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Royal Commission on
Patents, Copyright, Trade Marks
and Industrial Designs

REPORT
ON INDUSTRIAL
DESIGNS

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EDMOND CLOUTIER, C.M.G., O.A., D.S.P.
QUEEN'S PRINTER AND CONTROLLER OF STATIONERY
OTTAWA, 1958

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TO HIS EXCELLENCY THE
GOVERNOR GENERAL
IN COUNCIL

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PART I

INTRODUCTORY

By commission, dated June 10, 1954, we were appointed Royal Commissioners

to inquire as to whether Federal legislation relating in any way to patents of invention, industrial designs, copyright and trade marks affords reasonable incentive to invention and research, to the development of literary and artistic talents, to creativeness, and to making available to the Canadian public scientific, technical, literary and artistic creations and other applications, adaptations and uses, in a manner and on terms adequately safeguarding the paramount public interest, the whole in the light of present day economic conditions, scientific, technical and industrial developments, trade practices and any other relevant factors or circumstances, including practices under or related to the said legislation and any relevant international convention to which Canada is a party.

As indicated in our Report on Copyright, our inquiry into the field of industrial designs was initiated on August 20, 1954, by a short questionnaire addressed to corporations, firms, associations and individuals whom we had reason to believe were interested in this subject from either the aesthetic, commercial or public-interest point of view. The questionnaire is attached to this Report as Appendix "A". Public hearings were then held from time to time to allow representations to be made. In our opinion all persons desiring to speak to this subject have been heard, and those who appeared either personally or by representatives before the Commission to make representations together with those who filed statements only are listed in Appendix "B". We should also mention that throughout the course of the inquiry we have had before us the Report of the Departmental Committee (to be referred to as the Swan Committee) appointed by the President of the Board of Trade of the United Kingdom to consider the Patents and Designs Acts whose final report (to be referred to as the Swan Report) was presented to Parliament in September, 1947. We have found this report extremely helpful in our investigations. The subject of industrial designs, design patents, etc., was discussed also with officials of the patent departments of the governments of the United Kingdom, France, the United States, Switzerland and the Netherlands. We have also examined Bill H.R.8873 introduced on July 23, 1957, in the House of Representatives of the United States and entitled "A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying" together with the statement appearing in the Congressional Record at the time the Bill was introduced.

PART II

EXISTING INDUSTRIAL DESIGN LEGISLATION

The term "protection of industrial property" is often taken as including not only the protection afforded by a patent of invention, giving as it does a monopoly for a limited period to the inventor of a new and useful product, machine or process, but the protection afforded by a design patent or certificate of registration of a new design which is intended to improve or at least alter the appearance of an article of manufacture. Such a design patent or certificate of registration ordinarily gives the proprietor of the design a monopoly of the use of the design for a limited period.

1. Conventions

The International Convention for the Protection of Industrial Property (Paris Convention of 1883 as revised) to which Canada is a party provides (Art. 1, par. 2) that the protection of industrial property is concerned with "patents, utility models, *industrial designs* or models" etc. This Convention provides that "national treatment", that is the protection which a country gives its own nationals in respect of industrial property, must be extended to persons within the jurisdiction of each of the countries which are parties to the Convention (e.g., the United Kingdom and the United States). Other relevant provisions of the Convention will be referred to later.

There is nothing in the Convention obliging Canada to protect industrial designs; nor is there in any other international convention to which Canada is a party, either at present or in contemplation. It may be noted, however, that if Canada becomes a party to the Universal Copyright Convention, Canada will be bound by Article IV, par. 3, which provides that "the term of protection in those Contracting States which protect . . . works of applied art in so far as they are protected as artistic works shall not be less than ten years for (such) works". As will be seen we do not propose to recommend legislation which will protect works of applied art "as artistic works" and we think that paragraph 3 will have no application to the kind of legislation we recommend.

2. Legislation in the United Kingdom

A very good way to get an idea of what is ordinarily meant by an industrial design is to consider the legislation of other countries. At our instance Dr. Walton Hamilton, Professor Emeritus of Law at Yale University, now of the law firm of Arnold, Fortas & Porter, Washington, D.C., prepared a comprehensive memorandum on industrial designs which, with his permission, we append as Appendix "C". It will be seen from this that the present Registered Designs Act in the United Kingdom defines a design as follows: "In this Act the expression "design" means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated

solely by the function which the article to be made in that shape or configuration has to perform." If such a design is new or original and has not been registered or published (in the United Kingdom) before, it may be registered in respect of any article or set of articles. And for five, ten or fifteen years after registration, as the case may be, the proprietor of the registered design has what is called a copyright in the design, that is, the exclusive right in the United Kingdom (and the Isle of Man) to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, etc. (Section 7 of United Kingdom Act). The legislation, case law and legal textbooks indicate:

- (1) that the design may be of two dimensions (pattern, ornament) or three (shape, configuration);
- (2) that it need not possess artistic merit—it need not be ornamental in the artistic sense;
- (3) that the design need not add to the utility of the article, but if it does—if some mechanical advantage necessarily follows from adoption of the design—it is not deprived of registrability on that account, provided only that the features (being features of shape or configuration) which constitute the design were not dictated *solely* by function;
- (4) that the article is not the design—that the design is an idea or conception as to features of shape, configuration, pattern or ornament *applied* to an article; and
- (5) that the design must appeal to and be judged solely by the eye.

If an alleged design is submitted to the Registrar for registration and comes within the definition of design and it is new *or* original and has not before been published or registered in the United Kingdom in respect of the same or any other article, it is registrable.

The way in which the system of protecting industrial designs in the United Kingdom developed is concisely stated in the Swan Report, paragraphs 267 and 268 which are as follows:

267. Copyright in a design applied to an article of manufacture has always been given by Statute, and, since 1839, has been dependent upon the registration of the design by the proprietor in the statutory Designs Register before publication or delivery on sale of articles bearing the design.

268. The first Designs Act was passed in 1787 and was limited in duration, being subsequently continued in force by Acts of 1789 and 1794. It granted a monopoly for two months in new and original patterns for printing on linens, cottons, calicoes and muslins. Two further Acts were passed in 1839, one extending the Act of 1787 to wool, silk and hair fabrics and fabrics made of mixtures, and the other giving protection, upon registration with the Board of Trade, to ornamental designs for all articles other than lace and designs protected under the earlier Acts. In 1842 a consolidating Act repealed all existing designs legislation, and made provision for the granting of a sole right of applying to articles of manufacture (except sculptures and busts) any new or original ornamental design applicable for pattern, shape, configuration or ornament. For the purposes of registration, designs were divided into 13 classes and the term of protection varied, according to the class of articles, from 9 months to 3 years. In the next year this protection was extended to new or original designs for articles of manufacture having reference to some purpose of utility, the term of protection for such designs being 3 years. The design could be for the whole of the shape or configuration or for a part thereof. Amending Acts were passed in

1850 and 1858, and it may be noted as a matter of interest that the Act of 1850 provided for the provisional registration of designs, which gave protection for 1 year (extendible by the Board of Trade for another 6 months), such protection ceasing as soon as the article bearing the design was placed on sale. In 1875, the control of the registration of designs was transferred from the Board of Trade to the Commissioners of Patents, and in 1883 the distinction between the protection of useful and ornamental designs was abolished by the Designs Sections of the Patents, Designs and Trade Marks Act of that year, which repealed all existing legislation, transferred the registration of designs to the Patent Office, extended protection to all designs (other than sculptures) without regard to purpose or utility, and fixed a uniform term of protection of 5 years. Apart from an amendment in 1907 allowing the term of copyright to be extended by two further terms of 5 years each, no noteworthy change in the law has been made by the later Acts.

However, the Registered Designs Act, 1949 (United Kingdom) did make noteworthy changes. This Act is attached as Appendix "D" as it will be referred to repeatedly in this Report.

3. Legislation in the United States

Title 35 of the United States Code, which will be referred to as the United States Patent Act, Section 171, provides that "whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor..." As will appear from Appendix "C", patentable designs in the United States have many of the characteristics of registrable designs in the United Kingdom but it should be noted that to be patentable a design must be new *and* original; it must be ornamental (a requirement often regarded by the courts as calling for artistic merit); and it must be the result of invention, an inventive step, at least of "greater skill than that exercised by the ordinary designer who is chargeable with knowledge of the prior art".

4. Legislation in Canada

With regard to our present Act (Industrial Design and Union Label Act, R.S.C. 1952, c. 150) it would be a waste of time to discuss its provisions in detail. For if Canada is to have industrial design protection at all it is clear that a completely new act must be substituted for it. Mr. Justice MacLean, late President of the Exchequer Court, said of it: "The scope of this part of the Trade Marks 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 in serious need of amendment": *Clatworthy & Son Ltd. v. Dale Display Furniture Ltd.* (1928) Ex. C.R. 159 at p. 162.

The first design protection legislation in what is now Canada was passed in 1861. No more appropriate sketch of the history of design protection legislation in Canada can be given here than that which was supplied by Dr. Harold G. Fox, Q.C., in a presentation which he made to the Commission on behalf of the Board of Trade of the City of Toronto from which the following is quoted:

The protection of a design applied to an article of manufacture has, since 1861, been dependent upon registration of the design by the proprietor in accordance with the legislation respecting the registration of such designs.

The Canadian law relating to the protection of Industrial Designs appears to have had its origin and stem from the Design Act which was first passed in Great Britain in 1787 when the first design legislation was enacted.

The legislation that preceded the present legislation is not of interest except as to the definition of a "design" which was contained in the first Design Act, but dropped in subsequent Acts. The first legislation relating to and granting protection to Industrial Designs was enacted by the Province of Canada in 1861 (24 Vic. c. 21). Section 11 of that Act gives the one and only definition of a "design" to be contained in any Canadian legislation. That section declared that it was advisable to make provision for the copyrighting, protecting and registering of new designs whether such designs may be applicable to the ornamenting of any article of manufacture, or any substance, artificial or natural, or partly natural and partly artificial and whether such design be so applicable for the pattern, or for the shape, or for the configuration, or for the ornament, or for any two or more such purposes, and by whatever means such design may be so applicable whether by printing or painting, or by embroidery, or by weaving or by sewing, or by modelling or by casting, or by embossing or by engraving, or by staining, or by any other means whatsoever, manual, mechanical or chemical, separate or combined. Following Confederation, 31 Vic. Chap. 55 was enacted by the Parliament of Canada, in much the same terms as the one just mentioned, providing for the registration of new designs but unfortunately omitted any definition of a design.

The legislation under which Designs are now afforded protection was enacted in 1906 as the Trade Mark and Design Act. Like its predecessor it contained no definition of a design. Since that date no noteworthy change has been made in the Act. In 1932 the sections in the Act relating to Trade Marks were repealed and replaced by a new Act entitled—The Unfair Competition Act, 1932. The sections relating to the protection of "Industrial Designs" remained unchanged.

Four features of our Act should perhaps be mentioned:

(1) It is not clear whether shape or configuration may be the subject of a registered design. See *Clatworthy & Son Ltd. v. Dale Display Furniture Ltd.* (supra) and *Renwall Manufacturing Co. v. Reliable Toy Co.* (1949) Ex. C.R. 188 at p. 196.

(2) Ornamentation appears to be a requirement. This is the implication from Section 11 and Section 16 (1) (a). But there is nothing to indicate whether the ornamentation must possess artistic merit.

(3) Originality appears to be a requirement (implication from Section 7(3)) but the meaning of originality is no clearer than in the United Kingdom Act, where it is not clear at all. Russell-Clarke on Copyright and Industrial Designs (1951) at page 162, suggests two if not three possible meanings of the word "original" as used in the United Kingdom Act, and in *Dover v. Nurnberger Celluloid Waren Fabrik* (1910) 27 R.P.C. 498, Buckley L. J. and Kennedy L. J. differed in their interpretations of the word.

(4) Novelty does not appear to be a requirement unless it is involved in originality, but the proprietor applying for the registration must deposit a declaration "that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof". (Section 4).

Other features of our Act will be referred to as we make our recommendations.

PART III

CONSIDERATION OF QUESTION WHETHER PROTECTION DESIRABLE

Should industrial designs be protected at all? We ask this question because we have seriously considered recommending the repeal of our present Act with the substitution of nothing in its place.

1. Arguments Against Protection

Some or all of the arguments for wiping the slate clean and leaving it at that may be stated as follows:

(1) We think that no one can read Appendix "C" to this Report without being impressed with the weakness of the protection which is given to industrial designs in the United States. The protection seems to be virtually non-existent, except (since the decision in *Mazer v. Stein*, (1954) 347 U.S. 201) in the case of artistic works industrially applied, which retain their copyright protection. Yet we have not heard it suggested that progress in design there is unsatisfactory. Design protection in Canada is virtually non-existent. Yet can it be said that design progress is wanting? Two members of this Commission examined the situation with respect to industrial designs in some other countries and were impressed with the high level of design excellence in at least one country which affords no protection.

(2) Persons who make innovations in the mercantile arts as distinguished from the mechanical arts cannot obtain monopoly of their innovations. Yet they continue to make them. As far as an observer can discern, progress in the mercantile arts has been rapid and satisfactory. The legislative creation of exclusive rights to innovations does not seem to have been necessary in that field. The dynamic urge to innovate seems to drive men on to creative effort. Does it not do the same in the field of industrial design?

(3) Any industrial design legislation that can be devised is bound, we think, to result in uncertainty in many instances as to whether a design registered or deposited for registration was new at the time, and, in many infringement actions, as to whether a design infringes a registered design. Under the United Kingdom Act a design is not registrable in respect of an article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade. It must be most difficult in considering a design for a chair, for example, to say whether it differs from other known designs, perhaps of existing chairs, in more than immaterial details or in features which go beyond variants commonly used in the trade. A similar problem must arise in infringement actions. The court must decide whether the allegedly infringing design is or is not "substantially different" from the registered design. In most cases there would, we imagine, be *some* difference. If the allegedly infringing design looks enough like the registered design there is infringement; if not enough, there is none. The field is one which is filled with uncertainty. In such a field the advantage is with the party with strong financial resources.

It is a great misfortune to a financially weak person to be faced with litigation, the outcome of which is very uncertain. It is possible to conceive of a substantial number of designs being registered by large concerns, Canadian or foreign, some of them properly registrable and some of them not, who then bring a number of infringement actions against competitors, some of whom have really infringed, and some of whom have not. This is perhaps an improbable situation, but the possibility of it makes us cautious in our recommendations in respect of design legislation.

2. Arguments For Protection

We turn now to the arguments in favour of design legislation.

