

O/0646/25

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6154438
IN THE NAME OF ERKAN FAKILI
IN RESPECT OF THE FOLLOWING DESIGN**



**AND
AN APPLICATION FOR INVALIDATION (NO 24/25)
BY
GEORGE RYE & SONS LTD**

Background and pleadings

1. Erkan Fakili (“the registered proprietor”) filed application no. 6154438 for a registered design for a shoe in Class 02, Sub class 04 of the Locarno Classification (Footwear, Socks and Stockings) on 12 August 2021. It was registered with effect from 16 November 2021 and is depicted in the following representations:



2. On 21 January 2025, George Rye & Sons Ltd (“the applicant”) applied 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 design did not meet the requirements set out in section 1B of the Act that a registered design should be new and have individual character. The applicant claims that it first marketed shoes to the

design in April 2019. It further claims that between 2019 and 2024 it sold the product to more than 250 UK retailers.

3. The registered proprietor filed a defence and counterstatement on 19 March 2025, denying the applicant's claims. In particular, the proprietor stated that it had been selling 'this shoe' since 2018 in its bag and shoe store.

4. The Tribunal wrote to the proprietor, outlining the relevant legislation and requesting clarification of the date on which the design was first made available in the UK. It said:

“You make reference to the fact that you have been selling the shoe since 2018. Please can you clarify if you are claiming to have made the design available to the public in 2018. If so, this may invalidate your design which has a filing date of 12 August 2021.”

5. The proprietor filed an amended counterstatement with email and invoice evidence that supported its claim that the shoe was put onto the UK market in November 2018.

6. After considering the evidence, the Tribunal wrote to the parties, highlighting that the proprietor had confirmed that the design it had registered was disclosed more than 12 months before the application was filed in the UK. It confirmed the Registrar's preliminary view was that the design was invalid, due to prior disclosure.

7. The parties were given an opportunity to request a hearing if they disagreed with the preliminary view. The proprietor requested a hearing and a case management conference (CMC) was held on 10 July 2025.

8. At the CMC the proprietor did not seek to amend its claimed date of first use of this design but asked that I take its unregistered rights into account. In submissions filed prior to the CMC, the proprietor also suggested that a design held by the cancellation applicant is also invalid.

9. I explained why it was not possible for me to consider unregistered design rights and pointed the proprietor to relevant resources, in the event it wants to rely on

unregistered design rights in other proceedings. I also advised the proprietor that designs held by other parties cannot be invalidated by raising them in unrelated registered design proceedings. If the proprietor wants to challenge a registered design, it should file a cancellation application against that design. I note this point was also clarified by the tribunal caseworker in the first response to the proprietor's defence.

10. With regard to the proprietor's disclosure of this design in the UK in November 2018, I clarified that there is no discretion available to me where a design has been disclosed more than a year before application.

11. I issued a letter later the same day to confirm the outcome of the CMC and advised that a decision would follow shortly after that. This is that decision.

12. Section 11ZA(1)(b) of the Act reads as follows:

“(1) 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”.

13. Section 1B of the Act 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."

Conclusion

14. 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, and 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: in this case, 12 August 2021. Some disclosures are excluded from the assessment as per section 1B(6), which deals with disclosures in the 12 months before the relevant date (which does not apply here and the design was disclosed more than 12 months before the relevant date) or disclosures made under condition of confidentiality, or that are very obscure, none of which has been claimed.

15. 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).

16. In view of the fact that the proprietor has claimed (and provided evidence) showing that the design was disclosed more than 12 months before the design was applied for 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.

17. The design registration is hereby declared invalid.

Costs

18. As the cancellation applicant has been successful, it is entitled to an award of costs. My assessment is as follows:

Official fee for application to invalidate: £48

Statement of case and considering the counterstatement: £200

Total: £248

19. I order Erkan Fakili to pay George Rye & Sons Ltd the sum of £248. 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 July 2025

AI Skilton

For the Registrar,

The Comptroller-General