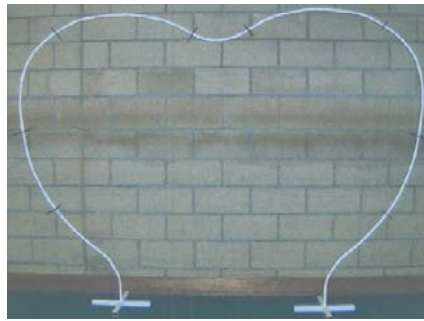


O-351-11

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO 4011363

IN THE NAME OF BELINDA SINGH IN RESPECT OF:



AND

A REQUEST TO INVALIDATE (NO. 37/09)

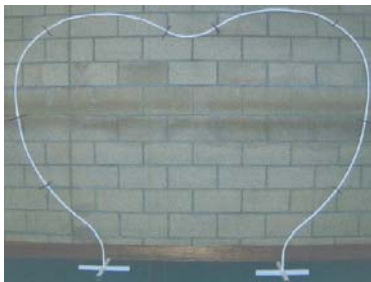
BY SAUNDERS DISPLAYS (UK) LTD T/A SAUNDERS DISPLAYS

THE BACKGROUND AND THE PLEADINGS

1) Ms Singh filed registered design no 4011363 on 3 June 2009. The design is said (on the form of application) to be:

“a heart shaped frame, made from square metal tubing composed of 9 sections with spigots and placed on two base sections”.

The design itself is depicted below:



2) Invalidation of this design is sought by Saunders Displays (UK) Ltd t/a Saunders Displays (“Saunders”). The request for invalidation was made on 2 November 2009. At this point in time the claim was based solely on a claim of disputed ownership. Ms Singh filed a counterstatement in defence of her registration. Subsequent to this, Saunders, who by then had appointed Graham Coles & Co as its representative, amended its claim to include claims about the novelty of Ms Singh’s design. Ms Singh did not object to the requested amendment and, as such, the amendment was accepted by the tribunal. Ms Singh was invited to file an amended counterstatement, but she did not do so. The case then proceeded to the evidence rounds, both parties filing evidence. Whilst it is regrettable that Ms Singh did not file an amended counterstatement so as to clarify the areas in dispute, it is clear (given that she has proceeded to file evidence) that she still defends her registration on all fronts. It is not considered that any of Saunders’ amended claims should succeed by default.

3) Saunders’ claims are made under the provisions of the Registered Designs Act 1949 (as amended) (“the Act”) and can be summarised as follows:

- i) That the design is not new nor does it have individual character compared to other heart shaped frame designs that have been made available to the public;
- ii) That Ms Singh’s registered design was used in trade or otherwise disclosed (by her) before the relevant date and that such disclosure does not fall within any of the exceptions contained in section 1B(6) of the Act (in particular, the claimed disclosures were more than 12 months before the date of application);

- iii) That if the design was new and possessed individual character at the relevant date then it was created by Ms Singh as an employee of Saunders in the course of her employment, so meaning that Saunders is the proprietor of the design and not Ms Singh.

Claims i) and ii) are founded under section 1B¹ of the Act whilst claim iii) is founded under section 11ZA(2).

THE EVIDENCE

4) I do not intend to summarise the evidence on a piecemeal basis. I will, instead, draw from the evidence and refer to its contents when dealing with the substantive issues that need to be determined. However, to set matters in context, I will record the details of the evidence filers and what, primarily, they have given evidence about:

Saunders' primary evidence comes from:

- Mr Mark Saunders, the director of Saunders. His evidence relates to his (or more specifically Saunders') relationship with Ms Singh and how the design the subject of this dispute came to be. He also gives evidence about other heart shaped balloon frames that are in the public domain.
- Ms Sonn, who runs the Creative Balloon Company. Her evidence relates to a balloon frame referred to as the "Dandy Frame" which she knows to have been in the public domain and used in trade for some time, one of which she owns. She also gives evidence about Saunders who have worked on (welding and re-spaying) the Dandy Frame that she owns.
- Mr Coles of Graham Coles & Co, who provides evidence about one of the other heart shaped frame designs.

Ms Singh's primary evidence comes from:

- Ms Belinda Singh, the registered proprietor of the design. Her evidence relates to the origins of her design and, also, her relationship with Saunders. She also makes observations about the prior art.
- Ms Jacqueline Walker, a client of Ms Singh. Her evidence relates to an order she put in with Ms Singh for a heart shaped walkthrough balloon frame for her wedding.

