

**O-086-17**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NO 4014852**

**OWNED BY BUSHBABY LTD**

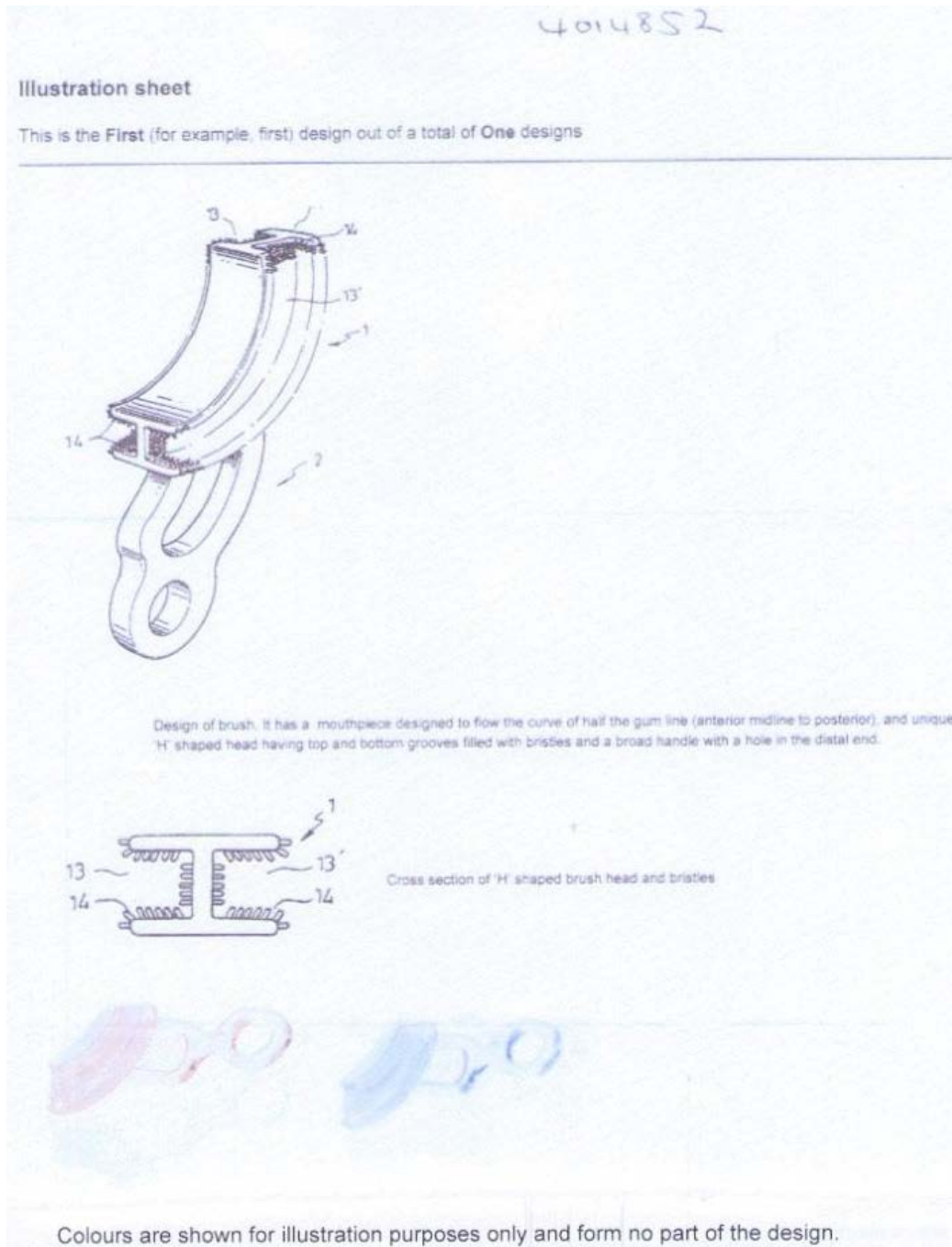


**AND**

**AN APPLICATION (No. 5/16) TO INVALIDATE THE DESIGN  
BY JUSTIN BERNHAUT**

## The background and the claims

1. The registered design the subject of these proceedings was filed by Bushbaby Ltd (the proprietor) on 5 March 2010. The proprietor has at all times represented itself in these proceedings. Its design is described as a “baby toothbrush”. The illustration sheet provided at the time of filing looks like this:



2. The representation of the design on the cover page of this decision appears to be a cleaned up version of the first image above, with the numbers removed. A certificate of registration was granted on 2 July 2010.

