

O-249-04

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER OF APPLICATION UNDER SECTION 11(2)
BY JFA LIMITED FOR CANCELLATION OF
REGISTERED DESIGN No. 2075829 IN THE NAME OF
OCEANCROWN LICENCING LIMITED**

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF an Application under Section 11(2) by JFA Limited for the cancellation of Registered Design No. 2075829 in the name of Oceancrown Licencing Limited

BACKGROUND

1. On 3 July 1998 Trevor Matthews applied under the Registered Designs Act 1949 (as amended) to register a design with the Statement of Article “Portable self-contained gas range cooker”. The registration was granted and the design has since been assigned to Oceancrown Licencing Limited.

2. The statement of novelty for which registration is claimed is as follows:

“The novel features of the design are the shape and configuration and pattern and ornament, in particular the shape and configuration of the single integral housing of the article having a low profile, such that the horizontal proportions of the article being at least two times greater than the vertical proportions.”

3. A copy of the representation of the registered design is at Appendix One to this decision.

4. On 17 March 2003 JFA Limited filed an application under Section 11(2) of the Act to cancel the registered design on the grounds that “the portable self contained gas range was not novel and lacked individual character at the date of application for registration when compared with earlier designs”.

5. Section 1(2) of the Registered Designs Act 1949, as amended, provides:

“A design which is new may, upon application by the person claiming to be the proprietor, be registered under this Act in respect of any article, or set of articles, specified in the application.”

6. Section 1(4) of the Act goes on to say that a design shall not be regarded as new for the purposes of this Act if it is the same as a design registered in respect of the same or any other article in pursuance of a prior application, or published in the United Kingdom in respect of the same or any other article before the date of application, or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

7. The registered Proprietor filed a Counterstatement denying the grounds of cancellation.

Applicant's Statement of Case and Evidence

8. The applicant's statement of case refers to the following alleged prior publication or "prior art" –

(i) A Korean patent which the applicant states was published in the UK on or before 16 May 1991, at which date it was filed in the Science Reference Section of The British Library where it was open to inspection by the public – see Appendix Two to this decision.

(ii) A portable self-contained gas range, known as the "Glowmaster", a product which the applicant states was available to the public and therefore published prior to 3 July 1998 – see Appendix Three to this decision.

9. The applicant's evidence also comprises a witness statement by Garry Fountain, 13 June 2003.

10. In his statement, Mr Fountain explains that he was an independent agent contracted by a company called Samuel Groves Limited during the sale seasons of 1995 and 1996 and that one of his responsibilities was to sell the "Glowmaster" portable gas cooking stove to retailers in East Anglia. He refers to photographs of the product at GF1 to his statement, which are the same photographs copied at Appendix Three to this decision. Mr Fountain adds that the appliance was CE approved and that the main customers with whom he dealt, were cook shops e.g. Marchants in Bury St Edmunds. He states that he sold the "Glowmaster" and its accessories until the agreement with Samuel Groves Limited came to an end after the 1996 sales season.

Registered Proprietor's Evidence

11. This comprises a witness statement by Trevor John Matthews dated 7 August 2003. Mr Matthews is the Managing Director of Oceancrown Licencing Ltd (the registered proprietor).

12. Mr Matthews states that he does not propose an extensive comparison of the respective designs in his evidence as this can be dealt with at a later stage in submissions. However, he believes the respective designs to be materially different in features of shape, configuration, pattern and ornament. He adds that the claimed British Library publication has no dimensions or features of pattern or ornament and he notes that no representation of the top of the "Glowmaster" product has been produced. Mr Matthew's states that anticipation of the design in suit remains to be proven.

13. Mr Matthews has been advised that it should not be possible to defeat a valid subsisting legal right, such as a registered design, on the basis of an act which was a criminal offence and he has also been advised that such evidence should be excluded from consideration e.g. whether the marketing of the product concerned constituted a criminal offence. He adds that this would apply when the product was illegally marketed without a proper CE certificate or without complying with the safety requirements under the CE marking system. Mr Matthews goes on to

say that as Garry Fountain claims that the “Glowmaster” design of product has a CE mark, that is for the applicant to prove.

