

O/149/22

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF A JOINT HEARING IN RELATION TO:

**REGISTERED DESIGN NO 6095483
IN THE NAME OF ROUNDELWRAPS LTD
IN RESPECT OF THE FOLLOWING DESIGN**



ROUNDEL
Wraps

AND

**AN APPLICATION FOR INVALIDATION (NO 50/21)
BY SUPERWRAPPZ LIMITED**

Background

1. Roundelwraps Ltd (“the registered proprietor”) filed application no. 6095483 for a registered design for badge decals in Class 19, Sub class 8 of the Locarno Classification (Stationery and office equipment, artists’ and teaching materials/Other printed matter) on 21 July 2020. It was registered with effect from that date and is depicted in the following representation:



2. On 2 July 2021, Mr Bogdan Isac applied for the registered design to be invalidated under section 11ZA(1A), (2), (3) and (4) of the Registered Designs Act 1949 (“the Act”). Under each of these grounds, he sought to rely on an earlier design with a registration date of 18 June 2016 (No. 5003448). On 18 August 2021, the Registry requested clarification as to the identity of the applicant as Mr Isac had given both his own name and that of Superwrappz Limited, of which he was the Director. The Registry also identified a number of deficiencies with the pleadings. The substance of the letter is reproduced below:

11ZA(1A)

In order to make a claim under the above Section, it is necessary for you to be the proprietor of an earlier filed design which was made available to the public **on or after the publication date** of the design you are challenging.

The design you are challenging was registered on 21 July 2020. The design you are relying on was made available to the public in 2016. As you are relying on a design which has been made available **before the application date** of Design 6095483 this provision does not apply to you.

To be successful a claim under this ground would also need to show that the design being applied for is not new and does not have individual

character when compared to another design that has been made available to the public.

If you can provide the registry with an image of a design that has been made available to the public prior to the filing of the design you are challenging, that also meets the criteria given above, you may wish to consider S1B.

11ZA(2)

A claim under 11ZA(2) is a claim that you are the proprietor of the design. You have stated that the proprietor has copied your designs, but have not explained why you should have been recorded as the owner of this design.

To proceed with this claim the registry would need to know why you should be recorded as the owner of this design number.

As this claim can only be brought by the person that should be the owner, the registry would also need clarification as to who the proceedings were being brought in the name of as requested above.

11ZA(3)

A claim under 11ZA(3) is that you are the owner of an earlier distinctive sign. To support this claim you would need to provide details of the earlier distinctive sign that you have used. A sign would usually mean something that acts as a badge of origin to demonstrate who is providing a product or service.

To support this claim we would need to see a copy of the earlier distinctive sign that you own and be told when and where it was used.

As this claim can only be brought by the person that is the owner of the earlier distinctive sign owner, the registry would also need clarification as to

who the proceedings were being brought in the name of as requested above.

11ZA(4)

11ZA(4) is a claim that you have work protected by the law of copyright and you are the copyright holder. To support this claim the registry would expect to be provided with the following information.

- What the work relied on is, including a representation of it.
- Who created the work and when it was created.
- The nationality of the author (or if the author of the work is a corporate body where the corporate body is incorporated) at the time the work was created.
- If domicile/residence of the author is relied upon, where the author was domiciled/resident at the time the work was created.
- If the publication of the work is relied on, where the first publication of the work took place and when.
- Who the current owner of the work is and, if such a person is not the author, by what method ownership transferred.

You may therefore wish to review the claims available on the form to determine if you have picked the most appropriate claims. It is noted that you have given the same response for each section of the form. For each section of the form you complete you should provide the information requested to support the specific claim being made.

A date of **8 September 2021** has been allowed for you to respond.”

