

**O-730-18**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN NO. 5000104**

**IN THE NAME OF FEEL GOOD UK**



**AND**

**THE REQUEST TO INVALIDATE THE REGISTRATION (NO. 7/18)**

**BY COZY PET LTD**

## **Background and pleadings**

1. The registered design which is the subject of this dispute was filed by Feel Good UK<sup>1</sup> (“the registered proprietor”) on 16 October 2015. The design is described on the application form as a “chicken coop”. There are four representations of the registered design attached to the application, as shown below:

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<sup>1</sup> Which appears to be a trading name of Clarke-Coles Ltd.



2. On 15 February 2018, Cozy Pet Ltd (“the applicant”) requested that the design be declared invalid under Section 1B of the Registered Designs Act 1949 (“the Act”), which requires that a registered design be new and have individual character. The applicant claims that the registered proprietor has sold such a chicken coop on

Amazon and Ebay since before the registered design was filed, attaching evidence of what it claims to be prior art which destroys the novelty of the registered design<sup>2</sup>.

3. A notice of defence on Form DF19B, which contains a statement of truth, was signed by Lauren Coles, who also identified herself on that form as the registered proprietor. Ms Coles disputed that the applicant's evidence shows that the proprietor sold the chicken coop outside of the 'grace period' (a reference to section 1B(6)(c) of the Act), thereby denying the ground alleged.

5. Both sides filed evidence. On 17 August 2018, Ms Coles emailed the Registry saying:

I have a query regarding an ongoing case where our design 5000104 is looking to be invalidated by a competitor. I understand you may not be able to make comment at all but wasn't sure how to proceed given some information which has come to light this week, it may not affect the ongoing case at all but I wanted to know if this information should be included in our final submission of evidence or if it should be left out as it may be of no relevance depending on how the case is decided.

It has come to our attention following a chance encounter with a former employee, who was in a very similar role to me but left shortly before I joined that 5000104 was not the earliest application of this design to the IPO office. The employee had designed the original prototype with our director and photographed the design from a sample before submitting the application to the IPO office on the 06th Sept 2014 (design 4037013). The employee had to leave fairly suddenly due to family illness and the certificate was misfiled, so at a later date when we were ready to import and market the design it appeared we did not have the certificate in place and a submission was made on Oct 16th 2015, it is this design which the applicant of the DF19A form is attempting to invalidate.

The earlier design (4037013) supersedes the later design (5000104), do you believe the case should be left to run and be decided on without this information as they are two stand alone designs, although we could rescind the later design if we wanted to. Or should I introduce this information despite it not being challenged by the applicant?

I appreciate you may not be able to comment at all but your thoughts would be appreciated.

6. Ms Coles also filed a witness statement dated 29 August 2018 in which she stated:

"It is my understanding that the applicant is the one who must provide conclusive evidence of this design being made available in the public domain

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<sup>2</sup> The application form includes a statement of truth, signed by Claire Woodhouse, meaning that the statement of case qualifies as evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006 ("the Rules").

before the registration period began in Oct 2014<sup>[3]</sup>, this should be provided as a clear representation of the design along with the date, this has not been provided, Cozy Pet have failed to provide the evidence required by the IPO. However, in recent days an encounter with a former employee who worked at Feel Good UK prior to my employment has brought about some new information which is further proof of our ownership of the design and shows an even longer history of the design being appropriately registered.

It appears that the first prototype of this design was photographed and submitted to the IPO on the 6th September 2014, the design which is registered as design 4037013 (doc 1) supercedes design 5000104 (doc 2)<sup>[4]</sup>. The reason this was not known to myself is the employee who submitted it left suddenly due to family illness and the certificate was not filed correctly, however, now it has come to light I can show that the applicant would need to show the design in question in the public domain before September 6<sup>th</sup> 2013<sup>[5]</sup>. We can categorically state the design in question was not sold on eBay until early 2015, as shown with our previous evidence which has yet to be disproved by the applicant, but the applicant can now only challenge the earlier design 4037013 by showing a representation of the design in the public domain before 6 September 2013.

Due to the employee leaving fairly suddenly and then the misfiling of the design certificate we submitted the design (5000104) in the Oct of 2015 which was around 9 months after the item first became available for sale to the public, we did not realise at the time the design was already protected by the earlier submission of design 4037013.

I have spoken to the IPO helpline who have advised that we can rescind the later design if we wanted to but the earlier design would remain in place offering protection on the design, however the fact a later, updated submission was made is not a problem.”

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<sup>3</sup> The contested design was not registered until October 2015.

<sup>4</sup> Docs 1 and 2 are copies of the details for 4037013 and 5000104 on the designs register.

<sup>5</sup> 4037013 was filed on 6 September 2014.

7. On 20 September, Ms Coles followed her email enquiry and witness statement with a letter to which was attached statutory Form DF19C 'Notice by proprietor to cancel a registration'. The letter was signed by Ms Cole and said:

“Owing to the discovery of the earlier design, predating the design in question we are submitting form DC19C for design 5000104.

Our discovery of the earlier design predates the submission of 50000104 and despite there being some minor changes to the design the overall impression would be deemed the same.”

