

O-285-08

**AN APPLICATION BY MRS DOROTHY CLARK**  
**UNDER SECTION 11ZA OF THE REGISTERED DESIGNS ACT 1949 (AS**  
**AMENDED)**  
**FOR THE INVALIDATION OF REGISTERED DESIGN No. 3018250**  
**IN THE NAME OF NICOLA PACQUETTE**

## **BACKGROUND**

1. On 29 July 2004 Nicola Pacquette applied under the Registered Designs Act 1949 (as amended by the Registered Designs Regulations 2001) to register a design consisting of the appearance of an article of clothing being a pull on top with grown-on mittens and thumb sleeves. Registration was granted.

2. A copy of the representations of the registered design is at Appendix One to this decision.

3. On 21 November 2006 Dorothy Clark filed an application under Section 11ZA(1)(b) and 11ZA(2) of the Act to invalidate the registered design on the basis that the design was not new and had been in the public domain for some 24 years, and that Dorothy Clark is the proprietor of the design.

## **THE APPLICABLE LEGISLATION**

4. The relevant parts of Section 11ZA of the Act (as amended) are as follows:

- (1) The registration of a design may be declared invalid -
  - a) on the ground that it does not fulfil the requirements of Section 1(2) of this Act
  - b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act;
  - c) where any ground of refusal mentioned in Schedule A1 to this Act applies.
- (1A) The registration of a design (“the later design) may be declared invalid if it is not new or does not have individual character when compared to a design which –
  - a) has been made available to the public on or after the relevant date; but
  - b) is protected as from a date prior to the relevant date –
    - (i) by virtue of registration under this Act or the Community Design Regulation or an application for such registration, or
    - (ii) by virtue of an international registration (within the meaning of Articles 106a to 106f of that regulation) designating the Community.

- (1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.
- (3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.
- (4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.
- (5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

5. Section 1B of the Act provides that:

- (1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design whose features differ only in immaterial details has been made available to the public before the relevant date.
- (3) For the purposes of subsection (1) above, 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.
- (4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.
- (5) For the purposes of this section, a design has been made available to the public before the relevant date if-

- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
  - (b) the disclosure does not fall within subsection (6) below.
- (6) A disclosure falls within this subsection if-
  - (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
  - (b) it was made to a person other than the designer, or any successor in title of his, under condition of confidentiality (whether express or implied);
  - (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
  - (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
  - (e) it was made during the 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.
- (7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and have individual character –
  - (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
  - (b) to the extent that those visible features of the component part are in themselves new and have individual character.

- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.

6. Section 11ZB provides that:

- (1) Any person interested may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.
- (2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(c) of this Act.
- (3) The relevant person may make an application to the registrar for a declaration of invalidity under section 11ZA(1A) of this Act.
- (4) In subsection (3) above the “relevant person” means, in relation to an earlier design protected by virtue of registration under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.
- (5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that section.
- (6) An application may be made under this section in relation to a design at any time after the design has been registered.

## **THE EVIDENCE**

7. The evidence submitted by the applicant on 25<sup>th</sup> April 2007 included two witness statements, one from Dorothy M Clarke dated 24<sup>th</sup> April 2007 with 5 exhibits and one from Per Hoiby dated 17<sup>th</sup> April 2007 with 1 exhibit.

8. The registered proprietor also submitted evidence in the form of a witness statement by Nicola Pacquette dated 8<sup>th</sup> June 2007.

9. The applicant submitted evidence in reply in the form of a further witness statement from Dorothy Clark dated 25<sup>th</sup> July 2007. Certain aspects of this evidence was contested by the registered proprietor and as a result an amendment to the witness statement was submitted on 26<sup>th</sup> September 2007.

10. Neither party requested a hearing in respect of this matter. Accordingly, my decision is based upon the Statement of Case and Counterstatement and the evidence filed by the parties.

The first matter I will consider is the claim that the design was not new and/or lacked individual character when it was registered.