The Swan Committee in paragraph 270 of its report says that "the object of the designs legislation is to encourage the production of articles of commerce which possess new or original features of shape, configuration, pattern or ornament". An industrial designer by his skill, talent and industry creates an industrial design which is intended to make articles to which it is applied more saleable, that is, more valuable, than they otherwise would be. He hopes that his activity will create a commercial asset. The design may prove to appeal to the public or it may not. If it does not, he has sustained expense and a loss of time and effort. If it does, it seems only fair and just that he be proportionately rewarded. He may have created the design as an employee of or contractor for a manufacturer. If the design fails to appeal to the public the manufacturer sustains a financial loss. Is it fair that if the design appeals to the public, it should be open to costless appropriation by the manufacturer's competitors? A man should be entitled to reward for creating a commercial asset unless there is some good reason why he should not receive it.

It is sometimes argued that design protection legislation promotes design activity. If this were so, it is not at all obvious that the artistic level of industrial design as a whole would thereby be raised. But it may not be so. Where there is no effective design protection we think that there might be more frequent and rapid changes in design than where there is such protection. Indeed it is possible that strong design protection promotes stability of design rather than activity in design. This of itself might be regarded as a desirable development, as it is hard to see the social utility of constant promotion of obsolescence, however profitable it may be to certain trades and industries. Nevertheless, stability of design cannot be counted on as a net result of design protection, because such protection may promote "designing around" a protected design just as patent protection is said to promote "inventing around" a patented invention. We find it impossible to say with any assurance whether design protection promotes activity or stability, or whether if it does promote activity this raises the general level of design. This leaves the ground of fairness as the only certain justification for design protection legislation.

The National Industrial Design Council, a non-profit body which is active in promoting improved design in Canada, made strong representations to us in favour of design protection by legislation. Since the inception of the Council in 1948 it has held Canada-wide annual competitions for design awards. Early in 1956 the Council sent a questionnaire to over a hundred companies which had submitted entries in 1955, for the purpose of eliciting their opinions on whether

they needed design registration and if so, how they obtained protection of their designs. The Council has supplied us with the following information as to replies:

(1) Of 54 companies answering the questionnaire, 49 said their operations included the original design of new products, and 5 said they only adapted existing designs or had rights to United States designs.

(2) Of 49 companies replying that they produced original designs (usually anywhere from 2 to 20 designs yearly) the answers to the questions were that 31 had the problem of preventing competitors from copying, and 18 had had no trouble of this kind; 39 stated that they found their designs were not normally patentable or did not think they were; 10 were able to patent original features of their products from time to time; 13 stated that, when patent protection was unavailable, they then relied on protection by industrial design registration; 33 stated that they never tried to rely on industrial design registration; and 3 stated that while they used industrial design registration, it was, in practice, giving them no protection.

(3) Of the 33 companies that never used design registration, 8 stated that the present law was ineffective or that court decisions had shown it did not protect designs; 8 stated that the protection it affords was too limited in interpretation to cover the products they designed and produced; 5 stated that the legal procedures involved in trying to enforce protection were too expensive or involved; 5 pled ignorance, "did not know design protection available"; and 7 said that such protection was unnecessary, "styles changed too quickly", "first on the market was sufficient protection", etc.

(4) Most of the 49 companies, including those that had previously said protection was unnecessary or who used patent protection replied "Yes" to the following:

If a different kind of design registration was available that would prevent others from *copying* any of the original features of your new products (not merely features of outer appearance or ornamentation), would you like to see such protection available to you and your competitors? Remember that such design protection, unlike a patent, would not prevent another designer from *independently creating* a similar article.

Only 6 companies said "No" to this. 42 said "Yes", and of the 42 who favoured this change, 32 said it would encourage them to produce more original designs and 35 said it would help stimulate sales of their products. The minority were doubtful as to such additional advantages.

Making due allowance for the selective character of the list of companies to which the questionnaire was sent, it would appear that there is some demand for effective design protection legislation. This conclusion finds support in the character of the representations made to us.

3. Conclusion

On the whole, we think that Canada should have some design protection legislation. And we think it might well follow the form, while departing in many respects from the substance, of the United Kingdom legislation. The United Kingdom Act of 1949 is a recent act and embodies the results of much experience with design protection legislation. Many of its provisions or of their predecessors have been helpfully considered by the United Kingdom courts. We will later consider the provisions of the Registered Designs Act, 1949, (United Kingdom)

section by section and will recommend the adoption of many of the sections. But this does not mean that we think the drafting of our act should necessarily follow closely the drafting of the United Kingdom Act. All we mean by adoption of a section or subsection is the enactment of a provision which is substantially the same. Reference in detail to the United Kingdom Act is by far the most convenient way of expressing the substance of many of our recommendations. We do not consider that the design protection provisions of the United States Patent Act are nearly so helpful.

PART IV

EXCEPTIONS TO PROTECTION

There is one class of designs which in our opinioin should not be protected. These are designs for wearing apparel, millinery and boots and shoes. Prior to the coming into force of the Registered Designs Act, 1949, (of the United Kingdom) designs were divided into classes. Two of these classes were the following:

Class 10—Boots and shoes,

Class 11—Millinery and wearing apparel (except boots and shoes). At that time there was registration by classes but this does not take place under the new United Kingdom Act. In cases of doubt as to the class in which a design ought to be registered, the comptroller was in the old Act given power to decide the question. There is, therefore, a precedent for setting up classes consisting of boots and shoes, millinery and wearing apparel for certain purposes and we think a class to be called "wearing apparel, millinery and boots and shoes" should be set up, with power to the Commissioner of Patents to decide, in case of doubt, whether an article is in that class. If it is, a design applied to that article should not be registrable.

The Gregory Report, referred to in our Report on Copyright, says at page 96, paragraph 261:

As regards the possible protection of a dress under the Registered Designs Act, it has been pointed out to us that it is difficult and in many cases impossible to register a dress design, since the design is usually not sufficiently novel for registration.

It would appear from Appendix "C" that attempts to patent or to defend patents on dress designs in the United States have usually, if not always, failed because they were not the result of inventive steps.

If, as we recommend, Canada enacts legislation making it a defence to an infringement action that the design attacked is not substantially different from the design registered, the question as to whether one design of a dress is *substantially* different from another design of a dress will arise in infringement actions and, we should think, prove virtually impossible to answer.

On the whole we think that the protection of dress design presents so many difficulties that it should not be attempted. The difficulties in respect of millinery design, male apparel and boots and shoes are similar.

PART V

SOME PROPOSALS MADE TO THE COMMISSION

Among the most interesting and thoroughly considered proposals made to us in respect of legislation on industrial designs were the proposals made by Mr. Roy V. Jackson, Patent Attorney of Toronto. Other interesting proposals were made of which we may mention those of Mr. Cecil C. Kent, but these were not worked out as definitely as Mr. Jackson's proposals. After Mr. Jackson's representations were made to us, his proposals were set out with minor modifications in an article written by him entitled "A New Approach to Protection for the Designs of New Products" and published in *The Canadian Bar Review* of April, 1956. As this article presumably expresses Mr. Jackson's later and best considered views on the subject, we will deal with his proposals as found in that article. The main features of the proposals may, as we understand them, be summarized as follows:

(1) Artistic works as defined in the Copyright Act should be extended to include designs.

(2) A design should be defined as meaning any article having an inherently useful function and as including a drawing, model or prototype for a design.

(3) A finished industrial article should be defined as a design that has been produced in quantity by a machine or an industrial process.

(4) All original designs should receive copyright protection under the Copyright Act as artistic works or works of artistic craftsmanship.

(5) As soon as a design becomes a finished industrial article it should cease to have protection under the Copyright Act and should thereafter not be protected at all unless registered under the Industrial Designs Act, with this exception, that when reproduced not industrially it retains its fullfledged copyright protection.

(6) Infringement should be defined as in Section 17 (1) of the Copyright Act. That is to say, industrial design registration should be deemed to be infringed by any person who without the consent of the registrant does anything, the sole right to do which is by the Act conferred on the registrant. It will be noted, however, that if a person makes a design originally which is identical with a registered design he would not infringe, because his design would be an original work even though not new.

(7) Marking should be required as a precondition of infringement actions.

(8) Persons who do not reproduce registered designs but who merely sell them or let them for hire or import them for sale or letting for hire should be very carefully protected. Generally speaking they would not infringe unless they have notice that the design has been registered and registration itself should not constitute such notice.

(9) Putting a design into production a short time before the application for registration should not disqualify it for registration.

(10) A person merely selling or importing for sale should have the right without infringing to sell the stock which he has on hand at the time he receives notice.

(11) What is to be registered is the design, that is, a photograph, drawing, plan, model or other representation of the article constituting the design.

(12) Registration should create no presumption of validity. In an infringement action the burden of proving originality should be on the plaintiff.

(13) A design to be registrable need not be new—it need only be original.

After respectful consideration of the system proposed by Mr. Jackson we have concluded that we cannot recommend the adoption of its main principles for reasons which appear from the following three paragraphs:

We do not think that the Copyright Act should be amended so that every article having an inherently useful function may enjoy copyright as an artistic work or work of artistic craftsmanship. Under the law at present if, for example, a bulldozer were claimed in copyright infringement proceedings to be an artistic work, we should think that the court would hold that it is not an artistic work. The grounds of distinguishing it from a monument may be somewhat difficult to define; but Clauson J. in an English case seemed to be of the opinion that a lady's dress was not capable of enjoying copyright protection as a work of artistic craftsmanship. See Copinger and Skone James on Copyright, 8th Ed., page 67. It would, we think, be departing too far from established copyright principles to enact that copyright may subsist in every article having an inherently useful function.

We do not think that novelty should be dispensed with as a condition of registrability. Theoretically, novelty is not required for copyright. Practically, however, it is. The chance that an original work of the kinds governed by the Copyright Act is old, is one in a million. If copyright were extended to all industrial products, the chance might be one in ten. As stated above, we were told that coincidental design was not uncommon. We think that a person should only be entitled to industrial design protection if he has given something to the public which the public did not have before. This is, generally speaking, the rule with regard to patents. From the practical point of view it is also the rule in the law of copyright.

Under Mr. Jackson's proposals a person would not be infringing a registered design even though he used the identical design provided he could show that it was original with him. We think that this is undesirable. Here again the courts would be led into difficult questions of determining credibility and might often be confronted with false claims of originality.

There are, however, some of Mr. Jackson's proposals which we think are acceptable, as indicated in our detailed recommendations below.

PART VI

DEFINITION OF DESIGN

We would suggest the following definition of design:

"In this Act the expression 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated *wholly or partly* by the function which the article to be made in that shape or configuration has to perform."

The wording of this definition is the same as that of the definition in the United Kingdom Act except that the words "wholly or partly" have been substituted for the word "solely". This apparently minor change would effect an important alteration in the scope of the legislation.

One of the principles of patent law is that a "workshop improvement", as it is often called, is not patentable. An improvement to be patentable must have come about as a result of an inventive step—it must be up to the level of true invention. It has been generally considered that to give exclusive rights to workshop improvements would retard progress rather than promote it. If designs which add to the utility of an article may be registered if they also give the article some individuality of appearance and therefore make an appeal to the eye and are not dictated *solely* by function, is it not likely that the designs legislation will be used as a means of obtaining the equivalent of short term patents on workshop improvements? We should think that almost any improvement in the shape of a wrench, for example,—improvement, that is, from the standpoint of function,—would produce in the wrench a sufficient individuality of appearance to make the design registrable. Bearing in mind the principle of patent law, with which we are in accord, that workshop improvements should as soon as they are made known, be in the public domain, we would rule out as non-registrable as a design any feature or features of shape or configuration which are dictated by function either in whole or in part. If the design has utility it is either patentable (the result of an inventive step) or it is not. If it is not, we would not give it short term protection simply because it was dictated partly by attractiveness or appeal to the eye. If a practicable definition could be worked out which would make a design registrable if the main, principal or primary purpose was that the article be more pleasing to the eye than it otherwise would be, this might be preferable. But such a definition would, we think, be impossible of application by the courts and simply add to the uncertainty which under any definition is bound to surround questions of registrability, validity and whether there was infringement.

It may be noted that, for all practical purposes, shape and configuration may be regarded as synonymous. They both signify the form in which the article is fashioned. Moreover, pattern and ornament can in many cases be treated as synonymous. "A pattern or ornament, though it may stand out to a certain extent from the article to which it is applied, as in embossing or engraving,

may to all intents and purposes be considered as something in two dimensions only, which is placed upon the article simply for the purpose of decoration." Russell-Clarke on Copyright and Industrial Designs, pages 142, 143.

Section 13 (2) of the Trade Marks Act provides that "no registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise". We have considered whether we should not recommend that a design be defined as in the United Kingdom Act with the addition of some such provision as the following: "No registration of a design interferes with the use of any utilitarian feature embodied in the design". It would appear from Bill H.R. 8873, introduced in the United States House of Representatives on July 23, 1957, that this, in effect, is a provision of that Bill. For by Section 9 (d) of that Bill it is provided *inter alia* that "an article embodying only features of the protected design which are dictated by the function or purpose of the article" is not an infringing article.

It would seem to us that to define a registrable design in such a way as to embrace a design which includes both functional and non-functional features and then go on to provide that the functional features are nevertheless not protected, would be less desirable than (as we propose) to provide that no design shall be protected if it includes functional features. As will be noted later, we recommend that it should be necessary for an application to contain a description of the features which the applicant claims as constituting the design. If there are both functional and non-functional features in a design it should be the applicant's responsibility to separate them and apply only for protection of the non-functional features. These, under our proposals, would be the only features which make up a registrable design. If the other principle under consideration were adopted (that which applies to distinguishing guises and which is incorporated in Bill H.R. 8873) what would be the position of a person desiring to make use of the functional features of a registered design which includes such features? To be safe he would have to select, and, at his peril, to select correctly, the functional features or such of them as he might desire to use. If he made a mistake and selected a non-functional feature for use he would infringe. The burden of making a correct selection should not, we think, be placed on him. It should be placed on the registrant. If the registrant claims as his design only the non-functional features, these should be protected. If he claims, as his design, features including both functional and non-functional features, none of the features should be protected. After all, the question whether certain features were dictated by the function or purpose of the article or were dictated by considerations of appearance is a much easier question for the author of the design than for another person who wishes to make use of those features.

Moreover if what we have called the other principle were adopted, particularly if the language in the Trade Marks Act relating to distinguishing guises were used, it would seem to us that it might not be unusual for a court to be confronted with the necessity of deciding whether a functional or utilitarian feature could have been appropriated without appropriating the whole design and that it would not be desirable to impose such a task on a court. We think a preferable principle is that if a design includes a functional or utilitarian feature it is not registrable. This we intend as the principle of the definition recommended.

