

signed the other pages of the will as required by the section. The testatrix died on 17 October 1972. The commissioner of oaths who appended the certificate to the 1972 will wanted to sign the other pages of that will but did not wish to do so without the knowledge and approval of the Court. The application was brought by the executors appointed in the 1972 will.

A. *Mendelow, Q.C.* (with him *H. H. Nestadt*), for the applicants: The only question is whether the will can now subsequent to the death of the testatrix be validated by the commissioner signing the various pages thereof. In *Ex parte Nel*, 1955 (2) S.A. 133, the Court in relation to sec. 2 (1) (a) (v) of the Act in its unamended form held that the certification referred to in the section must, at the very least, have been effected before the death of the testator. In such unamended form the commissioner of oaths had to certify that the testator "is known to him and that he has satisfied himself that the will so signed is the will of the testator". In *Ex parte Sookoo: In re Estate Dularie*, 1960 (4) S.A. 249, CANEY, J., dealing with the Act in its unamended form, stated (*obiter*) that *post mortem* certification is too late. The learned Judge cited *Nel's* case as authority. In *Soonaram v. The Master and Others*, 1971 (3) S.A. 598, it was held that a will invalid as at the testator's death (by reason of the prescribed certificate not being in proper form) cannot be validated by adding to it such certificate after his death so as to comply with the requirements of the section. Despite the 1958 amendment to the section, which required the commissioner to certify that "he has satisfied himself as to the identity of the testator", HENNING, J., equated "is known" with "has satisfied" and followed the principle of *Nel's* case. In *Arendse v. The Master and Others*, 1973 (3) S.A. 333, BAKER, A.J., after an exhaustive review of the authorities concluded (*albeit obiter*) that the prescribed certificate can be appended at any time after the will has been "marked" by the testator and signed by the witnesses and this even *post mortem testatoris*.

As to the alternative submission that an order in terms of para. 4 of the notice of motion be granted the submission rests on the principle of dependent relative revocation. As observed by the Master in his report this principle is part of our law. *Raabe v. The Master and Another*, 1971 (1) S.A. 780. On the facts it would seem to be clear that the testatrix did not intend to die intestate and that the revocation of her first will was dependent upon her second will being valid. To provide for possible representations which the beneficiaries under both wills may wish to make a rule *nisi* providing for service on such parties should be issued.

G No appearance for the respondent who abided the decision of the Court.

MOLL, J.: In the circumstances, and in order to avoid unnecessary cost for the State, I am prepared to accede to the request to appoint, at this stage, Adv. Aaron Frame as *curator ad litem* on behalf of Jimmy Anthony Bakos.

H There will then be a rule in terms of paras. 1, 2 and 3 of the notice of motion, returnable on 6 August 1974, and to be served on Beverly Bakos, Delores Basel, Allana Bakos, and the said *curator ad litem* on behalf of Jimmy Anthony Bakos, on Louis Bakos and Jeanette Mercedes Bakos on behalf of Jimmy Anthony Bakos and his unborn heirs.

Postea (August 6). The rule *nisi* was confirmed.

Applicants' Attorneys: Sapire, Jacobson & Creswick.

SWISSTOOL MANUFACTURING CO. v. OMEGA AFRICA PLASTICS.

(WITWATERSRAND LOCAL DIVISION.)

1975. February 12, 13; May 16. ELOFF, J.

A

Copyright.—*Design.*—*Action for interdict in respect of alleged infringements of a registered design.*—*Defendant entitled to counterclaim for cancellation of registration.*—*Act 57 of 1967, secs. 10 (2), 24 (4).*—*Court in any event having discretion to sanction counterclaim B procedure.*—*Validity of registration of design.*—*Fact of registration gives design prima facie validity.*—*Onus on defendant to prove invalidity.*—*"In so far as such features appeal to and are judged solely by the eye" in definition of "design" in sec. 1 (vi) of Act.*—*Such "eye" is the eye of the Court but regard may be had to what is likely to appeal to the customer.*—*Association of well-known features in C design.*—*Such can result in a distinctive design.*

The provision in section 24 (4) of the Designs Act, 57 of 1967, that cancellation of the registration of a design may be sought by a defendant on any of the grounds specified in section 10 (2) must have been enacted with contemplation of the fact that such relief should ordinarily be sought by introduction of a counterclaim. Whatever the position regarding choice of procedure might be as regards an interested party who initiates proceedings, a defendant in a claim for an interdict in respect of an alleged infringement of a registered design is entitled to claim cancellation by way of counterclaim. In any event the Court has a discretion whether or not to sanction such a procedure.

