

[HIEMSTRA, J.]

[1973 (3)]

[T.P.D.]

This application is expressly brought under sec. 10, and the question is whether either notice or joinder is implied in the section.

Sec. 33 of the Trade Marks Act, 62 of 1963, is to some degree a combination of secs. 10 and 12 of the Designs Act. Sec. 33 reads as follows:

"33. General power to rectify entries in register.

(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply to the court or, at the option of the applicant and subject to the provisions of sec. 69, on payment of the fees prescribed in the prescribed manner, to the registrar, for the desired relief and thereupon the court or the registrar, as the case may be, may make such order for making, expunging or varying the entry as to it or him may seem fit.

(2) The court or the registrar, as the case may be, may in any proceedings under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In the event of the registrar being satisfied that any entry relating to the registration, assignment or transmission of a trade mark has been secured by fraud or misrepresentation or that any such entry was made without sufficient cause or wrongly remains on the register, he shall also have *locus standi* to apply to the court under the provisions of this section.

(4) Any order of the court rectifying the register shall direct that notice of the rectification shall be served on the registrar, and the registrar shall on receipt of the notice together with an application on the form prescribed, rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to alter a registration in part A of the register to a registration in part B of the register."

It will be seen that sub-sec. (1) is for practical purposes identical to sub-sec. (1) of sec. 12 of the Designs Act. On the other hand the reference to the registration of a trade mark secured by fraud, appearing in sub-sec. (3), bears some resemblance to sec. 10 (2) (c). I find that secs. 10 and 12 of the Designs Act are *in pari materia* with sec. 33 of the Trade Marks Act. The general object of the two Acts is the same and the functions of the Registrars operating under each of the two Acts are very similar. I make these remarks in order to lead up to a decision of this Court in *Gulf Oil Corporation v. Rembrandt Fabrikante en Handelaars (Edms.) Bpk.*, 1963 (2) S.A. 10 (T). That was a judgment *inter alia* on the question of joining the Registrar of Trade Marks. It dealt with sec. 136 of the old Trade Marks Act, 8 of 1916. That section is not similar in wording to sec. 33 of the present Trade Marks Act but it is the counterpart of the present sec. 33 in that it provides for rectification of the register. In that section, as in sec. 10 of the Designs Act, there is no provision in regard to joinder of the Registrar or notice to him.

The functions and responsibilities of the Registrar of Trade Marks are set out in the *Gulf Oil* case on p. 18E-G and after doing so the Court said at H:

"The Registrar is therefore the guardian of the register and it is his duty in the public's interest to ensure that it is properly compiled and maintained, so much so that he is entitled to appear before any Provincial Court to uphold his refusal to register a trade mark, and so appeal to the Appellate Division if a Provincial Court overrules his decision (*Holman Bros. Ltd. v. Registrar of Designs*, 1935 T.P.D. 266; *Registrar of Trade Marks v. Wassenaar*, 1957 (4) S.A. 513 (A.D.)."

I have no doubt that the same can be said about the Registrar of Designs. The Court proceeded to say on p. 19C-F:

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"Obviously it was not envisaged by the Act or Rules that the Court should itself, or that the proprietor should himself, alter the register when the Court orders rectification under sec. 136. I think that only the Registrar can do that. Consequently, having regard to the aforementioned functions of the Registrar, I think that the only effective relief that can and must be claimed in an application under sec. 136 is an order directing (or perhaps authorising) the Registrar to rectify the register by removing the trade mark therefrom. He is therefore the true respondent in such proceedings and should be cited as such. He is not (as the official was in *Tefu v. Minister of Justice and Another*, 1953 (2) S.A. 61 (T) at p. 73) merely a public scribe whose sole duty it is to record the result of the application. The Registrar would, I think, be entitled to appear or otherwise place his views before the Court if it were necessary or desirable in the public interest to do so, or if they were otherwise relevant to the Court's judgment under sec. 136 (cf. sec. 135 (2), and the cases of *Holman Bros. Ltd. and Wassenaar, supra*).

