be filed, and that therefore the request should be refused. Both parties were given the opportunity to

request a hearing if they disagreed with this view. The proprietor requested a hearing on 22 August 2019.

8. A hearing took place before me, by telephone conference, on 11 October 2019. At the hearing, the applicant was represented by Dr Philip Stephenson of Bailey Walsh & Co LLP, who filed a skeleton argument on 9 October 2019. The proprietor represented himself.

Preliminary issue

9. On 16 July 2019 the proprietor submitted that the application for invalidation should be struck out, on the grounds that any such application must be made by a legal entity and that the proprietor believed that the applicant was not a registered company.

10. In its response of 8 August 2019, the Registry declined to strike out the application, or require the applicant to supply evidence of its incorporation. It referred to section 11ZB(1) of the Act:

“Any person interested may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.”

11. The proprietor raised this issue again at the hearing. I reminded him of the Registry’s previous response and that the legislation did not specify what legal form the “interested person” should take. I do not strike out the application for a declaration of invalidity.

DECISION

12. Rule 15 of the Rules states that:

“(3) The registrar shall send a copy of Form DF19A and the statement of case to the registered proprietor.

(4) The registrar shall specify a period within which the registered proprietor shall file a counter-statement.”

13. Rule 19(1) of the Rules states that:

“The registrar may extend or shorten (or further extend or shorten) any period which has been specified under any provision of this Part.”

14. The legislation therefore gives me discretion to extend this period, should I be persuaded that such an extension is justifiable.

15. In exercising the discretion given to the Registrar, the Tribunal will take into account relevant case law. As the applicant notes in his skeleton argument, case law on this particular area of registered design law is lacking. Dr Stephenson refers me to the first decision of an Appointed Person for Designs to support his view that the trade mark case law relating to late filing of defences provides guidance in these circumstances. In *Ahmet Erol's Registered Designs* (BL O-253-17), Martin Howe QC said:

“2. This is the first decision of an Appointed Person under the new appeal regime for designs created by the Intellectual Property Act 2014. The system of appeals to an Appointed Person, as an alternative to the route of appealing to the High Court in heavier and more complex cases, was intended to mirror the long standing system of appeals to an Appointed Person in trade mark appeals.

3. Both the statutory provisions and the rules (The Appointed Person (Designs) Rules 2015, SI 2015 No 169) are closely modelled on the corresponding statutory provisions and rules relating to appeals in trade mark cases.

4. In addition to the rules themselves, there is a large reservoir of practice and procedure which has built up on appeals to Appointed Persons in trade mark cases. Unless there is a relevant difference between

substantive designs law and trade mark law which justifies a different approach, or some other specific and concrete reason, the Appointed Persons for designs appeals will follow and apply the established practice and procedural decisions of the Appointed Persons in trade mark appeals.”

16. Whether Mr Howe’s comments were meant to be interpreted in the manner argued by Dr Stephenson, or rather referred to issues of practice and procedure specifically relating to the hearing of appeals to Appointed Persons, it seems to me that the relevant factors to be taken into account when considering the late filing of a trade mark defence will also, given the absence of specific case law, be relevant in registered design cases. The factors were identified by Mr Geoffrey Vos QC, sitting as a deputy judge of the High Court, in *Music Choice Ltd’s Trade Mark* [2006] RPC 13:

“The factors that are, in my judgment relevant to the exercise of discretion in this case include:

- (1) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed.
- (2) The nature of the applicant’s allegations in its statement of grounds.
- (3) The consequences of treating the proprietor as opposing or not opposing the application.
- (4) Any prejudice caused to the applicant by the delay.
- (5) Any other relevant consideration, such as the existence of related proceedings between the same parties.”¹

17. I have already detailed the reasons given by the proprietor for missing the deadline set by the Registry. It is the responsibility of any proprietor of an intellectual property right to provide the Registry with an address for service, where documents such as the Form DF19A can reliably be received. This may be their own address, or that of a third party, such as a professional representative or the type of mailbox service used by the proprietor in this instance. I must say that it is not entirely clear what happened

¹ Paragraph 67.

after the first letter from the Registry had been received and signed for. The proprietor states that he did not receive a notification email. There is, however, no witness statement from a representative of the mailbox service to give their account of events.

18. The applicant's allegation is that the design is not novel, being a copy of a product that is the subject of a Chinese design patent of which it is the proprietor. The applicant also refers to prior public sales in or around January 2018, which is before the filing date of the UK design. Dr Stephenson submits that the delay in concluding the proceedings has caused prejudice to the applicant as a result of uncertainty regarding the validity of the registered design. No further details are given.

19. I also note that a considerable length of time has elapsed since the proprietor says he learned of the application and the hearing, and still no defence has been filed. I accept that the proprietor contacted the Registry promptly on becoming aware of the application. In fact, he did this on the same day. There was a period of six weeks between this date and the letter giving the Registry's preliminary view, and a period of just over three months between that date and the hearing. It is, of course, possible that, as a litigant in person, the proprietor may not have been aware that he could have submitted a defence during this time. However, there are no specific or separate provisions for litigants in person and I keep in mind that it is in the interests of all parties that disputes before the Registry are dealt with in as timely and efficient a manner as possible.

20. I take account of the possible consequences for the proprietor of losing a registered right in the event that I uphold the Registry's preliminary view. That said, it seems to me that the reasons for missing the deadline have not been explained with the particularity that is required and the proprietor has not sought to file a defence in the intervening period. There appear to be no other proceedings between the same parties that might be affected by my decision.

Conclusion

21. Given the facts that I have set out, I consider that it is reasonable for me to refuse an extension of time to allow the filing of the defence. The application for invalidation

has therefore not been opposed and Design registration 3068334 is declared invalid under section 11ZA(1)(b) of the Act.

Costs

22. As this decision brings to a close the proceedings, subject to any successful appeal, I shall now consider the issue of costs. Costs are based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£548** as a contribution towards the costs of the proceedings. This sum is calculated as follows:

Preparing a Statement of Case: £200

Preparing for and attending the Hearing: £300

Official fee: £48

Total: £548

23. I therefore order Denis Lau S Yung to pay Zhenzhen Yingmei Dike Medical Technology Co., Ltd. the sum of £548. The sum should be paid within 21 days of the expiry of the appeal period, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of October 2019

Clare Boucher

For the Registrar,

Comptroller-General