

O/0930/23

CONSOLIDATED PROCEEDINGS

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NOS 6168281 & 6168282
IN THE NAME OF A.K GARMENTS LTD**

AND

**THE APPLICATIONS FOR INVALIDATION THEREOF
UNDER NOS 111/21 & 112/21
BY MUHAMMAD USMAN NAZIR**

BACKGROUND AND PLEADINGS

1. A.K Garments Ltd (“the registered proprietor”) filed application no. 6168281 for a registered design for a 3-zips high visibility workwear pullover hoodie in Class 02, Sub class 02 of the Locarno Classification (Garments) on 1 October 2021. It was granted on 1 November 2021 and is depicted in the following representations:



2. The following disclaimer was entered on the register: *“No claim is made for the colour shown. We are claiming for the design, pattern and features, regardless of the colour.”*

3. On the same day, the proprietor also filed application no. 6168282 for a registered design for a 3-zips high visibility workwear zipper hoodie in Class 02, Sub class 02 of the Locarno Classification (Garments). It was granted on 1 November 2021 and is depicted in the following representations:



4. The following disclaimer was entered on the register: *“Don’t want to limit the rights in the design to the colour. We are claiming for the design features regardless of colour.”*

5. On 16 November 2021, Muhammad Usman Nazir (“the applicant”) applied for both registered designs to be invalidated. His claims are brought under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the designs did not meet the requirements of section 1B of the Act that designs must be new and have individual character compared to Registered Design Nos. 6141169 and 6141171 respectively, which the applicant claims were registered on 7 June 2021. The register says, however, that while they are registered with effect from 7 June 2021 (which was the application date), the grant of the designs took place on 9 November 2021 and the designs were published on 10 November 2021. The representations showing these designs can be found in the Annex to this decision.

6. The registered proprietor filed counterstatements denying the applicant’s claims. It admits that the registered designs that the applicant relies on were registered before

the contested designs but claims that it has made its designs available to the public before 7 June 2021, but within the 12-month “grace period” in which a designer may make their design public without destroying its novelty for the purposes of registration.

7. Both parties filed evidence which is briefly detailed below.

8. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, both parties are unrepresented.

EVIDENCE

9. The applicant’s evidence comes from Mr Nazir, who is the Director of DU Apparel Ltd. His witness statement is dated 10 May 2022 and is accompanied by four exhibits.

10. The registered proprietor’s evidence comes from Irfan Khan, who is the manager of A.K Garments Ltd. His witness statement is dated 22 June 2022. He states that the proprietor has been selling the contested designs since February 2021. Eight exhibits accompany the witness statement.

DECISION

11. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid–

...

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

12. Section 1B of the Act is 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 or no 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 account.

(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 geographical area comprising the United Kingdom and 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 conditions 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 period of 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.

...”

13. The relevant date is the application date for the contested designs, i.e. 1 October 2021.

14. The first issue I must address is whether the designs relied upon by the applicant constitute prior art. This requires the designs to have been made available to the public. Section 1B(5) gives a number of examples of how this might be done. The design may be offered for sale, shown at an exhibition, or published, including after registration.

15. It is clear that the applicant had applied for Registered Design Nos 6141169 and 6141171 before the registered proprietor had applied for the contested designs. The applicant did not claim in its initial statement of grounds that it had used its own registered designs before applying for them. However, in his witness statement, Mr

Nazir states that his firm received and sold the first shipment of the 6141169 and 6141171 designs on 18 August 2020, about ten months before the applications for these designs were filed.

16. Mr Nazir's evidence consists of the following exhibits:

- Exhibit 1 contains an invoice addressed to DU Apparel Ltd from Knitwear Textile UK Ltd, which states that it is an importer and exporter of clothing. The invoice is dated 18 August 2020. It records orders of 200 "hi viz pullover(s)" and 195 "hi viz zipper(s)";
- Exhibit 2 is a bill of lading stating that 4000 kg of garments were shipped to Knitwear Textile UK Ltd from Pakistan on 16 July 2020;
- Exhibits 3A and B contain two pairs of line drawings showing front and back views of a hoody with a zip and a pullover hoody, which Mr Nazir claims to be artwork for Registered Designs Nos 6141169 and 6141171. Both drawings are described as having an orange body. In the bottom right corner is a signature with the word "Approved" and the date 7 February 2020. There is no other identifying information. I note that the signature is similar to the beginning of Mr Nazir's signature on his witness statement;
- Exhibit 4 is a proforma invoice addressed to DU Apparel Ltd from Knitwear Textile UK Ltd dated 7 April 2020, showing a delivery date of 1 July 2020 for 200 "Hi Viz Hood Top(s) with Zip Pockets" and 200 "Hi Viz Zipper Hood Top(s) with Zip Pockets".

