

O-153-16

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF REGISTERED DESIGN NOS 4020104, 4020066,
4025695 AND 4020237
IN THE NAME OF AHMET EROL**

AND

**THE REQUESTS TO INVALIDATE (NOS. 33/14, 34/14, 36/14 AND 37/14)
BY MOHAMMAD MALIK TANVEER**

Background and pleadings

1. The four registered designs which are the subject of this dispute are owned by Ahmet Erol and are shown below:

4020104

Filed 21 May 2011; granted 17 June 2011

“Hoodies, t-shirts”



4020066

Filed 18 May 2011; granted 3 June 2011

“Hoody sweatshirt”



4025695

Filed 19 July 2012; granted 12 September 2012

“Tshirt-sweatshirt”



4020237

Filed 28 May 2011; granted 22 June 2011
“Sweat Jackets/T-shirts”



2. Mohammad Malik Tanveer has requested the invalidation of the design registrations under section 1B(1) of the Registered Designs Act 1949 (as amended) (“The Act”). Section 1B relates to the requirement that designs must be novel in comparison to others that have been made available to the public. In relation to design number 4020066, under section 11ZA(1)(c) of the Act, which relates to flags and emblems, Mr Tanveer claims that the “use of the Union Jack has no unique design application.”

3. Mr Tanveer states that the designs are not new because they are similar to the embellishments produced by his company (Global Fashion Links LTD) and Capital T-shirts LTD. Below, I describe the evidence attached to the applications¹.

4. Mr Erol filed counterstatements, denying the grounds. Although he states that the designs digitally date to 2004/2005, Mr Erol does not say if or when they were publically disclosed. Attached to the counterstatement for 4020104 are CAD drawings, none of which show the registered design. Attached to the counterstatement for 4020066 is a CAD drawing showing the word LONDON, in a curved formation, with a small Union Jack flag beneath it and, beneath that, the word ENGLAND. Attached to the counterstatement for 4025695 is a CAD drawing showing the words and pictorial elements as per the design registration. There are no CAD drawings attached to the counterstatement for 4020237, but a CAD drawing attached to the counterstatement for 4020104 shows the word LONDON and beneath it a Union Jack, with the word England to the right of it (as per 4020237). None of the drawings depict any type of garment. Three of the counterstatements have an attachment comprising a photocopy of a notary public declaration stating that an envelope containing a photograph (adduced in the evidence but as a photocopy) was posted to Mr Erol’s company on 10 July 2007 and that the notary public opened the envelope containing the said photograph on 24 February 2012. The photocopied photograph attached is the same in all three cases and corresponds to registered design 4020066.

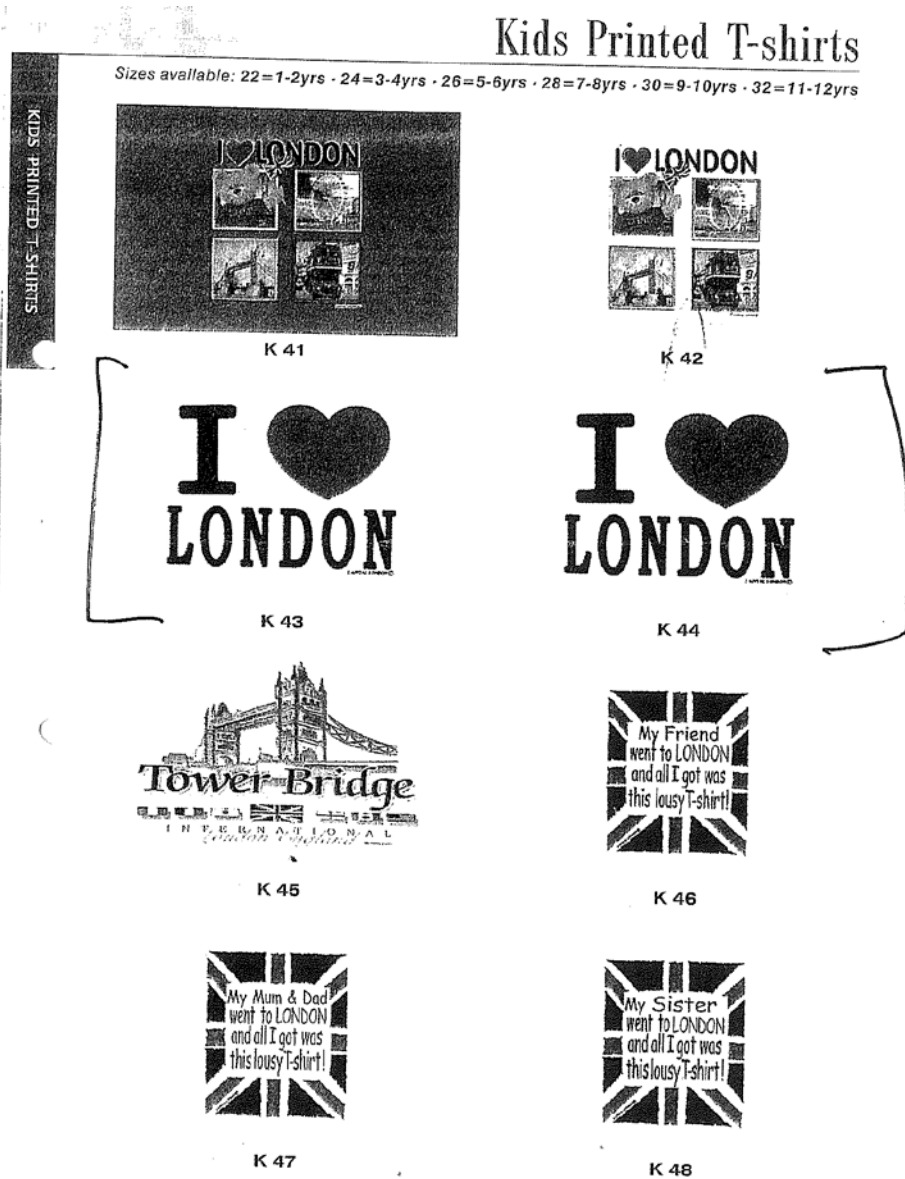
¹ Documents attached to a statement of case or a counterstatement constitute evidence in accordance with rule 21(1)(a) of the Registered Designs Rules 2006.

5. Both parties filed evidence. The matter came to be heard before me on 19 January 2016. Mr Erol was represented in Newport by Ms Millie Balkan, of Mishcon de Reya LLP. Mr Tanveer appeared in London, via video conference.

Evidence

6. Attached to Mr Tanveer's applications are various documents:

- Photocopied pages from a brochure from Capital T-Shirt Ltd, dating from 2004. The front page says that the brochure is the fourth edition from suppliers of printed and embroidered sweatshirts and casual wear to the souvenir trade. Further pages are shown below:



Adults Printed T-shirts

Sizes available: Small · Medium · Large · XLarge · XXLarge

ADULTS PRINTED T-SHIRTS



P 17



P 18



P 19



P 20



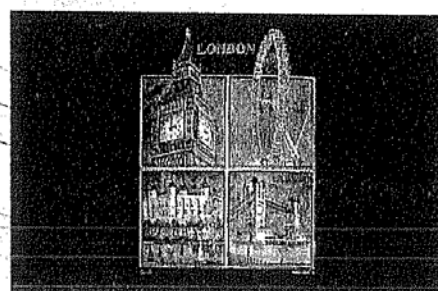
P 21



P 22



P 23



P 24

COPYRIGHT PROTECTION WITH CAPITAL T-SHIRTS LTD. COPYING OF ANY DESIGN IS STRICTLY PROHIBITED.

