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IN THE SUPREME COURT OF SOUTH AFRICA

(APPELLATE DIVISION)

In the matter between:

DENNIS JOHN GEORGE SCHULTZ

Appellant

AND

HUGH STANLEY BUTT

Respondent

CORAM: CORBETT, HOEXTER, BOSHOFF, JJA, NICHOLAS et
NESTADT, AJJA

HEARD: 10 March 1986

DELIVERED: 16 May 1986

J U D G M E N T

NICHOLAS, AJA

This is an appeal against a judgment of MULLINS J

in

in the Eastern Cape Division which is reported as Butt v Schultz and Another 1984 (3) SA 568 (ECD).

Mr. Hugh Butt (the applicant in the Court a quo and the present respondent) is a farmer and boat builder of Kenton-on-Sea, near Port Alfred. Mr. Dennis Schultz (the respondent in the Court a quo and the present appellant) is a boat builder of Port Alfred.

During the years 1954-1978 Butt developed the design of the hull of a catamaran-type ski-boat. First he created a concrete "plug" which embodied the shape of the hull in the inverted position. From the plug he made a mould by applying to it successive layers of glass fibre reinforced plastic (commonly called "fibre glass") and

resin

resin until the required thickness was achieved. Hulls could be made as required from the mould.

Butt constructed his first plug and made his first mould in 1955. The boats made from hulls cast from this mould being unsatisfactory, he made a new mould in about 1959. From this he started making hulls which he sold under the name of "Butt-Cat". The design was modified in 1964 and again in 1974 and 1978. In the latter year he constructed a new plug, from which he made two moulds, one of which he called his No. 1 mould. About 75% of the Butt-Cat hulls now produced are made from the No. 1 mould. Over the years the development of the Butt-Cat hull has taken a great deal of time, trouble and

money

money. Butt has had to make numerous experiments and to draw heavily on his experience as a seaman.

He has built up an extensive business in the manufacture and sale of Butt-Cat hulls, selling them to customers in many parts of the Republic and South-West Africa and as far afield as the Comoro Islands in the Indian Ocean. In the years 1981, 1982 and 1983 respectively, he sold 25, 15 and 16 Butt-Cat hulls, making an average profit of about R1 500,00 on each one.

During 1983 Schultz and his father approached Butt with a request that he sell them a mould which he was not using, in order (so they said) to build themselves one boat for their private use. Butt had doubts about

this

this because he knew that the Schultz's had from time to time manufactured boats for sale, and he refused to sell.

In August 1983 Butt received information that Schultz had constructed a mould from a Butt-Cat hull, and was using it to make hulls for boats which he was selling in competition with the Butt-Cat. On 24 August 1983, Butt's attorneys made these allegations in a letter to Schultz and stated -

"Your dishonest action aforesaid is clearly calculated to cause damage to our Client and as such constitutes wrongful and unlawful competition with our Client."

They called upon him to comply with certain demands. In a reply dated 5 September 1983 Schultz's attorneys wrote

inter alia:

"Our

"Our client denies absolutely the contents of your letter and takes the strongest exception to the suggestion that his action has been dishonest.

Our client has filed the design of his boat hull, the window structure and the Super 20 Boat in the Designs Office in Pretoria and you are referred to the Application Nos. 830645/6/7."

At the beginning of September, Butt examined a boat named "Bon Voyage 3" which had reportedly been manufactured by Schultz. With slight differences its hull was identical with the Butt-Cat hull and it was obvious to him that it was a copy. Later that month, a photograph was taken of Schultz's mould at his premises: it was substantially identical with the Butt-Cat mould. He learned that Schultz had acquired a complete Butt-Cat

hull

hull from one Beary to whom Butt had sold it as a reject in 1982 because the finish was unsatisfactory, and it was clear to him that Schultz had made his mould from this hull and was using it to make boats for sale.

Arising out of the letter from Schultz's attorneys, dated 5 September 1983, Butt caused a search to be made of the Designs Register. It appeared from the reports received that Schultz had on 1 August 1983 made three applications for registration of a design, in each of which he made a declaration that

"The applicant claims to be the proprietor of the design and that to the best of his knowledge and belief the design is new and original."

The

The first application (No 83/0645) was in respect of a "Boat Hull", and it was stated that

"The novelty claimed resides in the shape and/or configuration of a boat hull substantially as shown in the representation ..."

The second (No 83/0646) was in respect of a "Window Structure for a Boat". The third (No 83/0647) was in respect of a "Boat", it being stated that

"The novelty resides in the shape and/or configuration of a boat substantially as shown in the representation."

The representation showed a boat which was a composite of the hull shown in the representation of a boat hull in Application No 83/0645 and the window structure re-

presented

presented in Application 83/0646. Registration of all three designs was effected on 4 August 1983.

A comparison of drawings prepared from the Butt-Cat hull with the representations of the hull in Application No 83/0645 showed that the designs were identical.

By notice of motion dated 26 October 1983 Butt launched an application against Schultz, in which the Registrar of Designs was joined as second respondent, claiming cancellation by the Registrar of the registration of Designs Nos 83/0645 and 83/0647, and an interdict and ancillary relief against Schultz. The Registrar of Designs did not oppose the application but abided by the decision of the Court.

Originally

Originally Butt's claim for relief by way of interdict was based on passing off and "unlawful competition and for unlawful interference with my trade." In January 1984 leave was granted to Butt to supplement his founding affidavit, and to amend the notice of motion so as to claim relief for breach of copyright in the Butt-Cat hull.

