

O-027-07

AN APPLICATION BY PAULINE ANN WALTON
UNDER SECTION 11ZB OF THE REGISTERED DESIGNS ACT 1949 (AS
AMENDED)
FOR THE INVALIDATION OF UK REGISTERED DESIGN No. 3022471
IN THE NAME OF ZAP LIMITED

Background

1. On 7 September 2005, Zap Limited (Zap) applied under the Registered Designs Act 1949 (as amended) to register a design for a poncho. The design was entered into the register on 29 November 2005.
2. A copy of the representations of the registered design is at Annex A to this decision.
3. On 11 January 2006, Pauline Ann Walton filed an application under Section 11ZB of the Act to invalidate the registered design on the ground that at the date of the application for registration the design was not new and/or it had no individual character as compared to certain other known designs for ponchos.
4. Mrs Walton is the proprietor of earlier UK design registrations 3003615 (applied for on 15 May 2002) and 3006713 (applied for on 4 September 2002), and earlier registered Community design no. 3250-0001 (applied for on 1 April 2003). Copies of the representations of these registered designs are attached as Annexes B-D.
5. The applicant calls these designs, collectively, the Towcho design. Mrs Walton claims that Zap's registered design differs only in immaterial respects from these earlier designs. In that connection, Mrs Walton provides a page from a catalogue called M & G, which appears to have circulated in the UK in the summer of 2004. Mrs Walton points out that the ponchos shown in that catalogue were a modified form of her design but with a different shape of neck and/or hem.
6. Mrs Walton points out that Zap had licensed her design in the past and sold ponchos under a design licence from her bearing various images licensed from third parties. In particular, in June 2004 Zap promoted a number of ponchos in the UK, one of which carried surface decoration characteristic of an England football shirt, including the badge of the Football Association. A copy of this design is attached at Annex E.
7. The registered proprietor resists the application for invalidity.

The Facts

8. In addition to providing details of her earlier design registrations, Mrs Walton submitted two witness statements, the first dated 14 May 2006 and the second dated 1 July 2006.
9. The registered proprietor also submitted evidence in the form of a witness statement by John Peter Duckworth, who is a Director of Zap.
10. Mrs Walton states that Zap became the second licensee of her Towcho design in 2002. By February 2003 ponchos corresponding to Mrs Walton's design had been shown at an exhibition at Earls Court and offered for sale in a brochure. A copy of the brochure is re-produced as exhibit E to Mrs Walton's first witness statement.

11. The designs shown in this brochure appear to differ from UK registered design No. 3006713 in that the corners of the poncho are rounded off rather than having sharp 90 degree corners as in the registered design, and the neck aperture seems wider than the relatively short slit shown in the representation of the registered design. The modified design appears to reflect the shape and configuration of Mrs Walton other UK registered design, No 3003615, although that design is registered in a particular shade of blue and does not have the contrasting coloured hem featured in the design shown in exhibit E.

12. The modified design appears to correspond with the second of four representations of Community registered design No. 3520-001. Oddly, the first and third representations of the Community design appear to disclose a strictly rectangular shape of poncho corresponding to UK registered design No. 3006713. The Community design registration therefore appears to be made up of representations of both the original design and of the modified design. Like UK design registration No 3006713, colour forms no part of the Community design registration.

13. Mrs Walton's second witness statement provides some explanation for the difference between the designs. She says that:

“The basic pattern has squared edges before manufacture, but the manufactured/worn effect is of rounded edges. This is not to say that square edges are precluded.”

14. I do not understand how a poncho with 90 degree corners can look like one with rounded corners when worn. I therefore understand this to mean only that the products produced according to Mrs Walton's registered designs have a basically rectangular shape, but with the corners rounded off.

