

Request to invalidate a design registration - Statement of Case

A statement of case must accompany Form DF19A when a request to invalidate a design registration is made. Completion of this *pro-forma* statement of case is not compulsory, you may opt instead to draft your own statement of case. When completing this *pro-forma* statement of case, please tick which ground(s) you wish to rely on and then provide the requested further information in the corresponding spaces in order to explain the basis for your request for invalidation. You may continue on a blank sheet of paper if you need more space.

Any information you give in your statement of case will be treated as evidence in the proceedings. You may, though, need to provide further evidence to prove what you have claimed in your statement of case.

A summary of the possible grounds for invalidation is provided at the end of this *pro-forma* statement of case. You should read this before deciding which grounds you wish to rely on.

This *pro-forma* statement of case is broken down into related grounds rather than following the exact order set out in the Registered Designs Act 1949. The applicable grounds for completion are:

Page 1 - Grounds relating to novelty and individual character compared to other designs

Page 2 - Grounds relating to technical function, public policy or morality and grounds relating to the use of certain flags, emblems etc.

Page 3 – Grounds relating to disputes of ownership, to breach of copyright, and to breach of other earlier distinctive signs (such as trade marks), and a ground that the design being challenged is not a design at all.

Grounds relating to conflict with other designs (be it those that have been used already or applied for and/or registered) are the most common form of ground. This is dealt with by the grounds set out on page 1.

Grounds relating to novelty and individual character (s.1B is utilised under the provisions of s. 11ZA(1)(b))

S.1B: The design is not new nor does it have individual character compared to other designs that have been made available to the public before the application date of the design you are challenging. Please provide a representation of the other design(s), its application or registration number if it has one, and tell us when and how it was made available to the public.

11ZA(1A): The design is not new nor does it have individual character compared to an earlier filed design under this Act (or under the Community Design Regulations) of which I am the proprietor, which was made available to the public on or after the application date of the design you are challenging. Please provide the application/registration number of your design and tell us when and how it was made available to the public.

Grounds relating to technical function, public policy or morality (these grounds are utilised under the provisions of s. 11ZA(1)(b))

S.1C(1): The design subsists in features of appearance of a product which are solely dictated by the product's technical function. I say this because:

S.1C(2): The design subsists in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function. I say this because:

S.1D: The design is contrary to public policy or to accepted principles of morality because:

Grounds relating to the use of flags, emblems etc. (Section 11ZA(1)(C))

Please state which particular ground under schedule A1 you are relying on and provide the details of the flag, emblem etc. the use of which you are concerned.

Summary of possible grounds

The grounds for invalidation are set out in section 11ZA of the Registered Designs Act 1949 (as amended) (“the Act”). They are, in summary:

11ZA(1)(a) – because the design does not fulfil the requirements of **section 1(2)** of the Act. Section 1(2) sets out what a design is, namely, the appearance of the whole or a part of a product resulting from the features of, or in, the lines, contours, shape, texture or materials of the product or its ornamentation.

11ZA(1)(b) – because the design does not fulfil the requirements of **sections 1B to 1D** of the Act. Sections 1B to 1D relate to:

Section 1B – The requirement that a design must be new and have individual character compared to other designs that have been made available to the public before the relevant date (normally the date on which the design you are concerned with was applied for). Being made available to the public means published (whether following registration or otherwise), exhibited, used in trade, or otherwise disclosed (this is subject to certain exceptions). Publication in the Design Journal counts as being made available to the public.

Section 1C – The requirement that a design must not subsist in features of appearance solely dictated by technical function, or which are necessarily shaped to perform its function (or the function of something to which it is connected).

Section 1D – The requirement that designs should not be contrary to public policy or to accepted principles of morality.

11ZA(1)(c) – this relates to the grounds of refusal mentioned in Schedule A1 to the Act which cover refusal of designs that involve the use of Royal arms, amorial bearings and Insignia, UK flags, arms granted by the Crown, controlled representations under the Olympic Symbols etc (Protection) Act 1995, and flags, emblems, insignia and hallmarks of, or protected by, a Paris Convention country.

11ZA(1A) – This relates to the invalidation of a registered design (because it is neither new or has individual character) on the basis of an earlier UK design under this Act or the Community Design Regulation which has been made available to the public on or after the relevant date. Only the proprietor of the earlier design may request invalidation on this ground. Publication in the Design Journal counts as being made available to the public.

11ZA(2) – because the registered proprietor is not actually the proprietor of the design – only the claimed true proprietor can object on this ground.

11ZA(3) – because the design involves the use of an earlier distinctive sign. You can only make this request if you are the holder of the earlier distinctive sign which includes the right to prohibit in the UK such use of the sign.

11ZA(4) – That the design constitutes an unauthorised use of a work protected by the law of copyright in the UK. Only the owner of the copyright may request invalidation on this ground.