3. The applicant for invalidation is Mr Justin Bernhaut. Initially, he did not avail himself of legal representation and the proceedings were brought under section 1(C)(1) of the Registered Designs Act 1949 (the Act), which prohibits registration of a design if it is solely dictated by technical function. However, during the course of the proceedings the applicant appointed Keltie LLP as his legal representative. This led to a request to amend the pleaded case to replace section 1(C)(1) with section 1B of the Act, the new ground relating to the requirement that designs must be novel in order to be validly registered. I allowed the request to amend. It was clear that the applicant had misunderstood the relevant sections of the Act and that it was better to move forward with a properly founded set of proceedings, thus avoiding the potential for a multiplicity of proceedings. The proprietor indicated that it objected to the request, so was advised that a procedural hearing could be sought to discuss the matter. A hearing was not sought. I should add that although I allowed the request to amend, I considered that this was something that should be reflected in costs, something to which I return later.

4. The pleading under section 1(B) of the Act is based on a claim that the design had already been publically disclosed before it was filed. Three types of disclosure are relied upon: i) that the design was published as part of a US Patent in April 1997; ii) that an article made to the design was published on the website babybuddy.com in July 2005; iii) that the disclosure on the website demonstrates that the product has been on sale to the public since July 2005 (further evidence of this is provided by way of the product being depicted in a YouTube video in September 2009 and on amazon.com since 2007).

5. The proprietor filed a counterstatement in relation to the amended pleading. Initially, the basis on which the defence was made was not clear. After seeking clarification, the following can be summarised as the basis for the defence:

- The proprietor was authorised to commercialise the US patent in the UK market, but it nevertheless developed its own “tooling design” based on the US

patent. The proprietor's tooling is said to be the object of its registered design and is unique.

- In relation to the website and sales in the US, it is claimed that the product was a further design interpretation of the US patent which was commercialised in the US not the European Economic Area (EEA) or the UK. The proprietor is not aware of any business being undertaken in the UK by the relevant US company in the five years leading to the design being filed. Likewise, the proprietor has not ventured into the US market.
- Given the above, it is claimed that the disclosed design could not reasonably have become known to persons carrying on a business in the EEA specialising in the sector concerned.

6. Only the applicant filed evidence (which accompanied its amended statement of case). Neither side asked for a hearing, but both parties filed written submissions instead.

### **The evidence**

7. I have touched on the applicant's evidence already when detailing what was contained in its statement of cases. I will return to it in more detail, to the extent necessary, later in this decision.

### **The legislation and leading case-law**

8. Section 1B of the Act (so far as it is relevant) 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) -

(c) -

(d) -

(e) -

(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)--”

9. The relevant case-law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple*<sup>1</sup>. The most relevant parts are reproduced below.

**“The informed user**

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

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<sup>1</sup> [2012] EWHC 1882 (Pat)

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

### **Design freedom**

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom 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).”

### **Effect of differences between the registered design and the design corpus**

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted,

for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

### **The correct approach, overall**

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of "different overall impression" is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is



particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

10. Part of the proprietor’s defence is based on section 1(B)(6)(a) of the Act. This enables a disclosure to be ignored for the purposes of the novelty assessment 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.”

11. In *H. Gautzsch Großhandel GmbH & Co. KG v Münchener Boulevard Möbel Joseph Duna GmbH*<sup>2</sup> the Court of Justice of the European Union (CJEU) had referred to it the following preliminary questions.

“1. Is Article 11(2) of Regulation ... No 6/2002 to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders?

2. Is the first sentence of Article 7(1) of Regulation ... No 6/2002 to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if:

(a) it is made available to only one undertaking in the specialised circles,

or

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<sup>2</sup> Case C-479/12

(b) it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?”

