

BL O/1123/24

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN No. 6287701:



IN THE NAMES OF

AYUS DESIGN LLP, DEEPUK DEHOKENANAN AND ROSHUN DEHOKENANAN

AND

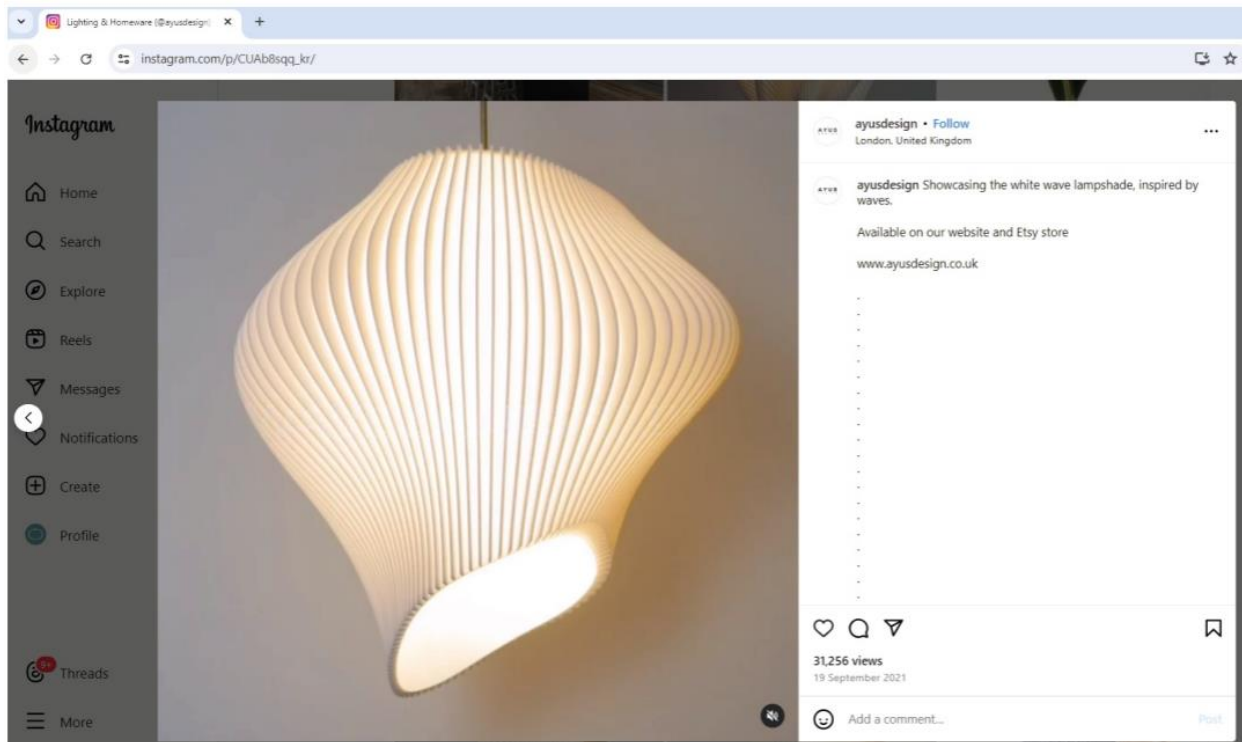
APPLICATION FOR ITS INVALIDATION (No. 162/24) BY GARY KINGTON

BACKGROUND AND PLEADINGS

1. Ayus Design LLP and Deepuk Dehokenanan and Roshun Dehokenanan (“**the Proprietors**”) filed Application No. 6287701 for a registered design for “lighting apparatus” in Class 26, Sub class 5 of the Locarno Classification (lamps, standard lamps, chandeliers, wall and ceiling fixtures, photographic and cinematographic projector lamps) on 4 June 2023. The design was registered with effect from that date (“**the Relevant Date**”). The register shows the design depicted in nine representations, including that shown below.



