XACTICS (PTY) LTD, v TAILORED CONTAINERS (PTY) LTD 1971 (2) SA 562 (C)

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Citation 1971 (2) SA 562 (C)

Court Cape Provincial Division

Judge van Heerden J

Heard October 30, 1970; November 3, 1970; November 4, 1970; November 11, 1970

Judgment February 23, 1971

Annotations Link to Case Annotations

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[zFNz]Flynote : Sleutelwoorde

Copyright - Design - Whether novel or original - Determination of - Evidence in support of - Act 57 of 1967 sec. 1 (1) (vi) - "Described" - B Need not be in minute detail - Sec. 4 (2) of Act - Design not novel or original - Court ordering cancellation of registration - Sec. 24 (4).

[zHNz]Headnote : Kopnota

To decide whether or not a design, as defined in section 1 (1) (vi) of the C Designs Act, 57 of 1967, is novel or whether there has been an infringement is a matter to be decided by the eye and the eye alone. To assist in deciding the question of novelty or originality (as also that of infringement) the evidence of experts in the trade is not only admissible but generally desirable and the eye which has to decide these questions should be that of an instructed person: a person enlightened as to what was common trade knowledge and usage in the class of articles to which the design applies. The design must be looked at as a whole. The test is not to look at two designs side by side, but apart, and a little distance away.

D Having regard to the fact that the word "described" is used in section 4 (2) of Act 57 of 1967 in the context of determining what is "new or original", it could not have been the intention of the Legislature that the description should be in such minute detail that the design could be reproduced exactly.

Where in an application for an interdict restraining the respondent from infringing its rights in respect of the design of bottles used for oil the Court found that the registered E design was not new or original on the date of application for registration, it exercised its jurisdiction conferred under section 24 (4) of Act 57 of 1967 and ordered the cancellation of the registration of the design.

[zCIz]Case Information

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

F B. Hobermann, for the applicant.

D. J. B. Osborn, for the respondent.

Cur. adv. vult.

G Postea (February 23rd).

[zJDz]Judgment

VAN HEERDEN, J.: Applicant is the registered owner in terms of the Designs Act, 57 of 1967, of design 68/346 and since May, 1969, applicant has been producing plastic bottles embodying H the design at the rate of 40,000 bottles per month. These bottles although manufactured as general purpose bottles were used chiefly as containers for sunflower and other edible oils.

Applicant alleges that shortly after January, 1970, it became aware that respondent was manufacturing and selling a clear, plastic bottle, embodying applicant's said registered design or a design not substantially different from applicant's said registered design and that these bottles were also used as containers for sunflower oil. It is alleged furthermore that the shape and configuration of respondent's bottle is

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not substantially different from applicant's said registered design and that respondent by manufacturing and selling the said bottle is infringing the rights enjoyed by applicant in terms of the provisions of Act 57 of 1967 as the registered proprietor of design 68/346.

A Applicant accordingly asks for an interdict restraining respondent from manufacturing, using or vending plastic bottles infringing its registered design together with costs.

In terms of sec. 4 (1) of Act 57 of 1967 the Registrar may only register a new or original design and in terms of the definition in sec. 1 (1) (vi) of the Act

B "'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 the Act."

C Sec. 4 (2) provides that for purposes of the Act a design is deemed new or original if, on or before the date of application for registration thereof, such design or a design not substantially different therefrom, was not (in so far as this application is concerned) used in the Republic; or described in D any printed publication anywhere. From the certificate of registration before the Court the date from which the design was registered is 12th July, 1968, and this is also the date of application. No description of the design appears in the certificate but "a copy is annexed" in the form of a photograph on which the front view of applicant's bottle appears and below which is inscribed that

E "the novelty claimed resides in the shape and configuration of a bottle, substantially as shown in the representations".

The design of the bottle depicted on the copy annexed to the certificate may be described as having a curved neck portion, the extremity of which is formed to accommodate a means of closing; a cylindrical body section which is continuously F ribbed with uniform ribbing; and a curved base which extends to meet the cylindrical body of the bottle. As far as the shape of this design bottle is concerned Mr. Hobermann, who appeared for applicant, conceded that it was certainly not novel but submitted that the salient feature was the ribbing.

Respondent has resisted this application on various grounds G ranging from an attack on the validity of the registration of the design itself to a denial of any infringement thereof and has in turn asked for an order cancelling the registration of design 68/346.

