

O-373-19

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN No. 6045074

IN THE NAME OF GAVIN FRANKLAND

IN RESPECT OF THE FOLLOWING DESIGN:



AND

AN APPLICATION FOR INVALIDATION (No 25/18)

BY LAMBRETТА CLUB GREAT BRITAIN

1. These proceedings concern an application by Lambretta Club Great Britain (“the applicant”) to declare the above registered design invalid. Three grounds were pleaded:

- Section 1B of the Registered Designs Act 1949 (“the Act”) - a claim which relates to an absence of novelty. The ground is based on the claim that “our” design (one corresponding to the registered design) has been used since the 1950s.
- Section 11ZA(2), that the recorded owner of the design is not its true proprietor.
- Section 11ZA(4), that the use of the design would constitute a breach of copyright.

Evidence was provided with the applicant’s statement of case showing use of identical designs from many years ago.

2. A defence was filed by Mr Frankland. Much of what he says relates to whether the applicant is the legal owner of the design (and its copyright).

3. After considering the evidence of both parties that was subsequently filed, the Tribunal wrote to the parties to highlight that Mr Frankland’s own evidence showed that the design had been disclosed. For example, it is included in a newsletter dated 1956. As such, there did not appear to be any dispute that the registered design had been disclosed to the public. As a consequence, the Tribunal advised the parties that a short decision may be issued invalidating the design on the basis of prior disclosure. The parties (including Mr Frankland) were given an opportunity to comment and/or to request a hearing. The applicant advised that they were content with what the Tribunal had advised. Mr Frankland did not respond. The letters sent to the parties explained why this course of action was suggested, for sake of clarity, I explain more below.

4. Section 11ZA(1)(b) of the Act reads as follows:

“(1) The registration of a design may be declared invalid

(a)...

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act...”

5. Section 1B reads as follows:

“(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.”

6. As can be seen, the novelty in a design is destroyed if an identical design (or one having the same overall impression) has been made available to the public before the relevant date. The relevant date is the filing date of the design, so in this case 29 September 2018. Some disclosures are excluded from the assessment as per section 1B(6), which deal with disclosures in the 12 months before the relevant date (which clearly does not apply here given that the design was disclosed as early as 1956) or disclosures made under condition of confidentiality, or disclosures that are very obscure, none of which has been claimed. It is important to note that it does not matter who made the disclosure. A novelty destroying disclosure can be made even by the rightful owner of the design (unless one of the exceptions apply).

7. In view of the fact that the applicant has claimed (and provided evidence) showing that the design was disclosed, and that Mr Frankland has accepted this (and indeed confirmed this through his own evidence), and in the absence of any reason to exclude the disclosures made, it follows that the registered design must be declared invalid. It was not novel when the design was filed, irrespective of any dispute over ownership. That stands as my decision.

8. Given that neither party has disputed the appropriateness of determining the matter purely on the novelty ground, I need say no more about the other grounds claimed in the invalidation.

9. The design registration is hereby declared invalid.

Costs

10. As the applicant has been successful, it is entitled to an award of costs. My assessment is as follows:

Official fee for application to invalidate - £48

Statement of case (which included evidence) and considering the counterstatement - £400

Considering and filing evidence - £500

11. I order Mr Gavin Frankland to pay Lambretta Club Great Britain the sum of £948 within 21 days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2019

Oliver Morris

For the Registrar,

the Comptroller-General