### **THE LEGAL TEST**

11. The comparison of designs must be made through the eyes of “the informed user.” In assessing the attributes of such a person I am guided by the comments of Judge Fysh Q.C. in the Patents County Court in the *Woodhouse UK PLC v Architectural Lighting Systems* case [2006] RPC 1, where he said:

“First, this notional person must obviously be a user of articles of the sort which is subject of the registered design – and I think a regular user at that. He could thus be a consumer or buyer or be otherwise familiar with the subject matter say, through use at work. The quality smacks of practical considerations. In my view the informed user is first, a person to whom the design is directed. Evidently, he is not a manufacturer of the articles and both counsel roundly rejected the candidature of “the man in the street”.

“Informed” to my mind adds a notion of familiarity with the relevant matter rather more than one might expect of the average consumer; it imports a notion of “what’s about in the market?” and “what’s been about in the recent past?”. I do not think that it requires an archival mind (or eye) or more than an average memory but it does I think demand some awareness of product trend and availability and some knowledge of basic technical considerations (if any).

In connection with the latter, one must not forget that we are in the territory of designs and thus what matters most is the appearance of things; as Mr Davies reminded me, these are not petty patents. Therefore focus on eye appeal seems more pertinent than familiarity with the underlying operational or manufacturing technology (if any).”

12. I note that this approach to the matter was subsequently followed by Lewison J. in the High Court in *The Procter and Gamble Company v Reckitt Benckiser (UK) Limited*, [2006] EWHC 3154 (Ch).

### **DECISION**

13. In general, the facts at issue in proceedings must be proved by evidence. This means that the applicant needed to provide evidence to prove the facts pleaded in their statement. The burden of proof in these proceedings lies with the applicant.

14. The applicant claims that the design fails on two grounds, namely that the design was not new when it was applied for and that the applicant is in fact the proprietor of the design.

15. In my view there are two “main” design features to the registered design. Firstly there is the neck design and secondly the all in one nature of the mitten attached to the sleeve with a thumb element.

14. The evidence supplied by the applicant shows some articles of clothing with a similar neck feature, whilst others show an all in one hand covering. It is significant that none of the designs referred to by the applicant show use of both of these elements in the same garment. It is also noticeable that none of the mitten devices shown in the applicants evidence, show use of a separate “thumb” element.

15. The applicant’s evidence refers to two main types of garment, those where the sleeve is enclosed and those where they are open. I refer specifically to Exhibit DMC6 where the actual garments are supplied. No dates of use of these particular garments are given with these exhibits. However Exhibit DMC4 consists of catalogues showing the sale of these garments. The catalogues are dated 1988 and 1989. I refer to page 5 of the 1988 catalogue and page 9 of the one dated 1989. In both of these catalogues the examples shown are clearly referring to the “Opening mitten” variety. No mention is made of the closed variety in these documents.

16. I am therefore unable to substantiate the claim that the closed variety is earlier art as I cannot substantiate the claim from the evidence provided.

17. I therefore only need to consider the evidence filed in support of the “open” variety.

18. As Judge Fysh Q.C. said in the case I have referred to earlier, the question of comparison of designs is by the “informed user” for these products. As we are considering clothing, specifically children’s clothing who suffer from excema, the informed user is likely to be the parents of such children.

19. It is also of relevant that design freedom is somewhat limited in respect of this type of garment. Consequently small differences in the design make a significant difference.

20. It is therefore my view, based on the evidence before me, the registered design has individual character and is not identical or differs in only immaterial details to the prior art shown.

21. I now turn to the grounds of brought under 11ZA(2) of the Act in that the applicant is the proprietor of the design. No evidence has been submitted in respect of this claim by the applicant, therefore I have no evidence on which to base my decision. I therefore have no option but to dismiss the claim under these grounds.

## **CONCLUSION**

22. The application for invalidation under Section 11ZA(1)(b) and 11ZA(2) fails as the applicant has not demonstrated that the design in suit was not new at the relevant date. Nor have they demonstrated that they are the proprietors of the design. The onus of proof lies with the applicant and this onus has not been discharged.

## **COSTS**

17. The application for invalidation has failed. Accordingly, the registered proprietor is entitled to a contribution towards costs. I order the applicant to pay the registered proprietor the sum of £1,000. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3<sup>rd</sup> day of October 2008**  
**MARK JEFFERISS**  
**For the Registrar the Comptroller-General**