Before dealing specifically with the defences raised it is necessary to set out briefly the approach to be adopted by a Court in matters of this nature. From the definition in sec. 1 (1) (vi) of the Act the features of a design must appeal to and H are judged solely by the eye. It seems to follow from this that to decide whether or not a design is novel or whether there has been an infringement is a matter to be decided by the eye and the eye alone. Counsel appearing on both sides contended, to my mind correctly, that to assist in deciding the question of novelty or originality (as also that of infringement) the evidence of experts in the trade is not only admissible but generally desirable and that the eye which has to decide these questions should be that of an instructed

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person: a person enlightened as to what was common trade knowledge and usage in the class of articles to which the design applies. It is thus simply the general impression gathered by the eye of the aforesaid person that counts. The A design must be looked at as a whole. The test is not only to look at the two designs side by side but also apart, and a little distance away - Russell-Clarke, Copyright in Industrial Designs, 4th ed., p. 21.

The validity of the registration of the design on the ground that it was not new or original was assailed by respondent on two grounds. Firstly that it was used in the Republic at the date of the application (sec. 4 (2) (a)) and secondly that it was described in certain printed publications before that date - sec. 4 (2) (c).

With regard to the first ground the admitted evidence establishes that one of the shapes used for many years prior to 1968 for glass bottles comprises:

C (a) a curved neck with an extremity formed to accommodate a closing means substantially the same as that shown in design 68/346;

(b) a plain cylindrical body portion; and

(c) a base portion with curved sides, substantially the same as that shown in the design bottle.

D In addition at the hearing a plastic bottle (exh. "G") was produced and identified by applicant's witness, Meyerson, as having been manufactured by applicant and being used by Cape Oils prior to July, 1968. In relation to this bottle Meyerson conceded that there was nothing new or original about it. Exh. E "G" is substantially the same bottle as that reflected in design 68/346 (exh. "C") save for the ribbing and in comparing the two Meyerson contended that the novelty was found in the ribbing. It is clear however that, for many years prior to 1968 and up to the present, ribbing has been used in the glass bottle industry as a decorative feature applied to plain F bottles. Mr. Hobermann submitted however that it was the type of ribbing of the design bottle which appeals to the eye and wherein the novelty lay. It was also according to Mr. Hobermann in this respect that the greatest similarities existed between the design bottle and the infringing bottle. It is common cause that the function of the bottle which is the subject of design 68/346 is to act as a container for liquids to be supplied to G the consumer markets and that the shape of the bottle is such that it is primarily suitable for manufacture out of plastic material. The essential function of ribbing in relation to plastic (or PVC) bottles is to secure the stability and rigidity required to withstand the forces exerted during the H evacuating and filling process. According to the evidence of Doyle, a witness well qualified to speak on this subject, a continuous pattern of corrugations or ribbing is required in order to achieve the greatest uniform strength since lateral pressures incurred during filling are uniform throughout the length of the bottle and any flat surfaces between the corrugations would deform in the process of filling which would in turn reduce the capacity of the bottles under vacuum thus rendering their performance less satisfactory.

It was further established by Doyle, Gericke and Opland that uniform

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ribbing gives the greatest strength, that the peaks of the ribs should have flat surfaces for a label but too great a flat surface of a rib would be a source of weakness; that sharp corners must be avoided as they are weak and that a square trough would mean that the bottle would not easily drop out of A the mould in the manufacturing process. It was therefore necessary that a compromise between a rounded rib and a square rib be effected and the trapezoidal rib as found in the registered design as also in the respondent's infringing bottle proves to be most suitable. The type of ribbing used in the registered design is moreover according to the evidence within the optimum range. Ribbing appreciably more widely spaced would B be weaker and again ribbing appreciably more closely spaced would also be weaker.

It seems therefore that the design bottle has no features other than those which are necessary to enable it to perform its function. There has been no endeavour to introduce features not connected solely with function, such as a "waist" in the C cylindrical body or some other variation in the overall cylindrical shape of the bottle. At the conclusion of his cross-examination Meyerson conceded that a plastic bottle suitable for vacuum filling with edible oil had to satisfy certain requirements. These were that it had to be of clear plastic of about 710 ml., and be of a diameter which could D easily be grasped by hand: it had to be made economically; be able to fit into a filling machine and withstand the force of vacuum filling, it had to be able to take a label. That applicant produced the design bottle to comply with the above requirements can leave no room for doubt nor can there be any doubt that without the ribbing the design bottle would not have fulfilled its purpose. On the evidence it is clear to me that E the feature of ribbing is dictated solely by the function which the bottle is to perform. Without the ribbing one is left with a shape such as exh. G., which admittedly is without novelty or originality. The intention of the Legislature being to ensure as far as possible that only that which was a design was registered it follows in my view that the ribbing in the F design bottle, being purely functional, cannot be a feature of the registered design and is accordingly excluded from the rights afforded by the Act.

