

HEMECRAFT STEEL INDUSTRIES (PTY) LTD v S M HARE & SON (PTY) LTD AND ANOTHER 1984 (3) SA 681 (A)

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Court Appellate Division

Judge Corbett JA, Kotzé JA, Viljoen JA, Galgut AJA and Howard AJA

Heard March 8, 1984

Judgment March 29, 1984

Annotations [Link to Case Annotations](#)

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[zFNz]Flynote : Sleutelwoorde

Copyright - Design - Registrability of - Designs Act 57 of 1967 s 1 - To qualify as design, article must have some special feature which appeals to the eye and distinguishes it from others of its class - While Court is the arbiter, C the article must be looked at through the eyes of the likely customer of the article - This criterion also applicable in deciding questions of novelty and infringement.

[zHNz]Headnote : Kopnota

In order to qualify as a design in terms of s 1 of the Designs Act 57 of 1967 there must be some special feature which appeals to the eye and distinguishes the article from others of its D type and class. While the Court is ultimately the arbiter of whether the article qualifies as a design it must consider how the design in question would appeal to and be judged by the likely customer of the class of article to which the design is applied. This visual criterion is also of importance in deciding questions of novelty and infringement.

The decision in the Transvaal Provincial Division in Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd and Another confirmed. E

[zClz]Case Information

Appeal from a decision of the Transvaal Provincial Division (VAN REENEN J). The facts appear from the judgment of CORBETT JA.

C E Puckrin for the appellant: In terms of s 15 (1) of the Designs Act 57 of 1967, the registered proprietor of a design "shall have the

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A exclusive right in the Republic to make, use or vend any article included in the class in which the design is registered, embodying the registered design or a design not substantially different from the registered design". In terms of s 24 (1) of the Act, the registered proprietor is entitled to institute proceedings to enforce his rights under the Act for, inter alia, damages and an interdict, provided that B damages or an account of profit shall not be awarded against a defendant who proves that at the date of the infringement he was not aware and had no reasonable ground for supposing that the design was registered in the Republic. The rights acquired by registration of the design in terms of the Act are substantially similar to the rights acquired by the C registered proprietor of a design in the United Kingdom in terms of the United Kingdom Registered Designs Act of 1949. See s 7 (1) of the United Kingdom Registered Designs Act 1949. English authority on the subject may therefore be of assistance to this Court. In terms of earlier United Kingdom legislation and the 1916 South African Act, the rights acquired by D registration of a design were infringed by an obvious and fraudulent imitation thereof. See s 93 (1) (a) of Act 9 of 1916. The requirements for infringement under both the earlier South African and English legislation were therefore more stringent than at present. The question of whether the alleged infringing design is or is not an infringement can only be E decided by the eye. The enquiry is really whether the alleged infringement has substantially the same appearance as the registered design. In other words, one should compare the registered design and the alleged infringement and decide whether or not the general effect is the same. Russel-Clarke Copyright in Industrial Designs 4th ed at 79 - 80; Manchester v F Umfreville & Son [1907] RPC at 788 lines 22 - 26. The F correct test is not a careful comparison of the design and the alleged infringement. Charles Henry Nevill & Others v John Bennett & Sons 1898 [RPC] at 417 lines 48 - 51; Brudd Lines (Pty) Ltd v Badsey (2) 1973 (3) SA at 979C. The eye to be considered is the eye of the Court but the Court should view the design through the spectacles of the customer. Swisstool G Manufacturing Co v Omega Africa Plastics 1975 (4) SA at 383B; Brudd Lines (supra at 978F - G); Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd 1971 (2) SA at 653H - 654A; Benchairs Ltd v Chair Centre Ltd [1974] RPC at 443 line 4; Amp Incorporated v Unilux (Pty) Ltd [1972] RPC at 108 lines 16 - 25 and 112 lines 38 - 44. Evidence from experts is receivable to assist the H Court in coming to a proper conclusion. However, the function of such expert witnesses is limited. Allen-Sherman-Hoff Co v Registrar of Designs 1935 TPD at 274; Wingate's Registered Design [1935] RPC at 131 lines 34 - 49. It should be borne in mind that the foregoing two cases were concerned only with the validity of the respective registered designs. For that purpose I expert evidence was receivable to explain the function of the various components of the articles in which the respective registered designs were

embodied. The comparison should take into account the doctrine of imperfect recollection, bearing in mind that a customer may not see the articles employing the registered design and the alleged infringement at the same time or place. *Swisstool Manufacturing Co* (supra at 383E). In order to

