

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

**IN THE MATTER OF REGISTRATION NO 2090481 IN THE NAME OF CYRIL  
SLOGGETT**

**AND**

**IN THE MATTER OF AN APPLICATION TO CANCEL THE ABOVE  
REGISTRATION UNDER S.11(2) BY HADLEY INDUSTRIES plc**

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#### **BACKGROUND**

On 17<sup>th</sup> February 2000 Cyril Sloggett applied to register a design for a Cold Formed Section/Profile. (representations at Annex AA@). The statement of novelty was:

AThe features of the design for which novelty is claimed are the shape, configuration and pattern of the surface of the article as shown in the representations and specimen.@

2. The design was classified by the examiner into Locarno Class: 25.02.02 (building units, construction elements/pre-fabricated or pre-assembled building parts/floors & floor coverings, floor panels etc.) Such items may be of indefinite length.

3. The application was accepted by the Registrar and published in Designs in View and on the Patent Office Website.

4. On 24<sup>th</sup> October 2001 Laurence Shaw & Associates on behalf of Hadley Industries plc filed an application for cancellation of the registration under Section 11(2) of the Act, stating that the registrar should have refused registration on the grounds that:

a) the design was not new (S.1(4)b), prior publication being claimed in WO97/35647(Hadley) (AnnexeB@), GB2279596(Sloggett) (Annexe AC@), US4025996(Saveker) (Annexe AD@), and GB2341195(Sloggett) (Annexe AE@),

b) it was an attempt to protect a Amethod of construction@(S.1(1)(a)),

c) its appearance was dictated by its function (S.1(1)(b)(i)), and

d) it lacked aesthetic appeal (S.1(3)).

5. It was also claimed that the Statement of Novelty was not valid and that the representations were unclear and should have been rejected, in that a finished article was not disclosed (as required by Rule 14(1)).

6. The applicant asked for an award of costs in its favour and filed evidence under Rule 54 and Rule 55(2).

7. The proprietor filed a counterstatement on 3<sup>rd</sup> January 2002 denying the grounds for cancellation and stating that the design was new on the date of application, and that the application met all requirements for registration. The proprietor filed evidence under Rule 55(1).

8. I do not propose to summarise the evidence filed in detail but an outline follows.

#### **Applicant's Evidence (Rule 54).**

9. This consists of a witness statement dated 1<sup>st</sup> March 2002 by Michael Anthony Castellucci, who is Manager (Technical Support) at Hadley Industries, and a witness statement dated 28<sup>th</sup> February 2002 by Stanley Walter Haines (architect) of Andrews Downie & Partners.

10. Mr Castellucci states that a finished section/profile is not shown in the design and provides examples of such articles. He also provides copies of order sheets/ brochures for Hadley profiles predating the application, and claims that dimpled feature on Mr Sloggett's design is identical to that created by the Hadley Ultra-Steel process (several examples being shown).

11. Mr Haines states that he would not take into account the appearance of such profiles, the technical features being the only factors to consider. He also stated that no finished article was shown in Mr Sloggett's registration.

#### **Proprietor's Evidence (Rule 55(1))**

12. This consists of a Statutory Declaration dated 28<sup>th</sup> April 2002 by Cyril Sloggett, registered proprietor of the design, and a witness statement by Barrie White, former section manager in Market Development Construction, British Steel plc/Corus plc.

13. Mr Sloggett states that:

a) the design was new at the time of application. It differs from WO97/35674 (registered design has spheroid forms, not square based pyramid frustum), from GB2279596 (generally elongate sinuous shape/longitudinal & lateral connection by ribs), from US4025996 (registered design has more clearly defined geometric pattern). There are visible & functional differences between all three patents and the registered design. He also points out that GB2341195 was published on 8.3.2000, after the application date of the registered design (17.2.2000)

b) No method of construction is mentioned or claimed in the registered design. The same effect could be achieved by different technical methods.

c) The appearance of the design is not dictated by function. The design is not restricted to use as a reinforcement or structural member, it can be for decoration/embellishment.

d) The appearance of the article is material and would be considered by a potential purchaser, therefore aesthetic requirements for registration have been met.

e) That a pattern is appropriate to Statement of Novelty and that the representations and specimens provided for the Designs Registry clearly show design features, and that the Statement of Article satisfies Rule 14(1).

14. Mr White states that he appreciates the aesthetic qualities & adaptability of the design in addition to its technical attributes, and that to the best of his knowledge the design was new

when filed.

**Applicant's Evidence (Rule 55(2))**

15. This consists of a second Witness Statement by Michael Anthony Castellucci dated 16<sup>th</sup> July 2002.

16. Mr Castellucci reiterates his earlier claims that the registered design is the same as Hadley's 'Ultra-Steel' design, and provides examples of prior publication of Hadley designs (Annexes AF and AG), which he claims are the same as the registered design.

17. Neither party applied for leave to submit further evidence under Rule 56, although Mr Sloggett made some observations in his letter of 30<sup>th</sup> July 2002 including copies of earlier correspondence between the parties. Mr Sloggett was advised that these observations could not be considered as part of the evidence.

