

Review

Intellectual Property

Prior Art to Twin Spray Bottle UK Registered Designs

Registered designs 4001559 and 4001666 in the name of Central Vista (M) SDN BHD and applications for invalidation (23/07 and 24/07) by Pemi Trade s.r.o (Decision O-137-09 dated 18 May 2009)

Pemi Trade s.r.o (“Pemi”) provides a recent example in this decision as to how the application and publication of a Community Registered Design can invalidate UK design registrations, in this case, those UK design registrations of Central Vista (M) SDN BHD (“Central”).

This decision is on an application by Pemi to invalidate two of Central’s UK design registrations (the “Central Registrations”). The Central Registrations are of numbers 4001559 (in respect of a ‘bottle for twin spray candy’) and 4001666 (in respect of a ‘twin spray bottle’), and their application dates, of 9 and 15 February 2007 respectively, were crucial to the decision making.

Pemi is the registered proprietor of Community Design registration 000533401-0001 (the “Pemi Registration”) which is protected in respect of sprays for liquid confectionary. The Pemi Registration was applied for and registered on 22 May 2006, and published on 20 June 2006. Both the Pemi Registration and the Central Registrations are registered in relation to a container with two separate compartments and sprays (the “Container”). A representation is set out below:



Pemi’s case is that the Central Registrations contravene the Registered Designs Act 1949 (the “Act”), on the grounds that they were neither new nor of individual character at the date of their application, having regard to the prior art contained in the Pemi Registration. The Act provides for such a contravening design to be invalidated.

This case shows how the application and publication of a Community Registered Design can invalidate UK design registrations

Central in no way disputed that the Central Registrations were not new and lacked individual character, when compared to the Pemi Registration. Any such argument would have been in vain as it was decided that it was beyond dispute that the Central Registrations were not new and neither did they have individual character. The differences between the two parties' designs were only minor and trivial in nature, did not affect overall appearance, and were only noticeable on close forensic analysis.

Prior to any of the above registrations, Pemi and Central forged a business relationship for the manufacture and supply of Containers from Central to Pemi, and the prototype was displayed at an exhibition in Germany in January 2006. The Containers' capacity was subsequently increased in size with the first shipment made on 23 April 2006 (just less than one month prior to the application for the Pemi Registration). It was this slightly modified design which was the subject of both the Pemi Registration and the Central Registrations.

The Act provides that prior art can only be relied on to invalidate a registered design if it has been disclosed to the public prior to the application date of the registered design. From the dates referred to above, it was deemed a straightforward matter that the Pemi Registration, applied for on 22 May 2006 and published on 20 June 2006, constituted a disclosure prior to the Central Registrations' applications in February 2007. While the parties both sought for protection for the same design, despite their previous business relationship and Central contending that it was their design, it was deemed to be a simple fact that Pemi 'got there first' by obtaining the Pemi Registration, and this effectively rendered the Central Registrations invalid.

It was therefore decided that there could be no dispute that the Pemi Registration constituted a prior disclosure. It was not, however, considered in the decision that Central might actually be the designers of the Container (as opposed to Pemi) and therefore that the Pemi Registration disclosure might not constitute a disclosure precluding the Central Registrations from being considered new or having individual character.

It was further decided that the exhibition of the product at the January 2006 exhibition in Germany (which was deemed substantially the same as the Central Registrations, differing only in capacity) could also constitute a novelty-destroying disclosure. Even if Central were deemed to be the designer of the Container, this disclosure was outside the 12-month period prior to the application of the Central Registrations and therefore would have been novelty-destroying.

The decision serves as a lesson, in any relationship involving the design and manufacture of products, for parties to properly document who owns, and who is entitled to use, any intellectual property rights in the relevant product. Further, parties seeking to register their design in the UK should always bear in mind the prior art which may exist, including as a Community Registered Design, and care should always be taken, taking into account the relevant dates, to avoid destroying novelty by making the relevant design available to the public, for example at trade fairs or other exhibitions.

FURTHER INFORMATION

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