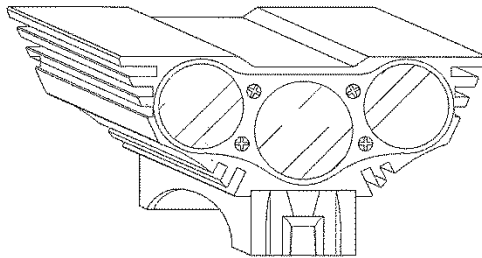


O-012-16

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF
REGISTERED DESIGN 4034148:**



IN THE NAME OF CHAOQUN LI

AND

AN APPLICATION FOR INVALIDATION BY YONG JUN

The background and the claim

1. This dispute concerns the validity of registered design 4034148 which was filed by Mr Chaoqun Li on 5 February 2014. On the form of application Mr Li describes the design as an “LED Flashlight Bike Light with cable connector”.

2. The applicant for invalidity is Mr Yong Jun. He relies on a ground under section 11ZA(2) of the Registered Designs Act 1949 (“the Act”), the claim being that Mr Li is not the true proprietor of the design. Mr Jun claims that he created the design which he describes as the “X3” in May 2013 and that he applied for a design right in China in relation to it. As part of his pleading, Mr Jun refers to products made to the design having been placed on sale in July 2013. In view of this the tribunal queried with Mr Jun whether the claim was also meant to be based on novelty grounds (section 1B of the Act). Mr Jun responded saying that he thought the evidence he filed was adequate to succeed under section 11ZA(2); no request to add section 1B was made.

3. The proprietor filed a counterstatement defending his registration. Mr Li states:

“With regards to your letter dated 17 March 2015, the DF19A that the proprietor stated that he created [t]he design in May 2013 and applied for the design right in China on 6 June 2013, I want to deny this claim, and clarify that I wish to be registered for the patent to sell within Europe only. This does not include any other countries i.e. China, or any other Asian domain.”

4. Both sides have represented themselves throughout the proceedings. Beyond what Mr Jun provided with his statement of case, neither side filed any further evidence. Neither side requested a hearing or filed written submissions in lieu of attendance at a hearing.

Section 11ZA(2) of the Act

The law

5. Section 11ZA(2) of the Act states:

“The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the registered design objecting”.

6. Proprietorship of designs registered under the Act are dealt with in section 2, the relevant parts of which read:

“2. Proprietorship of designs

(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1A) Where a design is created in pursuance of a commission for money or money's worth, the person commissioning the design shall be treated as the original proprietor of the design¹.

(1B) Where, in a case not falling within subsection (1A), a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the "author" of a design means the person who creates it.

(4)_"

7. The essence of a claim under section 11ZA(2) is a dispute over the proprietorship of a design, the claim being that the person who registered it (in this case Mr Li) is not, in accordance with the ownership provisions set out above, the true proprietor. However, there is one further part of the law that needs to be highlighted, namely, section 11ZB(5), which reads:

"(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection."