14. Mr Matthews provides background on his business and the sourcing of portable gas range products, in particular his extensive efforts to locate suitable products which met UK and EU legislation. Mr Matthews believes that if the “Glowmaster” gas cooker had been available during the 1995/96 seasons, he would have been aware of this fact.

15. Mr Matthews also outlines a dispute with the applicant in relation to the commercial development and marketing of gas range products which does not strictly relate to the issue before me ie. whether the design in suit was new at the relevant date, in the light of the claimed prior art.

16. Mr Matthews goes on to provide details on the CE certification regime and he believes that the “Glowmaster” product does not conform for a number of specific reasons.

Applicant’s Evidence in Reply

17. The applicant’s evidence in reply consists of a witness statement by Christopher Baker dated 12 September 2003. Mr Baker is the Managing Director of JFA Limited, the applicant in these proceedings.

18. Mr Baker makes it clear that he does not agree with Mr Matthews’ comments, in particular those relating to the wider commercial disputes between Mr Matthews and JFA Limited. He adds that these issues are not relevant to the current proceedings.

19. In relation to the comparison of the respective designs, Mr Baker draws attention to the digital photographs of “the Euro GT Model”, the subject of the registered design, and the “Glowmaster” model sold from 1995 by Samuel Groves & Co Ltd, a sample of which was purchased by the applicant in 2002. These are at Exhibit CB1 (docs. 1 to 7) to Mr Baker’s statement. Mr Baker also draws attention to document 8 of his Exhibit CB1, which, he states, comprises a price list produced by Samuel Groves in 1997 demonstrating that the company sold, in the UK, the “Glowmaster” T1300 cooker prior to the relevant date. Regarding the “Korean Design”, Mr Baker says that “this design registered at the British Library in 1991” is identical in all material ways to the design in suit and he attaches a copy of the “Korean Design” and the stamped cover thereto as document 9 to Exhibit CB1 of his statement.

20. In answer to the registered proprietor’s point that no representation of the top of the “Glowmaster” has been produced, Mr Baker provides a copy photograph at Exhibit CB1, document 10.

21. Mr Baker states that the position relating to the CE registration is irrelevant as there has been prior publication for the purposes of the Act. However, Mr Baker adds that he believes that the “Glowmaster” product (which is owned and sold by third parties) does possess a CE registration and that the number of this registration which was granted in 1995 is 048AQ-0025. He provides documentary information in support.

Preliminary Issues

22. Following the filing of the applicant's evidence in reply, the registered proprietor sought to file further evidence by virtue of the Registrar's discretion under Rule 56 of the Registered Designs Rules. The Designs Registry reply, dated 2 December 2003, included the statement that:

“Prima facie, the Registrar does not propose to allow further evidence to be filed under her discretion as it seems unlikely to assist the Registrar's Hearing Officer in his determinations under Section 11, in relation to the grounds of cancellation.”

23. The Registry letter of 2 December 2003 also offered the registered proprietor a hearing on this issue in accordance with Rule 48(2). There was no request for a hearing, nor an appeal.

24. Subsequently, the registered proprietor sought to “have certain of the evidence of the applicant's removed from consideration”. The Registry, in a letter dated 15 January 2004, requested the registered proprietor to state precisely what evidence it considered inadmissible and should be struck out, together with the registered proprietor's reasons in support. This letter and the Registry's subsequent letter of 25 February 2004, also made it clear that in the Registrar's view the admissibility of evidence issue was one which required clarification before the main hearing, through, if necessary, interlocutory proceedings. The registered proprietor did not provide the information requested. Again, the registered proprietor did not request a hearing and made no appeal on this point.

25. Prior to the main hearing Mr Miller for the registered proprietor made it clear that the illegality point relating to the position on the CE certificate was not being pursued.

26. This completes my summary of the background and the evidence filed. I now turn to the decision.

DECISION

27. The alleged “prior art” comprises the “Korean Patent” and the ““Glowmaster”” product and I turn first to a consideration of whether there has been prior publication.