2. On 1 July 2024, Gary Kington (“**the Applicant**”) requested that the registered design be declared invalid under Section 1B/11ZA(1)(b) of the Registered Designs Act 1949 (as amended) (“**the Act**”), which requires that a registered design be new and have individual character.
3. The Applicant’s claim stated that evidence showed that the lampshade design was publicly available for purchase online more than 12 months before the Relevant Date - specifically, a post on the Instagram account of Ayus Design, dated 3 June 2021. The DF19A referred to there being other examples of lamps in the public domain more than 12 months before the design was filed that have “the same look and character”. The Applicant included in support of statement of case, seven exhibits, five of which were Instagram posts from the account of Ayus Design, dated between 29 April 2021 – 24 October 2021 showing the lampshade design and stating that it was available for sale from its website and Etsy store, as shown in the example below:



4. The registry served the invalidation application on the Proprietors, who responded by filing a Form DF19B Notice of Defence, including a counterstatement commenting on the seven pieces of evidence filed by the Applicant. In respect of the five posts from the account of Ayus Design, the counterstatement responded only to say that “statements and documents submitted in support of an application for invalidity must be truthful and not misleading” and that:

“the statement of grounds submitted is untrue and false. Specifically, the application relies on facts and materials that are sourced from our copyrighted material without proper authorization. This constitutes a clear violation of copyright law.

The misuse of copyrighted material and the submission of false statements severely undermine the credibility of the invalidation application. According to the UK Design Rules 2006, such actions are not compliant with the regulations that govern the submission of documents and statements in these proceedings.

1) *Ayus Design is the rightful copyright owner of Design Number 6287701, as we are the original creators and sole proprietors of this design.*

- 2) *The Design is protected by copyright and permission was not obtained from the copyright holder making this application invalid.*
- 3) *Inadmissibility of Unsupported and Unfounded Evidence.”*

THE LEGISLATION

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

“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”.

6. 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.

(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.

(8)

(9)”.

DECISION

7. Having reviewed the content of the Form DF19B and counterstatement from the Proprietors, the registry sent an official letter on 16 October 2024 to each of the three Proprietors. The official letter read as follows:

“I refer to the form DF19B filed in defence of the application to invalidate registered design number 6287701.

The applicant’s claim is that the registered design is invalid because it had been made available to the public before 4 June 2023 - the application/registration date of the registered design. It was therefore not new at the relevant date and consequently cannot be validly registered. The claim and evidence is that in 2021 the lampshade design had been posted repeatedly on the Instagram of Ayus Design and is stated therein as available through your Etsy store and website.

The proprietor’s defence is that it had copyright in the images given in evidence. This is not relevant. It does not appear that the proprietor denies that the images were posted more than 12 months before the relevant date.

It is the preliminary view of the Tribunal that:

- *The proprietor’s stated position amounts to an admission that the registered design had been made available to the public before 4 June 2023,*

and that it therefore follows that the design is invalid because it fails to meet the requirements of section 1B of the Registered Designs Act 1949.

- In the circumstances, the application to invalidate must succeed.*

The parties have until 30 October 2024 to notify the Tribunal if they wish to challenge the above preliminary view. If there is no argument against the preliminary view, then the registered design will be invalidated.

- The electronic case file shows proof of delivery of the above official letter to the Proprietors, but the Proprietors did not respond to the preliminary view by the deadline, or at all.

OUTCOME

- Since there does not appear to be a valid defence. The application for invalidation is successful. Design No. 6287701 is declared invalid and will be removed from the register as if the design application had never been made.

COSTS

- The applicant has been successful and is entitled to a contribution towards its costs based upon Tribunal Practice Notice 1/2023, as follows:

Statutory fee for DF19A	£48
Filing the DF19A	£200
Total	£248

- I order Ayus Design LLP, Deepuk Dehokenanan, and Roshun Dehokenanan to pay to Gary Kington the sum of £248. This sum (which is a total) is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of November 2024

Matthew Williams

For the Registrar, The Comptroller-General