The fact of the registration of a design gives a plaintiff's design *prima facie* validity and the *onus* in relation to a counterclaim for cancellation of such registration for want of novelty or originality is in consequence on the defendant.

It is not inconsistent that while the eye in the phrase "in so far as such features appeal to and are judged solely by the eye" in the definition of "design" in section 1 (vi) of the Designs Act, 57 of 1967, is to be the eye of the Court, the Court should view the design through the spectacles of the customer. It should be borne in mind that the probing, tutored eye of the Court may discern features F which could well escape many customers. Furthermore, when it comes to making comparisons between certain designs, the Court is enjoined to have regard to the doctrine of imperfect recollection, which also involves bearing in mind that the customer, unlike the Court, might not see the articles embodying the designs at the same time or place. Accordingly, while the eye referred to in the definition is the eye of the Court, regard may in certain instances be had to what is likely to appeal to the customer and what he has seen.

An association of features in a design, even though such features individually might be well known, can result in a distinctive design.

Action for an interdict and counterclaim for cancellation of the registration of a design. Facts not material to this report have been omitted.

R. Kruger, S.C. (with him N. M. MacArthur), for the plaintiff.

H. H. Nestadt, for the defendant.

Cur. adv. vult.

Postea (May 16).

ELOFF, J.: The plaintiff in this action seeks to protect its rights in respect of a design registered in its favour against alleged infringements thereof.

Apart from an interdict other ancillary relief is also sought, but by agreement between the parties I am at this stage solely required to adjudicate on the claim for an interdict.

It is common cause that the design was registered as No. 70/005 reflecting A plaintiff as the proprietor thereof, and that it is still so registered. It was registered in respect of its application to articles in class 9 in terms of the Designs Act, 57 of 1967, which included containers. It is also common B cause that defendant has for some time and still is making and vending moulded plastic containers in the Republic of South Africa, and in particular a container a specimen of which was by agreement placed before me as C exhibit 1. It is plaintiff's case that the manufacture and vending of containers of the shape, configuration and appearance of exhibit 1 constitute an infringement of its above-mentioned registered rights.

On the pleadings the main issues which have been canvassed appear to be—

- C (a) whether the registration of design No. 70/005 is not liable to cancellation for want of novelty or originality;
- D (b) whether—assuming a negative answer to the first question—exhibit 1 embodies plaintiff's registered design or a design not substantially different therefrom. In this regard the point is also raised whether certain specified features of plaintiff's design, which are relied upon by it as part of the similarity with exhibit 1, are not dictated solely by the function which the article is intended to perform, and are accordingly excluded from the rights afforded by the Designs Act, 57 of 1967.

In regard to the first-mentioned of these issues the defendant not only E pleaded that the registration was invalid, but brought a counterclaim in connection with which he cited the Registrar of Designs as a third party, and in which an order for cancellation is sought. In this regard my attention was drawn thereto that sec. 10 (2) of the Act states that any person interested "may apply" for cancellation of the registration of a design, *inter alia*, on the ground that it was not new or original, and that the Court may make such F order on the "application" as it thinks fit. *Prima facie* the wording suggests that the Legislature contemplated that relief should only be sought on application and not by action (cf. *Gulf Oil Corporation v. Rembrandt Fabrikante en Handelsaars (Edms.) Bpk.*, 1963 (2) S.A. 10 (T) at p. 28B-D, on a similarly worded section). Regard should in my view be had also to the G provisions of sec. 24 of the Act, which give a registered proprietor of a design the right to bring proceedings to protect his interests, and which in sub-sec. (4) provides:

"In any proceedings under this section the Court shall have jurisdiction to order the cancellation of the registration of a design on any of the grounds specified in sec. 10 (2), and any such grounds 'may be relied upon' by way of defence."