28. In his skeleton arguments and at the Hearing, Mr Miller on behalf of the registered proprietor submitted that the applicant's evidence relating to the alleged prior art (except for Mr Fountains statement in relation to ““Glowmaster””) had been “sneaked in” through the reply evidence and should not be taken into account for the purposes of these proceedings. He also pointed out that no witness statement or statement of truth accompanied the applicant's statement of case and he submitted that the applicant had not properly explained the provenance and authenticity of its supporting documentation.

29. Firstly, I go to the Statement of Case. Rule 52(1) is relevant and it reads:

“52.-(1) An application for the grant of a compulsory licence under section 10 or for the cancellation of the registration of a design under section 11(2) or (3) shall be made on Designs Form 19A. Such application shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the applicant’s interest and the facts upon which he relies.”

30. Although a Statement of Truth may be desirable within the Statement of Case, it is not a requirement. Similarly, there is no requirement for accompanying witness statements to a Statement of Case.

31. I have examined the Statement of Case in the present proceedings and conclude that:

- (i) it clearly states that the applicant is seeking cancellation of the registered design on the grounds that it was not new at the date of application for registration;
- (ii) it refers to (and provides representations of) the alleged prior art ie. “the Korean Patent” and ““Glowmaster”” product;
- (iii) it claims that these designs are identical to the registered design in suit or differ in minor or immaterial variations.

32. In my view the applicant’s Statement of Case is adequately particularised. The grounds of cancellation are clear.

33. Turning to the registered proprietor’s comments on the reply evidence, Rule 55 is relevant and it reads:

“55.-(1) Within such time as the registrar may allow, the registered proprietor may file evidence in support of his case and shall send to the applicant a copy thereof.

(2) Following receipt of the copy from the registered proprietor and within such time as the registrar may allow, the applicant may file evidence confined to matters strictly in reply and shall send to the registered proprietor a copy thereof.

34. Rule 55(2) makes it clear that the applicant’s evidence must be confined to matters strictly in reply.

35. The registered proprietor’s evidence, which is in the form of a witness statement by Trevor John Matthews dated 7 August 2003: denies anticipation of the design in suit; states that anticipation stands to be proven (paras 8, 9 and 10 of the statement); and submits that there are material differences in the registered designs (paras 5 and 10). In light of these comments by Mr Matthews it is my view that the applicant was entitled to respond in its reply evidence (Mr Baker’s witness statement of 12 September 2003) and in relation to the anticipation and similarity issues, file comments, exhibits and representations to rebut the registered proprietor’s evidence and/or submissions on these points.

36. Next I go to the registered proprietor's submission that the applicant has not properly explained the provenance and authenticity of its supporting documentation.

37. In relation to the "Korean Patent" a copy was attached to the Statement of Case and a further copy was attached to Mr Baker's evidence in reply. Neither the Statement of Case nor the witness statement of Mr Baker explain the background to how the applicant was aware of or came across the "Korean Patent" and there is no supporting information as to its provenance other than the British Library, Science Reference and Information Service stamp dated 16 May 1991 on the copy front cover supplied with the representation of the design.

38. While the "Korean Patent", with its accompanying British Library stamped front cover, is specifically claimed as prior art by the applicant's professional representatives (Cumberland Ellis Peirs) and Mr Matthews in the statement of case and witness statement respectively, is this sufficient for me to infer that it was in existence in the British Library prior to the application for the design in suit? While I have some sympathy with the registered proprietor's position, it seems to me that I have no persuasive reason to believe that the British Library stamp is not relevant and/or genuine in relation to the "Korean Patent". In particular, I feel unable to readily conclude that the applicant and its professional representatives are being disingenuous or untruthful in relation to the prior existence of this document within the British Library at the relevant date. If the registered proprietor's case is the contrary, it may have been best served by pursuing this issue through cross examination.

39. The registered proprietor has also attacked the "reliability" of Mr Fountain's witness statement in relation to the "Glowmaster" product. On behalf of the registered proprietor Mr Matthews says that Mr Fountain (inter alia): fails to state whether he has any relationship to the applicant; fails to exhibit a copy of his contract with Samuel Groves; fails to provide any documentation to substantiate sales of the 1997 "Glowmaster"; and fails to confirm the provenance of the photographs which are claimed to be of the 1997 "Glowmaster".

