

1935. May 1, 16. TINDALL and BARRY, JJ.

Design.—*What is registrable.*—Act 9 of 1916, section 76.

There is no novelty or originality in a design where the shape is imposed upon the designer by the choice of the material used, or where it is necessarily determined by the function of various parts, and a shape so determined is not entitled to be registered as a design.

In deciding upon the novelty or originality of a design, the Court is entitled to rely on the evidence of witnesses, 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 inform the Court of the differences or similarities which they see in the various designs, but such witnesses are not entitled to tell the Court whether the design in question is novel or original, or for that is the function of the Court alone.

The applicant applied for the registration of the design of a particular form of impeller for centrifugal pumps. The novelty of the applicant's impeller lay in the fact that it was made of rubber supported by steel plates instead of being wholly of metal. Applicant had already obtained a patent for the invention. The Court found on the evidence that the differences in shape and appearance between the applicant's impeller and previous impellers were all determined either by the material used, namely, rubber, or by the function of the parts, as in the case of certain flanges designed to enable the steel plates to fit tightly on the rubber, or were of a trifling nature, as in the case of certain peculiarly shaped holes. The Registrar having refused to register the design.

Held, on appeal, that his refusal was justified.

Appeal against the refusal by the Registrar of Designs to register a design.

The facts appear from the judgment. *1935*
O. D. Schreiner, for the appellant: The design is registrable although the article itself is patented. The shape is not entirely imposed by mechanical requirements. There are different ways of shaping available. The shape of the article as a whole is distinguishable from the fundamental form of all impellers. See Russell-Clark on *Copyright in Industrial Designs*, pp. 15, 16.

H. de Villiers, for the respondent: The design is necessarily imposed by the mere change of material used. It is a mere trade variant. There is no art in the design. See *In the Matter of Bach's Design* (6 R.P.C. 376); *Dover, Ltd. v. Nurnberger, etc.* (27 R.P.C. 498; at p. 503); *Philips v. Harbro Rubber Co.* (37 R.P.C. 233, at pp. 238, 239); *In the Matter of Wingate's Regis-*

tered Design (52 R.P.C. 126, at pp. 130, 131); *Russell-Clark (op. cit.*, p. 38).

Schreiner, in reply: This is not a case of a mere trade variant. The test of novelty is that of the eye, and this impeller is different from others in appearance. See *Russell-Clark (op. cit.*, at pp. 35, 36, 57, 58). The shape is not dictated by mechanical consideration. A choice in shape was available to the applicant, and the result is distinctive and original.

Cur. adv. vult.

Postea (May 16th).

TINDALL, J.: This is an appeal under sec. 80 (6) of Act 9 of 1916 from a refusal of the Registrar of Designs to register a design presented to him by the applicant company. The application for registration requested the Registrar to register in Class 3 a design to be applied to a rubber impeller for a centrifugal pump. Photographs of the rubber impeller in question are filed in the papers before the Court. The Registrar refused the application preliminarily on 21st September, and thereafter on 6th November a hearing took place at which a patent agent appeared on behalf of the applicant. At the hearing the article in question was not produced, but photographs were used for explaining the applicant's claim to be entitled to register a design. On appeal this Court directed evidence to be heard under Design Rule 19, and the applicant's representative in South Africa, Harris, produced a specimen of an ordinary metal impeller body of a centrifugal pump, and of the rubber impeller body in respect of which the design is claimed, and the witness explained the various features. The ordinary type of impeller is made of metal, being an integral metal casting as is shown by the exhibit produced. It has been found that owing to the liquid sometimes pumped, e.g. slimes, containing abrasive particles, the blades of the impeller, which revolves at a very high velocity, get worn. The applicant Company invented an impeller consisting of a rubber moulding supported by steel plates, rubber being resistant to the abrasive effect mentioned. The rubber moulding is pliant and therefore cannot revolve truly at a high speed unless made rigid with steel plates. These steel plates are screwed on to the back and front of the moulding. Holes shaped like a banana are made in the rubber moulding into which

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blocks of hard composition are inserted to hold some of the screws. To enable the steel plates to fit tightly on the rubber moulding the periphery of the rubber moulding is raised in the form of two flanges, the metal plates having corresponding flanges. A flange is also provided round the central hole in the front of the moulding, the steel plate having a corresponding flange round the hole in the centre of it.

