

# O-489-17

## REGISTERED DESIGNS ACT 1949 (AS AMENDED)

### IN THE MATTER OF REGISTERED DESIGN No. 4014852 of BRUSHBABY LTD

and

### APPLICATION TO INVALIDATE (No. 5/16) BY JUSTIN BERNHAUT

## DECISION

1. This is the second appeal to arise under the new appeal regime for designs created by the Intellectual Property Act 2014.
2. The registered design is for a baby tooth brush. In decision O-086-17 dated 23 February 2016 (a mis-type for 2017), the Hearing Officer (Mr Oliver Morris) acting for the Registrar of Designs, upheld an application to invalidate it on the ground that the design was disclosed in the illustrations in prior published US Patent 5,615,443. He rejected the proprietor's argument under section 1B(6)(a) of the Act that the contents of the US Patent could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the EEA and specialising in the sector concerned.
3. Having held the design invalid on that ground, the Hearing Officer did not find it necessary to rule on the alternative grounds of invalidity which were raised by the applicant. The decision refers to the registered proprietor as "Bushbaby Ltd." Its name is, as implied by the nature of the design, "Brushbaby Ltd".
4. The registered proprietor appealed against the decision. However, when a hearing date was about to be arranged, it withdrew its appeal. The parties have made written submissions on costs with which I will now deal.
5. As I indicated in the first decision under this new registered designs appeal jurisdiction, *Ahmet Erol's Designs* O-253/17, the statutory provisions and the

rules for registered designs appeals are closely modelled on the corresponding statutory provisions and rules relating to appeals in trade mark cases. Therefore, unless there is a relevant difference between substantive designs law and trade mark law which justifies a different approach, or some other specific and concrete reason, the Appointed Persons for designs appeals will follow and apply the established practice and procedural decisions of the Appointed Persons in trade mark appeals.

6. One aspect of trade mark appeals before the Appointed Persons is that costs are normally awarded according to a fairly modest scale, rather than at or near the full level of costs actually incurred by the parties. That scale is based by analogy on the scale of costs published in relation to proceedings before the Office under Tribunal Practice Notice (2/2016): Costs in Proceedings before the Comptroller. I see no reason why in designs appeals we should depart from the practice in trade mark appeals of normally awarding scale costs, nor use a different scale or quantum. There are simple and complex designs cases as there are simple and complex trade mark cases. But, on an admittedly slender evidence base of two appeals so far, there is no reason to suppose that designs appeals in general will be either more or less costly than trade mark appeals.
7. In his attorneys' written submissions, the Respondent has asked that I should depart from the scale and award costs of the withdrawn appeal on a more generous basis, contending that the appeal was filed with no genuine intention of following it through in order to cause unnecessary costs to the Respondent. The grounds of appeal do appear to be weak, but I am not persuaded that such an abusive intention can properly be inferred either from the weakness of the grounds of appeal or from the Appellant's apparent failure to reply to correspondence. Further, I note that the appeal was withdrawn before a hearing date was actually set so abortive hearing preparation costs were avoided in this case.
8. In this regard, this is a weaker case for departure from the scale than Decision O/097/17 GO GLU of Mr Thomas Mitcheson QC upon which the Respondent relied, where an appeal was abandoned only shortly before the hearing. Mr Mitcheson noted at [13] that parties are to be encouraged to resolve their

disputes without a hearing if at all possible, and was not prepared in effect to penalise the appellant in that case for withdrawing its appeal, even at a late stage, rather than fighting it through to the bitter end. That consideration applies with even more force to the present case where the Appellant has withdrawn its appeal at an earlier stage.

9. The Appellant in its written submissions contends that it should pay no costs at all. Its first contention is that it did not bring the appeal in bad faith. This is not a reason for escaping from an order for scale costs. Such an order will normally follow the event without any precondition of bad faith or abuse of process. An appeal has been brought, it has failed, and therefore the Respondent is in the normal course entitled to a contribution to the costs he has been put to by the appeal according to the scale, up to the stage which the appeal has reached. The appellant has avoided a larger potential liability for the respondent's costs of the hearing by withdrawing its appeal at this stage.
10. I also reject the other grounds put forward by the Appellant as to why it should not pay costs, which are irrelevant or without merit, and a plea that I should reopen the merits of the withdrawn appeal of my own motion.
11. The visible costs incurred by the Respondent amount to preparation of a reasoned letter containing a respondent's notice relying, in the event of the appeal being allowed on the US Patent ground, on the other grounds of invalidity which the Hearing Officer did not deal with in his decision. Preparation of this letter would have involved consideration of the decision and of the other pleaded grounds. In addition, the Respondent's attorneys engaged in other correspondence relating to the appeal, but I disregard work done preparing their contentions relating to off-scale costs.
12. Overall and having regard to the relative simplicity of this appeal, I will award scale costs of £250 to the Respondent. These costs are additional to the costs of the proceedings in the Office which the Hearing Officer ordered the Appellant to pay. Sadly, ink and effort has been expended in vain both on the Respondent's unsuccessful attempt to obtain above-scale costs and in the Appellant's unsuccessful attempt to avoid paying costs altogether. I fear that the costs run up in arguing about the costs may well exceed the costs in issue.

13. Accordingly I will order that:

- (1) The appeal having been withdrawn, the Hearing Officer's decision to invalidate the registered design is maintained.
- (2) Brushbaby Ltd shall pay to Mr Justin Berhhaut as costs of the appeal the sum of £250 within 14 days, in addition to the sum of £500 which the Hearing Officer ordered to be paid.

In addition, for good order, the date of the Hearing Officer's decision should be corrected to February 2017 and the title to "Brushbaby Ltd", although I think the Office can do this without me needing to make a formal order to that effect.

**Martin Howe QC**  
**Appointed Person (Designs)**  
**9 October 2017**

*The Appellant made submissions via its director Dominique Tillen*  
*The Respondent was represented by **Keltie LLP***