H The provision that cancellation may be sought by a defendant must in my opinion have been enacted with contemplation of the fact that such relief should ordinarily be sought by introduction of a counterclaim. I think that whatever the position regarding choice of procedure might be as regards an interested party who initiates proceedings, a defendant such as the present is entitled to claim cancellation by way of counterclaim.

In any event I have a discretion whether or not to sanction procedure such as that adopted by defendant (*Mobbs Ltd. v. Sargent Ltd.*, 1936 E.D.L. 356; *Herbert Evans & Co. v. Henkel and Cie G.M.B.H.*; *Henkel and Cie*

G.M.B.H. v. *Herbert Evans & Co.*, 1962 (1) S.A. 8 (T) at pp. 11H-12B), and this to me appears eminently to be a case where I should exercise my discretion by approving of the bringing of the counterclaim.

Both parties to this action led evidence on the issue outlined above. I received this evidence because, although the question which permeates both A of the issues, namely what appeals to the eye in all the designs to which I shall presently refer, is one which I must resolve in the light of my own impressions in view of the designs in question, I may avail myself of the assistance of the opinions of experts. As TINDALL, J., said in *Allen-Sherman-Hoff Co. v. Registrar of Designs*, 1935 T.P.D. 270 at p. 274:

"It was also said in that judgment (in the *Wingate's Design*, 52 R.P.C. 131) that though by eye is meant the eye of the Court it does not mean the untutored eye. The Court is entitled to have instructions from persons who, because they are engaged in the trade or art in question, or because of some special knowledge of 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 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 designs with an eye so instructed."

See too *Xacrics (Pty.) Ltd. v. Tailored Containers (Pty.) Ltd.*, 1971 (2) S.A. 562 (C) at pp. 563H-564A.

Now the photographic representation of the article to which design No. 70/005 applies, and which forms part of the documents of registration, reveals a container, cylindrical in shape, with an enlarged recess at the bottom (obviously provided so as to facilitate stacking), and a spout, handle E and locating platform at the top. The handle, which is fairly large in relation to the size of the container, is somewhat offset. The spout is in line with the handle, and is placed close to the edge of the top of the container. The locating platform (also provided so as to facilitate stacking) is rounded, and the spout and part of the handle rise from it. The middle section of the vertical side of the container is recessed, and the sections above and below this recessed waist are rounded towards the top and bottom: respectively of F the container. These are the main features of the design. A model made in accordance with the design was by consent placed before me as exhibit 2. For the sake of convenience I shall henceforth refer to design No. 70/005 as exhibit 2, recognising nevertheless that for the purpose of the various comparisons which have to be made regard will always have to be had on G the one side to the perspective view as shown in the documents of registration.

It is, I think, logical that I should first discuss the issue relative to the validity or otherwise of design No. 70/005. It is necessary that I should here refer to the statutory basis of defendant's attack. Sec. 4 (1) of the Act authorises registration on application by any person claiming to be the H proprietor of "any new nor original design". Sec. 4 (2) provides:

"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;
- (e)

In its pleadings as amended defendant relies on descriptions contained in a number of publications of containers, and also on a design registered as No. 69/294. It was agreed between the parties that all of these publications (copies of which were placed before me by consent) were published in the Republic of South Africa prior to the date on which plaintiff applied for the registration of its design. It was also agreed that design No. 69/294 (the registration papers relative thereto were placed before me by consent) was registered before the date of plaintiff's above-mentioned application. On the strength of these publications and registration No. 69/294 it was alleged that plaintiff's design was neither new nor original on the basis set forth in paras. A (a), (b), (c) or (d) of sec. 4 (2) of the Act. The validity issue is therefore narrowed down to an enquiry into whether the prior publications alleged (there are nine of them) or design No. 69/294 describe designs any one of which are not substantially different from plaintiff's design.

Before I deal with the prior articles there are a few observations which I consider should be made.

To begin with, it should be borne in mind that the fact of registration gives plaintiff's design *prima facie* validity (*Amp Incorporated v. Utilit Proprietary Ltd.*, 1972 R.P.C. 103 at p. 108). The *onus* in relation to the first main issue is in consequence on the defendant.

Secondly, it is necessary that I should state my approach in relation to a point which was debated in the argument. It relates to part of the definition of "designs". The definition is as follows:

" '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." (My italics).

