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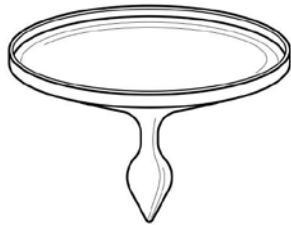
REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

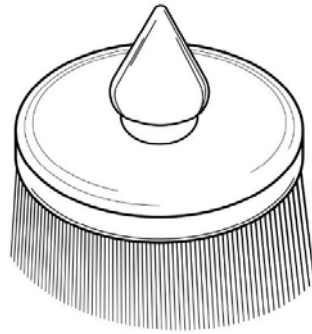
REGISTERED DESIGN Nos 6000473 & 6000525

IN THE NAME OF BARBARA FADOUA

IN RESPECT OF THE FOLLOWING TWO DESIGNS:



&



AND

APPLICATIONS FOR INVALIDATION (Nos 41/17 & 42/17)

BY AYVA BRUSHES LTD

The background and the claims

1. These proceedings concern applications by Ayva Brushes Ltd (“Ayva”) to declare the above registered designs invalid. Both applications are based on the provisions of section 11ZA(2) of the Registered Designs Act 1949 (“the Act”), which reads:

The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the registered design objecting.

2. Proprietorship of designs registered under the Act are dealt with in section 2¹, the relevant parts of which read:

2. Proprietorship of designs

(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the “author” of a design means the person who creates it.

(4).....

¹ This takes into account the amendments made to the Act by the Intellectual Property Act 1994

3. It is also worth noting section 11ZB(5) of the Act, which reads:

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection.

4. The net effect of sections 11ZA(2) and 11ZB(5) is that a request to invalidate a registered design on the issue of proprietorship can only be made by the person claiming to be the true proprietor of the design.

5. Ayva claims to be the true proprietor of the designs because it says that they were created on behalf of Ayva by its co-founder and sole managing director, Ms Teresa Faleye. The designs are claimed to have been created on or before 24 May 2016 (600473, for what I will call the palette design), and on or before June 2016 (600525, for what I will call the brush design). It is claimed that Ayva's other co-founder (and former shareholder), Ms Risikat Jinadu, was privy to the designs, but when her shareholding in the company ceased she disclosed them to Ms Fadoula (the registered proprietor) who registered them with the intention of transferring them to Ms Jinadu, or Ms Jinadu's company, Eloise Beauty Limited ("Eloise").

6. Ms Fadoula filed counterstatements denying the grounds on which the applications are made. She claims that the designs were created in 2014 by her husband, Mr Babatunde Ogunsan, and that she filed them on his behalf. It is further claimed that Ms Jinadu was an acquaintance of Mr Ogunsan and that he gave permission for the development of his designs to be undertaken by Ayva; it is added that no design rights were transferred to Ayva. It is claimed that when Ms Jinadu left Ayva, the designs were filed to protect the rights in them, with the intention of developing them and bringing the products to market.

7. Although the proceedings were not formally consolidated, I will, for sake of procedural economy, deal with both proceedings in one single decision. However, I will ensure that I differentiate between the designs, and any relevant evidence, when it is necessary to do so. Neither side requested a hearing or filed written submissions. I will, of course, take into account any arguments that have been made in the papers

before me. Ayva has represented itself. Ms Fadoula has been represented by Derek Jackson Associates.

The evidence

Ayva's evidence

8. Ayva's evidence is by way of statement of case², provided with each of the Forms DF19A³ filed to request the invalidation of the respective designs. Although virtually identical, they appear to be signed by two separate individuals. Whilst difficult to clearly make out from the signatures the names of the persons who are giving evidence, one (the statement provided for design 6000473) can just about be read as Ms Faley. I will, therefore, give this due weight, as Ms Faley is clearly in a position to give the evidence she does.

9. On behalf of Ms Fadoula, witness statements have been provided by herself, Ms Jinadu and Mr Ogunsan. They too are clearly in a good position to give evidence.

