

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE  
MARKS IN PROCEEDINGS UNDER THE INDUSTRIAL DESIGNS ACT, 2001**

BETWEEN

**WILLIAM O'CONNELL (Applicant for Declaration of Invalidity)**

**and**

**ROBERT SCANLON (Proprietor of the Design and Opponent to the Application)**

CONCERNING

**Registered Industrial Design No. 21726**

**The Registered Design**

1. Robert Scanlon, of Allied Imports Limited, Allied House, Unit 804 Northwest Business Park, Ballycoolin, Dublin 15, Ireland is the registered proprietor of the Industrial Design, depicted below, and titled “*a hat with a peak and with a 'patchwork' design*”, which was applied for on 15 January, 2014 (the “relevant date”) and is registered under No. 21726 in Class 2, Sub Class 03 in respect of “Headwear, Hats”.



**The Application**

2. On 1 September, 2014, William O'Connell, Director of Enterprise Asia JH Limited, of 32 Block A, Dunboyne Industrial Park, Dunboyne, Co. Meath, Ireland, applied under Section 47 of the Industrial Designs Act, 2001 (the “Act”) for a Declaration of Invalidity of the registration and included with the application a statement of the grounds on which it was made and supporting evidence.
3. On 10 September, 2014 Robert Scanlon (the Proprietor) filed a Notice of Opposition against the application under Rule 37(4) of the Industrial Design Regulations, 2002 (“the Regulations”), and attached supporting evidence.

4. The Applicant attended and represented himself at a Hearing of the matter, held on 6 November, 2014. The Proprietor declined to attend the Hearing. The matter was decided by me, acting for the Controller and the parties were notified of my decision to reject the Application for a Declaration of Invalidity by letter of 18 November, 2014. I now state the grounds of my decision and the materials used in arriving thereat.

### **Grounds of the Application**

5. In his Statement of Grounds in support of the Application for a Declaration of Invalidity, the Applicant makes a number of statements and claims, which I summarise as follows:
  - (i) The Applicant refers to Section 11 of the Act, which specifies that a design must be new and have individual character in order to qualify for registration, and claims the design at issue is neither new nor has individual character.
  - (ii) The disputed design offends against Section 12 of the Act because identical designs were previously made available to the public before the filing date for registration. The Applicant attaches a number of advertisements, downloaded from various websites (including [www.hatshop.ie](http://www.hatshop.ie), [www.hannahats.com](http://www.hannahats.com), [www.amazon.co.uk](http://www.amazon.co.uk), [www.celticcloting.com](http://www.celticcloting.com), [www.carnaweenclothing.com](http://www.carnaweenclothing.com), [www.irishtweeds.com](http://www.irishtweeds.com)), containing what the Applicant claims are images of hats identical, or differing only in immaterial detail, to the Proprietor's registered design, but in existence long before the disputed design was registered.
  - (iii) The disputed design does not possess the degree of individual character required for registration and, therefore, offended against Section 13 of the Act.
6. As well as advertisements depicting a variety of flat caps and the like, the Applicant also submitted a still from the RTE television programme "Reeling In The Years" from 1989 showing a man wearing a flat cap and material, including stills, relating to the film "The Quiet Man" (the famous John Ford movie made in Ireland in 1952) in which John Wayne appears with a flat cap.

## Notice of Opposition

7. In his Notice of Opposition against the application for a Declaration of Invalidity, Robert Scanlon denies all the grounds and makes a number of statements and claims supporting that denial. He also provides the context in which these proceedings are set, namely that the Applicant had been warned off from placing hats of a similar or identical design to that of his registered design under threat of infringement proceedings.
8. Mr. Scanlon states that his company (Allied Imports) was established in 1973 and has earned, over a period of 40 years, a reputation in the Irish souvenir sector for designing and marketing innovative and unique merchandise. During this period he and Allied Imports have registered more than fifty trademarks or designs with the Patents Office.
9. The Applicant is a representative of Enterprise Asia JH Limited, which was established in 2013. They have no reputation for innovative products but boast on their website “... *to offer low cost manufacturing*” (emphasis added by the Proprietor). Since its incorporation neither Enterprise Asia JH Limited nor William O’Connell have made any applications to the Patents Office to protect any intellectual property.
10. Having received a cease and desist letter from the Proprietor’s Trade Mark Attorneys the Applicant nonetheless went on to import into Ireland, what the Proprietor claims are, hats that infringe the Proprietor’s registered design. The Proprietor states the filing of the application for a Declaration of Invalidity is simply a tactic to defend the infringement of the Proprietor’s design rights and not for any genuine design conflict reason.
11. Mr. Scanlon offers an opinion that the material submitted in support of the application demonstrates the Applicant does not understand the design process or its mechanisms. The Applicant appears to believe that because he can show that flat caps existed prior to the application for the disputed design that the application is invalid. This is clearly not the case.
12. Mr. Scanlon states that while the Applicant has submitted many different images of caps, none of them are identical to the disputed design. What in fact the Applicant has done is demonstrate clearly that there are many differing designs of flat caps available on the market. In stating that “... *advertisements downloaded from the web from Hanna Hats of*

*Donegal producing similar items since 1924 ...*”, the Applicant confirmed that a number of design similar to, but not identical to, the Proprietor’s design exist.