8. The Registry wrote to the applicant on 21 September 2018 to enquire whether the applicant wished to continue with the proceedings, in the light of the proprietor having cancelled its registration. No reply was received from the applicant. As the proceedings are still extant, it is necessary, therefore, to decide the outcome of the applicant's cancellation action including the effect of the proprietor having cancelled its registration for the reasons it has given.

## **Decision**

9. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B reads:

“(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) .....

(9) ....”.

10. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked, unless the exceptions in subsection (6) apply. This means that the relevant date for my assessment is 16 October 2015.

11. Ms Coles, for the registered proprietor, has filed a request to cancel the registered design which is the subject of these proceedings, 5000104. She has explained in her email, witness statement of 29 August 2018, and letter attached to the cancellation form DF19C, that she considers 4037013 to constitute an earlier design which predates 5000104 and that “the overall impression would be deemed the same”.

12. 4037013 was applied for on 6 September 2014. 5000104 was applied for on 16 October 2015. 4037013 was, therefore, applied for over 12 months prior to the filing of 5000104, which means that the exception provided for under section 1B6(c) of the Act (“that it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date”), cannot apply. 4037013, having been applied for as a registered design, had been made available to the relevant public more than 12 months prior to the application date of 5000104 (also see section 11ZA(1A)(b)(i), below).

13. 4037013 constitutes prior art, in relation to which Ms Cole has stated that “the overall impression would be deemed the same” as for 5000104. She/the proprietor



has cancelled 5000104 on that basis. It is unnecessary for me to consider the applicant's evidence because the registered proprietor has, itself, stated that 4037013 "supercedes" 5000104. The effect of this statement, together with the other information provided by Ms Coles in her email, witness statement and letter attaching the form DF19C, is that the registered proprietor has itself admitted that prior art existed more than 12 months prior to the application date of 5000104. The consequence of the above is that at the relevant date, 5000104 was not new and did not have individual character, which means that it was invalid when applied for and registered.

14. Section 11ZA states:

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

(a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;

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

(c) where any ground of refusal mentioned in Schedule A1 to this Act applies.

(1A) The registration of a design ("the later design") may be declared invalid if it is not new or does not have individual character when compared to a design which—

(a) has been made available to the public on or after the relevant date; but

(b) is protected as from a date prior to the relevant date—

(i) by virtue of registration under this Act or the Community Design Regulation or an application for such registration, or

(ii) by virtue of an international registration (within the meaning of Articles 106a to 106f of that Regulation) designating the Community.

(1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later 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.

(2) ...

(3) ...

(4) ...

(5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.”

15. The proprietor, as set out earlier in this decision, has discovered it owns an earlier design registration which was made available to the public more than 12 months prior to the filing of 5000104. The establishment of this fact has come from the proprietor without it being necessary to assess the merits of the applicant’s evidence. On this basis, it appears that the ground of invalidity specified in the application has been established. I find that design registration (or former registration) 5000104 was invalid from 16 October 2015.

### **Outcome**

16. Registration 5000104 was invalidly registered from 16 October 2015.

17. Nothing I have said in this decision applies to design 4037013.

### **Costs**

18. The objective which the applicant set out to achieve was obtained owing to the proprietor's own admission that its registration was not new/did not have individual character at the relevant date. It has, therefore, been unnecessary to assess the merits of the applicant's evidence. The applicant states in its application for cancellation that the proprietor made an allegation that the applicant was infringing 5000104. That allegation was the catalyst for the application for cancellation. The applicant's statement is corroborated by the registered proprietor in its counterstatement. It was 5000104 which was the issue.

19. The applicant has unnecessarily been put to the trouble of seeking to have 5000104 declared invalid, when the registered proprietor itself has cancelled the design registration on the same grounds as the applicant has sought invalidation. It seems to me that, on that basis, the applicant is entitled to a contribution towards the costs of the proceedings, based upon the scale published in Tribunal Practice Notice 2/2016. The applicant is unrepresented, so would not have incurred the costs of legal representation. I award the official fee of £48 for filing the cancellation action. I also award £100 towards the cost of putting together the applicant's statement of case, which included an amount of evidence. I make no comment as to the efficacy of that evidence as it will be apparent from this decision that no assessment of evidence was necessary. The award merely reflects the trouble to which the applicant was put in filing an application to cancel 5000104 which the registered proprietor subsequently cancelled on the same ground as that sought by the applicant.

20. There is a question over the legal entity of the registered proprietor which has a bearing on who is liable to pay the costs award. The register records the owner of the cancelled registration as Feel Good UK. I note from the correspondence on the official file that the headed paper on which Ms Coles has written to the registry says "CLARKE-COLES LTD T/A Feel Good UK". Feel Good UK is a trading name, not a

legal person (corporate or otherwise). It is not, therefore, a legal entity capable of holding property<sup>6</sup>.

21. On the statutory Form DF19B which is the counterstatement, filled in by Ms Coles, she has identified herself, Lauren Coles, as proprietor, under box 3 "Full name of the proprietor". Ms Coles is a legal person. As Ms Coles has identified herself in these proceedings as the proprietor, she is liable for costs.

### **Cost order**

22. I order Lauren Coles to pay Cozy Pet Ltd the sum of **£148**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>th</sup> day of November 2018**

**Judi Pike**

**For the Registrar, The Comptroller-General**

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<sup>6</sup> Section 15A of the Act states: "A registered design or an application for a registered design is personal property (in Scotland, incorporeal moveable property)".