18. This completes my summary of the evidence filed in this case. I now turn to the decision.

**DECISION:**

19. As a pre-European Directive case this must be judged on the criteria in force before 9<sup>th</sup> December 2001. The grounds of the application are based on Section 1(4)(b) of the Act, depending on whether the registered design is the same as a design previously published in the UK. Also Section 1(1)(a), depending on whether the design seeks to protect a method or principle of construction, Section 1(1)(b)(i), depending on whether the appearance of the design was dictated solely by its function, and Section 1(3), depending on whether the appearance of the article is material. In addition the applicant claims that the Statement of Novelty is not valid, the representations are unclear and that a finished article is not disclosed in accordance with rule 14(1).

20. S.1(4)(b) states that *A design shall not be regarded as new for the purposes of this Act if it is the same as a design published in the United Kingdom in respect of the same or other articles before the date of the application, or if it differs from such a design only in immaterial details or in features which are common variants in the trade.*

21. S.1(1)(a) states that *A design means features of shape, configuration, pattern or ornament applied to an article by an industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include a method or principle of construction.*

22. S.1(1)(b)(i) states that *A design does not include A features of shape or configuration which are dictated solely by the function which the article has to perform.*

23. S.1(3) states that *A design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description.*

24. The test under S.1(4)(b) involves a relatively narrow definition of novelty (*A the same as a design published in the United Kingdom.....*) unlike the post-Directive definition which

extends to overall impression. In considering all the designs shown in the patent specifications and the earlier disclosures of Hadley's own designs, I find that they are clearly not the same as the registered design. The only exception to this is GB2341195 (Mr Sloggett's own patent application) which at fig.1 has an identical drawing to those originally filed with the design application (later replaced by photographs). However, this patent application was not published until 8.3.2000 i.e. after the date of application for the registered design.

25. Registered Designs are concerned with appeal to the eye and the comparisons should be of the designs as a whole. My initial impression on seeing the respective designs was that they were different in their overall impression and after reading the evidence and submissions and comparing the designs later, my opinion had not altered. The differences are therefore not immaterial and so I find that the registered design meets the requirements of S.1(4)(b).

26. In considering the objection under S.1(1)(a) I have to determine whether the application includes any claim to protect a method or principle of construction. I find that no such claim is made by Mr Sloggett, given the novelty claim which refers only to shape, configuration, and pattern of the surface of the article, and the representations which show an article of manufacture. The only suggestion of how the article is made appears in the Statement of Article Cold Formed Section/Profile. However it is clear from the evidence in this case that cold forming is a common method of producing such articles, and no claim to any monopoly rights in any particular method of cold forming would be inferred from this Statement of Article. I therefore find that the registered design meets the requirements of S.1(1)(a).

27. Turning to the objection under S.1(1)(b)(i), I have to consider whether the features of shape or configuration of the article are dictated solely by the function which the article has to perform. The fact that several different variations on the design appear in the evidence shows that the function which the article has to perform (in this case, floor covering or similar) does not dictate the features of shape or configuration. The projections on the surface could, within reason, be any shape and in any arrangement. I therefore find that the registered design meets the requirements of S.1(1)(b)(i).

28. The test under S.1(3) is based on whether a person acquiring or using the article would normally take aesthetic considerations into account - i.e. whether the appearance of the article is material. In the present case I consider that, while the projections on the surface of the article may have a technical function, they also have a particular appearance which is not dependent on that function. It is reasonable to infer that any potential purchaser or user of the article would take that appearance into consideration. I therefore find that the registered design meets the requirements of S.1(3).

29. I now consider the additional points raised by the applicant. The Statement of Novelty reads: The features of the design for which novelty is claimed are the shape, configuration and pattern of the surface of the article as shown in the representations and specimen. In my view the pattern is caused by the raised projections on the surface of the material but it is still a pattern which would be seen by the eye and judged by a potential purchaser or user of the article. I find that the Statement of Novelty is valid.

30. While it is accepted that the photographs (particularly sheet 1) are far from ideal, the Registry has no vires to refuse **A**less than perfect@representations. In this case samples of the article were provided for the examiner (samples since returned to the proprietor) and the examiner was satisfied that the representations were acceptable. In my view the representations filed in totality are sufficient to disclose the design in suit.

31. Rule 14(1) requires that **A**the article to which the design is to be applied@is stated on the application. **A**Cold formed section/profile@is not a common Statement of Article but it meets the requirements of S.44(1) as an **A**article of manufacture@and allows classification under the LOCARNO system in 25.02, with the additional UK sub-class of 22. This class includes several similar registrations for floor coverings or similar articles of indefinite length. I therefore find that the requirement of Rule 14(1) has been met.

## **CONCLUSION**

32. After taking account of all the relevant factors, I find that the application for cancellation of the registered design fails. The application to cancel this registration under Section 11(2) is hereby refused.

## **COSTS**

33. As the application for cancellation has failed the registered proprietor is entitled to a contribution towards costs. I accordingly award costs of £600 to be paid to Cyril Sloggett by Hadley Industries plc. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against the decision is unsuccessful.

Dated this 6th day of December 2002

**JOHN MacGillivray**  
**For the Registrar**  
**The Comptroller General**