40. Notwithstanding Mr Matthews' criticisms, Mr Fountain, in his witness statement, clearly states that he was an independent agent who sold the "Glowmaster" product until his contract with Samuel Groves came to an end after the end of the 1996 sales season. Furthermore, it seems to me that it can be readily inferred that his Exhibit GF1 refers to photographs of the relevant "Glowmaster" product. I see no reason why I should not take Mr Fountain's evidence fully into account. If the registered proprietor is of the opinion that Mr Fountain has been disingenuous or untruthful it may have been best served by pursuing this issue through cross examination.

41. Having considered the position on whether the alleged "prior art" should be taken into account and having found that it should, I now turn to whether the existence of "Korean Patent" and the "Glowmaster" product amounts to prior publication.

42. There is no definition of "published" in the Registered Designs Act 1949 (as amended). However, the position on prior publication is best summarised in Laddie, Prescott and Vittoria, *The Modern Law of Copyright and Designs* (3rd Edition, paragraph 44. 15):

“44.15 All designs which have been published in the UK in respect of the same or any other article before the priority date of a registered design are available as prior art. There is no definition of ‘published’ in the Act but it has for long been accepted that it has essentially the same meaning as when used in the Patents Act 1949 and its predecessors. It follows that any design which has been made available to any person in the UK who is free in law and equity to use or disclose the same is treated as published. It is not necessary to show that the whole or a substantial part of the public knows of the design, only that the design was available to the public. Publication may be by disclosure in documents or by prior user.”

43. There is no requirement to prove that the publication is commonplace or even that it needs to be for commercial purposes. At the hearing, Mr St Ville reminded me of the decisions in *Vredenburg’s Design* (1934) 52 RPC 7 where it was held that the use of a single example of a new tennis racket at a tennis club amounted to publication of its design, and also *Pressler v Gartside* (1933) 50 RPC 240 where it was held that a design lodged in a library to which the public had access, was published. Both parties also took me to nineteenth century patent cases, but I believe the above mentioned registered designs decisions to have greater application to the present proceedings.

44. In light of the above I have no hesitation in concluding that the presence of the “Korean Patent” within the British Library would constitute publication for the purposes of these proceedings. I feel able to infer that the date stamp would have been placed on the document by British Library staff and that the document would have been available for public inspection within the library from 16 May 1991 or soon after that date.

45. Turning to the ““Glowmaster”” product, I earlier found that, on the evidence filed, goods of this design were sold in 1995/1996. Sales of goods to this design would have amounted to publication of the design.

46. Accordingly, I find that the “Korean Patent” and the ““Glowmaster”” product comprise designs which were published within the meaning of Section 1(4) of the Act.

47. I must now turn to a comparison of the respective designs and decide whether they are the same or whether any differences are only in immaterial details or are in features which are variants commonly used in the trade.

48. In considering the position relating to Section 1(4) I have borne in mind that the representations of the design in suit and the prior art must be looked at through the eyes of the notional customer, which in this case not only involves the trade but the public at large.

49. Registered designs are concerned with appeal to the eye and the ambit of a registered design must be decided not only by the representations of the design but also by the statement of novelty, which in respect of the design in suit reads as follows:

“The novel features of the design are the shape and configuration and pattern and ornament in particular the shape and configuration of the single integral housing of the

article having a low profile, such that the horizontal proportions of the article being at least two times greater than the vertical proportions.”

50. The purpose of a statement of novelty was explained in the following terms by the Court of Appeal in *Sommer Allibert (UK) Ltd v Flair Plastics Ltd* [1987] RPC 599:

“The purpose of the statement [of novelty] is to direct attention to the part or parts of the submitted design which are said to introduce into it the applicants’ alleged novel contribution and thus to entitle them to registration. It is important because it defines the scope of the monopoly claimed. While the court does not have to assume that it is correct, it precludes the proprietor, who has obtained his registration on the grounds that certain features of the design give novelty to it, from thereafter denying their novelty and asserting their immateriality, so as to extend the scope of the protected design.”

