

O/289/12

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

IN THE MATTER OF REGISTERED DESIGN NO 3017175

IN THE NAME OF JAMES KIERAN PADDEN

AND

A REQUEST TO INVALIDATE (NO. 37/09)

BY THE SECRETARY OF STATE FOR DEFENCE

THE BACKGROUND, CLAIMS AND PRELIMINARY MATTERS

1) The registered design the subject of these proceedings was filed by Mr James Kieran Padden on 20 April 2004. However, as the application did not contain the full fee, the application was given an effective filing date of 29 April 2004, being when the balance of fees were paid. The design is described as a badge and is depicted below:



Mr Padden's design was duly registered, the certificate of registration being granted on 18 August 2004.

2) The Secretary of State for Defence ("Defence") requests the invalidation of Mr Padden's design. Its claims are grounded on section 1B(1)¹ of the Registered Designs Act 1949 ("the Act") which relates to the requirement that registered designs must be novel in comparison to other designs that have been made available to the public. Defence refers to its own registered design (no. 3012265) which it claims has been made available to the public. The official records show that the design was filed on 22 April 2003 and its certificate of registration was granted on 13 May 2003. The design appeared in the relevant design journal on 4 June 2003. Defence's registered design is depicted below:



3) Defence also initially claimed under section 11ZA(3) of the Act on the ground that its earlier registered design constituted an earlier distinctive sign which would give rise to a right to prohibit the use of Mr Padden's design. The tribunal directed that this claim should be struck out as the existence of a registered design did not

¹ Which is relevant in invalidation proceedings due to the provisions of section 11ZA.

fall within the parameters of an “earlier distinctive sign” and, in reality, this second claim took matters no further forward than the first; Defence did not challenge this.

4) Mr Padden filed a counterstatement denying the claims. He states that the designs in question are neither identical nor does the later design lack individual character. Mr Padden also states that Defence’s design was produced and designed by him. He states that its publication [by way of the design journal] fell within the 12 month period preceding the relevant date and, consequently, such a disclosure falls within the exceptions contained in section 1B(6)(d) of the Act; this provision excludes disclosures on the basis that:

“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.”

5) Mr Padden also claimed that Defence’s design was itself invalid because he is the true proprietor of it. The tribunal advised Mr Padden that there was no provision in the Act/Rules to make counterclaims as to validity. He was advised that if his claim was to be pursued he would need to make an application for the invalidation of Defence’s registration; no such application was made.

6) In response to Mr Padden’s pleaded defence (that the disclosure was excluded under section 1B(6)(d)), Defence highlighted in its evidence that its design had been made available to the public in other ways and that such disclosures took place before the beginning of the 12 month period preceding the relevant date; the relevance of this is that the pleaded defence under section 1B(6)(d) cannot apply to such disclosures. I discussed this issue with the parties at a case-management conference along with other issues relating to evidence and the confidentiality of the names of various witnesses; the latter point is important because many of Defence’s witnesses have at one time been serving members of the Special Boat Service (“SBS”); it is a well known fact that such people benefit from a right to anonymity. I directed that the witnesses should be identified in the proceedings by way of an agreed list of pseudonyms in order that the papers on file did not breach this right to anonymity. From his evidence, it was clear that Mr Padden knew most of the witnesses in question so there was no real need to keep anything from him. I also directed that the proceedings be separated in order to deal with the disclosures claimed to have taken place before the start of the 12 month period preceding the relevant date. I did so for the following reasons:

- i) That if disclosures to the public had taken place before the start of the 12 month period preceding the relevant date then Mr Padden’s pleaded defence would not be operative.
- ii) That if the pleaded defence was not operative then the issues were more straightforward, all that would need to be determined was whether the

design had been publically disclosed and whether what was disclosed defeated the novelty in Mr Padden's design.