Perhaps it is unnecessary to add that in no case, whatever the article, should a feature which goes no further than giving or helping to give an article an attractive, artistic or a distinctive appearance be regarded as dictated by function.

The words "but does not include a method or principle of construction" appear in the definition section of the United Kingdom Act and have been criticized. Russell-Clarke on Copyright and Industrial Designs (1951) at p. 154 states:

To say that a shape is to be denied registration because it amounts to a method or principle of construction is meaningless. The real meaning is this, that no design shall be construed so widely as to give its proprietor a monopoly in a method or principle of construction. What he gets a monopoly for is one particular individual and specific appearance. If it is possible to get several different appearances, which all embody the general features which he claims, then those features are too general and amount to a method or principle of construction.

This statement, in virtually the same words, was contained in Russell-Clarke on Copyright in Industrial Designs (1930) and was approved by Luxmoore J. in *Kestas Ltd. v. Kempat Ltd. et al* (1936) 53 R.P.C. 139 at p. 151. The meaning of the words seems to have become pretty well established in the English courts, they at least do no harm, and we think that it cannot be said that they serve no useful purpose.

PART VII

SOME IMPORTANT FEATURES OF LEGISLATION RECOMMENDED

If, then, there should be design protection legislation, what should its main features be?

1. Aesthetic Appeal Unnecessary

We think it quite impracticable to require as a condition of registrability or validity of a design that it appeal to the aesthetic sense or sense of the beautiful. Russell-Clarke in his work on Copyright and Industrial Designs says at page 149:

It has, however, been laid down in decided cases that a design need not possess any artistic merit, and this has never since been disputed. The latter interpretation would be quite untenable, because, though design law ought perhaps rightly to cover only such productions as are actually artistic, in fact an insuperable difficulty would arise if such were the case, namely, the absolute impossibility of judging between what is and what is not artistic, since that which appeals to one man as artistic and beautiful may in no way please another.

As appears from Appendix "C", some of the courts in the United States have grappled with this "insuperable difficulty". But we are clearly of opinion that there should be nothing in Canadian legislation obliging Canadian courts to do so. Where a design is on trial the question to be decided should not be whether it has artistic merit but whether it gives to the article to which it is applied distinctiveness or individuality of appearance when the article is compared with other articles to which the design is not applied. Is it sufficiently distinct from other designs to stand apart?

2. Requirements of Novelty and Originality

Should it be provided that a design shall not be registered unless it is new *or* original (as in the United Kingdom) or should the condition be new *and* original (as in the United States)? We recommend that a provision to the effect of the following be enacted:

A design shall not be registered unless it is new *and* original or if it is the same as a design which before the date of the application for registration has been registered in Canada in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

3. Prior Publication

It should be made clear that a design is new if, and only if, that design or a design from which it differs only in immaterial details or in features which are variants commonly used in the trade has not been *published* before the date of the application, either in Canada or elsewhere.

Publication of a design should be defined as making it available to the public but so as to include showing it to some individual member of the public who is under no obligation to keep it secret.

It should however be made clear that a *design* is not deprived of novelty by reason only that the *features* which constitute it are known or have been disclosed to the public. The features may be old. The novelty of the design may reside in the application of an old shape or pattern to a manufactured article. If they were applied to a manufactured article before the date of application, even though that article is not multiplied by an industrial process, they then should be regarded as a design and if this design was published, either by disclosure of the sketches or models or by showing (by selling, letting for hire or otherwise) the finished article before the application, the design is not new.

It should be made clear that the design may be "applied" to an article before the article is itself manufactured, as for instance when a sketch or model of an article is made in accordance with the design.

In considering publication of a design, however, the three situations in which publication before date of application should not affect the registrability or validity of the design, are:

(1) One situation may arise as a result of Canada's membership in the International Union for the Protection of Industrial Property. The relevant paragraphs of Article 4 of the International Convention for the Protection of Industrial Property are appended as Appendix "E". It will be noted from these that a person who applied for registration of an industrial design in a convention country other than Canada, within six months before he applies in Canada, acquires a right of priority for his application abroad and that his Canadian application is not invalidated "through any acts accomplished in the interval". (Article 4B). If, for example, a proprietor of a design applies for a patent on the design in the United States and immediately publishes it, and within six months from the date of his United States application he applies in Canada for its registration as an industrial design, publication during that six months will not be a bar to Canadian registration. The design will not be deprived of its novelty by the publication. Any new Act should contain provisions recognizing this situation.

(2) Another situation is that which arises when copyright subsists in an artistic work and an application is made by, or with the consent of, the owner of that copyright, for the registration of a corresponding design (i.e., a design which when applied to an article results in a reproduction of that work). As to this situation, we think it should be provided that the design should not be treated as other than new by reason only of any use previously made of the artistic work unless the previous use consisted of or included the sale, letting for hire, or offer for sale or hire, of articles to which the design in question had been applied industrially, and that previous use was made by, or with the consent of, the owner of the copyright in the artistic work. See Section 7 of Part X of our Report on Copyright. (This principle should, however, be qualified to the following extent: Where the corresponding design could not have been registered (because it would not be new) but for the provision recommended in the last sentence and copyright protection expired before the normal date of expiry of design protection, design protection should expire at the same time as the copyright.)

(3) A third situation is that which arises as a result of Article 11 of the International Convention for the Protection of Industrial Property, which is as follows:

1. The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs

or models, and trade marks, in respect of goods exhibited at official, or officially recognised, international exhibitions held in the territory of one of them.

2. This temporary protection shall not prolong the periods of priority provided by Article 4. If, at a later date, the right of priority is invoked, the Administration of each country may date the period of priority as from the date of introduction of the goods into the exhibition.

3. Each country may require, as proof of the identity of the object exhibited, and of the date of its introduction into the exhibition, such evidence as it may consider necessary.

In order to comply with this Article, Canada, if it makes publication before application a ground of invalidity, should enact an appropriate exception in respect of goods so exhibited.

4. Originality

"Original" in any new Act should be given the same meaning as it has in the law of copyright, that is, a design is original if, and only if, it is not copied from another design, the work of someone else. The features which constitute it, if they have not been applied or if the author does not know that they have been applied to a manufactured article, may be copied and the design resulting, in part, from their copying, may still be original. But originality with the author in the making of the design, as a design, should be a condition of registrability and validity.

We were informed that there is some "co-incidental" designing. That is to say, a designer, exercising his own talent, independently evolves a design which is substantially the same as an existing design which he has never seen. The evolved design would, if our recommendations are accepted, be regarded as original. The design might however not be new and thus not be registrable. That would depend on whether the existing design had been published.

5. Term of Protection

The present Canadian Act (Section 10 (1)) provides that the exclusive right acquired by registration for an industrial design is valid for five years but may be renewed for another five.

The present United Kingdom Act (Section 8) provides that copyright in a registered design shall subsist for five years from registration but may be renewed for a second period of five years and for a third period of five years.

The United States Patent Act provides (Section 173) that patents for designs may be granted for 3½ years, 7 years, or 14 years, as the applicant, in his application, elects.

It has been suggested (see Appendix "C") that the term of protection for designs applied to certain classes of articles be different from that applied to others. A variation of the term by classes would involve registration by classes, which was abandoned in the United Kingdom in 1949 when the new Designs Act was passed. The Swan Committee recommended (paragraphs 289 to 295, pp. 58 and 59) that all references to classes be removed from the Act and the Rules. There was overlapping. Applicants were puzzled as to the class in which they should register. If we instituted a system of classification and the length of term were longer for Class A than for Class B and difficulty developed in determining whether an article belonged in Class A or Class B, the inconvenience of the

resulting situation is obvious. We think there should be no variation in term based on the class of the article. Whatever term is adopted may prove to be unnecessarily long for some designs and shorter than would otherwise be to the advantage of the proprietor for others. Our impression is that industrial designs do not remain especially popular for many years except in rare cases and we think that protection for seven years should be sufficient as a maximum. The submission of the National Industrial Design Council was that the term of protection should be 2½ years, 5 years, or 10 years at the applicant's option. We think, however, that if the applicant could receive 3 years' protection with the right to renewal for another 2 years, and to a second renewal for another 2 years, this would be reasonably adequate as to term from the applicant's standpoint; and trade and industry would not be in danger of the harassment after seven years which the existence of registered designs makes possible, even if they are little used. And we think that each renewal fee should be at least as high as the registration fee so as to discourage unnecessary prolongation of the period of protection.

6. Marking

The present Canadian Act contains drastic marking provisions. It provides (Section 14 (1)) that in order that any design may be protected, the name of the proprietor shall appear upon the article to which his design applies by being marked, if the manufacture is a woven fabric, on one end thereof, together with the letters Rd., and if the manufacture is of any other substance, with the letters Rd., and the year of registration at the edge or upon any convenient part thereof, and it further provides (Section 14 (2)) that the mark may be put on the manufacture by making it upon the material itself, or by attaching thereto a label with the proper marks thereon.

This section is contrary to Article 5D of the International Convention for the Protection of Industrial Property and should be repealed. Article 5D is as follows:

No sign or mention of the patent, of the utility model, of the registration of the trade mark or of the deposit of the industrial design or model shall be required upon the product as a condition of recognition of the right to protection.

The question is what, if any, marking provisions should take the place of the present marking provisions.

Section 9 of the United Kingdom Act is as follows:

9. (1) In proceedings for the infringement of copyright in a registered design damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the marking of an article with the word "registered" or any abbreviation thereof, or any word or words expressing or implying that the design applied to the article has been registered, unless the number of the design accompanied the word or words or the abbreviation in question.

(2) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of copyright in a registered design.

This section is very much like the section of the United Kingdom Patents Act, 1949 (Section 59) exempting innocent infringers of patents from damages. We recommend the adoption of subsection (1) and that there be no other reference to marking in the Act. As to subsection (2) certain considerations arise which will be discussed later.

PART VIII

INFRINGEMENT AND REMEDIES FOR INFRINGEMENT

What should constitute infringement of copyright in a registered design?

Section 7 (1) of the United Kingdom Act provides that "the registration of a design under this Act shall give to the registered proprietor the copyright in the registered design, that is to say, the exclusive right in the United Kingdom and the Isle of Man to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything for enabling any such article to be made as aforesaid, whether in the United Kingdom or the Isle of Man or elsewhere".

From this it appears that it is an infringement for any person (without the license of the proprietor of the design)

- (1) to make for sale or for use for the purposes of any trade or business any article in respect of which the design is registered, to which article the design or one not substantially different has been applied;
- (2) to import for sale or for use for the purposes of any trade or business any such article;
- (3) to sell, hire, or offer for sale or hire any such article;
- (4) to make anything for enabling any such article to be made as aforesaid.

(1) and (4) relate to infringement by manufacturers (to be referred to as Class (1) and Class (4) respectively).

(2) relates to infringement by importers (to be referred to as Class (2)).

(3) relates to infringement by vendors and those letting for hire (to be referred to simply as vendors—and as class (3)).

We regard Class (1) as the most important class and the one a person usually has in mind when he thinks of infringement. It seems to us that the provisions of Section 7 of the United Kingdom Act with regard to this class should, *mutatis mutandis*, be adopted and that it should be an infringement for anyone (except, of course, with the consent of the registered proprietor) to make in Canada for sale, or for use for the purposes of any trade or business, any article in respect of which the design is registered, being an article to which the registered design, or a design not substantially different therefrom, has been applied.

We think, however, that there should be some exemption of innocent infringers from damages. Section 9 of the United Kingdom Act is quoted above, and, as stated, we recommend the adoption of subsection (1) of that section. Theoretically it might be said that knowledge of the contents of the register at all times should be attributed to every person whom those contents might concern. But this would, we think, be placing too heavy a burden on manufacturers generally—a burden that should be lightened to the extent recommended. We think also that a provision to the effect of subsection (2) of Section 9 would be desirable as applicable to Class (1), but that it should be provided

that it will not be an infringement for an innocent infringer (one who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered) to dispose of the articles which he made while he was an innocent infringer and which are still on hand. If he were heavily stocked with such articles and could be restrained by injunction from disposing of them, the loss inflicted on him thereby might be very great. An injunction should, of course, be available to restrain him from making any additional articles to which the registered design is applied. He should not be allowed to go on infringing by manufacturing.

As to Class (2), importing for sale or for use for the purpose of any trade or business, provisions to the effect of subsection (1) of Section 7 of the United Kingdom Act should also be enacted. If, however, the importer proves that at the time of importation, or if before that time he bound himself by contract to accept the article on importation, then if at the time he bound himself, he was not aware and had no reasonable ground for supposing that the design was registered, he should not be liable to have damages awarded against him. Moreover, in such cases, it should not be an infringement for him to dispose of the goods imported. He should, however, be restrainable by injunction from importing any more goods bearing the registered design or one not substantially different therefrom.

In Class (3), vendors, are included wholesalers, retailers, etc. We think that unless it is proved that a person in this class, at the time he ordered the infringing article, or, if he did not order it, accepted it, knew or had received notice from the registered proprietor that the design was registered, and also knew or had received notice from the registered proprietor that the design was not applied to the article with the consent of the registered proprietor, there should be no infringement by his selling, hiring or offering for sale or hire, the article. If such proof is made, his sale, etc., should be an infringement—provided however that it should not be an infringement for him to sell, etc., any articles which a manufacturer or importer has the right to dispose of without infringement.

As to Class (4), we see no need for making persons in this class infringers.

PART IX

OTHER RECOMMENDATIONS (CONSIDERED WITH REFERENCE TO UNITED KINGDOM ACT)

The remaining features of the legislation which we recommend may conveniently be considered by examining the United Kingdom Act as passed in 1949 (attached hereto, without its schedules, as Appendix "D"), by reference to individual sections.

1. Registrable Designs and Proceedings for Registration

SECTION 1

Subsection (1). This should be adopted.

Subsections (2) and (3). The substance of these subsections is dealt with above.

Subsection (4). The exclusions provided for by rule under the United Kingdom Act are as follows:

(1) works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process;

(2) wall plaques and medals;

(3) printed matter primarily of a literary or artistic character, including book-jackets, calendars, certificates, coupons, dressmaking patterns, greeting cards, leaflets, maps, plans, postcards, stamps, trade advertisements, trade forms, and cards, transfers and the like.

We recommend that these exclusions be adopted by rule to be made by the Governor in Council. While much difference of opinion may arise as to what should or should not be included in a list of exclusions, we have no suggestion of improvements to be made in the list adopted by the United Kingdom rule.

We recommend that there be a statutory exclusion of wearing apparel, millinery, and boots and shoes, the Commissioner of Patents to be given the power to decide in a case of doubt whether an article is in that class. Consideration might be given to the advisability of providing for an appeal from his decision.