10. I turn first to the evidence given by Ayva in its statement(s) of case. Before detailing the evidence, I record here that there is no dispute that Ms Faley and Ms Jinadu were the co-founders of Ayva and that in 2016 they worked together on designs in the make-up and beauty field. Ms Jinadu subsequently ceased being a shareholder and her role within the company ended in September 2016. It is stated that the designs the subject of these proceedings were created by Ms Faley on behalf of Ayva. The primary evidence filed in support of this is as follows:

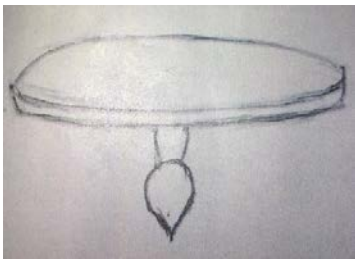
- Document A – this consists of WhatsApp messages containing a picture of an artists' palette. The messages, sent on 18 January 2016, include: "so we can create our own design", "U mentioned something with a knob", "Like the O circle?", "For your middle finger". It is stated that the messages were sent by

² Evidence may be given by way of statement of case, as per rule 21(1) of the Registered Designs Rules 2006.

³ The official form to request the invalidation of a registered design.

Ms Jinadu (from her mobile number, as detailed in the WhatsApp message) to Ms Faleye, asking about the palette Ms Faleye had apparently told her about which would have a knob.

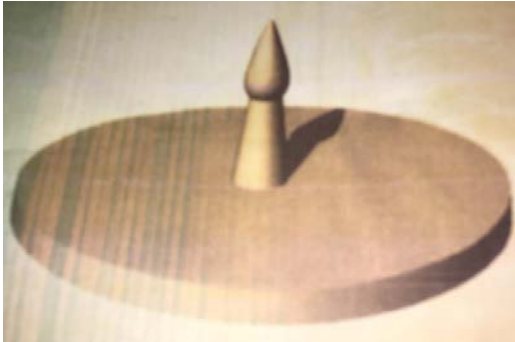
- Document B – this is another WhatsApp message dated 24 May 2016 but one which simply contains a sketch of the palette design. It is stated that this is the design created by Ms Faleye and sent to Ms Jinadu. The sketch looks like this:



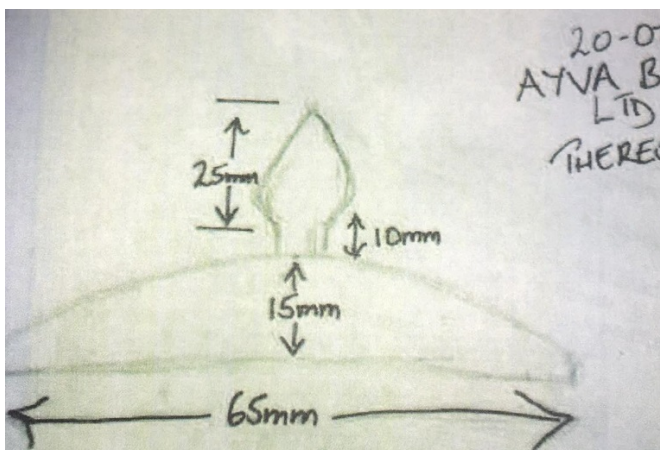
- Document C – this is another WhatsApp message dated 25 May 2016 containing two photographs of what is said to be a cardboard prototype of the palette design Ms Faleye had created. It is stated that this was sent by Ms Faleye to Ms Jinadu. The photographs look like this:



- Document D – this consists of an email dated 27 May 2016 from a company called Makestry Ltd to Ms Faleye (using an Ayva email address) in which it provides a 3D render of the palette design which Ayva had instructed to be created. The 3D render looks like this:



- Document E – this consists of an email dated 20 July 2016 from Ms Faleye (using an Ayva email address) to Makestry which is said to be part of a request for a 3D render of the brush design. Attached is a sketch of the design without bristles and which contains a handwritten date of 20 July 2016, together with Ms Faleye’s and Ayva’s name. It is stated that a copy of the design with bristles is no longer in Ayva’s possession, but it is identical to the subject (brush) design. The sketch of the brush without bristles looks like this:



11. It is stated that the designs created by Ms Faleye were shared in confidence with Ms Jinadu and that when Ms Jinadu left Ayva she “appears” to have disclosed the designs to Ms Fadoula, who subsequently registered them on 9 and 13 September 2016 respectively. Ayva “believes” that this was done so that they could later be

transferred to Ms Jinadu or her company Eloise. The reasons for this belief are as follows:

- Another design (no. 6000524) was filed by Ms Fadoula on 13 September 2016 and transferred to Eloise on 26 April 2017. Eloise was incorporated on 12 September 2016 and at that time was solely owned and directed by Ms Jinadu. It is added that the concept of design 6000524 was discussed between Ms Faleye and Ms Jinadu, but it was not considered to be one of Ayva's designs.
- Ms Fadoula does not operate any company in the beauty field, although she was once a sales representative selling cosmetics. Her occupation is now as a nurse.
- Ms Fadoula registered another design (no 6000526) on 13 September 2016 which is said to be similar to Ayva's EU trade mark (016305427) and EU design (003135755-0011).

12. It is stated that Ayva contacted Ms Fadoula with the above evidence and asked her for proof of ownership/creation. In response, Ayva was contacted by Mr Ogunsan who is claimed to have been evasive, but that he did say that he created the designs in 2014. It is stated that the applicant believes that Mr Ogunsan colluded with Ms Jinadu to falsely claim that Ms Fadoula was the owner of the designs to deprive Ayva of its rights – it is stated that Mr Ogunsan is now a director of Eloise.

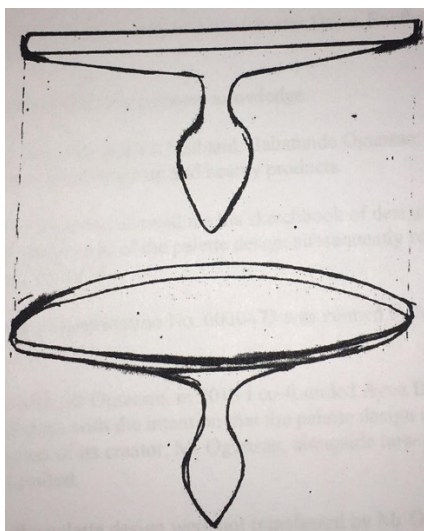
Ms Fadoula's evidence

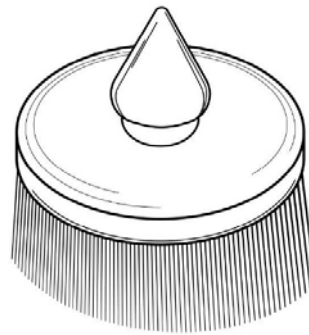
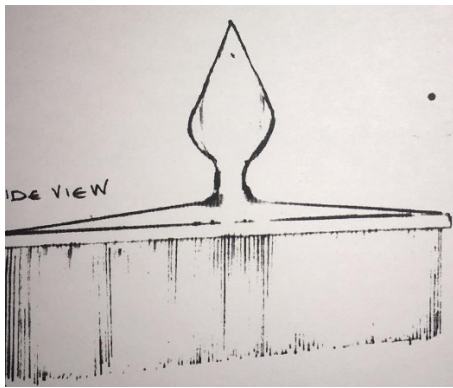
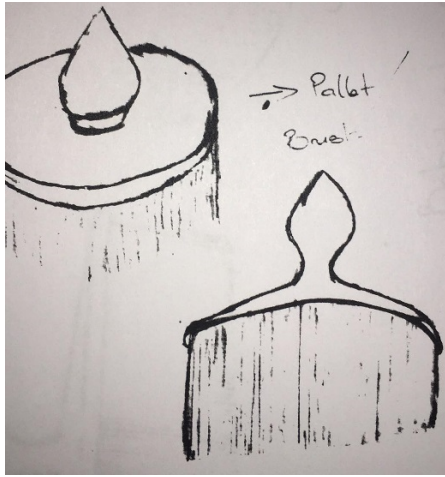
13. I turn first to Mr Ogunsan's evidence, which, to all intents and purposes, is identical for both proceedings. He states that:

- He created both designs in 2014, and provides a copy of sketches taken from his sketch book (Exhibit BO1, detailed below).