12. The CJEU answered thus:

“..... on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it”.

“... The same is true of the question whether the fact that a design has been disclosed to a single undertaking in the sector concerned within the European Union is sufficient grounds for considering that the design could reasonably have become known in the normal course of business to the circles specialised in that sector: it is quite possible that, in certain circumstances, a disclosure of that kind may indeed be sufficient for that purpose.

In the light of the foregoing, the answer to the second question is that, on a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.”

13. The above concerned prior art that had been shown in showrooms in China and the design disclosed to a single undertaking in Belgium. The CJEU answers are, essentially, that disclosure in the EEA is a question of fact for national courts and

tribunals to determine. However, it is also clear that a single disclosure to a person in the relevant sector in the EEA may, on occasions, be sufficient to prevent article 7(1) of Regulation 6/2002 from applying. The same must be equally applicable to the corresponding identical provisions of the EU Designs Directive<sup>3</sup> and the implementing national legislation, which includes section 1B(5)(b) of the Act.

14. It therefore appears that (a) disclosures outside the EEA may be sufficient to bring the design to the attention of *the circles specialised in the sector concerned*' within the EEA, (b) the extent of the disclosure required need not involve widespread disclosure to relevant persons in the EEA. This is consistent with the European Commission's 1996 Amended Proposal for the Designs Regulation, which explained the exception as follows:

“...Article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the ‘safeguard clause’. Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.”

15. I also note the decision in *Senz Technologies BV v OHIM*<sup>4</sup> where the General Court upheld the EUIPO's decision to invalidate an EU design on the basis of a prior disclosure of the design in the US register of patents, there being no evidence that designers in the EU would not have seen the entry. In its submissions the applicant also highlighted the decision of Arnold J in *Magmatic Ltd v PMS International Ltd* [2013] EWHC 1925 (Pat) (11 July 2013):

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<sup>3</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

<sup>4</sup> Joined cases T-22/13 & T-23/13

“34. Although it was not directly in issue, the obscure disclosures exception was considered by the Court of Appeal in *Green Lane Products Ltd v PMS International Group Plc* [\[2008\] EWCA Civ 358](#), [\[2008\] FSR 28](#). Jacob LJ, with whom Ward and Rimer LJJ agreed, said:

"66. ... How then did the exception to absolute novelty come about? The *travaux* are clear about this. It came about by reason of a specific piece of lobbying by the textile industry. It was a concern about counterfeiting and nothing to do with an intention that prior art, obscure in the field of intended use, should be discounted.

67. The Economic and Social Committee opinion of 1994 said this when considering the novelty provision:

'3.1.2 This provision, as worded, would be difficult to apply in many fields, and particularly in the textiles industry. Sellers of counterfeit products often obtain false certification stating that the disputed design had already been created in a third country.

3.1.3 In these circumstances, the aim should be dissemination to interested parties within the European Community before the date of reference.

3.1.4 In the light of the above considerations, article 5(2) might be worded as follows: "A design shall be deemed to have been made available to the public if it has been published following registration, exhibited, used in trade or otherwise disclosed, unless this could not reasonably be known to specialist circles in the sector in question operating within the Community before the date of reference."

68. This is clearly the forerunner of the exception in article 7. The Economic and Social Committee's suggestion was taken up, extended also to the individual character test and became the law. It is worthwhile

quoting the Commission's explanation for the proposed exception contained in its 1966 amended proposal:

'... article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the "safeguard clause". Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.'

69. As Mr Hacon observes, for the exception to work as intended the sector concerned had to be that of the cited prior art. His example demonstrates this:

'If the registered Community design was in respect of a design for, say, teapots and the alleged prior art was for Columbian textiles, it would be the textiles circles in Europe who would be in a position to know whether the "certification" was genuine. *Ex hypothesi* the teapot circles would never know.'

70. Moreover the exception was clearly conceived as narrow - it was aimed at obscure prior art only: it meant that forging this would not help an infringer.

71. Although there were further *travaux* before the ultimate Regulation, there was no significant relevant further change."