- iii) That proceeding in the above manner would mean that the contested evidence between the parties (as to who is the designer of Defence's design) would not need to be determined; if a determination was required then this would have required cross-examination of a number of witnesses in circumstances of confidentiality and anonymity.
- iv) That the separation of the proceedings would, therefore, represent, the most efficient way of handling the dispute.

7) Clearly, if the disclosures to the public claimed to have taken place before the start of the 12 month period preceding the relevant date does not resolve the proceedings, the tribunal will need to return (in another decision) to the other disclosures and to Mr Padden's defence under section 1B(6)(d).

THE LEGAL BACKGROUND

8) Section 1B of the Act 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) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –
- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
 - (b) to the extent that those visible features of the component part are in themselves new and have individual character.

- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.”

The relevant dates

9) The relevant date in these proceedings is 29 April 2004. The twelve month period immediately preceding the relevant date is 29 April 2003 to 28 April 2004. In view of the scope of this part of the separated proceedings, the only disclosures I am considering will be those made on or before 28 April 2003.

The approach to comparison

10) The approach to the comparison of designs was set out by the Court of Appeal in *Procter & Gamble Co. v Reckitt Benckizer (UK) Ltd* [2008] FSR 8. The key points are that:

- a) Where there are differences between the designs, the tribunal must assess the overall impressions created by the designs as wholes.
- b) In order to be valid, a registered design must create a clearly different visual impression from the prior art.
- c) The assessment should be made when the designs are carefully viewed through the eyes of an informed user of the article in question; imperfect recollection has little role to play.
- d) The informed user will be aware of which aspects of the design are functional when it comes to considering the overall impression it creates.
- e) Smaller differences are sufficient to create a different impression where the freedom for design is limited.
- f) The assessment should be made by comparing the impressions created by the designs at an appropriate (not too high) level of generality.

11) In terms of the legal principles, further guidance can be seen in the decision of Mr Justice Arnold in *Dyson Ltd v Vax Ltd* [2010] F.S.R. 39 (“*Dyson*”). Some of the key points from this are that:

- g) In terms of functional aspects, the fact that there may be another way of realizing the same technical function does not mean that that functional aspect contributes to the design characteristics, but, if that aspect has been designed for both its function and its aesthetic qualities then it may still play a part in the assessment.

h) In terms of design freedom, this 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). The more restricted a designer is, the more likely it is that small differences will be sufficient to produce a different overall impression on the informed user.

i) In terms of the existing design corpus, it is more likely that smaller differences will be sufficient to produce a different overall impression on the informed user when the prior art and registered design are both based on common features of the type of article in question. Smaller differences are less tolerable when striking features are involved.

j) In terms of overall impression, Mr Justice Arnold stated:

“46 It is common ground that, although it is proper to consider both similarities and differences between the respective machines, what matters is the overall impression produced on the informed user by each design having regard to the design corpus and the degree of freedom of the designer. In this regard both counsel referred me to the observations of Mann J. in *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat); [2008] R.P.C. 27 :

“123. ... A catalogue of similar features was relied on by Rolawn, but that exercise is a useful one only so far as it assists to verbalise a visual impression.

125 ... As Jacob LJ indicates, consideration has to be given to the level of generality to be applied to the exercise - the concept is inherent in the concept of ‘overall impression’ - but generality must not be taken too far. Just as, in his case, it was too general to describe the bottle as ‘a canister fitted with a trigger spray device on the top’, in the present case it is too general to describe either product as ‘a wide area mower, with rigid arms carrying cutters, and whose arms fold themselves up at a mid-way point’, and so on. One of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. ...

126 ... In every case I come to the clear conclusion that a different overall impression is produced by the Turfmech machine. In each case it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised similarities means that the machines give the same overall impression. ...”

The informed user

12) Matters must be judged from the perspective of an informed user. In assessing the attributes of such a person I note the decision of Judge Fysh Q.C. in the Patents County Court in *Woodhouse UK PLC v Architectural Lighting Systems* [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).”

