

**O/0794/24**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF: REGISTERED DESIGN No. 6183870**

**IN THE NAME OF NIMA ARAN IN RESPECT  
OF THE FOLLOWING DESIGN:**



**AND**

**AN APPLICATION FOR INVALIDATION (No  
193/23) BY ZEYSHAN MAHMOUD**

1. These proceedings concern an application by Zeyshan Mahmoud (“**the Applicant**”) to declare the above UK registered design (“**the Contested Design**”) to be invalid under section 11ZA(1)(b) of the Registered Designs Act 1949 (“**the Act**”). The Contested Design had been applied for on 20 January 2022.
2. The Applicant claimed that the Contested Design was not new and/or lacked individual character, when compared with earphones offered for sale to the public “from many third party websites”. The Applicant’s Form DF19A included a still image of an earphones product incorporating the Contested Design from a YouTube video on the 1st July 2021.
3. Nima Aran (“**the Proprietor**”) filed a Form DF19B in defence. Having considered the Proprietor’s brief accompanying counterstatement and supporting images, the Tribunal wrote to the parties on 25 June 2024 as follows:

*“We refer to the Form DF19B filed by the Proprietor of design number 6183870.*

*The Proprietor there states: “We have been selling this design on eBay since 23 January 2021. We brought this design to the UK first.”*

*It then shows a screenshot of a listing which the Tribunal understands to be stating that the listing was live on eBay on the Proprietor’s “online-global-sourcing” account*

*(i) at the time that it began selling the ear pods in question and*

*(ii) at the time that it applied to register the contested design. It states that the account remains active.*

*The attention of the Proprietor is drawn to the following provisions of the Section 11ZA(1)(b) of the Registered Designs Act 1949 (emphasis added in italics):*

***“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”.

**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 has been made available to the public before the relevant date.**

[....]

**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.*

*The Proprietor states that it has been selling this design on eBay since 23 January 2021. The application to register the design (“the relevant date”) was made on the 20 January 2022. Therefore, by the Proprietor’s own admission registered design had been “published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before the relevant date”.*

*As a result of that disclosure, the contested design will be invalid unless the disclosure is one that fits within subsection 6 above. If a limb of subsection 6 does apply the Proprietor must specify that in its DF19B. It will also need to be able to prove any such claim during the evidence rounds.*

*The Proprietor is asked to confirm whether it seeks to rely on any disclosure within subsection 6 and if it does, it must file an amended DF19B within 14 days – by Friday 5 July 2024.*

*If it is not able to claim that subsection 6 applies, the design will be invalidated and there will be no need to progress to the evidence rounds.*

4. The Tribunal received no response from the Proprietor to the above letter, which it had sent to the Proprietor’s address as recorded on the design examination system. The letter was sent by tracked and standard delivery, but both dispatches were returned marked as no longer at that address. The correspondence was also issued by email, which the Proprietor is presumed to have received, because the Proprietor filed a defence through that route.
5. As can be seen, the novelty in a design is destroyed if an identical design (or one having the same overall impression) has been made available to the public before the

relevant date. The relevant date is the filing date of the design: 20 January 2022. Some disclosures are excluded from the assessment as per section 1B(6), which deals with disclosures in the 12 months before the relevant date, or disclosures made under condition of confidentiality, or disclosures that are very obscure, none of which the Proprietor claimed in its Form DF19B. It is important to note that it does not matter who made the disclosure. A novelty-destroying disclosure can be made even by the rightful owner of the design (unless one of the exceptions apply).

6. In view of the fact that the Proprietor's own account in its counterstatement is that the design was disclosed before the relevant date, and in the absence of any reason to exclude the disclosures made, it follows that the registered design must be declared invalid. It was not novel when the design was filed.
7. The Contested Design registration No. 6183870 is hereby declared invalid.

### **COSTS**

8. As the Applicant has been successful in these curtailed proceedings, it is entitled to an award of costs, as governed by Annex A of Tribunal Practice Notice 1 of 2023. My assessment is as follows:

Official fee for application to invalidate: £48

Statement of case and considering the counterstatement: £250

Total: £298

9. I order Nima Aran to pay Zeyshan Mahmoud the sum of £298. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of August 2024**

**Matthew Williams**  
**For the Registrar,**  
**the Comptroller-General**