### **The Act**

13. For the purposes of these proceedings the relevant provisions of the Act are Sections 11, 12 and 13. Section 11 mandates that a design must be new and possess individual character in order to qualify for registration, while Sections 12 and 13 define what is meant by “new” and “individual character” respectively. These Sections are written in the following terms:

*11.(1) A design that is new and has individual character shall be registrable under this Act.*

*(2) A design shall not be registrable under this Act if the applicant for registration of the design is not the proprietor of the design.*

*12.(1) A design shall be considered to be new where no design identical to it has been previously made available to the public before the filing date for registration or, where priority is claimed, the date of priority.*

*(2) A design shall be deemed to be identical to a design which has been previously made available to the public where its features differ only in immaterial details.*

*13.(1) A design shall be deemed to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by a design which has been made available to the public before the filing date of the application for registration or, where priority is claimed, the date of priority.*

*(2) In assessing individual character, the degree of freedom of the author of the design in developing the design shall be taken into consideration.*

### **Application of the Act**

14. In the Act a “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colour, shape, texture or materials of the product itself or its ornamentation. I cannot attach any relevance to the description of the design as supplied by the Proprietor when he lodged his application, in this case “*A hat with a peak and with a 'patchwork' design*”. This is because, oftentimes, the description of a design can be at variance with the representations provided by an applicant for registration. However, this is not the case in these proceedings as the representations of the design are in line with the description.

15. The question of novelty is not to be determined by whether or not all parts of a design are new, but on whether the whole design has, or has not been seen before, or whether the design is so nearly identical to prior art that the only differences are in respect of immaterial details. In assessing whether or not the disputed design is new I must look only at the design itself, as depicted in the application for registration.
16. In these proceedings the burden of proof does not rest with the Proprietor to prove his design is new. It rests with the Applicant to prove the disputed design is not new. In this regard the Applicant submitted with his application images of over 300 different hats and singled out specific images that he felt were the same or similar to the disputed design. The disputed design is a flat cap with a peak, consisting of a patchwork of different materials or fabrics, each being cut into what might be described as the shape of a parallelogram and arranged in a grid pattern on the main body of the cap. At the back of the cap there is a strip of material containing an adjustable metal clasp that allows the wearer to adjust the circumference of the cap to the desired size. There are many flat caps on the market made with the same material as that used in the disputed design. There are many flat caps with a grid pattern consisting of the same geometrical shapes as those used in the disputed design. Also, I have no doubt that, the mechanism used for adjusting the size of the cap is to be found on other flat caps.
17. However, on examination, I find none of the hats submitted by the Applicant are identical to the disputed design. Nor, in my opinion, are any of the images of other hats so nearly identical to the disputed design that they differ in immaterial detail alone. I am satisfied the disputed design is new and does not offend against Section 12 of the Act and, therefore, I reject the application for a Declaration of Invalidity on that ground.
18. Turning now to the question of individual character. On first viewing I found little that struck me as particularly innovative or unusual about the design. However, I admit I am no expert when it comes to flat caps and confess I have never owned or worn headgear of that type. Therefore, I cannot consider myself to be an informed user. But, in order to reach a determination on these proceedings I must put myself in the shoes of an informed user. For the purposes of these proceedings an informed user is not a milliner or a person skilled in the art, nor is it a casual observer or an infrequent user of the product type. The informed user must be considered to be someone who would have an average degree of

exposure to flat caps of differing designs and would know something about the subject matter. The level of exposure would be sufficient to allow them to form an opinion, without the need to conduct a forensic examination, on whether or not their overall impression of the design is that it differs in character from other designs already known to them.

19. In the present case I am satisfied an informed user would notice the use of three different types of tweed material – herringbone, houndstooth and plain. The configuration of the pattern would also be noticed, in particular the placing of three patches of herringbone tweed-type material across the diagonal running from front left to back right (as viewed from the front). Another noticeable feature of the pattern is the placement of the three plain patches and the three houndstooth patches on the main body of the hat in such a configuration that the position of the plain patches are in a mirror-image of the houndstooth patches when reflected through the front-left to back-right diagonal. The peak consists of a plain dark material which is also used on the area of the body of the cap immediately above the peak. This would not, in my opinion, go unnoticed. The clasp mechanism for tightening and loosening the cap would also attract the attention of the informed user. As none of the 300 plus images submitted in support of the application bears this feature I must conclude that it is not typically found on patchwork flat caps.

20. I find there are a number of noticeable features in the design which are not all repeated on any single design the Applicant has brought to my attention. These features would, in my opinion, enable the informed user to reach the conclusion that the design has a degree of individual character that sets it apart from other designs already known to him/her. Therefore, the design does not offend against Section 13 of the Act. Accordingly, I must reject the application on this ground.

21. Having failed on all grounds, I hereby reject the application for a Declaration of Invalidity. Accordingly, I allow the design to remain on the Register.

Dermot Doyle

Acting for the Controller

3<sup>rd</sup> March 2015