15. Mr Duckworth points out that a rectangular shaped poncho design is not new. He says that they have existed in the same basic shape as shown in the representations of Mrs Walton's registrations for many years. In this connection, he draws attention to a number of earlier poncho designs. The most relevant of these appears to me to be the ponchos worn by the actor Clint Eastwood in the so-called “spaghetti westerns” series of films which became popular in the UK in the 1960s. Exhibit JD3C to Mr Duckworth's witness statement consists of some still photographs from those films, which show the character played by Clint Eastwood wearing a poncho of an apparently rectangular shape with an oval neck aperture.

16. On 17 May and 28 June 2005, Zap sent Mrs Walton e-mails containing an impression and then a representation of a new poncho design. These are shown as exhibits A and B to Mrs Walton's first witness statement. The shape and contours of this poncho correspond to those shown in the second representation of the Community design (a basically rectangular shape but with rounded off corners and an oval opening for the neck) and the existence of the Community design registration is acknowledged. The surface decoration shown on the poncho is characteristic of an England football shirt, including the badge of the Football Association. Mr Duckworth says that the surface decoration was produced under licence from the Football Association. The poncho shown in exhibit A is based upon the 2004 version of the official England football shirt, but it contains further representations which

appear to disclose aspects of the design for the official 2006 shirt. The poncho design shown in exhibit B carries surface decoration which appears to reflect the design of the official 2006 England football shirt.

17. Mrs Walton claims that the design in exhibit B was sent to her for approval, which she gave on 29 June 2005. Mr Duckworth states that the designs shown in these exhibits were created by Zap and sent to Mrs Walton in confidence. He does not deny that the reason that these designs were sent to her was that she was the owner of the registered design which covered the shape and contours of the poncho depicted in the exhibits and that her agreement to use that design was being sought.

18. Mrs Walton denies that the designs shown in exhibits A and B were shown to her in confidence. She claims that she was assured that there was no requirement for confidentiality and that, as a result, she showed these designs to all her friends (but she does not say when she did this or identify the people in question).

19. Towards the end of 2004 Mrs Walton became aware that Zap wanted to reduce its product costs in order to maintain its competitiveness. By early August 2005 the relationship between the parties had soured and Zap gave Mrs Walton 90 days notice of the ending of their licence agreement. Mrs Walton claims that Zap told her at the time that the England Towcho design had been dropped.

20. Mrs Walton points out that the surface decoration on Zap's registered design corresponds with the 2006 England football strip, which she notes is highly desirable. She says that this version of the England football strip was made public by the Football Association in March 2005, prior to the registration of the Zap design in September of that year. Exhibit G to her first witness statement bears this out. It consists of a copy of a page from a web site entitled MyVillage.com which records the unveiling of the 2006 England football strip at a hotel in Manchester in March 2005. Mrs Walton says that the surface decoration on the Zap design was therefore not new when the design was registered, and that Zap was neither the designer nor the proprietor of that aspect of the registered design.

21. Mrs Walton provides (as exhibit H) a page from a catalogue called Express Gifts Limited, which features a poncho produced according to Zap's registered design alongside another poncho produced according to a version of Mrs Walton's earlier designs (the modified design with rounded off corners). Mrs Walton claims that the co-placement of these designs in the catalogue shows that the retailer considered them to be sibling designs. They are both described as towel ponchos. According to Mr Duckworth, this catalogue was not produced until "late Autumn 2005", i.e. after the relevant date. This is not disputed. The only purpose the entry in the catalogue serves is therefore to illustrate how the designs may appear in use.

22. In January 2006 Mrs Walton received the Gratton Spring/Summer catalogue. It featured a poncho corresponding to the shape shown in the second representation of Mrs Walton's registered Community design (the modified design) and carried surface decoration based on the 2006 England football shirt. The design corresponds with the "impression" for a new design sent by Zap to Mrs Walton in May 2005. Mrs Walton says that she ordered one and received a poncho of the shape shown in the catalogue (i.e. her design), but bearing surface decoration based on the 2004 version of the

England football shirt. Mrs Walton says that she spoke to Grattan (she does not name the person she spoke to) who told her that no-one else had complained and that the buyer had not noticed the difference.

