

O-216-04

**REGISTERED DESIGNS ACT 1949**  
**(AS AMENDED BY THE REGISTERED DESIGNS REGULATIONS 2001)**

**IN THE MATTER OF APPLICATION UNDER SECTION 11ZB**  
**BY CE SHEPHERD FOR INVALIDATION OF REGISTERED**  
**DESIGN No. 3002929 IN THE NAME OF STEALTHCRAFT LIMITED**

**REGISTERED DESIGNS ACT 1949  
(AS AMENDED BY THE REGISTERED  
DESIGNS REGULATION 2001)**

**IN THE MATTER OF an application under  
Section 11ZB by CE Shepherd for invalidation  
of registered design No. 3002929 in the name  
of Stealthcraft Limited**

**BACKGROUND**

1. On 15 April 2002 Stealthcraft Limited applied under the Registered Designs Act 1949 (as amended by the Registered Designs Regulations 2001) to register a design intended to be applied to a “boat”. Registration was granted.

2. A copy of the representations of the registered design is at Appendix One to this decision.

3. On 10 October 2003 CE Shepherd filed an application under Section 11ZB of the Act to invalidate the registered design on the basis of his earlier UK design registrations 2082015 (applied for on 15 March 1999) and 2091641 (applied for on 25 March 2000). Copies of the representations of the earlier registered design(s) are at Appendix Two (2082015) and Appendix Three (2091641) to this decision. The registered proprietor refuted the application for invalidity and stated that the applicant gave up his rights in the design of the “stealth” when he became Technical Director and shareholder with Stealthcraft Limited in September 2001. A number of documents are filed in support.

4. Section 11ZA of the Act, as amended by the 2001 Regulations, states that:

“The registration of a design may be declared invalid on any of the grounds mentioned in Section 1A of this Act”.

5. Section 1A of the Act provides that:

“**1A.**- (1) The following shall be refused registration under this Act-

- (a) anything which does not fulfil the requirements of section 1(2) of this Act;
- (b) designs which do not fulfil the requirements of sections 1B to 1D of this Act;
- (c) designs to which a ground of refusal mentioned in Schedule A1 to this Act applies.

(2) A design (“the later design”) shall be refused registration under this Act if it is not new or does not have individual character when compared with a design which-

- (a) has been made available to the public on or after the relevant date; but
- (b) is protected as from a date prior to the relevant date by virtue of registration under this Act or an application for such registration.

(3) In subsection (2) above “the relevant date” means the date on which the application for the registration of the later 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.”

6. Essentially, Section 1A(2)(b) is the relevant ground in the present proceedings by virtue of UK design registrations 2082015 and 2091641. At the hearing, which was held on 13 July 2004, the applicant for invalidation was represented by Mr Cheffins-Barnard, advisor to CE Shepherd. The registered proprietor chose not to attend and was not represented.

### **Applicant’s Evidence**

7. In addition to providing details of the earlier design registrations, Mr Shepherd submitted an Affidavit dated 22 December 2003.

8. Mr Shepherd states that he is the conceiver and designer of the boat illustrated by registered designs 2082015 and 2091641 and he goes on to explain that he subsequently entered into a business arrangement to promote and market the product subject to the design which resulted in the incorporation of Stealthcraft Limited. He became Technical Director and a shareholder in Stealthcraft Limited but denies disposing of any of his personal rights to the company.

9. Mr Shepherd is supported in a statutory declaration by Robert Lewis dated 6 January 2000. Mr Lewis has known Mr Shepherd for some fifteen years both working for and with him over that period. Mr Lewis states that Mr Shepherd would not release the design or property rights to the “Stealth” product.

10. This completes my summary of the evidence filed. I now turn to the decision.

### **DECISION**

11. Before comparing the respective designs I turn to a consideration of whether the registered designs relied upon by the applicant fall within the scope of Section 1A(2)(b) of the Act. The application for registered design No. 2082015 was made on 15 March 1999 and the application for registered design No. 2091641 was made on 25 March 2000. Accordingly, at the relevant date ie. the date the design in suit was applied for (15 April 2002), the prior art in the form of the applicant for invalidation’s design registrations existed in the public domain and were protected within the ambit of Section 1A(2)(b).

12. I now turn to a comparison of the respective designs bearing in mind that a registered design must possess novelty and individual character. Section 1B(1) to (3) of the Act reads as follows:

**“1B.**-(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.”

13. The applicant for invalidation claims that the respective designs are identical. I have received no submissions from the registered proprietor on this point.

14. Registered designs are concerned with visual appearance and eye appeal. When I compared the respective designs I reached the conclusion that they were identical. However, even if I am wrong in that the designs are not identical, it follows that the designs vary in details so slight they are likely to go unnoticed. In my opinion, such small details must be regarded as immaterial for the purposes of the assessment.

15. The registered proprietor of the design in suit claims ownership of the applicant for invalidation’s registered designs. This is disputed by the applicant. However, the issue of ownership does not impact upon whether the design in suit (3002929) was novel at the date it was applied for, given the existence of the prior registrations (2082015 and 2091641) at that date. The ownership of design registration Nos. 2082015 and 2091641 is not an issue for decision in the current proceedings. I would only add that Section 20 of the Act provides that the court may, on the application of the relevant person, order the register of designs to be rectified by making, varying or deleting entries therein and “the relevant person” includes a person able to object on the ground of the registered proprietor not being the proprietor of the design.

## **CONCLUSION**

16. The application for invalidation under Section 11ZB succeeds.

## **COSTS**

17. The application for invalidation has been successful. Accordingly, the applicant is entitled to a contribution towards costs. While the applicant seeks costs at the “high end” of the scale based upon actual costs incurred, it seems to me that these proceedings have been relatively

straightforward bearing in mind the extent and detail of the evidence filed and the submissions of the parties. I order the registered proprietor to pay the applicant for invalidation the sum of £1,750. This sum is 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 21st day of July 2004**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**