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assess whether there is infringement, the drawing of the A article attached to the certificate of registration, as well as an actual manufactured article embodying the design, should be looked at. *Dunlop Rubber Co Ltd v Golfball Developments Ltd* [1931] RPC at 277 and 280; *Russel-Clarke* (op cit at 79 and 80). The alleged infringement and the registered design should be looked at, not only together, but apart and at different times B and a little distance off. *Russel-Clarke* (op cit at 80). In general, the scope of the design depends largely upon the state of knowledge at the date of registration. In this regard *Hecla Foundry Co v Walker Hunter & Co* 1889 [RPC] at 559 lines 11 - 20 is apposite. This approach has been adopted in the following cases: *Dean's Rag Book Co Ltd v Pomerantz & Sons* 1930 C [RPC] at 491; *Chudzikowski v A Sowak* [1957] RPC at 117; *Kevi A/S v Suspa Verein UK Ltd* [1982] RPC at 179 lines 10 - 20; *Negretti & Zambra v W F Stanley & Co Ltd* 1925 [RPC] at 365; *Russel-Clarke* (op cit at 83). Section 1 (1) (vi) has been adopted *holus bolus* from the judgment of *LUXMOORE J* in *Kestos Ltd v Kempat Ltd & Kemp* [1936] RPC at 151 lines 22 - 24. The Judge was in fact defining a test to be applied to the then D words of the British statute, which disqualified a "mere mechanical device" as being the subject of a registered design. *Russel-Clarke* (op cit at 22) suggests that a shape solely dictated by function is really the fundamental form of the article or something different therefrom by only minute variations. The author suggests that if a shape is capable of E giving to the article to which it is applied a definite individuality of appearance, which renders it distinguishable from the fundamental form, then it will be registrable. In this regard use of the word "solely" in the aforementioned section cannot be over-emphasised. See *Cow (PB) & Co Ltd v Cannon Rubber Manufacturers Ltd* [1959] RPC 347 at 352 lines 17 - 25; *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* (supra at F 565C - F). The test has been expressed in *Amp Incorporated v Unilux* (supra at 110 lines 27 - 30). *Russel-Clarke* (op cit at 24) suggests that the requirement that anything which amounts to a method or principle of construction should be debarred from registration, means merely that no design shall be G construed so widely as to give to its proprietor a monopoly in the method or principle of construction. See also *Associated Manufacturers Ltd v Airfix Products Ltd* [1957] RPC 239 at 241 and 251. In terms of s 4 (2) of the Act, a design is deemed to be new if, on or before the date of application for the registration thereof, such design or a design not substantially different therefrom was not, *inter alia*, used in the Republic. H A distinction is drawn in the Act between "make" and "use". Cf s 15 (1) of the Act. Only use and not manufacture prior to the date of the application of the registered design will invalidate such design, provided that such use was for an article falling within the

same class as that for which the registered design is registered. Section 6 (b) of the Act I specifically provides that the fact that a design has been registered in respect of an article in a different class, does not bar subsequent registration for the identical design in some other class. A fortiori, if a design has been used in an article in a different class to that for which the registered design is registered, such use will not invalidate the design. Section 5 of the Act details certain

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A provisions as to confidential disclosure. Such confidential disclosure relates to use and not manufacture. Clearly, a person is entitled to manufacture an article embodying a design before taking steps to register such design. The visual test propounded above in regard to infringement likewise applies in regard to a comparison between the alleged anticipating designs and the registered design.

B J R Gautschi for the respondents: The respondents' design is substantially different from the registered design and the prior "Samuel Osborn" design is not substantially different from the registered design in whatever manner these designs are compared, the various methods or elements of the comparison C being as follows: (a) on a basis of a side-by-side comparison: *Hecla Foundry Co v Walker Hunter & Co* [1889] RPC at 559 lines 11 - 14; (b) apart and a little distance away from each other and each as a whole: *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* 1971 (2) SA at 564A; *Russel-Clarke Copyright in Industrial Designs* 5th ed at 84; (c) " the overall appearance of the two articles and to the composite effect of D the differences" *Swisstool Manufacturing Co v Omega Africa Plastics* 1975 (4) SA at 304H; (d) " by looking at the effect, the general effect and the general comparison of the two": *Charles Henry Nevill and Others v John Bennett & Sons* [1898] RPC at 417 lines 50 - 51; (e) the "imperfect recollection" doctrine in *Valor Heating Co Ltd v Main Gas Appliances Ltd* E [1972] Fleet Street Reports 497. *Swisstool Manufacturing Co v Omega Africa Plastics* (supra ). The doctrine of "imperfect recollection" should however not be taken too far as is explained in the *Valor Heating* judgment at 502. The eye which has to judge whether there is any substantial difference F between two designs is the eye of the Court viewing the design through the spectacles of the customer. *Swisstool Manufacturing Co v Omega Africa Plastics* (supra at 383B - C); *Allen-Sherman-Hoff Co v Registrar of Designs* 1935 TPD at 274; *Brudd Lines (Pty) Ltd v Badsey* (2) 1973 (3) SA at 978G; *Swisstool Manufacturing Co v Omega Africa Plastics* (supra at 383B - H). In the light of the foregoing judgments, the G proper approach in comparing various designs, is to have regard to all of the foregoing principles without over-emphasising any one of them. Thus, for example, the "doctrine" of "imperfect recollection" is but one of the factors which may be taken into account. At the other end of the scale, the eye of the Court comparing the various designs can properly be an eye duly tutored by expert evidence, the attention of the eye of the Court having been drawn to both H similarities and differences in the various designs. An indication of how weight should be given to each element of the inquiry in which designs are compared, is to

be found in *Grafton v Watson* (1884) LT NS at 424. In *Watson (RB) and Co Ltd v Smith Bros (Wirewares) Ltd* [1963] RPC at 151 lines 32 - 38 attention was drawn to that element of the enquiry which involves the tutoring of the eye of the Court. It is of particular importance to bear in mind that even though there may be a similarity in various features of a design, another which has a striking feature in it which is substantially different from that of the registered design, would thereby avoid infringement. In this regard see *Dunlop Rubber Co Ltd v Golfball Developments Ltd* [1931] 48 RPC at 281. It should further be borne in