13) I also note that the above approach regarding the informed user 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) and later accepted as appropriate by the Court of Appeal in that case. In *Dyson*, Mr Justice Arnold stated:

“19 In *Grupo Promer Mon Graphic SA v OHIM (T-9/07)*, judgment of March 18, 2010, the General Court of the European Union held at [62]: “It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed.”

14) The case referred to by Mr Justice Arnold above was subsequently appealed to the Court of Justice of the European Union where, now published as Case C-281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA, Office for Harmonisation in the Internal Market* it was stated:

“It should be noted, first, that Regulation No 6/2002 does not define the concept of the „informed user’. However, as the Advocate General correctly observed in points 43 and 44 of his Opinion, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.”

15) The informed user is not, therefore, a casual user but must instead be deemed to be a knowledgeable/particularly observant user of badges and will possess those characteristics set out in the preceding case-law.

THE RESPECTIVE PARTIES’ STORIES

16) Much of the parties’ evidence focuses on who is the designer of Defence’s design. As I have already said, the scope of this decision is not to resolve that issue but, nevertheless, I think it useful to set out the competing stories so that matters can be placed in context.

Mr Padden’s version of events

17) Mr Padden’s background is as a former Royal Marine who, after retirement, set up his own small business producing memorabilia for the SAS and other regiments and military associations. He describes the following turn of events:

- End of 2001 - Whilst assisting Witness A with the design of some dinnerware, a telephone conversation took place in which he was asked if he had any new ideas for a new badge for the SBS. Mr Padden suggested that “the lads” should try to come up with something.
- March 2002 – Whilst discussing matters relating to a retirement trophy, Mr Padden had a discussion with a Major D who advised that Witness A was on leave but he would mention the business of the new badge on his return.
- April 2002 – Mr Padden was contacted by Witness A who advised that nothing had been done by the lads, so he asked Mr Padden if he could turn something around quickly.

- Mr Padden provides a number of sketches that he says he produced following the above discussions, some of which feature a sword/dagger with a single overlapping wave.
- May 2002 – Mr Padden sent instructions to a manufacturer, Mr David Sharp, to produce badge samples. Mr Padden provides various prints such as an order form and emails containing designs which include a dagger, an overlapping wave and the motto STRENGTH AND GUILLE which Mr Padden says he settled on.
- May 2002 - Mr Padden sent Witness A some designs for the new SBS logo and also a badge containing a frog which was for the dinnerware order. The SBS logos contain daggers, an overlapping wave and the motto STRENGTH AND GUILLE.
- 18 May 2002 – Witness A wrote to Mr Padden stating that he had sent the two designs to the Heraldic Committee and he adds that the Frog and Paddle may be turned down as a cap badge. It is further added that on July 4 the service will be given three options (if the two designs are approved by the committee) and asks Mr Padden to add silver wire to the finished product. Mr Padden states that Witness A was talking about the frog and paddle design when he was referring to doing something different.
- 16 July 2002 – Witness A wrote to Mr Padden stating that the badge had gone down well but asking for a few options mainly to do with the shape, positioning and number of waves. Mr Padden took these requests into account, as well as his own further ideas, and submitted more designs to Witness A.
- Mr Padden explains that Witness A informed him that he was no longer involved and that WO1 “C” had been assigned to approve a suitable badge. He says that a variant suggested by Witness A was disregarded in favour of a design by Mr Padden. A letter from WO1 “C” to Mr Padden dated 31 October 2002 is provided enclosing the final design and asking him to produce a sample for the Admiral to approve. The badge contains the motto BY STRENGTH AND GUILLE. Mr Padden says he sent the design to the badge maker but this turned out not to be the final design;
- November 2002 – It is explained that Major D then took the reins from WO1 “C”. It is explained that he visited Mr Padden’s premises on a number of occasions and that he made attempts to tamper with the design and he got a corporal to reproduce the design on a computer using Coral Draw.
- 31 January 2003 – Major D subsequently wrote to Mr Padden requesting further samples of various versions of the badge. I note from this letter the statement that “in view of the sample numbers and past lengthy R&D please absorb this into your unit price”.
- Following the above letter Mr Padden says that he was furious and he rang Major D to explain that he wanted to retain the intellectual property rights because he was to assign it to either the SBS association or use them to raise funds for the association. He highlights that in Major D’s

letter he had adjusted the waves by cutting and pasting them upside down and reverting to a white scroll. He then asked for the badge maker to produce samples pursuant to the Major's letter.