- CAD design drawings which are filed in support of the claim against design number 4025695 but which are substantially different to that design.
- A CAD design drawing of a hooded sweatshirt, reference F2 1129:



Garment. Fabric: 35% Cotton 65% Polyester Knit: Fleece Weight: 350gsm Fabric Pantone: Black Inner Hood Pantone: 18-4140 TP Stitching Body / Neck: Black Stitching Sleeve / Bottom Hem: Black	<div style="display: flex; align-items: center;"> <div style="width: 15px; height: 15px; background-color: black; margin-right: 5px;"></div> Black TP - Garment Fabric </div> <div style="display: flex; align-items: center; margin-top: 5px;"> <div style="width: 15px; height: 15px; background-color: #4169e1; margin-right: 5px;"></div> Royal Blue 18-4140 TP - Inner Hood Fabric </div> <div style="display: flex; align-items: center; margin-top: 5px;"> <div style="width: 15px; height: 15px; background-color: #4169e1; margin-right: 5px;"></div> Royal Blue 18-4140 TP - Cord </div>
Design Front: Applique: 18-4140 TP Applique Stitching: White	<div style="display: flex; align-items: center;"> <div style="width: 15px; height: 15px; background-color: #4169e1; margin-right: 5px;"></div> Royal Blue 18-4140 TP - Applique </div> <div style="display: flex; align-items: center; margin-top: 5px;"> <div style="width: 15px; height: 15px; border: 1px solid white; margin-right: 5px;"></div> White - 4mm Stitching </div>

1. Neck Label: See File F2 Printed Label
2. Patch See File F2 Woven Patch Label Artwork
3. Union Jack Patch: See File: Union Jack Embroidered Patch

7. Mr Tanveer's first witness statement is dated 27 January 2015. I summarise this and the attached exhibits insofar as they are relevant to the issues which I have to decide.

8. Mr Tanveer exhibits what he states to be brochures for Global Fashion Links (Mr Tanveer is the Director of this company) from 2002 and 2005 (Exhibit MT-4). The front cover of the 2005 brochure (bearing a copyright date of 2005) shows a man wearing a zipped hoody bearing a design resembling the London England and small Union Jack design (as per design number 4020237). The 2002 brochure (bearing a copyright date of 2002) consists of a folded piece of card, i.e. four pages in all. The middle two pages bear ten pictures of garments, four of which are zipped hoodies resembling 4020237. There is no information about the individual garments. The middle section of the 2005 brochure provides information about Mr Tanveer's company. The back page bears nine pictures of garments with varying themes of Union Jacks, crowns and words referring to London. One zipped hoody resembles 4020237, except that it has a thick line under the word London. There is no information about the individual garments.

9. Mr Tanveer exhibits (MT-5) photographs and photocopies of photographs from a farewell party at a school in Pakistan, sponsored by his company's supplier, Global Enterprise, in which some pupils and some teachers wore clothing donated by Global Enterprises. The photographs are dated 18 January 2005. In one of the photographs, a girl wears a sweatshirt which bears a design which resembles the I ♥ London design (4020104). In another, a child wears a sweatshirt which bears a design resembling the London England sweatshirt (4020066). In two of the photocopies (pages 5 and 19), men wear hoodies which resemble design number 4020237. The exhibit contains a letter on headed paper from the school, Namil United School, Faisalabad. It is dated 20 January 2005. It is headed 'To Whom It May Concern', referring to a party held two days earlier:

"This is to certify that Namil United School Faisalabad is a charity based school which provides affordable as well as free education to children who deserve.

Annual Funfair event that was held on 18-01-2005 fully sponsored by M/S Global Enterprises.

They support us as:

Event arrangements
Garments for school staff and students
Prizes for best performers
Lunch and refreshment
Cash support of Rs.50,000/

We appreciate their effort for encouragement of students and school for this welfare programme and we hope the same in future."

The letter is signed by the school Principal.

10. At the hearing, Ms Balkan challenged the veracity of the date of the party and this letter, asking why anyone would write such a letter contemporaneously. Mr Erol also challenged the veracity of the letter in his evidence, alleging it was fake.

11. Mr Tanveer states that his company sold items with the subject designs to M/s Slirtation UK Ltd (Red Clothing) in 2003, receiving a cheque from the latter which was returned unpaid. Mr Tanveer exhibits the delivery note with the original cheque, dated 15 January 2004 (MT-6). The delivery note is dated 1 December 2003 and lists a style number GFL-138 and a description, 'Men's zipper London England Embroidery'.

12. Mr Tanveer exhibits (MT-7) photographs of what he states to be the younger and older photographs of the same boy in 2006 and 2014, wearing a hoody which has a half Union Jack and half crown device. This is not the same or even similar to the registered designs.

13. Mr Tanveer exhibits (also MT-7) what look like original copies (the paper is aged) of a purchase order from Global Fashion Links Ltd to Global Enterprises dated 27 October 2003, a packing list from Global Enterprises dated 27 October 2003 and a freight receipt dated 3 November 2011. The purchase order lists GFL-138 Mens

Fleece Zipper Jacket London England Embroidery EU83 and GFL-147 Ladies Hood Jacket London England Applique Embroidery EU-83 (amongst other items). The purchase order total was £4354.92. The total net weight was 684 kgs, which matches the packing list weight and also the air waybill weight (Exhibit MT-8), dated 28 October 2003. At the hearing, Ms Balkan challenged the veracity of the purchase order because some of the type was in bold and, allegedly, in a different font. I do not see that it matters if the items are in bold – so are the addresses. They are also repeated in a table further down the page. I cannot see that they are in a different font.

14. Exhibit MT-9 contains what is described as a statement signed from a customer who has been buying the subject designs from 2002 onwards. It is headed up as a witness statement, reproducing pictures of various garments which have been bought since 2005. Some of the pictures resemble three of the contested designs (4020104, 402066 and 4020237), but not the contested London City design (4025695). The statement is undated and is signed 'Tamim', Chrome Ltd, in Camden.

15. Exhibit MT-10 contains a copy of a witness statement from the managing director of Lahore Fashions, Kashif Zia, dated 19 December 2014. He states that his company supplied Mr Tanveer's company between 2002 and 2008 with the following designs: I Love London Hoodie (2002 to 2008); London England Union Jack Pullover Hoodie (2003 to 2008); London England Union Jack Zipper Hoodie (2003 to 2008); and Half Union Jack & Crown Embroidered Zipper (2006 to 2008). No representations are provided. Mr Erol contacted the company in Spring 2008, requesting the supply of the same designs as Lahore Fashions supplied to Mr Tanveer's company. This was against Lahore Fashion's policy and was refused. The other document in this exhibit is an email dated 23 December 2013 from Mr Zia to Mr Tanveer, explaining that he was sending his witness statement as an attachment and also some old order sheets along with design packs to help in the dispute with Mr Erol (it is not clear which dispute, and the order sheets and design packs are not exhibited).

16. I will summarise Mr Erol's evidence in so far as it is relevant to the issues to be decided. Much of the evidence consists of challenges to the probity of Mr Tanveer's evidence. Some of the exhibits challenged are not material, so for the sake of procedural economy, I will not detail these. Other challenges are made to documents not filed in these proceedings. The main points of relevance are:

- Mr Erol states that the photographs of children at a party at Namil United School in Pakistan were not taken in 2005 because the school did not exist until 2014. The party was actually held on 18 January 2015. Mr Erol alleges that Mr Tanveer has intentionally made banners which say 2005 so that he could take photographs to use in these proceedings and that the party was staged. At AE6, Mr Erol exhibits what he refers to as a statement by Ameer Masood. The document in questions is not a witness statement. There is no statement of truth. It is not headed, although it is signed (illegibly) by Mr Masood (the name is typed above the signature) and dated 11 July 2015. The document consists of a single paragraph in which Mr Masood says that he telephoned the school on 10 July 2015 and spoke to a Mian Sabir Ali. Mr Masood asked Mr Ali how long the school had been open for and was told that the school was established in 2014 but was not open for education yet and will start teaching on 15 August 2015. The school had had an opening party on 18 January 2015 to encourage

new students and give thanks for donations. At Exhibit AE7, Mr Erol exhibits a printout of what appear to be Facebook messages between Mr Erol and an individual called Umair. Mr Erol states that Umair is a student at the school and that his blog comes up on Google if Namil United School is searched. Mr Erol states that the blog was created on 14 January 2014 and that he located Umair's details through a Google account which is open to the public. In the conversation, Mr Erol asks the student when the school opened (answer: 2014) and the student tells him that the school only has "8th class". Mr Erol states that, according to Wikipedia, the 8th grade is for 13 to 14 year old students. There is no Wikipedia evidence. Mr Erol says that the children in the photographs exhibited by Mr Tanveer are much younger than this. Mr Erol states:

"35. It must also be noted that IPO does not take use outside the UK in relation to a UK registered design, meaning that all evidence originating from Pakistan be disregarded."