35. There is a helpful discussion of this exception, which includes references to some more recent case law elsewhere in Europe, in Stone, *European Union Design Law: A Practitioners' Guide* (OUP) at §§9.22-9.66. As the author comments, the wording of the exception gives rise to a number of questions of interpretation which may require resolution by the Court of Justice of the European Union. In Case C-479/12 *H. Gautzsch Grosshandel GmbH v. Münchener Boulevard Möbel Joseph Duna GmbH* the Bundesgerichtshof has referred a question concerning the interpretation of the exception to the CJEU, but neither side suggested that I should defer judgment in the present case until after the CJEU has given its judgment. Nor was it suggested that I should refer questions myself. Accordingly, I must interpret the exception as best I can in the light of the guidance that is currently available. There are a number of points to consider.

36. First, the exception refers to "these events". The "events" are the events constituting disclosure referred to earlier in the first sentence of Article 7(1) – publication, exhibition, etc. Counsel for PMS submitted that the exception did not apply if the relevant event could reasonably have become known, even if the design itself could not reasonably have become known as a result of that event. I do not accept that submission. The purpose of the exception is to prevent obscure designs from being relied upon to attack the novelty and individual character of a Community registered design. If a design could not reasonably have become known, it cannot matter that the event could have become known. In most cases, of course, one will follow from the other.

37. Secondly, what is "the sector concerned"? In *Green Lane* the Court of Appeal held that it was the sector from which the prior design came, not the sector from which the registered design came. The Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) came to the opposite conclusion in Case R 84/2007-3 *Ferrari SpA v Dansk Supermarked A/S* (unreported, 25 January 2008) and Case R 9/2008-3 *Crocs Inc v Holey Soles Holdings Ltd* [2010] ECDR 11. An appeal to the General Court in the latter case was not pursued. In those circumstances, I am bound by the Court of Appeal's decision in *Green Lane*. Furthermore, I agree with it.

38. Thirdly, who are "the circles specialised in" that sector? In *Green Lane* Lewison J (as he then was) held at first instance that this comprised all individuals who conducted trade in relation to products in that sector, including those who designed, made, advertised, marketed, distributed and sold such products in the Community ([\[2007\] EWHC 1712 \(Pat\)](#), [2008] FSR 1 at [34]-[35]). This point was not addressed by the Court of Appeal. In Case R 552/2008-3 *Harron SA v THD Acoustics Ltd* (25 July 2009, unreported) the Board of Appeal held that the circles included experts and all businesses involved in the trade including importers. Thus it seems clear that the words are to be broadly interpreted.

39. Fourthly, the test is whether the events "could not reasonably have become known in the normal course of business". It is common ground that this is an objective test. Counsel for PMS emphasised that the question was whether the events *could not* have become known, not whether the events *would not* have become known. I accept that, but subject to the qualification that the test is whether the events could not *reasonably* have become known *in the normal course of business*. The wording must be interpreted as a composite whole.

40. It is common ground that the events in question must have occurred prior to the filing or priority date of the registered design. Counsel for PMS accepted that it was theoretically possible for a design to have become sufficiently obscure as a result of the passage of time that it could not reasonably have become known in the normal course of business at the filing or priority date even if it could have become known at the date of the event, although he submitted that this was unlikely to occur in practice.

41. Fifthly, who bears the burden of proof? Counsel for PMS submitted that the burden of proving that the exception applied rested on the party who relied on it, here Magmatic. He argued that this interpretation was supported by both the wording and purpose of the exception and by the case law of the Board of Appeal, in particular Case R 1516/2007-3 *Normanplast snc v Castrol Ltd* (unreported, 7 July 2008) at [9]. Counsel for Magmatic submitted that the burden of proving that the disclosure was made available to the public rested on the party challenging the validity of the registered design, and that included

proof that the design could reasonably have become known as result of the event relied on. In the alternative he submitted that, if the burden of proof lay on the proprietor of the design, nevertheless the evidential onus could shift if on its face the disclosure was an obscure one. In support of these submissions, he relied on the decision of the Board of Appeal in Case R 1482/2009-3 *Termo Organika Sp. z.o.o. v Austrotherm GmbH* (unreported, 22 March 2012) at [38]-[44]. As counsel for PMS submitted, however, there is no indication in that decision that the question of burden of proof was argued or that the Board of Appeal was addressing its mind to the question. In my judgment the burden of proving that the exception applies rests on the party relying on the exception. I accept, however, that the evidential onus may shift to the other party once it is shown that the disclosure relied on appears to be an obscure one.”