- Eventually, the final badge was agreed and received Collage of Arms and Royal Approval. Mr Padden was invited, for his efforts, to an inauguration ceremony. He says that even after the design was settled Major D still tried to change parts of it. He states that he put a huge amount of effort in to the research, development and design of the badge. He states that he did not receive any official commission or indeed any remuneration. All he was paid was the production costs for one order for a small batch of badges. He adds that he conceived and introduced every element of the design save for Major D's wave inversion.

18) Mr Padden filed a second witness statement which, as it largely relates to whether there has been a public disclosure, is detailed later.

Defence's version of events

19) A witness statement if provided by Witness A who, between 2000 and 2002, was the Regimental Sergeant Major of the SBS. He describes the following:

- That he was responsible for a project which, amongst other things, was to redesign the SBS badge. This was required due to a change in regimental responsibility.
- Witness A does not recall asking Mr Padden to think of ideas for a new badge and he did not, in any sense, commission him. He states that he did ask unit members to come up with a design but cannot recollect that this was at Mr Padden's suggestion.
- Witness A admits contacting Mr Padden in April 2002 but categorically denies saying that the lads had not come up with anything and asking Mr Padden to come up with something. He states, in fact, that SBS personnel did come up with something and provides a large number of drawings some of which contain daggers and waves. He says one of them was drawn by him personally. He says that along with Witness B in the illustrators department, they settled on the best ideas and tidied them up with computer drawings – a number are then provided some of which, again, featuring a dagger, waves and the motto BY STRENGTH AND GUILE.
- In May 2002 Witness A commissioned Mr Padden to turn the designs into prototype badges. He says that Mr Padden offered advice about the manufacture of them but not on the design itself, although he did give his broad opinion on the designs provided (e.g. that it was good to keep the dagger as the main feature).
- He states that the idea for the design came from the early sketches and his own ideas. He provides some old regimental badges that he used for research.

- He refers to further developments being required following comments from his commanding officer and those of the Flag Institute (I will say more about this shortly). Some further designs are shown in Exhibit 4 which he says were drawn around May/June 2002 by Witness B, one of which was sent to Mr Padden on 16 July 2002.
- On 22 July 2002 Mr Padden sent Witness A designs for prototype badges because what had been supplied so far was a flag which did not show all the various combinations needed. It is noted that the words “SBS Copyright” are included on this document.
- Witness A admits that Mr Padden may have made some very minor alterations to the design to assist in manufacture, but he was unaware that this had even been done.
- He makes various other comments on Mr Padden’ evidence which either are unnecessary to detail further or, he explains that he has no knowledge of certain events.

20) Evidence also comes from Witness B, who, at the relevant time, was a Royal Marine illustrator. His evidence is that:

- He was part of the re-branding project led initially by Witness A and subsequently by WO1 “C” and Major D.
- He was passed the original drawings referred to by Witness A on the Unit’s return from active service. He and witness A considered what the best ones were, did some research (as referred to by Witness A) and worked them up (as per Witness A’s evidence). He also provides further sketches that he did showing the development of the design at this time.
- His evidence then fits in with that of Witness A, to the extent that he was only aware of Mr Padden being commissioned to produce sample badges and that he (Witness B) made the majority of the drawings etc provided by Witness A upon instruction from Witness A (and later Major D) to develop the design.

21) Evidence also comes from Witness E, a retired Royal Marine who states that he has seen the material exhibited by Witness A and confirms that the drawings featuring the dagger, waves and motto (which have handwriting on and a redacted name) were drawn by him whilst on operational duty in February 2002.