In regard to the phrase in the definition which I have italicised the question was posed: whose eye? It will be remembered that in the *Allen-Sherman-Hoff* case from which I quoted earlier herein, it was said that what is meant was the eye of the Court. This *dictum* was quoted with approval in the decision in the case of *Brudd Lines (Pty.) Ltd. v. Badsey (2)*, 1973 (3) S.A. 975 (T) at p. 978F-G, where it was said:

"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 it is necessary under the Act." However, in the *Amp Incorporated* case, *supra*, which was a decision of the House of Lords, the following was said by Lord Reid at p. 108:

"Then there come the words 'being features which in the finished article appeal to and are judged solely by the eye'. This must be intended to be a limitation of the foregoing generality. The eye must be the eye of the customer if I am right in holding that the policy of the Act was to preserve to the owner of the design the commercial value resulting from customers preferring the appearance of articles which have the design to that of those who do not have it. So the design must be one which appeals to the eye of some customers."

To like effect is the following extract from the speech of Lord Morris of Borth-y-Gest on p. 112:

"The eye concerned will be the eye, not of the Court but of the person who may be deciding whether or not to acquire the finished article possessing the feature in question."

Counsel for the plaintiff contended that I should follow the House of Lords decision which was given in relation to a definition of "design", which is substantially similar to our own.

It is not clear to me that the above-mentioned *dicta* in the South African cases are necessarily inconsistent with the point which was being made by A the House of Lords. In the *Allen-Sherman-Hoff* and *Brudd Lines* cases the emphasis was being placed thereon that the decision of the Court must be reached in the light and on the basis of its own impressions.

The question whether the suggested divergence between the approach reflected in the South African decisions on the one hand and the *Amp Incorporated* case is not more imaginary than real is not free from difficulty. B I do not think that it is inconsistent with what was said in the South African decisions 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. It should, I think, be borne in mind that the probing, tutored eye of the Court may discern features which could well escape many customers. It is also not in C my view inconsistent with the South African *dicta* that the Court may in a given case be persuaded that the customers of an article embodying a design may comprise a class of persons in respect of whom it can be said that they will be influenced solely and exclusively by the function which the article in question is supposed to achieve, and not at all by its appearance. Such a case D was mentioned by Lord Reid in his speech on p. 108 (36-39). Furthermore, when it comes to making comparisons between certain designs, the Court is enjoined to have regard to the doctrine of imperfect recollection, which also involves bearing in mind that the customer, unlike the Court, might not see the articles embodying the designs at the same time or place. I accordingly E think that while the eye referred to in the definition is, as was laid down by the South African cases, the eye of the Court, regard may in certain instances be had to what is likely to appeal to the customer and what he has seen. To the extent that the views expressed in the *Amp Incorporated* case go further than that, I am not bound by them, and I must follow the South African decisions.

F I should also say a word or two concerning the witnesses who testified in this case, not only concerning the prior article but also in regard to the second main issue.

For the plaintiff one John Galgut was called. He is an attorney and patent agent and also holds an engineering degree. In addition he is a qualified G registered British patent agent, and in fact practised in Great Britain for a number of years where he gained experience in dealing with and considering designs for registration. He does not however have experience in marketing or manufacturing of containers. As far as that is concerned Roy Ayliff, who was called as defendant's expert witness, did have considerable experience H in the manufacture of moulds to manufacture plastic products including containers, and the design thereof. He also had experience for a few years from 1962 onwards in marketing plastic products. However, Ayliff's value as a witness was merely, as in the case of Galgut, to tutor me, and in the ultimate analysis my decision will depend on my own impressions, having regard to all the features which were drawn to my attention. There is in the present case little virtue in comparing Galgut and Ayliff as witnesses, and I found them both to be of value to me in my thinking.

I now intend to discuss the items of prior articles one by one.

[The learned Judge then dealt with the prior articles and continued as follows].

A me to be novel, and the attack on the registration fails.
My conclusion in relation to the first main issue is that exhibit 2 was not anticipated by the prior articles relied upon. Viewed as a whole it appears to

A now turn to the second main issue, involving the comparison between exhibit 1 and 2. It will be convenient firstly to set out the salient similarities between the two, which I think are the following:

[The learned Judge then set out the similarities and continued as follows].

