

**O/745/19**

**REGISTERED DESIGNS ACT 1949**

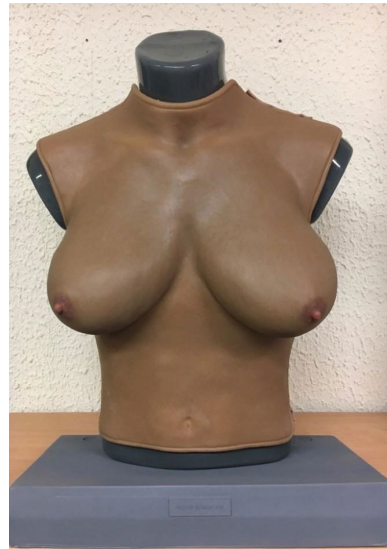
**IN THE MATTER OF  
REGISTERED DESIGN NO. 6047961  
IN THE NAME OF COSMEDIC LTD**

**AND**

**APPLICATION NO. 35/18 BY MR ROBERT WHITEHEAD  
TO INVALIDATE THE REGISTERED DESIGN**

## BACKGROUND AND PLEADINGS

1. Cosmedic Ltd (“the registered proprietor”) filed an application for a registered design for a breast model on 11 November 2018. The design was registered with effect from that date and is depicted in the following representations:



2. No disclaimers were entered on the application form.

3. On 26 November 2018, Mr Robert Whitehead (“the applicant”) applied for the registration of the design to be invalidated under sections 11ZA(2) and 11ZA(4) of the Registered Designs Act 1949 (“the RDA”). He claims that the registered proprietor is not the proprietor of the design and that he is its sole designer and manufacturer. He also claims that the design constitutes an unauthorised use of a work protected by the law of copyright in the UK and that he is the copyright holder.

4. The registered proprietor filed a counterstatement on 24 February 2019, denying the applicant’s claims. In particular, it claimed that a Mrs Lopa Patel drew up the exact design specification and that Mr Whitehead helped manufacture the prototype to that specification.

5. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers. In these proceedings, neither party had legal representation.

### **Preliminary issues**

6. Following receipt of the applicant's request to invalidate the design registration, the Registry sought clarification on a number of points and asked Mr Whitehead to submit an amended form. This was done on 21 January 2019, and the amended form was sent to the registered proprietor. The original invalidation request contained some details that were not reproduced in the amended form. The original form has not been admitted into proceedings and, consequently, the registered proprietor has not had the opportunity to see it. I have therefore not taken into account any information contained in the original form in coming to my decision, except where it is repeated in the amended request or the applicant's evidence and submissions.

7. In his evidence and submissions, the applicant notes that Mrs Patel states that she gave lectures and presentations in 2017 and 2018 on the breast reduction simulation model. He submits that this means that the idea had already been disclosed before an application for registration was made and that therefore Mrs Patel had relinquished any claim to intellectual property rights. The applicant did not however make any pleadings on this point in his request for invalidation. I shall therefore give this point no further consideration.

### **Evidence**

8. The applicant submitted evidence and submissions on 18 March 2019 under a statement of truth. The registered proprietor submitted evidence with its counterstatement on 24 February 2019.

9. At the time of her counterstatement, Mrs Patel (the owner of Cosmedic Ltd) was a senior Plastic Surgery trainee working in the NHS and about to qualify as a consultant. She identified the need for a simulation aid to develop trainees' skills in mark-up techniques for breast reduction surgery, as opportunities to practise those skills, or

watch them being demonstrated on a live patient, were scarce. She says that since October 2016 she “has spent substantial time, effort, money from grants/personal funds and energy in developing and conceptualising this model”.

10. Mrs Patel states that Mr Whitehead, the owner of Artizan Medical Prosthetics (“Artizan”), contacted her after he spoke to a colleague and said that he would be able to help with manufacturing the prototype. Exhibit 2<sup>1</sup> includes the email dated 13 September 2016. Mr Whitehead gave advice that was incorporated into a project proposal (Exhibit 1), which was drawn up with the aim of securing funding. The phases of the development of the prototype are set out as follows:

- Detailed life cast of model – Large breast size (F/G) requiring silicone impression backed onto plaster bandage.
- Cast will need to include patient chest and upper abdomen.
- Master copy from life cast made with repair of any irregularities.
- Further copy of master and wax copy.
- Making of a structural support to mount the heavy prosthesis onto
- Fiber Glass final sculpting
- Silicone “Deadener” pieces made.

