

O/534/22

REGISTERED DESIGNS ACT 1949

IN THE MATTER OF A JOINT HEARING IN RELATION TO:

**REGISTERED DESIGN NO 6109463
IN THE NAME OF MONTANA DAVIS-HUNTER
IN RESPECT OF THE FOLLOWING DESIGN**



AND

**AN APPLICATION FOR INVALIDATION (NO 49/21)
BY LAUREN BUTLER**

Background

1. Montana Davis-Hunter (“the registered proprietor”) filed application no. 6109463 for a registered design for a disco ball planter in Class 11, Sub class 2 of the Locarno Classification (Articles of Adornment/Trinkets, Table, Mantel and Wall Ornaments, Flower Vases and Pots) on 10 December 2020. It was registered with effect from that date and is depicted in the following representations:





2. The following disclaimers were entered on the register:

*No claim is made for the colour of the disco ball or the colour of the rope attached.
No claim is made for the stick-on hook shown.*

3. On 29 June 2021, Lauren Butler (“the applicant”) made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Registered Designs Act 1949 (“the Act”), on the grounds that the registered design did not meet the requirements of section 1B of the Act. The applicant claims that the registered design was not new and did not have individual character on the date of application. As required by Rule 15 of the Registered Designs Rules 2006 (“the Rules”), she made this application on Form DF19A.

4. The application was served on the registered proprietor on 13 July 2021 and she was given a deadline of 24 August 2021 to submit a defence, pursuant to Rule 15(5) of the Rules. This Rule states that:

“The registered proprietor, within that period, shall

(a) file his counter-statement on Form DF19B; and

(b) send a copy of it to the applicant,

otherwise the registrar may treat him as not opposing the application.”

5. No defence was received and on 31 January 2022 the registry wrote to the registered proprietor informing her that it was minded to deem the opposition to the application as withdrawn as no defence had been filed within the prescribed period and that, in accordance with Rule 18 of the Rules, either party had the right to be heard on the matter.

6. The registered proprietor requested a hearing on 14 February 2022. At the same time, she submitted a Form DF19B.

The hearing

7. The matter came to be heard by me by telephone on 14 March 2022. At the hearing, Ms Davis-Hunter represented herself, while Ms Butler was represented by Coralie Todd. Ms Davis-Hunter did not dispute that she had received the Form DF19A, but stated that she had been prevented from filing the defence by a serious medical condition (sarcoidosis) which had left her largely bed-ridden and that she would be able to supply evidence from doctors to prove this. She admitted that she had hoped that the matter would go away and said that her condition had been at its peak during the period given for filing a defence. In addition, she stated that around this time she had moved house.

8. Ms Todd, for Ms Butler, said that the parties had exchanged messages on Instagram between 28 June 2021 and 2 July 2021, with the proprietor and/or her representatives¹ alleging that planters used in Ms Butler’s hairdressing salon infringed the registered design. On 14 July 2021 the DF19A was served on Ms Hunter-Davis. This provoked the response of “*Let’s Boogie!*” with a clenched fist emoji and a Biblical reference (Isaiah 54:17).² Ms Todd noted Ms Hunter-Davis’s comments that she had a team of volunteers helping her and that messages had been sent and considered that the

¹ At least one message was written by another named individual.

² “No weapon forged against you will prevail, and you will refute every tongue that accuses you. This is the heritage of the servants of the Lord, and that is their vindication from me, declares the Lord.” (New International Version, from www.biblehub.com/niv/isaiah/54-17.htm, accessed on 17 June 2022.)

defence could therefore reasonably have been filed during the period given by the Tribunal.

9. Following the hearing, I wrote to the parties on 23 March 2022 asking Ms Davis-Hunter to file the aforementioned evidence by 20 April 2022.

10. On 20 April 2022, Ms Davis-Hunter filed a letter of the same date from her GP and the Registry requested on 12 May 2022 that she resubmit it under cover of a witness statement, which was received, albeit unsigned, on 23 May 2022. A signed copy was filed on 6 June 2022. In this witness statement, she confirms that she moved house in July 2021 in order to access specialist medical care and be closer to her family. She states that at that time her condition was at its peak and was causing severe pain. The letter from her GP confirms the diagnosis and lists her symptoms, which I shall not detail here. Her GP states that *“This may have impacted her functionality and ability to focus.”*

Decision

11. Rule 19(1) of the Rules is as follows:

“The registrar may extend or shorten (or further extend or shorten) any period which has been specified under any provision of this Part.”