22) Other evidence comes from Mr Christopher Shea, Defence’s representative. He provided 4 witness statements. His first simply refers to the dispute and to clarify that the design was disclosed to him no later than 15 April 2003 which is before the period of 12 months prior to the relevant date. His second is mainly a critique of Mr Padden’s evidence (with some counter evidence). It also highlights that a version of the design was included in a presentation to the Flag Institute well before the one year period preceding the relevant date; I will come on to this shortly. His third witness statement deals with confidentiality matters. His fourth is more submission than fact relating to the issue of disclosure.

THE DISCLOSURES CLAIMED TO HAVE TAKEN PLACE MORE THAN 12 MONTHS BEFORE THE RELEVANT DATE

23) Disclosures in this category are the ones relevant to the scope of this decision. Having considered the content of Defence's evidence and submissions, the following disclosure are claimed to have taken place:

- i) Disclosure by Major D to Mr Shea, the legal representative of Defence, when Mr Shea received instructions to file the design.
- ii) Disclosures by Mr Padden to Witness A, Major D etc.
- iii) Disclosures at a meeting of the Flag Institute.

24) This disclosure to Mr Shea does not amount to the design being made available to the public. Ms Shea is a legal representative and the design was disclosed whilst he was performing that role. I accept that a disclosure to a single member of the public may be enough in some circumstances, this was held by Bowen LJ in *Humpherson v Syer* (1887) 4 RPC 407 where the member of the public to whom a disclosure was made was free in law and equity to use the information so disclosed as he so pleased. However, a disclosure to a person's legal representative will be underpinned by an inherent condition of confidentiality. This claim is dismissed. In respect of the second disclosure listed above, I decline to deal with it at this stage. When I directed that the proceedings should be separated I also directed that disclosures between the parties would not form part of the first stage of the separated proceedings. That leaves the disclosure to the Flag Institute to which I now turn.

Evidence of Mr Christopher Rickard

25) Mr Rickard is a retired Royal Navy Petty Officer Communications Yeoman. At the relevant time he was working at HMS Collingwood as a Civilian Instructor. His duties included providing instruction on naval flag ceremonies and providing advice on the same subject to outside agencies. He also represented Yeoman of the Admiralty at meetings of the Flag Institute.

26) Mr Rickard's evidence is that Witness A contacted him seeking advice on the heraldic and artistic aspects of new designs for the SBS badge/motif. Mr Rickard informed him that he would present the designs to an upcoming meeting of the Flag Institute in Winchester. He then explains the role of the Flag Institute. It is the largest vexillologist membership organisation in the world. It conducts research and provides documentation relating to flags. It provides services to many organisations around the world advising on the use of flags, the design of flags and collating information on flags.

27) Mr Rickard gave his presentation in May 2002. He exhibits some of the material he used which includes pictures of a number of SBS designs, including

designs featuring the dagger, a wave and the motto BY STRENGTH AND GUILE. I will depict later what was contained in this material.

28) Mr Rickard also exhibits a number of letters/emails relating to the Flag Institute's response. The Flag Institute preferred the designs featuring a parachuting frog, but, if the sword and wave design was chosen then they suggested some improvements that could be made to it, including, lengthening and doubling the wave and positioning it behind the dagger. Mr Rickard explains that these proposals were made by the Institute and the Council in particular, not by him. One of the letters provides revised artwork produced by the Institute's vexillologist.

