SCREENTEX (PTY) LTD v J LYONS & CO (PTY) LTD AND OTHERS 1967 (2) SA 375 (D)

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Citation 1967 (2) SA 375 (D)

Court Durban and Coast Local Division

Judge Friedman J

Heard August 18, 1966

Judgment August 28, 1966

Annotations Link to Case Annotations

A

[zFNz]Flynote : Sleutelwoorde

Copyright - Design - Registration of - Design 'previously used' - Meaning of in sec. 80 (1) of Act 9 of 1916. B

[zHNz]Headnote : Kopnota

When a design is exhibited for a commercial purpose and otherwise than in confidential circumstances, before its registration in terms of section 80 (1) of Act 9 of 1916 is sought, it is 'previously used' within the meaning of that expression in the sub-section, with the result that, even if the person claiming to be its proprietor was not a party to such use, its subsequent registration is invalid. This is so, even when the exhibition was of the design applied to goods of a different class from those in respect of which subsequent registration C is sought, provided that the different goods shared the same general character and the same general use.

[zCIz]Case Information

Return day of a rule nisi. The first respondent manufactured tea, which it supplied in containers decorated with a willow pattern. In terms of sec. 37 of Act 62 of 1963 the pattern had been registered in its name as D a trade mark in respect of pure Ceylon tea. During early 1965, the first respondent had employed the services of the applicant to print a willow pattern, identical to the registered trade mark except for its lack of the border which surrounded the latter, upon textile goods which were to be distributed to the public in the course of a campaign to promote E sales of the first respondent's products. The applicant had rendered such services until late 1965, when they had been terminated and when those of the second respondent had been engaged.

In terms of sec. 80 (1) of Act 9 of 1916, the applicant had in the meantime caused the willow pattern, in the form in which it was printed on the textile goods, to be registered in its name as a design applied F to specified classes of textiles. The registration had been effective from 28th July, 1965, in terms of certificates of registration issued by the Registrar of Designs on 5th August, 1965.

On 24th June, 1966, the applicant had applied ex parte for, and had obtained, a rule nisi, calling upon the respondents to show cause why G they should not be interdicted from printing, producing or supplying specified textile goods bearing the registered design, and an interim interdict in those terms, operative until the return day. The applicant had relied upon alleged infringements by the respondents of the copyright in the registered design conferred upon it in terms of sec. 87 (1) of Act 9 of 1916. The respondents opposed the confirmation of the H rule nisi, and applied in terms of sec. 86 (1) of the Act for the order which appears from the judgment. They contended that the registration of the design in the applicant's name had been invalid for a number of reasons, which included the circumstance that, before it was so registered, it had been used within the Republic of South Africa, and that it had not therefore qualified, in terms of sec. 80 (1) of the Act, for registration. In this connection, they relied upon an affidavit deposed to by Mrs. M. P. de Villiers, an employee of the first respondent,

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who testified that a number of social functions had been held in Cape Town and in its vicinity during April 1965 and May 1965; that members of the public had been invited to attend them and had done so; that she had A exhibited to those present, and had offered in due course to distribute to them, towels bearing the willow pattern subsequently registered as a design; and that this had been done, not for any secret or confidential purpose, but for the purposes of the campaign to promote sales of the first respondent's products.

