

O/0991/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF

REGISTERED DESIGN NO. 6208374

IN THE NAME OF

KL TEK LTD

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 55/24

BY YOUSUF IBRAHIM

Background and pleadings

1. Registered design number 6208374 (“the contested design”) was filed on 16 May 2022 and was registered with effect from the same date. It stands in the name of KL Tek Ltd (“the proprietor”). These are the illustrations showing the contested design:



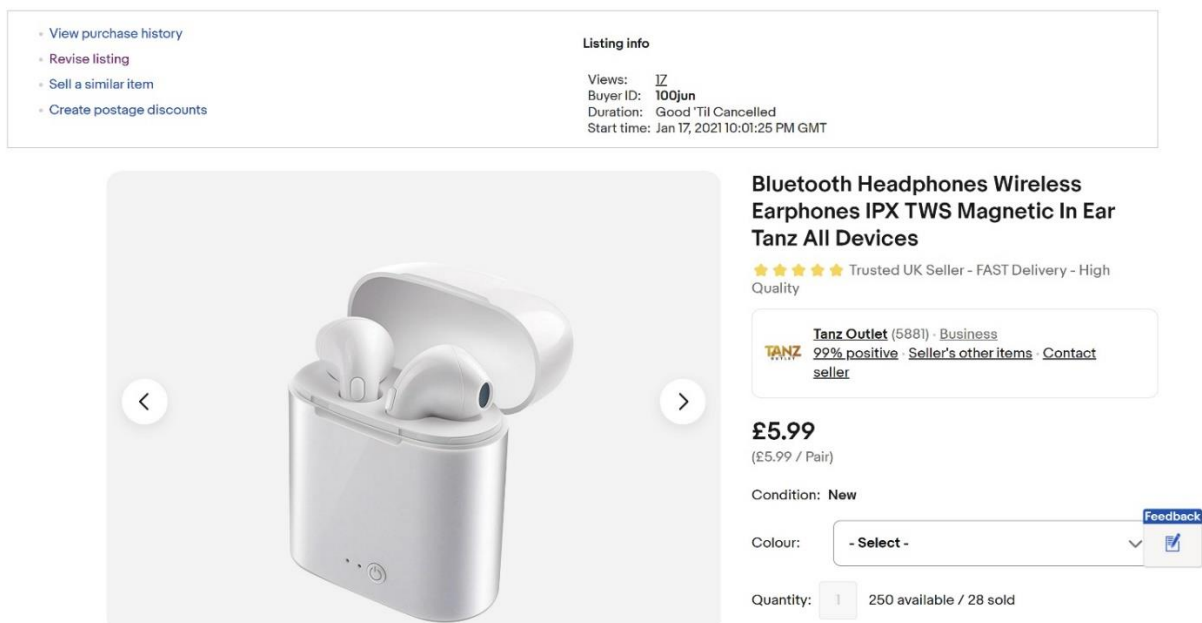
2. The product indication is given as “wireless earphones” and the design is registered as “recording, telecommunication or data processing equipment”, “equipment for the recording or reproduction of sounds or pictures” in class 14-01 of the Locarno classification system.

3. On 6 February 2024, Yousuf Ibrahim (“the applicant”) applied for the registration of the design to be declared invalid under s. 1B, given effect by s. 11ZA(1)(b), of the Registered Designs Act 1949 (“the Act”). The applicant says that the contested design is not new, nor does it have individual character, compared to other designs made available prior to the relevant date. In particular, the applicant relies upon products made available on eBay from December 2021.

4. The proprietor filed a defence and counterstatement. It was not initially clear whether the counterstatement related to the contested design or another case. Consequently, the tribunal wrote to the proprietor seeking clarification. The proprietor filed an amended counterstatement, which reads:

“We have been selling this design on eBay since 17th Jan 2021. We brought this design to the UK first. Below, I have attached the screenshot of our listing which was live at the time on eBay on our account online-global-sourcing. This account belongs to me and is still active.”

5. This image is attached to the amended counterstatement:



6. After considering the amended counterstatement, the tribunal issued a preliminary view that, as the proprietor had confirmed that the design was disclosed on 17 January 2021 and did not rely upon any of the exceptions at s. 1B(6), a decision may be issued invalidating the design on the basis of prior disclosure.

7. The parties were offered the chance to be heard if they disagreed with the tribunal's preliminary view. Neither party requested a hearing.

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

“The registration of a design may be declared invalid –

(a) [...]

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

9. Section 1B of the Act, so far as is relevant, reads 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."

10. A design may only be registered if it is new and has individual character. A design is new if no identical design has been disclosed before the relevant date; it has individual character if there has been no disclosure of a design giving the same overall impression to the informed user before the relevant date. The relevant date is the date of application for the registered design which is, in the present case, 16 May 2022. Some disclosures are excluded from the assessment. These are identified at s. 1B(6). Two points are important to note: first, none of the exemptions at s. 1B(6) is claimed in this case; secondly, unless one of the exceptions at s. 1B(6) applies, it does not matter who made the disclosure. The rightful owner of the design can still destroy the novelty of a design by disclosing it.

11. In view of the fact that the proprietor has claimed (and provided evidence) that the design was disclosed on 17 January 2021 and in the absence of any reason to exclude the disclosure made, the registered design must be declared invalid. The design was not novel when it was filed.

12. Design registration 6208374 is hereby declared invalid.

Costs

13. As the applicant has been successful, it is entitled to an award of costs. The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction set the amount payable to litigants in person at £19 per hour. I order KL Tek Ltd to pay Yousuf Ibrahim the sum of £181, calculated as follows:

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| Official fee: | £48 |
| Filing the application form and considering the counterstatement: | £76 (4 hours) |
| Filing written submissions: | £57 (3 hours) |
| Total: | £181 |

14. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 16th day of October 2024

Heather Harrison

For the Registrar,

The Comptroller-General