- He discussed the designs with Ms Jinadu in 2015 with the intention that she develop them.
- He did not assign his unregistered design rights either to Ayva, a company formed in 2016 by Ms Jinadu and Ms Faleye, or individually to either of them.
- When he learned that Ms Jinadu had left Ayva, the subject designs were filed in order to protect them so they could be developed and brought to market. The designs were filed by his wife, Ms Fadoula, on his instruction.
- At no time were any designs created by Ms Faleye, or on behalf of Ayva, disclosed to him.
- The designs were filed by Ms Fadoula on his behalf, no one else's, nor were they filed with the intention of transferring them to anyone else.

14. Exhibit BO1 contains a number of sketches dated in May and June 2014. I set out below what appear to be the most pertinent sketches, alongside illustrations of the designs as registered:





15. I next turn to Ms Jinadu's evidence, which sheds further light on her dealings with Mr Ogunsan. I note the following:

- She met Mr Ogunsan and Ms Fadoula in 2014 to discuss mutual business ideas in the field of make-up and beauty products.
- During 2014 Mr Ogunsan showed her his sketch book including the brush design and palette design.
- In 2016 Ayva was co-founded by herself and Ms Faleye with the intention of developing the designs with the permission of their creator Mr Ogunsan, alongside new products created by Ayva.
- The unregistered designs were not transferred by Mr Ogunsan, to Ayva, or herself.

- Along with Ms Faleye, she took steps to prepare prototypes of Mr Ogunsan's designs. Such preparations included considering the types of materials that could be used and obtaining 3D renderings. During this time, the designs were not commercially manufactured or disclosed to the public.
- In accordance with a shareholder agreement, Ms Jinadu ceased being a shareholder of, and working for, Ayva on 1 September 2016.
- Mr Jinadu informed Mr Ogunsan of the above, and she was subsequently informed that as a consequence of this the subject designs were filed to protect the rights in the designs.
- At no time has she disclosed to Mr Ogunsan or Ms Fadoula any designs created by Ms Faleye or on behalf of Ayva, nor did she instruct the filing of the subject designs or that it be filed on her behalf.

16. In relation to the palette design, and in response to the Ayva's evidence, Ms Jinadu's evidence is that:

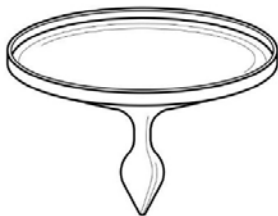
- The picture identified as document C is a cardboard prototype of the palette design. Ms Jinadu states that she took the photograph of a third person's hand holding the prototype and sent it to Ms Faleye. She disputes that Ms Faleye created it and contends that it was a prototype of the design created by Mr Ogunsan.
- The picture identified as document B is a sketch said to have been sent by Ms Faleye to Ms Jinadu on 24 May 2016. However, Ms Jinadu provides in her Exhibit RS01 a photograph of the sketch dated 26 January 2016. She states that she made the sketch of Mr Ogunsan's 2014 palette design and the photo taken to show Ms Faleye what they were intending to commercialise. There can be no doubt from the photographs in the evidence that these sketches are one and the same.

17. Ms Fadoula's evidence corresponds with that of Mr Ogunsan in terms of him creating the designs in 2014, her filing them in 2016 upon his instruction, that Ms Jinadu was to develop the designs and that when she left Ayva the designs were filed to protect the rights in the designs and to subsequently bring them to market. She confirms that no designs created by Ms Faleye, or on behalf of Ayva, were disclosed to her, and she confirms that the designs were not filed on behalf of anyone else (except Mr Ogunsan) and were not filed with the intention of transferring them to anyone else.

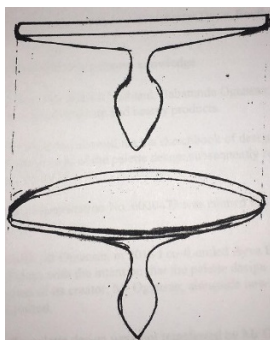
Decision

18. Given the relevant provisions, Ayva must not only establish that Ms Fadoula is not the proprietor of the design, it must also establish that it is in fact the true proprietor. It is therefore clear that the identification of the designs' creator is of paramount importance in this decision.

19. I deal first with the palette design, which as registered looks like this:



20. It is clear that the sketch in Mr Ogunsan's sketch book is extremely reminiscent of the above, the sketch looks like this:



21. On face value, there is nothing which casts any doubt that the sketches in the sketch book were drawn by him in 2014. The only doubt would come if I were to hold that they were fabricated for the purpose of these proceedings as part of the claimed ongoing collusion between him and Ms Jinadu. I have no submission to that effect from Ayva, let alone any direct evidence of this.