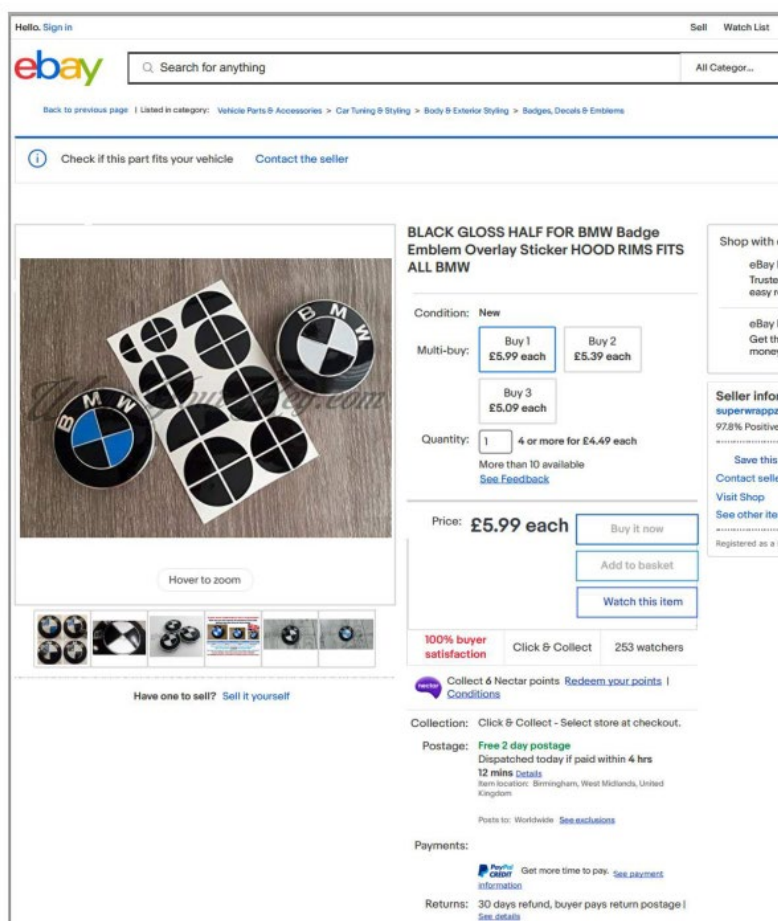
3. Mr Isac filed an amended Statement of Case on 23 September 2021. He confirmed that the application was being brought by SuperWrappz Limited (henceforth “the applicant”). He relied on section 11ZA(2), (3) and (4) of the Act and supplied copies of

ebay listings and product descriptions. The Registry wrote back to him on 15 October 2021, requesting the information specified in the earlier letter.


4. A further amended Statement of Case was filed on 20 October 2021. Only the section 11ZA(3) and (4) grounds remained. With regard to the section 11ZA(3) ground, the applicant claimed that:

“the words roundel wraps were used since 21 Jul 2016 in the description of SuperWrappz ebay item id 131884779472 which was bought by Lewis Campbell. After delivery he copied the words from the description to create his copy of our items. The design’s look, feel, get-up is same as our SuperWrappz logo at that time.”

5. In support of this claim, the applicant provided undated screenshots of the item bought by Mr Campbell and descriptions of the item, as reproduced below:



www.superwrappz.co.uk



SuperWrappz
superwrappz-co-uk

Sign up for newsletter


Search within shop

Visit shop: SuperWrappz

Items On Sale | BMW Badge Emblem Corners | BMW Rectangular Shape | Audi Flip 2nd Gen (04 to now) | Audi Smart | Audi Airbag Wrap Rectangular

Categories

- BMW Badge Emblem Corners
- VW / Seat / Skoda
- Vauxhall Keys
- BMW Keys
- Audi Airbags
- Audi Keys
- Sonstige



Product Information

BLACK GLOSS
HALF EMBLEM Wrap Cover Skin
BMW 1 3 4 5 6 E Series Z4 X1 X3 X5 X6M
HIGHQUALITY BADGE EMBLEM ROUND WRAP VINYL FOR BMW

- 1 Series (2004 - now): E81, E82, E87, E88, F21, F20
- 2 Series (2013): F22, F23, F45, F46
- 3 Series (2005 - now): E90, E91, E92, E93, F20, F30, F31, F81,
- 4 Series (2013): F32, F33, F36
- 5 Series (2004 - now): E60, E61, F10, F11, F07
- 6 Series (2004 - now): E63, E64, F12, F13, F06
- 7 Series (2002 - now): E65, E66, E67, E68, F01, F02, G11, G12
- Z4 (2004 - now): E85, E86, E89
- X Series: X1, X3, X5, X6: E84, F25, E70, E71, E72, F48, E83, F25, G01, E53, E70, F15, F26, F16

E31 E36 E38 E39 E46 E52 E53 E70 E60 E61 E63 E64E65 E66
E81 E83 E86 E87 E90 E91 E92 E93 E94 X3 X5 Z3 Z4Z8
 Possibly fit other BMW models, with same emblem size

