

REGISTERED DESIGNS ACT 1949 (as amended)

**IN THE MATTER OF AN APPLICATION UNDER
SECTION 11(2) BY PARAMOUNT PICTURES
CORPORATION FOR CANCELLATION OF
REGISTERED DESIGN NO 2077550 IN THE
NAME OF ANDREW SCOTT ANDERSON
& STEPHEN WILKINSON**

REGISTERED DESIGNS ACT 1949 (as amended)

IN THE MATTER OF an Application under Section 11(2) by Paramount Pictures Corporation for cancellation of Registered Design No 2077550 in the name of Andrew Scott Anderson and Stephen Wilkinson

BACKGROUND

- 1 On 14th September 1998, Andrew Scott Anderson and Stephen Wilkinson of Risca, South Wales applied under the Registered Designs Act 1949 (as amended) to register a design with the Statement of Article “Millennium Jacket”. The registration was granted and a certificate was issued on 29th December 1998.
- 2 The statement of novelty is “The features of the design for which novelty is claimed are the shape, configuration, pattern and ornament of the article as shown in the representation.” A copy of the representation of the registered design is at Appendix One.
- 3 On 6th December 1999, Paramount Pictures Corporation filed an application to cancel the registered design on the grounds (insofar as they were pursued before me) that the design lacked novelty and that designs differing only in immaterial details or common trade variants had been published in the United Kingdom before the date of application.

THE EVIDENCE

- 4 I have carefully considered the evidence and propose not to summarise it in detail. Much of it relates to longstanding wider disputes between the parties. At the Hearing which took place on 17th January 2001, where the applicant was represented by Mr Roberts of counsel and the proprietors’ by Mr Anderson (one of the joint proprietors of the registered design), it was common ground that the relevant legislation was Section 1(4) of the Registered Designs Act 1949, as amended, which insofar as material provides:-

“A design shall not be regarded as new for the purposes of this Act if it is the same as a design published in the United Kingdom in respect of the same or any other article before the date of application, of if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.”

- 5 It was further agreed at the Hearing that the alleged prior publication or “prior art” involved consideration of the following:

- 1) The photographs exhibited at "ASI 1" and "ASA 2" to the Witness Statement of 24th October 2000 by Mr Andrew Scott Anderson (joint proprietor of the registered design), filed on behalf of the proprietor and showing a waistcoat which Mr Anderson stated, he created and provided him with the inspiration for the registered design.
- 2) The publicity kit for the film Star Trek Insurrection and the related shipping invoice exhibited at "NAM 2" and NAM 3" to the Statutory Declaration of 15th August 2000 by Mr Neil Anthony Miller (Legal Counsel of Viscom Inc., the parent company of Paramount Pictures Corporation), which was filed on behalf of the applicant for cancellation.
- 3) The extracts from Star Trek Communicator Magazine exhibited at "NAM 4" to Mr Miller's Statutory Declaration of 15th August 2000.

PRELIMINARY ISSUES

- 6 Prior to the commencement of the Main Hearing I considered a prior request by the applicant for cancellation to "strike out" certain parts of the proprietors' counterstatement and evidence on the grounds that it consisted of scandalous and vexatious allegations. The request was subsequently limited to Paragraphs 2, 3 and 4 and the first sentence of Paragraph 8 of the counterstatement and Paragraphs 9 to 12 of Mr Anderson's witness statement of 24th October 2000. Following submissions, I decided to allow the request as in my view the contents of the evidence in issue do not relate and are not relevant to the cancellation of the registered design. Mr Anderson, for the proprietors, did not resist on this basis.

DECISION

- 7 Before comparing the relevant designs, I turn first to a consideration of whether there has been prior publication.
- 8 As stated previously, the alleged prior art consists of the photographs exhibited at "ASA 1" and "ASA 2" to Mr Anderson's Witness Statement of 24th October 2000; the publicity kit for the film Star Trek Insurrection; and the Star Trek Communicator Magazine. I propose to consider each of these separately.

1. Photographs "AS 1" and "ASA 2"

Paragraph three of Mr Anderson's witness statement makes it clear that both photographs were taken well before the date of application for the registered design. Under cross examination at the hearing, he readily stated that the waistcoats being worn in the photographs were being worn in a public house on a public occasion.

