

1926
 Jany. 14.

KAUFMAN RUBBER COMPANY, LTD... PLAINTIFF;
 AND
 MINER RUBBER COMPANY LIMITED.. DEFENDANT

Industrial design—Trade variance—Novelty of invention

Plaintiff registered two industrial designs which were the outline or representation of an overshoe. The means of fastening the flaps thereof being the usual metal buckle arrangement on the lower part and cross straps on the upper part to which dome fasteners are applied. One design shows two straps with buckles and two straps with dome fasteners. The other, one strap with buckles and three straps with dome fasteners. The only description given is "the said industrial design consists of the novel configuration of overshoes or goloshes as shown."

Held, that the form or configuration of the overshoe and the fasteners, whether with buckles or dome fasteners or both, is old and discloses no originality, and that the addition of buckles or straps with dome fasteners, whether concealed or exposed, or the substitution of one for the other, or the variation in the respective numbers of each, all well known, can not render a design new or original. Such variations are

mere trade variants, without invention, originality or novelty, the introduction or substitution of which in a design, is not sufficient to make the design new or original, and that the industrial designs in question are not proper subject matters for registration within the spirit and intendment of the Trade-Marks and Designs Act.

2. That a design to be registrable must be some conception or suggestion as to shape, pattern or ornament, applied to a particular article, and is judged solely by the eye, and does not include any mode or principle of construction. It cannot be an article of manufacture, but something to be applied to an article of manufacture or other article to which an industrial design may be applied, and capable of existence outside of the article itself.

1926
 KAUFMANN
 RUBBER
 Co., LTD.
 v.
 MINER
 RUBBER
 Co., LTD.
 Maclean J.

ACTION for infringement of industrial designs and counter-claim by defendant asking for the expunging of plaintiff's designs.

Ottawa, 11th December, 1925.

Action now tried before the Honourable Mr. Justice Maclean.

J. F. Edgar for plaintiff;

R. S. Smart for defendant.

The facts are stated in the reasons for judgment.

MACLEAN J., now this 14th January, 1926, delivered judgment.

The plaintiff is the proprietor of two industrial designs, registered in Canada, under the provisions of the Trade Mark and Designs Act, and this is an action for the infringement of the same by the defendant. The design is the usual outline or representation of an overshoe, and the means of fastening the flaps of the overshoe, the means being the usual metal buckle arrangement on the lower part, and cross straps on the upper part, to which dome fasteners, well known in gloves, are applied. The one design shows two straps with buckles, and two straps with dome fasteners, while the other design shows but one strap with a buckle, and three straps with dome fasteners. The only description accompanying the application is, "the said Industrial Design consists of the novel configuration of overshoes or goloshes as shown."

Part 11 of the Trade Marks and Designs Act relates to Industrial Designs and the registration of the same. No definition of Industrial Designs is contained in the Act, and there has been no litigation in our courts upon the point

1926

KAUFMANN
RUBBER
Co., LTD.

v.

MINER
RUBBER
Co., LTD.

Maclean J.

so far as I know, and consequently no assistance is available from judicial decisions, in determining what constitutes an Industrial Design, under the statute.

A review of some sections of the statute should however furnish some light, as to what was intended to be the principal characteristics of an Industrial Design, and what are the necessary elements to be found in a design to sustain its registration.

Sec. 24 required that the design be one not in use by any other person than the proprietor, at the time of his adoption thereof. Sec. 27, ss. 3, would indicate that originality of the design was necessary. Then sec. 31 is to the effect that no person shall without the license of the registered proprietor, apply a design, to the ornamentation of any article of manufacture or other article, to which an industrial design may be attached or applied, or to sell or use any article to which such design may be applied. Section 34 provides that the name of the proprietor of a design shall appear upon the article to which his design applied. Sec. 36 is the penalty clause for violation of this part of the Act, and ss. (a) states, that any person applying a design to the ornamenting of any article of manufacture or other article, without license, is subject to a money penalty.

The sections of the statute to which I have just referred, would therefore seem to indicate that "industrial designs" is there intended to mean some design or mark, which is to be attached to a manufactured article. The use of the word "ornamenting," in two different sections of the Act, would clearly indicate that a design might be adapted to purposes of ornamentation. In dealing with designs, the legislature had, I think, primarily before it, the idea of shape or ornamentation involving artistic considerations. Clearly a design cannot be an article of manufacture, but something to be applied to an article of manufacture, or other article to which an industrial design may be applied, and capable of existence outside the article itself, nor do I think that the registration of a design would afford any protection for any mechanical principle or contrivance, process or method of manufacture, or principle of construction. Then there must be something original in a registered design, and it must be substantially novel or original, having

regard to the nature and character of the subject matter to which it is applied.

