

**O/0015/23**

**CONSOLIDATED PROCEEDINGS**

**REGISTERED DESIGNS ACT 1949**

**IN THE MATTER OF:**

**REGISTERED DESIGN NOS 6091966 & 6091816  
IN THE NAME OF I-SMART DEVELOPMENTS LIMITED**

**AND**

**APPLICATIONS FOR INVALIDATION (NOS 11/22 & 13/22)  
BY XIN ZHOU**

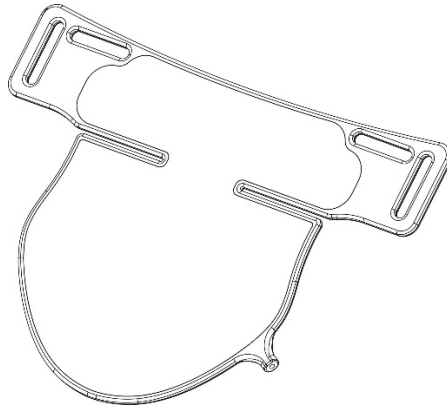
## Background and pleadings

1. i-Smart Developments Limited (“the registered proprietor”) filed application no. 6091816 for a registered design for a light therapy face mask in Class 24, Sub-class 01 of the Locarno Classification (Medical and Laboratory Equipment/Apparatus and Equipment for Doctors, Hospitals and Laboratories) on 10 June 2020. It was registered with effect from that date. The representations can be found in the Annex to this decision. I have reproduced the main representation below:



2. On 7 February 2022, Xin Zhou (“the applicant”) made applications 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 design did not meet the requirements of section 1B of the Act that a design should be new and have individual character. He claims that an identical product was advertised by a company called OMNILUX via a video on YouTube that had been available since 21 April 2020.

3. The registered proprietor filed application no. 6091966 for a registered design for a phototherapy device in Class 24, Sub class 02 of the Locarno Classification (Medical and Laboratory Equipment/Medical Instruments, Instruments and Tools for Laboratory Use) on 12 June 2020. It was registered with effect from that date. The representations can be found in the Annex to this decision. I have reproduced the main representation below:



4. On 25 March 2022, the applicant made an application for the registered design to be invalidated under section 11ZA(1)(b) of the Act on the grounds that the design did not meet the requirements of section 1B of the Act that a design should be new and have individual character. He claims that an identical product was advertised by a company called thelightsalon on various social media platforms, including Instagram on 29 January 2020.

5. The proprietor filed counterstatements to both these applications on 13 May 2022 and 5 May 2022 respectively. It admitted that the designs were identical to the prior art filed by the applicant, but claimed that they were designed by the proprietor and disclosed with its consent during the period of 12 months immediately preceding the application date. Therefore, they were permitted disclosures under section 1B(6)(d) of the Act. At the same time, the proprietor filed evidence from Susan D'Arcy, Director, i-Smart Developments Limited.

6. Neither side requested a hearing. I have taken this decision after a careful consideration of the papers before me. In these proceedings, the applicant is represented by Greg Sach and the registered proprietor by Certainty IP.

## **Evidence**

### ***Registered Design No. 6091816 (invalidation no. 13/22)***

7. Mr Zhou relies on the following disclosures:

A1) A YouTube video advertising “OmniLux Contour FACE” available on the platform since 21 April 2020;

A2) An Instagram post from Sarah Akram Skincare showing the Omnilux Contour Face and dated 7 May 2020;

A3) Another Instagram post showing the Omnilux Contour Face, this time from Paul Labrecque Salon & Spa, dated 30 May 2020; and

A4) A YouTube video from a company called DP Derm advertising a product SKINLITE, available on the platform since 14 April 2020.

8. Ms D’Arcy’s witness statement for the proprietor is dated 11 May 2022. She explains that i-Smart Developments is a developer of phototherapeutic products with a turnover in excess of £5 million. It has developed a phototherapy facial device and supplies this to what she describes as “*well-known global brands including Omnilux and DP Derm*”. She states that the products shown in A1-A3 by the applicant are the Omnilux Contour Face which is a product designed and manufactured by i-Smart and supplied to the owner of the Omnilux brand, GlobalMed Technologies (“GlobalMed”). Exhibit SD1 is an invoice from i-Smart dated 10 March 2020 showing the sale of 500 Omnilux contour products to GlobalMed. Exhibit SD2 is a witness statement from Quinten Stainer, President of GlobalMed, dated 11 May 2022. He confirms that the Omnilux Contour Face is manufactured and supplied to GlobalMed by i-Smart and that the disclosures at A1-A3 were made directly by GlobalMed or as a result of GlobalMed’s marketing activities, and were made with the consent of the proprietor.

9. Ms D’Arcy goes on to say that the product shown at A4 is the SKINLITE which is designed and manufactured by i-Smart and sold by DP Derm LLC. Exhibit SD3 is an invoice from i-Smart dated 19 March 2020 showing the sale of 500 units of SKINLITE to DP Derm. Exhibit SD4 is a witness statement from Joel Marshall, Director of DP Derm, dated 11 May 2022. He states that his company markets and sells a phototherapy facial treatment under the product name “Facelite”, that the “Facelite” product disclosed in A4 is the same “Facelite” product that they sell and that it is designed and manufactured by i-Smart. He also states that the disclosure at A4 was

made by DP Derm, or as a result of its marketing efforts, and was made with the consent of the proprietor.