The analogy between these two cases is inescapable and it would seem that here also we should say, as in the passage I have just quoted: "The Registrar is therefore the true respondent in such proceedings and should be cited as such."

That means he should be joined as a respondent and that mere service of the papers on him is not enough. There is however still the question whether the express provision in sec. 12 (3) of the Designs Act makes mere notice sufficient also where the proceedings are under sec. 10.

In my view the two sections are distinct and the procedure under each depends upon its own wording. Sec. 12 is more expressly aimed at mistakes in the nature of technicalities whereas sec. 10 is meant for instances where the merits of the registration are called into question.

I hold that it is necessary to join the Registrar in proceedings under sec. 10 and the following order is made:

1. The Registrar must be joined as second respondent and the matter is postponed until to-morrow to enable the applicant to do so.
2. Applicant pays the costs of postponement.

Applicant's Attorneys: *Brian Kahan & Lochner*. Respondent's Attorneys: *De Klerk & Kruger*.

BRUDD LINES (PTY.) LTD. v. BADSEY (2).

(TRANSVAAL PROVINCIAL DIVISION.)

1973. June 14, 15, 22. HIEMSTRA, J.

Copyright.—*Designs Act, 57 of 1967*.—Application for an order under sec. 10 (2) cancelling the registration of a design alleged to be *new or original*.—Fact that designer had not seen or copied another design insufficient to preclude cancellation.—Design of a "tulip chair" not substantially different from designs shown in books.—"Description" as contemplated by sec. 4 (2) (c) of Act.—When a pictorial representation qualifies as such.

A pictorial representation of a design is sufficient to qualify for a description as intended in section 4 (2) (c) of the Designs Act, 57 of 1967. The picture

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should however be intended to depict a design. A casual photograph, not intended to display the design of articles appearing in it, would possibly not qualify for the "description" contemplated in section 4 (2) (c).

In an application for cancellation of the registration of a design of a chair which was registered in terms of section 10 (2) (a) of the Designs Act, 57 of 1967, on the ground that the design was not new or original, the Registrar of Designs having been joined as a respondent, the applicant contended that the design of the chair which in the trade was called a "tulip chair" had before registration been "described in a printed publication" within the meaning of section 4 (2) (c) of the Act. Evidence of books containing designs and photographs, and of an industrial design consultant was placed before the Court in substantiation of applicant's claim. The Court accepted the respondent's statement that he had not seen these designs and that he had not copied anyone else's idea.

Held, that the registered design was not substantially different from the designs shown in the books published before the design had been registered, and that the fact that the respondent had not seen the publications was not enough to preclude cancellation. Application accordingly granted.

C Application for the cancellation of the registration of a design. The facts appear from the reasons for judgment.

W. G. Serrurier, for the applicant.

N. S. Page, for the respondent: In this matter the sole issue is whether respondent's registered design is new or original. Sec. 4 of Act 57 of 1967. Applicant has based its case entirely upon the form of anticipation described in sec. 4 (2) (c), viz. description in prior publications. The attempt to introduce in reply a fresh cause of invalidity under sec. 4 (2) (a) is not permissible. In any event, the allegation of prior use is so vague as to carry no weight. The question of whether the registered design is novel in the light of the prior publications must be decided by the eye, see definition of "design" in sec. 1; *Russell-Clarke, Copyright in Industrial Designs*, 4th ed., pp. 34-5; *Xactics (Pty.) Ltd. v. Tailored Containers*, 1971 (2) S.A. at p. 563H. The eye referred to is not that of the Court, but of the customer for the goods in question, *Amp Inc. v. Utilux*, 1972 R.P.C. at pp. 108, 112-3. It is permissible, and indeed desirable, for the Court called upon to apply the foregoing test to have the aid of instruction from expert witnesses, *Allen-Sherman-Hoff Co. v. Registrar of Designs*, 1935 T.P.D. at p. 274; the *Xactics* case, at p. 563; *Russell-Clarke, op. cit.*, p. 37. Since the instruction relates to trade knowledge and usage in the particular trade to which the design in question relates, it is to persons engaged in that trade that the Court must look for guidance, *Allen-Sherman-Hoff* case, *supra* at p. 274; *Grafton v. Watson*, (1984) 50 L.T. at p. 422. The test to be applied by the eye, instructed as aforesaid, is whether the registered design and the alleged anticipation, viewed as wholes, are substantially the same or not, *Russell-Clarke*, pp. 34-5. Whilst the introduction of features which are common knowledge in the trade will not in itself constitute a substantial difference, the effect of the combination of known features can be to produce a design which is novel, viewed as a whole, *Russell-Clarke*, p. 35. The test must be applied to each alleged anticipation separately: it is not permissible to "make a mosaic" of prior publications to support an allegation of anticipation, *Russell-Clarke*, p. 39; *Rosedale Assoc. Mfrs. Ltd. v. Airfix Products*, 1957 R.P.C. 239. For purposes of applying the test, the