In his answering affidavit Schultz admitted that he had used the Butt-Cat hull which he had obtained from Beary to construct from it a mould which he used to create hulls for boats which he named "Supercats". He claimed, however, that he had made modifications to the Butt-Cat hull, spending 600 man hours "re-working" it and employing labour and materials which he valued at R16000.

Judgment

Judgment was delivered on 26 April 1984. In the judgment, MULLINS J referred to the modifications which Schultz alleged he had made but considered them to be the result of simple operations which did not affect the design of the hull as a whole. He said(at 580 B-D):

"All these modifications ... had as their starting point a mould which itself had been constructed from one of applicant's hulls. It does not require much imagination to appreciate the saving to first respondent in time, labour, and money by reason of his using one of applicant's hulls as a plug. First respondent admits that building a plug is a laborious process, whether it is being built from scratch or whether it is being redesigned. Even if he had one of applicant's hulls available, from which he could take measurements, the construction

of

of a plug would still be the vital starting point of the construction process. The using of applicant's hull as a plug from which to commence his construction process, and thereby avoiding the necessity to design his own hull, amounts in my view to unfair competition, against which applicant is entitled to be protected."

The learned judge found further that Schultz's conduct in using a Butt-Cat hull in order to produce hulls, whether or not with the adaptations or modifications effected by him, constituted an infringement of the copyright which Butt had in the Butt-Cat plug, moulds and hull. He also found in Butt's favour in respect of the claim for cancellation of the registration of Designs Nos 83/0645 and 83/0647. The cause of action based on passing off was

abandoned

abandoned and it was not dealt with in the judgment.

An order was granted as follows:

- "1. The first respondent. (i.e. Schultz) is interdicted and restrained
 - (a) from using
 - (i) any catamaran hull, with or without adaptations or modifications, manufactured by applicant; or
 - (ii) any mould, with or without modifications, made from a catamaran hull manufactured by applicantfor the purpose of manufacturing catamaran hulls in the course of first respondent's trade or business
 - (b) from selling or otherwise disposing of in the course of trade any catamaran boat or hull presently in his possession manufactured from any hull or mould referred to in paragraph (a) above.
2. The first respondent is ordered to deliver to the deputy sheriff for destruction any moulds or hulls presently in his possession which have

been

been manufactured, with or without adaptations or modifications, from a catamaran hull manufactured by applicant.

3. It is declared that the catamaran moulds and hulls presently manufactured by first respondent in the construction of boats marketed by him under the name of "Supercat" infringe the copyright in such mould and hull, which copyright vests in the applicant in terms of the provisions of the Copyright Act 98 of 1978 as amended by Act 66 of 1983.
4. Second respondent is directed in terms of section 10(2) of the Designs Act No 57 of 1967 to cancel in his register the registration in the name of first respondent of a boat hull and boat registered on 4th August 1983 under Nos 83/0645 and 83/0647 respectively.
5. (a) First respondent is ordered to pay the costs of application, such costs to include the costs of two counsel, and the reserved costs of the postponements on 31st October, 1983, 24th November 1983 and 6th December 1983.

(b)

(b) Leave is granted to first respondent, if so advised, to re-open the issue of the costs of the aforesaid postponements on notice to the applicant and the Registrar within 14 days of the date of delivery of this judgment, and thereafter to set the matter down for further argument in regard to such costs."

With the leave of the Court a quo, Schultz now appeals against the whole of the order.

UNFAIR COMPETITION

As a general rule, every person is entitled freely to carry on his trade or business in competition with his rivals. But the competition must remain within lawful bounds. If it is carried on unlawfully, in the sense that it involves a wrongful interference with another's rights as a trader, that constitutes

an

an injuria for which the Aquilian action lies if it has directly resulted in loss. (See Matthews and Others v. Young, 1922 A.D. 492 at 507; Geary & Son (Pty) Ltd v. Gove 1964(1) SA 434 (A) at 440-441).

In order to succeed in an action based on unfair competition, the plaintiff must establish all the requisites of Aquilian liability, including proof that the defendant has committed a wrongful act. In such a case, the unlawfulness which is a requisite of Aquilian liability may fall into a category of clearly recognized illegality, as in the illustrations given by CORBETT J in Dun and Bradstreet (Pty) Ltd v S.A. Merchants Combined Credit Bureau(Cape)(Pty)Ltd

1968 (1) SA 209 (C) at 216 F-H, namely, trading in contravention

of

of an express statutory prohibition; the making of fraudulent misrepresentations by the rival trader as to his own business; the passing off by a rival trader of his goods or business as being that of his competitor; the publication by the rival trader of injurious falsehoods concerning his competitor's business; and the employment of physical assaults and intimidation designed to prevent a competitor from pursuing his trade. But it is not limited to unlawfulness of that kind. In Dun and Bradstreet (supra) at 218 CORBETT J referred to the fact that in the cases of Geary & Son (Pty) Ltd v. Gove (supra) and Combrinck v. De Kock 5 SC 405 emphasis was placed upon criteria such as fairness and honesty in competition

Petition and said:

"Fairness and honesty are themselves somewhat vague and elastic terms but, while they may not provide a scientific or indeed infallible guide in all cases to the limits of lawful competition, they are relevant criteria which have been used in the past and which, in my view, may be used in the future in the development of the law relating to competition in trade."

See also Stellenbosch Wine Trust Ltd and Another v Oude

Meester Group Ltd, 1972(3) SA 152(C) at 161 G-H. In judging

of fairness and honesty, regards is had to boni mores and

to the general sense of justice of the community (Cp. Atlas

Organic Fertilizers (Pty) Ltd v Pikkewyn Ghwano and Another

1981(2) SA 173(T) at 188-189 and the cases there cited, and

Lorimar Productions Inc & Others v Sterling Clothing Manu-

facturers (Pty) Ltd 1981(3) SA 1129(T) at 1152 - 1153).

