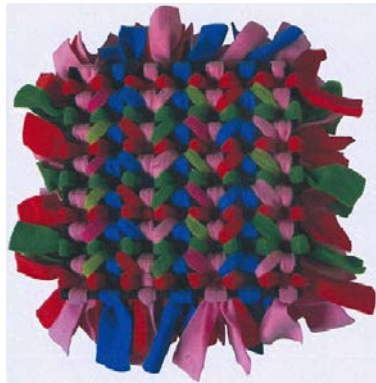


**O-375-16**

**REGISTERED DESIGNS ACT 1949 (AS AMENDED)**

**IN THE MATTER OF REGISTERED DESIGN NO. 5001346  
IN THE NAME OF MS SARAH WHITE  
IN RESPECT OF THE FOLLOWING DESIGN:**

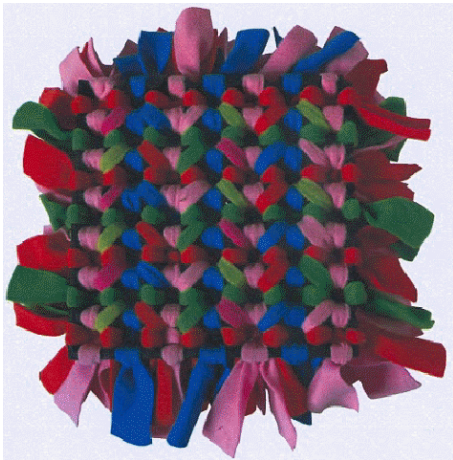


**AND**

**A REQUEST TO INVALIDATE (NO. 8/16)  
BY MRS SHARON DAVIS**

## The claims and the counterstatement

1. The registered design the subject of these proceedings was filed by Ms Sarah White on 1 February 2016. A certificate of registration was granted on 7 March 2016. The design, which is described as a “pet play mat”, is depicted below:



2. Mrs Sharon Davis requested the invalidation of the design under section 1B(1)<sup>1</sup> of the Registered Designs Act 1949 (“the Act”), which relates to the requirement that designs must be novel in comparison to designs which have already been made available to the public. Mrs Davis states that the design is based upon a well-known design of a “snuffle mat” and has been around since 2011 and has been made all over the world.

3. Ms White filed a counterstatement defending her registration. I note the following comments:

“I have been making my pet play mats since 1994....”

“I made and sold these to other potbellied pig owners during the 1990s”

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<sup>1</sup> Which is relevant in invalidation proceedings due to the provisions of section 11ZA.

“I have continued to make the rooting rug and sold it locally through word of mouth during the 2000s...”

“..the product was certainly not invented in 2014 by the Dutch, as claimed by Mrs Davis, nearly 20 years after I had been originally making them.”

### **The relevant legislation**

4. 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.”

**Is there a basis for the defence?**

5. The nub of Ms White’s defence is that she has been making the design since 1994 and has been selling the design since the 1990s, more than twenty years before the relevant date of 1 February 2016. Ms White appears to consider this to

be relevant because her use pre-dates any designs which have subsequently come along. However, such a defence, on the face of it, is misconceived. First, the novelty of a design is not determined on a “who got there first” basis. Second, the novelty of a design can, potentially, be destroyed not just by the disclosure of a design by a third party, but also by the disclosure of the design itself (in this case Ms White’s design) by its designer. There are, though, certain exceptions to what I will call “self-disclosure” (including disclosures made with some involvement of the designer). These are set out in section 1B(6) as follows:

“(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.”

6. As can be seen, the above exceptions apply only in relation to disclosures made in the 12 month period before the relevant date. The exceptions provide what is often regarded as a grace period of 12 months, the operative effect being that from the date on which the designer discloses the design, he/she may file an application for registration of the design without the prior disclosure counting against its novelty. However, in the case before me, Ms White has stated that she disclosed the design (because it was sold) many years ago. The consequence of this is that the above exceptions do not apply. There are two further exceptions in section 1B(6), these relate to confidential disclosure or obscure disclosure, but there is nothing whatsoever to suggest that these apply.

7. Given the nature of her counterstatement, I wrote to Ms White indicating my view that her own statements confirmed the claim that the design was not valid and that, effectively, she had no tenable defence. I indicated that it was my intention to issue a summary decision on this basis, but, before doing so, Ms White was afforded an opportunity to make submissions and/or to request a hearing. No response to this letter was made. Consequently, this decision stands as my summary decision. The claim for invalidation succeeds.

### **Costs**

8. I wrote to the parties asking for submissions on costs and asking whether notice had been given that the application for invalidation was to be made. Only Mrs Davis responded. She provided information about Ebay (and other e-commerce platform) disputes that had arisen between the parties which led to some of her listings being taken down. In communication between the parties, I note that Ms Davis did at one point highlight that she may seek invalidation of the design, but there is nothing in the communication to show that notice was formally given, which would have enabled Ms White to voluntarily cancel the registration. That being said, it is unlikely that Ms White would have done so given that she defended her registration, albeit on an untenable basis. In the circumstances, and given that the registration has been deemed invalid, I consider that Mrs Davis is entitled to an award of costs. I award £50 for the official fee paid and £50 for completing the DF19A. It is not possible to make any form of award for any lost sales while listings on Ebay (etc) were taken down.

9. Ms Sarah White is ordered to pay Mrs Sharon Davis the sum of £100 within fourteen 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 5th day of August 2016**

**Oliver Morris**

**For the Registrar, The Comptroller-General**