11. The contribution each party made is disputed. Mrs Patel states that Mr Whitehead’s role was confined to manufacturing the prototype, while Mr Whitehead maintains that some of the features of appearance of the design were his own decision. He identifies four in particular – collar bones; a navel; strapping to enable the model to be strapped to a person not just a mannequin; and the mannequin and stand – as being different from the prior art. At Exhibit F, he provides four undated printouts from web retailers, showing two breast examination training models and two pairs of false breasts one designed for use by cross dressers and the other by drag queens. None of these possess those features, but, as the printouts are undated, I am unable to determine whether or not they constitute prior art.

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<sup>1</sup> The registered proprietor’s exhibits are numbered; the applicant’s are given letters.

12. Mrs Patel obtained funding from Health Education England (HEE) and the British Association of Aesthetic and Plastic Surgeons (BAAPS). She states that these organisations acknowledged that the design rights lay with her and, after seeking their approval, she applied for a registered design. The NHS trust for which she worked at the time agreed to assign any intellectual property to her. The agreement is at Exhibit 4.

13. Mr Whitehead says in his request for invalidation that design and manufacture of the model started in February 2017 and ended in July 2017. Mrs Patel collected the prototype in July 2018, when full payment of £4500 had been made. Both parties provide a copy of the invoice issued (Exhibit 3 for the registered proprietor, Exhibit G for the applicant). At Exhibit H, Mr Whitehead provides screen shots from text message conversations between Mrs Patel and himself. These are undated but appear to be taken from the period during which Mr Whitehead was carrying out the work. Mrs Patel acknowledges that Mr Whitehead is making a loss on the prototype and the two agree a deal for the distribution of revenue from future sales.

14. Mr Whitehead states that at no time did he relinquish his design rights.

## **Decision**

### ***Section 11ZA(2)***

15. Section 11ZA(2) of the RDA is as follows:

“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.”

16. Section 2 of the RDA provides that, where a design is commissioned, the proprietor of the design is the person who creates that design:

“(1) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.

...

(1B) Where a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.

(2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.

(3) In this Act the 'author' of a design means the person who creates it.

..."

17. Given the relevant provisions, Mr Whitehead must not only establish that Cosmedic is not the proprietor of the design, but also establish that he is in fact the true proprietor.

18. No evidence has been provided of any written agreement between the registered proprietor and Mr Whitehead. Such an agreement might have stated whether Mr Whitehead was acting in a personal capacity or on behalf of Artizan. The invoice for the work was issued by Artizan and Mr Whitehead used a corporate email address for correspondence with Mrs Patel. These facts suggest to me that the work was done by Artizan, which has a separate legal personality from that of its owner. Consequently, Mr Whitehead's application for an invalidation of the registration under section 11ZA(2) fails as he has not shown that he has the standing to bring the action under this ground.

#### **Section 11ZA(4)**

19. Section 11ZA(4) of the RDA is as follows:

“The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.”

20. Section 9(1) of the CDPA states that:

“In this Part ‘author’, in relation to a work, means the person who creates it.”

21. Section 11 of the CDPA is as follows:

“(1) The author of a work is the first owner of any copyright in it, subject to the following provisions.

...”

22. Section 154 of the CDPA states that:

“(1) A work qualifies for copyright protection if the author was at the material time a qualifying person, that is –

(a) a British citizen, a national of another EEA state, a British overseas territories citizen, a British National (Overseas), a British Overseas citizen, a British subject or a British protected person within the meaning of the British Nationality Act 1981, or

(b) an individual domiciled or resident in the United Kingdom or another EEA state or in the Channel Islands, the Isle of Man or Gibraltar or in a country to which the relevant provisions of this Part extend, or

(c) a body incorporated under the law of a part of the United Kingdom or another EEA state or the Channel Islands, the Isle of Man or Gibraltar or of a country to which the relevant provisions of this part extend.”

23. Mr Whitehead is in the same position under section 11ZA(4) as he is under section 11ZA(2). He has not shown that he has the standing to bring the action under this ground, and so the application fails under this section.

### **Conclusion**

24. The request for invalidation has failed and the design will remain registered.

### **Costs**

25. The registered proprietor has been successful. As the registered proprietor is a litigant in person, it was invited to complete a proforma with a breakdown of its actual costs and return this to the Registry. It was advised that, if the proforma was not returned, no costs, other than official fees arising from the action, would be awarded. No proforma was received, so I make no award of costs.

**Dated this 5<sup>th</sup> day of December 2019**

**Clare Boucher  
For the Registrar,  
Comptroller-General**