

CLATWORTHY & SON LIMITED.....PLAINTIFF;

AND

DALE DISPLAY FIXTURES LIMITED..DEFENDANT.

1928
 May 10.
 June 29.

*Trade-Mark and Design Act—Industrial Designs—Definition of design
 —Requirements of—Trade Variants*

Held, that as the Trade-Mark and Design Act does not define what industrial designs are within the meaning of the Act, the word Design therein must be taken to be used in its ordinary, and not in an artificial, sense.

2. A design to be registrable must be original and not in use by anyone else at the time of its adoption. Invention or utility is not a requirement to valid registration. A Design cannot be rendered original merely by a change in the mode of the construction of an article. A design to be registrable must be distinguishable from what previously existed by something that is essentially original. The introduction of ordinary trade variants into an old Design cannot make it new or original.

ACTION by plaintiff to restrain the defendant from infringing its industrial design registered on the 26th November, 1926.

The action was tried before the Honourable Mr. Justice Maclean, President, of the Court, at Toronto.

R. S. Smart, K.C., and *B. H. L. Symmes* for plaintiff.

B. Macpherson and *H. G. Fox* for defendant.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now, June 29, 1928, delivered judgment.

This is an action to restrain the defendant from making, selling or displaying for sale a certain display stand which it is alleged, is in imitation of a design of a display stand registered by the plaintiff pursuant to the Trade-Mark and Design Act, on November 26, 1926. The Design as registered is shown below.

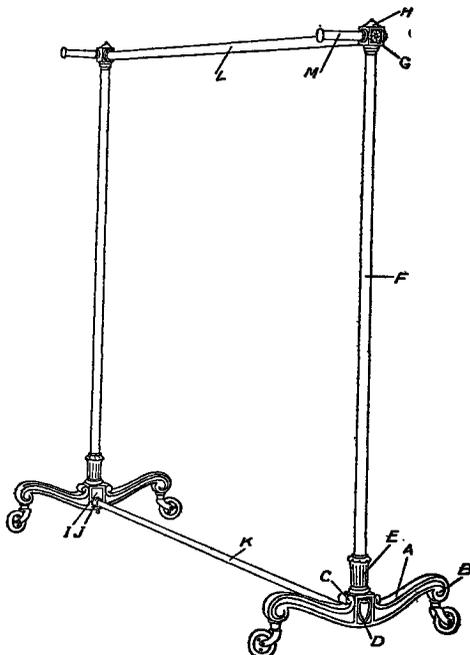
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The application for registration is as follows:—

I, Egerton Ryerson Case, of the City of Toronto, County of York, Province of Ontario, Canada, hereby request you to register in the name of Clatworthy and Son, Limited, of the City of Toronto, Province of Ontario, Canada, an Industrial Design for Display Stands, of which the said Company is the proprietor.

I declare that the said Industrial Design was not in use to my knowledge, by any one other than the said Company at the time of their adoption thereof.

A drawing of the said Industrial Design hereunto annexed shows the Display Stand in perspective.

The said Industrial Design embraces a base composed of oppositely-disposed curved arms, A, the outer ends of which terminate in a spiral scroll B. The upper side of the inner end of each arm also terminates in a spiral scroll C.

The outer side of the said base is provided with a heart-shaped panel D. The top of the base is flat between the scrolls C, and supports a fluted boss E. The top and bottom of this boss are ornamented.

The said boss supports a standard F, and the top of this standard is provided at the outer side with a panel G which carries an ornamentation. A fluted conical-shaped cap H ornaments the upper side of the top of the standard F.

The inner side of the base is provided with a panel which has a boss J. There are two bases forming this display stand, both alike in appearance, and they are coupled together by a bar K the ends of which are held in the bosses J.

The tops of the standard are coupled together by a bar L. M are bars held in the tops of the standard F, and disposed at right angles to the bar L.

Although casters are shown, these do not form part of the Design.