- Mr Erol cannot find any evidence that Global Enterprises exists, including on the MINT database which covers about 150 million global companies. Exhibit AE10 is an email from Adeel Mustafa from the Lahore Chamber of Commerce and Industry. Mr Mustafa says that there are no records of Global Enterprises. To export from Pakistan, companies must be registered with the Lahore Chamber of Commerce and Industry.
- In relation to Exhibit MT-9, the so-called statement from 'Tamim', Mr Erol states that Mr Tamim has stated that he doesn't remember exactly which designs he bought from Mr Tanveer's company and that he only signed the document. Mr Tanveer filled in the purchase dates. Mr Erol exhibits (AE15) an undated 'To whom it may concern' handwritten note from Mr Tamim to this effect. The handwriting and signature appear consistent across the two exhibits.

17. Mr Tanveer's evidence in reply is dated 29 September 2015. Annex A-1 comprises Facebook photographs from 30 July 2010, but it is not possible to see any designs with sufficient clarity to enable a comparison to be made without resorting to guesswork. Annex A-2 comprises two letters (one unsigned and undated, the other signed and dated 1 December 2014) stating that two of the designs (4020104 and 4020066) are old and date back to the turn of the 21st Century. No images are provided and there are references to same or *similar* designs. Both authors say that they have evidence (e.g. catalogues) but none is provided. Annex A-3 includes prints from Google images, made on 16 September 2015, showing 'I ♥ London' T-shirts corresponding to design number 4020104. Mr Tanveer states that this shows the existence of the designs between 1 January 2000 to 1 January 2011. The search criteria appears as being between 1 January 2000 and 21 May 2011 (the date on which design number 4020104 was filed). Page 9 of the exhibit is a Google images print, made on 20 September 2015, with the search criteria being 1 January 1990 to 1 April 2011, showing a hoodie corresponding to design number 4020066 (which was filed on 18 May 2011).

18. Annex A-9 comprises some CAD artwork which Mr Tanveer states was produced by his designer, Brian Reed. The artwork specifications bear dates of Spring/Summer

2010 Collection. The CAD drawings show a CAD swing tag which says LONDON 2012. Ms Balkan challenged this, for the first time, at the hearing. Mr Tanveer's reply was that these garments were souvenirs for 2012 (the year of the Queen's Diamond Jubilee and the London Olympics) and these swing tags were used for some 5 years (from 2007).

19. Annex A-10 reproduces the unsigned and undated letter shown in Annex A-2.

20. Annex A-11 comprises prints from the Facebook page of Sumaira Tanveer, showing photographs of a birthday party (some are the same as in Annex A-1). The Facebook page is dated 30 July 2010. It is not possible to see clearly the garments in the photographs.

21. Annexes A-20 to A-23 concern Namil United School, in Pakistan. To counter Mr Erol's challenge to his evidence about the school party, Mr Tanveer exhibits an email, dated 9 April 2015, from Shahida Sharif. Ms Sharif says she is the school's Principal and that the original school opened in 2003 (at the address in Mr Tanveer's evidence at exhibit MT-5). A new school was opened in 2014 at a different address. Mr Tanveer states that Mr Erol bribed the boy called 'Umair' to create a blog about Namil school, which is now blocked, along with his Facebook account. Mr Tanveer states that he spoke to the boy and his mother, following which Umair told Mr Erol that he doesn't know about Namil school and doesn't want his offers of money, gifts or any more contact. Mr Tanveer states that the purpose of the letter from Namil school was "to encourage".

22. Annex A-24 is in response to Mr Erol's statement that Global Enterprises does not exist. Mr Tanveer exhibits a letter ("To whom it may concern") from Dr Mazhar Ali Azhar, who was the Director of Global Enterprises. He says that he delivered goods to Mr Tanveer's company in 2003 and 2004 and that M. Masood is his partner. The exhibit includes a photograph of a Lahore Chamber of Commerce & Industry membership card (expiry 31 December 2009) showing Dr Azhar's name, photograph, and the words 'M/s. Global Enterprises'. A membership certificate from 2003 is also exhibited. The exhibit also includes a membership certificate dated 26 June 2003 for Global Enterprises, as a provisional member of the Pakistan Readymade Garments Manufacturers and Exporters Association; a National Tax Number certificate from 2003; and a National Tax Number certificate from 2008.

23. Annex A-27 includes an email dated 23 August 2015 from Ramesh Desilva to Mr Tanveer's company. Mr Desilva is a customer of Mr Tanveer's company and has bought "London Souvenirs [sic] garments from global fashion links since 2005". He says that Ahmet Erol told him that he has exclusive rights to the designs including "I love London, Union Jack, London England, Crown Union Jack" and that Mr Erol threatened him with 'trading standards'.

24. Annex A-31 contains prints of photographs of children and family groups on the Facebook pages of Subhaan Ahmed Zaheer (dates in April 2010 and September 2010) and Sumaira Tanveer (25 July 2010). A selection is shown below:



Subhaan Ahmed Zaheer

April 5, 2010 · 🌐

Like · Comment · Share



Write a comment...

Sponsored 📄

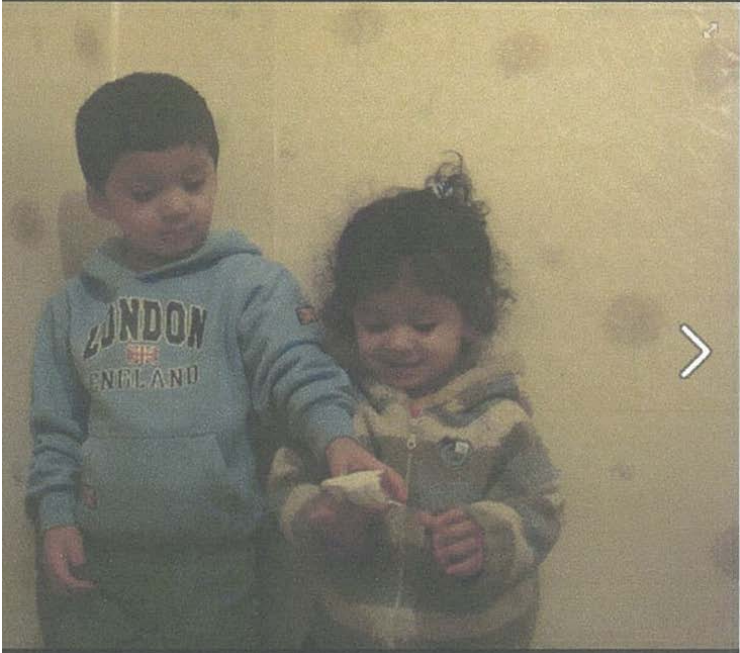


Send money to Greece
WESTERNUNION.CO.UK

This is for your loved ones. Send money in n
home to Greece today!

23

Tag Photo Options Share Send Like




Subhaan Ahmed Zaheer
September 5, 2010 · 🌐

Like · Comment · Share

Write a comment...

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Award-Winning small business accounting and payroll software.