SECTION 2

This section should be adopted.

SECTION 3

This section should be adopted. The section raises the following questions:

(1) What should be the form of the application? We think that the rules should provide as follows:

(a) Every application shall contain a description of the features which the applicant claims as constituting the design. (There is no reason why this description should not be called a claim. It would be much the same as the statement of novelty required by the rules under the United Kingdom Act. See Russell-Clarke pp. 180 to 185.)

(b) But this description may consist of a representation of the design accompanying the claim. For example, the applicant may claim the design as shown in the representation. In that case, if the representation were of the article as a whole it would not be an infringement to take any special feature of the design and copy it unless the thing as a whole were taken.

(c) There shall be only one claim.

(d) The applicant may claim the shape in one application and the pattern in another. (The shape might have an advantage over existing shapes which arguably lies wholly or partly in the way in which it causes the article to function and might for this reason, although new and original, not be registrable. In that case the applicant could claim the shape and the pattern separately so that if his application for the shape design is refused, or if not refused is later held invalid, his pattern design will not go down with it.)

(e) The application shall contain or be accompanied by a statement of originality made by the author.

(2) To whom should the appeal lie?

We think the appeal should lie to the same court or tribunal as that which has jurisdiction to hear an appeal from the refusal by the Commissioner of Patents to grant a patent.

SECTION 4

This section should be adopted.

SECTION 5

As, under our recommendations, designs which include any functional or utilitarian feature are not to be registrable, we see no need for this section. It is true that in some cases the registrar may improperly register, and thereby enable to be made public, designs having defence utility, but the necessity of legislation to deal with these exceptional cases is not obvious.

SECTION 6

Subsection (1) (a) and (b) should be adopted. We see no necessity for (c).

Subsection (2) should be adopted because of Canada's convention obligations, the Governor in Council to be substituted for the Board of Trade.

Subsection (3) should be adopted.

A subsection should be added giving effect to the recommendation in the paragraph beginning with (2) in Part VII 3 above (down to the parenthesis).

2. Effect of Registration, Etc.

SECTION 7

Subsection (1). The substance of this subsection is fully dealt with above.

Subsection (2). We see no reason for adopting this subsection. The appropriation of registrable designs by the Crown—designs which have no utility advantage over existing designs—is likely to be on so limited a scale, if it takes place at all, that legislative provisions regarding it are, we think, unnecessary.

SECTION 8

This section, as indicated above, should be adopted, the terms being three years, two years and two years, instead of five, five and five.

A subsection should be added giving effect to the recommendation in the parenthesis at the end of the paragraph beginning with (2) in Part VII 3 above.

SECTION 9

The substance of this section is fully dealt with above.

SECTION 10

While we do not regard the principle of this section as very important, we recommend its adoption. There might be cases, particularly of foreign applicants, who would register valuable designs in Canada, and neither apply them to articles in Canada or permit them to be applied to articles in Canada. This section provides a safeguard against this.

The appeal should lie to the same court or tribunal as that to which an appeal lies from the refusal of an application for registration.

SECTION 11

Subsection (1). This should be adopted.

Subsection (2). This should be adopted *mutatis mutandis*.

We think that there should also be a provision here for cancellation by the registrar (on the application of any person interested) of a design which has expired by reason of the circumstances mentioned in the parenthesis at the end of the paragraph beginning with (2) in Part VII 3 above.

Subsection (3). This should be adopted.

SECTION 12

This section we think is unnecessary.

3. International Arrangements

SECTION 13

Subsection (1). This subsection should be adopted.

Subsections (2) and (3). The necessity of adoption by Canada of the principle of these subsections is not obvious; but there should probably be some statutory provision for defining "country" as used in subsection (1).

SECTION 14

Subsections (1) and (2) should be adopted.

Subsection (3) should be adopted; the words "in the United Kingdom or the Isle of Man" being omitted.

Subsection (4) should be adopted.

SECTION 15

We see no necessity for this section.

SECTION 16

While we regard this section as of small importance, we recommend its adoption *mutatis mutandis*.

4. Register of Designs, Etc.

SECTION 17

This section should be adopted *mutatis mutandis*.

SECTION 18

This section should be adopted.

SECTION 19

This section should be adopted *mutatis mutandis*.

SECTION 20

The principle of this section should be adopted, the court to mean the Exchequer Court of Canada.

SECTION 21

This section should be adopted.

SECTION 22

Subsection (1) should be adopted but all the words before the words "the representation" should be omitted.

Subsections (2) and (3) should not be adopted.

Subsection (4) should be adopted.

SECTION 23

This section should be adopted.

SECTION 24

This section should be adopted.

5. Legal Proceedings and Appeals

SECTION 25

Subsection (1). This subsection should be adopted but the sixth word should be "a" instead of "the" as we think that provincial courts should have jurisdiction as well as the Exchequer Court.

Subsection (2). We recommend that this subsection be amended so as to read as follows or to the effect of the following:

Where any such certificate has been granted, then if in any subsequent proceedings before a court for infringement of the copyright in the registered design or for cancellation of the registration of the design, a final order or judgment is made or given in favour of the registered proprietor, the court may award him his costs as between solicitor and client.

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

SECTION 26

This section should be adopted and a subsection should be added providing that if the person threatening does not take proceedings for infringement within one month after the threat, he shall not be entitled to recover damages in respect of infringements taking place between the end of the month and the time when he takes proceedings.

SECTION 27

This section is not applicable.

SECTION 28

It should be provided that any appeal from the registrar shall be to the same court or tribunal as that to which an appeal lies from the refusal of an application for registration.

6. Powers and Duties of Registrar

SECTION 29

This section should be adopted.

SECTION 30

Subsection (1). This subsection should be adopted but the last eleven words should be omitted.

Subsection (2). This subsection should be adopted *mutatis mutandis*.

SECTION 31

Subsection (1) should be adopted *mutatis mutandis*.

Subsection (2) should be adopted *mutatis mutandis*, the words "Exchequer Court" being substituted for "Supreme Court".

SECTION 32

This section should be adopted *mutatis mutandis* but with the addition to subsection (2) of a proviso to the effect that any member in good standing of the bar of any province of Canada shall be recognized by the registrar as an agent in respect of any business under this Act.

7. Offences

SECTION 33

This section is not applicable.

SECTION 34

This section should be adopted but with the last two words changed from "a misdemeanour" to "an offence punishable on summary conviction". A person convicted under this section would then, by virtue of Section 694 (1) of the Criminal Code, be liable to a fine of not more than five hundred dollars or to imprisonment for six months or to both.

SECTION 35

This section should be adopted but with the substitution of the words "twenty dollars" wherever the words "five pounds" appear.

8. Rules, Etc.

SECTION 36

Subsection (1) should be adopted *mutatis mutandis*.

Subsection (2) should not be adopted.

SECTION 37

Provision for publication of rules in the *Canada Gazette* should be made.

SECTION 38

This section is unnecessary and inapplicable.

9. Supplemental

SECTION 39

This section should be adopted *mutatis mutandis*.

SECTION 40

This section should be adopted *mutatis mutandis* and it should provide that the fees paid in respect of each application for extension shall be at least as high as those payable in respect of the original application.

SECTION 41

This section should be adopted. It may be that there should be additional provisions that the mailing date shall be deemed to be the filing date in the case of some or all notices, applications and other documents, at least in cases where the mailing is by registered post. This, however, is a question upon which we wish to reserve our recommendation until we make our Report on Patents where similar questions will arise and as to which representations have been made to us.

SECTION 42

This section should be adopted *mutatis mutandis*.

SECTION 43

This section should be adopted but subsection (2) may be unnecessary.

SECTION 44

There should, of course, be an interpretation section. The definitions in subsection (1) of this section all seem appropriate and applicable *mutatis mutandis* except those of "Appeal Tribunal", "court", "Journal" and "registrar". "Registrar" should be defined as meaning the Commissioner of Patents.

Subsections (2) and (3) should be adopted.

Subsection (4) should be adopted as far as applicable.

In addition to the provisions of the Registered Designs Act 1949 (United Kingdom) as it appears in Appendix "D", certain amendments to Sections 6, 8, 11 and 44 were enacted by Section 44 of the Copyright Act 1956 (United Kingdom). In so far as we have considered it to be necessary we have had regard to these amendments in the foregoing recommendations.

SECTIONS 45, 46 AND 47

These sections are inapplicable.

SECTIONS 48 AND 49

A suitable section providing for repeals, savings and transitional provisions must of course be enacted as should also a section providing for short title and commencement.

PART X

RELATIONSHIP BETWEEN INDUSTRIAL DESIGNS AND TRADE MARKS

Our terms of reference include Trade Marks as well as Patents, Copyrights and Industrial Designs and we think it appropriate here to recommend an amendment to the Trade Marks Act in respect to applications for registration of distinguishing guises which may have been registered as industrial designs.

A distinguishing guise is defined in Section 2 (g) of the Trade Marks Act as follows:

(g) 'distinguishing guise' means

- (i) a shaping of wares or their containers, or
- (ii) a mode of wrapping or packaging wares the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

A distinguishing guise is a trade mark: Section 2 (t).

Section 13 of the Trade Marks Act is as follows:

13. (1) A distinguishing guise is registrable only if
 - (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration, and
 - (b) the exclusive use by the applicant of such distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry.
- (2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.
- (3) The registration of a distinguishing guise may be expunged by the Exchequer Court of Canada on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

It will be noted that if our recommendations with regard to Industrial Designs are accepted and no amendment is made to the Trade Marks Act, it will be possible for some registered designs to be registered also as distinguishing guises. The following state of facts will be possible: A person registers a shape or configuration design or one including features of shape or configuration. He then under the protection of the Industrial Designs Act uses the design in Canada so that the design, or these features of it, becomes distinctive of his product. He then applies for registration of the design, or these features of it, as a distinguishing guise.

This, in our opinion, should not be possible. He should not be permitted under the cover of his design monopoly to build up distinctiveness of his design, or these features of it, so that it or they can be registered as a distinguishing guise and thereby prolong his monopoly beyond the period of the design protection.

We think that after a design has been registered no person should be entitled to register this design, or any features thereof, as a distinguishing guise until the expiration of, say, three years after the design protection expires. If at that time

it is still distinctive because others have not used it, the applicant should **not** be debarred by this provision from registering it as a distinguishing guise. But if others have used it so that it is not distinctive the applicant should be so debarred.

We recommend that the Trade Marks Act be amended accordingly.

All of which is respectfully submitted.

Dated at Ottawa
this first day of June, 1958.

(Signed)

J. L. ILSLEY,
(Chairman),

GUY FAVREAU,
W. W. BUCHANAN,
Commissioners.

Appendix A

INDUSTRIAL DESIGNS

1. Have you any recommendations to make, consistent with the public interest, which, in your opinion, would stimulate Canadian artistic talent in the field of industrial designs?

2. If new legislation is desirable, what, in particular, are your views respecting
- (a) the definition of a "design" upon which any new legislation might be based;
 - (b) the term of protection considered adequate to encourage and reward the creator of a design;
 - (c) compulsory licensing of designs or other methods to protect the public against misuse or abuse of any right in an industrial design;
 - (d) safe-guarding the creator or proprietor against pirating of designs, and penalties therefor;
 - (e) registration and marking requirements?

3. Apart from the above, are there any other matters relating to present industrial design legislation, or to the practice and procedure thereunder, which might be altered to promote an efficient statute, satisfactory to the profession and to industry and in the public interest?

OTTAWA, Canada,
August 20th, 1954.

Appendix B

<i>Persons or Bodies Making Representations</i>	<i>Representatives (Where Representations made Orally)</i>
Association of Canadian Industrial Designers	Henry Finkel
Ayerst, McKenna & Harrison Limited	
Board of Trade, City of Toronto	Dr. Harold G. Fox, Q.C.
Canadian Electrical Association Incorporated	
Canadian Manufacturers' Association	<div style="display: flex; align-items: center;"> { <div> Dr. Harold G. Fox, Q.C. H. W. MacDonnell F. W. Hamer George Leetham </div> </div>
Canadian Refractories Limited	
Englesmith, George	Roy V. Jackson
Fairweather, S. W.	
Fox, Dr. Harold G., Q.C.	
Furniture Manufacturers' Association	
International Association for the Protection of Industrial Property (Canadian Group)	Christopher Robinson, Q.C.
Jackson, Roy V.	
Kent, Cecil C.	
National Industrial Design Council	<div style="display: flex; align-items: center;"> { <div> Raymond A. Robic D. W. Buchanan Roy V. Jackson </div> </div>
Patent Institute of Canada	
Reliable Toy Co. Limited	
Registrar of Trade Marks	
Supreme Aluminum Industries Limited	H. V. L. Lush
Trade Marks, Patents and Design Federation (U.K.)	

Appendix C

MEMORANDUM FOR THE ROYAL COMMISSION ON PATENTS, COPYRIGHT, TRADE MARKS AND INDUSTRIAL DESIGNS ON THE PROTECTION OF INDUSTRIAL DESIGN

by Walton Hamilton

I

STATEMENT OF THE QUESTION

The task of securing to an author or inventor for a limited time an exclusive right in his industrial design is as unique and inviting as it is beset with difficulties. The two words which together specify the object of legal protection are not in perfect harmony; for "industrial" is a word endowed with commercial significance, while the word "design", suggesting symmetry of line runs towards the artistic. The nearest synonym to design is "pattern", and the wide coverage of "design" is here restricted to its industrial employment.

But lack of clean-cut identity marks only the beginning of difficulties. It is the form, the mold, the shape, the silhouette, the sensory appearance, rather than the tangible article of commerce itself for which legal protection is sought. It is the permutation of line and shape which as a stimulus invites visual or tactual response. The design is sharply to be separated from the article to which it is affixed or upon which it is impressed. It has nothing to do with the function which that article serves, or of the utility which it possesses. The shaping, for example, which is essential to fitting a hammer or a can opener or a loud-speaker to the work it is intended to do, is excluded from design. The lines, shapes or configurations which make up industrial design may attract the buyer, but for the purpose at hand the design must be judged in isolation. Utility sets at least rough limits to variation in form and shape, and such functional lines lie within the public domain. So it is only where use and function do not dictate that industrial design invites legal protection in its own right. The line between the command of function and the freedom accorded to artistry is almost of necessity an evasive one.