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mind that in deciding whether any differences between the A alleged infringement and the registered design are or are not substantial differences, the same considerations will apply as in determining whether the registered design is or is not novel as compared with previous designs. *Russel-Clarke* (supra at 85). In comparing the registered design with other designs, the principle in *Jones & Attwood v National Radiators Co Ltd* [1928] B 45 RPC at 83 should be borne in mind. It is also permissible to have regard to a comparison between a model or an article manufactured in accordance with the registered design and to compare that article to the respondents' article and the "Samuel Osborne" and "Ventco" articles. See *Dunlop Rubber Co Ltd v Golfball Developments Ltd* [1931] RPC at 277. C See also *Swisstool Manufacturing Co v Omega Africa Plastics* (supra ) where a model made in accordance with the design was, by consent, placed before the Court (at 381D - G.) The defence of "anticipation" is governed entirely by s 4 (1) read with s 4 (2) of the Act. The additional question of "obviousness" which arises in patent law over and above the question of novelty (compare s 23 (1) (d) and (l) of the D Patents Act 37 of 1952), does not arise in considering a design under the Designs Act. If the design or a design not substantially different therefrom was not used in the Republic before the application for registration, the design is "deemed" to be "new or original" and, in consequence thereof, complies with the requirements of the Act. Conversely, if a design not E substantially different from the registered design was used in the Republic prior to the date of application for registration, then it is in terms of s 4 (2) not "new or original". Accordingly, it is also irrelevant to have regard to the state of knowledge at the time of registration. The specific statutory provision in s 4 (2) of the Act distinguishes the reasoning in the judgment relied upon in *Hecla Foundry v Walker Hunter Co* [1889] RPC at 559. In terms of the definition of F "design" in s 1 (1) of the Act, any feature which is dictated solely by the function which the article is intended to perform, is excluded from protection under the Act. The top and bottom flanges and the return lip on the bottom flange are purely functional in that they provide the requisite rigidity and facilitate handling of the fascias. The fluting on the face G of the design serves the functional purpose of providing additional rigidity. In regard to the question of when functional features are excluded from protection, see *Amp Incorporated v Unilux (Pty) Ltd* [1972] RPC 103; *Swisstool*

Manufacturing Co v Omega Africa Plastics (supra ). See also the commentary on "method or principle of construction" in Russel-Clarke (supra at 27 - 28) and Kestos Ltd v Kempat Ltd & H Kemp [1936] 53 RPC 139 at 151.

Puckrin in reply.

Cur adv vult.

Postea (March 29). I

[zJDz]Judgment

CORBETT JA: The appellant is the proprietor of a design registered in terms of the Designs Act 57 of 1967 ("the Act") in class 25 (building units and construction elements) and having the registration number

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A 70/0448A. In terms of s 4 (8) of the Act, appellant's design was registered as from 9 June 1970. In August 1978 appellant instituted action against first respondent, S M Hare & Son (Pty) Ltd, in the Transvaal Provincial Division (the "TPD") alleging infringement by first respondent of appellant's registered design and claiming an interdict, damages and an order for the delivery up for destruction of all infringing B articles in first respondent's possession and costs of suit. Thereafter, in February 1980, appellant instituted a similar action for infringement in the TPD against second respondent, Umdloti Strand Hotel (Pty) Ltd. After each respondent had pleaded to the appellant's particulars of claim, C appellant obtained an order from the TPD consolidating the two cases. It appears that in November 1978 second respondent purchased the shares in first respondent and then proceeded, under the name S M Hare & Son, to carry on the business formerly conducted by first respondent. The alleged infringements occurred in the course of the business operations conducted prior to November 1978 by first respondent and D thereafter by second respondent: hence the two actions and the consolidation thereof.

In its plea first respondent admitted the acts of infringement alleged by appellant, but denied that such acts constituted an infringement of appellant's registered design. First respondent alleged furthermore that in any event the registration of E appellant's design was, and at all material times had been, invalid on the grounds (i) that the design was not a "design" within the meaning of the definition contained in s 1 of the Act, and (ii) that the design was not new or original in that it had been anticipated by a construction element used continuously in the Republic of South Africa from at least 1956 by Samuel Osborn (SA) Ltd ("Samuel Osborn"). I shall refer to F this element as the "Osborn element" or the "Osborn design", depending on the context.

Second respondent raised the same defences as did first respondent. It denied that the construction elements made and sold by it infringed the registered design and it alleged that the registration of the appellant's design was invalid on G grounds (i) and (ii) above. In addition second respondent pleaded in effect that, in the event of it being held that it had infringed appellant's registered design, the latter was not novel in that it had been anticipated by construction elements manufactured in the Republic of South Africa since 1969 by Ventco Engineering (Pty) Ltd ("Ventco Engineering"). I shall refer to this element as the "Ventco element" or the "Ventco H design", depending on the context.