Evidence of Gillian Mary Huthart

29) Ms Huthart is the solicitor representing Mr Padden in these proceedings. Her evidence relates, in the main, to the claimed disclosure to the Flag Institute. I note the following statements/evidence:

- That whilst anyone can join the Flag Institute, membership of the Council (to whom she says the flag was disclosed) is restricted (to elected UK residents). The Council is the Institute's elected administrative body.
- That the Institute meets twice a year and (save for what is called "the Perrin Lecture") such meetings are not open to the public. Various documents relating to the Institute are provided in Exhibits GM1 & 2.
- Ms Huthart notes that Mr Rickard's talk was about flags in general with the relevant flags being disclosed for the purpose of taking a poll. Ms Huthart does not consider this, when the non-public nature of the meeting is considered (she refers to it as being to the Institute's committee), to constitute a public disclosure.
- Given that Mr Rickard was putting forward options, an implied level of confidentiality would have existed and the members present at the meeting were not free in law and equity to make whatever use they wished of the information gleaned. Ms Huthart states that the rank of Witness A (who would be bound by the Official Secrets Act) further supports this.
- That the seeking of an opinion cannot constitute a public disclosure.
- That the design disclosed is different to the final version and, further, the design is a flag print not a badge design.

Evidence of Mr Padden – second witness statement

30) In response to Mr Shea, Mr Padden states that his initial application contained an identification of novel aspects (including stitching direction, colour, silver wire) but he was directed by the IPO to remove this. He states that he was not commissioned to produce the design and that he did not give consent to it being disclosed. He says that the various protagonists at Defence knew that he intended to donate the design rights to the SBS Association and until then it was

to remain “commercial in confidence”. He says that any disclosures to Witness A (which I have said is not being discussed in any event) were on such basis. He says that this also applied to any subsequent disclosure and that he should have been informed what was happening.

31) Mr Padden says that in 2003 Lt Col F approached him to produce various mementos for the inauguration day. Mr Padden agreed to do so if Lt Col F would investigate the possibility of assigning the design to the SBS Association. For creating the mementoes he asked to spend a day with the Royal Marines School of Music. Lt Col F arranged for the music day. He spoke to someone in the MOD about the copyright issue and the message passed onto him was that it was none of his (Mr Padden’s) business. Mr Padden then stated that as far as he was concerned he owned the copyright/design right and would assign it himself or keep it in perpetuity to raise funds for the association. He believes that whoever Lt Col F spoke to in the MOD then sought priority by registering the design.

Evidence of Mr Rickard – second witness statement

32) In a second witness statement Mr Rickard provides further detail about his meeting with the Flag Institute. He explains that the audience he presented to consisted of about 6 officers of the Institute plus about 30 ordinary members. He explains that his talk was about Royal Marine Flags in general but he finished his presentation by revealing the new flags and then taking an audience poll. He explains that the correspondence after the presentation was not conducted in any sort of public forum. Mr Rickard had not previously heard of registered designs and did not know that his presentation might be a disclosure with any legal ramifications. He says that it did not cross his mind that he should ask for any confidentiality arrangements with his audience and he had no indication whatsoever from Witness A that the material was to be regarded as commercially confidential.

Evidence of Ian Sumner

33) Mr Sumner is a librarian at the Flag Institute. He explains that the Institute’s members have free access to its library in Hull. He also sends information to any enquirers without them having to personally come to Hull. At his discretion, non-members may also access the Institute’s information. He remembers the talk given by Mr Rickard. A handout of the presentation was distributed to those who attended and, he explains, a copy is kept in the library. He provides a copy of the handout. One of the designs (which I depict later) is included. He says that this would have been freely available since the meeting to anyone using the library.

Evidence of Mr Graham Bartram

34) Mr Bartram is the Chief Vexillologist of the Flag Institute. He provides background information about the institute (as per Mr Rickard’s evidence) and

the library (as per Mr Sumner's evidence). He was present at the meeting in which Mr Rickard gave his talk. He recalls around 30 people being there. He explains that the meeting was open to the public but he does not know if any non-members were there. He says that it was the meeting's suggestion that some changes should be made to the design.

35) Mr Bartram provides a copy of the Institute's journal which is distributed to its members. Copies are also kept at the copyright libraries and the British Library. The journal is said to contain a reference to Mr Rickard's talk: "New Badges and Flags for the SBS – Chris Rickard", although I cannot find the entry myself. He states that those with a professional interest in vexillology is small but most would be members of the institute and are, therefore, able to attend meetings and use the library. He says that although the designs are not in the journal, if any reader was interested then they would have provided from its records or approached Mr Rickard to do so.