Again, the separation of design from function is only the beginning of distinction. In this domain, as in others, the author or inventor is entitled at most only to the protection of his own creation. Yet the art or craft which he practices may be old, and the product which he makes and sells has over the decades been offered to the public by a host of others. Among the producers of a ware of trade there have usually been individuals who, not content with the commonplace forms dictated by sheer utility, have attempted to give distinctive appearance to the lines of merchandise which bear their names. All such patterns are set down as "the prior art". If its owner is to be given an exclusive right, the industrial design must be different from anything which has gone before. In an area of the economy where there have been few manufacturers, this requirement of novelty may be easily met; in a domain in which types and brands have been legion, it is difficult. A distinctive design is easier to effect in connection with a commodity just coming into use than with one which has long been established. In many industries the spirit of competition is, and long has been, keen, and ingenuity

and imagination have given to merchandise an allure which is all its own. In any case, the design which seeks protection needs to be compared with others—often with a host of others—of its own kind. An exclusive right is to be accorded only where clearly there is distinction, and the criteria by which distinction is to be judged are not obvious or even easy to formulate.

A like difficulty lies in the vast and amorphous ambit of industrial design. The law's protection is most easily accorded where uniformness prevails among the members of a class, or the units which make it up may with justice be treated alike. A sales tax, for example, may at a single rate be applied to a host of articles of merchandise without inviting a challenge as a denial of that equality which the law is supposed to give. But it is almost impossible to think of a class of phenomena which are more heterogenous than industrial designs. These designs—as the illustrations in the pages below will attest—are to be found in almost every domain of the economy. They vary in form from a simple geometric design involving only a few lines to the most elaborate configurations which three dimensions can produce. They are impressed upon, attached to or in some way made inseparable from a great diversity of wares of trade apart from which no one of them would have a reason for existence. At one extreme is the shaping of an ephemeral article, such as artificial flowers for dress decoration; at the other extreme lie the stately lines of an electric refrigerator and the contours given to a pre-fabricated house. The articles upon which industrial designs are impressed stretch away in an interminable series from the most perishable to the most durable of goods. The identity of the article itself may remain quite stable, or it may be subject to the fickle commands of high fashion. The author or owner may want a distinctive design which will stand him in stead for years, or even for as long as he remains in a distinctive line of business, or he may—like the dress manufacturer—demand protection for an indefinite series of designs, each valuable to him only over an initial period of several weeks or months. Here is the kind of diversity which is hard to grapple with in shaping a system of protection; for equality before the law as well as effective administration demands a system of control which is as uniform and uncomplicated as possible.

There is a difficulty, too, in setting down in clean-cut terms the objective which the protection of industrial design should serve. The word design cannot be kept free of art. The authors of industrial designs are intent upon giving to wares of trade an appeal which otherwise they would not possess. The aesthetic then, with its lack of definite standards, is present, and must be reckoned with. But the very uncertainty of aesthetic standards suggests either a compromise with art or the setting up of a more practical objective. The latter is to be had through the mere insistence that the design in which its author is to enjoy an exclusive right need be no more than distinctive; that it is enough that it stands apart from all others. In such a case logic seems to demand that the security granted be for the life of the design. In the former case, where its objective is to be set down as the promotion of the decorative arts, the limited time has its proper justification. So long as the objective is unclear or confused, an additional difficulty will be added to those just recited. The one road leads towards the treatment of industrial design as if it were a trade-mark; the other as if it were an invention.

In any case the formulation of a system of legal protection for industrial design presents its distinctive challenge to public policy. A recognition of the

character of the problem and the difficulties which attend it are essential to its solution.

II

ANCIENT RITES IN SIGN AND SYMBOL

The historical origins of industrial design antedate recorded history. The eye appeal and the distinctive image were being used as symbols of identification before writing was known. The tools, devices and weapons which come from kitchen middens and like sources reveal not mere articles of utility, but reveal shapes and forms which give distinction and impart individuality. The three Latin words *In Hoc Signo* date back to days before the Roman legion became famous, and the symbols of the various legions are numerous enough to fill a museum. In the Middle Ages, when literacy was a separate craft and an ability to write conferred benefit of clergy, signs which would delight the eye and attract attention were universally in use. The common inn bore its sign of the Red Bull, the Goat and Compasses or the Elephant and Castle. The striped pole attested the presence of the shop of the surgeon barber. The nobleman had his coat of arms, and the vassal in his service wore his master's livery. The livery of knighthood, especially the shield, was made resplendent and distinctive and there arose the Herald's College as an institution whose function it was to give authoritative recognition to family coats of arms. Each member of a trade was in the habit of imposing upon the ware which left his shop a distinctive mark, plain or decorative in character. This served the double purpose of telling the customer where good work was to be had, and of making it easy for the customer to return a defective article to its maker. The cattle brand, the book plate, the crest of arms, are typical of modern optical devices intended to identify an object and to distinguish it from others of its kind. In these and like cases the symbol was an undifferentiate thing which served a number of purposes. From it there has been derived the modern usages which cluster about the trade name, the trade-mark, the commercial symbol and industrial design.

From time immemorial the symbol—whether literal, geometrical or pictorial—has served alike as a means of identification and a mark of distinction. So it has been commonly recognized that every man has a right to impose upon that which is his own, whether by ownership or by manufacture, a sign which imparts this knowledge to the public. Here as elsewhere the line of development is from common usage into the common law into the statute, and this seems to have been the route taken by the idea that the law may do something to accord to its originator or its owner protection of a design which is of his contrivance.

Although our search has not been exhaustive, the first legislative act whose provisions may be read as comprehending industrial design was the Statute of Monopolies passed in 1623. This Act was an aspect of the struggle to abate the royal prerogative and severally to limit the power of the Crown to issue letters patent of monopoly. Although industrial design is not specifically referred to, the protection accorded to a trade new to the realm carried with it, at least to some extent, a legal vesting of the maker in the distinctive form and shape of his articles of manufacture.

In a sense, however, the protection of sign, symbol and design is of statutory origin. It is only through legislative definition that standards can be set up, lines sharply drawn about the coverage of protection, and an adequate scheme

of remedies provided. But in a more real sense it is old, for the law intrudes as an institution to put the police power of the state back of common usage.

III

THE CASE OF ENGLAND

The English statutes contain no statement of the purpose which the legal protection of industrial design is intended to serve. Before 1883 the field of industrial design was covered by two separate statutes. The one was concerned with purely artistic design; the other with designs for the shape or configuration of articles of utility. (Halsbury's Laws of England, Second Edition, Vol. 32.) In 1883 the Artistic Design's Act, statute of 1842, 5 & 6, Victoria, Chapter 100, and the Configuration statute, Act of 1843, 6 & 7, Victoria, Chapter 65, were merged into the patents and design and trademark act (Act of 1883, 46 & 47, Victoria, Chapter 57). The merger was not hard to effect, for if utility is dropped out of the picture, the protection of shape, form and configuration comes to be of a kind with that given to artistic design. The result is a form of legal protection which is sharply limited to design and from which all traces of the practical uses to which articles are put are eliminated. In the light of experience and with the progress of the art of design, the Act of 1883 was amended in more or less substantial fashion, in 1907, 1914, 1919, 1928, 1932, 1938, and 1946. In 1949 the sections of this act concerned with industrial design were separated, subjected to revision in detail rather than substance, and given a separate identity as the Registered Design Act of 1949.

1. *The English Statute.* The law for the protection of industrial design is sharply separated from that which governs the exclusive right for invention. The device employed is that of registration, subject to a broad administrative discretion rather than the issue of letters patent. A design may be registered in respect to "an article or set of articles specified in the application." This application must be made by "the proprietor" of the design. If the author of the design has not transferred it to another party, it is assumed that he is the proprietor. If he has alienated his design, or if he has produced the design when in the employ of, or has been paid by another party, it is that other party which for the purpose of registration is to be regarded as the proprietor. If the claim is made by a person other than the rightful party, the real proprietor may assert his rights through any legal procedures open to him.

The requisites for registration are written in negative rather than in positive language. A design shall not be registered under the provisions of this act "unless it is new or original". In particular, it is not subject to registration "if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article, or differs from such a design only in immaterial details or in features which are variants commonly used in the trade." In the Act the word "design" is defined as comprehending "features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye." It is specifically set down that the "design" for which protection is sought "does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article

to be made in that shape or configuration has to perform." (Section 1, sub-sections 2 & 3.)

To be eligible for registration the design to be registered must be "new or original" and must not comprehend any design which belongs to the prior state of the art. The accent here falls upon the difference between the design which it is sought to register and any design which has been previously used. There is no demand for "a flash of genius," a product which rises to the "heights of invention," or of the thing which only the unusual individual can produce. In fact, there is no requirement of creative effort, however meager. It is enough that it be new or original and clearly distinguishable from anything offered by the previous state of the art. So far as the language goes, the demand can be met by permutation of symbols, figures, or even of lines, provided that particular permutation has not been used before. Here the law of industrial design stands on its own feet. It does not represent an attempt to carry the patent law into a field to which it is not native. It avoids the difficulties of judgment and administration which are inseparable from the application of the criteria of invention or beauty. A mere variant of a prior design, however, or a number of variants on a common theme do not exhibit that newness or novelty which makes them eligible for registration.

The statute defines with painstaking care the orbit of the industrial design which is subject to legal protection. Such protection is limited to "features of shape, configuration, pattern or ornament." It is set down in specific terms that the protection does not extend to the "method or principle of construction" or to such "features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform." In a word, anything that has to do with office, performance, function or utility lies beyond the scope of any protection which the statute affords. The industrial design which is the object of legal solicitude is thus limited to what can be seen—"features which appeal to and are solely to be judged by the eye." Moreover, the judgment by the eye is not that which emerges after a study of detail or severe scrutiny. It is the kind of judgment which is made by giving the industrial design the "once-over". Inasmuch as a requisite for registration is that the design must be "new or original", a comparison must be made of the design which is sought to be registered, and the design or designs nearest akin to it which are already in use. Here then there is no break with tradition. The judgment of the eye by a casual rather than a studied look is exactly that which was made back in the Middle Ages when signs or symbols were employed as marks of identity. But even within such limitations the law here operates with less than precise standards. The test of appeal to the eye and the distinctions which the eye makes seem definitive. The human eye as yet has not been standardized, and there are many intermediate points between the casual look and the studied visual analysis. The words too which appear over and over again in the statute, such as design, shape, configuration, pattern, ornament, novelty and original, are alike in having no fixed contours. In general, the legal dictionaries give no definitions for such words, and when reference is made to the ordinary dictionaries of English usage, the net result is a run-around from one word to another until one gets back to the word with which one started. For example, if one starts with configuration, the trail leads on to such terms as design, form, shape or pattern, and ultimately back to configuration, so one returns from the verbal journey no wiser than when the search began. Nor have the courts been more successful than the makers of dictionaries in appointing boundaries to the statutory terms. Thus we are told

that "the word design must be taken to be used in its ordinary signification of something marked out—a plan or representation of something." *In Re Clarke's Design* (1896) 2 Chancery 38, p. 43. Again, "The design is the conception, suggestion or idea of a shape, picture, device or arrangement which is to be applied to the article. It is a suggestion of form or ornament to be applied to a physical body. It must be new or original." *Dover, Ltd. v. Nurnberger Celluloid Waren Fabrik Gedruder Wolff* (1910) 2 Chancery 25, 28. There are few fields of the law where in drawing the line between the permissive and the prohibited the standards of judgment exhibit such an absence of precision as they do here.

2. *The Procedure of Registration.* The Industrial Design Act is applicable throughout the United Kingdom and the Isle of Man. Its administration is entrusted to the Patent Office in the Board of Trade. The principal office is located in London and there is a branch office in Manchester, the operations of which are limited to the registration of designs in the field of textiles. The actual work is carried on in the Designs Registry of the Patent Office, a division separate and distinct from the other activities of that office. The personnel of this division is distinct from the staff which handles patent applications and its members are specialists in the work they do. In the office of the Designs Registry the work is broken down into relatively minute fields, and each member of the staff has his distinctive domain. As a result, papers are processed with great dispatch, and there is far less hazard than in the United States that a design will become obsolete before it can be properly registered.

The procedure to be followed in securing the registration of a design is outlined in the statute and reduced to detail in the Designs Rules. The statute states that the application is to be made upon the proper form and presented to the Patent Office in the proper manner; the Designs Rules present a series of forms adapted to different types and set forth in detail the various steps which the applicant must take. The applicant must assert that he is the proprietor of the design he wishes to register, and name the article or articles to which it is to be attached, or upon which it is to be affixed. Except where the design is to be employed upon "textiles, wallpaper or lace," the application must be accompanied by a statement of "the features of the design for which novelty is claimed." Where it is proposed that a design be imposed upon a number of articles, a separate application must be made in respect to each of these articles, and each application must go forward in a separate proceeding. A re-design or a variation of an old design—if the character of the latter is left unchanged—must be accompanied by the serial number of the original registration. By reference to the former proceedings, time and labor are saved, and the application is hurried on its way. A single application may be made for a design to be imposed upon a set of articles which are of like kind or which are complementary. A typical example would be an aluminum water pitcher and a set of aluminum tumblers. In procedural matters the registrar enjoys a wide zone of discretion. In an enumeration of his powers the word "may" appears over and over again. Thus, "For the purpose of deciding whether a design is new or original the Registrar may make such searches, if any, as he thinks fit." The Registrar is also given an alternative, "He may refuse any application for the registration of a design or may register the design in pursuance of the application subject to such modification, if any, as he thinks fit." In general, if an application is in order and is not otherwise objectionable, the Registrar has discretion as to whether or not to register it. *T. A. Blanco White, Patents for Invention and the Registration of Industrial*

Designs, 2nd Ed. p. 232 (1955). An appeal, however, lies to the proper tribunal from any decision of the Registrar in respect to the acceptance or rejection of any application. In general the registration is dated from the day upon which the application is filed, but at his discretion the Registrar may fix an earlier or a later date, in accordance with the circumstances of the particular case. In any event, the proprietor of the design cannot sue for infringement because of any act occurring prior to the date upon which the certificate of registration is actually granted.

An initial registration of an industrial design runs for a period of five years (§8 of the Registered Designs Act of 1949). The registration may be extended for two additional periods of five years each. To secure the extension the proprietor of the design must file an application in the form set up in the Designs Rules of 1949. Application for such extension must be made before the expiration of the five-year term for which the registration was last granted. The required fee must be paid before the end of the period for which registration was last effected, or, with permission of the Registrar, within an additional period not to exceed three months. There is to be no renewal of registration of a design at the expiration of a fifteen-year period.

3. *The Case Law.* Although the statute granting protection to industrial design has been several times amended, the continuity of doctrine has been little disturbed. For the most part the amendments have carried into the statute the results of administrative experience. The amendments have caught up language from cases and have consolidated holdings into the body of the law. For this reason, quite irrespective of their particular dates, the cases on the subject constitute a single, consistent and coherent body of law.