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Court must attempt to visualise articles made according to the registered design and the alleged anticipation, *Russell-Clarke*, p. 35. In order to assist the Court in this task, it may have regard to actual articles made as aforesaid; the *Allen-Sherman* case, *supra* at p. 271. The court should not, however, confine itself to a comparison of the designs side by side, but should also consider them apart, and a little distance away, *Grafton v. Watson, supra*. The *onus* of showing that the registered design is not new or original rests upon the applicant for cancellation, cf. *Heinrich's Design*, 9 R.P.C. '73, and compare the position under the Patents Act; Burrell, *S.A. Patent Law and Practice*, para. B 374; *Miller v. Boxes & Shooks (Pty.) Ltd.*, 1945 A.D. at p. 581.

Cur. adv. vult.

Postea (June 22nd).

C HIEMSTRA, J.: This is an application for the cancellation of the registration of the design of a certain chair, which registration was effected in terms of the Designs Act, 57 of 1967. The applicant wants to manufacture and sell a chair which is similar in appearance to the design which has been registered in the name of the respondent. The respondent objected to such manufacture, alleging that his registered monopoly of the design was being infringed. The applicant retorted that the respondent's design should never have been registered because it is not new or original.

The applicant now invokes sec. 10 (2) of the Designs Act, which reads:

"(2) At any time after a design has been registered any person interested may apply to the court for the cancellation of the registration of the design on any of the following grounds, namely—

(a) that the design was not new or original;

(b) that the applicant for registration was not the proprietor; or

(c) that the application was in fraud of the proprietor,

or on any ground on which the registrar could have refused to register the design, and the court may make such order on the application as it thinks fit."

He contends that para. (a)—

"that the design was not new or original"

applies. The expression "new or original" is elucidated in sec. 4 (2) of the Act, which reads:

"4. (2) For the purposes of this Act a design shall be deemed to be a new or original design if, on or before the date of application for registration thereof, such design or a design not substantially different therefrom, was not—

(a) used in the Republic;

(b) described in any publication in the Republic;

(c) described in any printed publication anywhere;

(d) registered in the Republic . . ."

The remaining portion of the sub-section is not relevant to this case.

The applicant says the design of the chair which in the trade is called a "tulip chair" had before registration been "described in a printed publication" within the meaning of para. (c), *supra*. Eleven photostatic copies of pictures are contained in the record, and the originals were exhibited to me. Most of them appear in books which illustrate beautiful homes and gracious living. On ten of the eleven photostats chairs

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are to be seen which could appositely be called "tulip chairs". A picture was also attached to the record showing the chair design that was registered. At a glance the similarity was obvious. At this point the definition of "design" is relevant. It reads:

A "design" means 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 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 is intended to perform and any method or principle of construction shall be excluded from the rights afforded by this Act.