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

- Mr Victor Gibbard, Ms Singh's father. His evidence relates to the assistance he gave to Ms Singh in the development of the design.

Saunders' reply evidence

- Mark Saunders, who gives further evidence about Saunders' relationship with Ms Singh and Saunders' role in the development of the design.
- Ms Sonn, who gives further evidence about the Dandy Frame and discussions she had with Saunders about balloon frames.

DECISION

5) The proprietorship issue is only relevant if I find that Ms Singh's design was new or possessed individual character at the relevant date. I will, therefore, begin with an assessment about what is commonly known as the novelty requirement.

The legal background

6) 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.”

7) According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to its application. This means that the relevant date for my assessment is 3 June 2009. Any prior art must have been made available to the public prior to this date. There are, though, exceptions to this, including disclosures that have been made by Ms Singh herself. The effect of this is that disclosures which may have been made by Ms Singh in the twelve month period prior to the relevant date must be ignored; they cannot be counted against her. Any disclosures she has made prior to this twelve month period will, however, count.

8) The approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

- a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.
- b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.
- c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the article in question; imperfect recollection has little role to play.
- d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.
- e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

9) In terms of the legal principles, further guidance can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”)². Some of the key points from this are that:

² In reaching his judgment, Mr Justice Arnold referred extensively to a number of other decided cases including the judgment of the European Court of Justice in *Grupo Promer Mon Graphic SA v OHIM* (T-9/07).

- g) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.
- h) In terms of design freedom, this may be constrained by (i) the technical function of the product or an element thereof; (ii) the need to incorporate features common to such products; and/or (iii) economic considerations (e.g. the need for the item to be inexpensive). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user, and vice versa.
- i) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.
- j) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised *similarities* means that the machines give the *same* overall impression. ...”

The informed user

10) Matters must be judged from the perspective of the informed user. In assessing the attributes of such a person I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

“First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the articles and both counsel roundly rejected the candidature of “the man in the street”.

“Informed” to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of “what’s about in the market?” and “what’s been about in the recent past?”. I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any).

In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

11) I also note that the above approach regarding the informed user was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch) and later accepted as appropriate by the Court of Appeal in that case. In *Dyson*, Mr Justice Arnold stated:

“19 In *Grupo Promer Mon Graphic SA v OHIM* (T-9/07), judgment of March 18, 2010, the General Court of the European Union held at [62]:

“It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed.”

20 In *Shenzhen Taiden v OHIM* (T-153/08), judgment of June 22, 2010, not yet reported, the General Court held:

“46 With regard to the interpretation of the concept of informed user, the status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended.

47 The qualifier ‘informed’ suggests in addition that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

48 However, contrary to what the applicant claims, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product’s technical function from those which are arbitrary.”

12) The article in question is a balloon frame. The heart is simply the article’s shape so the informed user must be taken to be a knowledgeable user of balloon frames per se such as an event decorator or balloon artist. He or she will possess the characteristics set out in the preceding case-law.

The prior art

13) I will set aside, to begin with, the claims relating to Ms Singh having disclosed her own design to the public and will begin, instead, with the claims relating to the other designs in the public domain. Saunders’ relies on multiple prior art:

- a) "The walk thru heart" used by Creative Balloon company since at least 12 May 2005".
- b) "A heart-shaped balloon arch of uncertain origin" but which was published as early as March 1995.
- c) "A heart-shaped balloon arch" originally supplied by Dandy Events. It is added that such a frame was supplied to Ms Amanda Hill (trading as Dreams 2 Go) no later than 2000.
- d) A heart shaped balloon frame depicted on the website of www.ballonsit.com in 2004

14) Prior art a), b) and c) were foreshadowed in Saunders' pleaded case but prior d) was not. However, Saunders' pointed out in further submissions that I directed to be filed that the pleaded case was more general (in relation to heart shaped balloon frames generally) and that the prior art identified in the pleadings, whilst being included within the general claim, were not limited to them. Ms Singh, for her part, says that Saunders have only ever relied on the walkthrough heart frame. I have considered whether prior art d) should be taken into account, I come to the conclusion that it should. The pleaded case was generally made and I am satisfied that this enabled the provision of further examples of prior art in the evidence stages against which the assessment of novelty could be made. Furthermore, if I were to disregard this prior art and Saunders failed on the other grounds it relies upon then a further set of proceedings could be instigated, which would not be in the interests of either party. I have, though, ensured that Ms Singh has been provided with an opportunity to comment and provide evidence in relation to prior art d), an opportunity which she availed herself of.