Van

Van der Merwe and Olivier, Die Onregmatige Daad in die

Suid-Afrikaanse Reg, 5th ed., p. 58 note 95, rightly em-

phasize that "'die regsgevoel van die gemeenskap' opgevat

moet word as die regsgevoel van die gemeenskap se regs-

beleidmakers, soos wetgewer en regter."

While fairness and honesty are relevant criteria in deciding whether competition is unfair, they are not the only criteria. As pointed out in Lorimar Productions (ubi cit), questions of public policy may be important in a particular case, e.g., the importance of a free market and of competition in our economic system.

In the present case it seems that MULLINS J's conclusion that Schultz's conduct amounted to unfair competition was based, in part, on the application of principles extracted from dicta in the English cases

of Saltman Engineering Co Ltd v. Campbell Engineering Co Ltd (1948) 65 RPC 203 (CA) at 215, and Terrapin Ltd v. Builders' Supply Co (Hayes) Ltd 1960 RPC 128, which were quoted and applied in Harvey Tiling Co (Pty) Ltd v. Rodomac (Pty) Ltd & Another 1977 (1) SA 316 (T).

The English judgments applied the broad principle of the English law of equity that he who has received information in confidence shall not take unfair advantage of it. In Dun and Bradstreet (supra) it was held at 213-215 that the equitable cause of action based on breach of confidence which is available in England does not exist in our law; but that does not mean that the misuse of confidential information in order to advance

vance one's own business interests and activities at

the expense of a competitor's may not constitute a wrong-

ful act in the context of an action for unlawful compe-

tition. See Dun and Bradstreet (supra) at 221 C-E;

and compare Stellenbosch Wine Trust Ltd & Another v. Oude Meester Group Ltd

(supra) at 162. See also Prok Africa (Pty) Ltd & Another v

NTH (Pty) Ltd & Others 1980 (3) SA 687(W) at 696.

In the case of Harvey Tiling (supra), it is clear that, although there was no clear statement in the summons to that effect, the cause of action was unfair competition. The first defendant, Rodomac, manufactured a tile in competition with that manufactured by the plaintiff, Harvey Tiling. The second defendant, Roux, had

been

been employed as Harvey Tiling's works manager, but left

its service and became a $33\frac{1}{3}\%$ shareholder and managing

director of Rodomac. The plaintiff's case as alleged

in the summons was that Rodomac was manufacturing tiles

according to a process that was the same as Harvey Tiling's

process, and that the two defendants had always used and

were using Harvey Tiling's know-how which they had wrong-

fully misappropriated. It was in these circumstances

that counsel on both sides were agreed that the legal

principles which were applicable were those stated in the

English cases. (See p. 321 G).

MULLINS J stated the following as a test of

confidentiality: "Information reasonably useful to a

competitor

competitor, i.e., to gain an advantage over the holder of such information, may generally be regarded as confidential" and added, "I consider that the same considerations apply to cases where trade information is obtained from sources other than through an employee."

(See . . at 577 B-C). Having quoted from the judgment of LORD GREENE MR in the Saltman Engineering case, he indicated that he was "applying these principles to the present case".

In my opinion, the learned judge erred in this regard. Where nothing is said between the parties to a communication in regard to confidentiality, the criterion referred to will be relevant to the question whether it was confidential. But it is of the essence that the communication should be of secret or private matters. To be confidential, the information must

"have

"have the necessary quality of confidence about it, namely, it must be something which is not public property and public knowledge."

(per LORD GREENE M.R. in the Saltman Engineering case at p. 215).

The design of the Butt-Cat hull was in the public domain: there was nothing confidential about it.

In my view, therefore, the decision of the Court a quo cannot be sustained insofar as it is based on the misuse of confidential information.

That, however, was not the only basis of MULLINS J's decision. He said at 579 D-F:

"Admittedly in the Dun and Bradstreet case the information was distributed by the plaintiff to its clients on a

confidential

confidential basis. I do not regard this however as the sole ratio decidendi of the judgment. The sale of an object such as a boat inevitably releases the design thereof, and in casu the hull, to the purchaser.

This does not entitle the purchaser or anyone else, in my view, to make a mould therefrom and to copy that hull for commercial purposes. A rival manufacturer is entitled to examine hulls designed by his competitors, and to incorporate in his own design what he regards as the most desirable features thereof.

He may not, however, in my view, copy such hull, the product of another's inventiveness and experience, in a manner which does not require him to apply his mind to such design or to exercise his own inventiveness and experience, even if he only uses it as a starting point and makes modifications thereto."

And at 580 E-F:

"There

"There is no question of granting applicant a monopoly in regard to the design of his hull. Anyone is entitled to design a hull with similar features. What applicant is entitled to be protected against is the use by first respondent of applicant's hull as a starting point. First respondent must start from the beginning, not on the second or third rung of the ladder. Applicant is not entitled to be protected against another person evolving his own design similar to that of applicant, or even against the copying of his design, but he is entitled to be protected against the use of one of his hulls to form a mould, with or without modification. See Callman on Unfair Competition para 4.60."

Counsel for Schultz submitted that the main question in the appeal was whether the copying of something which was not protected by the Copyright Act, the Patents Act or the

Designs.....

Designs Act can be unfair or unlawful.