Although each of the respondents denied appellant's averment that the design registration was "valid and subsisting", the only grounds advanced in the pleas for it not being valid and subsisting were the grounds of invalidity detailed above. In I view of the relationship between the two respondents (the one being in effect the successor to the other), the identity of their interests and the similar defences raised by them, I shall henceforth not treat them separately, but regard them for practical purposes as if they were a single party to the consolidated proceedings.

At a pre-trial conference held in terms of Rule 37 (1) of the Uniform

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Rules of Court it was agreed by the parties that all questions A of damages would stand over pending the determination of the issues of infringement and invalidity. The matter accordingly went to trial on these two main issues. The trial Judge (VAN REENEN J), having heard the evidence and arguments, held that appellant had failed to establish infringement and that respondents had failed to prove anticipation. He estimated that B the latter issue had occupied one day of the hearing. He accordingly gave judgment for respondents with costs (but excluding the costs of one day's hearing), such costs to include the qualifying fees of an expert witness, a Prof Rallis, and (erroneously, for appellant was represented by only one counsel) the costs of two counsel. The trial Judge does not C appear to have dealt in his judgment with the other grounds of invalidity pleaded.

Appellant appealed against the judgment and order of the trial Court, save for that part relating to and holding that the issue of anticipation failed and that the costs of one day's hearing should be excluded from the costs awarded to respondents. Respondents, on the other hand, cross-appealed D against the decision of the trial Court that they had failed on the anticipation issue and that they, therefore, were to be deprived of the costs of one day's hearing.

With that introduction I turn to the facts.

The facts

Appellant's design was registered, as I have indicated, in E class 25, which is headed "Building units and construction elements" and comprehends the following: Building material and elements, such as beams, tiles, slates, panels, etc; windows, doors, blinds, etc; sections, angles and channels; houses, garages and all other buildings; civil engineering elements; F and miscellaneous. (See reg 4, read with schedule 3, of the Designs Regulations 1968.) In appellant's application for registration of the design it is stated that

"the novelty claimed resides in the shape and/or configuration of an elongated constructional element having an end profile substantially as shown in the representation".

The "representation" referred to is what is described as a G "threedimensional view". It shows an oblong piece of material which has flanges top and bottom and the face of which has been shaped by the introduction of five horizontal and parallel flutings. The end profile of the element shows that the flanges are set approximately at right angles to the main portion of the element (which I shall call - as the trial Judge did H - the "main element"). The bottom flange has, in addition, a narrow return which gives it a channel-like profile or Ubend. The flutings have a curved profile and are separated by fairly wide slightly curved valleys. The crests of the middle and two outer flutings have approximately the same radius of curvature, while the crests of the two inner flutings have about the same radius of curvature. The radius of curvature of the former is I larger than that of the latter. The general effect of these flutings, crests and valleys, is a sinuous, undulating one. A copy of the three-dimensional representation which forms part of the registration of appellant's design is attached to this judgment and marked "figure 1" \* .

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A The evidence shows that appellant, which carries on business as the manufacturer of sheet metal products for the building industry, utilised the registered design in the manufacture, by a rolling process, of a metal fascia boarding. It commenced marketing this product towards the end of 1970. It was sold in lengths of up to 10m. At the time of the trial appellant was B selling about 40 to 50 tons of this fascia boarding per month. A fascia board is used to hide or cover the open ends of the purlins of the roof of a building and generally to finish off the edge of the roof. Samples of appellant's fascia boarding were put in as exhibits (exhs C and P).

The infringement alleged by appellant is that respondents have for some time been making and vending lengths of fascia board C embodying appellant's registered design or "a design not substantially different from" the registered design. According to the respondents' own evidence first respondent commenced making and selling a rolled metal fascia board in about 1977; and it and its successor,



second respondent, continued to do so up to the time of the trial. This is not disputed. What is D disputed is whether this fascia board embodied appellant's registered design or a design not substantially different from the registered design.

Specimen sections of the fascia board manufactured and sold by respondents were produced in evidence (exhs A and Q). This fascia board is made of sheet metal of, it would seem, about E the same thickness as appellant's product. The width (ie from top to bottom) of the main element of respondents' fascia board (viz 225 mm) is also about the same as the width of the main element of appellant's product. Respondents' fascia board also has flanges, top and bottom, set at about right angles and, as in the case of appellant's registered design, the bottom flange F has a narrow return. Furthermore, the face of the main element of respondents' fascia board has been shaped to contain three horizontal, trapezoidally-shaped flutes. The valleys between the flutes are flat and are wider than the crests of the flutes. The record does not contain a three-dimensional representation of respondents' product, but only a drawing, to about the same scale as figure 1, showing the end-profile. A copy of this is annexed and marked "figure 2" \* .