The Applicable Legislation

23. The relevant parts of Section 11ZA of the Act are as follows:

- (1) The registration of a design may be declared invalid
 - (a) on the ground that it does not fulfil the requirements of section 1(2) of this Act
 - (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act
 - (c) where any ground of refusal mentioned in Schedule A1 to this Act applies.

(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which –

- (a) has been made available to the public on or after the relevant date; but
- (b) is protected from a date prior to the relevant date by virtue of registration under this Act or the Community Design Regulation or an application for such registration.

(1B) In subsection 1A “the relevant date” means the date on which the application for the registration of the later 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.

(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.

24. Section 1B of the Act provides that:

- (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 or no 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.

25. Section 11ZB (insofar as it is relevant) provides that:

- (1) Any person may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.
- (2) –
- (3) –

(4) –

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that section.

(6) –

The Hearing

26. At the hearing, which was held on 26 October 2006, the applicant for invalidation, Pauline Ann Walton, represented herself. The registered proprietor was represented by Mr Hodgkinson of Marks and Clerk, Patent and Trade Mark Attorneys.

Extension of the Pleadings

27. The evidence filed by Mrs Walton seeks to introduce an additional ground for invalidation; that Zap is not the owner of the registered design. As I understood it, there were two legs to this claim. Firstly, that Zap is not the owner of the design for the shape and contours of its registered design because Mrs Walton is. Secondly, that Zap is not the owner of the design for the surface decoration shown in its registered design because the Football Association is.

28. Mrs Walton represented herself in this matter and this explains why no formal application was made to amend the grounds for invalidation prior to the hearing.

29. In the circumstances I felt it appropriate to point out to Mrs Walton that a) the claim about ownership could be not be considered in the absence of an application to amend the grounds for invalidation, and b) such an application could be made at any time, but c) it did not follow that such an application would automatically be accepted.

30. Mr Hodgkinson on behalf of Zap objected to any amendment of the grounds because of a) the lateness of the request, and b) it would lead to an adjournment of the hearing and an extension of the proceedings in order for his client to file evidence directed to the ownership of the design.

31. Mr Hodgkinson was plainly correct in submitting that, if allowed, the application for amendment would require an adjournment in order for the proprietor to be permitted to file further evidence. Adjournment and delay can be a form of prejudice to the party affected by it. Accordingly, there must be a persuasive reason why the registrar's discretion should be exercised in order to permit an amendment that is likely to require an adjournment of the hearing.

32. As far as Mrs Walton's own claim of ownership of the Zap design was concerned, this appeared to me to be just another way of expressing her existing claim that the Zap design is not new because it creates the same overall impression as her earlier designs. A finding that the respective designs do create the same overall impression would lead to invalidation under the original ground of attack. On the other hand, a finding that the Zap design creates a different overall impression to Mrs Walton's

earlier designs would be bound to defeat any claim that she was the owner of the Zap design. In the circumstances, I decided that there was no sufficient reason why this claim of ownership should be permitted to be added as a further ground for invalidation at such a late stage in the proceedings.

33. By contrast, the claim that the Football Association is at least a co-owner of Zap's registered design appeared to me to be a matter which was clearly distinct from the existing ground for invalidation. Further (and without pre-judging the matter) the claim appears to be at least arguable. However, as Mr Hodgkinson pointed out, s.11ZA(2) and s.11ZB(5) preclude the matter of ownership of a registered design from being raised in invalidity proceedings by anyone other than the proprietor (which I think must include a co-proprietor) of the design. Consequently, it was not open to Mrs Walton to ask for the registration to be declared invalid on the ground that a third party part owned the registered design. I accordingly refused to permit this issue to be added as a further ground of invalidation because Mrs Walton did not have the necessary standing to raise the matter.

Was the Zap Design New and did it have Individual Character at the Relevant Date?

34. The relevant date is the date of the application for registration: 7 September 2005.

35. The application for registered design No. 3003615 was made on 15 May 2002. The application for registered design No. 3006713 was made on 4 September 2002, and the application for registered Community design No. 3250-0001 was made on 1 April 2003. Accordingly, Mrs Walton's registered designs were all in the public domain prior to the application to register the Zap design and, in principle, fall within the ambit of section 11ZA(1)(b).