15) In relation to prior art a) and c), it is clear that they are one and the same. Ms Sonn (of Creative Balloon Company) explains in her witness statement that the frame used by her business is, in fact, a "Dandy Frame". Ms Sonn provides pictures of the frame with and without balloons attached. Prior art a) and c) will be treated as one.

16) Saunders' evidence does not deal with prior art b) and the only representation of it (from the statement of case) does not show the frame itself – the depiction shows the frame only with balloons attached. Given that the actual frame (if it has a frame at all) has not been depicted then this cannot put Saunders in any stronger position to the other pieces of prior art and, therefore, I do not intend to make (indeed it is not possible to make) a comparison between prior art b) and Ms Singh's design.

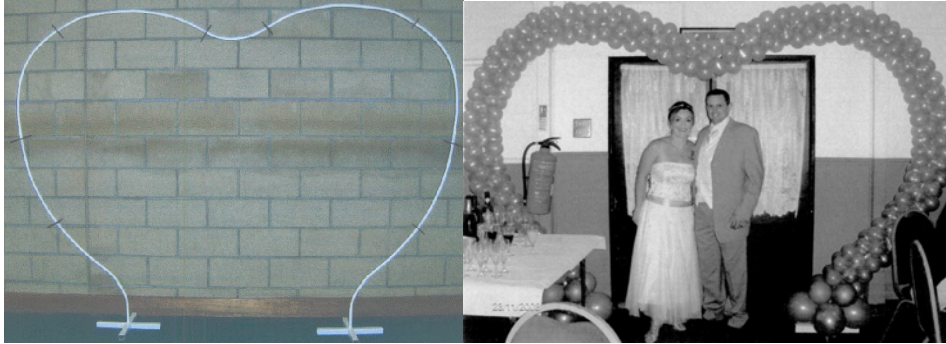
The "Balloonsit.com" frame

17) This frame is mentioned by Mr Saunders in his evidence. He highlights that the print on this website is copyright dated 2004. In her evidence Ms Singh highlights that the copyright date may relate to the website in general and not the design in question. She adds that the only information she could find relates to 2010. She also says that although the website is aimed at balloon decorators, it is not aimed at the general public. She also questions the relevance of the website because many balloon decorators, herself included, have no interest in the site because they used to promote themselves in relation to business logos rather than designs. The evidence from Saunders, however, also includes evidence showing that the “Arch 1 Love” frame, model number 8100031, was available in 2006 and evidence showing that this frame number and name corresponds to a balloon frame clearly mirroring that depicted in Saunders’ initial evidence.

18) A disclosure is not relevant if “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”. The fact that the website may not be known to the general public is not relevant, it is clearly the type of website likely to be used by persons specialising in the sector concerned. There is no reason to suggest that the website was only known outside the EEA. In terms of some balloon decorators not being interested in this website, this is not significant. The question simply relates to public (including the specialised public concerned) disclosure. Widespread disclosure is not a prerequisite. I am also satisfied, based on the totality of Saunders’ evidence, that the balloon frame in question was publicly disclosed by at least 2006. **The balloonist.com design qualifies as relevant prior art.**

19) The designs to be compared are:





20) As the Act and the case-law highlights, the degree of design freedom that the designer has is of importance. The article is a balloon frame. The question of design freedom must be assessed in respect of that type of article, namely balloon frames per se (and not heart shaped balloon frames). Whilst a frame will have some form of configuration to enable it to stand up without falling over, and whilst its configuration is likely to be tubular so that balloons can be attached to it in a way which completely surrounds the frame, the actual shape itself has no real limiting factor. I agree, therefore, with Saunders submission (even though it was based on the degree of design freedom of heart shaped frames as opposed to balloon frames per se) that the degree of design freedom in terms of the shape of a balloon frame is large and, consequently, small differences between the overall impressions of the designs are less tolerable.

21) A detailed analysis of the respective designs show a number of similarities: i) both have stands, albeit the stands may not be quite the same ii) both curve outwardly and upwardly iii) the curved sections then dip in the middle to create the heart like effect. In terms of the differences, the outward curves of Ms Singh's design curve more outwardly than the prior art. Ms Singh's design also has a number of protrusions at what I take to be the frame joints, whereas the prior art has none. These similarities and differences (except for the protrusions) are also evident, to a degree, when the designs are considered with balloons attached.