51. At the hearing Mr St Ville submitted that the above statement of novelty in effect, limited the design in suit to:

“The shape and configuration of the single integral housing of the article having a low profile, such that the horizontal preparations of the article being at least two times greater than the vertical proportions.”

52. Mr St Ville contended that in so far as novelty is concerned, attention is being drawn to the low profile nature of the article.

53. While I understand Mr St Ville’s point on the nature of limited novelty claims that may stem from the inclusion of the words “in particular” in a statement of novelty, it seems to me that in the present case, such an interpretation is not appropriate. I note that the statement of novelty filed refers to “pattern and ornament”, features that would be excluded if novelty was limited to those features appearing after the words “in particular”. Furthermore, the representations of the design filed with the Registry also go to define the scope of protection and on the limited novelty interpretation proposed, the plan view (see representation 2 of 3) would be redundant.

54. In my view, for novelty purposes the design in suit should be considered as a whole, but with due weight placed upon the particular emphasis within the novelty claim.

55. The respective designs consist of articles which perform identical functions in the same manner ie. they are one ring/burner portable gas cookers. As I have no specific evidence before me in relation to features and variants which are commonly used in the trade, I must put myself in the position of the average consumer when assessing the designs. While I have no evidence in relation to features and variants commonly used in the trade, my own knowledge and experience (and I believe, that of the notional customer), would expect the relevant articles to include functional features such as for example, an adjustment control for the gas flame and a pan holder.

56. In my considerations I am guided by the following comments of Laddie J in the matter of *Household Article Ltd’s Registered Design* No. 2044802 [1998] FSR 685-686, paragraphs 26 and 27:

“The purpose of Section 1(4) is to ensure that any designer is free to take a piece of prior art and to apply to it well known and commonly used design features or visually immaterial modifications or a mixture of both without fear of falling foul of a registered design. Even if the result of his work is visually pleasing and different it cannot fall within the scope of a valid design registration. If on the other hand the design in suit contains some features which are neither immaterial nor common trade variants then it must be looked at as a whole and the question answered whether, taking all the features together, it is sufficiently different to the prior art to warrant a monopoly of up to 25 years duration. In the latter case the fact, if it be one, that many of the features are either immaterial when taken by themselves or are common trade variants is likely to make it more difficult to show novelty.

The words “commonly used” in Section 1(4) must be given effect. This statutory provision does not mean that all features which are known and in the palette of alternatives available to a designer can be used with impunity. Were it so, as Mr Hacon emphasized, any design made up solely by blending together known design features would always be invalid. There is authority going back over a century showing that that has never been the law. A design can be novel even if it is made up entirely by blending together a number of old designs provided the resulting combination itself has a sufficiently distinctive appearance. It is only where all the features have been used before, and used commonly, (or are immaterial) that the Act deems them to be novelty-destroying.”

57. Firstly, I turn to a comparison of the design in suit with the “Korean Patent” design.

58. Registered designs are concerned with appeal to the eye and it seems to me that, from a practical context, the most important or obvious comparison of the respective designs would be the front and top/askance views. This appeared to be common ground at the hearing. Of course, it does not follow that the other views/aspects of the designs need not be taken into account. However, the notional customer would be most likely to view the respective designs from the front and/or top/askance perspective(s).

59. My impression when viewing the respective designs was that from a front, top/askance perspective, the shape and configuration of the designs appeared identical. The housing for the “knob” and “lever” controls is in an identical location and is an identical shape. The remainder of the front tapers upwards and leftwards from its base in similar proportions vertically and horizontally. The edges are “rounded” and the pan base element within the respective designs appears to cover the same proportion and location of the top of the designs. Furthermore, the pan holders in both designs comprise four two prong holding elements in an identical location.

60. Some differences are noticeable on a closer, side-by-side comparison e.g. the pattern adjacent to the control knobs and lever which goes to indicate the height/strength of the flame required, the absence of instructional material on the “Korean Patent” and also the shape of the “central” element that surrounds the burner within the pan holder differs. However, it seems to

me that the differences are somewhat lost within the overall impact of the designs and in the comparisons.