36. I now turn to a comparison of these respective registered designs. The comparison must be made through the eyes of "the informed user." In assessing the attributes of such a person I am guided by the comments of Judge Fysh Q.C. in the Patents County Court in the *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

"First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the articles and both counsel roundly rejected the candidature of "the man in the street". "Informed" to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of "what's about in the market?" and "what's been about in the recent past?". I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any). In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies

reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

37. I note that this approach to the matter was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch).

The Registered Designs

38. I indicated at the conclusion of the hearing that I did not find any of Mrs Walton’s earlier registered designs to be identical to the Zap design or to create the same overall impression as that design from the perspective of an informed user. These are the reasons why.

39. UK Registered design No.3006713 comprises the shape and configuration of poncho. It is a very simple design indeed. Just a rectangle of material, bound at the edges, and with a narrow transverse slit half way up the length of the cloth for the user to pop his or her head through. By contrast the Zap design, although basically rectangular, has the corners of the rectangle shaved off so that it is strictly octagonal. Further, the neck is triangular rather than the straight slit of Mrs Walton’s registered design. It is true that the Zap design, like the earlier design, conveys the impression of bound edges. Apart from the basically rectangular shape, that is really the only real feature that the designs have in common. The material from which the ponchos are made is not a feature of either design and the fact that they are towelling ponchos is therefore irrelevant.

40. Mrs Walton advised me at the hearing that a rectangular shape had certain benefits when it came to adding printed surface decoration, but I do not suppose that even an informed user would be aware of that. Nevertheless, I believe that an informed user would be aware that there is limited freedom to design a poncho which is not basically square or rectangular in shape. All of the ponchos shown in the prior art exhibited to Mr Duckworth’s witness statement take one of these shapes.

41. It is true that none of these ponchos (with the possible exception of part of the last poncho shown in exhibit JD3D) give the impression of bound or seamed edges. Fringed or tasselled edging appears to be more common. However, bound or seamed edges are certainly not new and are common features of related products such as blankets. I do not therefore regard the commonality of this feature as being sufficient to create a similar overall impression to the Zap design in the eyes of an informed user of such products when balanced against the differences to the basic shape of the poncho design and the noticeably different neck designs.

42. Mr Hodgkinson submitted that the Zap design differed further in that it included surface decoration based around the official 2006 England football shirt. Mrs Walton’s earlier registered design No.3006713 consists of monochrome line drawings of a poncho design. This form of registered design protects only the shape and contours of the product (confirmed in paragraph 27 of the *Procter and Gamble v Reckitt Benckiser* judgment cited above). The absence of surface decoration in Mrs Walton’s registered design is not therefore a positive feature of that design.

Consequently, another design taking the same shape and contours as that registered design would remain identical in all material respects to the registered design, even if it included surface decoration. I did not therefore take account of the addition of surface decoration in the Zap design in reaching my conclusion that the shape and configuration of the Zap design would create a different overall impression on an informed user than registered design No.3006713.

43. The second earlier UK registered design relied upon is No.3003615. The design is registered in a colour blue. Everything that is shown in a registered design (unless disclaimed in some way) forms part of the protected subject matter. Accordingly, the colour blue is to be taken as part of the subject matter of registration No.3003615. The Zap design manifestly does not take the colour blue and to that extent the Zap design is further distinguished from this prior art. Against that it could fairly be said that the apparently rounded off corners of the prior registered design create a closer resemblance in use to the basic shape of the Zap design with its shaved off corners, as compared to the impression that would be created by the strictly rectangular shape of Mrs Walton's other UK registered design. Nevertheless, I take the view that when combined with the more obvious difference in the neck designs, a different overall impression would be made on an informed user of this sort of product. Again, I bear in mind that such a user would be aware of the limitations in design freedom when it comes to the basic shape of a poncho and consequently would pay more attention to similarities and differences in the other features of the design.