22) The overall impression of the designs must be assessed from the perspective of the informed user. In terms of the feet, these are functional elements and there is nothing to suggest that they have been designed for aesthetic reasons as well as for function. Being purely functional, I do not consider that the informed user will pay any real regard to the feet in terms of the overall impression of the designs. The same can be said of the protrusions (in Ms Singh's design) which seem to be there to assist in the way in which the balloons are attached, so as to hold overall shape. Whilst there is no evidence about this, it is highly unlikely that the protrusions were designed for an aesthetic purpose given that when the article is in use they will not be visible.

23) Ms Singh refers to the method of construction (one piece against multiple pieces) and the material of construction. Such differences are not relevant because of importance is what the articles look like and not how they are

constructed. She also says that the balloonist.com frame is more similar to the Dandy frame that she and her client were not happy with. Whilst these comments are noted, the point of primary importance is whether the designs, which I concede are not identical, have the same overall impression. The most significant differences are those created by the more outwardly curve of Ms Singh's design. Whilst I have identified these differences, the overall impressions of both designs are still of outward curves with a dip at the top of the frame. These characteristics will form on the informed user an overall impression of a heart shape which, when in use, can be walked through. Whilst the designs are not identical, the question is not whether the designs are identical, but whether Ms Singh's design has a different overall impression. As stated earlier, the degree of design freedom is large meaning that small differences are less tolerable. I come to the conclusion that the differences between the designs are at the small end of the scale and they are not sufficient to create a different overall impression on the informed user. **The invalidation request succeeds on the basis of this prior art.**

The "Dandy Frame"

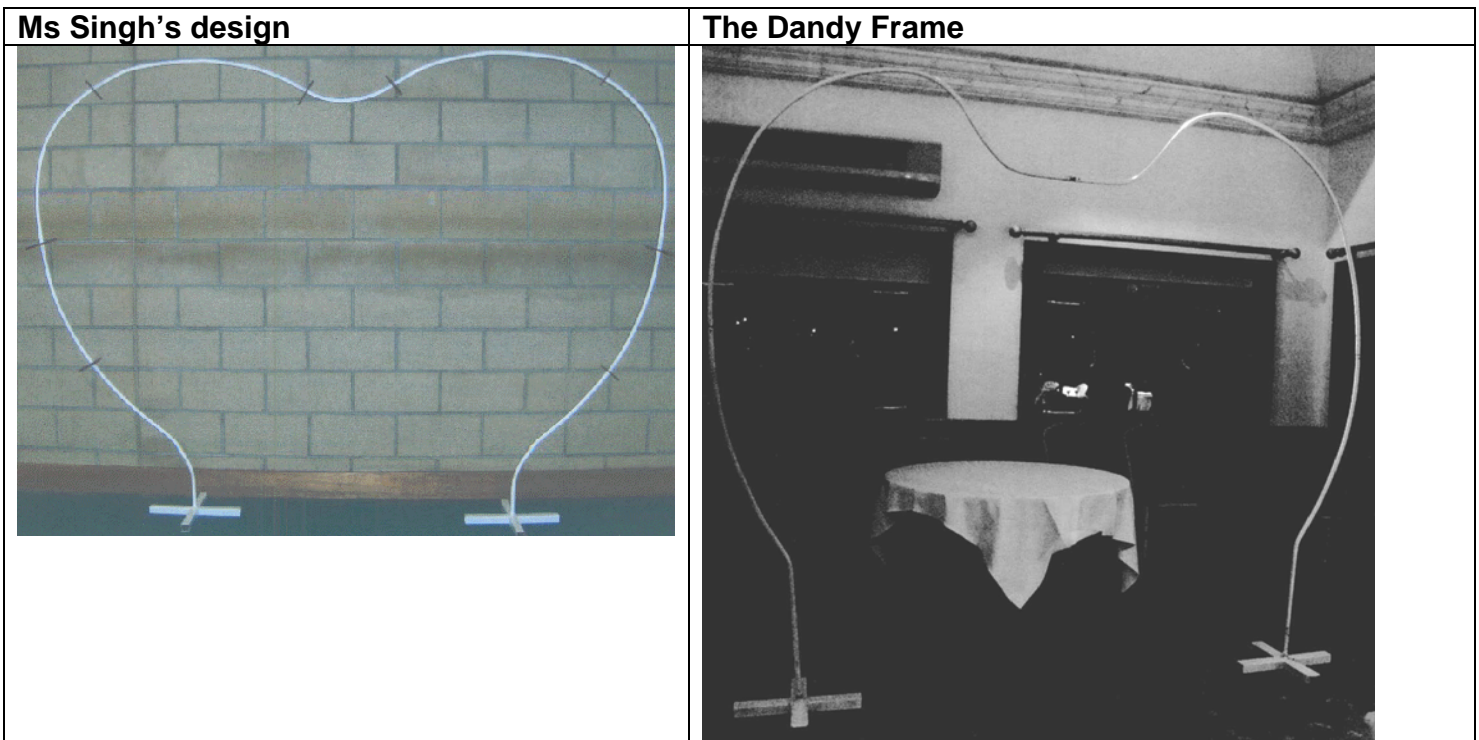
24) Ms Sonn states that she obtained her Dandy Frame no later than 2002. She states that Dandy Event & Party Specialists have been supplying these frames since as early as 1990. She provides pictures taken in July 2004 of the frame, with and without balloons attached to it. She provides a computer screen shot of the electronic file in which the pictures were stored. The thumbnail image is entitled "july 04 014". I note that that the electronic file in which the image was stored was created on 2 December 2009 and modified on 3 July 2004. It is difficult to see how something was modified before it was created. However, Ms Sonn's evidence has not been challenged and so she has not been called upon to explain why the files have been tagged in such a way. In any event, there is unchallenged evidence from Mr Saunders who explains that he worked on the frame in question for Ms Sonn in June 2006. Mr Saunders also exhibits a letter from Amanda Hill of Dream2Go who states that she purchased a Dandy Frame 10 or 11 years ago and that other similar frames were available but normally shipped in from abroad. Ms Hill's letter is not evidence direct from her (she has not filed her own witness statement) so it is only hearsay. However, it at least supports the proposition that the Dandy Frame has been around for some time. Mr Saunders also exhibits a print from the website of Balloons To Go which shows a design which appears identical to the Dandy Frame depicted in Ms Sonn's evidence. It is difficult to ascertain a clear date for this because the copyright notice is 2006-2010.