Has a relevant disclosure been made?

36) I will come on to whether what was disclosed to the Flag Institute defeats the novelty in Mr Padden's design, but what needs to be determined initially is whether the disclosures should count as "being made available to the public". In her evidence Ms Huthart has highlighted a number of factors including: i) that the talk was about Royal Marine Flags in general and the SBS flags presented merely to seek an opinion, ii) that the meeting was not a public meeting, iii) that there would be an implied level of confidentiality. Mr Padden also refers to issues of confidence and that any disclosures he had made were on a commercial in confidence basis and that this should have also filtered down to the Flag Institute disclosure.

37) In terms of point i), the fact that designs were disclosed for the seeking of an opinion does not mean that they were not made available to the public. Whatever the purpose of the disclosure, the designs have either been made available to the public or they have not. The fact that they were disclosed as part of a more general talk does nothing to alter this fact. In terms of point ii), this relates to the nature of the Flag Institute itself and also the particular meeting. It is clear that anyone may join the Institute. The tribunal has been provided with direct evidence from the Institute's Chief Vexillologist explaining that the meeting was in fact open to the public. In any event, the meeting was attended, according to those in the best position to know, by around 30 people, including, at the very least, ordinary members of the Institute. I see no reason why a disclosure made in such circumstances should not be regarded as a public disclosure. That then leads to the issue of confidentiality. As a matter of fact, the meeting was not advised of any issues regarding confidentiality. Mr Rickard states that it did not even cross his mind. This does not mean that Mr Rickard would have requested confidentiality if he had thought about it. He is simply saying that it did not occur to him. In terms of implied confidentiality, I see no reason why anyone at the

meeting would have believed that they were under an obligation of confidence. It is not as though a proposed design for a new regimental badge would have hinted of a commercially sensitive issue.

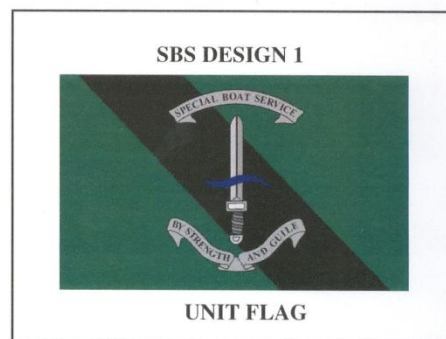
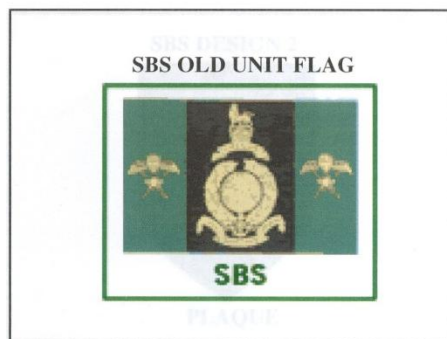
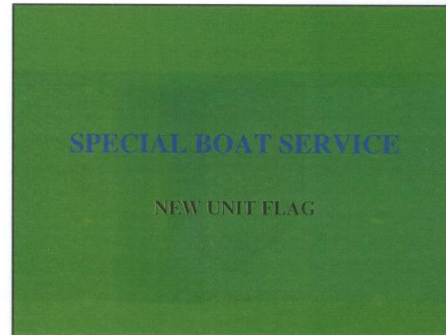
38) Mr Padden also mentions confidentiality. He states that when he gave his designs to Witness A/Major D etc. it was on a commercial in confidence basis. I note that one of the exceptions to a disclosure being relevant is that:

“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)”