B Now in regard to the points of similarity it was part of defendant's case that I should disregard the fact that each of the two designs had locating platforms and recesses which were very similar. Reliance was placed in this regard on the terms of the proviso to the definition of "design", which I quoted previously, and which excludes from protection any feature in an article incorporating a design in so far as the feature is dictated solely by the function which the article was intended to perform. The locating platform and recess are clearly functional items, but it was pointed out by Mr. Galgut, and I think that it stands to reason, that neither of these features have to be given the appearance which they were in exhibit 1 and 2 to fulfil the function intended. Mr. *Nestadt* argued, however, that that does not matter, and he relied on what was said by Lord Reid on p. 109 (30) of the *Amp Incorporated* case:

"The respondent's argument is that a shape is only dictated by function if it is necessary to use that precise shape and no other in order to perform the function. Admittedly if that is the meaning the scope of this provision would be reduced almost to vanishing point because it is difficult to imagine any actual case where one shape and one shape alone will work."

E I do not however consider the contention discussed and rejected by Lord Reid to be apposite. We are more concerned with the question whether the fact that the locating platform and recess was given the appearance which it has was dictated solely by functional reasons. Both features could have been given a variety of shapes, but they were given the appearance which they did partly for functional reasons and partly for the visual impact. As such they seem to me to fall within the requirement stated as follows on p. 110 (27) of the *Amp Incorporated* case:

"There must be a blend of industrial efficiency with visual appeal."

I accordingly hold that defendant's reliance on the proviso does not assist it.

G I now turn to the impression made on me of the points of difference between exhibit 1 and 2, and for the sake of convenience I shall follow the numerical sequence set out above.

[The learned Judge then dealt with the points of difference and continued as follows].

H Regard has of course to be had to the overall appearance of the two articles, and to the composite effect of the differences. I think that the factors which are most conspicuous amongst the common denominators of the exhibits are the cylindrical appearance; the similarity in height-diameter ratio; the tapering of the bottom and lower ends, the large similarly shaped recesses; the large similarly shaped handles, the position of the pouring spouts in relation to the handles; the locating platforms; and the waists or what appear almost as waists. When viewed against this the points of difference are inconspicuous and do not have the effect of making exhibit 1 appear to be substantially different from exhibit 2.

I now refer to Mr. *Nestadt's* contention that mosaicing can be considered when it comes to a comparison such as I am presently engaged in. He referred in this regard to the decision in the application of *Universal Plastics Ltd.*, 1958 R.P.C. 439 at p. 441 (30), where the following was quoted with approval from an earlier decision:

"In my opinion it is not open to a manufacturer to take one or more leading features of different goods already on the market, and by registering a design showing merely a combination of those features, and without any real mental activity for its production, acquire copyright in a registered design."

Mr. *Nestadt* argued that all that both plaintiff and defendant did was to piece a number of well-known features together, and that the combination is not so distinctive as to make exhibit 1 appear to be substantially similar to exhibit 2. I do not agree. An association of features, even though they individually might be well known, can result in a distinctive design, and I think that plaintiff has achieved this.

Mr. *Nestadt* further argued that, inasmuch as exhibit 2 does show some resemblance to the Plysu container, even a slight difference between exhibit 1 and 2 will suffice to defeat the claim. I am however satisfied that the main and conspicuous features of plaintiff's design, in particular the large handle, the large recess and the waist constitute so fundamental a departure from the Plysu container that the argument cannot succeed.

I am conscious of the fact that the Court should not protect a registered design so as to give a monopoly in favour of the holder in respect of designs falling outside the scope of the design, and so impede growth, but in my view a clear infringement has been established in this case.

E I grant an interdict restraining defendant from infringing registered design No. 70/005, and I direct it to pay the costs of the action including the costs attendant on the briefing of two counsel. By agreement I postpone the hearing of plaintiff's other claims *sine die*. In terms of sec. 25 (1) of the Act I in addition certify that the validity of the registration of the said registered design was contested in these proceedings.

Plaintiff's Attorneys: T. T. Baskin & Levin. Defendant's Attorneys: F. Ratray, Truter & Berman.