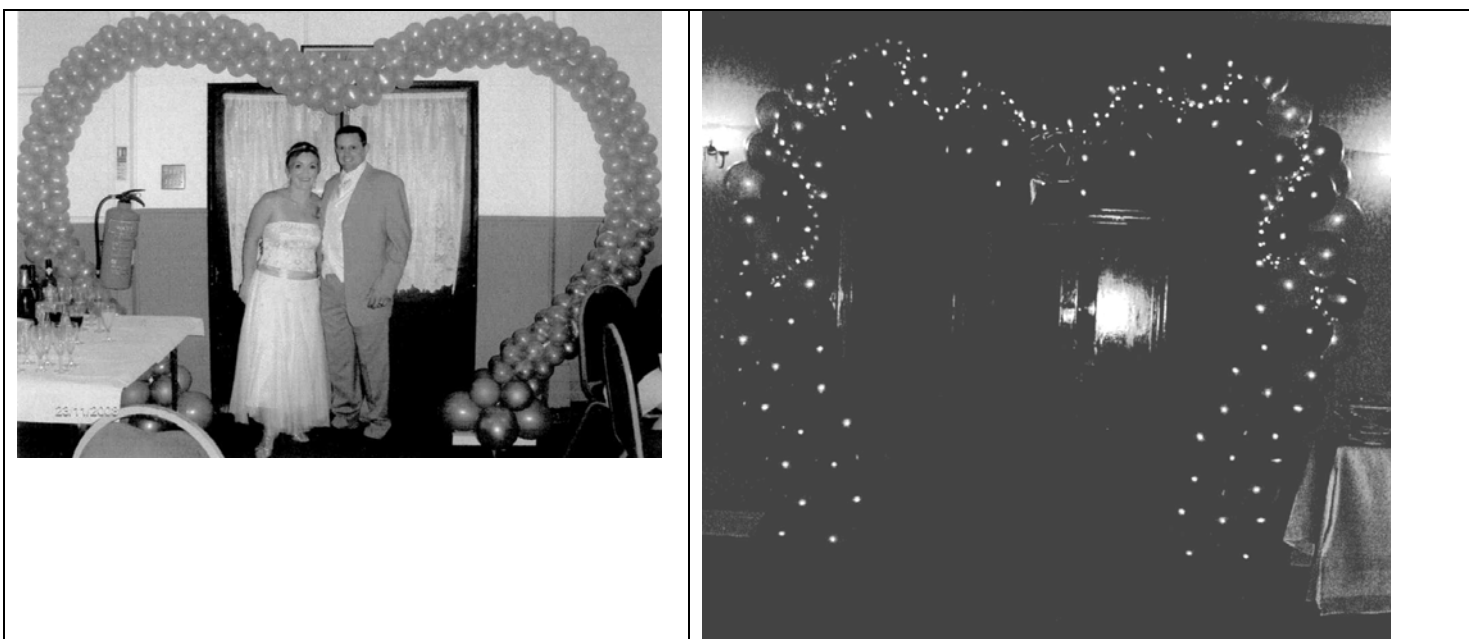
25) Any doubts about the date of the prior art are resolved by Ms Singh's own evidence. This is because she refers herself to the existence of the Dandy Frame. In February 2008 Ms Singh discussed the Dandy Frame with a client (Ms Walker) of hers. It was considered as a potential frame to use at Ms Walker's wedding. The Dandy Frame was not chosen by Ms Walker which, in turn, led Ms