B The definition makes it plain that the features of a design "are judged solely by the eye". Sec. 4 (2) makes it plain that a design can only be regarded as new and original if it is "substantially different" from a design described in a printed publication which appeared before registration. I attach to this judgment the photostatic copy of the design which was registered. It is annexure "A" to the record.*

C I next attach a photostatic copy of a photograph of a chair which is called the "Saarinen chair", after the designer, Eero Saarinen of Finland.† The picture appeared in a book entitled *E. Saarinen—on his Work*, printed and published in the U.S.A. by Yale University Press in 1960. Other photographs were exhibited to the Court, which appeared in *Domus*, a periodical printed and published in July, 1966, in Europe; in *Modern Room*, a book printed and published in Milan in 1967; in *David Hicks—on Decoration*, a book published by Lesley Frewin, London, in 1966; in *New Interiors* by J. P. Morris, published in Italy in 1964; in *Young Designs in Living* by Barbara Plumb, printed and published in London in 1969; and in *Modern Chair* by E Gilbert Frey, printed and published in Switzerland in 1970. All these pictures show chairs which are unmistakably similar in design to the one on exh. "A".

The question arose as to whose eye is meant when the definition of design says "in so far as such features appeal to and are judged solely by the eye". The Act does not designate the owner of the eye but it seems obvious that it is the eye of the person who for the time being is charged with the duty of passing judgment on the design in any context in which that is necessary under the Act. In the present context it is the eye of the Court, but, as was stated in *Allen-Sherman-Hoff Co. v. Registrar of Designs*, 1935 T.P.D. 270 at p. 274:

G "the Court is entitled to have instruction from persons who, because they are engaged in the trade or art in question, or because of some special knowledge of the trade or art, are in a position to assist the Judge in coming to a proper conclusion".

Evidence is therefore allowed, and, such evidence has been placed before me by a Mr. P. T. Whitworth, an industrial design consultant practising in Johannesburg. He confirms, with copious references to the origins and general acceptance of the "tulip chair", what seems to me quite unmistakable, namely that the registered design is not substantially different from the design shown in the books.

A point was made as to whether the word "described" in sec. 4 (2) (c) does not mean more than a photograph, namely a description

*See p. 980.

† See p. 981.—Ebs.

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in words. This suggestion has—to my mind rightly—been rejected in the case of *Xacities (Pty.) Ltd. v. Tailored Containers (Pty.) Ltd.*, 1971 (2) S.A. 562 (C) at p. 566B. It was there held that a pictorial representation of a design is sufficient to qualify for a description as intended in sec. 4 (2) (c). I would only like to add that the picture should be intended to depict a design. A casual photograph, not intended to display the design of articles appearing on it, would possibly not qualify for the "description" contemplated in sec. 4 (2) (c). But these photographs are specially intended to display the chair and as such they are a description.

B The respondent was at pains to show that his own design differs from the published pictures. No doubt there will be differences. The stem of his chair is thicker and not so elegant as some of those in the pictures. But that is not the point. Anyone can camouflage plagiarism by introducing a difference here or there. It is the impact on the eye made by the whole design which is decisive, and the similarity is unmistakable and beyond argument. He also took trouble to show that his registered design was his original idea and that he had not seen the books. I will gladly accept that he did not copy anyone else's idea, but if the design had been published before, and is therefore not new, the fact that the owner had not seen or used the previously published description is not enough to preclude cancellation. Sec. 10 (2) (a) says "not new or original". If it is either not new or not original it does not qualify for registration and a registration can be cancelled.

I have therefore decided that the application should be granted. The record was burdened with unnecessary papers and I will make a special order thereanent.

The following order is made:

1. The registration of South African Registered Design No. 70/0873 is cancelled.
2. The respondent pays the costs of this application except the costs of pp. 159 to 193 of the record.
3. The question of the costs of a preliminary application, which were reserved, are to be decided on a date to be arranged with the Registrar.

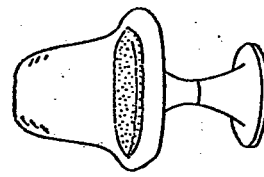
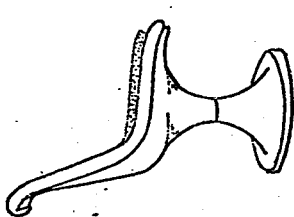
Applicant's Attorneys: *Brian Kahn & Lochner*. Respondent's Attorneys: *De Klerk & Kruger*.