2. The Publicity Kit for the Star Trek Insurrection Film

In his Statutory Declaration of 15th August 2000, Neil Anthony Miller on behalf of the applicant states that publicity kits for the Star Trek Insurrection film were distributed in the UK, US and Canada on or around 10th August 1988 and that the publicity kits included photographs of an “evening jacket” design of the applicant for cancellation which differs in only minor and insubstantial ways from the registered design. A copy of the publicity kit is attached at Exhibit “NAM 2” to Mr Miller’s declaration and also attached at Exhibit “NAM 3” is a copy of a shipping invoice to show that the transparencies from which the photographs were reproduced were sent to the UK on 7/8th August with an estimated time of arrival of 10th August 1988.

Under cross examination at the Hearing Mr Miller stated that publicity kits were distributed to press contacts prior to the date the registered design was applied for and went onto explain that, unfortunately, the shipping invoice (“NAM 3”) was the only remaining documentation as due to the short life time and the nature of publicity kits, it is not practice to keep long term records relating to them. Mr Miller further explained that the recipient of the publicity kit transparencies (colour slides) shown on the copy of the shipping invoice (“NAM 3”), United International Pictures, is a film distribution company owned by three film producing corporations - Paramount, MGM and Universal - each of whom own one third of the share capital.

3. Extracts from Star Trek Communicator Magazine

In his Statutory Declaration of 15th August 2000, Mr Miller also refers to an August/September 1998 issue of Star Trek Communicator Magazine which he states contains photographs of an “evening jacket” design of the applicant for cancellation which pre-dates the registered design. A copy of extracts from this publication is attached to his Statutory Declaration at Exhibit “Nam 4”. During cross-examination at the Hearing Mr Miller stated that, although the magazine is published in the USA, it is available in the UK eg through Forbidden Planet (a specialist science fiction retailer) who have informed him that it would have been in the shop within a week of publication.

- 9 While there is no definition of “published” in the Registered Design Act 1949 (as amended), it has long been accepted that, in practice, it has the same meaning as when used in the Patents Act 1949 and its predecessors. Any design which has been made available to any person in the United Kingdom who is free to use or disclose it is treated as published. During the Hearing, Mr Roberts for the applicant, reminded me that there is no requirement to prove that publication is commonplace or even that it needs to be for commercial purposes. He drew my attention to VREDENBURG’S Design (1934) 52 RPC 7 where it was held that the use of a single example of a new tennis racket at a tennis club amounted to publication of its design.

- 10 Upon consideration of each example of the alleged prior art in suit, I find:
- 1) The waistcoats shown in Exhibits "AS 1" and "ASA" 2 to Mr Anderson's Witness Statement of 24th October 2000 were published within the meaning of Section 1(4) of the Act. This was made clear in Mr Anderson's own evidence under cross examination at the Hearing.
 - 2) The Publicity Kit for the Star Trek Insurrection Film illustrated in Exhibit "NAM 2" to Mr Miller's Statutory Declaration of 15th August 2100 was published within the meaning of Section 1(4) of the Act. Under cross examination Mr Miller appeared a reliable witness and I do not accept the proprietors' view that the shipping invoice (Exhibit "NAM 3" to Mr Miller's Declaration) was fabricated. From this invoice I find that, on the balance of probabilities, the Publicity Kit was disclosed to another person in the UK on or very soon after 10th August 1998, the other person being United International Pictures, a company in which neither the applicant nor their parent company have a controlling interest.
 - 3) The Star Trek Communicator Magazine (Exhibit "NAM 4" to Mr Miller's Declaration of 15th August 2000) has not been shown to be published within the meaning of Section 1(4) of the Act. I have come to this view as the applicant's "evidence" on this piece of "prior art" is not supported by adequate documentation and amounts to little more than assertion and hearsay.
- 11 I must now turn to a comparison of the relevant designs and decide whether the differences are only in immaterial details or in features which are variants commonly used in the trade.
- 12 In considering the respective arguments relating to Section 1(4) I have borne in mind that the representations of the design and the alleged prior art must be viewed through the eye of a notional customer which, in this case, not only involves the trade, but ordinary members of the public ordering clothing for themselves or others, some of whom may be familiar with or fans of the "Star Trek" films or television series.
- 13 Registered designs are concerned with appeal to the eye and the comparisons should be of the designs as a whole. In this particular case I pay regard to the fact that the proprietors statement of novelty is widely framed and consists of:-
- "The features of the design for which novelty is claimed are the shape, configuration, pattern and ornament of the article as shown in the representations."
- 14 At the Hearing, Mr Roberts drew my attention to the following comments of Bowen LJ in *Le May v Welch* (1885) 28 Ch.D 24 at 34:-
- "In considering whether the design is new or original, we must remember in the first place that we are dealing with a design which purports to found itself on shape, and to deal with outline; and secondly, that we are considering the question with reference to an article of dress of the very simplest and least

