W R B ENTERPRISES (PTY) LTD v PLASBOX INDUSTRIAL APPLIANCES (PTY) LTD AND ANOTHER (1) 1975 (1) SA 801 (T)

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Citation 1975 (1) SA 801 (T)

Court Transvaal Provincial Division

Judge Hiemstra J

Heard November 20, 1974

Judgment November 20, 1974

Annotations Link to Case Annotations

[zFNz]Flynote : Sleutelwoorde

Copyright - Design - Application for a temporary interdict - Recently registered design - Approach by E Court - Interdict - Temporary interdict - In respect of a recently registered design - Approach by Court.

[zHNz]Headnote : Kopnota

A temporary interdict will not, where a recent patent is involved, be granted where there is a serious question to be tried as to its validity. The same principles apply in the case of designs. Where the patent or design is clearly valid there F is no objection to the granting of an interdict.

[zCIz]Case Information

Application for an interdict. The facts appear from the reasons for judgment.

C. E. Puckrin, for the applicant.

R. H. Peart, S. C. (with him D. Marais ), for the respondents. G

[zJDz]Judgment

HIEMSTRA, J.: The applicant asks for an interdict against each of the two respondents which will restrain them from selling an article which applicant claims to be a design registered in its name in terms of the Designs Act, 57 of 1967. The article involved is a set of four decimalised measuring receptacles for kitchen use. In the alternative a temporary interdict is H applied for pending the determination of an action to be instituted.

The application was brought as a matter of urgency in terms of Rule 6 (12) (a). The respondent contended in limine that the proceeding should in terms of Rule 30 (1) be set aside as an improper or irregular proceeding because it is not urgent and the applicant can gain substantial redress in due course, by way of damages. The applicant says the matter is urgent because respondents have, besides other marketing activities, publicised their own product in a monthly magazine by way of a full-page advertisement in colour. Applicant fears that its

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own sales will be adversely affected, especially during the festive season in December. The damage will be all the greater because it has just produced a more expensive article of beteer quality plastic.

Mr. Peart, for the respondents, relied strongly on the A following passage in Zaidener v Barrisdale Engineers Ltd., 1968 R. P. C. 488 at p. 495:

"I take it to be well settled that an interlocutory application will not normally be granted where damages will provide an adequate remedy should the claim succeed."

I do not consider damages in such a matter to be an adequate remedy. The damage resulting from unfair competition is extremely difficult to assess and involves a long and expensive B trial. It is much better to prevent damage where the applicant's rights are clear. Infringement of a registered design by way of unfair competition causes damage day by day and an applicant who bona fide believes that he is the victim of such conduct, is justified in coming to Court by way of urgent application. It could be that issues come to light which necessitate a postponement and adequate time to the respondent C to reply. But I would not dismiss the application or set it aside in terms of Rule 30 on the ground that it is not urgent.

Because I was not disposed to uphold the point taken in limine, Mr. Peart proceeded to argue the matter on its merits. He was on surer ground when he contended that the Courts are slow to D grant an interim interdict where the patent or the design is of recent date. The design involved here was registered on 18 July 1973. There is ample authority for this proposition, e. g. Griesel and Another v Phoenix Foundry and Another, 1929 T. P. D. 806 at p. 810. It is there laid down, on the authority of English cases, that a temporary interdict will not, where a recent patent is involved, be granted where there is a serious question to be tried in regard to its validity. This is a E principle of long standing, reaffirmed in Smith v Grigg, (1924) 41 R. P. C. 149 at p. 153. Lord ATKIN further says at p. 154 that the mere fact that a patent has been granted does not show that the holder has an exclusive right. A patent which has been long established is in a stronger position. The same line was followed as recently as 1968 in the case of Zaidener, supra at p. 496.

F These cases have to do with patents, and Mr. Puckrin, for the applicant, drew my attention to sec. 15 of the Designs Act which provides that the registered proprietor of a design shall have the exclusive right to use it. It must be noted however that the Patents Act, 37 of 1952, has the same provision in sec. 32 and the British Act has it in sec. 21. And yet it did not prevent the Courts, here or in England, from adopting a G questioning attitude to new patents and to guard against unjustifiable monopolies. The principle is the same in regard to designs as well as patents. The authorities contain the reservation that an interdict will be refused only when a substantial issue in regard to validity is raised. Where the patent or the design is clearly valid, there is no objection to an interdict.

In this case the respondents have not yet replied. They H refrained from replying, so as not to jeopardise the case which was initially set up on the basis of Rule 30. If they are given time to reply, a substantial issue could conceivably arise. In terms of sec. 10 (2) of the Designs Act a registration may be cancelled. One of the grounds for cancellation there mentioned, is that the design is not new or original. I do not know whether this design is new and original. The grounds for refusing registration can also be advanced for cancellation. They appear in sec. 4 (2). One of them, for instance, is that a description of the design had before registration appeared in any printed publication anywhere in the world. The respondents have, on procedural grounds, not entered into any of

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these aspects and I believe that in the interests of justice they should be given an opportunity to do so.

Mr. Peart also raised the aspect of class. The design is registered in Class 9, which is "Packaging and Containers", whereas this design would be more suitably placed in Class 7, A which is "Household goods: Cooking Utensils and Containers". The design may lawfully be used upon goods not within the class. The question in how far the measuring receptacles which have been exhibited to me can lawfully be used outside Class 9, has also not been developed in an answering affidavit. There are therefore insufficient facts before me to decide the matter now. Both sides were to a substantial extent successful at the B first hearing, and I will not make a separate order as to costs for the first day.