16. Although Arnold J’s decision was the subject of appeal to both the Court of Appeal and the Supreme Court, no criticism has been made of the above guidance.

#### **The relevant date**

17. The relevant date is the date on which the proprietor applied to register its design i.e. 5 March 2010.

#### **The case based on the publication of the US patent**

18. The proprietor has not denied the existence of the US patent or that it was published in 1997. However, it denies the relevance of the US patent on the basis that it has the right to commercialise the patent in the UK and, further, that its design is unique because it developed its own tooling design based on the US patent.

19. It is worthwhile at this point comparing the design with the prior art (the US patent). The illustrations provided when the registered design was filed look like this:

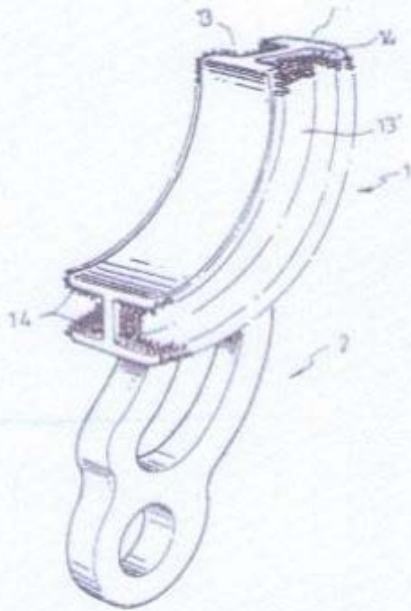


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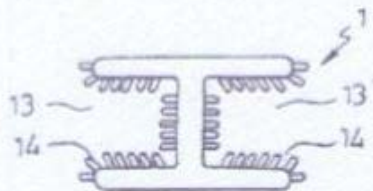
### Illustration sheet

This is the **First** (for example, first) design out of a total of **One** designs

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Design of brush. It has a mouthpiece designed to flow the curve of half the gum line (anterior midline to posterior), and unique 'H' shaped head having top and bottom grooves filled with bristles and a broad handle with a hole in the distal end.

