

O-0449-25

REGISTERED DESIGNS ACT 1949 (AS AMENDED)

**IN THE MATTER of Registered Design No. 4017255 in the name of
Stephen L. Preston in respect of a mount board design**

and

APPLICATION TO INVALIDATE (No. 169/23) by Artsylaser Limited

DECISION

1. On 11 August 2023, Artsylaser Ltd applied to invalidate registered design No. 4017255 ("the '255 Design") which is the subject of this appeal, and on the same date also applied to invalidate registered designs Nos. 4017253 and 4017254. All three designs are registered in the name of the same proprietor, Mr Stephen L. Preston, have the same registration date of 2 October 2010, and are in respect of mount boards (classified within mirrors and frames).
2. The actual content of these designs is not relevant to this appeal, so I am not following the normal practice of putting a picture of the design into my decision.
3. Copies of the three applications to invalidate were posted out by the Office to the proprietor on 18 August 2023 via the Royal Mail Special Delivery Guaranteed service. It appears that they were sent in separate

envelopes. The proprietor received notice of the application relating to the '254 design and duly filed a defence. However, he says that he never received notice of the applications relating to the '253 or '255 designs so did not respond to those applications to invalidate.

4. On 30 October 2023, Mr Raoul Colombo issued orders in relation to those two cases recording that the proprietor had not filed a Form DF19B and counterstatement within the 6 week period required under rule 15(5) of the Registered Designs Rules 1996 in relation to the '253 and '255 designs, and accordingly ordered that those two designs were deemed to be invalid.
5. Subsequently the Office accepted on the basis of representations made by the proprietor that he had not received notice of the invalidation application relating to the '253 design and Mr Colombo's order relating to that design was rescinded. However the Office was not sufficiently satisfied that the proprietor had not received such notice in relation to the '255 design, and hence declined to rescind Mr Colombo's order in relation to that design.
6. Hence the proprietor now appeals to me against Mr Colombo's order of 30 October 2023 in relation to the '255 design.
7. When the appeal first came to me, I was asked to deal with it urgently. It was hoped that if the appeal were successful, the restored invalidity proceedings in relation to the '255 design could proceed together with those relating to the other two designs. On that basis I appointed a very early hearing date giving only a few days longer than the statutory minimum notice.

8. However, shortly before the hearing was due to take place, I was informed that the invalidity applicant had withdrawn all three applications and did not wish to resist the proprietor's appeal. Accordingly I was asked to vacate the hearing and deal with the appeal on the papers on a non-urgent basis.

Merits of the appeal

9. The proprietor is represented on the appeal by McDaniels Law solicitors who filed a notice of appeal to the Appointed Person which contains the results of quite extensive investigations into the circumstances in which (according to the proprietor's case) he did not receive notice of the invalidation proceedings relating to the '255 design. The factual account contained in the notice of appeal has been supported by a Statement of Truth from Mr Preston and by a number of exhibits.
10. I am prepared to treat this as an application to adduce new evidence on the appeal and I exercise my discretion to allow it in.
11. The Office declined to rescind Mr Colombo's order relating to the '255 design because it had received back from the Royal Mail what purported to be a proof of delivery. This contained a photograph showing the envelope resting on what looks like the boot of some kind of vehicle, and records that a "G HOGG" signed for it. There is a facsimile signature which like so many signatures taken on tablets is illegible.
12. The proprietor has provided documentary evidence that he was away in Spain until the day of the purported delivery (21 August 2023) and his flight arrived back in the UK more than an hour after the time of the

purported delivery. He gives evidence that his premises were closed throughout that day so could not have received the delivery. He employs only three staff members, none of whom is named G HOGG. In short, the proprietor says that he was not in the country at the time the Form DF19A was supposedly delivered, that there was nobody present to receive it at the address to which it was sent and that, although someone apparently signed for its receipt, that person was not employed by or known to the proprietor.

13. He further gives evidence that he did not receive a chaser letter from the Office dated 10 October 2023 despite Royal Mail having provided a facsimile signature, which the proprietor denies is his.
14. Dealing with the overall probabilities of the situation, it should be remembered that the proprietor did receive the Form DF19A for the '254 design and duly responded to it. There seems no plausible reason why the proprietor, if he did receive the DF19A relating to the '255 design, should have chosen to ignore it rather than responding to it in the same way as he did to the attack on the '254 design.
15. Therefore I hold it proved on the balance of probabilities that the proprietor did not receive notice of the Form DF19A nor did he receive the follow up letter dated 10 October 2023, as a result of deficiencies on the part of Royal Mail acting as delivery agent for the Office. This is not therefore a case (in contrast to my decision O/1002/22 "Tyre Tools" dated 8 November 2022) where the Form DF19A was duly delivered to the proprietor's correct address but the proprietor seeks an indulgence because of his own difficulties in collecting and dealing with the correspondence. By analogy with the practice when setting aside default

judgments in civil proceedings, the proprietor is entitled to have the default order set aside as a matter of justice without needing to enquire into the merits of the case.

16. My understanding is that the invalidity proceedings are no longer live and therefore the effect of setting aside the default order will simply be that the '255 design is restored to the Register. This is not a case where it is appropriate to make any order for costs.

Disposition

Order: I allow the appeal and order that the Order of Mr Raoul Colombo dated 30 October 2023 which deemed Registered Design No. 4017255 to be invalid be set aside, and that the said design be restored to the register with effect from the date of Mr Colombo's Order.

Martin Howe

Martin Howe KC
Appointed Person (Designs Appeals)
22 May 2025