61. In the comparisons I must also note that in so far as the particularisation of the registered proprietor's novelty claim is concerned ie. that part of the claim relating to a low profile and horizontal proportions, it is in my opinion very difficult if not impossible to distinguish the respective designs.

62. Turning to the remaining views of the respective designs ie. the rear and the sides, I am unable to distinguish the respective designs from the rear with the exception of the instructional (information material) which it seems to me would not be readily viewed as a design feature by the relevant customer. In relation to the side views, the designs overall appear identical. The horizontal vents are of the same general shape and location. Any differences are not readily apparent and demand a very close and somewhat artificial inspection.

63. After considering the evidence and submissions, I returned to compare the designs again. However, my opinion did not alter from my initial impression and conclusion. In my view the design in suit and the "Korean Patent" design, in their totality, are the same or, if not, the differences are such as to be immaterial to the relevant customer for the purposes of overall novelty.

64. In light of the reasons given above, I have decided that the design in suit fails to meet the requirements of Section 1(2) of the Act and the application for cancellation based upon Section 1(4) is therefore successful.

65. Strictly, I have no need to go on and compare the remaining prior art, the "Glowmaster" product with the design in suit. However, I shall do so for the sake of completeness.

66. My comparisons of the respective designs is conducted on the same basis as my earlier comparison with the "Korean Patent". While there are obvious similarities between the respective designs it seems to me that on a relative basis there are marked differences, in particular:

- (i) from a front, top/askance perspective the "knob" and "lever" controls fill a larger area and are more prominent within the area within which they are housed in the "Glowmaster" and the remainder of the front area is less obviously tapered away from this area, with the vertical and horizontal proportions being noticeably different from that of the registered design;
- (ii) the rear views differ markedly in that the horizontal proportions of the "Glowmaster" appear consistent throughout its length;
- (iii) the side views differ in that the vents on the "Glowmaster" are in two sets, on the right and left respectively of each other, as opposed to running across the sides equidistantly.

67. In my view, the design in suit and the ““Glowmaster”” product, in their totalities, differ in material details. The overall impression is different. Accordingly, the prior existence of the ““Glowmaster”” product does not assist the applicant for cancellation.

68. The applicant for cancellation has been successful and is entitled to costs. However, before I address this issue there are a number of additional points raised in these proceedings which require comment.

ADDITIONAL EVIDENTIAL ISSUES

69. During the hearing, in relation to the prior art Mr Miller asserted that “the alleged Korean Patent is a fruit bowl” and stated that “I have it with a witness statement here”. I pointed out that this amounted to fresh evidence. There was no formal request to adduce it into the proceedings. Accordingly, I have not seen this witness statement and do not take it, nor Mr Miller’s statement in relation to the fruit bowl, into account in my decision.

70. In response to the “fruit bowl” assertions of the registered proprietor, the applicant, following the hearing, sought to submit a further witness statement under Rule 56 which, it stated, “does not add to the evidence provided by Mr Baker” but is “to ensure that it cannot be later said that the applicant has in some way misled the tribunal”.

71. In an official letter dated 9 July 2004, the applicant was informed that, in the view of the hearing officer, it would be an inappropriate exercise of the Registrar’s discretion to allow the admission of this evidence following the hearing. The letter included a statement that:

“No additional evidence was accepted at the hearing and the hearing officer does not intend to take into account any comments or submissions made in respect of evidence not accepted into the proceedings. Accordingly, no evidence in rebuttal is appropriate.”

72. The applicant was offered a hearing on this point under Rule 48 but declined this option.

AMENDMENT OF THE REGISTERED DESIGN

73. In the event that the design in suit was found not to be new at the date of registration, the registered proprietor sought the exercise of the Registrar’s discretion under Section 11(2), pursuant to Section 3(5), and allow/order the amendment of the registered design.

74. The registered proprietor has not provided the Registrar with any proposed amendment and when asked at the hearing if the registered proprietor had any specific amendment in mind, Mr Miller had no proposals.