44. Mrs Walton invited me to infer that the person responsible for the Studio Catalogue (exhibit H to her written evidence), which she thought must be an informed user, must have considered that the poncho produced accordingly to the shape and contours of her design was a sibling of the poncho produced according to the Zap design. This is because the ponchos were shown next to each other on the same page of the catalogue, and offered for sale at the same price. I am not convinced that the person responsible for the layout of products in the catalogue would necessarily be an informed user of ponchos. That person is liable to be responsible for the marketing of a wide range of products. There is nothing to suggest that the person concerned would have been informed as to the field of designs for ponchos. In any event, it seems to me that the only inference that can safely be drawn from the catalogue is that the person responsible thought that the respective ponchos were comparable products. But that might have been because of a range of factors other than design. For example, it is clear from the written descriptions of the goods (but not to the eye) that the ponchos were both made from a towel-like material. And it is clear from the pictures that the products were of a size suitable for children. In my view, all this shows is that the products were thought to be aimed at the same market.

45. As I noted earlier, the Community design registration appears to consist of a mixture of the two national designs, but without colour. Even assuming that it protects a basically rectangular shape poncho, but with rounded corners (contrary to two of the representations of the registered design), for the reasons given in the preceding paragraph, I concluded that this design would also create a different overall impression to the Zap design on the relevant user.

The Other Prior Art

46. Mr Hodkinson assessed that Mrs Walton's best case lay with the prior publication in the UK of an unregistered design published in the UK in June 2004. I agree. This design corresponds with the shape and contours for a poncho shown in one of the representations of Mrs Walton's earlier registered Community design (the modified design with rounded off corners). The design in question bore surface decoration based on the official 2004 England football shirt. It seems to me that, in principle, the limited similarity between the shape and contours of the prior art and that of the Zap design could be enhanced by similarities between the surface decoration in the respective designs so that the overall impression created by the earlier design, when taken as a whole, is the same as that of the Zap design.

47. Mr Hodkinson submitted that an informed user of ponchos bearing reproductions of the England football strip would be a person who was interested in showing his or her allegiance to the England team. Such a user would be quick to notice the differences between the 2004 England shirt and the 2006 version. Mrs Walton argued that the relevant user was someone who wanted to buy a poncho for a child or person with an interest in football. Such a user may be much less aware of the differences between one England shirt and another.

48. The differences between the 2004 England shirt design and the 2006 design, when adapted and applied to the ponchos in question are quite significant. Both designs have a white background and are edged in blue. The old design has drawn onto it (and again edged in blue) a conventional shirt-like collar. Above that runs a thick blue line which extends up to the slit for the neck. Two thick red stripes run up the 'arms' of the poncho before merging into one and extending across the shoulders. The thick red stripes 'emerge' again from the gap between the drawn-on collars and merge together to form a ribbon-like arrangement from which the three lions badge of the Football Association 'hangs' like a medal. The thick red stripes are not a feature of the 2006 version. They are replaced by a single red cross which appears over the right shoulder of the wearer. It is made up of two thin crossed red lines which taper to points. The vertical line is longer than the horizontal line. Thus the overall effect resembles a star as much as a cross. The badge of the Football Association remains a part of the design, but is moved so that it appears on the left breast of the wearer.

49. The differences between these designs would, I think, create different overall impressions on even an average consumer of sports shirts. Indeed there is a whole industry in the sale of replica football garments which depends upon changes in design of this sort creating a different overall impression on consumers of products of this kind.

50. The position is likely to be a little different when it comes to the average consumer for a poncho, who I accept may be less likely to notice the differences between one England football shirt design and another. Nevertheless, I do not think that it would be right to approach the matter on the footing that, to this consumer, one England football shirt looks the same as any other provided that it is in the same colours and carries the badge of the Football Association. After all the consumer in question is likely to be purchasing the poncho because either they, or the person they are buying it for, has an interest in the English football team. They are therefore

unlikely to be wholly indifferent as to the whether the design reflects the latest strip or an earlier version. An informed user of ponchos decorated with a replica football strip should be taken to be aware of the practice of updating football strips. They are therefore more likely than an average consumer of ponchos to be alert to material differences in this aspect of the design.

