

O/1019/22

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

**REGISTERED DESIGN NO 6185611
IN THE NAME OF RED COTTAGE FURNITURE LTD
IN RESPECT OF THE FOLLOWING DESIGN**



AND

**AN APPLICATION FOR INVALIDATION (NO 20/22)
BY GEMMA BAMBER**

Background and pleadings

1. Red Cottage Furniture Ltd (“the registered proprietor”) filed application no. 6185611 for a registered design for a nest of tables in Class 06, Sub class 03 of the Locarno Classification (Furnishing/Tables and Similar Furniture) on 10 January 2022. It was registered with effect from that date and is depicted in the following representations:





2. On 25 February 2022, Gemma Bamber (“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 she first marketed tables to the design in March 2021 and that it was subsequently copied by other traders, including the registered proprietor.

3. The registered proprietor filed a defence and counterstatement on 5 April 2022, denying the applicant’s claims. In particular, it states that it had been marketing the design “*on and off*” since 2016.

4. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. Both parties are unrepresented.

Decision

5. 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”.

6. 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 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 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.

(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 to 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.”

may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.”

7. The essence of the registered proprietor’s defence is that it had been marketing the design since 2016, which was before the applicant claims to have designed the nest of tables. It attaches to its notice of defence screenshots from its own website and the Amazon marketplace in 2017 and 2018 respectively.

8. 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, 10 January 2022. Some disclosures are excluded from the assessment as per section 1B(6), which deals with disclosures in the 12 months before the relevant date) or disclosures made under condition of confidentiality, or disclosures that are very obscure, none of which has been claimed. 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).

9. In view of the fact that the proprietor has claimed (and provided evidence) showing that the design was disclosed 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.

10. The design registration is hereby declared invalid.

Costs

11. As the 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

12. I order Red Cottage Furniture Ltd to pay Gemma Bamber 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 21st day of November 2022

Clare Boucher

For the Registrar,

The Comptroller-General