22. Both parties have provided a further sketch of the design which looks like this:



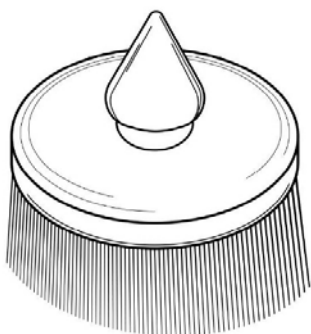
23. The sketch is relied upon by Ayva because it claims that it was sent by Ms Faleye to Ms Jinadu after Ms Faleye created it. However, Ms Jinadu provides evidence to show that in fact she sent the sketch to Ms Faleye first. She also claims to have drawn it, albeit it was based on Mr Ogunsan's sketch. Ayva did not respond to Ms Jinadu's evidence in relation to this.

24. Taking all of the evidence into account, Ms Jinadu's evidence is clear and direct. She drew the sketch that Ayva relies upon and sent it to Ms Faleye, the sketch being based on the one drawn by Mr Ogunsan in 2014. The prototype then clearly followed this, which Ms Jinadu states she photographed. In contrast, Ms Faleye's evidence is not compelling. There is nothing to explain when and how she actually created the design. Her supporting evidence that she sent a sketch of the design to Ms Jinadu has been undermined by Ms Jinadu showing that she sent it to Ms Faleye first. Whilst I note the first WhatsApp conversation where the concept of a palette design with a knob is referred to, this gets nowhere close to establishing that Ms Faleye created the design. In any event, and as has been mentioned in argument by Ms Fadoula's representative, it is not altogether clear who was speaking to who in that message, although I do not place significant weight on this point. The fact that Ayva subsequently arranged for 3D renders to be made makes no difference because this does not go to initial creation.

25. Further points have been made by Ayva in relation to other design applications that were made, one of which it says it did not own anyway, another which looks like a trade mark owned by Ayva. However, whilst in some circumstances similar fact evidence of this type may assist, it does not here in circumstances where the evidence of creation is so weak from Ayva and much stronger from the proprietor. Further, that the designs were filed by Ms Fadoula is not convincing evidence of any form of collusion as she filed them on behalf of her husband. Similarly, that Mr Ogunsan now apparently has a role within Eloise, is consistent with him wanting to develop the designs he created with Ms Jinadu (and her new company) and nothing more than that.

26. I come to the firm finding that the preferred view of the evidence is that whilst Ms Faleye and Ms Jinadu were clearly working together in relation to various designs, the palette design was first drawn by Mr Ogunsan, replicated by Ms Jinadu and then developed in terms of initial prototype and 3D render by Ayva. That means that Ayva cannot claim to be the true proprietor because the design was not created by it or on its behalf. There is no evidence of collusion and my finding is that Ms Fadoula filed her husband's design, based upon his original sketch, on his behalf. The application for invalidation fails.

27. I next consider the brush design, which looks like this:



28. There is less evidence in relation to this design, although, as set out earlier, there is evidence showing a similar sketch by Mr Ogunsan from 2014. Whilst, again, there is evidence of Ayva seeking a 3D render of the design (although there is no picture of the brush with bristles), this, as observed earlier, does little by itself to establish

creation. Absent evidence showing creation by Ayva, in circumstances where there is evidence of a sketch from 2014 by Mr Ogunsan then, again, I come to the clear finding that the design was not created by Ayva. This application for invalidation also fails.

Conclusion

29. Both applications have failed. The designs may remain registered.

Costs

30. The proprietor has succeeded and is therefore entitled to a contribution towards costs. I calculate these as follows, which covers both proceedings:

(i) £500 for the cost of considering the applications and preparing the counterstatements;

(ii) £1000 for filing evidence and considering the applicant's evidence.

31. I therefore order Ayva Brushes Ltd to pay Barbara Fadoula the sum of £1500. This sum is to be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the end of the appeal proceedings (subject to any order of the appellant tribunal).

Dated this 16th day of October 2018

Oliver Morris

For the Registrar,

the Comptroller-General