Tag Photo Options Share Send Like



Sumaira Tanveer
25 July 2010 · 🌐





Add a description

Tag photo Add location Edit

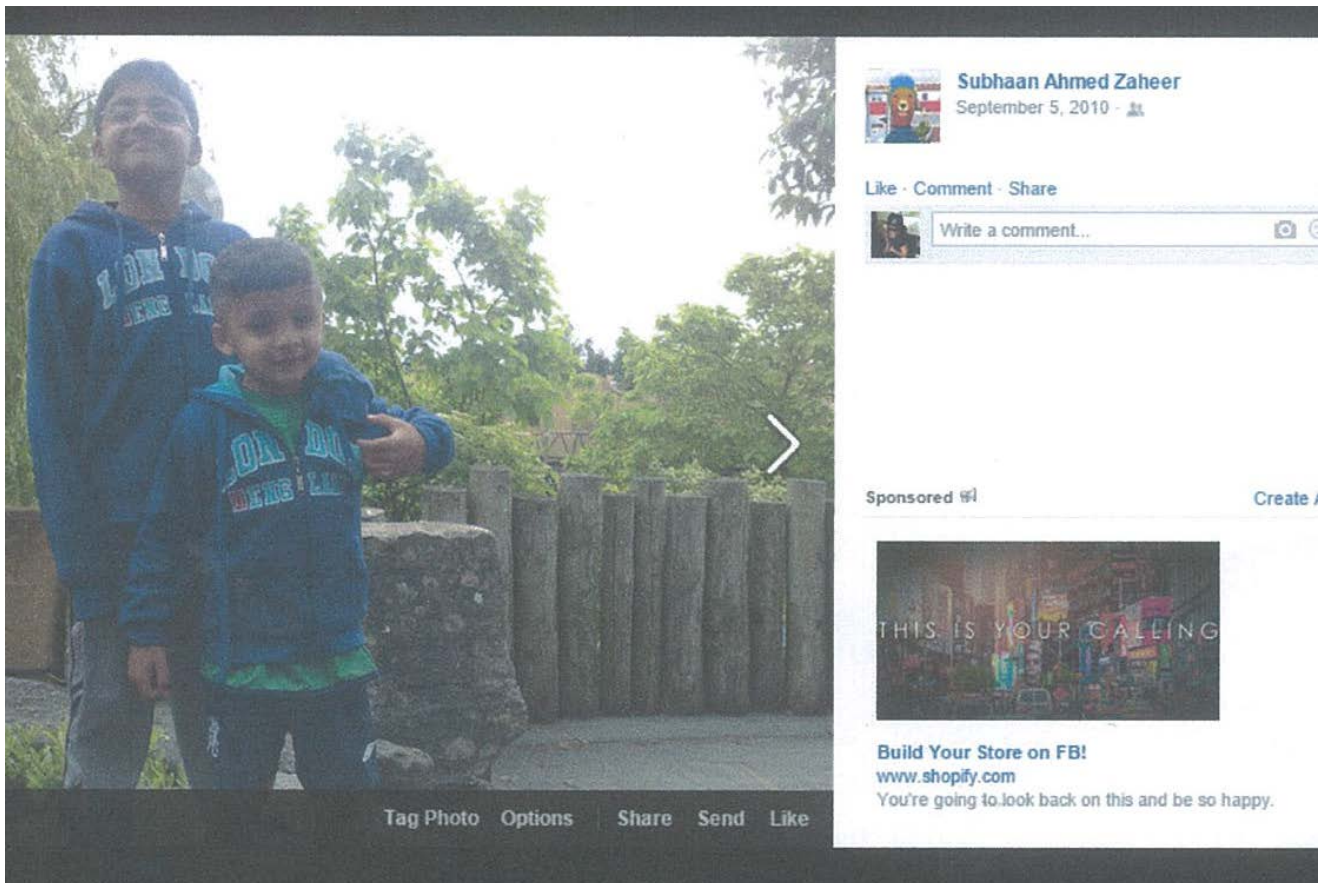
Like · Comment · Turn Off Notifications · Share

Write a comment...

People You May Know

-  **Iqra Mahi**
1 mutual friend
[Add Friend](#)
-  **Zahra Ali**
2 mutual friends
[Add Friend](#)
-  **Maryum Jawad**
10 mutual friends
[Add Friend](#)
-  **Usman Rauf**
10 mutual friends
[Add Friend](#)

Loading time 36 of 200 Make Profile Picture Tag photo Options Share Send Like



Preliminary point at the hearing

25. Mr Tanveer made a request, the day before the hearing, to file further evidence, consisting of a CD which had lately come to light. The CD was said to contain Global Fashion Links' designs with dates. I refused permission to admit the evidence because it was extremely late and because it was unlikely to be material. A CD containing designs and artwork does not prove that the designs were ever disclosed.

Decision

26. Section 11ZA of the Act provides the capacity for a registered design to be invalidated on the ground (section 1B) that it was not new or that it did not have individual character. Section 1B 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 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)
- (9)”.

27. Section 11ZA(1)(c) states:

“(1) The registration of a design may be declared invalid—

(a)...

(b)...

(c) Where any ground of refusal mentioned in Schedule A1 to this Act applies.”

28. The relevant part of Schedule A1 provides:

“(2) A design shall be refused registration under this Act if it involves the use of—

(a) The national flag of the United Kingdom (commonly known as the Union Jack); or

(b) ...

and it appears to the registrar that the use would be misleading or grossly offensive.”

29. Mr Tanveer’s section 11ZA(1)(c) pleading is that “use of the Union Jack has no unique design application”. This pleading is about novelty (already pleaded), not about why the designs are misleading or grossly offensive. Consequently, the ground under section 11ZA(1)(c) fails.

30. According to section 1B(7) of the Act, prior art can only be relied upon to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design being attacked. This means that the relevant dates for my assessment are 21 May 2011 for 4020104; 18 May 2011 for 4020066; 19 July 2012 for 4025695; and 28 May 2011 for 4020237. Any prior art must have been made available to the public prior to these dates unless the exceptions in subsection (6) apply.

31. In *Magmatic Limited v PMS International Limited* [2013] EWHC 1925 (Pat), Arnold J considered the operation of the exceptions² (my emphasis):

“33 *Article 7(1)*. By virtue of Articles 4, 5 and 6 of the Regulation, a Community registered design must be novel and have individual character having regard to any design "which has been made available to the public". Article 7(1) sets out the ways in which a design may have been made available to the public. In short, any disclosure which makes the design public in any part of the world will suffice. This is subject to two exceptions, however. These may conveniently be labelled "obscure disclosures" and "confidential disclosures". Only the first of these is relevant for present purposes. This applies where "these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community".

34 Although it was not directly in issue, the obscure disclosures exception was considered by the Court of Appeal in *Green Lane Products Ltd v PMS*

² In the parallel context of the Council Regulation 6/2002/EC of 12 December 2001 on Community designs.

International Group Plc [2008] EWCA Civ 358, [2008] FSR 28. Jacob LJ, with whom Ward and Rimer LJJ agreed, said:

"66. ... How then did the exception to absolute novelty come about? The *travaux* are clear about this. It came about by reason of a specific piece of lobbying by the textile industry. It was a concern about counterfeiting and nothing to do with an intention that prior art, obscure in the field of intended use, should be discounted.

67. The Economic and Social Committee opinion of 1994 said this when considering the novelty provision:

'3.1.2 This provision, as worded, would be difficult to apply in many fields, and particularly in the textiles industry. Sellers of counterfeit products often obtain false certification stating that the disputed design had already been created in a third country.

3.1.3 In these circumstances, the aim should be dissemination to interested parties within the European Community before the date of reference.

3.1.4 In the light of the above considerations, article 5(2) might be worded as follows: "A design shall be deemed to have been made available to the public if it has been published following registration, exhibited, used in trade or otherwise disclosed, unless this could not reasonably be known to specialist circles in the sector in question operating within the Community before the date of reference."