On the evidence I am accordingly satisfied that the design registered by the applicant is invalid in that neither the design nor the ribbing which is relied upon is new or original and was used in the Republic at the date of application and G that in any event the ribbing is purely functional and not a feature of the registered design.

Respondent further relied on the provisions of sec. 4 (2) (c) of the Act that design 68/346 was not new or original in that it was described in certain printed publications on or before the date of application for registration. To this end H respondent has placed numerous publications, principally those featuring plastic for bottles and containers, wherein plastic bottles of various shapes and forms are depicted. Mr. Osborn, for respondent, has relied especially on the Lupi bottle appearing in the November/December, 1966, issue of Plastics, Paint and Rubber being annexure N to Gericke's affidavit. This bottle, judged solely by the eye as instructed by the evidence, is not substantially different from the bottle of design 68/346 because of the following features and the overall impression:

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the shape of the neck portion, the cylindrical body portion with continuous uniform ribbing and the base portion which curves upwards to meet the body portion.

Mr. Hobermann has contended however that upon a proper A construction of the section involved the Lupi bottle which is merely depicted in the publication cannot be said to be "described" as required by the wording of the Act.

According to the Oxford English Dictionary, "describe" means inter alia,

B "to delineate, mark out the form or shape of, trace the outline of (geometrical figure, etc.)"

and having regard to the fact that the word is used in sec. 4 (2) in the context of determining what is "new or original" it clearly can not be the intention of the Act that the description should be in such minute detail that the design can C be reproduced exactly, as contended for by Mr. Hobermann. To describe certain designs, especially those to be applied to material or fabrics for use as curtains or wall-paper for example otherwise than by a picture would not only be very difficult but wellnigh impossible. I am strengthened in this view by the fact that applicant's design as registered contains no "description" other than a representation or photograph which is annexed to the certificate R.S.C.3.

D I have accordingly come to the conclusion that applicant's registered design 68/346 was not new or original by reason of the fact that a design not substantially different therefrom had already been described in a printed publication before the date of application for registration.

Lastly I deal with the question of infringement. This I do on E the premise that I am wrong in holding that applicant's design is invalid and that the ribbing is purely functional.

In drawing a comparison between the two bottles it is important to remember that as far as the design bottle is concerned no novelty is claimed for the shape of the bottle the body whereof is cylindrical and continuously ribbed with uniform ribbing. As F far as the neck portion is concerned the witness Keiller conceded in cross-examination that there was a difference in the neck geometry. He point to the rounded profile of the design bottle and the straight profile of respondent's bottle. There is also a difference in the neck finish due to different closing means but this feature would appear to be purely functional. The evidence further discloses that the G respondent's bottle has one less rib and that there is a slight difference in the geometry of the ribs. Then there is also a difference in the curvature of the base portion. Although Mr. Hobermann has contended that the Court should look at the general appearance of the bottles as a whole he has stressed however that it was the salient feature of the design H bottle, the ribbing, which appeals to the eye and that it was here that the greatest similarities existed. I agree with the submission that if only the ribbing is looked at then in spite of slight geometrical differences the general impression created is that it is not substantially different from the ribbing of design bottle. But this is precisely what is to be avoided - looking at only one feature of the design. Looking at the two bottles as a whole, not only side by side, but also apart and at a distance the differences in the neck and base portions of the bottles are very apparent to the instructed eye and it cannot be

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said that respondent's bottle is not substantially different from the registered design.

It follows that the application for an interdict must be dismissed with costs.

This Court having arrived at the conclusion that the registered A design was not new or original on the date of application for registration respondent has asked that in that event the Court should exercise the jurisdiction conferred upon it by sec. 24 (4) of the Act to order the cancellation of the registration of the design. I can see no reason why a design which was not new or original when it was registered should be allowed to remain B in the register of designs and design 68/346 will accordingly be cancelled.

The following order is made:

(a) The application for an interdict is dismissed with costs, such costs to include the qualifying expenses of the witnesses Doyle, Opland and Lloyd;

C (b) The registration of design 68/346 is cancelled and the Registrar of Designs is directed to amend the register of designs accordingly.

Applicant's Attorneys: Mallinick, Ress, Richman & Co. Respondent's Attorneys: Syfret, Godlonton & Low.