75. Section 11(2) of the Act is as follows:

“11(2) At any time after a design has been registered any person interested may apply to the registrar for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration thereof, new, or on any other ground on

which the registrar could have refused to register the design; and the registrar may make such order on the application as he thinks fit.”

and Section 3(5) reads:

“3(5) The registrar may refuse an application for the registration of a design or may register the design in pursuance of the application subject to such modifications, if any, as he thinks fit; and a design when registered shall be registered as of the date on which the application was made or is treated as having been made.”

76. In my view, the Registrar’s discretion cannot and should not be exercised in the circumstance proposed by Mr Miller. In general, amendments of the register are for the court by virtue of Section 20 of the Act which reads as follows:

“20.-(1) The Court may, on the application of any person aggrieved, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.

(2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the court under this section shall be given in the prescribed manner to the registrar, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the court.

(4) Any order made by the court under this section shall direct that notice of the order shall be served on the registrar in the prescribed manner; and the registrar shall, on receipt of the notice, rectify the register accordingly.

(5) A rectification of the register under this section has effect as follows-

- (a) an entry made has effect from the date on which it should have been made,
- (b) an entry varied has effect as it had originally been made in its varied form, and
- (c) an entry deleted shall be deemed never to have had effect,

unless, in any case, the court directs otherwise.”

77. Notwithstanding the above, it seems to me that the registered proprietor is proposing a course of action which would lead to a design which was not new at the date of registration, becoming a design which was new at that time. This must materially effect the identity of the design to such a degree that it becomes a different design to that originally registered. In effect, a registered design which is not novel and is subject to cancellation is transformed into a new

and different design which remains on the register. I have no hesitation in concluding that the Registrar has no powers to effect such an outcome, which would grant a monopoly from the date of registration in a new and different design to that registered.

COSTS

78. As the application for cancellation has been successful, the applicant is entitled to a contribution towards costs.

79. The applicant has submitted that in the circumstances of this case it is reasonable for the Registrar to award actual costs incurred by the applicant because of:

- (i) the unpleaded allegation of illegality relating to the CE certificate, raised in Mr Matthews witness statement, which the registered proprietor decided not to pursue just prior to the hearing;
- (ii) the registered proprietor's unparticularised application to have evidence excluded;
- (iii) unnecessary matters pursued at length in correspondence, in particular the registered proprietor's letters of 14 and 16 February 2004 to the Registrar;
- (iv) the registered proprietor's late correspondence about skeleton arguments; and
- (v) the registered proprietor's rejection of the applicant's without prejudice offer.

80. Having carefully considered the applicant's submissions and those of the registered proprietor on this issue, I see no need to depart from the normal scale of costs in proceedings before the Registrar.

81. The issue of the CE Certificate undoubtedly incurred costs on behalf of the applicant, but I presume the applicant's responses in its evidence on this point played a role in the registered proprietor not pursuing the issue at the hearing. The relatively late nature of the registered proprietor's decision not to pursue the point can be taken into account within the scale of costs.

82. Turning to the registered proprietor's application to have evidence excluded, I doubt this issue could have resulted in any considerable cost to the applicant, given that the registered proprietor did not specifically particularise the evidence in question and did not pursue the matter following the Registry's letter of 15 January 2004.

83. I do not consider it appropriate to penalise the registered proprietor for entering into correspondence with the Registry and I do not believe the applicant's involvement in relation to the pre-hearing correspondence to be unduly onerous.

84. On the skeleton argument issues, I would only reiterate my comments at the hearing. The cancellation proceedings before me were essentially straightforward and related to the issue of

novelty. Consequently, the parties were able to take the proceedings forward without any great difficulty and fully address all relevant points.

85. In relation to the “without prejudice offer”, a party to proceedings is fully entitled to reject such offers or settlement proposals and to pursue proceedings to their conclusion. It is not for the tribunal to involve itself in such issues.

86. I order the registered proprietor to pay the applicant for cancellation the sum of £2,800. This takes into account the consolidation of the proceedings with registered design 2078755.

87. Costs are 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 this decision is unsuccessful.

Dated this 13th day of August 2004

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**

Appendices are not attached