68. This is clearly the forerunner of the exception in article 7. The Economic and Social Committee's suggestion was taken up, extended also to the individual character test and became the law. It is worthwhile quoting the Commission's explanation for the proposed exception contained in its 1966 amended proposal:

'... article [6] has furthermore been amended in accordance with the wishes of the European Parliament and the Economic and Social Committee through the introduction of what is commonly known as the "safeguard clause". Its aim is to protect the design industry from claims that a design right is not valid because there was an earlier design in use somewhere in the world where the European industry could not possibly have been aware of it. The intention of this provision is to avoid the situation where design rights can be invalidated by infringers claiming that antecedents can be found in remote places or museums.'

69. As Mr Hacon observes, for the exception to work as intended the sector concerned had to be that of the cited prior art. His example demonstrates this:

'If the registered Community design was in respect of a design for, say, teapots and the alleged prior art was for Columbian textiles, it would be the textiles circles in Europe who would be in a position to know whether the "certification" was genuine. *Ex hypothesi* the teapot circles would never know.'

70. Moreover the exception was clearly conceived as narrow - it was aimed at obscure prior art only: it meant that forging this would not help an infringer.

71. Although there were further *travaux* before the ultimate Regulation, there was no significant relevant further change."

35 There is a helpful discussion of this exception, which includes references to some more recent case law elsewhere in Europe, in Stone, *European Union Design Law: A Practitioners' Guide* (OUP) at §§9.22-9.66. As the author comments, the wording of the exception gives rise to a number of questions of interpretation which may require resolution by the Court of Justice of the European Union. In Case C-479/12 *H. Gautzsch Grosshandel GmbH v. Münchener Boulevard Möbel Joseph Duna GmbH* the Bundesgerichtshof has referred a question concerning the interpretation of the exception to the CJEU, but neither side suggested that I should defer judgment in the present case until after the CJEU has given its judgment. Nor was it suggested that I should refer questions myself. Accordingly, I must interpret the exception as best I can in the light of the guidance that is currently available. There are a number of points to consider.

36 First, the exception refers to "these events". The "events" are the events constituting disclosure referred to earlier in the first sentence of Article 7(1) – publication, exhibition, etc. Counsel for PMS submitted that the exception did not apply if the relevant event could reasonably have become known, even if the design itself could not reasonably have become known as a result of that event. I do not accept that submission. The purpose of the exception is to prevent obscure designs from being relied upon to attack the novelty and individual character of a Community registered design. If a design could not reasonably have become known, it cannot matter that the event could have become known. In most cases, of course, one will follow from the other.

37 Secondly, what is "the sector concerned"? In *Green Lane* the Court of Appeal held that it was the sector from which the prior design came, not the sector from which the registered design came. The Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) came to the opposite conclusion in Case R 84/2007-3 *Ferrari SpA v Dansk Supermarked A/S* (unreported, 25 January 2008) and Case R 9/2008-3 *Crocs Inc v Holey Soles Holdings Ltd* [2010] ECDR 11. An appeal to the General Court in the latter case was not pursued. In those circumstances, I am bound by the Court of Appeal's decision in *Green Lane*. Furthermore, I agree with it.

38 Thirdly, who are "the circles specialised in" that sector? In *Green Lane* Lewison J (as he then was) held at first instance that this comprised all individuals who conducted trade in relation to products in that sector, including

those who designed, made, advertised, marketed, distributed and sold such products in the Community ([2007] EWHC 1712 (Pat), [2008] FSR 1 at [34]-[35]). This point was not addressed by the Court of Appeal. In Case R 552/2008-3 *Harron SA v THD Acoustics Ltd* (25 July 2009, unreported) the Board of Appeal held that the circles included experts and all businesses involved in the trade including importers. Thus it seems clear that the words are to be broadly interpreted.

39 Fourthly, the test is whether the events "could not reasonably have become known in the normal course of business". It is common ground that this is an objective test. Counsel for PMS emphasised that the question was whether the events *could not* have become known, not whether the events *would not* have become known. I accept that, but subject to the qualification that the test is whether the events could not *reasonably* have become known *in the normal course of business*. The wording must be interpreted as a composite whole.

40 It is common ground that the events in question must have occurred prior to the filing or priority date of the registered design. Counsel for PMS accepted that it was theoretically possible for a design to have become sufficiently obscure as a result of the passage of time that it could not reasonably have become known in the normal course of business at the filing or priority date even if it could have become known at the date of the event, although he submitted that this was unlikely to occur in practice.

41 Fifthly, who bears the burden of proof? Counsel for PMS submitted that the burden of proving that the exception applied rested on the party who relied on it, here Magmatic. He argued that this interpretation was supported by both the wording and purpose of the exception and by the case law of the Board of Appeal, in particular Case R 1516/2007-3 *Normanplast snc v Castrol Ltd* (unreported, 7 July 2008) at [9]. Counsel for Magmatic submitted that the burden of proving that the disclosure was made available to the public rested on the party challenging the validity of the registered design, and that included proof that the design could reasonably have become known as result of the event relied on. In the alternative he submitted that, if the burden of proof lay on the proprietor of the design, nevertheless the evidential onus could shift if on its face the disclosure was an obscure one. In support of these submissions, he relied on the decision of the Board of Appeal in Case R 1482/2009-3 *Termo Organika Sp. z.o.o. v Austrotherm GmbH* (unreported, 22 March 2012) at [38]-[44]. As counsel for PMS submitted, however, there is no indication in that decision that the question of burden of proof was argued or that the Board of Appeal was addressing its mind to the question. In my judgment the burden of proving that the exception applies rests on the party relying on the exception. I accept, however, that the evidential onus may shift to the other party once it is shown that the disclosure relied on appears to be an obscure one."

32. The exceptions are defences available to a registered proprietor. They must be expressly relied upon. There are two evidential issues in these proceedings where the exceptions have relevance. These are (i) the evidence relating to the school party in Pakistan; and (ii) the Facebook photographs. In neither case has Mr Erol expressly stated that they do not count as disclosure because they "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". I do not think that Mr Erol's statement, in relation to the school evidence, that "It must also be noted that IPO does not take use outside the UK in relation to a UK registered design, meaning that all evidence originating from Pakistan be disregarded" can be regarded as a reliance on the exception. Evidence outside the UK may be, and frequently is, relevant in establishing disclosure in design law. I will, therefore, take these two pieces of evidence as I find them.

Decision in relation to 4025695



33. There is no evidence at all of any prior art in relation to this design. The only documentation adduced by Mr Tanveer comprises CAD drawings which a) do not, of themselves, prove public disclosure and b) are substantially different to the registered design. The application for invalidity fails against 4025695.

Scope of the remaining three registered designs

34. Mr Erol's application form for design 4020104 states that the products for which the design application was made are hoodies and t-shirts. These are different items. The scope of this registered design is the representation of 'I ♥ London' applied to the front of a garment.

35. Mr Erol's application for design 4020066 is for a hoody sweatshirt. The attachment to the counterstatement shows a CAD drawing of the motif without depicting a garment. The scope of this design is therefore unclear in the light of the counterstatement attachment, but as the form says it is for a hoody sweatshirt, I will take the scope as the hoody sweatshirt represented in the form for the registered design.

36. Mr Erol's application for design 4020237 is for sweat jackets and t-shirts. These are different items. The CAD attachments to the counterstatement do not show the registered design, but the motif is shown in a CAD attachment to the counterstatement for 4020104, without any garment. The scope of this registered design is the representation of the motif on the application form applied to the front of a garment.

The notary public evidence

37. I inspected Mr Erol's notary public evidence (described at paragraph 4 of this decision) at the hearing so as to examine the original, which appeared to be genuine. Mr Erol's envelope, sent to himself in 2007 and opened by the notary public in 2012, contained a photograph of a hooded sweatshirt with a motif, the whole corresponding to design number 4020066. Mr Erol relies upon this in his counterstatement to prove that the design belongs to him. These proceedings do not concern copyright or the date of creation. The question is whether the design was publicly disclosed before the relevant date. Mr Erol has not gone so far as to claim the design was disclosed in 2007; if he had, he would have rendered his own design invalid because it would have been disclosed more than twelve months prior to the filing of the application for the design.