The law on industrial design was largely fashioned in the last half of the nineteenth century. As early as 1867 Lord Westbury in *Holdsworth v. M'Crea*, 2 L.R. 380, at pp. 386-389, blazed the path which from that day to this the English courts have followed. A design somewhat complicated in character and based upon a star as a motif was refused registration and an appeal was taken to the court. The design had been submitted without any description whatsoever, and it was objected that the several figures which together made up the design might be arranged into a large number of permutations, and that if each of these enjoyed the protection of the registration, a large area would be blocked off. The learned judge found it to be a virtue rather than a fault that a description had not been attached to the design. He suggests that so long as courts were able to judge the invention itself they were not likely to go astray, but he insists that "undoubtedly we should do very great evil if we introduced in the interpretation of these Acts of Parliament the niceties of the patent law." He contends that "the difficulties of the patent laws arise from ambiguity and obscurity of language in the description," not in a model of the invention itself. He firmly states that judgment must be made upon the design itself just as it stands, not upon any description or written matter which may accompany it. As a warning to proprietors of industrial designs, as well as for the protection of the public, he insists that "if a design as exhibited in a pattern is filed and registered by an inventor without any further limitation or description than that which is given by the design itself it protects the entire thing and the entire thing only, and the protection cannot at pleasure be made applicable one day to the entirety and another day to the separate integral parts or elements of the entire design." As a consequence, registration of the design confers no protection upon

the elements of which it is composed, nor upon any other combination of the same elements. Here he states in language which is habitually quoted by the courts, "the appeal is to the eye and the eye alone is the judge of the identity of the two things." To him the determination is to be made by "an unerring judge, namely, the eye." The test is to take "the one figure and the other figure" and to ascertain "whether they are or are not the same."

In this opinion Lord Westbury recognizes alike the claim of the designer for protection and the necessity of protecting the public interest. In striking a balance he limits the protection afforded by the registration to exactly the design which is registered, no more and no less; to its distinctive configuration, not to any other combination of its elements. He realizes that the more exact the standards, the easier is the task of judgment. He wants to avoid leading the courts into an area where criteria are so uncertain as to be unsafe guides to decision. He disclaims any concern of the statute with the artistic merit or beauty of the design. He is indulgent not only to geometrical but even to "fantastic and grotesque combinations," stating that "if they are all exhibited upon the pattern and the patent is registered, then, however destitute of beauty they may be, they do in the mind of the inventor . . . constitute the design he desires to protect." In the opinion of Lord Heatherly, who spoke for the Appeal Court (1870) 6, Chancery Appeals, 417, *M'Crea v. Holdsworth*, this severe definition of the design as registered is repeated, "...the designer is not bound as in a patent case to distinguish the new from the old and is allowed to register his pattern without distinguishing what is new from what is old. But if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design." To the same effect see *Harrison v. Taylor* (1859), 157 E.R. 1064.

But if for registration the requirement of beauty is waived, that of novelty or originality is not. Instead, the English courts, solicitous about the interest of trade and of the public, demand something substantial in the way of innovation, even though the novelty may not rise to invention. In *Re Lemay's Registered Design* (1884), 28 Chancery Division 24, 34, Lord Justice Bowen states "in considering whether the design is new or original . . . we are dealing with a design which purports to found itself on shape and to deal with outline." In the instant case the design lies "in an article of dress of the simplest kind, an article of dress which may vary in form in every town in England and in every year in which collars are worn." In the England of that time practically all articles of dress were shaped either by tailors or dressmakers or else were made at home. He holds that to allow to protection so easy and so wide a range would be serious in its effects, "tailoring would become impossible if such were the law." The judge elaborates this demand for severity in these words, "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." As for the standard, "There must be not a mere novelty of outline but a substantial novelty in the design having regard to the nature of the article." In his concurrence Lord Justice Bagaly insists that to justify the registration of a design there must be "some clearly marked and defined difference between that which is to be registered as a new design and that which has gone before. If the difference of half an inch in the placing of a stud or any other similar trifling difference from previous designs were to be taken as justifying registration of a design for a collar, no one could have a collar made in his own home by his servants without running the risk of infringing some registered design." He adds, "It would be oppressive in the extreme if any trifling change in the

shape of such an article as this would justify the registration of the design so as to preclude all the rest of the world from making an article of the same or like form." In *Lazarus v. Charles* (1873), Law Reports 16, Equity 117, 121, Chancellor Malins sums up the holdings of the courts on this point, "People who manufacture articles with only a slight alteration in form from other articles already manufactured should not rush into the mistake of registering their design, thus causing an embarrassment to the trade." In a word, the protection of industrial design must stop short of embarrassment to the trade or mischief to the public.

But even as so narrowly defined the English Courts are sensitive to the difficulty of the problem. As a judge, doubtless speaking for many of his brethren, has said, "It is not easy to determine what distinction, if any, is intended to be drawn between novelty and originality, but if there is any difference the design need not be both new and original."

"Every design which is original is new, but every design which is new is not necessarily original . . . There are very few designs which are entirely new. Hardly any could be produced. They are made up from the old . . . The distinction between pattern and shape is not necessarily specific and precise . . . The practical distinction is shown by such a common illustration as that which I will give. I like the shape of your coat but I think that the pattern of the material is in execrable taste." In *Re Rollason's Registered Design* (1898), 1 Chancery 237. In constructing a design the inventor has before him a number of avenues. "A combination of old shapes may result in a new or original design or shape, and if that is the result such design will be protected if registered under the Act; nor do I say that even the omission of something from an old shape may not result in a new or original shape which may be protected." In fact, "a new combination of two or more old patterns or designs may form a good subject matter for registration as a new or original design; but the combination must not be obvious and must result in something new or original as a whole, whether it be an ornament, pattern, shape or configuration." Any appeal to the artistic or the esthetic is irrelevant, "... the design may be for artistic or beautiful shape or configuration . . . or for shape in which no appeal is made to a sense of beauty." The essence of the design lies in the design itself, not in the thing to which it is attached or any object external to it.

Thus, a design within the Act may be some ornament printed or produced on the flap such as woven or printed designs in textile fabrics, paperhangings, floor cloths, or the like; or patterns or designs etched or stamped, or cast or embossed, or cut or otherwise produced on metallic articles, or glass or plastic material, or furniture or tiles, or worked or woven as in lace; or it may be for artistic or beautiful shape or configuration as in a lamp-stand or a lamp shade, or iron railing or gate; or for shape in which no appeal is made to a sense of beauty as in a new shape or configuration of a grate door or oil can or cravat; or the design may contain two or all of the foregoing elements, that is, ornament, pattern, shape and configuration. In *Re Clarke's Design* (1896), 2 Chancery 38. The general demand is that the design must be "substantially novel" or "substantially original," having regard to "the nature and character of the subject matter to which it is applied." In *Re Bach's Design* (1889), 42 Chancery 661.

The law set down in these holdings is as valid today as it was when first written. The cases referred to above have been repeatedly cited over the intervening decades.

4. *Resort to Rule of Thumb.* The success of the English courts in dealing with individual design is largely due to the common-sense attitude which they have brought to the problem. It is easy enough on the basis of statutory language to erect a code of categories, concepts and rules. Instead, the judges have avoided indulgence in the refinements of legal technology and have attempted to reduce judgment to its simplest terms. Instead of the specialist it is the reasonable man of the law who must decide. The decision must be made not on the basis of expert testimony but by the eye giving the individual design the "once-over." Here it is the rule of thumb which is invoked and judgment is wisest when the line of decision does not stray far from this everyday basis. The matter is thrown into sharp relief by a short series of quotations from representative cases:

"It seems to me, therefore, that the eye must be the judge in such a case as this and that the question must be decided by placing the designs side by side and asking whether they are the same or whether the one is an obvious imitation of the other." *Hecla Foundry Company v. Walker Hunter and Company* (1889), 14 A. C. 550.

"If it is the eye and the eye alone which is to judge, and if that judgment is to be made by the once-over rather than by the studied look, there seems to be no place for the expert in the administration of the Designs Act. What they are asking in this form of question is, "Is the picture or mark complained of calculated to deceive the public?" It is not what would happen to them individually, but what they think the rest of the world would be likely to suppose or believe. They are not experts in human nature, nor can they be called to give such evidence and apart from admissibility one cannot help feeling that there is a certain proneness in the human mind to think that other people are perhaps more foolish than they really are . . . It only remains then to call the evidence of people who can say that they themselves would be deceived. Now it is obviously extremely difficult to get any such evidence. People are reluctant to admit that they are more foolish than their fellows. The result is that unless it is left to the eyesight of the judge to judge for himself there is practically no evidence open to the plaintiff in an action of this sort." *Bourne v. Swan & Edgar, Ltd.* The case is also known as *In Re Bourne's Trade Marks*, 1903, 1 Chancery Division 211.

In the administration of the Act, a resort to comparison is inescapable. To determine the novelty or originality of a design, reference must be made to the previous state of the art and that previous state is best exhibited in designs which most closely resemble the one which seeks legal protection. If a suit be instituted for infringement the registered design must be placed side by side with the imitation to let the eye determine whether the latter is a pirative edition of the former. Infringement does not of necessity mean identity. "They (the defendants) point to the different details, the different parts of the design, and they show in each part how the design differs in detail. They undoubtedly show that but to my mind that has no bearing upon the question whether the one is or is not an obvious imitation of the other." *John Harper and Company, Ltd. v. Wright & Butler Lamp Manufacturing Company, Ltd.* (1896), 1 Chancery 142.

An essential requirement for registration is that "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 the design. A conception or suggestion as to a mode or a principle of construction, though in some sense a design, is not registerable under the Act. Inasmuch, however, as the

mode or principle of construction of the article may affect 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." *Pugh v. Riley Cycle Company* (1912), 1 Chancery 613.

It is in citations such as these rather than in the complexities of annotated codes that the spirit of the English law is to be found.

5. *Interest of the Public.* In the application of the Act, administrative and judicial, it has been the concern of the courts to see that the grant of exclusive rights should not impose a burden upon trade or sanction the levy of a toll upon the public. The Statute of Monopolies represents the first legislative excursion in the grant of exclusive rights as an incentive to the progress of the creative and useful arts. Sections of the statute provide for such grants for a period of fourteen years for the "sole working or making of any new manufactures within this realm to the true and first inventor and inventors of such manufactures which others at the time of making, such letters and patents shall not use." It is, however, specifically provided that such grants of monopoly in their use shall not be "contrary to the law or mischievous to the state by raising the price of commodities at home or hurt of trade or generally inconvenient." This classic attitude finds expression in language employed in the *Shirt Collar case*, "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 dress like this which constitutes novelty of design. To hold that would be to paralyze industry and to make the patents, designs and trademarks act a trap to catch honest traders." *In re Le May's Design*, (1884) 28 Chancery Division 24. The learned judge concludes by insisting that shirt collars have been designed for a long, long time, that protection is not a necessary incentive to the creation of new lines, and if a result is that no new design can be patented, "it will not be any great calamity to the world." The case, in spite of its date, is still a "leading case." It has been repeatedly cited in the opinions of the court as fixing a limit beyond which legal protection of industrial design must not go.

IV

THE CASE OF THE UNITED STATES

The law of the United States assumes a more ambitious task than does that of England. In both countries it is the "industrial design"—and the industrial design alone—which is subject to protection. The protection does not extend to the article upon which the design is impressed or to which it is affixed, nor is utility to be taken into account in determining whether or not the exclusive right is to be given. In both countries stress falls upon form, shape and configuration, and in both countries ornamentation, if present, is to be accorded recognition. But in the United States a prerequisite of "invention" is called for, and although the usage of the several courts is by no means uniform, there is a disposition to read ornamentation as involving the presence of "beauty." These two requirements of invention and beauty are more exacting than any demanded by English law. They make more evasive the standards of judgment and in practice deny to a multitude of designs the protection which the statutes of the older country afford. The administrative device employed in the United States is the letter patent, whereas in England it is registration.

1. *The Statute.* The essence of legal protection is set down in a single section of the Patent Act, 35 U.S.C. 171. It is there stated, "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor subject to the conditions and requirements of this title." The word "invents" is a direct carryover from the Patent Act, and when originally set down in the statute in 1842 was intended to have the meaning which it had in patent law. The phrase; "new, original and ornamental," is to be read in the conjunctive, not in the disjunctive, as the final "and" indicates. It has been argued by the courts that the word "ornamental" states a question rather than answers it. At any rate a definition of the word is not set down and no standards are set up by which its contours are to be determined.

If any industrial design meets these evasive standards, its inventor receives a letter patent. This confers upon him an exclusive right, like the exclusive right granted for an invention, which runs at his election for a period of three and a half, seven or fourteen years. Again, like the letter patent for an invention, this exclusive right at the expiration of its limited time passes into the public domain and all are free to use it.

Applications for industrial designs are processed in a section of the United States Patent Office established for the purpose. In theory at least they are subjected to a more searching scrutiny than if no more than registration was asked for. But in the field of mechanical invention the standards maintained by the Patent Office are different from, and far less exacting than, those laid down by the courts; and it would be strange if such criteria as novelty, originality, beauty and invention were made more exacting than elsewhere in the organization. The procedure followed is not proof against improvident issue; and even if the volume is far smaller, it is doubtful whether the level of creation rises higher than with letters patent in general. It is inevitable that the usages of the Patent Office should prevail in the section devoted to industrial design, but the character of the separate tasks makes the processes of examination somewhat different. In the realm of mechanical and scientific invention an effort is made to separate the whole of the prior art, to define with precision the exact invention and to limit the grant to the technology so insulated. With industrial design such a procedure is out of the question, for whatever significance and appeal it possesses lies in its entity. To strip away all that is old is to rob it of form, shape and configuration. The design must be given protection whole or not at all. Nor as distinct from the realm of the useful arts, the design cannot be fragmented and separate letters patent issued for each of its parts. Nor again can the novelty or originality of the design be reduced to a series of claims, each of which stands in its own right. The proceeding leading to a grant of letter patent involves only the applicant and the patent office. It is the Examiner who in his inquisitorial capacity adds the role of adverse party, and by his own effort piles up the information which may prevent the grant. As in other divisions of the Patent Office, the work is broken down into specialties, and the tendency is to confer upon the Examiner an autonomous province. The applicant denied a grant may ask to have the matter looked at freshly by the Appeal Board within the Patent Office, and under specified conditions an appeal may be taken to the courts.

The grant issued by the Patent Office gives to its holder no right greater or other than that of going into court and suing for infringement. Such a suit is more hazardous than a suit for infringement of a letter patent for invention. The pleas which may be interposed in defense are numerous, and the burden of proof of novelty, originality, beauty and invention may again have to be met.

