

O-129-20

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER of Registered Design No. 6045074 for
LAMBRETTA in the name of Gavin Frankland**

and

**APPLICATION TO INVALIDATE (No. 25/18) by Lambretta Club
Great Britain**

DECISION

1. This is an appeal from decision O-373-19 dated 4 July 2019 by the Hearing Officer (Mr Oliver Morris) acting for the Registrar of Designs. He upheld an application by the Lambretta Club of Great Britain to invalidate registered design No. 6045074:-



2. The parties agreed to waive their right to a hearing of the appeal. I have therefore dealt with the appeal on the papers, which comprise the evidence and submissions which were before the Hearing Officer, together with the Notice of Appeal on Form DF55 and a brief Respondent's Notice filed by BHP Law on behalf of the Respondent Club.
3. It appears that these proceedings arose from an underlying dispute between Mr Frankland, who is apparently a former member of the Respondent Club, and claims to be President of the British Lambretta Owners' Association, and the Respondent Club, over ownership of rights relating to the logo which forms the subject of this design registration.
4. Indeed there are parallel proceedings in the Trade Marks Registry in which Mr Frankland is seeking to register this same logo as a trade mark (under UK No. 3203938) and in which the Club is opposing that registration. Further, there is a dispute over ownership of copyright in that logo.
5. However, it appears to be common ground between the parties that the logo which forms the subject of this design registration was in public use in the United Kingdom since 1956 or possibly earlier. In the light of this accepted fact, the Hearing Officer decided that the design registration lacked novelty and declared it invalid on the ground that it did not fulfill the requirements of section 1B(2) of the Act. He considered (correctly in my view) that the ownership dispute was irrelevant to this ground of invalidity and therefore he did not have to go into the various other issues canvassed between the parties in their pleadings and evidence.
6. Mr Frankland's grounds of appeal on his Form DF55 state that "*You have*

invalidated on this point and this point only, so I can not see why I should pay anything towards the Lambretta Club GB as they have no claim at all". He asserts that the "badge" belongs to the British Lambretta Owners Association which is a non-profit club which has no money, while he personally is in financial difficulty.

7. Whether on not the Club have any proprietary claim to the logo or to rights associated with it is irrelevant to their entitlement to be awarded costs. It was open to anyone potentially affected by Mr Frankland's registration of this logo as a design, whether claiming any ownership in it or not, to bring an application to invalidate it and to claim their costs of doing so if successful.
8. It is correct that the Hearing Officer's decision related only to this one ground and that the other issues raised in the Club's grounds and evidence did not need to be decided. A significant part of the Club's costs were presumably incurred on dealing with those other issues. However, a court or tribunal before whom a party achieves overall success based on only one of several issues may make an overall award of costs to the winning party under the principle that the costs follow the event. It is a departure from the norm to award costs based on the individual issues which led to the "event".
9. While there is a discretion to depart from that principle in appropriate cases, the Hearing Officer's decision not to depart from that principle in the present case is discretionary and so is not open to challenge on appeal in the absence of an error of principle -- of which I can see no sign.
10. Alleged impecuniosity is not normally a ground for resisting a costs order

in civil proceedings of this kind. Mr Frankland caused the Club to incur costs by choosing to register an invalid design. He could have reduced his risk of an adverse costs order by giving up defending this plainly indefensible registration at an early stage.

11. Accordingly I dismiss this appeal. In accordance with the Hearing Officer's direction in paragraph 11 of his decision, costs of £948 become payable by Mr Frankland within 21 days of the date of this appeal decision.
12. The Respondent Club is in principle entitled to its costs of resisting this appeal, although it would appear that any such costs would be modest in view of the very limited steps taken. If the Respondent Club thinks it worthwhile to take the time and trouble to apply for an order for its costs of the appeal, it should do so within 21 days of the date of this decision.
13. Finally, I wish to record an observation about the nature of this particular registered design. The statutory definition of "design" in s.1(2) of the Act is as follows:-

(2) In this Act "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

14. And the definition of "product" in section 1(3) is also of relevance:

"product" means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, *graphic symbols*, typographic type-faces and parts intended to be assembled into a complex product. [*emphasis added*]

15. It appears to me that the logo registered in the present case can only fall within the statutory definition of "design" if it counts as "ornamentation"

of the surface of a product, or if it is to be regarded as within the extended definition of “product” in s.1(3) as a “graphic symbol”. The logo is described on the registration as a “badge”, and it has been classified by the Registry under two headings:-

Class 32 - Graphic symbols and logos, surface patterns, ornamentation

Sub class 00 - GRAPHIC SYMBOLS AND LOGOS, SURFACE PATTERNS, ORNAMENTATION

Class 11 - Articles of adornment

Sub class 03 - MEDALS AND BADGES

16. The logo consists principally of the words “British Lambretta Owners Association”, the word Lambretta being stylised but the other words plainer, within a shield device. It is a classic trade mark logo, consisting of words (partly in fancy script), and of non-verbal graphic elements. Whether or not a logo of this kind is registrable as a design, and if so what product it is “ornamenting”, may raise issues which need to be argued and addressed in future cases. In the present case these issues have not been raised or argued and in any event do not arise because the registration is invalid on the straightforward ground of lack of novelty.

Disposition: The appeal is dismissed. The Respondent may apply for its costs of the appeal (if so advised) within 21 days of this decision.

Martin Howe QC

Appointed Person (Designs Appeals)

2 March 2020