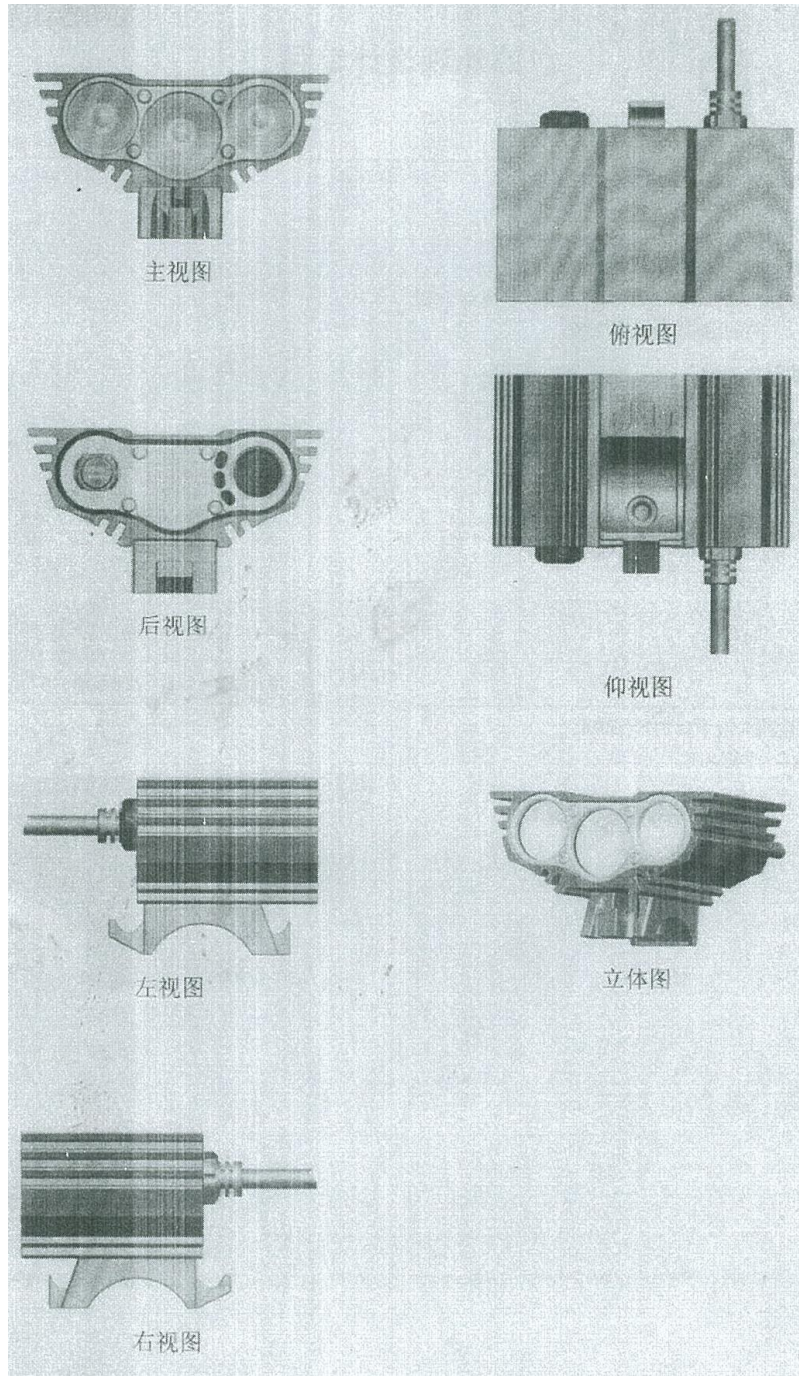
8. The net effect of section 11ZA(2) and 11ZB(5) is that a request to invalidate a registered design on the issue of proprietorship can only be made by the person claiming to be the true proprietor of the design.

The evidence

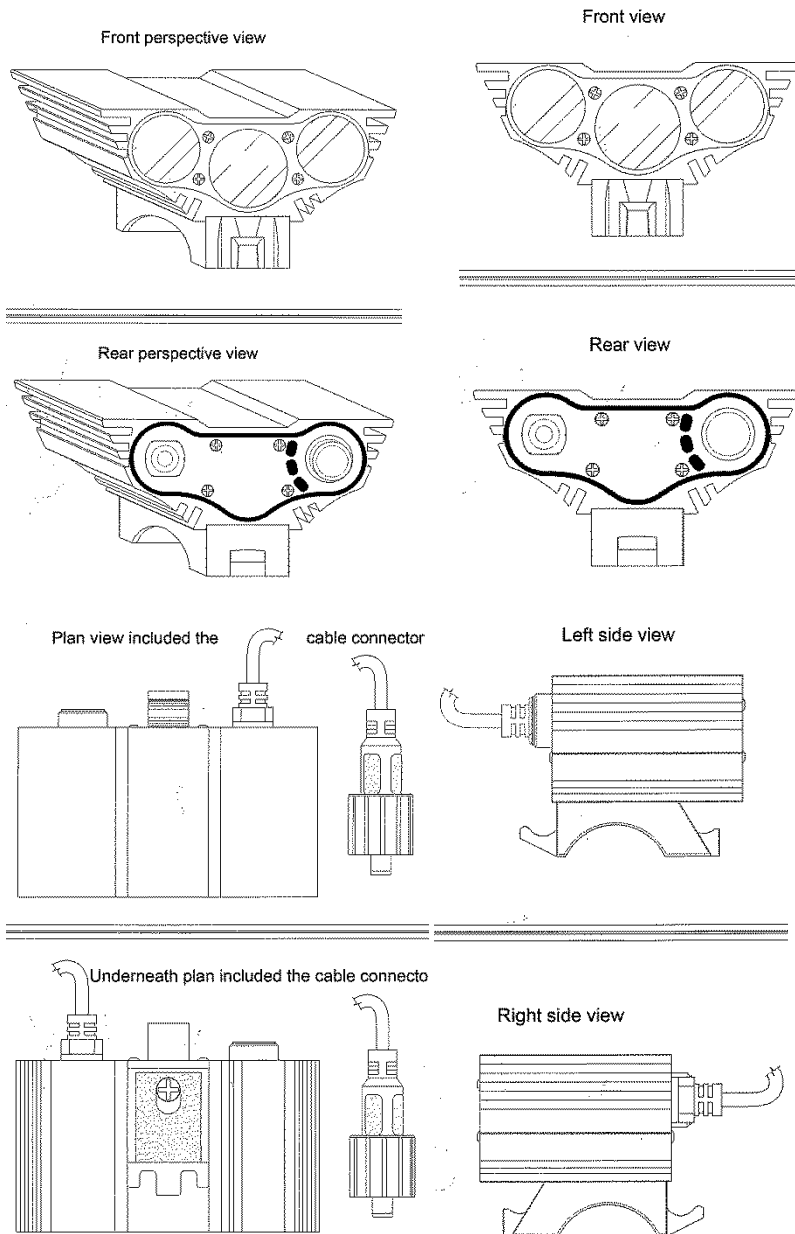
9. Mr Jun states in his statement of case² that he is a product designer and owner of a Chinese company called Shen Zhen Ming Xiao Technology Co Ltd. He states that he created the "X3" design in May 2013, that he registered the design right in China on 26 June that year, and that it was subsequently published on 20 November 2013. Mr Jun provides a copy of the design right certificate (certificate no. 2660699). The certificate depicts various representations showing the design from various angles. The details are in Chinese script, but a translation (albeit not a certified translation) confirms the details provided by Mr Jun and lists him as applicant and inventor. The images on the certificate are as follows:

¹ It should be noted that this provision has now changed as a result of the Intellectual Property Act 2014. The position now is that the commissioned person is the owner of the design unless there is an agreement to the contrary. However, the change only applies to designs created after 1 October 2014, so this is not relevant in these proceedings.

² Rule 21(1)(a) of the Registered Design Rules 2006 confirms that evidence may be given by statement of case, as here.



10. Mr Li filed no evidence. The only statement of any sort received from him during the course of the proceedings is that already set out in paragraph 3 above. The design that he registered in the UK the subject of these proceedings can be seen in the following representation:



Analysis and findings

11. Although Mr Jun's evidence is brief, I see no reason to doubt the veracity of his statement that he created the design that is embodied by the product shown in the Chinese design right certificate. I think it is also extremely clear that the design embodied by the product shown in the UK design registration is remarkably similar to Mr Jun's design. Indeed, I struggled at first glance to find any differences. Having inspected them very carefully, there may be one or two extremely minor differences, albeit ones which do not really impact upon the essence of what has been created.

12. What is also telling in this case is that despite an allegation being made against Mr Li that he is not the true proprietor of the design, Mr Li filed no evidence whatsoever. Indeed, even in the briefest of statements he did make in his counterstatement, Mr Li does not even claim that he created the design or,

alternatively, that the design is vested in him on account of it being created by someone else (someone other than Mr Li). It would have been a very easy task for Mr Li to have informed the tribunal as to who, how and when the design he filed was created.

13. Whilst it is possible for extremely similar designs to be created independently, the nature of the designs here strike me as ones where co-incidental creation would be a highly improbable conclusion to reach. Further, the net effect of what has been said, and what has not been said, leads me to the conclusion that Mr Li did not create the design he filed. There is no evidence of why it should be vested in him. Mr Jun's evidence paints at least a *prima facie* case that he is the true proprietor, a *prima facie* case that has not been answered. Mr Li refers to him wishing to have his registration in Europe not China (or elsewhere). However, this is not the point. Design registration is a mechanism to reward the creators of designs (although the reward can be passed on to another person), it is not to reward a person who simply takes someone else's design and files it another jurisdiction – such a person has not created anything. I conclude that the invalidity claim succeeds for the reasons I have given.

Costs

14. Mr Jun having succeeded, he is entitled to a contribution towards costs. I have taken into account that Mr Jun was not represented so would not have incurred legal fees and, furthermore, what has been provided in these proceedings is limited in nature. My assessment is as follows:

Filing a statement of case and considering the counterstatement - £150

Official fee - £50

15. I therefore order Mr Chaoqun Li to pay Mr Yong Jun the sum of £200. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

Dated this 14TH Day of January 2016

**Oliver Morris
For the Registrar,
The Comptroller-General**