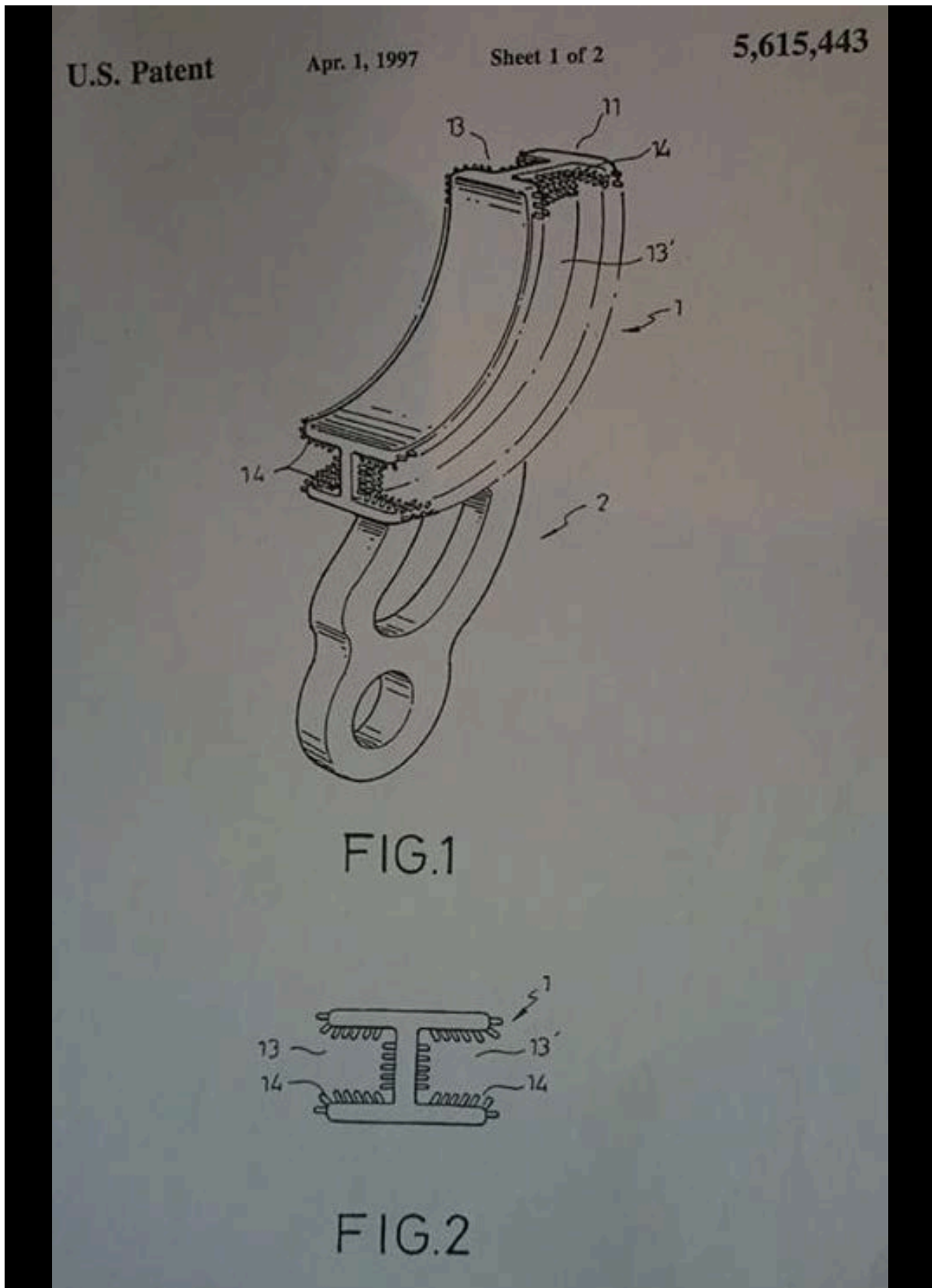


Cross section of 'H' shaped brush head and bristles



Colours are shown for illustration purposes only and form no part of the design.

The most relevant illustrations of the US patent look like this:



20. Put simply, the detailed line drawings provided in respect of the patent/design are the same. Any difference created by the proprietor's claimed unique tooling design is not apparent in the representation it has provided, or, if it is, cannot be seen. As the applicant pointed out in its statement of case, the drawing used by the proprietor appears to be a direct copy of one of the drawings used for the US patent. The use of the word "copy" is not intended to suggest any form of impropriety, but merely reflects the fact that the same artwork is in use, illustrated not only by the drawing itself, but also by the use of the same numbering of features of the patent/design. I note that the applicant's comments in this respect were made in relation to a second representation of the design shown on the official record which had been cleaned up and the number's removed, but the point remains the same.

21. I acknowledge that the representations provided by the proprietor contain additional images showing two products made according to the design. These images are unclear and they do not clearly show any material difference in the way in which the product has been made. In any event, the provision of a detailed drawing by the proprietor must fairly be taken to be the design it wants registered. Hence, this takes the applicant no further forward. Whether in trade the proprietor has manufactured a product which has further differences created by its claimed unique tooling does not matter. The tribunal can only work upon what the proprietor has registered as its design. Similarly, in its written submissions a picture said to be tooling design from 2009 is provided; this is not helpful for three reasons: i) it was not filed in evidence, ii) it is small and unclear and iii) it does not form part of the registered design.

22. In its written submissions the proprietor states that the

"disclosure of a patent does not mean resulting commercial designs cannot be registered under design right. The Brush-Baby product arises from Bushbaby Ltd's design tooling. The design is not an exact copy of Patent US5615443".