ANNEXURE A.

WILLIAM JOHN BADSEY CHAIR 10

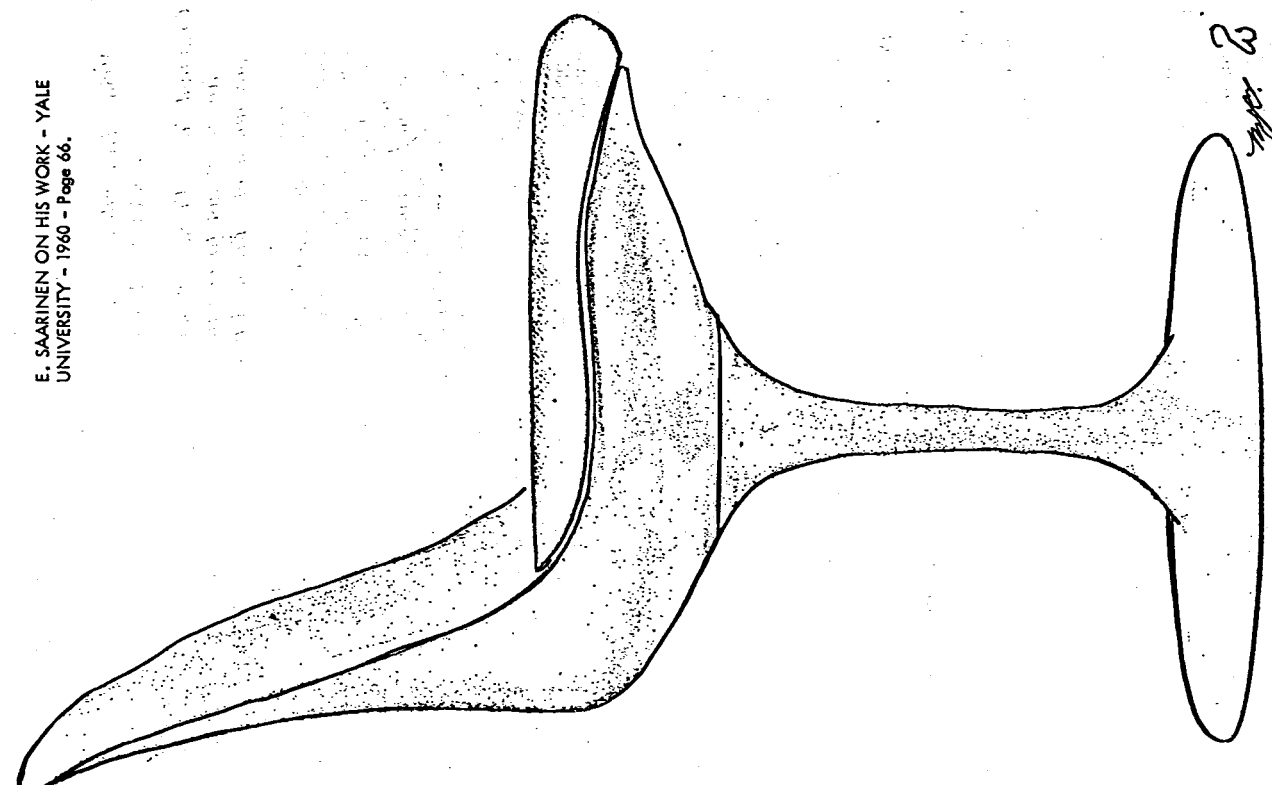
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STATEMENT OF NOVELTY :

The novelty claimed for this design resides in the features of shape, configuration and ornamentation of the article substantially as illustrated.



E. SAARINEN ON HIS WORK - YALE
UNIVERSITY - 1960 - Page 66.

ANNEXURE A.