

**O/0875/24**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 4024648**

**IN THE NAME OF CHRISTOPHER RIDDELL**

**IN RESPECT OF THE FOLLOWING DESIGN**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 72/23)**

**BY WILLIAM BENTON**

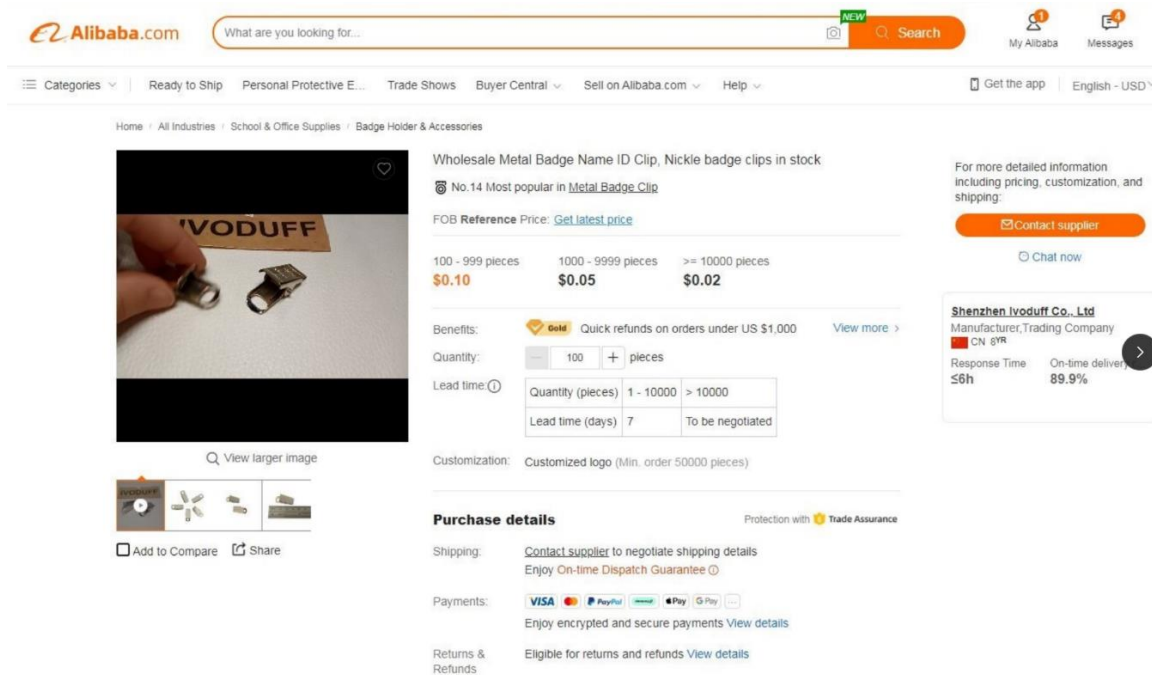
## Background and pleadings

1. Christopher Riddell (“the proprietor”) filed application no. 4024648 for a registered design for a metal clip on 9 May 2012. It was registered with effect from that date and is depicted in the following representations:



2. On 4 April 2023, William Benton (“the applicant”) made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the metal clip was not designed by the proprietor and is available on Alibaba from ‘various sellers’ meaning that it lacks novelty and individual character. A link was provided, without any indication of what that link showed.

3. Following receipt of the cancellation application, the tribunal requested a copy of the page shown in the link provided in the applicant’s form. The following was provided:



4. The registered proprietor filed a counterstatement to the application for invalidation, dated 7 June 2023, denying the applicant’s claims. He states:

*“...Mr Benton has failed to provide any substantiating evidence demonstrating the existence of a product identical or substantially similar to my design prior to my application.”*

5. Neither side filed evidence. The proprietor filed written submissions, dated 16 August 2023. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. Both sides are litigants in person.

## DECISION

6. 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”.

7. 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.”