Singh to create the registered design. This is confirmed by Ms Walker whose witness statement confirms all of this. Ms Walker also supplies a picture (with balloons affixed) of what Ms Singh states is a Dandy Frame. Ms Singh at no point denies that the frames depicted by Ms Sonn are not Dandy Frames.

26) On the basis of all of the above, the evidence paints a compelling picture that the Dandy Frame, as depicted by Ms Sonn, was made available to the public and used in trade from at least 2002. **This is well before the relevant date and it therefore qualifies as relevant prior art.**

27) The Dandy Frame and Ms Singh's design are depicted below, both with and without balloons:





28) Similar considerations apply here in that both designs curve outwardly and upwardly. The feet are very similar but this is not significant given my earlier comments. The absence of protrusions in the prior art is also not significant for the reasons given earlier. The primary difference between these designs is that the prior art has a straighter section in the top dip of the heart and that Ms Singh's design curves more outwardly.

29) Whilst I have identified the above differences, the overall impressions of both designs are still of outward curves with a dip at the top of the frame. These characteristics will form on the informed user an overall impression of a heart shape which, when in use, can be walked through. Whilst the designs are not identical, as stated earlier, the question is not whether the designs are identical but whether Ms Singh's design has a different overall impression. The degree of design freedom is large meaning that small differences are less tolerable. I come to the conclusion that the differences between the designs are at the small end of the scale and they are not sufficient to create a different overall impression on the informed user. I note Ms Singh's observations that the Dandy Frame has a more "M" like look. I, though, have come to the view that the prior art will be seen by the informed user as a heart shaped balloon frame (with the characteristics described above). The fact that Ms Singh did not want to use a frame identical to the Dandy frame is borne in mind, however, whether the frame she subsequently designed differs from the overall impression of the prior art is a matter for the tribunal to decide based on an application of the principles set out. For the reasons already outlined, I come to the view that the design Ms Singh produced does not so differ in overall impression. **The invalidation request succeeds on the basis of this prior art.**

Ms Singh's disclosures

30) For a disclosure made by Ms Singh to count against her, it must have been made before the twelve month period immediately preceding the relevant date. The relevant date is 3 June 2009, so the twelve month period in question is 3 June 2008 to 2 June 2009. For it to count, Ms Singh must have disclosed her design before 3 June 2008.

31) Saunders refers to a number of disclosures that Ms Singh is alleged to have made. These include disclosures to Essex Displays (the predecessor of Saunders), to Premier Security Solutions and to Aztec displays. These three potential disclosures can be quickly ruled out because it is clear from the evidence that Ms Singh did not work for Essex Displays until August 2008 and that her interactions with Premier Security Solutions and Aztec Displays did not take place until after her employment began. **Given the dates referred to in the preceding paragraph, the claimed disclosures are not relevant.**

32) Saunders' also refers to alleged disclosures by Ms Singh to Ms Walker (her client) and to Mr Gibbard (her father). These need to be assessed in greater detail. It is necessary to consider the chronology of the creation of the design.