51. In my judgment, the differences in the shape and contours of the Zap design as compared to the design disclosed in June 2004, combined with the differences between the surface decoration of the Zap design and those of the prior art, would create a different overall impression on such an informed user.

52. In support of her submission to the contrary, Mrs Walton pointed out that when she ordered a poncho from the Gratton's Spring/Summer 2006 catalogue, which was shown in the catalogue as bearing the 2006 England shirt strip, the product that she was sent bore the 2004 strip. Mrs Walton says that she spoke to Gratton about this and was told that the buyer didn't notice the difference and that no-one else had complained.

53. Whilst potentially important, I am reluctant to attach weight to this evidence because I regard it as unreliable. This is because 1) it is hearsay, 2) the person at Gratton to whom Mrs Walton spoke is not named, and 3) the description of the buyer's mistake therefore seems likely to be unattributable second hand hearsay.

54. In the light of the above analysis (which takes account of the differences between the shape and contours of the registered design and that of the prior art, as well as the difference in the respective surface decorations), I conclude that the ground for invalidation based upon the unregistered 2004 prior art also fails.

55. This leads me on to consider the point brought out by Mrs Walton about the earlier disclosure of the 2006 England football strip. There are two aspects to this. Firstly, there is the disclosure of the official 2006 England football strip in March 2005. Secondly, there is the disclosure to Mrs Walton in May and June of 2005 of poncho designs of the shape and contours of her design bearing versions of the official 2006 England football shirt.

56. Neither disclosure disclosed the shape and contours of the Zap design.

57. The first disclosure did not disclose how the design for the 2006 England football shirt would be applied to ponchos. I do not therefore think that the first disclosure robbed the Zap design of its novelty.

58. The position with regard to the second disclosure is more arguable in this respect, but I do not think that it was a relevant disclosure for the following reasons.

59. The disclosure was made during the period of 12 months immediately preceding the relevant date. There is no dispute that Zap licensed designs for football kit from the Football Association. The sending of a poncho design to Mrs Walton bearing the 2006 England football strip in May and June of 2006 therefore appears to me to be a consequence of the action taken by the Football Association to licence Zap to apply

that design to ponchos. As such the disclosure falls within one or other of the exceptions listed in paragraphs b) or d) of section 1B(6).

60. The question of whether the design was shown to Mrs Walton in confidence, as Zap claims, or not, as Mrs Walton claims, falls to be determined on the balance of probability having regard to the surrounding facts. These facts do not compel one irresistibly to either conclusion but, on balance, I believe that they favour Zap. First, it must be borne in mind that the reason that Zap sent Mrs Walton this design was to seek her agreement to apply the surface decoration based on the England football shirt to ponchos of the shape protected by her designs. The starting point is therefore disclosure for the purpose of a commercial relationship between a licensor and a licensee. Ordinarily I think that Zap would have been entitled to expect that the information given to Mrs Walton in pursuit of their commercial relationship would not be used by her for any other purpose. And that would point to an implied condition of confidence.

61. The matter is less clear cut because by the time the design for the surface decoration of the poncho was sent to Mrs Walton, the design for 2006 England football shirt had been made public. What was not in the public domain was how Zap intended to adapt this design for the purpose of applying it to a poncho, and the very fact that Zap had commercial plans to market such a product. On balance, and in the absence of any corroborating evidence that Zap waived confidence, I find that the disclosure was made under at least an implied condition of confidence. Had it been necessary I would therefore have accepted that section 1B(6)(c) applied.

Conclusion

62. I find that the Zap design was new and had individual character at the relevant date. The application for invalidation therefore fails.

Costs

63. The registered proprietor has been successful. Accordingly, it is entitled to a contribution towards its costs. I therefore order the applicant for invalidation to pay the registered proprietor the sum of £900. This sum is to be paid within one month of the expiry of the appeal period.