Decision in relation to 4020104

38. The evidence in relation to this registered design suffers from a lack of pictorial representation and a lack of coding which could be used to cross-refer e.g. from catalogues to invoices. The potentially relevant evidence is:

- (i) the Capital T-shirt Limited brochure from 2004, which includes codes beneath the various print designs.
- (ii) A photograph from the school party in Pakistan in 2005.
- (iii) The Google images prints from a search for images from 1 January 2000 to 21 May 2011.

39. The statement from 'Tamim' which includes a picture resembling the registered design, is undated, so is unacceptable as a witness statement. It is hearsay and the fact that it has been solicited for the proceedings, but not in evidential form so that the witness can be tested, counts heavily against its capacity to prove the design was disclosed from 2002. Further, the same person appears to have signed the letter filed by Mr Erol to say that he can't remember exactly which designs he bought from Mr Tanveer.

40. The relevant question is whether an identical design, or one which creates the same overall impression as the registered design, was made available to the public before.

Does the registered design create a different overall impression to the prior art?

41. For economy of process, the focus will be on whether the registered design has individual character (rather than whether it was new; if it does not have individual character, it cannot be new). The relevant case law in this respect was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). The parts which are most relevant to these proceedings are reproduced below.

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the Court of Justice of the European Union in *PepsiCo v Grupo Promer* (C-281/10P) [2012] FSR 5 at paragraphs 53 to 59 and also in *Grupo Promer v OHIM* [2010] ECDR 7, (in the General Court from which *PepsiCo* was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, BAILII: [2010] EUECJ T-153/08 , 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J summarised that passage from *Grupo Promer* as follows:

"design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive)."

Effect of differences between the registered design and design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

"as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements 'that are totally banal and common to all examples of the type of product in issue' and will concentrate on features 'that are arbitrary or different from the norm'."

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe? Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of "different overall impression" is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by

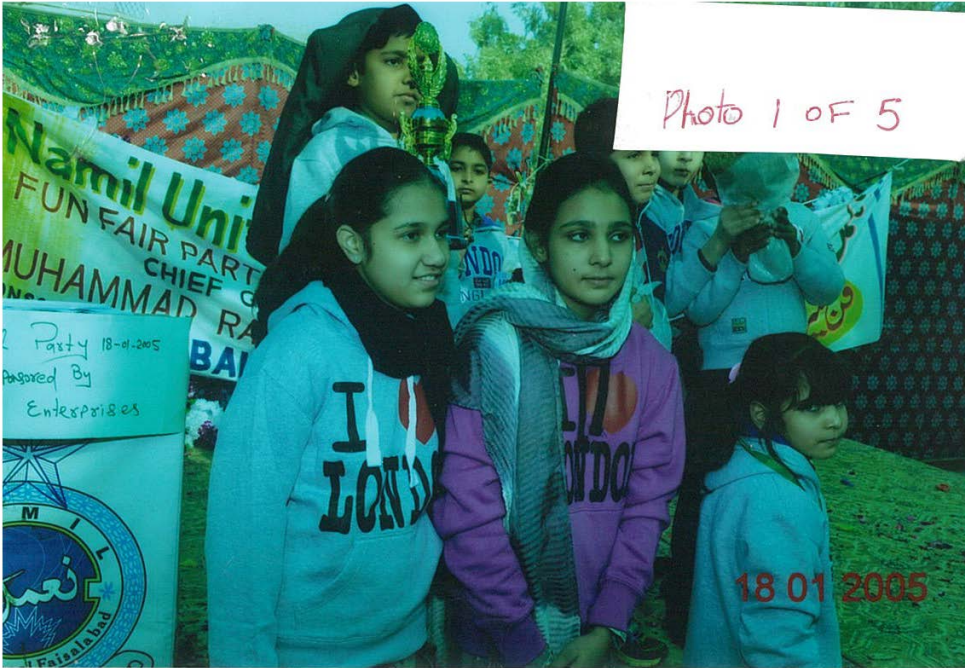
side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

42. The informed user of clothing is a consumer as opposed to an actual designer or some other expert in the field. However, the informed user is not an average or standard consumer, it is instead someone who is likely to have an interest in clothing design. Such a person is, therefore, likely to have a keen eye in relation to the design attributes of a particular item of clothing. They will not, however, make a forensic analysis of each and every detail.

43. The registered design is:



The alleged prior art is shown below:



(An example from the Google images search results)



44. I consider that the Google search provides a sufficiently robust search mechanism to satisfy me that, on the balance of probability, the design would have appeared on the internet before the relevant date. Mr Erol, in his evidence, challenged the veracity of the dating of the party at Namil United School, alleging that the school did not exist in 2005; that the children in the photograph were too young for the age of the school's pupils (as of 2015); and that the company who sponsored the party (and donated the clothing) did not exist. Mr Tanveer answered these criticisms in his evidence in reply.

Firstly, not everyone is wearing 'London/Union Jack' clothing, which undermines the submission that the party was staged for the proceedings. Secondly, Mr Tanveer has provided several items of corroborative evidence from Dr Mazhar Ali Azhar, Director of M/s Global Enterprises, to show that the company did exist. Thirdly, Mr Tanveer has also provided evidence to cast serious doubt upon Mr Erol's evidence from the boy called Umair. Lastly, there are a good number of children in the photographs who appear to be teenagers, which refutes Mr Erol's claim that the children are too young to be at the school. Mr Erol did not seek to cross-examine Mr Tanveer. The challenges to the school evidence were answered satisfactorily.

45. The designer of clothing has a very free hand in what design is actually used in terms of patterning. There is a wide degree of design freedom. There is no evidence about the design corpus. It would be wrong to speculate. This factor has a neutral influence on the findings I make.

46. The comparison of the design with the alleged prior art is relatively simple because the designs are simple. The registered design consists of the word 'I', with a red heart to its right and the word London beneath. London is slightly wider than the combination of the I and the heart. There is a space between the I and the heart. The words are in a plain, ordinary font and are in upper case. The same font is used in the Google image and the layout and proportions are identical (or, if not, highly similar) to the registered design. The proportions of the heart are identical. The two girls at the front of the photograph are clearly wearing sweatshirts with the same arrangement of I, a red heart and London, with the same font, although there is a larger gap between the I and the heart. There are either no differences between the registered design and these two pieces of prior art or a difference (the gap) which is too minimal to affect the overall impression. There is no need to go on to examine the Capital T-shirt Limited brochure from 2004; in any event, without corroborative evidence to show the brochure was actually disclosed to the public before the relevant date, its probative weight is limited.

47. The registered design does not have individual character because it does not create a different overall impression compared to the prior art, which shows an earlier design which was made available to the public before the relevant date.

Outcome for 4020104

48. The registration of the design is invalid because, at the date of application, it was not new and/or lacked individual character.

Decision in relation to 4020066

49. The evidence in relation to this registered design also suffers from a lack of pictorial representation and a lack of coding which could be used to cross-refer e.g. from catalogues to invoices. The potentially relevant evidence is:

(i) A photograph from the school party in Pakistan in 2005.

(ii) The Google images prints from a search for images from 1 January 1990 to 1 April 2011.

