

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

In the matter of application under
Section 11(2) by Crystal Canopies Ltd
for cancellation of Registered Design No. 2068265
6 in the name of Tempest Shield Fibreglass Roofing Ltd

DECISION

The design in suit was registered on 13th August 1997 and the article in respect of which the
11 design is registered is “a canopy bracket”. The proprietor is Tempest Shield Fibreglass Roofing
Ltd.

The statement of novelty is as follows:

16 "The novelty resides in the shape and configuration of that part coloured blue shown
in the representation."

Representations of the registered design are shown at Appendix One.

21 An application for cancellation was filed on 10th December 1997 by Crystal Canopies Ltd under
Section 11(2) of the Registered Designs Act 1949 (as amended), on the grounds that the design
was not new at the date of registration, and also on lack of entitlement, by virtue of the

discretion vested in the Registrar by Section 3(5) of the Act.

26 In support of these claims the applicant provided copies of several photographs of canopy installations and magazine advertisements for canopies which pre-dated the application. Furthermore, they stated that Crystal Canopies registration 2063416 (registered on 20th February 1997) was for the same article and that no rights in this design had been transferred to Tempest Shield.

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Representations of design 2063416 appear at Appendix Two.

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

36 "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
41 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.

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Section 3(5) states:

51 “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.”

56 The proprietors filed a counterstatement under Rule 53 on 2nd March 1998. Cancellation was opposed on the grounds that the design was new at the date of application and that novelty was restricted to the part coloured blue, which did not appear in the applicant’s design 2063416. It was also claimed that all rights in the design had been assigned to Tempest Shield by the designer, Mr Daniel (Don) Templeton, (who also designed 2063416). While it was admitted that Mr Templeton was at the time a director of Crystal Canopies, it is stated that he was not an employee and did not assign the rights to the applicant.

61 The applicant filed evidence under Rule 54 on 11th May 1998, in the form of an Affidavit by Mr Douglas Martyn of Crystal Canopies. Mr Martyn states that he is the designer of the article registered as 2068265, including the “infill arch feature” in which novelty is claimed. He also claims that Tempest Shield altered advertisements for Crystal Canopies design 2063416 by blocking out the Crystal Canopies name, and that Mr Daniel (Don) Templeton of Tempest Shield (a former director of Crystal Canopies) obtained brackets from suppliers under false pretences and modified them by adding a piece with the appearance of an infill arch. He states that Mr Templeton made no contribution to the design.

71 The proprietor submitted Rule 55(1) evidence on 14th July 1998, in the form of two Statutory
Declarations by Mr Daniel Templeton and Statutory Declarations from Mr Alex Callachan of
Fixings Direct, Mr Joe Wright (an engineering consultant) and Mr Robin Marlin of GRP
Canopies. Mr Templeton claims to be the author of both designs 2068265 and 2063416 and the
Declarations of Messrs. Callachan, Wright and Marlin support him in this claim.

76 The applicant then filed evidence under Rule 55(2) on 8th January 1999, in the form of a
Statutory Declaration by Mr Douglas Martyn, supported by Statutory Declarations from Mr
Alistair Mack of Crystal Canopies, Mr Adam Thompson of Fereneze Glassfibre Products and
Mr George Dunn of Fereneze Glassfibre Products. Mr Martyn states that he is the designer
of the article registered as 2063416, and that Mr Templeton was an employee of Crystal
81 Canopies and therefore, he claims, not entitled to register the design 2068265 which was in any
case too close to 2063416.

The parties have decided that they do not wish to attend a formal hearing and it was agreed
with both agents that decisions on this case and Cancellation Application 5/98 (for the
86 cancellation of 2063416), would be taken on the papers submitted.

Firstly, I will consider the arguments relating to novelty under Sections 1(2) and (4) of the
Act.

91 The applicant argues that novelty is prejudiced by prior application 2063416 dated 20th
February 1997 in the name of Crystal Canopies Ltd.

Section 1(4) of the Act states:

“A design shall not be regarded as new for the purposes of this Act if it is the same as a design -

96 (a) registered in respect of the same or any other article in pursuance of a prior application, or

(b) published in the United Kingdom in respect of the same or any other article before the date of the application,

101 or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.”

In considering the respective arguments relating to Section 1(4)(a) I have borne in mind that the representations of the design and the alleged prior art must be viewed through the eye of a notional customer which, in this case, not only involves the trade, but ordinary members of the public ordering a canopy to be fitted at their homes. Thus the end customer is not necessarily an expert nor a specialist in the field.

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The two designs are not identical, but it is accepted that the prior art will be fatal to the registration if the differences only relate to immaterial details or to features which are common trade variants.

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Both designs consist of articles which have the same function (supporting a canopy roof section attached to the outside of a building) and they utilise a general “wedge” shape common to such articles. In such a close field of goods it is necessary to consider the features which are

116 important for design purposes and in this particular case I must pay regard to the fact that the proprietor's statement of novelty is limited to "the shape and configuration of that part coloured blue in the representation" ie. the so-called infill arch feature at the free end of the bracket.

121 In consideration of my decision I am guided by the comments of Laddie J in the matter of Household Article Ltd's Registered Design No 2044802 (1995 FSR 685 -686), paras 26 and 27):

126 "The purpose of s.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
131 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.

136 The words "commonly used" in s.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 emphasised, any design made up solely by blending together known design features
141 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
146 novelty-destroying.”

Registered designs are concerned with appeal to the eye. My first impression on seeing the designs was that despite the obvious similarity between them, there were equally obvious differences - notably the ribs and the arched feature at the free end of the bracket in the design
151 in suit, this latter feature being that in which novelty is claimed. When I compared the designs again at a later time, my opinion did not alter. To qualify for design registration a design is not required to possess striking novelty and there are many precedents to show that a design can be legitimately registered even where there is quite close prior art - this is particularly true of designs in such a close field as the ones in question.

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In my view the applicant for cancellation has not demonstrated that the differences in the designs are features which are common trade variants. The differences in the respective designs are not considerable but given the nature of the articles, they are significant enough to give the registered design a different overall impression from and novelty over the prior art.

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In considering the arguments relating to Section 1(4)(b) I have examined the copies of photographs purporting to show publication of the registered design prior to the date of application. In my view these photographs, while showing canopies with support brackets, are too indistinct to prove prior publication of the design in suit.

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I have therefore decided that the design in suit meets the requirements of Sections 1(2) and (4) of the Act.

Turning to the claim regarding ownership and the request for the Registrar to exercise discretion under Section 3(5), I have considered the evidence provided by Mr Martyn and Mr Templeton, both of whom claim to be the author of the design, and the evidence provided by witnesses to support their claims. However, this evidence is totally contradictory and in my view inconclusive.

176 Section 3(5) allows for registration to be refused, or allowed subject to such modifications as the Registrar thinks fit. The Registrar clearly has discretion to refuse registration (or cancel an existing registration) if it can be proved that the requirements of Section 1(2) have not been met - in particular if it appears to the Registrar on the clearest evidence that the person in whose name the design is registered is not the proprietor as he claims to be. However, where
181 there is merely doubt about the claim made by the applicant, or where the Registrar must choose between two competing claims of equal weight, it seems to me that the benefit of a decision should in all equity go to the proprietor.

186 I therefore find that there are insufficient grounds to cancel or modify the registration by
exercising discretion under Section 3(5).

The application to cancel this registration under Section 11(2) is hereby refused.

Dated this 13th day of September 1999.

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J MacGILLIVRAY

Head of Designs, acting for the Comptroller