A design to be registrable must therefore be some conception or suggestion as to shape, pattern or ornament applied to any article, and is judged solely by the eye, and does not include any mode or principle of construction. What would constitute a registrable design, is, I think, admirably and comprehensively expressed in *Pugh v. Riley* (1) by Parker L.J., at p. 202, and is I think quite applicable to the provisions of our statute. There he said:—

A design to be registrable under the Act must be some conception or suggestion as to shape, configuration, pattern or ornament. It must be capable of being applied to an article in such a way that the article to which it has been applied, will show to the eye the particular shape, configuration, pattern, or ornament, the conception or suggestion of which constitutes design. In general any application for registration must be accompanied by a representation of the design; that is, something in the nature of a drawing or tracing, by means of which the conception or suggestion constituting the design may be imparted to others. In fact, persons looking at the drawing ought to be able to form a mental picture of the shape, configuration, pattern, or ornament of the article to which the design has been applied. A conception or suggestion as to a mode or principle of construction though in some sense a design, is not registrable under the Act. Inasmuch, however, as the mode or principle of construction of an article may effect its shape or configuration, the conception of such a mode or principle of construction may well lead to a conception as to the shape or configuration of the completed article, and a conception so arrived at may, if it be sufficiently definite, be registered under the Act. The difficulty arises where the conception, thus arrived at, is not a definite conception as to shape, or configuration, but only a conception as to some general characteristic of shape or configuration, necessitated by the mode or principle of construction, the definite shape or configuration being, consistently with such mode or principle of construction, capable of variation within wide limits. To allow the registration of a conception of such general characteristics of shape or configuration might well be equivalent to allowing the registration of a conception relating to the mode or principle of construction.

I would also refer to the judgment of Moulton L.J. in *Phillips v. Harbro Rubber Company* (2); to the judgment of Astbury J. in *Wilson v. Chalco Ltd.* (3), and *Bayer's Design* (4).

In the case before me, the design covers the shape or configuration of the whole overshoe, together with the buckles and straps, the means of fastening. That this is

1926

KAUFMANN
RUBBER
Co., LTD.
v.
MINER
RUBBER
Co., LTD.

Maclean J.

(1) [1912] 29 R.P.C. 196.

(2) [1920] 37 R.P.C. 233 at p.

239.

(3) [1922] 39 R.P.C. 252 at p. 255.

(4) [1906] 24 R.P.C. 65.

1926
 KAUFMANN
 RUBBER
 Co., LTD.
 v.
 MINER
 RUBBER
 Co., LTD.
 Maclean J.

a registrable design within the contemplation of the statute, is not I think to be seriously considered. To hold that it is so registrable would be as said by Bowen L.J., in *Le May v. Welch* (1),

to paralyse industry, and to make the *Trade Marks and Designs Act* a trap to catch honest traders.

The registrations are but an attempt to protect a mode of construction. There is nothing original or novel in the configuration of an overshoe as shewn by the plaintiff's designs, or any part of them. The form or configuration of the overshoe, and the fastenings, whether with buckles or dome fasteners or both, are old and disclose no originality. The addition of straps with buckles or straps with dome fasteners, whether concealed or exposed, or the substitution of the one for the other, or the variation in the respective numbers of each, everyone of which are well known, cannot render a design new or original, because it merely represents a change in the mode of construction of the article. Such variations are mere trade variants, and do not represent invention, originality or novelty. The introduction or substitution of ordinary trade variants in a design, is not only insufficient to make that design new or original, but it does not even contribute to give it a new or original character.

For the reasons which I have above given, I am of the opinion that the registered designs in question, are not proper subject matters for registration within the spirit and intendment of the *Trade Marks and Designs Act*, and in any event neither of them possess the originality or novelty necessary to warrant registration. If it were necessary to dispose of this matter upon other grounds, I might say that the evidence does not establish, that the idea of applying the dome fasteners with a strap, beneath the flap of the overshoe, and which is admittedly the only original suggestion in the configuration of the overshoe, originated with the plaintiff, but with Beddoe, who does not claim any invention for it, or the authorship of it. Then again, the statute and the rules require a description of the design, to accompany the drawing upon the application for registration. This was not done, the only description being

(1) [1885] 28 Ch. Div. 24.

the mere statement that the design consists of the novel configuration of an overshoe which is no description at all. If the plaintiff's case is rested upon the contention that the design was intended to cover only a part of the configuration of the overshoe and its fastenings, then the registration is void by virtue of the absence of a description. If it was intended to comprehend the whole of the overshoe and all its parts, then the registration is also void for want of description.

The plaintiff's action therefore fails. There will be judgment directing that the two industrial designs, mentioned in the pleadings, be expunged from the Register of Industrial Designs. The judgment will also contain an order allowing the defendant his costs of the action.

Judgment accordingly.

1926
KAUFMANN
RUBBER
Co., LTD.
v.
MINER
RUBBER
Co., LTD.
Maclean J.