complicated kind, an article of dress which may well vary in form in every town in England, and in every year in which collars are worn. We must not allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length, or breadth, or configuration, in a simple and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs, and Trade Marks Act a trap to catch honest traders. It cannot be said that there is a new design every time a coat or waistcoat is made with a different slope or a different number of buttons. Tailoring would become impossible if such were the law, and it does not appear to me that such is the law. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article.”

which, as according to “Russell-Clarke on Industrial Designs”, page 74, para 3 144, infers that:-

“novelty must be substantial having regard to such matters as the nature of the article, the extent of the prior art and the number of previous designs in the field in question. Especially with fields such as clothing where there is a huge volume of prior art, there must be some clearly marked and defined differences.”

- 15 My first comparison is between the registered design and the designs of the waistcoats shown in Exhibits “ASA 1” and “ASA 2” to Mr Anderson’s Witness Statement of 24th October 2000. While Mr Anderson conceded that the waistcoat provided him with the inspiration for the registered design he argued that the designs were different. My initial opinion on seeing the respective designs was that they were considerably different in their overall impression and after listening to the submissions of both parties and comparing the designs later, my opinion has not altered. Mr Roberts sought to argue that the registered design was merely the waistcoat shown in “AS 1” and “AJA 2” with sleeves added and the braiding continued onto the sleeves. While there is some merit in this view, it fails to take account of the fact that the front of the waistcoat tapers outwards at the bottom so that it cannot join and that a number of different alternatives would exist in relation to the positioning of braiding on the sleeve. In any event, I am firmly of the view, that the overall look or impression of the designs is different.
- 16 My next comparison is between the design in suit and the “dress jackets” shown being worn by “Star Trek” crew members in the Publicity Kit for the film Star Trek Insurrection, at Exhibit “NAM 2” to Mr Miller’s Statutory Declaration of 15th August 2000. Mr Robert’s drew particular attention to slide “STIX 1368” and the jackets worn by the two males on the far left of the picture and the female on the centre/right of the picture. Mr Anderson criticised the clarity of the illustration and went on to mention a number of differences with the registered design which included stitching line details, quilting details, braiding details and the width of the jacket opening at the front, especially the top of the front. However, my initial impression on viewing the relevant designs was that they were very similar and when I looked at them again, upon considering the evidence, my view had not changed. While differences exist, they are not in my view material. Designs should be viewed from a normal distance

and such differences as there are in the designs at issue seem largely related to the quality of the finish of the article as opposed to design features.

- 17 Having already found that the Star Trek Communicator Magazine (Exhibit "NAM 4" to Mr Miller's Statutory Declaration of 15th August 2000) has not been published for the purposes of Section 1(4) of the Act, I need not compare the illustration of the design shown therein with the registered design. However, for the sake of completeness I will do so. Mr Anderson argued that this alleged prior art consisted of a view of the shoulders or very top part of a jacket and a full and proper overall comparison of the designs is not possible. I agree. If I had held it published, "NAM 4" would not have assisted the applicant.
- 18 To conclude, I have decided that the design in suit does not meet the requirements of Section 1(4) of the Act because the applicants Publicity Kit for the film Star Trek Insurrection was published before the registered design was applied for and that it contains a design of a jacket which differs from the registered design only in immaterial details or in features which are commonly used in the trade.
- 19 As the cancellation has succeeded, the applicant is entitled to a contribution towards costs. I accordingly order the proprietors to pay the applicant the sum of £650.00. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of February 2001

**J MACGILLIVRAY
For the Registrar
The Comptroller General**