

EIP

Popular tourist design held invalid

A design, which is no doubt familiar to most readers, has been held invalid by Recorder Douglas Campbell QC in a recent IPEC decision ([here](#)).

Background

The Claimant, Mr Erol, brought a claim against Posh Fashion Limited for infringement of his two registered designs (dated 18 May 2011) which were for the front and back of a hoody and tee-shirt bearing a legend which consists of the word London, the Union flag and the word England (the “London+Flag+England” legend). The designs are registration numbers 4 020 066 and 4 020 067 respectively.

The Defendant sought to invalidate both designs on the basis that neither of them were new and/or had individual character. In particular, the Defendant relied on three pieces of prior art:

- A brochure by Urban Attitude dated 1999 which included a tee-shirt and hoody bearing the “London+Flag+England” legend;
- A screenshot of a tourist outlet’s (Lambert Souvenirs) website which featured a red hoodie bearing the “London+Flag+England” legend; and
- Images from the website of KK Hosiery (which was run by Mr Zarguly of the Defendant) which feature hats and caps bearing the “London+Flag+England” legend.

The issue of infringement largely fell away during the trial – the Defendant did run a non-infringement defence on the basis of colour alone as, if the designs were held to be valid they were limited to red and grey but the Defendants did not sell any red hoodies or grey

tee-shirts.

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The key issue to be considered at trial was therefore whether or not the designs were valid.

Legal issues

For a design to be registered it must be (i) new and (ii) have individual character (s.1B(1) Registered Designs Act 1949 (as amended) (the 'RDA').

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" (s.1B(2) RDA). 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" (s.1B(3) RDA).

Further, with regard to colour "if colour forms no part of the design then it is conventional to file the design in black and white. Similarly, if a particular colour does form part of an aspect of a design then it may be filed wholly or partly in that colour. So also, if monochrome colours are a feature of the design, this can be shown by placing the design against a background of a uniform but different colour." (Lord Neuberger, in *PMS v Magmatic* [2016] UKSC 12)

The Court's decision

In his decision Recorder Douglas Campbell QC stated that the "hoody shown in the [066] design is unexceptional" and that "the only element which can convey novelty and/or original character on the design as a whole is the legend itself". Mr Campbell QC also found that the colours formed part of the design.

On the basis of the hoody's "unexceptional" design Mr Campbell QC found the 066 design invalid having regard to the Urban Attitude Brochure. In particular, he found that the Urban Attitude "London+Flag+England" legend is identical to the 066 design and that changing the colour from blue (as in the Urban Attitude Brochure) to red did not confer individual character. Accordingly, even if the 066 design was novel over Urban Attitude, it would lack individual character with respect to it.

The 067 design was also invalid having regard to the Urban Attitude Brochure for the same reasons.

Given that the designs were invalid with respect to the Urban Attitude Brochure it was not necessary to consider validity over Lambert Studios or KK Hosiery. That said, Mr Campbell QC did briefly address the Lambert Studios prior art and confirmed that the designs were invalid having regard to this as well.

This judgment is perhaps unsurprising and will no doubt be welcome news for all of the tourist outlets across London!