It will be seen from the application and certificate that the design or pattern of the whole of the display stand is registered as the Design; it is only the casters that are said not to form a part of the Design. It was not sought to register the configuration or pattern of the base, or the ornamentation upon it. There is no claim to any particular portions or features of the display stand as shown in the drawing, as the Design. In fact there is nothing in the way of a specific claim to the shape or configuration of the whole Design, the claim is merely the description of the Design. It is unfortunate I think that neither the statute or the Rules require the applicant for registration to file with his application, a statement of the matters which he claims constitute the novelty of his Design.

The design or configuration of the display stand made and sold by the defendant is the same as the plaintiff's, except that ornamentation work on the outside of the base and on the top of the standard is different; as a whole the plaintiff's display stand is said to be of a Grecian pattern while the defendant's is Gothic. To the casual observer the distinction in this respect would hardly be noticeable, although in the opinion of Mr. Smeal who was the author of the complete designs of both display stands, they would not be confusing to any persons understanding anything about designing, and are readily distinguishable on account of the different ornamental work deliberately applied to each by him, in order that they might be in contrast. The ornamental work applied to each is well known to the art though in detail they are quite different; the general configuration of both display stands, are the same.

Part II of the Trade-Marks and Design Act, dealing with Industrial Designs, contains no definition of an Industrial Design, neither do the Rules provide any; in fact I am not at all sure that there are in existence any Rules applicable to Part II of the Trade-Mark and Design Act. A design is therefore a design, and must be taken to be used in its ordinary sense. It is required that a design be original, and that it was not in use by any person other than the pro-

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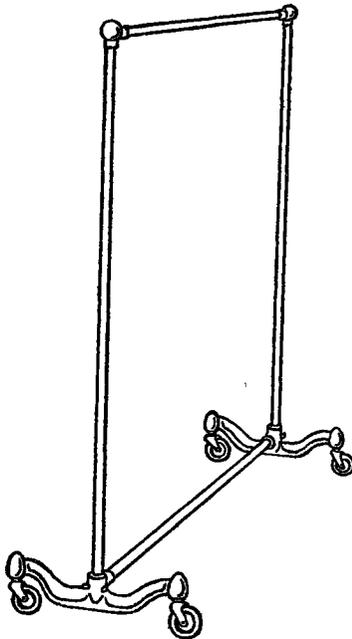
prietor, to his knowledge, at the time of his adoption of it. Invention or utility is not a requirement to a valid registration, and the general principles of Patent Law are not applicable here. According to the statute the design must, it would seem, be something capable of application to any article of manufacture or other article, for the ornamentation thereof. The words "to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached" are used in more than one section of the statute.

The scope of this part of the Trade-Mark and Designs Act is difficult of definite ascertainment or construction. It is a piece of legislation that seems flimsy and incomplete, ill adapted for its intended purposes, and is seriously in need of amendment. I think it is clear that a design within the Act may be some ornament, printed, woven or produced on such articles as textile fabrics, paper hangings, floor cloths, lace, etc., or some ornament produced in such things as metal articles, glass or tiles. The Act seems confined to designs applicable to manufactured articles, and the application of such design to such articles; it does not apply to the things to which a design is applied. The Act is not clear when the design is merely for the shape of a thing, and it may be doubtful if a design for shape or configuration, which can only be applied to a thing by making it in that shape, comes within the Act. In the corresponding English Act, 1907, it does, but the statute there states that "Design" means any design applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, etc., and the same was true of the English Act of 1883.

