O/1006/26

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO 6297318

IN THE NAME OF YAMI ZHONGCHUANG (WENZHOU) TECHNOLOGY CO., LTD

IN RESPECT OF THE FOLLOWING DESIGN



AND

AN APPLICATION FOR INVALIDATION NO 266/24

BY YANG YIGEN

BACKGROUND AND PLEADINGS

1. These proceedings concern an application for a declaration of invalidity against Registered Design No. 6297318 ("the contested design"). On 19 July 2023 ("the relevant date"), Yami Zhongchuang (wenzhou) Technology Co., Ltd ("the registered proprietor") applied for it to be registered. It was entered on the Register on 25 July 2023 and published on 26 July 2023. The indication of product is recorded as *Scooter lock*.

2. The design is depicted in the following representations:

Illustration 1



Illustration 2



Illustration 3



Illustration 4



Illustration 5



Illustration 6



Illustration 7



Illustration 8



Illustration 9



Illustration 10



3. On 31 October 2024, Yang Yigen (“the applicant”) filed an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”). He claims that the design is not new and lacks individual character under section 1B of the Act compared to the following designs, which he claims were made available to the public on the dates shown below:

Prior Art 1

Made available on 14 October 2022 on the Amazon.de website under ASIN BOBJ73LTKB.





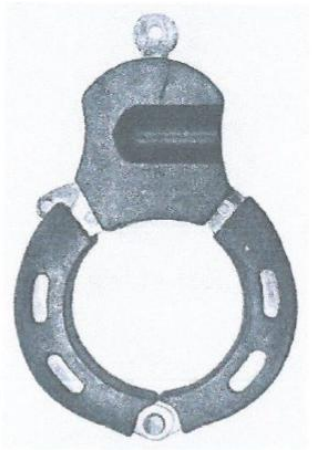
Prior Art 2

Made available on 25 May 2023 on the EUIPO website as Registered Community Design No. 015022558-0001.



Prior Art 3

Made available on 11 September 2018 through publication in the *Chinese Intellectual Property Office Bulletin*, under registration number 201830174550.4.



4. The applicant submits that the competing designs are similar in respect of locking mechanism placement; position of the bolts/joints; the locking shackle cover; symmetry; and resemblance to handcuffs.

5. The registered proprietor was given a deadline of 27 December 2024 by which to file a defence. As no defence was filed by this date, the Registry wrote to the registered

proprietor on 8 January 2025 stating that it was minded to deem the invalidity application to be undefended but informing the registered proprietor that it had the right to be heard if it objected to this preliminary view. On 22 January 2025, the registered proprietor's representative wrote to the Registry stating that the registered proprietor had not been aware of the application since its previous representative had not informed it of the matter in time. On 26 February 2025, the registered proprietor filed a defence on Form DF19B, along with an affidavit made by Rujian Qiu, a General Manager of Yami Zhongchuang (wenzhou) Technology Co., Ltd. This affidavit explains the reason given above. The Registry was satisfied by the explanation. The Form DF19B was admitted and served on the applicant.

6. The registered proprietor's defence is that, pursuant to section 1B(6)(c) of the Act, the grace period lasted from 19 July 2022 to 18 July 2023, and that it had disclosed the contested design within this period and earlier than the dates of the alleged disclosures of Prior Art 1 and Prior Art 2 on 14 October 2022 and 25 May 2023 respectively. The registered proprietor also claims that that Prior Art 3 lacks novelty when compared with US Design Patent No. USD46899151, registered on 21 January 2003. The registered proprietor makes a brief comparison of the features of the contested design with those of Prior Art 3.

7. It concludes the defence by saying:

> "It is clear that the contested design was disclosed prior to the evidence submitted by the applicant and always within the grace period prior to registration specified by the Law. Furthermore, the contested design and the applicant's priority design only coincide in the elements that are absolutely necessary for the correct functioning of and that are given by the very nature and purpose of the product to which they are applied, and, furthermore, are anticipated in numerous products existing on the market for a long time …"

8. I understand *"the applicant's priority design"* as a reference to Prior Art 3, which the applicant claims was made public before the start of the grace period relied upon by the registered proprietor. It refers to the applicant's design in the singular, and it is only Prior Art 3 that the registered proprietor compares with the contested design. I also

understand the registered proprietor to be admitting that the contested design was disclosed before the application was made.