In defense it may be pled that the design in question is not novel; that it is devoid of originality; that it is lacking in aesthetic appeal; and that the innovation does not rise to the level of invention.

2. *The Leading Cases.* On the surface the protection of industrial design presents a taut line of legal doctrine. The principles by which courts are to adjudge the validity of industrial design were laid down nearly three quarters of a century ago, and in their purity—at least as verbal statements—have stood fast until today. Over the years and in the current law reports these cases command as much authority in current utterance as they did when they were first read as mandates to federal judges from the highest court in the land. The language has endured even though the designs to which it has reference have long ago lost the touch of fashion and the articles to which they were attached have moved towards the category of museum pieces.

The leading, or rather the lead-off, case is *Gorham Manufacturing Company v. White*, 81 U. S. 511 (1872). This is a suit for the infringement of a patent for industrial design, the validity of which is not challenged. Although the spokesman for the United States Supreme Court states, "The sole question . . . is one of fact, the opinion is largely concerned with the true test of identity of design." He enumerates valid reasons for the legislative protection of industrial design. The giving of new and original appearance to a manufactured article "may enhance its salable value, may enlarge the demand for it and may be a meritorious service to the public." It is, therefore, the appearance which is focal to the question of identity. If the appearance is to attract trade, it must be such as easily to distinguish the article to which it gives shape and form from others of its kind. The purpose which the patent serves is "to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them." It is the "appearance" which gives significance. The agency by which they are caused or the modes through which they are produced "has very little if anything to do with giving increased salableness to the article." The need then is for a practical test by which difference or identity in design is to be discovered. Here the Justice quotes with approval the standard set up in the English cases of *McCrea v. Holdsworth*, 6 Chancery Appeal, L. Law Report 418, and *Holdsworth v. McCrea*, 2 Appeal Cases H. L. 388, which establish the standard of the eye, and the eye alone, as the unerring judge. The test is in "sameness of appearance," not in mere difference of line in the drawing or sketch. A variation in the number of lines or slight variances in configuration if insufficient to change the effect upon the eye will not destroy substantial identity. An engraving with many lines may present to eye and mind the same appearance as another design whose lines are fewer. Infringement does not turn upon "substantial identity in view of the observation of a person versed in designs in the particular trade in question." It turns rather upon the judgment made by "observers of ordinary acuteness bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give." Accordingly, it is not the testimony of experts but that of the ordinary run of men and women who purchase the article, which the court should accept in passing upon the question of identity or difference. The court holds, "If in the eye of an ordinary observer giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is

infringed by the other." In a word, since the legislative intent is commercial, the question is whether or not the customer is deceived. In the instant case "even the minor differences" in the two designs before the Court "are so minute as to escape observation unless observation is stimulated by a suspicion that there may be diversity." In this way the rule of unfair competition as developed in the Common Law is carried over into the interpretation of the statute giving protection to industrial design.

A follow-up case quite as frequently cited is *Smith v. Whitman Saddle Company*, 148 U. S. 674 (1893). The Court repeats its previous utterance in insisting that "The Acts of Congress authorizing the granting of patents for designs contemplated not so much utility as appearance." It is "That which gives a peculiar or distinctive appearance to the manufacture of articles to which it may be applied or to which it gives form" which invites the granting of the patent. With this as a start, the highest court in the land makes canonical the opinion of Judge, later Mr. Justice Brown, in the case of *Northrop v. Adams*, 18 Fed. Cases No. 10, 328, Cir. Ct. Mich (1877). Here there is a direct introduction of the law of patents for invention into the domain of industrial design, and it is largely through this uncritical borrowing that the exacting standards of invention are brought in. All the regulations and provisions which apply to the obtaining of protection of patents for inventions or discoveries shall apply to patents for designs. Such an attitude leads to a discussion of invention as a requisite of a design patent. "To entitle a party to the benefit of the Act in either case"—whether a patent for invention or for design—"there must be originality and the exercise of the inventive faculty. In the one there must be novelty and utility; in the other originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius, an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new role, is not invention." Thus, by the citation of its language the Supreme Court of the United States endows the *Adams* case with authority and employs its rationale in the decision of the *Whitman Saddle* case. The *Whitman Saddle* case involves a claim that the defendant had been infringing the design of a saddle. The Court points out that there were several hundred separate styles of saddles, and that the various elements which make up form are capable of being arranged in an innumerable number of permutations. That being so, a new design may emerge simply by putting old elements together, and this, in the opinion of the Court, is within the capacity of any person skilled in the art of saddle-making. For that reason the standard set up in the law of patents for invention seems pertinent. There must in the way of novelty be something more than the mere artisan can contrive. There must be "the selection and adaptation of an existing form is more than the exercise of the imitative faculty and if the result is in effect a new creation the design may be patentable." Thus it was that in a case concerned with an article in ordinary use appearing in a myriad of patterns invention came to be a requisite for legal protection of industrial design. But once this standard was imported from the law of invention to that of design, it was there to stay.

The classic statement, however, is the opinion of Mr. Justice Bradley, speaking for a unanimous Court in *Atlantic Works v. Brady*, 107 U. S. 192 (1883). This is a case involving the validity of a patent for invention, not for an industrial design. It is, however, repeatedly cited in industrial design cases and its strictures have been held as binding in its borrowed field as in that to

which it is indigenous. The dominant idea of Mr. Justice Bradley and his Court is that the grant of an "exclusive right" is a monopoly and that by the mandate of the Constitution such an intent of the patent laws is "to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers."¹ He insists that "such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies which enable them to lay a heavy tax upon the industry of the country, without contributing anything for the real advancement of the art. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexacious accountings for profits made in good faith."

This trilogy of cases breaking new ground has become authoritative. The three holdings, especially that of Mr. Justice Bradley, are as freely cited today as when they were cases of first impression.

3. *The Search for Standards.* No domain of the law offers a greater invitation to excursion into statutory language. Opinion after opinion given by learned judges give no more precise limits to ornamentation than those suggested by inexact synonyms. A number of courts find it impossible to think of ornamentation apart from a concept of beauty. The design, it has been said, "must be one that appeals to the aesthetic sense, to the artistic sense, to the sense of beauty or the beautiful," or as one poetry conscious judge has phrased it, "The design must be 'a thing of beauty' which 'is a joy forever'." *Franklin Lamp Mfg. Co., Inc. v. Albe Lamp & Shade Company*, 26 F. Supp. 960 (D.C. Penn. 1939) at 961. "If ornament, ornamental, ornamentation are to be read in this sense," the judge suggests, "the law imposes upon the examiners of the Patent Office a real task. The difficulty is the absence of a standard . . ." The learned judge refers to the new vintage of Easter bonnets. They may be novel and original and ornamental, but they are not always "things of beauty." Yet he would not deny to them as industrial design the protection of the law just because their shapes, forms and configurations do not fall pleasantly upon the eye of the beholder. The judge here, like some others on the bench, is willing to accord protection even though the designs appear to him to be "grotesque or hideous."

An appreciation of the difficulties of so subjective a test is not universal, and the majority of his brethren on the bench are not inclined to read ornamentation in such literate terms as to exclude the criterion of art altogether. The test is an impossible one, yet it must be used. The judge just cited attempts to

¹ Note the language of Mr. Justice Jackson concurring in part and dissenting in part in *Mercoird Corporation v. Mid-Continent Investment Co.*, 320 U.S. 661, 680 (1944): "The practical issue is whether we will leave such a combination patent with little value indeed or whether we will give it value by projecting its economic effects to elements not by themselves a part of its legal monopoly. In these circumstances I think we should protect the patent owner in the enjoyment of just what he has been granted—an abstract right in an abstruse combination—worth whatever such a totality may be worth."

apply the inapplicable and to make use of a non-standardized standard by drawing a distinction between the "ornate" and the "beautiful." It is the ornate, not the beautiful which the law seeks to protect. Even if this distinction is at hand, many judges do not avail themselves of it.

In the cases concerned with industrial design the word invention takes its wayward course down through the decades and the law reports. Here a borrowing from the patent cases and a blurring of the frontier between invention and beauty opens the way to decision. "To be inventive the design must produce substantially different aesthetic effect and requires a display of exceptional talent which is something more than that of an ordinary artisan or designer." *Applica. of Peet*, 211 F. 2d. 602, CCP 1954. Another judge translates the bald words of the statute into an imposing formula for the discovery of invention, "A design . . . to be patented must present to the eye of the ordinary observer a different effect from anything that preceded it, and render the article to which it is applied pleasing, attractive and beautiful, and there must be something akin to genius, an effort of the brain as well as of the hand." *Sodemann Heat & Power Co. v. Kauffman*, 275 Fed. 593, 597. It even happens sometimes that a judge becomes so expert in interpretation as to lose all sight of the statute which he is expounding. Thus it is said, "More is required for a valid design patent than that the design be new and pleasing enough to catch the trade. It must be the product of invention by which it is meant that conception of the design must demand some exceptional talent beyond the skill of the ordinary designer. Such a standard is necessarily vague and difficult of application." *Neufeld-Furst & Co., Inc. v. Jay-Day Frocks, Inc.*, 112 F. 2d 715, 716 (2d Cir. 1940). In the end statutory language may drift far from its primitive moorings and the legislative provisions may be conscripted to a cause they were never intended to serve. Where shape and configuration of the structure are not ornamental but are dictated by functional requirements rather than by those of design, the structure is not patentable and therefore cannot be infringed. Industrial design does not extend to utility or function, but a learned judge states, "Where shape and configuration fail to show creative artistry there is consequently nothing present to show the exercise of invention." In more general language it is said, "The purpose of the design patent law is to encourage the decorative arts," and to "stimulate the exercise of the inventive faculty in improving the appearance of articles of manufacture." *Hueter v. Compco Corp.*, 179 F. 2d 416 (7th Cir. 1950). Another judge in succinct language sums it all up by saying that an industrial design to win a patent "must be not only new but inventively new." *Howell v. Royal Metal Manufacturing*, 93 F. 2d 112 (7th Cir. 1937). Such a requisite is easily commuted into a standard which lacks focus and is all fringe, "The fourth element, exercise of the inventive faculty is the ultimate determinant of patentability. It is said to defy imagination and its determination resides as a subjective standard in the mind of the judge considered as an average observer." *Application of Jabour*, 182 F. 2d 213 (1950). It is safe, therefore, to say that the judge could not be deemed incorrect who insists that the test is a matter of "speculative appraisalment." *Application of Zemon*, 205 F. 2d 317. In actual practice standards subjective in character are sometimes read out by judges only to be let in again by the back door. Thus, for example, it is said, "It is not necessary that the design . . . should be a work of the fine arts, but it is necessary that the design should be new and original and either embellished or adorned or distinguished by its grace of symmetry and form." *In Re Stimpson*, 24 F. 2d 1012 (D. C. Cir. 1928). The overt exclusion

of beauty and its stealthy inclusion appears in the line, "The statutory requirement that the design be 'ornamental' must disclose at least a rudimentary aesthetic appeal." *Cooper v. Robertson*, 38 F. 2d 852, 858 (D. C. Md. 1930). The route from the front door to the back is clearly indicated in the statement, "To be ornamental, the design need not be ornamental in the sense of being ornate, or bedecked, but in the sense that it has a certain marked appearance which lends beauty or elegance to it." *H. D. Smith & Co. v. Peck, Stow & Wilcox Co.*, 258 Fed. 40, 44 (D. C. Conn. 1919). A judge on occasion makes it clear that his devotion to the aesthetic is pure and undefiled, for example, "It"—that is the industrial design—"must be ornate. It must appeal to the eye of the beholder. The inventor of a design entitled to the protection of a patent must produce a result akin to that produced by the artist or sculptor. His design must be new. It must be beautiful and attractive." *Baker & Bennett Co. v. N. D. Cass Co., et al*, 220 Fed. 918, 921 (2d Cir. 1915). A man has a right to the protection which the law accords, but the statute invoked by the applicant says what a bench of judges over a period of years say that it says. The statute is the legislative mandate to the courts. But here even more than in many branches of the law, a statute means what a changing bench of judges over the years say that it means.

4. *Dress Design—No Place for Innovation.* The case of dress design is notable, for it illustrates in ultimate terms what in lesser degree is true throughout the field of general merchandise. The cases have to do very largely with the designs of women's dresses, but the rulings which emerge will hold generally through the whole realm of merchandise where high fashion prevails. The women's dress industry is not only focussed upon, but is very largely confined to a few blocks in New York City. For that reason the cases originate almost without exception in a single District Court, that for the Southern District of New York, and are reviewed by a single appeal court, that for the Second Circuit.

In the case of *Neufeld-Furst & Co., Inc. v. Jay-Day Frocks, Inc.*, 112 F. 2d 715 (2d Cir. 1940), the District Court had found valid a design for a dress. The Court of Appeals set its task down as obliged to resolve the issue by standards which were alike vague and difficult to apply. It had to decide as best it could whether the dress in question was original and aesthetic and involved a step beyond the prior art. The court insists, "In this circuit it is firmly established that more is required for a valid design patent than that the design be new and pleasing enough to catch the trade." That the design does just that is admitted, but the court argues that "Its salient features" were all known before, and that an artisan "who had or was chargeable with knowledge" could have contrived it. The design lacks "invention" for invention is a product of "some exceptional talent beyond the skill of the ordinary designer."

In *White v. Lenore Frocks, Inc.*, 120 F. 2d 113, (2nd Cir. 1941), an appeal is likewise taken from a decision of the federal district court. The issue was the validity of two design patents for women's dresses. In this case the patentee sought an immediate injunction against a firm which was pirating the design. The dresses had won public esteem and were at the height of fashion. If the two designs were to be protected, an injunction would have to issue almost at once, for nothing depreciates more rapidly than values given by the touch of style. So almost without the taking of testimony the adverse decision of the District Court was hurried up on appeal. There had presumably been fashion shows, and "public acquiescence" in these designs was just beginning to appear. A temporary injunction would be far

more valuable than one of permanent character. The case reached the appeal court without "defense of any kind." In its consideration of the moving papers, the court said, "Courts have at times held design patents invalid upon their face, without any showing of invalidity by the defendant. Indeed, we have done so ourselves, but in the only instance in which the Supreme Court passed upon the question it reversed a dismissal and sent back the case for trial although the design was certainly extremely simple . . ." *New York Belting and Packing Co. v. New Jersey Car-Spring & Rubber Co.*, 137 U. S. 445 (1890). See also *Denton v. Fulda*, 225 Fed. 537 (2d Cir. 1915). The court then announced its disapproval of disposing of such suits in so summary a manner except in the clearest possible cases. *Jacob Elishe-witz & Sons Co., Inc. v. Bronston Bros. & Co., Inc.*, 40 F. 2d 434 (2d Cir. 1930), again lays down the rule that "the validity of a design patent depends upon the same factors as that of a mechanical patent; the condition of the art when the design was made; how long the need had existed; how nearly the art had approached the new design and when; how far the design met with popular approval and displaced other designs when it appeared." It insists that "A court can seldom inform itself of these elements well enough to declare that the patent must inevitably be invalid. The only safe course is to let the action go to trial."