Dated this 22nd day of January 2007

**ALLAN JAMES
For the Registrar**

ANNEX A



Poncho Front Image



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ANNEX A

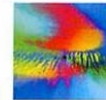
Poncho Back Image

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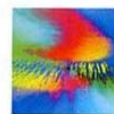
Poncho Full Image

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ANNEX A

View showing product in use

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* For illustrative purposes only



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ANNEX B

3003615

PAULINE ANN WALTON

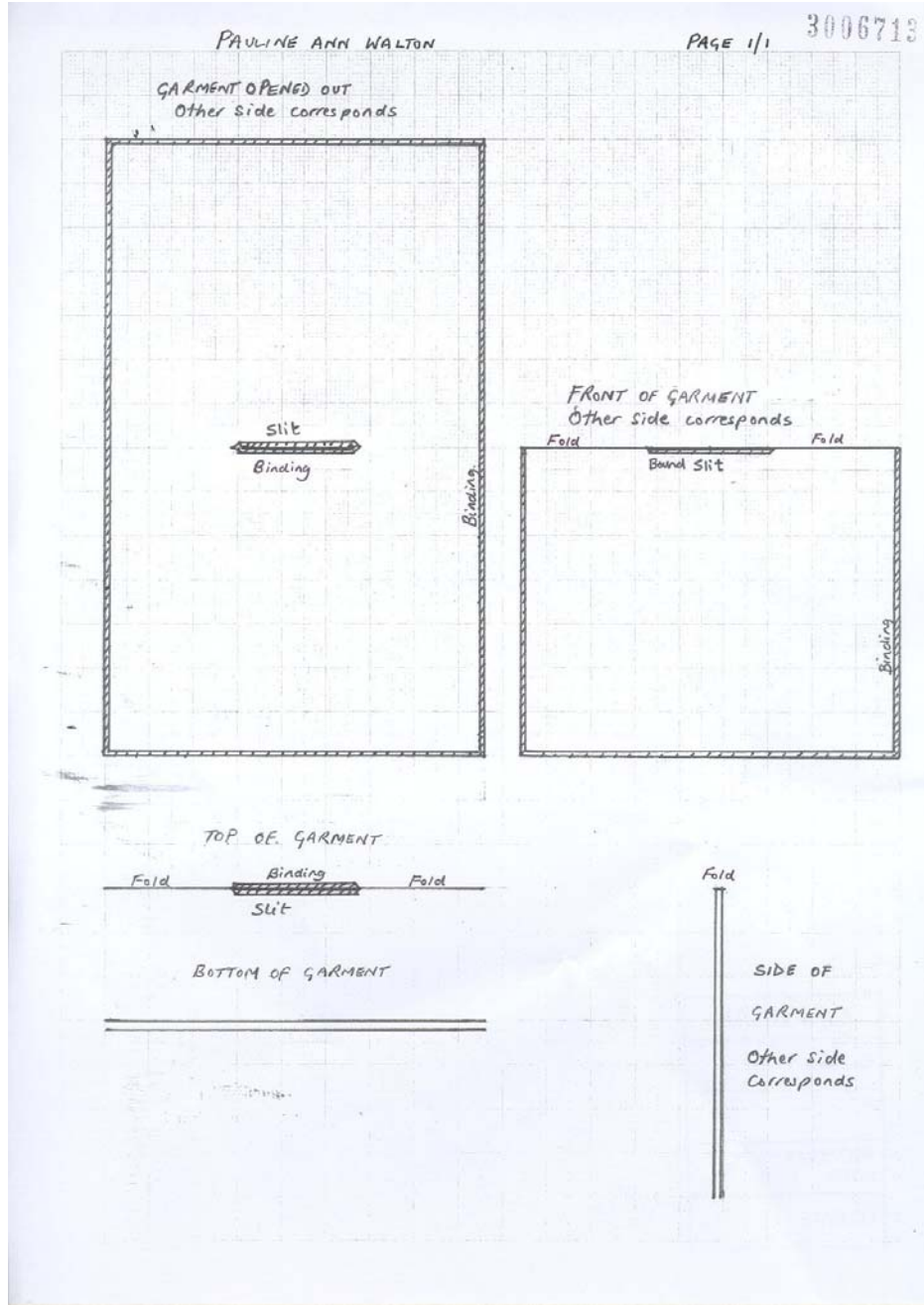
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FRONT VIEW