***Registered Design No. 6091966 (invalidation no. 11/22)***

10. Mr Zhou relies on the following disclosures:

A1) – A4) Instagram posts from a company called thelightsalon showing a product called “Boost” and dated 29 January 2020, 30 January 2020, 11 February 2020 and 6 March 2020;

A5) A review taken from nordstrom.com of the “Boost” product dated 23 May 2020;

A6) An article from purewow.com dated 13 May 2020 and entitled “What are LED light therapy masks & do they really work?” Boost is one of the product recommended.

11. Ms D’Arcy’s witness statement for the proprietor is dated 5 May 2022. She gives the same background information as in her evidence in the other invalidation action. She states that the Instagram account from which the posts in A1 to A4 were taken is operated by The Light Salon Boost Limited, a customer of the opponent. The product shown in the posts is The Light Salon Boost LED Bib for Neck and Décolletage was, Ms D’Arcy attests, designed and manufactured by iSmart according to the contested design and supplied to The Light Salon. Exhibit SD1 is an invoice from i-Smart dated 8 January 2020 showing the sales of 500 units of the Boost Bib to The Light Salon. Exhibit SD2 is a witness statement from Laura Ferguson, Director of The Light Salon Boost Limited, dated 28 April 2022. She confirms that her company operates the aforementioned Instagram account and sells “The Light Salon Boost LED Bib for Neck and Décolletage” designed and manufactured by the opponent. She also states that the disclosures at A1 to A4 were made by or as a result of its marketing efforts, and were made with the consent of the proprietor.

## **Decision**

### ***Legislation***

12. Section 11ZA(1)(b) of the Act states that:

“The registration of a design may be declared invalid –

...

(b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act”.

13. Section 1B of the Act is as follows:

“(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 account.

(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 conditions 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 period of 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.

...”

14. As I have already noted, the proprietor admits that the registered designs are identical to the prior art relied on by the applicant and has claimed that the disclosures were made within the twelve months prior to the date of application for the designs and were made with the permission of the proprietor. Therefore, it argues, the disclosures are exempt under section 1B(6)(d) of the Act.

15. The earliest disclosure of Registered Design No. 6091816 was made on 14 April 2020 by DP Derm. A later disclosure was made on 21 April 2020 by GlobalMed. The application date was 10 June 2020. The earliest disclosure of Registered Design No. 6091966 was made on 29 January 2020 by The Light Salon Boost Limited. The application date was 12 June 2020. All the disclosures were therefore made in the twelve-month period provided by the Act.

16. The witnesses from all three of these companies state that the disclosures were made with the consent of the proprietor. For each of these companies, the proprietor has supplied an invoice for a final payment for 500 units of the product using the registered design. All these invoices have a date before the earliest disclosures recorded above. The invoice to GlobalMed states that 20 units have already been delivered.

17. The other evidence relied on to destroy the novelty of Registered Design No. 6091966 (A5 and A6) comes from two different websites. However, they both show The Light Salon Boost bib and are dated after the disclosures mentioned above.

18. The evidence has not been challenged by the applicant. The witness statements of the individuals from DP Derm, GlobalMed and The Light Salon are corroborated by the invoices. Supplying these companies with the product would in my view under “*other action taken by the designer*” in section 1B(6)(d) of the Act. I find that the disclosures were made as a consequence of actions taken by the designer and so I



find that they are exempt disclosures under section 1B(6)(d) of the Act and do not destroy the novelty of the contested designs.

## **OUTCOME**

19. The applications to invalidate the registered designs nos. 6091816 and 6091966 have failed. They will remain registered.

## **COSTS**

20. The proprietor has been successful. In the circumstances, it is entitled to a contribution towards the costs of the proceedings in line with the scale of costs set out in Tribunal Practice Notice 2/2016. I award the proprietor the sum of £1000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

*Preparing statements and considering the other side's statements: £400*

*Preparing evidence: £600*

*Total: £1000*

21. I order Xin Zhou to pay i-Smart Developments Limited the sum of £1000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

**Dated this 6<sup>th</sup> day of January 2023**

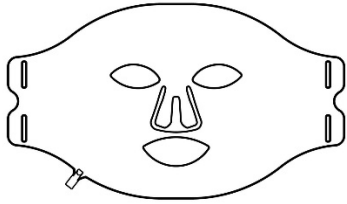
**Clare Boucher**

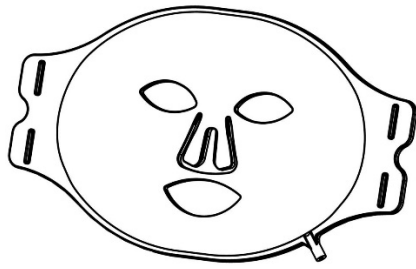
**For the Registrar,**

**The Comptroller-General**

**Annex**

**Registered Design No. 6091816**





**Registered Design No. 6091966**

