

EIP



Three new UK IPO decisions demonstrate the wide commercial applicability of registered designs

In the UK, applications to declare a UK registered design invalid can be filed at the UK Intellectual Property Office (UKIPO), whereupon the case is decided by a Hearing Officer of the UKIPO acting on behalf of the Registrar of Designs.

Such cases are not particularly common, but decisions in three have just been made available at the same time on the law reporting website BAILII.

In all three cases, the circumstances are rather more complicated than the usual commercial dispute between parties.

[Diane Gillespie v Neil Corbett \(Design\) \[2012\] UKIntelP o26212 \(05 July 2012\)](#)

In this first case, both parties held registered designs in relation to whelping boxes (boxes designed to keep puppies safe after birth). It has been alleged that some customers had believed that the defendant and the claimant were the same company. In respect of one of the designs, both parties had a registration, each being very similar to the other. Both of those designs were held invalid due to prior sales by the claimant. The other designs were held to be valid over the prior art cited.

[James Kieran Padden v The Secretary of State for Defence \(Design\) \[2012\] UKIntelP o28912 \(27 July 2012\)](#)

In the second case, the defendant had been involved in the design of a new badge for the

Special Boat Service. He registered the design, but in the meantime the MoD had already registered a very similar badge. Mr Padden claimed that this prior art and other prior art that was published less than 12 months before his filing date was covered by the grace period provisions, as he was the designer. Therefore, in this decision, only prior art more than 12 months prior to the filing date was considered. The design was held to lack individual character over the disclosure of a similar design in a talk to the Flag Institute.

Registered Designs Limited v David Saville (Design) [2012] UKIntelP o28812 (27 July 2012)

In the third case, two designs were at issue, both being wallets for driving licences. One design was alleged to lack novelty over a wallet produced and distributed by the Driver and Vehicle Licensing Agency (DVLA). This allegation did not succeed as it was not substantiated by the evidence, so this registration was upheld. The other design was alleged to lack novelty over a product sold as “Protect-a-Badge”. The Hearing Officer considered that the prior sales were substantiated, and the differences between the two designs were immaterial, and so that design was declared invalid.

These cases illustrate the wide variety of commercial situations that registered designs can be used to protect.

By Darren Smyth