33) The origins of the registered design can be traced back to the meeting that Ms Singh had with Ms Walker. In this meeting a discussion took place between the two as to an appropriate balloon frame that could be used at Ms Walker's wedding. This meeting took place in February 2008 which means, given the dates referred to above, that if the design was disclosed by Ms Singh then it would be relevant. However, it is clear that the design the subject of these proceedings was not actually disclosed at the meeting. The Dandy Frame was discussed and rejected. All that happened is that Ms Singh agreed to source an alternative. Nothing specific was disclosed. When Ms Walker subsequently had the designed frame at her wedding the date had moved on to July 2009 which is after the relevant date and, so, does not count. **There is no evidence of a relevant disclosure made by Ms Singh to Ms Walker.**

34) Saunders submissions further suggest that even if Ms Singh did not disclose the design to Ms Walker then the creation subsequent to the meeting meant that the design was a result of a commission. There is no evidence of a commission taking place. If a commission was in existence then it should be reasonably clear to see. There is nothing in the evidence of either Ms Singh or Ms Walker to suggest that a commission was in play. In any event, I struggle to see the relevance of this claim because if Ms Walker is the proprietor of the design on account of being a commissioner, then this has no bearing on this invalidation claim. A claim to invalidation on account of disputed ownership can only be made by the person said to be the true proprietor. **The argument made by Saunders as to Ms Walker commissioning the design has no relevance to the issues before me.**

35) After her meeting with Ms Walker, Ms Singh started to create the design. When doing so she took assistance from her father, Mr Victor Gibbard. Mr Gibbard has a background in engineering. Mr Gibbard confirms that this was in February 2008. Mr Gibbard was to make up a frame using copper piping. The shape for the design was created in Mr Gibbard's living room. Ms Singh chose the size etc and used electrical wire to obtain the shape required. The design was then transferred onto a full scale plan which Mr Gibbard then used to produce the first frame made to that design. Whilst it could be argued that Ms Singh had, therefore, disclosed the design to Mr Gibbard, this does not strike me as a disclosure in the sense of the design being made available to the public. A disclosure to a single member of the public may be enough. This was held by Bowen LJ in *Humpherson v Syer* (1887) 4 RPC 407 where the member of the public concerned was free in law and equity to use the information disclosed to him as he so pleased. However, a disclosure made by the designer to her father who is assisting with the production of an article made to the design does not strike me as a disclosure to the public. A disclosure may have an implied condition of confidentiality (see section 1B(6)(B)). The circumstances are ones where Mr Gibbard would not likely have believed that he was free to use the information (the design) in any way he chose. Mr Gibbard confirms that what he was doing was to his daughter's benefit and it would, therefore, be counterintuitive to believe that he would be able to pass the design on to the public at large (and if he did, that itself would not count in view of the provisions of section 1B(6)(D)). **I am not satisfied that any disclosure to Mr Gibbard constituted a public disclosure.**

Conclusions based on novelty

36) Whilst the claims fail in respect of Ms Singh's disclosures, the claims relating to the Dandy Frame and the Balloonsit frame succeed. This means that the application for invalidation is successful and Ms Singh's design is held to be invalid.

The proprietorship claim

37) As I have already determined the registered design to be invalid, I do not intend to deal with this claim in detail but I will, in case of appeal, give some brief views.

38) It is clear from the evidence of Ms Singh that she started the creative process for her design prior to gaining employment with Saunders. This is confirmed by Mr Gibbard who produced some form of prototype matching the shape and configuration Ms Singh had mapped out. In terms of Ms Singh's employment, both parties refer to it as being in a secretarial capacity although Saunders' evidence is that they utilised Ms Singh's previous experience in the party industry in a project to design a walk through heart frame. It is clear, though, that Ms Singh was not employed as a designer.

39) Ms Singh says that the work she had already undertaken on the design was carried on whilst working for Saunders in her own time. She says that she discussed her design with Mr Saunders who simply gave her advice about possible manufacturing contacts. She visited some of these companies in what she says was her own time and that she paid for related expenses such as petrol. On only one occasion does Ms Singh say that Saunders contributed to her expenses, this was when she undertook some separate activity for Saunders; the killing of two birds with one stone meant that Saunders contributed £10 towards petrol. Mr Saunders, on the other hand, says that all of this was just part of a project that was on-going and that Ms Singh visited the manufacturers at his direction and that some of her expenses were reimbursed through petty cash.