12. This includes the period of time for filing a counter-statement, which is specified under Rule 15(4). That provision does not prescribe how long the period of time should be.

13. There is limited guidance from case law on procedural matters specifically concerning registered designs. Where applicable, we follow the practice established in more frequent trade mark proceedings. However, it would not be appropriate to follow precisely the case law on late trade mark defences. Trade mark law is considerably more limited in the ability to extend time periods for the filing of a defence, although I note that there is the flexibility to extend certain other deadlines, such as for

filing evidence. This is provided for in Rule 77(1) of the Trade Marks Rules 2008 (SI 2008 No. 1797):

“Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar’s own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.”

14. In *LIQUID FORCE Trade Mark*, [1999] RPC 429, Mr Geoffrey Hobbs QC considered the exercise of discretion where there is this greater degree of flexibility. He said of the equivalent rule as it then stood:

“... I think that the discretion conferred by the provisions of that rule is as broad as the discretion conferred by the provisions of Order 3 rule 5(1) of the Rules of the Supreme Court:

‘The court may, on such terms as it thinks just, by order extend ... the period within which a person is required ... by these rules or by any judgment, order or direction, to do any act in any proceedings.’

In *Finnegan v Parkside Health Authority* [1998] 1 WLR 411 the Court of Appeal examined earlier appellate decisions as to the breadth of the discretion conferred by Order 3 rule 5(1) and followed the decision of the Court of Appeal in *Mortgage Corporation Ltd v Shandoes* [1996] TLR 751 to the effect that the absence of good reason for failure to comply with a time limit was not always and in itself sufficient to justify refusal of an extension of time; the true position being that it is for the party in default to satisfy the court that despite his default, the discretion to extend time should nevertheless be exercised in his favour, for which purpose he could rely on any relevant circumstances. Due weight can be given to the public interest in accordance with this approach and I think that it is the approach I ought

to adopt when considering the exercise of discretion under rule 62(1) of the 1994 Rules in the present case.”

15. I also bear in mind the comments of Mr Simon Thorley QC, sitting as the Appointed Person, in *Siddiqi’s Trade Mark Application*, BL O/481/00:

“1. It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. ...

2. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.

3. In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it.

4. Accordingly, it must be incumbent on the application for extension to show that the facts do merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”³

16. He also noted that:

“Each case must turn on its own facts and there can be no presumption that an extension will be granted.”⁴

³ Pages 6-7.

⁴ Page 8.

17. I consider that the principles outlined in these trade mark cases are applicable to the present case. I must decide whether to use my discretion to grant an indulgence, keeping in mind the need to balance the interests of both parties and of the public.

18. I accept that Ms Hunter-Davis was suffering from a debilitating medical condition. I have considered the applicant's arguments that Ms Hunter-Davis was assisted by a team of volunteers and that there had been correspondence between the parties. However, this appears to have been within a fairly short space of time (27 June – 2 July 2021), with a further message on 14 July 2021.

19. I have sought to balance the interests of both parties and the public. The consequence of upholding the preliminary view would be that Ms Hunter-Davis would lose her registered right on account of her medical condition. I accept that, should I allow the defence to be admitted, Ms Butler would be put to the additional costs of moving forward with the proceedings. However, should she be successful, she would be entitled to a contribution towards her costs.

20. Therefore, having heard the parties and considered the medical evidence submitted by Ms Hunter-Davis, I am of the view that it would be appropriate to overturn the registry's preliminary view to deem the application undefended. The proprietor's DF19B and counterstatement will be admitted into the proceedings and assessed accordingly. Provided that no anomalies are identified, it will then be formally served upon the applicant and a timetable set for the filing of evidence.

21. As these proceedings are to continue, any costs relating to the hearing will be considered at the final determination of the case.

Dated this 21st day of June 2022

Clare Boucher

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