G It is convenient at this stage to refer to the two other designs which call for consideration in this case, viz the Osborn design and the Ventco design. A sample of an element, made of stainless steel by means of a draw process by Samuel Osborn from about 1956 onwards, was placed before the Court H (exh N). This element is about 74 mm wide. It has flanges top and bottom. The main element is shaped so as to contain horizontal fluting. The fluting has five crests. The central crest has a larger radius of curvature than the other crests and occupies about one-third of the width of the element. The valleys between the flutings are sharp and narrow. A three-dimensional representation of this element, drawn to I approximately the same scale as the drawing of the registered design (figure 1) and also figure 2, is annexed to this judgment and marked "figure 3 \* ". According to the evidence the

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Osborn element was sold to various refrigeration manufacturers, A who used it in the construction of the type of open refrigeration counters found in supermarkets and cafés.

Mr J H Zwiaglaer, the managing director of Ventco Engineering, who was called as a witness by respondents, produced a sample of a metal fascia board which his company had been manufacturing by the press brake process since 1969. The sample B itself had been fabricated towards the end of 1981, shortly before the trial, but, according to Zwiaglaer, the sample was typical of what had been produced by the company for years; the profile itself was basically the same, but the dimensions might differ slightly. This Ventco element is (at 270 mm) somewhat wider than the other elements. It has flanges, C top and bottom, and, like the

registered design and respondents' product, the lower flange has a narrow return. The face of the main element contains three horizontal trapezoidally-shaped flutes. The valleys between the flutes are flat and are wider than the crests of the flutes. The flutes D are proportionately deeper than those on respondents' product, but, that apart and making due allowance for the difference in width, there is very close resemblance between the Ventco element and respondents' product. A three-dimensional drawing of the Ventco design, done to approximately the same scale as figures 1, 2 and 3, is annexed hereto and marked figure 4 \* .

In describing these designs I have used the words "flute" and "fluting" generally to denote the parallel ribs or raised E portions of the main elements. This may not be strictly in accordance with the dictionary meaning of these words, but this was the sense in which they were used by the expert witness who gave evidence in this case.

F I come now to the law.

The law.

Section 4 (1) of the Act empowers the Registrar of Designs, on application made to him by the proprietor of "any new or original design", to register the design. The effect of such G registration is stated in s 15 (1), which reads as follows:

"The person registered as the proprietor of a design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have the exclusive right in the Republic to make, use or vend any article included in the class in which the design is registered, embodying the registered design or a design not substantially different from the registered design."

The statutory monopoly thus conferred on the proprietor of a H registered design is infringed by any other person who unauthorisedly makes, uses or vends any article included in the class in which the design is registered, which article embodies the registered design or a design not substantially different from the registered design; and the registered proprietor is entitled to enforce his rights by suing the infringer in the I appropriate division of the Supreme court for damages, an interdict or such other relief as the Court may deem fit (s 24 (1)).

Among the defences which a defendant in an infringement action may raise are the following:

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A (a) that the plaintiff's registered design is not a "design" as defined in the Act, with the consequence that the design ought not to have been registered in the first place (see s 24 (4), read with s 10 (2));

(b) that the plaintiff's registered design was not new or original at the time of the application for B registration thereof and, therefore, ought not to have been registered (see s 24 (4), read with s 10 (2) and s 4 (2));

(c) that the articles made and vended by him did not embody the registered design or a design not substantially different from the registered design and C that consequently he was not guilty of infringement.

These are in fact the defences raised by the respondents and I shall consider them in the order stated above. Defences (a) and (b) strike at the validity of the registered design. Defence (c) accepts or assumes the validity of the registered design, but denies the infringement thereof.

D Appellant's registered design not a "design". "Design" is defined in s 1 of the Act to mean:

"any design applied to any article, whether for the pattern, for the shape or configuration or for the ornamentation thereof or for any two or more of such purposes, and by whatever means it is applied, in so far as such features appeal to and are E judged solely by the eye: Provided that any feature of an article in so far as such feature is dictated solely by the function which the article intended to perform and any method or principle of construction shall be excluded from the rights afforded by this Act;"

With this definition must be read the definition of "article" in s 1, viz "any article of manufacture" and including "any part of an article". It is also pertinent at this stage to note F the provisions of s 4 (5), which read:

"Designs for articles which are not intended to be multiplied by an industrial process shall not be registrable under this Act." "Design" is thus defined in terms of the features of pattern, shape, configuration or ornamentation applied to an article, either singly or in combination, "in so far as such features appeal to and are judged solely by the eye". The words quoted did not appear in the corresponding definition which applied prior to the commencement of the Act (see s 76 of the Patents, Designs, Trade Marks and Copyright Act 9 of 1916). Their introduction into the definition in the Act may, I think, be attributed to the development of the English legislation on the subject. In the United Kingdom similar words, requiring the features of the design to appeal to and be judged "solely by the eye", were inserted in the definition of "design" for the first time by s 19 of the Patents and Designs Act 1919. It enacted what had already been stated to be the law in many

I decided cases (see Russel-Clarke on Copyright in Industrial Designs 5th ed at 18). The words were again incorporated in the definition contained in the current English legislation (see s 1 (3) of the Registered Designs Act 1949), which definition is in its essential features very similar to the definition of "design" in the Act. Useful

guidance as to the meaning of these words - and indeed as to the meaning of the definition in our Act as a whole - may, in my

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view, be derived from authoritative decisions of the English A and Scottish Courts on the topic.

