

O/181/20

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF:

REGISTERED DESIGN NO. 6010384

IN THE NAME OF GORGE LIMITED

AND

APPLICATION NO 22/18

BY WELLPHY (SHANGHAI) INDUSTRIES CORP

TO INVALIDATE THE REGISTERED DESIGN

Background and pleadings

1. Gorge Limited (“the registered proprietor”) filed application no. 6010384 for a registered design for an altitude training and fitness mask on 5 April 2017. It was registered with effect from that date and is depicted in the following representations:

Shown in component parts - protection is sought for all parts



No claim is made for colour shown

Front view



No claim is made for colour shown



No claim is made for colour shown

Side view



No claim is made for colour shown

Side view



No claim is made for colour shown

2. As can be seen from the representations above, the following disclaimer was entered on the register: *No claim is made for the colour shown.*

3. On 10 September 2018, Wellphy (Shanghai) Industries Corp (“the applicant”) applied for the registered design to be invalidated under section 11ZA(2) of the Registered Designs Act 1949 (“the Act”), on the grounds that the registered proprietor is not the proprietor of the design, and that it is, as the owner of a utility patent covering the design.

4. The registered proprietor filed a defence and counterstatement on 22 November 2018, claiming that it is the author and the original proprietor of the design. Although the applicant has not made any pleadings under section 11ZA(1)(b) relating to novelty and individual character, the registered proprietor also filed a defence against that ground.

5. On 17 January 2019, the Registry wrote to both parties to inform them that it was considering staying the proceedings, as the registered design was already subject to invalidation proceedings which were at a more advanced stage. The Registry gave the parties fourteen days to submit any comments. No response was received, so proceedings were suspended until the conclusion of the previous proceedings which

failed.¹ The Registry wrote to the parties on 10 April 2019 to set the timetable for the submission of evidence.

6. The applicant had submitted evidence alongside its Statement of Case. No further evidence was filed by either party.

7. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Kate Blackburn-Roffey and the registered proprietor by Pinsent Masons LLP.

Evidence

8. The applicant submitted very brief evidence alongside its statement of case. This consists of the registration details of the utility patent. This document contains two dates: 14 April 2017 and 27 April 2018. Both are later than the date of application for the contested design. The evidence contains images, but the text is in what appear to be Chinese characters. The applicant states that the first of the dates is the date on which the utility patent was granted. However, no statement has been made to indicate that this translation was made by an individual who is competent in the relevant languages. No further evidence was filed.

Decision

9. Section 11ZA(2) of the Act states that:

“The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.”

10. Section 2 of the Act deals with the proprietorship of designs and is as follows:

¹ BL O/095/19

“(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

(1A) [...]

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the ‘author’ of a design means the person who creates it.

(4) In the case of a design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made shall be taken to be the author.”

11. The applicant must therefore show that it has created the design. The registered proprietor submits that:

“We are presuming that the Applicant is asserting that it owns design rights over the mask which appears on pages 5 to 7 of the Chinese patent. However, the Applicant’s ownership of the Chinese patent does not confer on the Applicant any design rights over the Gorge design.”

12. The applicant has filed no evidence prior of the filing date of the registered design and it is not apparent from what has been filed what the applicant claims to have created. A claim of proprietorship of a registered design imposes a strong evidential burden to show what was created and when. In these proceedings, there is no evidence to show that anything was created by the applicant, let alone something that

would give rise to a finding that they created the registered design. In my view, the applicant has not shown that it is the proprietor of the design and the application for invalidity on this ground fails.

13. The registered proprietor submits a defence to a section 11ZA(1)(b) claim that the design lacks novelty and individual character. The applicant has not made a claim on those grounds so I need consider these submissions no further.

Conclusions

14. The registered design no. 6010384 remains registered.

Costs

15. The application for invalidity has failed. In the circumstances, the registered proprietor is entitled to a contribution towards the costs of the proceedings, in line with the scale of costs set out in Tribunal Practice Notice 2/2006. I award the applicant the sum of £200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement of case and considering the other side's statement: £200

Total: £200

16. I order Wellphy (Shanghai) Industries Corp to pay Gorge Ltd the sum of £200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 19th day of March 2020

Clare Boucher
For the Registrar,
The Comptroller-General