The applicant has obtained a patent for its invention, but it also desires to have a design of the rubber moulding registered as a design. The registering of the patent, of course, does not prevent the applicant from registering the moulding as a design provided it can prove that the moulding has design within the meaning of the Act and that such design is new or original. In *Wingate's Design* (52 R.P.C. 131), FARWELL, J., said: "There is nothing impossible in the least in a similar device being registered both as a design and as a patent. The difference is that in the case of a design all that can be looked at is the shape, i.e., that which appeals to the eye disregarding altogether the other side of the picture, namely, the mechanical use to which the instrument can be put, whereas in the case of a patent it is not the shape of the instrument which matters, but the function which it performs." In the application before the Registrar no statement of novelty under Design Rule 19 was filed; it seems to me unfortunate that the Registrar did not require such a statement of novelty. Judging from the Registrar's reasons for his decision, and from the statement of case filed by the applicant, the differences of shape relied upon by the applicant as constituting a design are the greater thickness of the impeller and the presence of the flanges which perform sealing functions as already mentioned. The Registrar, in his reasons, stated that it was argued before him that a single mass of rubber gives rise to a distinctive appearance, but the use of rubber alters the shape since the parts must be thicker, and that flanges are provided which cannot be provided in the metal article. The Registrar was of opinion that the differences relied upon, except in the case of the flanges, were imposed upon the designer by his choice of material, namely, rubber. On that point he quoted a passage from Russell-Clark on *Copyright in Industrial Designs* (page 38) to the effect that there can be no novelty or originality where the shape is imposed upon the designer by the necessity of his task, for some mental effort, small though the amount may be,

is necessary upon the part of the inventor, and that some skill and labour of a draughtsmanlike nature must be involved to constitute a design. Then with regard to the flanges the Registrar held that the shape was necessarily determined by their function, and that the alteration of the shape of the whole article by the provision of the flanges was so slight as not to constitute a new and original design.

The applicant's impeller consists of several parts, namely, the rubber moulding, the blocks that fit into the banana-shaped holes, the steel plates on back and front of the moulding, and the steel hub fitted for holding the shaft. When the parts of the rubber impeller are fitted together the flanges and the banana-shaped holes are not visible, but I shall assume for the purposes of the present appeal that it is permissible to register part of an article as a design. On that assumption the Court has to decide whether the rubber moulding has a new or original design within the meaning of sec. 80 (1), i.e., a new or original shape or configuration, for there is no question here of pattern or ornament. In general appearance there can be no doubt that the rubber moulding is similar to the metal moulding. The witness, HARRIS, however, drew attention to seven differences in detail. Of these differences five obviously cannot be relied on as constituting design: the greater thickness of the rubber moulding cannot be relied upon because that is necessitated by the difference of material and, moreover, the evidence is that metal impellers of well-known types themselves vary in thickness. The fact that the periphery is concave and not convex like that of the metal impeller produced does not assist the applicant because some metal impellers are concave. The appearance of the blades on looking into the centre of the impeller from the front was relied on, but in my opinion nothing can be made of this point as the appearance of the metal impeller is similar except for the fact that the central hole goes right through the metal impeller. There are well-known impellers in which the hole does go right through. As to the small holes inside the blades, they are hardly noticeable and are negligible as regards appearance. The applicant, therefore, is really confined to the flanges and the banana-shaped holes. In deciding whether these constitute a design, as was stated in *Wingate's case (supra)* "one has to see whether that which it is desired to register is something which can be treated as a design appealing to the eye, or whether the shape is obviously nothing more than

part and parcel of the function without any appeal to the eye as a design, in which case there should be no registration." It was also said in that judgment that though by the eye is meant the eye of the Court it does not mean the untutored eye. 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. For that purpose witnesses are entitled to inform the Court as to the differences or similarities which they see in the various designs in question; but they are not entitled to tell the Court that such designs are novel or original or new or not. That is the function of the Court alone. But the Court may be told what persons interested in the trade see as the particular similarities or differences in the various designs, and having that knowledge, the Court must then look at the design with an eye so instructed.

My first impression, after listening to the evidence and the argument, was that the flanges constituted a design, but upon consideration I have come to the conclusion that the view of the Registrar is correct. In dealing with the appearance of the flanges we must disregard the fact that they are in circles; the circle is inherent in the mechanical device because it is a wheel which revolves. Therefore, it seems to me, that the applicant, in regard to the flanges, is confined to the appearance of the raised levels of the rubber. I think the Registrar is correct in saying that the shape of the flanges is necessarily determined by their function. It was said by Lord Moulton in *Phillips v. Harbro Rubber Company* (37 R.P.C. 239) that a design cannot be rendered new or original merely by a change of the mode of construction of the article, and that a registered design is not in any way a minor type of patent, that it is something that is protected in respect of its appearance or form alone, and that for this reason all attempts to make registered designs cover modes of manufacture have rightly failed, and that the Courts have invariably insisted on the principle that designs must be judged by the eye alone. In *Vanderrell & Co. v. Lundberg & Sons* (33 R.P.C. 69) the plaintiffs claimed a design for a box for a switch-board already patented. The patent was claimed as part of the design of the box, a feature which was an integral part of the board and as such did not form part of the design of the box but was imposed upon its designer by the necessity of his task.