BLACK COLOUR
GLOSS FINISH
HALF BADGE WRAP
(ONLY 2 QUADRANTS COVERED)

**IT IS THE BUYER'S RESPONSIBILITY TO CHECK THE SIZ-
 ING
 PICTURE AND COMPARE WITH HIS BADGES.
 IN CASE YOUR BADGE IS NOT THE SAME SIZE - WE CAN
 MAKE
 A CUSTOM ONE FOR YOU!
 JUST SEND US A MESSAGE WITH THE SIZE OF EACH
 QUADRANT :)**

**STYLE UP ALL YOUR BMW BADGES WITH
 THIS KIT**

This is not a hard badge made from plastic. This is an insert to place over your car's original badges. The inserts are only to install in the inner circle of the badge (as shown in the pictures).

WARNING!
**OTHER SELLERS ARE TRYING TO TRICK YOU WITH
 CHEAPER PRICES BUT THEIR ITEMS ARE FAKE,
 HORRIBLE QUALITY AND MADE WITH CHEAP CHINESE
 VINYL!
 DO NOT BUY FROM THEM!**

**THIS IS THE ORIGINAL BADGE ROUND WRAP
 DESIGNED AND TRADEMARKED BY SUPERWRAPPZ!**

**ONLY OUR EMBLEM CUT-OFFS ARE MADE FROM
 PREMIUM MATERIAL: 3M™ Wrap Film Series 1080 - Scotch Print
 ORACAL 970 PREMIUM
 Ritrama Wrap
 ARLON Ultimate Premium Plus™**

High class precision engineering has produced this top quality roundel wrap vinyl sticker for your valuable BMW, guaranteeing a perfect fit.

**High Quality
 Premium wrap (3M, Oracal, Ritrama)
 Perfect Fit
 Easy to fit
 Easy to Remove Again - no marks left!
 Protects your BMW's badges and emblems from
 Scratches
 Cracks
 Wear & tear
 Dirt
 Rain / water
 & GIVES THEM A FRESH NEW LOOK LIKE NO ONE ELSE HAS !**

Helps hide previous wear & tear and other imperfections
 Can match your car's colour or choose your favourite!
 MANY COLOURS AND MODELS OF KEY, AIRBAG AND BADGE WRAPS
 AVAILABLE. SEE
 MY OTHER LISTINGS!

When will I send it?
I am trying to send it the same day if ordered before 2 PM.
What you will receive:

1 SET for a vehicle

The set includes corners for:

- Hood
- Tailgate
- Steering Wheel
- Engine Badge
- Wheels
- Indicators left and right (Z3 /Z4)
- Reserve / Spare one's

Any questions, please ask

Larger orders (MORE THAN 5) available at discounted price.

ATTENTION! THIS IS NOT A PLASTIC OR METALLIC EMBLEM!

**QUADRANT ROUNDEL WRAPS
TO COVER YOUR BADGES CIRCLES**

Thank you!

6. With regard to the section 11ZA(4) ground, the applicant claimed to be the owner of copyright in the ebay listings shown above and in the words “Roundel wrap/wraps”, which it claimed were original literary works created in 2016 by Mr Isac, a Romanian citizen resident in the UK for 12 years. The applicant then stated that at the time of the incorporation of SuperWrappz Limited, Mr Isac entered into a confirmatory assignment transferring the ownership of the works from him to the applicant.

7. The Registry wrote back to the applicant on 13 December 2021. It said that:

“Having reviewed the information provided you have stated that the phrase ‘roundel wraps’ was used in the description of the product, but have not indicated that it has been used as a mark of origin.”

8. It also said that it considered that the applicant had not provided sufficient information to support a claim under section 11ZA(4), as a two-word phrase would not constitute a literary work and, while the listings could potentially be a work protected by copyright, it was not clear how the registered design at issue was alleged to have used those listings.

9. The Registry’s preliminary view was that neither claim could proceed and that the invalidation should be struck out. The parties were given a deadline of 29 December 2021 to request to be heard, if either disagreed with this preliminary view.

The hearing

10. The applicant requested a hearing, which I held by telephone on 16 February 2022. The applicant was represented by its sole director, Mr Isac, while the registered proprietor was represented by Ross Manaton of Bromhead Johnson LLP.