In the leading English case of *Amp Incorporated v Utilux (Pty) Ltd* [1972] RPC 103, Lord REID discussed the apparent policy of the legislation relating to registered designs as follows (at 107 - 8):

"Those who wish to purchase an article for use are often influenced in their choice not only by practical efficiency but B by appearance. Common experience shows that not all are influenced in the same way. Some look for artistic merit. Some are attracted by a design which is strange or bizarre. Many simply choose the article which catches their eye. Whatever the reason may be, one article with a particular design may sell better than one without it: then it is profitable to use the design. And much thought, time and expense may have been C incurred in finding a design which will increase sales.

Parliament has been concerned to see that the originator of a profitable design is not deprived of his reward by others applying it to their goods."

Lord REID went on to point out that under the legislation in question protection was given not to everything that could be called a design, but only to a design falling within the definition. In the same case Lord MORRIS of BORTH-Y-GEST D referred in particular to the requirement of the definition that the features in the finished article "appeal to and are judged solely by the eye". He said (at 112):

"The question is raised as to the sense in which the features in a finished article are to appeal to and are to be judged solely by the eye. I think that it is clear that the particular feature which is in question or under consideration must be seen when the finished article is seen. But the words of the E definition point, in my view, to considerations other than that of merely being visible. The phrases 'appeal to' and 'judged solely by the eye' denote features which will or may influence choice or selection... This does not mean that the 'appeal' or the attraction must be to an aesthetic or artistic sense - though in some cases it may be. The features may be such that they gain the favour of or appeal to some while meeting with the disfavour of others. Beyond being merely visible the feature must have some individual characteristic. F It must be calculated to attract the attention of the beholder."

In his speech in this case Lord PEARSON said, with reference to the definition of "design" (at 121):

"The emphasis is on external appearance, but not every external appearance of any article constitutes a design. There must be in some way a special, peculiar, distinctive, significant or striking appearance - something which catches the eye and in this sense appeals to the eye."

Similar views were expressed by Lord AVONSIDE in the Scottish Court of Session in the case of G A Harvey & Co (London) Ltd v Secure Fittings Ltd [1966] RPC 515 in the following terms (at 518):

"The judge of the design is the eye and the eye alone and to the eye it must appeal. The design, to appeal, must be noticeable and have some perceptible appearance of an individual character. Where, as in the present instance, the design is for a shape or configuration of the article as a whole, the only effective application of the design rests in making an article of that shape or configuration. In that situation, in order to achieve application of the design to an article, the article produced must be such as appeals to the eye as possessing, by reason of its shape or configuration, features which distinguish it from others of its type and class."

(This judgment was referred to with approval in the Amp Incorporated case supra at 112 - 3, 119 and 121 - 2.)

These citations give, I think, a general indication of the features which a design must possess in order to appeal to and be judged by the eye. And the next question which arises is: whose eye? This question

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A was discussed at length by ELOFF J in Swisstool Manufacturing Co v Omega Africa Plastics 1975 (4) SA 379 (W) at 382F - 383F. Here reference is made to the Amp Incorporated case supra in which it was held that the eye in question must be the eye of the customer. (See also Benchairs Ltd v Chair Centre Ltd [1974] RPC 429 at 442 - 3; Ferrero's Design Application [1978] RPC B 473 at 482 - 3.) ELOFF J stated (at 383B) that it would not be inconsistent with what had been said in previous South African cases

"to hold that while the eye is to be the eye of the Court, the Court should view the design through the spectacles of the customer".

I think, with respect, that this statement pithily expresses what I conceive to be the correct approach, viz that while the Court is ultimately the arbiter it must, when determining these matters, consider how the design in question would appeal to and be judged by the likely customer of the class of article to which the design is applied.

This visual criterion is, of course, of cardinal importance not only in determining whether a design meets the requirements of D the definition, but also in deciding questions of novelty and infringement.

The proviso to the definition in s 1 of the Act states in effect what is not registrable as a design by providing that (i) any feature of an article, in so far as such feature "is dictated solely by the function which the article is intended to perform", and (ii) any method or principle of construction, E are excluded from the rights afforded by the Act. A similar provision is to be found in the definition of design in the English Act of 1949. As in the case of the English Act, the proviso to the definition in s 1 of the Act incorporates principles which had long been accepted in the law relating to designs, namely that a feature which is necessarily determined F by the function of the article in question is not registrable as a design and that registered designs must be judged by the eye alone and cannot be made to cover modes of manufacture (see *Allen-Sherman-Hoff Co v Registrar of Designs* 1935 TPD 270 at 272 - 5; see also *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* 1971 (2) SA 562 (C) at 565E - F; the *Swisstool* case G supra at 384B - F; *WRB Enterprises (Pty) Ltd v Plasbox Industrial Appliances (Pty) Ltd and Another* (2) 1975 (1) SA 803 (T) at 804C - H; *Robinson v D Cooper Corporation of SA (Pty) Ltd* 1983 (1) SA 88 (T) at 93A - 94E, the latter all being cases decided in relation to the definition in the Act). Naturally a design which incorporates both registrable and non-registrable features may be registered, but in that case H only the registrable features will enjoy the protection afforded by registration. This proviso is of importance not only in deciding whether the design in question contains features which make it registrable, but also in determining issues of novelty.