YOUNGER, J., said: "If such a claim were to succeed, it would have the result that the plaintiffs would in effect obtain, under the guise of its being part of a design of its box, protection for the switch-board either beyond the protection to which as patentees they would be entitled or in respect of features to which as a part of their switch-board they were entitled to no protection at all. To my mind it would be most dangerous to extend the scope of the Patents and Designs Act so as to include such a claim within it; and I find, in the opinion of the House of Lords, in the *Gramophone* case, a distinct warning against any extension of the Act in the matter of designs which are merely useful. It is quite true that a design is not bad because it may incidentally be useful. It is, however, quite another proposition to say that a designer is entitled to claim as an original feature of his design some pre-existing thing, not originating with him as a designer but imposed upon him as a feature or component part of that which his design has to fit." It seems to me that the same is the case in regard to the flanges. Having used rubber for the moulding it was necessary to make the moulding rigid by fitting steel plates on to the front and the back of the moulding. For sealing purposes the flanges in question were devised. I do not think that it assists the applicant to say that means other than the steel flanges could have been devised to seal the steel plates. The fact remains that the flanges are merely an integral part of the change of the mode of construction of a well-known article.

In regard to the banana-shaped holes, as already stated these were not relied on before the Registrar and are not relied on in the statement of case, and one doubts whether they would have been mentioned had a statement of novelty been required under Design Rule 19. I can see nothing new in the shape itself of these holes, but the question is whether they are new or original having regard to the purpose to which they are applied. It seems to me that whether the blocks to hold the screws are round, oval, banana-shaped, or square is such a trifling matter that the variation in shape cannot be said to constitute any substantial novelty.

For these reasons, in my opinion, the appeal fails and the applicant will have to rest content with its patent rights.

In regard to costs, the point was taken in this appeal, as in that of *Holman Bros., Ltd. v. Registrar of Designs** (in which judgment

* (*Supra*, p. 266.)

has just been delivered) that the Registrar was not entitled to appear. For the reasons stated in that judgment the Court holds that the Registrar was entitled to appear and is entitled to costs.

The appeal is dismissed with costs.

BARRY, J.: I agree.

Appellant's Attorney : E. H. Veale.

Respondent's Attorney : Government Attorney.

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36 Q.A. 486.

THOM v. UNION GOVERNMENT.

1935. May 2, 15. TINDALL, BARRY and FISCHER, JJ.

Mines and minerals.—Section 10 of Act 35 of 1908, as amended by section 2 of Act 36 of 1934.—*Prospecting on lapsed claims.*—*Validity of.*—*Statute.*—*Interpretation.*—*Generalia specialibus non derogant.*

The new section 10 of Act 35 of 1908, as enacted by section 2 of Act 36 of 1934, does not authorise prospecting by the holders of prospecting permits on proclaimed land previously held under claim licences, when the rights under such claim licences have lapsed to the Crown under section 100 of Act 35 of 1908. The effect of section 100 is to confer the right on the Crown of keeping the land in respect of which claim licences have lapsed available indefinitely for treatment under section 30; and this right, on the principle of construction *generalia specialibus non derogant*, is not overridden by the general provisions of the new section 10.

Appeal against a decision of DE WET, J., in Chambers.

The facts appear from the judgment.

Colin Steyn, K.C. (with him J. G. N. Strauss), for the appellant : Under new sec. 10 land not held under mining title and not reserved from pegging may be prospected. A notice declaring the land open to prospecting is no longer necessary, as it was under old sec. 10 (2). The land here in question is not held under mining title and is not reserved from pegging. The effect of sec. 100 is that on lapsing of claim licences the claims revert to the condition of being unpegged ground on proclaimed land, and in the absence of a notice

in terms of sec. 10 (2) withdrawing the land from prospecting, there is no let or hindrance to pegging.

J. M. Murray (with him B. T. Tindall), for the respondent : (after tracing the history of legislation relating to lapsed claims). There are no public rights revived by a lapse of rights under sec. 99. Such right is excluded by the provision of sec. 100, which leaves the ground at the option of the Governor-General to deal with in terms of sec. 30, or of sec. 14 of Act 30 of 1918. In the result, the lapsed claims must be regarded as impliedly reserved from pegging. The fact that there was no specific repeal of secs. 30 and 100 indicates that the rights of the Crown as represented by those sections were to be maintained intact.

In any case, as the lapsed claims were held under mining title, on such claims passing to the Crown they must be regarded as held under mining title in terms of sec. 10 (1) in the hands of the Crown.

Steyn, in reply.

Cur. adv. vult.

Postea (May 15th).

TINDALL, J. : This appeal raises the question of the validity of the pegging by the appellant under a prospecting permit of a prospecting area on land which had previously been held under claim licences, the licences having lapsed under sec. 100 of Act 35 of 1908. It is common cause that, but for the amendment of sec. 10 of Act 35 of 1908 contained in sec. 2 of Act 36 of 1934, the land would not have been open to prospecting. The rights claimed by the appellant, therefore, depend on the effect of the new sec. 10. The land in question, namely portion B of the farm Tweefontein, Heidelberg, is Crown land, and was proclaimed a public digging partly in 1888 and partly in 1911, and as from the latter date the whole of it has been a duly proclaimed public digging.

The whole of the said land was pegged under sec. 32 of Act 35 of 1908 by one J. H. Pienaar and by the West Rand Development and Exploration Company, Limited, and these holders held the claims pegged under prospecting licences. Owing to the failure of these holders to pay the licence moneys under sec. 40, the claims, comprising the whole of the said portion B, lapsed to the Crown in terms of sec. 100, the lapsing having occurred as regards