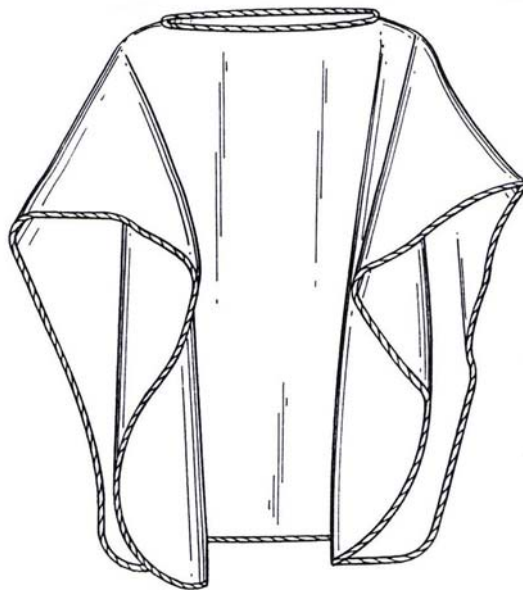
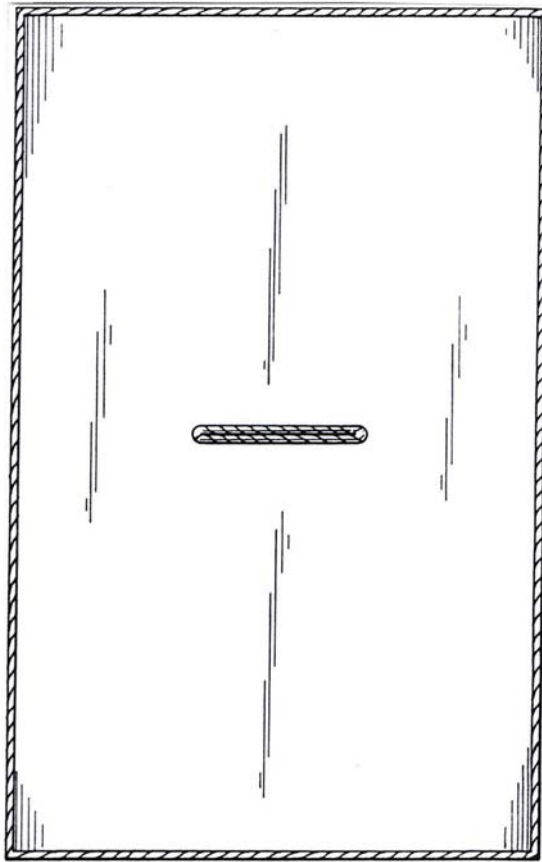


The view from the other side is the same

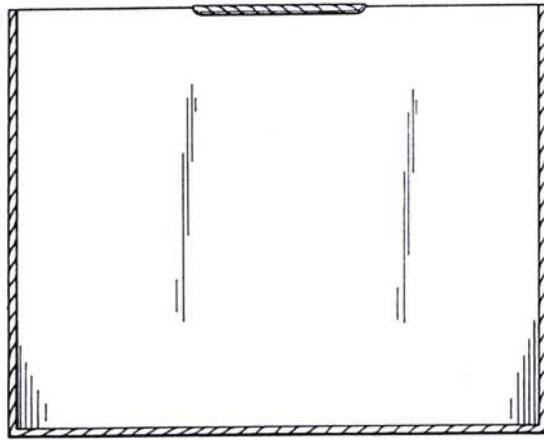
ANNEX C



ANNEX D



ANNEX D



ANNEX E