In the present case it is contended that appellant's registered I design is entirely functional; that, therefore, it does not fall within the definition of "design"; and that in consequence thereof the registration was invalid. This contention was aimed at the top and bottom flanges and the return on the bottom flange in that they merely provided rigidity to the fascia board and facilitated its handling, and at the fluting on the face of the element in that this provided additional rigidity.

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I do not think that this contention is well-founded. While A there may be some doubt as to whether the flanges and the return have more than a functional role in the design, I am of the opinion, on the evidence and upon a visual consideration of the design itself, that the fluting is not solely functional: while it may perform the function of imparting additional rigidity to the element, it also has a definite visual appeal.

Respondents have also attacked the validity of the registered B design on the ground that it amounts to a method or principle of construction. The meaning and

effect of this aspect of the proviso, as it appears in the definition of "design" in the English Act, is fully discussed in Russel-Clarke (op cit at 27 - 31); see also LAWSA vol 8 at para 83. It is not necessary to canvass this topic fully C because respondents' argument boiled down to the following submission: if the registered design were construed so widely as to result in respondents' design constituting an infringement thereof, it would mean that all designs including fluting would be comprehended in the registered design; and this in turn would mean that appellant had been given a monopoly in a mode or principle of construction, which is not D permitted by the Act. I see no warrant for construing the design as comprehending all forms of fluting. This basic premise of the argument therefore falls away and the argument itself collapses.

The attack upon the validity of the registered design on the ground that it is not a "design", as defined, accordingly E fails.

Novelty: anticipation.

As I have indicated, the Registrar is empowered to register only "new or original" designs (s 4 (1)); and one of the grounds upon which the Court may order the cancellation of the registration of a design and which may, therefore, be relied F upon by way of defence to an infringement action is that the design "was not new or original" (see s 10 (2), read with s 24 (4) of the Act). Section 4 (2) provides that for the purposes of the Act a design shall be deemed to be a new or original design if on or before the date of application for registration thereof, the design or a design not substantially different G therefrom was not, inter alia, " used in the Republic".

Respondents aver that the appellant's registered design was not new or original, primarily on the ground that the Osborn design was not substantially different from the registered design and had been used in the Republic since about 1956, ie for about 14 years prior to the date of application for the registration of H appellant's design. Respondents also raised a similar defence of anticipation in regard to the Ventco design, but this was really on the premise that the respondents' design was found to infringe the registered design.

In adjudging the novelty of a design it is important to have regard generally to the state of the art at the time of registration, as well as the alleged anticipation. (See eg I Aspro-Nicholas Ltd's Design Application [1974] RPC 645 at 653; Benchairs Ltd v Chair Centre Ltd (supra at 436 - 7); Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd (supra at 563H - 564A).) The feature of appellant's design which is most distinctive - which makes most appeal to the eye - is the fluting on the main element. Now fluting, as an architectural and constructional

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A embellishment, is as old as Western civilization. No evidence is necessary to establish this well-known fact. In addition, it appears from the evidence of Mr S E Bellingan, called by appellant, that prior to 1970 there were on the South African market imported wooden fascia boards with various patterns somewhat similar to the registered design cut into the wood. B And, according to Mr Hamman, the manager of the aluminium department of Samuel Osborn, in addition to the Osborn element (exh N), his company produced and sold various other metal elements with different profiles consisting of curved flutings.

In the circumstances it seems to me that the novelty, if any, of appellant's design must lie in the number and the particular C shape and arrangement of the flutings contained in the registered design. On the evidence, the anticipatory design which bears the closest resemblance to the registered design is the Osborn design. I have carefully considered these two designs, adopting a process of comparison similar to that required when the issue of infringement is adjudicated upon, as to which more anon. Clearly the Osborn design is not the same D as the registered design; and, although it is a border-line case, I am of the opinion that the Osborn design is substantially different from the registered design, or, to put it in the language of s 4 (2), it cannot be said that the Osborn design is "not substantially different" from the registered design. The main differences that strike the eye are E (i) the very wide central flute in the Osborn design, which occupies about a third of the width of the element; (ii) the narrow, sharp valleys in the Osborn element, compared with the wide, flat valleys of the registered design; and (iii) the rounded edges of the Osborn element, where the outside flute runs into the flange, as compared with the sharper, rectangular F edges of the registered design which form part of a valley, not a fluting. In this connection it is important that any comparison between the registered design as embodied in appellant's fascia board (exhs C and P) and the Osborn element (exh N) should make due allowance for the difference in scale. Of course no such difference appears in figures 1 and 3, which G are drawn approximately to the same scale.

As to the Ventco design, this is, in my opinion, very different from the registered design. Since, however, it was advanced as an anticipation only in the event of infringement being established and since, for the reasons which follow, I am of H the opinion that respondents' product did not infringe the registered design, it is not necessary to say anything more about the Ventco design.

For these reasons I am of the opinion that the attack upon the validity of the registration of appellant's design on the ground that it was not new or original must fail.

