O-308-17

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO. 6001060
IN THE NAME OF SHANG HAN
IN RESPECT OF THE FOLLOWING DESIGN:

AND

A REQUEST TO INVALIDATE (NO. 9/17)
BY BEECHFIELD BRANDS LIMITED

The claims and the counterstatement

1. The registered design the subject of these proceedings was filed by Shang Han on 4 October 2016 – it looks like this:

2. Beechfield Brands Limited requested the invalidation of the design under section 1B(1)[1] of the Registered Designs Act 1949 ("the Act")[2], which relates to the requirement that designs must be novel in comparison to designs which have already been made available to the public. It is claimed that the design is of a simple knitted "slouch beanie hat" (this is what the proprietor described it as when the design was filed) and is without novelty. It is claimed that such hats have been produced for many years [before the relevant date]. Some examples are attached to the statement of case, from brochures put out by the applicant, including one dating to 2010. Indeed, one of the examples seems to be identical to the design as registered with the claim being that the proprietor copied the image [dated 2014] the applicant was using.

3. Shang Han filed a counterstatement defending the registration. I note the following comments:

[1] Which is relevant in invalidation proceedings due to the provisions of section 11ZA.

[2] There were also claims under sections 11ZA(2) and (4) but, for reasons that will become apparent, I need not detail them here.

"First, we'd like to provide evidence that the publication of our design 6001060 dates back to March, 2013, on which day the beanie hat in this design was launched on Amazon.co.uk market."

"After reviewing the details provided by the applicant for invalidation, we'd like to enlighten the fact, our publication date goes prior ahead of theirs, they put this style of beanie hat on their website since 2014, while our design was launched one year ago."

The relevant legislation

4. Section 1B of the Act reads:

"(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 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 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 condition 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 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) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above "normal use" means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product."

Is there a basis for the defence?

5. The nub of the defence is that the registered design was made available to the public in March 2013 (over three years before the relevant date) whereas the applicant's design was not published until 2014. However, such a defence, on the face of it, is misconceived.

6. First, the novelty of a design is not determined on a “who got there first” basis. The issue is, instead, simply about disclosure and whether a design which is the same, or has the same overall impression, has been disclosed before the relevant date, regardless of whether the proprietor disclosed it even earlier. Thus, if the applicant put its design in the public domain in 2014 (before the relevant date) this has the potential to destroy the novelty in the registered design. The proprietor does not dispute either the fact of disclosure or that the designs are the same or have the same overall impression.

7. Second, the novelty of a design can, potentially, be destroyed not just by the disclosure of a design by a third party, but also by the disclosure of the design itself (in this case Shang Han’s design) by its designer. There are, though, certain exceptions to these disclosures as set out in section 1B(6) as follows:

> “(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 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.”

8. As can be seen, the above exceptions apply only in relation to disclosures made in the 12 month period before the relevant date. The exceptions provide what is often regarded as a grace period of 12 months, the operative effect being that from the date on which the designer discloses the design, he/she may file an application for registration of the design without the prior disclosure counting against its

novelty. However, in the case before me, Shang Han has stated that the design was disclosed over three years before the relevant date and it is accepted that the applicant's design was disclosed in 2014, two years before the relevant date. The consequence of this is that the above exceptions do not apply. There are two further exceptions in section 1B(6), these relate to confidential disclosure or obscure disclosure, but there is nothing whatsoever to suggest that these apply.

9. Given the nature of the counterstatement, the tribunal wrote to Shang Han indicating that the statements made confirmed the design was not valid and that, effectively, there was no prospect of success. An earlier decision of this tribunal (BL O-288-14) was referenced as an example of a similar circumstance where this had been decided. It was indicated that a summary decision would be issued on this basis, but, before doing so, Shang Han was afforded an opportunity to request a hearing on this matter. No response to this was made. Consequently, this decision stands as my summary decision. The claim for invalidation succeeds.

Costs

10. The applicant has been successful and is entitled to a contribution towards its costs. My assessment is as follows:

Official fee - £48

Filing statement of case -£300

Total – £348

11. I order Shang Han to pay Beechfield Brands Limited the sum of £348 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of July 2017

Oliver Morris
For the Registrar,
The Comptroller-General