23. I have already given my views that the design and the patent appear to be the same and that any difference created by the design tooling is not apparent in what has been registered. In terms of the general point that a disclosure of a patent does not mean that resulting commercial designs cannot be registered, the proprietor is, in my

view, misguided. If a patent has been disclosed prior to the filing of a registered design, then unless the proprietor of the design can avail itself of one of the defences set out in section 1(B)(6), any design which is the same as that shown in the patent document, or one that does not differ in overall impression, will have had its novelty destroyed. I come to the very clear view that the registered design is identical to the prior art which comprises the US patent. If there are any differences (which I strongly doubt) they are immaterial given that I cannot even see them. This means that, all things being equal, the proprietor's design is invalid. I should stress at this point that the fact that the proprietor may be authorised to commercialise the patent in the UK is not pertinent. The relevant questions revolve around prior disclosure. To exemplify this, it is possible, and indeed often happens, that the novelty of a design can be destroyed by a disclosure made by the author of the design him/herself (subject, again, to any relevant defences).

24. In terms of whether the proprietor can avail itself of a defence, reference has been made to section 1(B)(6)(a) of the Act, the so called obscure disclosure provisions. It is not altogether clear whether the proprietor relies on the defence in relation to the patent disclosure (its comments were made more in relation to the disclosures on the US website and subsequent sales), however, I will give my views on the matter as if it had been pleaded in defence.

25. In my view, the defence is bound to fail. I referenced earlier the decision of the General Court in *Senz Technologies BV v OHIM*<sup>5</sup> where it upheld the EUIPO's decision to invalidate an EU design on the basis of a prior disclosure in the US register of patents. This seems on all fours with the present case. However, even without this precedent, it seems to me that the publication of a patent in the US, a country that is regarded as one of the most important industrialised nations in the world, means that it would be wrong to conclude that the publication could not reasonably have become known to persons specialising in the relevant sector in the EEA.

26. To supplement its argument the applicant refers to the fact that the proprietor must have become aware of the patent via some avenue for it to subsequently

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<sup>5</sup> Joined cases T-22/13 & T-23/13

commercialise it, thus demonstrating that the disclosure was not obscure. The proprietor commented on this in its written submissions, although much of what it said was more akin to evidence than submission. The primary points appear to be that the proprietor was yet to be incorporated when the US patent was published and, further, that the proprietor was not a specialist in this sector at the relevant time. The first point does not assist because the proprietor clearly became aware of the disclosed patent. Likewise, the second point is not a good one because if a business that claims not to be a specialist in the sector became aware of the US patent then this point towards the disclosure being not obscure as opposed to obscure. In view of all this, I accept the applicant's point, although, for sake of clarity, I add that I would have found for the applicant with or without this point.

27. My finding is that the design the subject of these proceedings was disclosed prior to the relevant date and that such a disclosure is not excluded by the pleaded defence. The registered design is not new and is, consequently, invalid. Subject to appeal, it will be struck from the register accordingly.

28. Given my finding that the design is invalid on the basis of the disclosure of the US patent, it is not necessary to go on to consider whether its novelty is also destroyed by the other items of prior art.

### **Costs**

29. The applicant having succeeded, it is entitled to an award of costs. However, given the comments I made earlier about the amendment it made to its pleadings and the consequential requirement that placed on the proprietor to file a further counterstatement, I will deduct £350 from the sum I would otherwise have awarded. The applicant asked that costs should also take account of the fact that the proprietor filed a second short written submission late. Whilst noted, I do not reflect this in costs because it would not have put the applicant to any additional cost. My assessment is as follows:

Official Fee: £50

Filing and considering statements of case, including the accompanying evidence: £500

Written submissions: £300

**Sub- total: £850**

Deduction: £350

**Total: £500**

30. I therefore order Bushbaby Ltd to pay Mr Justin Bernhaut the sum of £500. Subject to appeal, the above sum should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

**Dated this 24<sup>th</sup> Day of February 2016**

A handwritten signature in black ink, appearing to be 'O. Morris', written over a horizontal line.

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