If that would be the main question the answer would be clear. Anyone may ordinary make anything produced by another which is in the public domain: One may freely and exactly copy it without his leave and without payment of compensation. So, In Steers v Rogers 10 RPC 245 (H.L.), where LORD HERSCHELL LC, having said (at p 251) that a patent does not confer upon the patentee a right to manufacture according to his invention, continued:

"That is a right which he would equally effectually have if there were no Letters Patent at all - only in that case all the world would equally have the right. What the Letters Patent confer is the right to exclude others from manufacturing in a particular way and from using a particular invention."

See

See also John Waddington Ltd v. Arthur E Harris (Pty) Ltd

1968 (3) SA 405 (T) at pp 407-408.

But the question to be decided in this case is not whether one may lawfully copy the product of another substantially but whether A, in making a identical copy, with the use of B's mould, of an article made by B, and selling it in competition with B, is engaging in unfair competition.

This question has not arisen in any previous case in South Africa. Nor do cases decided in England provide any assistance, since it appears that English law does not recognize an independent tort of unfair competition. (See the judgment of POWELL J sitting in the Supreme Court of New South Wales which is included in the

report

report of Cadbury-Schweppes (Pty) Ltd v. The Pub Squash Co Ltd 1981 RPC 429 (PC) at pp 461-464). Some guidance is however to be obtained from the decision of the United States Supreme Court in International News Service v. The Associated Press (1918) 248 U.S. 215, a case which was considered by CORBETT J in Dun & Bradstreet (supra) at pp 219-221. In that case the Court held by a majority that it constituted unfair competition in trade for the defendant news agency to appropriate news gathered by the plaintiff news agency for the purpose of selling it to the defendant's clients. PITNEY J, who wrote the opinion of the Court, said at 239-240:

"The right of the purchaser of a single newspaper to spread knowledge

of

of its contents gratuitously, for any legitimate purpose not unreasonably interfering with complainant's right to make merchandise of it, may be admitted; but to transmit that news for commercial use, in competition with complainant - which is what defendant has done and seeks to justify - is a very different matter. In doing this defendant, by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown, and by disposing of it to newspapers that are competitors of complainant's members is appropriating to itself the harvest of those who have sown. Stripped of all disguises, the process amounts to an unauthorized in-

terference

terference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not; with special advantage to defendant in the competition because of the fact that it is not burdened with any part of the expense of gathering the news. The transaction speaks for itself, and a court of equity ought not to hesitate long in characterizing it as unfair competition in business. "

A. reversal of this approach occurred

in two cases decided in 1964: Sears, Roebuck & Co v.

Stiffel Co 376 U.S. 225 and Compco Corporation v. Day-Brite

Lighting Inc 376 U.S. 234.

In Sears the ques-

tion was whether a State's unfair competition law

can

can, consistently with the federal patent laws, impose liability for or prohibit the copying of an article which is protected by neither a federal patent nor a copyright.

It was stated in the opinion of the Court (pp 231-232):

"In the present case the 'pole lamp' sold by Stiffel has been held not to be entitled to the protection of either a mechanical or a design patent. An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so. What Sears did was to copy Stiffel's design and to sell lamps almost identical to those sold by Stiffel. This it had every right to do under the federal patent laws. That Stiffel originated the pole lamp and made it popular is immaterial. 'Sharing in the goodwill of an article unprotected by patent or trade-mark

is

is the exercise of a right possessed by all - and in the free exercise of which the consuming public is deeply interested'... To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public."

What the Court decided was a constitutional question.

It did not deal at all with the question whether Sears's conduct amounted to unfair competition. The case has therefore no bearing on the present problem.

The way in which unfair copying had been dealt with in Western European countries is of

interest

interest. Some examples are given in Christine Fellner, The Future of Legal Protection for Industrial Designs (ESC Publishing Limited, Oxford, 1985):

"319 On 9 November 1978 a plaintiff complained to the Court of Appeal at Ghent about slavish copying of his advertisements for carpets. He did not allege copyright infringement, but said that he had originated the theme of bare feet on a carpet suggesting a feeling of pleasant comfort, and had used and developed this theme for many years at considerable cost. The defendant had, the Court found, taken care to avoid confusion but had taken advantage of this original 'theme', and there was substantial similarity of presentation. An injunction was granted, based entirely on the 'parasitic' exploitation of the investment and ideas of another. Confusion was not necessary."

A

"471. A further recognised type of unfair competition is the direct misappropriation ('unmittelbare Leistungsübernahme') of the work of another by using his artefact as a mould or prototype for the competitor's own product. This principle was used to combat pirate record pressing before the existence of 'mechanical copyright' in records. Recent examples include the copying of a plastic boat by using the competitor's boat as a mould and the copying by direct casting of carefully selected sets of 'off the peg' false teeth. The unfairness here resides in the method of copying; the defendant is taking the fruits of the plaintiff's money, skill and labour intact, without investing any of his own. Where this is not the case, the action will not lie."

See also Van Heerden en Neethling, Onregmatige Mededinging,

pp. 144-145.

Fellner

Fellner (op. cit p. 200) refers to the ways in which

"foreign jurisdictions selectively control slavish imitation through their unfair competition laws", saying:

"In the absence of specific industrial property rights, by no means all copying is prohibited; but where it is felt to be 'unfair', the law will provide a remedy. As well as the fact of copying, the judge can consider the scale of the plaintiff's initial investment, the originality and commercial success of his product, the ease with which it was copied, the technical and commercial feasibility of product differentiation, and the economic sense or nonsense of requiring investment in redesigning a satisfactory product from scratch. He can also scrutinise the behaviour of the parties, taking account, for example, of any unfairness in the way information was obtained,

impropriety

impropriety of motive, and dubious marketing practices, including public deception. His aim is to reach a decision which is fair as between the parties while paying due regard to the public's interest in free, as well as fair, competition. In certain jurisdictions at least he can grant a remedy which is tailored to the facts, such as a limited injunction or damages only."