11. The purpose of the hearing was to consider whether to uphold or overturn the preliminary view of the Registry that the invalidation should be struck out. Mr Isac made a number of submissions on the substantive issues and the history between the parties which I am unable to take into account in this decision.

12. I shall refer to specific points made by the parties where relevant in my decision below.

Decision

13. The Registered Designs Rules 2006 contain no provisions on summary judgment or strike out. However, it has long been recognised that the Registrar has the power to regulate his own procedures provided that he neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon the Registrar: see *Pharmedica GmbH's International Trade Mark Application* [2000] RPC 536 at [541]. In other words, the Tribunal has an inherent power to fill gaps where the statutory procedural rules are silent, provided that it is necessary and proper to do so. I am satisfied that the Registrar has the power to strike out a claim if it has no real prospect of success, discloses no reasonable grounds or is abusive.

14. In *Franbar Holdings Limited v Casualty Plus Limited* [2011] EWHC 1161 (Ch), Proudman J said that a real prospect of success meant “a case that is better than merely arguable”.¹

¹ Paragraph 26.

The section 11ZA(3) ground

15. Section 11ZA(3) of the Act states that:

“The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.”

16. A distinctive sign is one that denotes the origin of goods or services supplied under it. An example is a trade mark, which enables the consumer to recognise that goods or services come from Company A rather than Company B. Mr Isac submitted that the phrase “roundel wraps” was used as an unregistered trade mark of SuperWrappz. However, he also admitted that the phrase was used to describe the products sold by his company. Indeed, at one point in the hearing, he said that the products sold were “roundel wraps by SuperWrappz”.

17. A roundel is a small circular decoration, such as a car badge. It is clear from the description of the product that it is a vinyl sticker that the user places over the car badge to protect it from damage or the elements. The term “roundel wrap” therefore describes the use to which it is put. On reading the ebay listings, the public would, in my view, understand “SuperWrappz” to be a distinctive sign, but see “roundel wrap” as descriptive.

18. Consequently, I consider that the section 11ZA(3) claim has no real prospect of success and I uphold the preliminary view to strike out this ground.

The section 11ZA(4) ground

19. Section 11ZA(4) of the Act states that:

“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 1 of the Copyright, Designs and Patents Act 1988 (“the CDPA”) defines copyright as follows:

“(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work –

- (a) original literary, dramatic, musical or artistic works,
- (b) sound recordings, films or broadcasts, and
- (c) the typographical arrangement of published editions.

(2) In this Part ‘copyright work’ means a work of any of those descriptions in which copyright subsists.

(3) Copyright does not subsist in a work unless the requirements of this Part with respect to qualification for copyright protection are met (see section 153 and the provisions referred to there).”

21. In *R Griggs Group Limited & Ors v Ross Evans & Ors*, [2003] EWHC 2914 (Ch), Mr Peter Prescott QC, sitting as a deputy judge, said:

“Copyright law protects the skill and labour that has gone into the creation of an original work. A simple word or phrase, like ‘Dr Martens’, is not capable of being copyright, and for two reasons. First, it is not a ‘work’. Secondly, and in the ordinary way, its creation does not imply sufficient literary skill or labour.”²

22. The applicant is therefore not able to assert copyright in the phrase “roundel wraps”.

23. The applicant also claims that the ebay listings reproduced in paragraph 5 above are copyright works. In contrast to the two-word phrase, the listings could be capable

² Paragraph 17.

of being copyright. The difficulty that the applicant has is that it is not clear how the registered design could be said to be a use of a work protected by the law of copyright.

24. Section 16 of the CDPA details the acts that are restricted by copyright in a work. These acts include copying, which is what Mr Isac alleged that the registered proprietor had done. Section 16(3) of the CDPA states that:

“References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –

- (a) in relation to the work as a whole or any substantial part of it; and
- (b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright.”

25. The only part of the listings that appears in the registered design is the phrase “roundel wraps”. In my view, it is not even an arguable, never mind a better than arguable, case that a two-word phrase could be a substantial part of the listings. Consequently I find that there is not a real prospect of success under section 11ZA(4). I therefore uphold the preliminary view to strike out this ground.

Outcome

26. The application to invalidate registered design no. 6095483 is struck out.

Dated this 21st day of February 2022

Clare Boucher
For the Registrar,
The Comptroller-General