

1 **REGISTERED DESIGNS ACT 1949 (as amended)**

In the matter of application under

Section 11(2) by Spice Girls Ltd

for cancellation of Registered Designs Nos 2068328, 2068329, 2068330, 2068331 & 2068332

6 in the name of Girl Power Toys Ltd

**DECISION**

The designs in suit were registered on 14.8.97. The statement of Article in each case is

11 “Figure”. The designs were registered on the understanding that the five Spice Girls had given their consent to these products, as the designs consist of “figures” which embody images of the Spice Girls, a very well known group of popular entertainers.

The statement of novelty in each case is as follows:

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"The features of the design for which novelty is claimed reside in the shape and configuration applied to the article as shown in the representations".

Representations of the registered designs are shown at Appendices 1 - 5.

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Applications for cancellation were filed on 23.6.98 by Spice Girls Ltd under Section 11(2) of the Registered Designs Act 1949 (as amended), on the grounds that the designs lacked

novelty under Section 1(2) of the Act as they embody the identities and images of well-known individuals in the public domain and also that the Spice Girls have not granted permission for the registration of the designs, with reference being made to Rule 25 of the Registered Designs Rules 1995.

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."

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.

Rule 25 of the Registered Designs Rules 1995 states:

“Where the name or portrait of a living person appears on a design, the registrar shall be furnished, if he so requires, with consent from such person before proceeding to register the design and, in the case of a person recently dead, the Registrar may call for consent from his personal representative before proceeding with the registration of

a design on which the name or portrait of the deceased person appears.”

51 The proprietors filed a counterstatement under Rule 53 on 27.8.98, claiming that Section 1(2) was irrelevant in the light of Saunders V Wiel (1893)10RPC, that the designs were the result of skill and labour on the part of the designer rather than a slavish copy of anything/anyone, and denying that consent was needed. They also contended that Rule 25 makes no provision for refusing registration even if consent is not given.

56 Following a change of agent, a request was made by the applicant to submit a clarified version of the statement. The proprietors agreed to this on the understanding that they would be able to respond with a further counterstatement. The clarified statement was submitted on 11.2.99. This restated the claims made in the original statement and added that the registered designs are the same as or only differ in immaterial details from designs which had been published by being made known to the then merchandising agent of Spice Girls Ltd on or about 28<sup>th</sup> July  
61 1997.

66 The proprietors failed to respond with a further counterstatement despite extensions of time being granted. Both agents had indicated that the parties were likely to reach a mutual agreement, but more recently the agents for the proprietors have stated that they were receiving no instructions from the proprietors and were therefore unable to respond with a counterstatement. On 20.7.99, both parties were advised that as no counterstatement had been submitted, the Registrar would decide the case based on the papers which have been provided to date.

71 Although the proprietors have failed to respond to the clarified counterstatement, I have not regarded the applications for cancellation as undefended and have given full consideration to the points raised in the original counterstatement.

76 Firstly, I will consider the arguments relating to novelty under Section 1(2) and (4) of the Act. The applicants argue that as the designs embody the identities and images of well known individuals they were not new at the date of application. However, it is established that prior publication must consist of a design as defined in Section 1(1) of the Act. i.e. features of shape, configuration, pattern or ornament applied to an article by an industrial process, being features which in the finished article appeal to and are judged by the eye.

81 The agent for the proprietors drew attention to *Saunders V Wiel* (1893) 10RPC 29 in which Lindley L J states:

86 “The proprietors go by steps and say the Abbey is not a design within the meaning of this Act of Parliament. In one sense, of course, it is a very valuable design. If an architect was thinking about building an Abbey, having Westminster Abbey before him, it would be a very valuable design: but it is not a design within Section 60 until you come to apply it as a design to some article of manufacture, and, therefore, you cannot say that abstractly, and as a general proposition, Westminster Abbey is a design. Then [the defendant] says “well, but the photograph is”. The answer is the same. No, the photograph is not: until you apply it to something the photograph is not a design within the meaning of this Act...”

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This decision was followed in *Dean's Rag Book Co Ltd v Pomerantz & Sons* (1930) 47RPC 485 where a registration for a design of a Mickey Mouse doll was allowed notwithstanding that the shape of Mickey Mouse was well known from earlier cartoons.

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In my view, images or photographs of individual persons are not a design until they are applied to some article of manufacture. Accordingly, the applicant does not succeed on this argument.

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Turning to the applicants second argument under Section 1(2) and (4), their statement that designs identical or only differing in immaterial details from the registered designs were published on or about 28<sup>th</sup> July 1997 i.e. prior to the date the registered designs were applied for, is not contested by the proprietors. Accordingly, the application for cancellation is successful.

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While the application for cancellation succeeds under Section 1 (2) and (4) of the Act on the grounds that the design are not new, for the sake of completeness I go on to consider the arguments relating to the Spice Girls' lack of consent to the registration of the designs.

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The Registrar did not utilise Rule 25 of the Registered Designs Rules 1995 during the examination of the applications but I am aware that this was only due to the fact that the examiner was mistakenly informed by representatives of the proprietors that permission for the registrations had been given by the Spice Girls. This incorrect information was critical to the examiner's decision to allow the designs to proceed to registration. In the circumstances, it is

116 my view that if the Registrar had not been misinformed on this issue, the application would have  
been refused under Section 3(5) of the Act, which states:

121 “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.”

Accordingly, the applicants also succeed on this ground.

126 In this decision I have considered all the evidence filed by both parties and have decided that the  
applications for cancellation of the designs should be allowed as the designs do not meet the  
requirements of Section 1 (2) and (4) of the Act and also that they should properly have been  
refused by the Registrar under Section 3(5) of the Act.

131 The registrations are hereby cancelled under Section 11(2).

Dated this 16<sup>th</sup> day of August 1999.

136 J MacGILLIVRAY

Head of Designs, acting for the Comptroller