In my view the principles enunciated in the International News Service case, and the principles appearing from the passages quoted from Fellner, are generally in accordance with the broad equitable approach adopted by South African courts in unfair competition cases.

The question then is, what is the result of the application of these principles to Schultz's conduct?

In

In the American case of American Safety Table Co Inc ^{v.} Schreiber

(1959) 269 F.2nd 255, it was said at 271-272:

"...(At) first glance it might seem intolerable that one manufacturer should be allowed to sponge on another by pirating the product of years of invention and development without licence or recompense and reap the fruits sown by another. Morally and ethically such practices strike a discordant note. It cuts across the grain of justice to permit an intruder to profit not only by the efforts of another but at his expense as well."

However, this initial response to the problem was curbed

in deference to the greater public good:

"For imitation is the life blood of competition. It is the unimpeded availability of substantially equivalent units that permits the normal

operation

operation of supply and demand to yield the fair price society must pay for a given commodity

Unless such duplication is permitted, competition may be unduly curtailed with the possible resultant development of undesirable monopolistic conditions. The Congress, realizing such possibilities, has therefore confined and limited the rewards of originality to those situations and circumstances comprehended by our patent, copyright, and trademark laws. When these statutory frameworks are inapplicable, originality per se remains unprotected and often unrewarded. For these reasons and with these limitations the bare imitation of another's product, without more, is permissible. And this is true regardless of the fact that the courts have little sympathy for a wilful imitator."

One's initial response to Schultz's conduct in the present case is no different. There can be no doubt that the community would condemn as unfair and unjust

Schultz

Schultz's conduct in using one of Butt's hulls (which were evolved over a long period, with considerable expenditure of time, labour and money) to form a mould with which to make boats in competition with Butt. He went further.

Having trespassed on Butt's field, he added impudence to dishonesty by obtaining a design registration in his own name for the Butt-Cat hull, with the object no doubt of forbidding the field to other competitors.

In South Africa the legislature has not limited the protection of the law in cases of copying to those who enjoy rights of intellectual property under statutes.

The fact that in a particular case there is no protection by way of patent, copyright or registered design, does not

license

license a trader to carry on his business in unfair competition with his rivals. In my view there is not in the present case any sufficient countervailing public interest to displace one's initial response to Schultz's methods of competition.

In my opinion, therefore, MULLINS J was right in his conclusion that Schultz's conduct amounted to unfair competition, against which Butt was entitled to be protected.

INFRINGEMENT OF COPYRIGHT

It is common cause that Butt is the "author" of the Butt-Cat hull and that he is a "qualified person" in terms of s. 3(1) of the Copyright Act, No 98 of 1978.

In

In terms of s. 2(1)(c) of the Act, "artistic works" are eligible for copyright if they are original. Prior to the amendment of s. 1(1) of the Act by s. 1(a) of the Copyright Amendment Act, No 66 of 1983 (which came into force on 17 October 1983) "artistic work" was defined as meaning inter alia:

" (c) Works of artistic craftsmanship not falling within either paragraph (a) or (b)";

By the amendment a new paragraph (c) was substituted; namely,

" (c) works of artistic craftsmanship, or works of craftsmanship of a technical nature, not falling within either paragraph (a) or (b)".

It is common cause that the Butt-Cat hull is a

"work

"work of craftsmanship of a technical nature" falling with-
in para (c). As such it became eligible for copyright
for the first time on October 1983.

It was submitted on behalf of Schultz that -

(a)

- (a) The 1983 amendment did not create copyright retrospectively. Consequently there was no copyright in the Butt-Cat plug, mould and hulls because they had been made before 17 October 1983.
- (b) In any event, there could have been no infringement of copyright before 17 October 1983.
- (c) By virtue of s. 43(a)(ii) of the Act, there was no copyright in the Butt-Cat plug, mould and hulls because such copyright did not subsist prior to 11 September 1965.

Schultz's counsel did not press submission (a) with any conviction. That was not surprising in view of the provisions of s. 43 of the Act:

"43. This Act shall apply in relation to works made before the commencement of this Act as it applies in relation to works made thereafter: provided that -

- (a) nothing in this Act contained shall -
 - (i)
 - (ii) be construed as creating any copyright which did not subsist prior to 11 September 1965"

It

It follows that if the substituted para (c) of the definition of "artistic work" had been included in the definition of that expression, in the 1978 Act, there could have been no doubt that it would have operated retroactively. And the mere fact that it was substituted by amendment in 1983 cannot have a different result.

Butt's counsel did not quarrel with submission (b). Clearly any copying by Schultz before 17 October 1983 was not an infringement because prior to that date no copyright existed in respect of works of craftsmanship of a technical nature, and there is nothing in the 1983 amendment which makes conduct unlawful which was lawful when it was committed.

In

In regard to submission (c): if the hull acquired by Schultz from Beary was made from a mould or plug created prior to 11 September 1965, Butt had no copyright therein. The probability is, however, that the Beary hull was made from the plug and mould which Butt created in 1978. The 1978 plug was "original", not, it is true, in the sense of being the first work of that type which was created, but in the copyright sense of originating from the author. Even though it was developed from and resembled the original plug, it was in itself a "work of craftsmanship of a technical nature", in which Butt owned the copyright.

In terms of s. 7 of the Act, copyright in an

artistic

artistic work vests in the owner of, the copyright the exclusive right inter alia of reproducing the work in any manner or form, and of making an adaptation thereof.