39) This has not specifically been pleaded but I will deal with the point none the less. It may be that the defence can be relied upon if Mr Padden was the designer and if a condition of confidentiality was in existence. In such a scenario, if Mr Padden passed the design to Witness A under condition of confidentiality then a subsequent disclosure arranged by Witness A should be subject to a similar condition. In my view, even if Mr Padden was the designer, there is nothing to suggest that a condition of confidentiality was in existence. If Mr Padden's version of events is to be believed, then it is clear that Mr Padden was designing something for the SBS. He was asked to come up with something. Mr Padden says that he was not formally commissioned, that may be so, but the whole arrangement, an arrangement which appears to be underpinned by a large degree of informality, was to design something for the SBS. In such circumstances it would be counterintuitive to believe that representatives of the SBS could not do as they saw fit with the designs. Mr Padden's reference to commercial in confidence comes later in his evidence. He may believe that this was the arrangement but he has provided nothing to demonstrate that that was the true relationship. If Mr Padden's version of events is true, then the whole issue is more to do with payment for his services and/or his desire that the SBS association take ownership of the copyright/design. This is not particularly relevant when it comes to whether a design has been publically disclosed. My finding is that the disclosures made at the Flag Institute meeting count for the purposes of this decision.

The disclosed designs compared to Mr Padden's registered design

40) In his evidence, Mr Rickard provided screen shots depicting what he disclosed during his talk, they are depicted below:



41) The three designs headed SBS DESIGN 1 are relevant. I will make the comparison on the basis of the plaque version of the design, meaning that the two designs to be compared are:



42) The design on the left is the design registered by Mr Padden; the design on the right is one of those disclosed during the talk. I should say straight away that the fact that the designs are applied to different articles (a badge compared to a plaque) has little significance. If a design not differing in overall impression is moved from one article to another, this does not necessarily provide the latter application with a novel character, especially, as in this case, that the outline shape of the article is virtually identical. There are a number of similarities between the designs. Both have a dagger of very similar style pointing upwards, both have a wave or waves either cutting across or behind the dagger in a similar position and direction, both have a scroll towards the bottom of the dagger featuring the words BY STRENGTH AND GUILLE. There are also some differences. The wave is singular and goes over the dagger in the prior art whereas it is doubled and goes behind the dagger in the badge, there is an additional scroll featuring the name of SBS in the plaque and, finally, the background colour is different (black, as opposed to green with a black stripe).

43) It is worth noting at this point that the degree of design freedom relating to signs of this type is extremely wide. There are no real constraints save for the designer's imagination. In such circumstances small differences between designs is less tolerable than in cases where the freedom of design is more limited. In terms of the daggers and the waves, the differences, in my view, are very small. Repositioning the wave behind the dagger and doubling the number has little impact on overall impression. The position of the bottom scroll is, likewise, minor. That leaves the additional scroll and the colouring of the background. The colouring is not significant in my view. The removal of a background colour and placing it upon a plain background has little design impact especially as the primary focus of the designs are, in view, the dagger and wave element. The same applies to the additional scroll which simply features the name of the regiment to whom the design relates – this adds little new in terms of real design and, so, its removal has little impact. I come to the view, bearing in mind the degree of design freedom, together with the similarities and differences between the designs, that Mr Padden's design does not clearly differ in overall impression from the disclosed design.

44) The consequence of the above finding is that Mr Padden's registration is invalid. In the circumstances, this separated part of the proceedings resolves the issue and there is no need to consider any other issues.

COSTS

45) Defence having been successful, it is entitled to a contribution towards its costs. With regard to costs, although the registrar has a wide discretion in relation to such matters, he nevertheless works from a published scale (as per Tribunal Practice Notice 4/2007). I have borne the scale in mind when determining what award of costs to make. I hereby order Mr Padden to pay The Secretary of State for Defence the sum of £1850. This sum is calculated as follows:

Fee for requesting invalidation	£50
Preparing a statement and considering the other side's statement	£300
Filing evidence and considering Mr Padden's evidence	£1000
Filing submissions	£500

46) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of July 2012

**Oliver Morris
For the Registrar
The Comptroller-General**