9. Both parties filed evidence, and I summarise this below.

10. Neither side requested a hearing or filed written submissions in lieu. I have therefore taken this decision on the basis of the papers already admitted. In these proceedings, the applicant is represented by Paweł Wowra and the registered proprietor by Arcade & Asociados.

EVIDENCE

11. The applicant, Mr Yang Yigen, filed a witness statement dated 15 April 2025, exhibiting evidence of the alleged prior disclosures.

12. The registered proprietor's evidence comes from Isidro Díaz de Bustamante, a patent and trade mark lawyer at Arcade & Asociados, the registered proprietor's legal representative. The witness statement is dated 27 May 2025 and repeats the counterstatement. It is accompanied by identical exhibits.

RELEVANCE OF EU LAW

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

14. 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".

15. 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 consideration.

(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.

…"

16. The applicant relies on three designs that he claims were disclosed before the registered proprietor filed its application to protect the contested design. The registered proprietor submits that the first two of these were disclosed during the grace period provided by section 1B(6) of the Act and, further, that it had disclosed the design earlier than the dates on which Prior Art 1 and Prior Art 2 were allegedly made available to the public, while still remaining within the grace period. In *Sphere Time v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-68/10, the General Court interpreted the corresponding provision in the Council Regulation (EC) No. 6/2002 on Community Designs as follows:

"24. In relation, firstly, to the applicability of Article 7(2) of Regulation No. 6/2002 to this case, it should be noted that the objective of that provision is to offer a creator or his successor in title the opportunity to market a design, for a period of 12 months, before having to proceed with the formalities of filing.

> 25. Thus, during that period, the creator or his successor in title may ascertain that the design concerned is a commercial success before incurring the costs relating to registration, without fear that the disclosure that takes place at that time may be successfully raised during any invalidity proceedings brought after the possible registration of the design concerned.
>
> 26. It is apparent from the foregoing that, for Article 7(2) of Regulation No. 6/2002 to be applicable in the context of invalidity proceedings, the owner of the design that is the subject of the application for invalidity must establish that it is either the creator of the design upon which that application is based or the successor in title to that creator."

17. The case law explains that only the designer, or any successor in title of the designer, may benefit from the grace period provided for in section 1B(6)(c) of the Act. The onus is on the registered proprietor to establish this fact. The registered proprietor has filed a selection of invoices containing thumbnail images it claims show the contested design, and the earliest of these is dated 13 September 2022 (i.e. before the alleged disclosure of the applicant's Prior Art 1). However, it must be borne in mind that these invoices do not establish that the registered proprietor is the designer of the contested design or their successor in title, merely that it sold the goods shown on the invoices. I also note that the registered proprietor does not claim anywhere in the counterstatement or witness statement to be the designer or the designer's successor in title.

18. The registered proprietor has not sought to rely on the grace period provided for by section 1B(6)(d) or (e). In any event, there is no evidence to support such a claim.

19. The registered proprietor has made a clear admission that it has disclosed the contested design before the relevant date and has not claimed that any of the exceptions apply, other than the grace period in section 1B(6)(c): *"It is clear that the contested design was disclosed prior to the evidence submitted by the applicant and always within the grace period prior to registration specified by the Law."* Although the registered proprietor refers to the act of registration as the end of the grace period, it is the date of application that is relevant. Given the lack of any evidence that the registered proprietor is the designer or the designer's successor in title, I deem that,

as the registered proprietor admits that it had already been made available to the public, the contested design was not new and that it lacked individual character when the application was made.

CONCLUSION

20. The application for a declaration of invalidity is successful and, subject to a successful appeal, Registered Design No. 6297318 is declared invalid.

COSTS

21. The applicant has been successful and is entitled to a contribution to his costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. I award the applicant the sum of £948 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

> *£300 for preparing a statement and considering the other side's statement*
> *£600 for preparing evidence and considering the other side's evidence*
> *£48 for official fees*
> ***£948 in total***

22. I order Yami Zhongchuang (wenzhou) Technology Co., Ltd to pay Yang Yigen the sum of £948. 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 November 2026

Clare Boucher
For the Registrar