40) Ms Singh says that her relationship with Saunders developed into one of potential distributor/retailer of the frames. Saunders were to sell the frames through its business. Saunders say that this is not the case and that Ms Singh was simply its employee. Both sides filed some documentary evidence to support their claims. Ms Singh provides:

- i) A quotation from Premier Security Solutions Ltd dated 28 August 2008. It is addressed to Ms Singh at what appears to be her home address;
- ii) A receipt for the purchase of balloons to decorate the frame dated 5 December 2008;
- iii) Another quotation from a manufacturing company (Frontline Marketing) for the frames dated 20 January 2009. This is an email, it is not possible to see if it was sent to Ms Singh's personal email account or one belonging to Saunders. Either way there is no mention of Saunders;
- iv) An invoice dated 26 February 2009 from Aztec Displays for what is said to be a sample frame (the invoice refers to "balloon samples"). The invoice is again sent to Ms Singh's home address;
- v) A print of a reservation at the Holiday Inn Express for 28 April 2009 which was booked for Ms Singh to attend a conference to show the new frames.

41) Mr Saunders' provides:

- i) An invoice to Saunders dated 17 April 2009 from Cherin Products & Services Limited for "Samples Arch Heart and Wire Form";
- ii) An email from Ms Singh in which she resigns from Saunders in which she refers to having spent many hours "promoting your [Saunders] business with the balloon frames";
- iii) A letter from Cherin Products & Services addressed to Ms Singh which refers to its understanding that when Ms Singh visited them

they were under the impression that it was in her capacity an employee of Saunders;

- iv) Invoices showing that Saunders paid for Ms Singh's room at the Holiday Inn and that Saunders paid for the stand at the conference;
- v) Details of contacts and orders received from the conference and the Saunders' business cards that were issued at it.

42) The onus is on Saunders to show that the creation of the design by Ms Singh was in the context of an employee/employer relationship. There are clearly two different versions of events put forward. However, what Ms Singh says is not inconsistent with the documentary evidence supplied by Saunders. If what she says is true in terms of her developing a business relationship with Saunders then it is quite possible for an invoice to be made out to Saunders for the frames and that Saunders would pay for Ms Singh to attend the conference to promote them. The fact that the frames were to be sold through Saunders' business is a different matter from the ownership of the design. Saunders highlights Ms Singh's email of resignation which followed the conference in which she refers to promoting Saunders' business. This is not inconsistent with Ms Singh's explanation as a business relationship had developed between the parties so she would have been promoting Saunders' business selling and distributing the frames. This applies also to Saunders' evidence about paying for the conference and obtaining orders/contacts. If Saunders were selling the products then it is inevitable that the stand would be set up in Saunders' name, that Saunders would benefit from the orders and contacts made and that Saunders would pay for the stand.

43) In view of this, Saunders' documentary evidence does little to prove its case. In terms of Saunders' explanations, it is not particularly detailed in terms of the creation of the design. Ms Singh's evidence, on the other hand, is detailed and is not inconsistent with Saunders' documentary evidence. Her documentary evidence supports that she was progressing things in her own name and time (the quotations and invoices addressed to her at her home address). Things may have changed and a business relationship developed, but it is reasonably clear that this was not in a true employee/employer relationship. The test is based on the balance of probabilities. Bearing this in mind, it is my finding that Ms Singh's version of events is the more probable. **The ground based on proprietorship would have been rejected if it was determinative of the application for invalidation.**

COSTS

44) Saunders having been successful, it is entitled to a contribution towards its costs. With regard to costs, although the registrar has a wide discretion in relation to such matters, he nevertheless works from a published scale (as per Tribunal Practice Notice 4/2007). I have borne the scale in mind when determining what award of costs to make. I hereby order Ms Belinda Singh to pay Saunders

Displays (UK) Ltd t/a Saunders Displays the sum of £600. This sum is calculated as follows:

Fee for requesting invalidation	£50
Preparing a statement and considering the other side's statement	£250
Filing evidence and considering Ms Singh's evidence	£300

45) It will be noted that I have not awarded Saunders any costs in relation to the filing and considering of evidence. This is because the bulk of both parties evidence focused primarily (although not exclusively) on the proprietorship issue and the creation of the design in question. As Saunders failed on this claim and also the claim relating to disclosures made by Ms Singh then it would be inappropriate to award it costs for such evidence.

46) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17 day of October 2011

**Oliver Morris
For the Registrar, the Comptroller-General**