The order is:

1. The matter is postponed to Wednesday 28 November.

2. Respondents must serve a replying affidavit by 22 November, at 4 p. m.

Applicant's Attorneys: Adams & Adams. Respondent's Attorneys: C Spoor & Fisher.

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[zRPz]W R B ENTERPRISES (PTY) LTD v PLASBOX INDUSTRIAL APPLIANCES (PTY) LTD AND ANOTHER (2) 1975 (1) SA 803 (T)

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Citation 1975 (1) SA 803 (T)

Court Transvaal Provincial Division

Judge Hiemstra J

Heard November 28, 1974

Judgment December 10, 1974

Annotations Link to Case Annotations

[zFNz]Flynote : Sleutelwoorde

Copyright - Design registered - Application for an E interdict - Refusal of - Design not new or original - Act 57 of 1967, secs. 1 (1), 10 (2).

[zHNz]Headnote : Kopnota

The Court refused an application for a temporary interdict restraining the first respondent from selling certain metricated measuring cups, the design of which had been registered in terms of the Designs Act 57 of 1967, where it found that the design was not new or original. F

[zCIz]Case Information

Application for an interdict. The facts appear from the reasons for judgment.

C. E. Puckrin, for the applicant.

R. H. Peart, S. C. (with him D. Marais ), for the respondents.

Cur. adv. vult.

G Postea (December 10).

[zJDz]Judgment

HIEMSTRA, J.: This matter came before me as an urgent application on 20 November and after argument on a preliminary point was adjourned to 28 November to enable the respondent to H file replying affidavits. That has now been done.

The applicant seeks a perpetual interdict against the respondent company restraining it from marketing certain metricated measuring cups on the ground that such cups are of a design which infringes the applicant's registered design, 73/0919. The applicant's cups are of opaque plastic. They are sold in sets of four, in measurements of 25, 50, 100 and 250 millilitres. They have a convenient handle, joined to the cup right at the top of the lip. The four are held together by a ring which passes through a hole at the extreme end of the handle. For storing, the

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smaller cups fit into the bigger ones in what is called a "nest". The respondent has brought out a similar set, but of transparent plastic. There is little difference in shape. The handle is rounded at the end in stead of square, like the applicant's. If similarity of shape or configuration had been A the only consideration one would immediately regard the respondent's product as an infringement, but there are many other relevant aspects. The respondent contends that the applicant's product is not entitled to protection because it is not a design within the meaning of sec. 1 of the Designs Act or, alternatively, it was anticipated by published description, or further in the alternative, it is registered in the wrong class.

Sec. 1 (1) of the Designs Act, 57 of 1967, defines a "design" as

B "any design applied to any article, whether for the shape or configuration or for the ornamentation thereof or for any two or more of such purposes, and by whate ver means it is applied, in so far as such features appeal to and are judged solely by the eye: Provided that any feature of one 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".

C The proviso excludes features which are dictated solely by the function which the article is intended to perform. The cup and the handle are obviously purely functional. There is no other way of making a good measuring device. The cup must be round to facilitate cleaning and for greater accuracy in measuring dry goods. A receptacle with corners could leave D voids when it contains dry goods. In both articles, that of applicant and that of respondent, the cup is not cylindrical, but tapers slightly towards the bottom. That again, according to the evidence, is not a matter purely of configuration. It is dictated by the method of construction in that it is easier to withdraw a moulding tool from a cup which widens towards the top.

Not only are the main features functional, but they were in E fact specified by the South African Bureau of Standards. Specifications have been published by the Central Standardisation Committee for dry measures in metric units. It is a committee appointed to promote the standardisation and co-ordination of purchases made by Government departments and semi-Government organisations. Naturally an article produced in F accordance with these specifications cannot, at any rate as far as the specified features are concerned, claim to be new or original. For valid registration a design must be new or original, in terms of sec. 10 (2) of the Act. I select from the specifications those which are here relevant:

1. The four capacities which I have mentioned supra are laid down.

2. The measures shall have cylindrical walls, a G flat or recessed base and a handle. The requirement that walls be cylindrical shall not preclude a slight taper to facilitate withdrawal of moulding or pressing tools.

3. The handle shall be of adequate strength and shall be such as to facilitate "nesting" the measures in sets. Each handle shall have a hole (size and position specified).

H Mr. Puckrin, for the applicant, of course conceded that functional features and features previously specified could not be relied upon. He says the outwardly widening handle is a design feature totally unrelated to function as method of construction. In my experience all or nearly all handles of receptacles widen towards the tip. There is nothing new or original in that. He says there is a flanged rim at the base of the container body which is not functional but appeals solely to the eye. This seems to me to be a triviality which is hardly noticed and makes no appeal to the eye as a design feature. Thirdly it was submitted that the position of the handle flush with the rim of the cup is a feature which solely appeals to the eye.

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It requires little originality to put it there. It facilitates nesting and it facilitates cleaning. There must be thousands of different receptacles having the handle flush with the rim.

I find that there are no features which relate purely to design, and as such appeal solely to the eye, which are new or A original. It would create an unjustifiable restraint of trade to grant a monopoly to the applicant's article. In view of this conclusion there is no need to deal with anticipation or wrong classification, which were also put forward by Mr. Peart, for respondent.

In the result the application is dismissed with costs, including the costs of the first hearing and the costs of two counsel.

B Applicant's Attorneys: Adams & Adams. Respondent's Attorneys: Spoor & Fisher.