### Infringement

I The test for infringement is whether the article alleged to infringe embodies the registered design or a design not substantially different from the registered design



(s 15 (1)). This must be decided by the eye; and in applying this visual test the Court must bear in mind the reaction of the likely customer. The two designs must be viewed and compared side by side and also separately. Ultimately it may be a matter

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of degree. The Court may have regard to the expert evidence to A the extent and for the purposes described by TINDALL J in the Allen-Sherman-Hoff Co case supra at 274. The state of the art at the time when the design was registered and the degree of novelty and originality achieved by the registered design is also an important factor. Russel-Clarke (op cit at 85) states:

"If only small differences separate the registered design from B what has gone before, then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement."

And (at 87):

"Thus, it may be said that a registered design which is possessed of substantial novelty and originality will have a broader reading given to the monopoly which it affords than C will a design which is barely novel or original. In the latter case, where the novelty is small, the Court may refuse to hold anything to be an infringement, unless it is almost exactly like the registered design."

These statements appear to be well-supported by the authorities cited at 85 - 8 (to which might be added the case of Valor Heating Co Ltd v Main Gas Appliances Ltd [1973] RPC 871); and the principles enunciated appear to me to be sound and logical D and of equal application in our law.

Applying this general approach, I have no doubt that appellant failed to establish infringement on the part of the respondents. There are substantial differences between the fascia board made and vended by respondents and the registered design. I refer in particular to (a) the number of flutes, E three in the case of respondents' product and five in the case of the registered design; and (b) the angular, trapezoidal shape of the flutes and the valleys in the case of respondents' product, as compared with the sinuous undulating flutes of the registered design. The measure of novelty of appellant's design is small and the ambit of appellant's monopoly is F correspondingly restricted. It is very much bound up with the particular arrangement and design of the flutings on its design. Consequently, relatively small differences would, in my opinion, take a design out of the ambit of that monopoly. The differences in respondents' design cannot even be described as relatively small: they are far more substantial than that. In fact, in my view, there is a close resemblance between the G respondents' design and the Ventco design. As

far as the Ventco design fails to qualify as an anticipation of the registered design, so far also does the respondents' design, as incorporated in its product, fail to constitute an infringement of the registered design. For these reasons, I hold that H appellant failed to establish infringement.

In the result I agree with the conclusions reached by the trial Judge on both the main issues, viz infringement and invalidity. There was no criticism by either party of the costs order, as such, made by the Court a quo. Both the appeal and the cross-appeal must consequently be dismissed. As regards the I costs of appeal and cross-appeal, appellant's counsel submitted that the combined costs should be apportioned; while respondents' counsel argued that his clients should be awarded all their costs on both appeal and cross-appeal. In my opinion, it is convenient that the costs of appeal and cross-appeal be combined and, in that event, I do not think that respondents, who failed on the cross-appeal,

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A are entitled to all their costs. In all the circumstances, I think it would be equitable if appellant was ordered to pay 80% of respondents' combined costs of appeal and cross-appeal.

In the Court below appellant asked that, in the event of the attack on the validity failing, a certificate of contested validity be granted in terms of s 25 (1) of the Act. The Court B a quo failed to grant such a certificate, but gave no reasons for so doing: in fact the judgment does not mention this point. Appellant's counsel submitted that should this Court dismiss the cross-appeal a certificate of contested validity should be granted. Respondents' counsel contended that no such certificate should be granted. The issue of invalidity, C on the grounds pleaded by respondents, was fully canvassed at the trial. This Court has held that the contention that the appellant's registered design is not a "design", as defined in the Act, is not well-founded. This is largely a question of applying the visual test to the design and considering the design in the light of the relevant legal principles. I cannot see that any further evidence could affect this decision. The D other ground of invalidity advanced, viz lack of novelty on the ground of anticipation, has also failed. This issue was strenuously contested by both parties and it seems unlikely that there were other more pertinent anticipations than those put forward by the respondents. In the circumstances, I think that E the discretion which the Court is given by s 25 (1) ought to have been exercised in appellant's favour (cf the remarks of LLOYD-JACOB J in *The Aberdale Cycle Co Ltd v The County Cycle Co* [1950] 67 RPC 168 at 170). From the absence of any mention of a certificate of contested validity in the judgment a quo I can only conclude that VAN REENEN J overlooked the matter. This Court is, therefore, entitled to exercise the discretion which F in the first place ought to have been exercised by the trial Judge; and for the reasons

stated the discretion should be exercised in appellant's favour. To this extent, therefore, the order of the Court a quo must be varied; but this variation will not affect the proposed order as to costs.

It is ordered as follows:

G (1) Subject to para (2) of this order, the appeal is dismissed.

(2) The order of the Court a quo is amended by the addition of the following:

"It is certified that the validity of the registration of appellant's design No 70/0448A was contested in these proceedings."

(3) The cross-appeal is dismissed.

H (4) The appellant is to pay 80% of the respondents' combined costs on appeal and cross-appeal.

KOTZÉ JA, VILJOEN JA, GALGUT AJA and HOWARD AJA concurred.

I Appellant's Attorneys: Adams & Adams, Pretoria; Siebert & Honey, Bloemfontein.  
Respondents' Attorneys: Spoor & Fisher, Pretoria; Israel & Sackstein, Bloemfontein.

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\* See below at 697 - Eds.

\* See below at 697 - Eds.

\* See below at 698.

\* See below at 698 - Eds.