17. The registered proprietor challenges this evidence. In particular, it notes that there are no images of any goods having been made available to the public and that it is not possible to tell from the invoices whether the goods in question were the 6141169 and 6141171 or some other "hi-vis" designs. It also states that the contested registered designs have been available to the public since February 2021 and provides dated screenshots of WhatsApp messages advertising the garments.

18. In *Glimarpol sp. z o.o. v European Union Intellectual Property Office*, Case T-748/18, the General Court said:¹

“22. Disclosure of an earlier design cannot, however, be proven by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of actual disclosure of the earlier design on the market. In addition, the items of evidence adduced by the applicant for the declaration of invalidity must be assessed in relation to each other. Although some of that evidence may be insufficient in itself to prove disclosure of an earlier design, when combined or read in conjunction with other documents or information, it may nevertheless contribute to establishing disclosure. Finally, in order to assess the evidential value of a document, it is necessary to verify whether the information which that document contains is plausible and accurate. It is necessary to take account of, *inter alia*, the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears to be sound and reliable (judgment of 17 May 2018, *Bicycle baskets*, T-760/16, EU:T:2018:277, paragraph 42 and the case-law cited).”

19. I agree with the applicant that the invoices and the bill of lading do not specify whether the garments were the 6141169 and/or 6141171 designs or not. Mr Nazir’s witness statement does not explicitly say that the documents relate to the applicant’s designs, although he unequivocally states that those designs were first sold on 18 August 2020 and I note that this is also the date of the invoice from the importer in Exhibit No. 1. The drawings in Exhibit 3 are the only evidence containing any images. These show that designs were produced and approved on 7 February 2020, but these do not appear to be exactly the same as the applicant’s registered designs which are both a yellowy green in colour, rather than orange as indicated by the drawings. No disclaimer as to colour has been entered on the register and so these are not evidence

¹ Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Registered Designs Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the design case-law of the EU courts, although the UK has left the EU.

of the design and approval of the 6141169 and 6141171 designs. The applicant's case therefore depends on my accepting the narrative evidence in the witness statement.

20. The weight to be attached to a witness's evidence has been considered more frequently in trade mark proceedings than in registered design proceedings. However, it seems to me that the same principles would apply here. In *Robot Energy Limited v Monster Energy Company*, BL O/308/20, Ms Emma Himsworth QC, sitting as the Appointed Person, reviewed the case law as set out in *Pan World Brands v Tripp (EXTREME)* [2008] RPC 2, *Williams and Williams v Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32 and *Advanced Perimeter Systems Ltd v Keycorp Ltd (Multisys Trade Mark)* [2012] RPC 14. She noted that, where the truth of a witness's evidence was challenged during the written stage of the proceedings, the requirement set out in *EXTREME* to accept evidence that was not challenged through cross-examination, did not apply:

"73. ... It is necessary to form a view as a matter of judgment whether the evidence is sufficient to establish the relevant fact which requires, as the Hearing Officer correctly said, the decision taker to consider the evidence as a whole. That the Hearing Officer took this view is entirely consistent with the guidance set out in *CLUB SAIL* (and *EXTREME* and *MULTISYS*). This includes weighing up in particular (1) the power of one side to produce the evidence and the other to contradict it; and (2) the plausibility of the positions that have been adopted in the context of the evidence as a whole which entails where the parties have elected to proceed without cross-examination accepting that the evidence of one witness might be found to have been disproved or displaced by the evidence of another."

21. It should have been possible for the applicant to provide some visual evidence of the designs on sale or advertised to customers. I consider that it is significant that it has not done so, particularly in response to the proprietor's challenges to its evidence. It had the opportunity to file evidence in reply, but chose not to do so. In my view, the evidence of the witness statement that "*First shipment received and sold on 18th August 2020*" is somewhat imprecise. Mr Nazir does not say where the goods were sold or the manner in which they were sold and if they are likely to have come to the

attention of the public at this point. This is information that should have been within his power to provide. Consequently, I find that the applicant has not shown that the registered designs were made available to the public before the relevant date of 1 October 2021 and therefore the applications for declarations of invalidity have failed.

OUTCOME

22. The applications for declarations of invalidity have failed and Registered Designs Nos 6168281 and 6168282 remain registered.

COSTS

23. The registered proprietor has been successful and would in the circumstances be entitled to a contribution towards the costs of the proceedings. As the registered proprietor is unrepresented, it was invited to complete a proforma with details of the time spent on particular activities associated with the proceedings. It was informed that if the proforma were not completed and returned, costs, other than official fees arising from the action, may not be awarded. As no proforma was received, and the registered proprietor has incurred no official fees, I make no award of costs.

Dated this 2nd day of October 2023

Clare Boucher

For the Registrar,

The Comptroller-General

Annex

Registered Design No. 6141169



Registered Design No. 6141171