It is clear that Schultz infringed that right subsequently to 17 October 1983, and consequently a declaratory order in terms of para 3 of the order made by the Court a quo was properly granted.

CANCELLATION OF REGISTERED DESIGN

In terms of s. 10(2) of the Designs Act, No 57 of 1967,

"10(2) At any time after a design has been registered any person interested may apply to the court for ^{the} cancellation of the registration of the design on any of the following grounds, namely,

(a)

(a) that the design was not new or original;

(b) that the applicant for registration was, not the proprietor; or

(c) that the application was in fraud of the proprietor,

....."

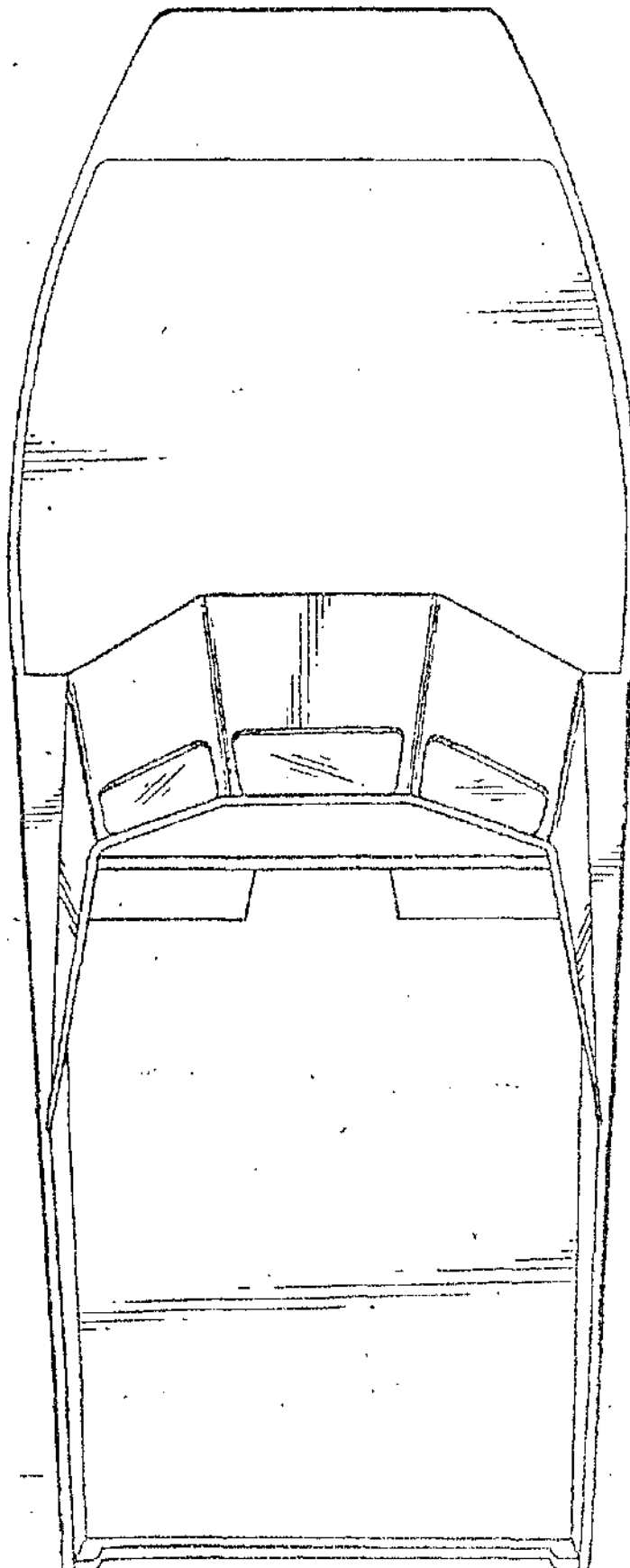
In Design No 83/0647, the boat is represented in

plan, side and front views:

Dennis John George SCHULTZ

3 Sheets
Sheet No 1

830647

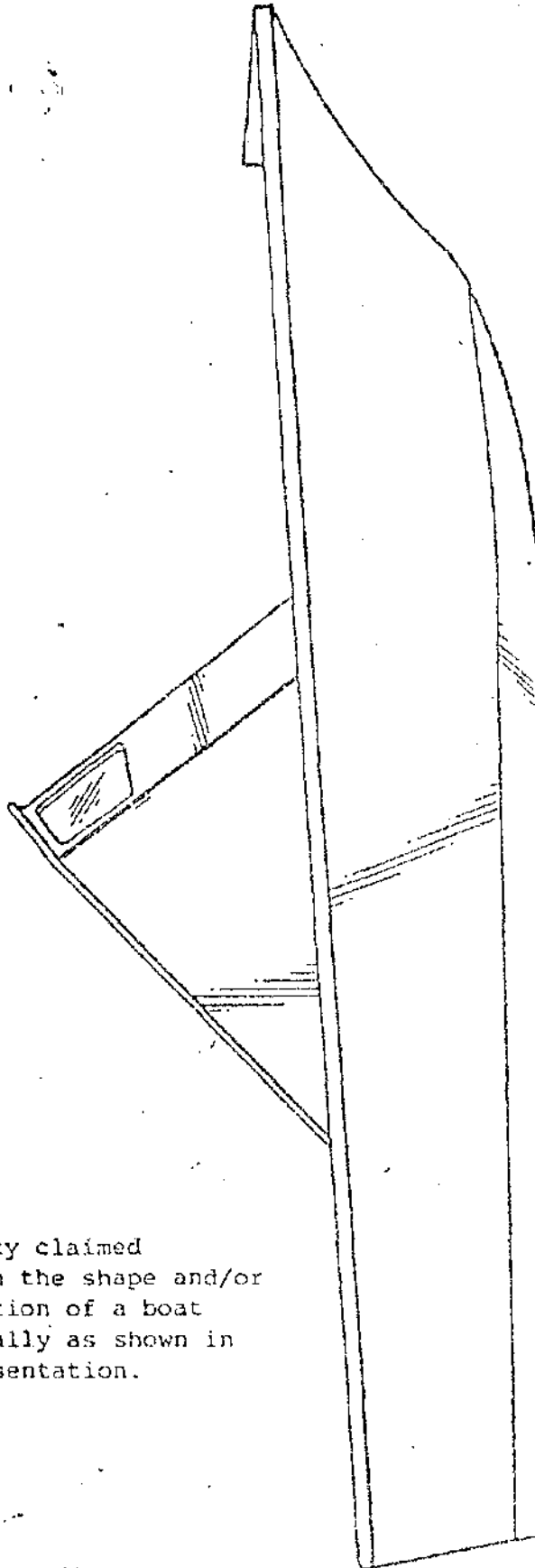


Plan View

The novelty claimed resides in the shape and/or configuration of a boat substantially as shown in the representation


Dennis J. Schultz

830647



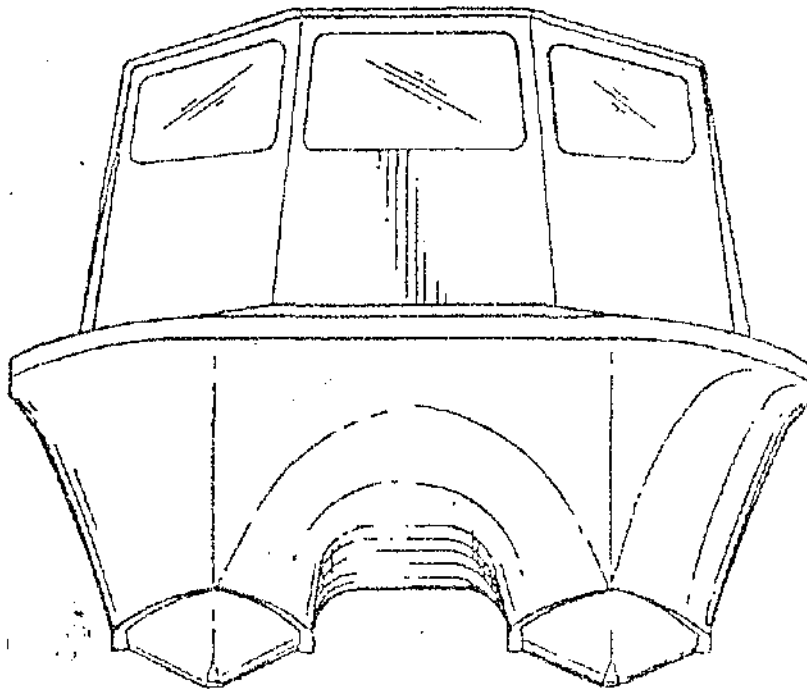
Side View

The novelty claimed
resides in the shape and/or
configuration of a boat
substantially as shown in
the representation.

Dennis John George SCHULTZ

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Front View

The novelty claimed resides in the shape and/or configuration of a boat substantially as shown in the representations

A stylized, handwritten signature in ink, likely belonging to one of the patent attorneys, Adams & Adams.

ADAMS & ADAMS
APPLICANT'S PATENT ATTORNEYS

Design No 83/0645 is for a boat hull, which is the same as the hull of the boat represented in Design No 83/0647.

Design No 83/0646 is for a window structure for a boat, which is the same as the window structure represented in Design No 83/0647.

It is conceded that the registration of Design No 83/0645, in respect of a boat hull, was properly cancelled on the ground that the Design was not new or original at the effective date. In my opinion the registration was also liable to cancellation on grounds (b) and (c). But, not Schultz, was the author of the design and hence the proprietor within the definition in s. 1(1) of the Act. Schultz's declaration that he was the proprietor was to

his

his knowledge untrue, and he made it with the intention of procuring a registration to which he was not entitled.

The registration of Design No 83/0646 was not attacked and no order was made in regard thereto.

In regard to Design No 83/0647, cancellation of registration was claimed on the ground that it was not new or original.

In terms of s. 4(2) of the Act, a design shall be deemed to be a new or original design if, on or before the date of application for registration thereof, such design or a design not substantially different therefrom was not "(a) used in the Republic".

The general concept of a "design" was discussed

in

in the judgment of this Court in Homecraft Steel Industries (Pty) Ltd

(Pty) Ltd & Another
v S M Hare & Son, 1984(3) SA 681(A) at pp 690 D - 692 H. As

appears therefrom, the elements of design are pattern,

shape, configuration or ornamentation; and for the exter-

nal appearance of any article to be registrable as a design

there must be something special, peculiar, distinctive,

significant or striking about its pattern, shape, configu-

ration or ornamentation, something which catches the eye -

and in this sense appeals to the eye - and which distinguish-

es the article from others of its type and class. * More-

over, the proviso to the definition of "design" excludes

from consideration (i) any feature in so far as such feature

is dictated solely by the function which the article is in-

tended

tended to perform and (ii) any method or principle of construction. As was observed in that case (at p. 692

D) -

"The visual criterion is, of course, of cardinal importance not only in determining whether a design meets the requirements of the definition, but also in deciding questions of novelty and infringement."

