

O-288-14

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF REGISTERED DESIGN NO. 4032447
IN THE NAME OF THERAMIT LTD
IN RESPECT OF THE FOLLOWING DESIGN:**



AND

**A REQUEST TO INVALIDATE (NO. 53/13)
BY ZHU ZHU LTD**

The claims and the counterstatement

1) The registered design the subject of these proceedings was filed by Theramit Ltd (“Theramit”) on 23 October 2013, with its certificate of registration being granted on 6 December 2013. The design is depicted below:



2) ZHU ZHU Ltd (“ZHU”) has requested the invalidation of the design under section 1B(1)¹ 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. ZHU relies on the production and sale of wheat bags by it since before the relevant date, and, also, sales by other manufacturers in the field.

3) Theramit filed a counterstatement defending its registration, stating that none of the designs highlighted by ZHU are the same as its design. However, it went on to say that its product was designed in 2003, featured in *Arthritis News* magazine in 2003, featured on the television programme *This Morning* in 2004 and trialled and recommended by many NHS and private hospitals since 2003.

4) The material attached to both sides’ respective statements counts as evidence in these proceedings in accordance with rule 21 of the Registered Designs Rules 1996. Given this, it is clear from Theramit’s own evidence that the subject design has been in the public domain since 2003.

The relevant legislation

5) 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

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

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?

6) Part of Theramit’s defence is that it has been supplying articles made to its design since 2003, some 10 years before the relevant date of 23 October 2013. However, it does not matter who got there first when it comes to considering the novelty of a design and, furthermore, the novelty of a design can potentially be destroyed not just by the disclosure of a design by a third party, but by the disclosure of the design by its designer or owner. There are 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.”

7) 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, the disclosure, on Theramit's own evidence, took place 10 years before the relevant date. 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.

8) Given the nature of its counterstatement, the tribunal wrote to Theramit indicating the view that its own evidence confirmed the claim that the design was invalid; effectively, Theramit had no tenable defence. The tribunal indicated that it was its intention to issue a summary decision on this basis, but before doing so, Theramit was afforded the opportunity to make submissions and/or to request a hearing. No response to this letter was made. Consequently, this decision stands as the summary decision in this matter. The claim for invalidation succeeds as at the relevant date the design was not novel.

Costs

9) ZHU has been successful and is entitled to a contribution towards its costs. I take into account that the proceedings have been disposed of relatively early, with limited paperwork, and that ZHU was not legally represented so would not have incurred legal fees. My assessment of costs is as follows:

Preparing a statement (and initial evidence) and considering the other side's statement	£100
Official fee	£50
Total	£150

10) Theramit Ltd is ordered to pay ZHU ZHU Ltd the sum of £150. This sum is to 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 30th day of June 2014

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