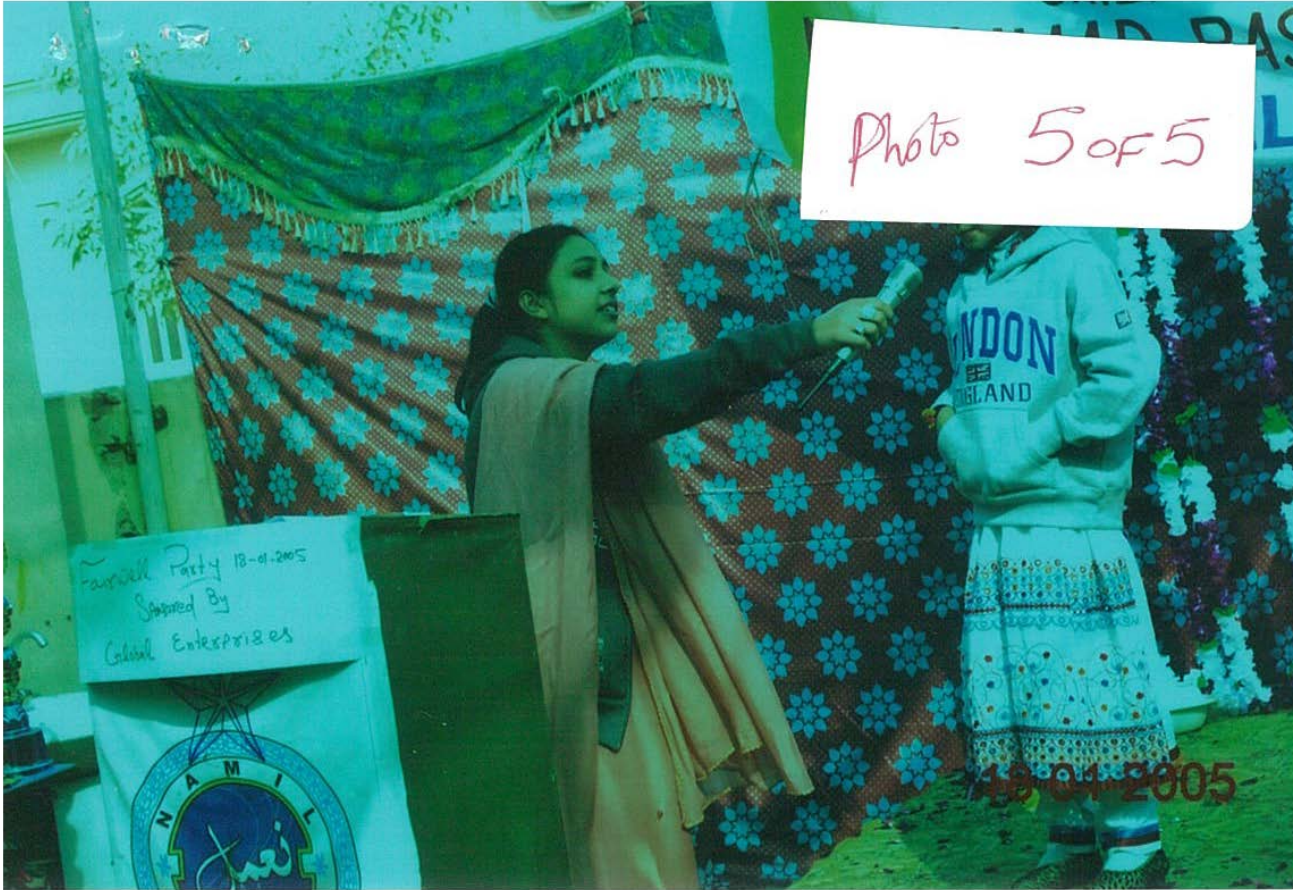
(iii) One of the Facebook photographs.

50. The statement from 'Tamim', which includes a picture resembling the registered design, is undated, so is unacceptable as a witness statement. My other comments (above) about this evidence, design freedom and the design corpus also apply here.

51. The registered design is:



The alleged prior art is shown below:



Size ▾

Color ▾

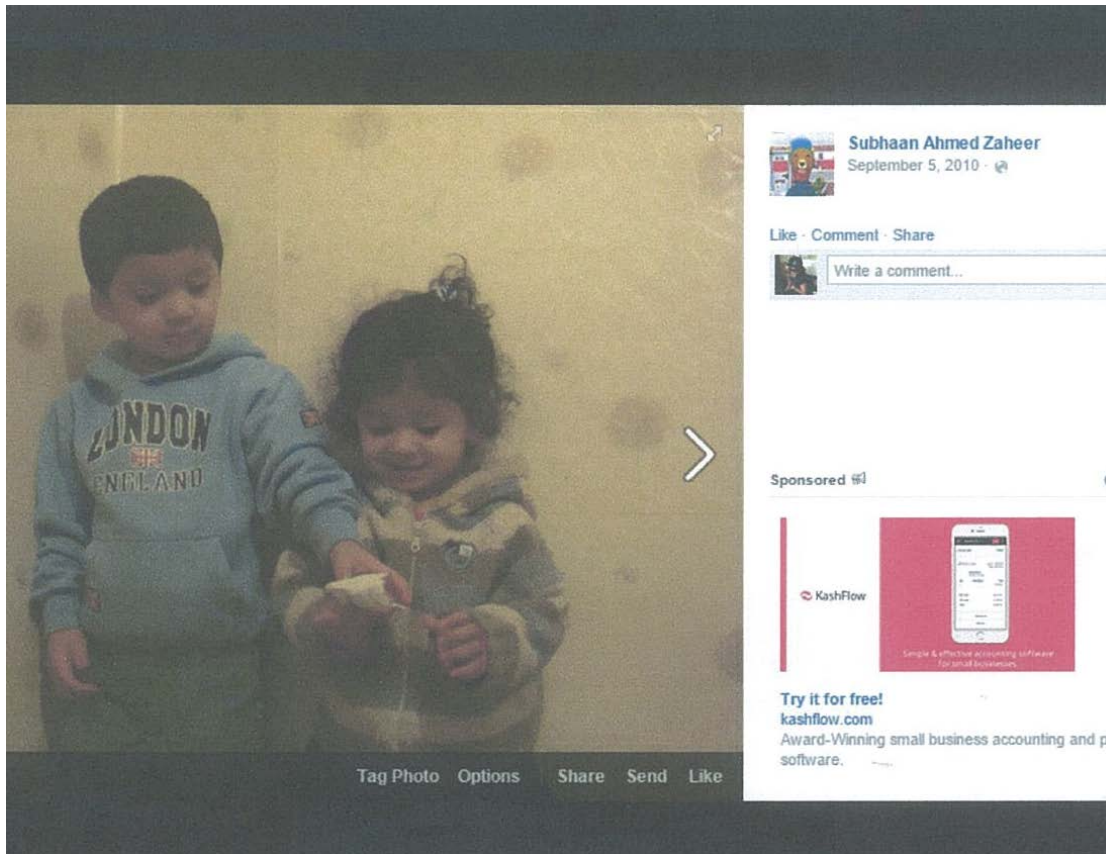
Type ▾

1 Jan 1990 – 1 Apr 2011 ▾



365 x 465 - clicksouvenirs.c...





52. The scope of the registered design is the hoody sweatshirt represented in the application form for the registered design. The registered design shows a red hooded sweatshirt. The middle garment in the Google image search results shows a red hooded sweatshirt. Both the registered design and the Google sweatshirt bear a motif on the front comprised of the word London, in dark capital letters, outlined in white, and on a slightly curved line, with a small Union Jack beneath the word London, centred, with the word England beneath the Union Jack, again centred. The proportions of these elements and their layout are near identical. The photographs from the school and on Facebook also show sweatshirts (in blue and grey) with the same motif on the front as in the registered design. Although the colours are different, the motifs are the same as in the registered design. The overwhelming impressions of the registered design and the prior art, particularly the Google sweatshirt, do not differ. The registered design does not have individual character because it does not create a different overall impression compared to the prior art, which shows an earlier design which was made available to the public before the relevant date.

Outcome for 4020066

53. The registration of the design is invalid because, at the date of application, it was not new and/or lacked individual character.