The question whether a design is novel and original is thus a question of fact to be decided by the eye, upon comparison between the registered design and an alleged anticipation.

What has to be considered here is a comparison between Design No 83/0647 and the design of a boat which differs only in respect of the window structure.

It

It may be accepted for the purposes of the present case that the design of Schultz's window structure was new or original. But that is not sufficient to justify a

finding in his favour. . In Registered Clarke's Design (1896) 13

RPC 351, LINDLEY LJ said at 360 lines 28-30:

"Where a design is composed of old parts and is registered, the design, as one whole, is what is protected; not the design for some or one of the component parts taken separately from any of the others, and it is not necessary to distinguish what is old from what is new."

Compare what CHITTY J said in Walker & Co v A G Scott & Co

(1892) 9 RPC 482 at p. 485 lines 50-55:

"The design may be valid within the Act although all the parts are old except some particular part only which is new

or

or original. The novelty or originality of the particular part may be sufficient to impart the character of novelty and originality to the whole."

Where the novel part of a design is nothing more than an ordinary trade variant, it is

insufficient to impart that character. See Phillips v

Harbro Rubber Co (1920) 37 RPC 233 at p. 240 lines 31-36.

LORD MOULTON said (ubi cit at lines 9-13):

"The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in any particular instance, and ... no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind."

The window structure of a sea-going ski boat is

the

the equivalent of the wheel-house of a larger boat - its function is to provide some protection to the occupants against wind and spray. Basically its design is determined by that function, and variants are matters of taste or choice in the trade. That such variants are numerous is evident from the copies of illustrations from publications annexed to Schultz's affidavit.

In my opinion, Schultz's window structure is no more than an ordinary trade variant of window structures in common use in the boat-building trade. As such, its introduction cannot make the design of the boat new or original. If it were otherwise, one would have the absurd position that anybody could obtain registration of the design

sign of a boat comprising a Butt-Cat hull and a variant of
a window structure. The observations of ASTBURY J in

Allen West & Co Ld v British Westinghouse Electric and

Manufacturing Company Ld (1916) 33 RPC 157 are apposite.

The learned judge said at p. 162 lines 27-40:

"The encouragement given by the Patent Law to those who produce new and useful inventions, and by the law relating to Designs to those who produce new and original Designs, is primarily to advance our industries, and keep them at a high level of competitive progress; but in administering these provisions it is, I think, most important to bear in mind the fact that they are not intended, and ought not to be allowed, to paralyse or impede the natural and normal growth and development of the manufactures which they are intended to benefit. I think this case ought to be

determined

determined upon the question whether the difference in the registered Design of the right-angled finger support is or is not sufficient to make it an original Design within the meaning of the Act, or, whether, on the contrary, it is not an ordinary and natural alteration of the shape of a known article for the purpose of fitting it into a case or apparatus in which it is desired that it shall work."

and at p. 164 line 46 to p. 165 line 15:

"In Le May v Welch (L.R. 28 C.D. 34) Lord Justice BOWEN said:--'It is not every mere difference of cut,' - he was speaking of collars - 'every change of outline, every change of length, or breadth, or configuration, in a simple and most familiar article of dress like this, which constitutes novelty of Design. To hold that would be to paralyse industry and to make the Patents, Designs and Trade Marks Act a trap to catch honest

traders

traders.' There must be, not a mere novelty of outline, but a substantial novelty in the Design having regard to the nature of the article. Lord Justice FRY said:- 'It has been suggested by Mr. Swinfen Eady that unless a Design precisely similar, and in fact identical, has been used or been in existence prior to the Act' - prior to the date of registration I think it ought to be - 'the Design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for their own use. It appears to me that such a mode of interpreting the Act would be highly unreasonable, and that the meaning of the words "novel or original" is this, that the Design must either be substantially novel or substantially original,

having

having regard to the nature and character of the subject-matter to which it is to be applied."

My conclusion is that Design No 83/0647 was not novel or original, and that MULLINS J was correct in ordering the cancellation of the registration.

FORM OF ORDER

It was submitted on behalf of Schultz that paras 1 and 2 of the order made by the Court a quo were too wide.

I agree that the order should be amended to make it clear that the interdict relates solely to the Butt-Cat hull (which was the only hull in issue in the application), and that the order for delivery up in para 2 should relate solely to the period after 17 October 1983.

In

In the result the appeal will be dismissed except insofar as it relates to the amendments of the order.

This is a matter which occupied very little time at the hearing of the appeal, and I do not think that Schultz's

... : limited success in this regards calls for any special order in regard to costs.

The following order is made:

1. Paragraphs 1 and 2 of the order of the Court

a quo are amended to read:

"1. The first respondent is interdicted and restrained

(a) from using

(i) any Butt-Cat hull, with or without adaptations or modifications, manufactured by applicant; or

(ii) any mould, with or without

modification ...

modifications, made from
such hull manufactured by
applicant

for the purpose of manufacturing
catamaran hulls in the course of
first respondent's trade or busi-
ness.

(b) from selling or otherwise dispos-
ing, of in the course of trade any
catamaran boat or hull presently
in his possession manufactured
from any hull or mould referred
to in paragraph (a) above.

2. The first respondent is ordered to de-
liver up to the Deputy Sheriff for
destruction any moulds or hulls pre-
sently in his possession which have
since 17 October 1983 been manufac-
tured, with or without adaptations or
modifications from a Butt-Cat hull
manufactured by applicant."

2. Save as aforesaid the appeal is dismissed with costs,
including the costs of two counsel.

H C NICHOLAS, AJA

CORBETT, JA
HOEXTER, JA
BOSHOF, JA
NESTADT, AJA } Concur