G. I. Raftesath, for the applicant.

B J. M. Didcott, for the respondents: The provisions of sec. 80 (1) of our Act 9 of 1916 correspond substantially, for purposes relevant to the present proceedings, with those of sec. 47 (1) of the English Patents, Designs & Trade Marks Act of 1883 (now repealed) and with those of sec. 49 (1) of the English Patents & Designs Act of 1907 (now also C repealed). If there is any difference in meaning between the expression 'previously used' in the South African legislation and the expression 'previously published' in the English legislation, the former expression, while including the notion of the latter, is the wider in import. The provisions of sec. 90 of our Act 9 of 1916 are identical to those of sec. 55 of the 1907 English Act. The English cases to be D referred to are therefore in point. Before its registration, the willow pattern had publicly been exhibited by Mrs. de Villiers for a commercial purpose, and not in confidential circumstances. Notwithstanding that the applicant had not been a party to its exhibition, it had therefore been 'previously published' within the meaning of that expression in the English legislation. Cf. Blank v Footman, Pretty and Co., (1888) 39 E Ch. D. 678 at p. 683; Gunston v Winox Ltd., (1921) 1 Ch. 664 (C.A.) at p. 668; Kangol (Manufacturing) Ltd v Centrokomisie (London) Ltd., (1937) 3 All E.R. 179 at p. 180. A fortiori, it had been 'previously used', within the meaning of the expression in sec. 80 (1) of our Act 9 F of 1916. This conclusion is not affected by the circumstance that the exhibition might have been of the design applied to goods of a somewhat different class from those in respect of which it was subsequently registered; for the towels which had been exhibited were of the same general character and general use as the goods in respect of which registration was eventually effected. Cf. Saunders v Wiel, (1893) 1 Q.B. 470 (C.A.) at p. 473; In re Clarke's Design, (1896) 2 Ch. 38 G (C.A.) at pp. 44 - 5.

The order sought by the respondents is competent and in the correct form. See Mobbs Ltd v Sargent Ltd., 1936 E.D.L. 356.

[zJDz]Judgment

H FRIEDMAN, J.: It is unnecessary for me to set out the history of this litigation, or to deal with the various allegations which have been made in the affidavits filed on behalf of the applicant and the respondents or with the various submissions made to me by counsel. It is sufficient if I say that the affidavit of Mrs. de Villiers, which has been filed on behalf of the respondents, satisfies me that, before the applicant applied for the registration of its design, that design had been used within the Republic of South Africa. The allegations made by Mrs. de Villiers are not disputed, the applicant, as I understand the position, being unable to either admit or deny them.

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In the light of these allegations, Mr. Raftesath, while not conceding that the respondents are entitled to an order in terms of the opposing order prayed, frankly stated that he found himself in some difficulty in trying to contend that the design had not been used within the Republic A of South Africa before it was registered. I can quite appreciate Mr. Raftesath's difficulty in this regard, because it seems to me to be quite clear, on the evidence of Mrs. de Villiers, looked at in the light of the authorities to which I have been referred, that there had been such use and that the registration of the applicant's design was, therefore, invalid.

B It follows that the respondents are entitled to an order in terms of the opposing order prayed, with the amendments which have been suggested by Mr. Didcott and which have not been opposed by Mr. Raftesath.

The order I accordingly make is that the 'willow pattern' which was C registered as a design in the applicant's name with effect from 28th July, 1965, and the registration of which was reflected by means of the certificates issued on 5th August, 1965, by the Registrar of Designs in respect of designs Nos. 728 of 1965 and 729 of 1965, is declared to have been used within the Republic of South Africa before it was so registered; that the said registration of the said 'willow pattern' is D therefore declared to have been invalid; that the applicant is hereby directed forthwith to apply to the Registrar of Designs, and to adopt all other necessary measures, for the cancellation of the said registration of the said 'willow pattern'; and that the rule nisi and the interim interdict, which were granted by this Court in the present proceedings on 24th June, 1966, are hereby discharged.

E In so far as the costs are concerned. Mr. Raftesath contends that the respondents should be ordered to pay the costs of the proceedings in which the respondents sought to have the interim interdict discharged before the applicant had had an opportunity of filing replying affidavits.

[The learned Judge then dealt with certain facts and concluded.]

F In these circumstances, I do not propose to make any special order in regard to those particular costs and the final paragraph, therefore, of the order which I make is that the applicant is ordered to pay the costs of the respondents, including the costs of the hearing on 18th August, 1966.

G Applicant's Attorneys: A. Goldberg and Douglas Tobias. Respondents' Attorneys: Goodricke & Son.