Decision in relation to 4020237

54. The evidence in relation to this registered design also suffers from a lack of pictorial representation and a lack of coding which could be used to cross-refer e.g. from catalogues to invoices. The potentially relevant evidence is:

- (i) The CAD drawing attached to the invalidation action (paragraph 6 above).
- (ii) Brochures from 2002 and 2005 (Exhibit MT-4).
- (iii) Photocopied pictures from the school party.
- (iv) The Facebook photographs.

55. A party must file evidence sufficient to prove its claim. I am not bound to accept everything said by a witness without analysing what it amounts to. The brochures are brief. The 2002 version consists entirely of pictures of garments. There are no descriptions, no sizes, no reference codes, no prices and no order forms. There is no explanation as to whom the brochure was sent or given. The brochure cannot be used to corroborate other pieces of evidence since there is no information contained within it. In relation to the 2005 brochure, this is also brief without descriptions of the garments, sizing, reference codes, price or order forms. Although the notable difference is that the front page of the 2005 brochure consists of a man modelling a garment, in what appears to be a public place, this is too flimsy a basis to find that there has been public disclosure:



56. The statement from 'Tamim' which includes a picture resembling the registered design, is undated, so is unacceptable as a witness statement. My other comments (above) about this evidence, design freedom and the design corpus also apply here.

57. The registered design is:



The alleged prior art is shown below:



Sumaira Tanveer
25 July 2010 · 📍





Add a description

📍 Tag photo 📍 Add location ✎ Edit

Like · Comment · Turn Off Notifications · Share

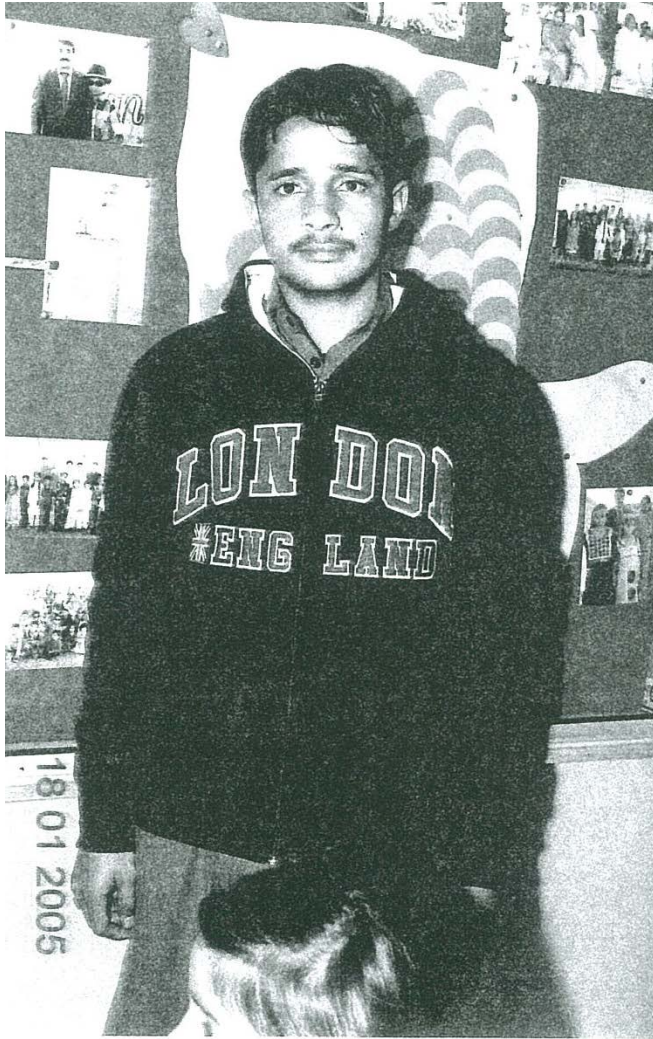
Write a comment...

People You May Know

-  **Iqra Mahi**
1 mutual friend
[Add Friend](#)
-  **Zahra Ali**
2 mutual friends
[Add Friend](#)
-  **Maryum Jawad**
10 mutual friends
[Add Friend](#)
-  **Usman Rauf**
10 mutual friends
[Add Friend](#)

loading time 36 of 200 Make Profile Picture Tag photo Options Share Send Like





58. The registered design and the prior art pictures share the following features:

- (i) The word LONDON, in block capital letters which are surrounded by a white border.
- (ii) Beneath the word LONDON is the word ENGLAND, also in block capital letters which are surrounded by a white border.
- (iii) The words LONDON and ENGLAND are separated (where the garment zip runs) between LON-DON and ENG-LAND.
- (iv) To the right (the left as you look at the pictures) of the 'ENG' is a small Union Jack flag, turned 90° so that it is vertical rather than the normal horizontal representation of the Union Jack flag.

59. The differences between the registered design and the prior art pictures are:

- (i) The word LONDON is either presented on a straight or a curved axis.
- (ii) The word ENGLAND is smaller in comparison with LONDON in the registered design than it is in the brochure picture.

(iii) The font in the registered design is slightly different to the fonts used in the prior art pictures.

60. These differences are slight, certainly in comparison with the very pronounced similarities. Although attention to detail matters, “minute scrutiny by the informed user is not the right approach”. These differences border on the forensic because the overwhelming overall impression is the same. The registered design does not have individual character because it does not create a different overall impression compared to the prior art, which shows earlier designs made available to the public before the relevant date.

Outcome for 4020237

61. The registration of the design is invalid because, at the date of application, it was not new and/or lacked individual character.

Overall outcome

62. Registered designs 4020104, 4020066 and 4020237 are hereby declared invalid.

63. The application for invalidation of 4025695 fails. This design remains registered.

Costs

64. Mr Tanveer has been largely successful and is entitled to a contribution to his costs. Although the registrar has a wide discretion in relation to costs, he nevertheless works from a published scale (Tribunal Practice Notice 4/2007). I mention here a Case Management Conference (“CMC”) which I held on 10 June 2015. The CMC was held because Mr Erol disputed whether Mr Tanveer had posted his evidence to him at the time it was filed at the Registry. Mr Erol contended that the application should be struck out for want of evidence (because it had not been sent to him at the time it was filed, rule 16(4)(b) of The Registered Designs Rules 2006). My decision, given by letter on 12 June 2016, is reproduced below:

“You claim that the applicants’ attempts to prove that they posted the evidence to you by recorded delivery do not stand up because there is no receipt provided by Royal Mail. They responded that they have a system installed by Royal Mail whereby a postman collects parcels and documents and that they did post their evidence to you.

I am of the view that, whether or not the applicants did in fact send to you their evidence, as was required, there is a public interest in allowing these proceedings to continue so that the substantive issue may be decided. There have been several rounds of litigation in the Registry, and the parties have also met in IPEC. To avoid a multiplicity of proceedings and to keep a sense of proportion in this case, I do not intend to strike out the application on the technical point you raise. You are in possession of the evidence because the

Registry has sent it to you. Therefore, in exercising discretion via rule 19(3), I will allow the Registry's decision to admit the applicants' evidence to stand.

You now have two months from the date of this letter to file evidence and/or submissions. If evidence is filed, the applicants will have a month to say whether they wish to file evidence in reply; if they do, they will then have a further month to file that evidence. All parties are reminded that evidence should be properly paginated and must be filed on time and sent to the other side at the same time as it is sent to the Registry."

65. I asked Mr Tanveer at the conclusion of the main hearing whether, if he was successful, he wished to be awarded costs on the scale. The reply was that no costs were sought:

"We have no costs at all, please. We do not want to claim any costs. If we lose we pay that, but if we win we do not want to charge anything".

66. Bearing in mind that Mr Tanveer was the majority winner, and also successful in the CMC, but has waived his right to claim costs in his favour, it does not seem equitable to expect him to pay Mr Erol in respect of his minority success. In the circumstances, I award no costs to either party.

Dated this 23rd day of March 2016

**Judi Pike
For the Registrar,
The Comptroller-General**