For the purposes of this case I am going to assume that under the Act a design is applicable for the shape or configuration. The statute is clear that novelty is in all cases essential to a valid registration, and prior publication is fatal. Display stands had been made and sold by the defendants since 1910, the general configuration and purpose of some of them, was the same as the plaintiff's design here in question, except that they particularly lacked ornamental work, being very plain in design and without casters. The general characteristics and the prin-

ciple of construction was the same. The underslung base of the plaintiff's design was stressed before me, but the defendant, in the latter part of 1925 or early in 1926, and prior to the plaintiff's registration, obtained a display stand manufactured in the United States with this form of base and having the general outlines of the plaintiff's display stand, and he then placed it in the hands of his designer to produce a display stand similar to it. Practically the same display stand was advertised in February, 1925, in a trade journal published by Hugh Lyons & Co., Ltd., of Lansing, Michigan, featuring display stands. Below is a figure of the display stand obtained by the defendant in the United States prior to the plaintiff's registration, showing an underslung base without ornamentation, and it is said of Romanesque style.

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In my opinion there is nothing more whatever in the plaintiff's design, than is shown in the above figure, excepting the ornamental work; that is not by itself claimed as a design, and none of it as such is original. It is a method of construction and not a configuration, pattern, or ornament that the plaintiff claims. It is well settled, I think, that however constructed, an article of the same configura-

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tion is equally within or without the scope of a registered design. A design cannot be rendered original merely by a change in the mode of the construction of the article. I cannot reach the conviction that this is the sort of thing to which protection should be granted. No design should be counted as original unless it is distinguishable from what previously existed, by something which is essentially original. The introduction of ordinary trade variants into an old design cannot make it new or original. The requirement of novelty or originality by the statute, precludes the introduction of ordinary trade variants from making a design new or original if it is not new or original without them. The public is entitled to its choice of ordinary trade variants for use in any particular instance, and no registration should prevent its using or not using trade knowledge of this kind.

I might appropriately quote from Bowen L.J. in *Le May v. Welch* (1), where a registered design for a shirt collar was in question. He said:—

In order to enable the respondents to maintain the registration, they must be, or claim to be, the proprietors of a new or original design. In the present case is there any new or original design shown by this drawing? In considering whether the design is new or original, we must remember in the first place that we are dealing with a design which purports to found itself on shape, and to deal with outline; and secondly that we are considering the question with reference to an article of dress of the very simplest and least complicated kind, an article of dress which may well vary in form in every town in England, and in every year in which collars are worn. We must not allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length or breadth, or configuration, in a simple and most familiar article of a dress like this which constitutes novelty of design. To hold that would be to paralyze industry and to make the Patents, Designs, and Trade-Marks Act a trap to catch honest traders. It cannot be said that there is a new design every time a coat or waistcoat is made with a different slope or a different number of buttons. Tailoring would become impossible if such were the law, and it does not appear to me that such is the law. There must be, not a mere novelty of outline, but a substantial novelty in design having regard to the nature of the article. Now in the present case is there substantial novelty? That is an issue of fact to be decided by the view. Mr. Higgins says, and in that I am disposed to agree with him, that a new combination of old elements of design will satisfy the Act, and he asks us to find such novel combination in the presence, for the first time, in his article, of three characteristics; the absence of band, the downward curved opening and the large share of collar above the button. Now the answer which seems to go to

(1) (1885) 23 Ch. Div. 24 at p. 34.

the root of his contention is this, that if you take the specimen which the Lord Justice has dwelt upon as the most conspicuous instance, you will see that Mr. Higgins' contention is not well founded. The plaintiff's collar it is true, differs from A.H.K. 1 by exaggerating one or more of the characteristics which are there combined; but I can find in it no other novelty. It would be a most dangerous view of this Act to allow a design which presents no other element of novelty than this, to have the benefit of registration.

If cases of this kind cannot be disposed of in the manner I have indicated, then the only safe course for a court to pursue will be to insist on absolute identity between the infringement and the registered Design. This view was in fact strongly expressed by Halsbury L.J. in *Gramophone Company Ltd. v. Magazine Holder Company* (1), in discussing the proper method of applying the provisions of the English Act respecting Designs.

I am of the opinion that there is no novelty or subject matter in the plaintiff's registered design, and that the same is invalid. The plaintiff's action is therefore dismissed with costs.

Judgment accordingly.

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