### **Prior Art**

8. On 3 May 2023, the tribunal wrote to Mr Benton informing him that the print he had provided with his cancellation application did not include a date to show that it was on the Alibaba website before the contested design was made available to the public. Mr Benton was asked to provide ‘a version containing dates’.

9. On 4 May 2023, Mr Benton sent an email to the tribunal stating that he could not provide a date when this item was first available, but submitted that, *“This item was available when I was in school in the seventies as we used them for making id badges”*.

10. On 23 May 2023, the tribunal wrote to Mr Benton. That letter included the following:

*“The form DF19A stipulates that you tell us when and how the earlier design was made available to the public. Therefore, to say it was available in the seventies is not sufficient. As these are legal proceedings, in order for case to continue the registry needs you to provide the following information:*

- *A representation (image) of the product that was made available.*
- *To be told when that product was made available e.g. an exact date or a month and year, or in some cases a specific year. (The date needs to be before the date the design was applied for so in this case before 9 May 2012).*
- *To be told how it was made available to the public on the date given.*

*It has been noted that the print outs provided to do not display a date that the item was first made available. Neither have you told us when the screen shot was taken or when the listing was first made available on the website shown.”*

11. Mr Benton replied on the same day, reiterating his position that providing a dated picture of when the clips were first made available to the public would be difficult as, *“they have been on the market for many years”*.

12. With his email he included a screenshot of an email, dated 8 April 2011, that Mr Benton says is an order placed by him with his supplier for 10,000 metal clips, identical to the contested registered design. He included a photograph of clips he has in stock. The photograph is undated.



13. Following the filing of the defence by the proprietor, Mr Benton sent an email to the tribunal, dated 4 July 2023. It included the following:

*“As previously mentioned I cannot provide a picture of the badge clip as it has been around way longer than claimed. Finding a picture with a date stamp would be virtually impossible. I have provided an email that tells you I originally bought the clip before Mr Riddell registered it as his design.”*

14. In addition to his submissions that the contested registered design has been available for many years, Mr Benton’s evidence is:

- a US page from Alibaba, that does not show the metal clips in the picture to have been available to the public prior to the proprietor’s application for the registered design.

15. Mr Benton also sent the following by email:

- An email requesting the purchase of 10,000 metal clips, that are not shown in the email.
- An undated photograph of bags of clips on a shelf.

16. It is necessary in design cancellation cases for the applicant to provide at least one example of the claimed earlier design having been made available to the public prior to the application for the contested design. This is commonly achieved through the use of internet archive services, or online stores that show the dates when products were first offered for sale on those marketplaces.

17. The material provided by Mr Benton falls short of providing a dated example of prior art. The US Alibaba page, which is the only evidence on file, does not show a date when the product was offered for sale. The advertising at the top of the page would seem to indicate that it was printed contemporaneously with the cancellation application.

18. The statements made by Mr Benton are not in evidential form, but even if they were, the burden of proof is on Mr Benton and an unsupported assertion, lacking in any detail, is not sufficient to discharge that burden. This is because, in order to make a determination concerning Mr Benton’s application to cancel the contested design, I must have an example of a claimed earlier design being available on a specific date, earlier than the date of the registered design and I must be able to see the

characteristics of the earlier design in sufficient detail to be able to compare it with the contested design.

19. With regard to Mr Benton's purchase of clips from a supplier in April 2011, this is not filed as evidence, but even if it were, it does not show the appearance of the purchased clips, nor does it show that they were offered to sale to the public. If I could determine the characteristics of the metal clips shown in the photograph of bags of clips that Mr Benton keeps in stock, I could not be sure of the date they were purchased or where they were purchased from.

20. In the absence of prior art, the cancellation application fails.

## **CONCLUSION**

21. The application for invalidation against Registered Design No. 4024648 has failed and it will remain registered.

## **COSTS**

22. 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, he was invited to complete a proforma with details of the time spent on particular activities associated with the proceedings. He 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 incurred no official fees, I make no award of costs.

**Dated this 10<sup>th</sup> day of September 2024**

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**