The owners may, if they will, seek legal protection for their designs, but at the end of a course of litigation they will probably discover that, the issue of the patent aside, there is nothing to attest their validity. Their designs appear to be simple variants upon old themes such as capable designers can turn out almost by combination of known elements. Their hopes in going to the Patent Office and in seeking vindication in court are likely to prove "illusory." There is little chance that valid design patents can be procured in the number and with the regularity essential to the protection of creative effort. As a verbal gratuity the court adds that the protection of copyright will stand them in stead where that of industrial design fails. It may be, however, that what is really needed is a new statute which will give to industrial design the recognition it has not yet won and which can be so contrived as to prevent the plagiarism which is currently so manifest. The opinion concludes that ". . . recourse to the courts as the law now stands is not likely to help them. Perhaps if their grievance is as great as they say, Congress may yet afford an effective remedy." Such an attitude is not surprising in view of the "crowded state of the arts." For women's dresses the individual contribution is likely to be lost in the rapid metamorphosis—we do not say development—of the art. A myriad of persons are in one way or another involved in design. There is the widest interchange of ideas in the dress industry and the treasures of the past are drawn upon to turn out models for the future. "The skill of the multitude of dressmakers, the innumerable fashion magazines, the many services rendered to manufacturers by design companies—these and many other sources make real advancement, although slight, in the art exceedingly difficult." *Roseweb Frock, Inc. v. The Mee Feinberg-Mor Wiesen, Inc.*, 40 F. Supp. 979 (S.D. N.Y. 1941). In this case "The plaintiff paid salaries to designers, assistants, sample makers, and each year a considerable period of time was devoted to an effort to produce what is considered a new and pleasing type of dresses. A group of these is presented as a so-called 'line' to buyers. From this perhaps one or two, or even more, make a decided 'hit' with those who buy both wholesale and retail, yet immediately such 'hit' dress is copied, usually not exactly, it is sufficient to lessen materially the demand for same. There seems to be no adequate means to compel a limited monopoly over such dress." In fact, even where infringement is perfectly clean-cut and willful, the question of validity arises.

In *White v. Lombardy Dresses, Inc.*, 40 F. Supp. 548 (S.D. N.Y. 1941), the defendant admitted that for fourteen years it had been his practice "to buy models of expensive dresses and copy them in whole or in part." In the instant case the president of the accused company admitted in open court that he "bought samples of plaintiff's dresses . . . somewhere in the South, brought them back with him and duplicated them." The testimony in a number of these cases is that the would-be observers visit fashion shows, make notes and drawings of dresses there on display, and reproduce them. Instance after instance is given of a delay of less than a month between the appearance of the original model at an expensive store and a copy of it at a store catering to persons of lower income. There may be slight differences in design, but the difference lies largely in material and workmanship. The pirated dress, of course, sells for a great deal less than the original model. In defense of the piracy it is argued—we have found no case in which the court recites this reason—that the practice of piracy tends to break down caste lines; that it recognizes the principle that "the Colonel's lady and Judy O'Grady are sisters under the skin."

But if the lower courts offer only a verbal shadow of protection against design piracy, the high priests of fashion are not permitted by means of a united front to make secure the market for their own creations. The matter came before the United States Supreme Court in the case of *Fashion Originators Guild of America v. Federal Trade Commission* 312 U.S. 457 (1941). The defendant is an organization established and maintained by the joint action of manufacturers of women's garments, chiefly dresses, and of manufacturers, converters, or dyers of textiles from which the garments are fashioned. The former group claimed to be creators of original and distinctive designs of fashionable clothes for women; the latter to be creators of similar original fabric designs. After the designs enter the channels of trade other manufacturers of textiles and of garments systematically make and sell copies of them, the copies usually selling at prices lower than the originals. The Guild admitted that it had no protection in copyright or patent but insisted that the sale of copied design "constitutes an unfair trade practice and a tortious invasion of their rights." It is conceded by the court that in many ways the members of the Guild competed with each other, yet for the purpose of protecting the original designs the several members "combined among themselves to combat and, if possible, destroy all competition on the sale of garments which are copies of their original creations." The Federal Trade Commission had concluded that "the petitioners pursuant to understandings, arrangements, agreements, combinations and conspiracies entered into jointly and severally had prevented sales in interstate commerce that substantially lessened, hindered and suppressed competition and had tended to create in themselves a monopoly." To that end the members of the Guild had tightly closed their ranks, declined to sell their products to retailers who follow a policy of selling garments copied by other manufacturers from designs put out by Guild members. As a result of their efforts some 12,000 dealers throughout the country had signed agreements to cooperate with the Guild boycott program, but the evidence indicates that more than 6,000 of these had signed the agreement constrained by threats that Guild members would not sell to retailers who failed to yield to their demands—threats that had been carried out by the Guild practice of placing on red cards the names of non-cooperators to whom no sales were to be made, placing on white cards the names of cooperators to whom sales were to be made, and then distributing both sets of cards to the manufacturer. As a technique of enforcement, the Guild employed shoppers to visit the stores of both cooperating and non-

cooperating retailers for the purpose of examining their stocks to determine and report as to whether they contained copies of registered designs. All of this was carried out within an elaborate system of private trial and appeal courts set up and maintained by the Guild itself. Each of the two branches of the Guild, the textile and the manufacturing, maintained its own private bureau for the registration of designs. The scheme as a whole constituted a system of private government through which the members of the Guild were held to the law of the industry. Supplies were denied to wholesalers and retailers who handled pirated designs. The Supreme Court found that the system was an usurpation of the functions of government; that the concert of action was beset by unfair competitive practices; that its purpose and effect was "substantially to lessen competition" and its tendency "to create a monopoly." Although the need for protection of creative effort was loudly pled in oral argument and brief it failed to move a unanimous court. The question of legitimate limits of letters patent accorded to design was not directly involved in the case, but the lower Federal courts have seized upon this decision as revealing an attitude of severity on the part of the highest bench in the land.

5. *The Venture into Copyright.* The attention of the buyer has shifted in many lines of merchandise from the commodity to its container. Here the industrial artist finds a host of elements to play with—the shape and size of the container, the insignia or design in which the famous name is set, the configuration by means of which it is given distinction and identity, and the like. This shift relieves the pressures on industrial design, gives wide scope to the decorative arts, and opens new paths to legal protection. In an economy like ours where the graphic arts are used in praise of merchandise, it would be strange if new techniques for winning consumer acceptance had not been developed.

A very recent move along this line may well mark the beginning of a new era. It involves the employment of copyright to secure the protection which the letter patent for industrial design was originally intended to give. It was not until 1954 that this technique received high judicial recognition and the way to its more general employment was pointed out. If events move as they promise to do, the case of *Mazer v. Stein*, 347 U.S. 201 (1954), is destined to become classic. Stein had secured a copyright of a statuette as a "work of art." His intent from the first was to use the statuettes as the bases for "table lamps with electric wiring, sockets and lampshades attached." A number of other manufacturers of electric lamps had copied the statuettes into their models offered for sale. Stein brought a number of suits in the lower Federal Courts, there meeting with varied fortune. Eventually, because of a conflict between two circuits, the case reached the United States Supreme Court. As Mazer, the petitioner, put it in asking for a review, "Can statuettes be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity, and carried the intention into effect?" Mazer did not challenge the copyright of the statuette, but insisted that, "When an artist becomes a manufacturer or a designer for a manufacturer, he is subject to the limitations of design patents and deserves no more consideration than any other manufacturer or designer." He points to the mass production of the lamps, a commercial venture, and challenges the right of Stein to a broader protection under copyright than he would have been entitled to by a letter patent for industrial design. Mr. Justice Reed, speaking for the Court, puts the question simply and bluntly, "Can a

lamp manufacturer copyright his lamp bases?" Mazer points to the dichotomy of "publication as a lamp and registration as a statuette to gain a monopoly in manufacture" and insists that this is "such a misuse of copyright as to make the registration invalid." As background and to give perspective, Mr. Justice Reed shows the constant enlargement of its coverage as one copyright act has followed another. In 1790 the First Congress conferred a copyright "upon authors of any map, chart, book or books, already printed." Later "designing, engraving, and etching" were included. In 1831 musical compositions, in 1856 dramatic compositions, and in 1865 photographs and negatives thereof were added. In the Act of 1870 the coverage was extended to include "statuary, models and designs intended to be perfected as works of the fine arts." By this Act copyright was extended to tangible objects in three dimensions; and by a later amendment in 1909 the word "fine" just preceding the word "arts" was struck. The term "works of art" is deliberately intended as a broader specification than "works of the fine arts." Mr. Justice Reed justifying this textual change insists that "Individual perception of the beautiful is too varied a power to permit narrow or rigid concept of art." His demand is that such works must be "original" which he defines as the "author's tangible expression of his ideas." Mazer, however, insists that "the protection offered by Congress through the industrial design laws precludes the grant of similar or additional protection through the grant of copyright." The challenge of dual protection is stated thus, "Fundamentally and historically the Copyright Office is the repository of what each claimant considers to be a cultural treasure, whereas the Patent Office is the repository of what each applicant considers to be evidence of the advance in industrial and technological fields." Mr. Justice Reed replies that "Neither the copyright statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold." "... Nor do we think that the subsequent registration of a work of art published as an element in a manufactured article is a misuse of the copyright." He refuses to set patent for industrial design and the registration of copyright down as alternatives or to hold that the inventor or designer must make a choice between them. The breadth of the Court's language, particularly the employment of the term "works of art" instead of "works of the fine arts", is sufficient justification for the ruling that the statuettes in question are eligible for copyright. But the protection extends only to the statuette itself, not to the lamp-statuettes complete with all of its works. Another manufacturer is free to employ a statuette as a lamp base, provided he does not pirate the statuette which has the protection of copyright. The gist of the decision is that "protection is given to the expression of the idea, not to the idea itself." The effect is to shift the spotlight from invention to originality.

Mr. Justice Douglas and Mr. Justice Black, in a "concurring opinion" raise the fundamental question of whether a statuette is a "writing" within the meaning of that word as employed in the clause in the Constitution giving to the Congress the power to promote the progress of science and the useful arts. They ask for a re-argument of this issue, but, since they are in the minority, fail to secure it.

It remains to be seen how far manufacturers will go along the road lighted ahead by the Stein decision. The Library of Congress mentions "statuettes, bookends, clocks, lamps, door knockers, candle sticks, ink stands, chandeliers, piggy banks, sun dials, salt and pepper shakers, fish bowls, casseroles and ashtrays" as "works of art" which it has blessed with its imprimatur. It is

now clear that as between the letter patent for mechanical invention or industrial design and copyright, the maker and vendor of a commodity does not have to make an election. The copyright seems to offer a narrower protection and yet to be easier to obtain; the patent for industrial design the tighter coverage, but with the larger hazard to validity. It is enough here to point out that a vast area, largely unexplored, has been opened up by a single court decision.

In any event the *Stein* decision poses the current problem. It may be that an alternative device for the protection of industrial design must be found, or it may be that the severities with which letters patent in this field are adjudged must be relaxed, or it may be that the effort to give legal recognition to creative work in the domain of the decorative arts will have to be abandoned. Here public policy is at the crossroads.

6. *The Law—Old and New.* It is impossible to find a definitive statement of the law which is current. For years there has been no case before the United States Supreme Court concerned with industrial design, and that tribunal as a general rule undertakes review of decisions concerning the validity of letters patent for mechanical invention only where there is a conflict between circuits. But in opinions which have to do with the validity of industrial designs, patent cases are cited, and the two streams of holdings are gathered into a single legal code. For that reason it is as true today as ever it was that the opinions of the Supreme Court concerned with the character, the limits, the validity and the permissible uses of letters patent for invention are relevant and valid in respect to those for industrial design.

In *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84 (1941), Mr. Justice Douglas, speaking for a unanimous bench, states the requisites for the grant of a letter patent. He asserts that to win the exclusive right granted by the Government, ". . . more must be done than to utilize the skill of the art in bringing old tools into new combinations." It may be that the combination is "new and useful" but that "does not necessarily make the device patentable." It is not enough that the device presented be "new and useful." It must also "be an invention or discovery." He points out that this requirement is of ancient standing; that "since *Hotchkiss v. Greenwood*, 11 Howard 248; 13 L. Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the work of a mechanic skilled in the art." He is explicit that "perfection of workmanship, however much it may increase the convenience, extend the use or diminish the expense, is not patentable." He repeats, "The new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails it has not established its right to a private grant on the public domain." In the case before it, the Court was unable to see that the placing of a thermostat in a cigar lighter installed in an automobile met the standard of "a flash of genius." "Certainly the use of a thermostat to break a circuit in a wireless cigar lighter is analogous to, or the same in character as, the use of such a device in electric heaters, toasters or irons, whatever may be the difference in detail of design." It is recognized that grants of monopoly, however narrow, are hazards to business and afford opportunity to harass commerce. For this reason grants of privilege are hedged about with limitations. Severity in application is demanded "lest the heavy hand of tribute be laid on each slight technological advance in an art."

In the *Great Atlantic and Pacific Tea Company v. Super Market Equipment Corporation*, 340 U. S. 147 (1950), the dominant question is "what indicia of invention should the Court seek in a case where nothing tangible is new, and invention, if it exists at all, is only in bringing old elements together." In this case the District and the Circuit Court alike had found valid a patent for a "cashier's counter equipped with a three-sided frame or rack, with no top or bottom, which, when pushed or pulled, will move groceries deposited within it by a customer to the checking clerk and leave them there when it is pushed back to repeat the operation." In the opinion of the Supreme Court it is beyond dispute that the accused device "speeds the customer on his way," and "reduces checking costs for the merchant." It is also admitted that the device is not a part of the prior art and that it has been widely copied and put to use. Mr. Justice Jackson stated, "While this Court has sustained combination patents, it has never ventured to give a precise and comprehensive definition of the test to be applied in such cases. The voluminous literature which the subject has excited discloses no such test." He points to the tendency of the Court to use the word "combination" when the patent is allowed and to use the word "aggregation" when it is not. Such usage, he insists, as criteria of invention "results in nothing but confusion." The wayward concept of invention along with the lack of precision in language has caused courts and text writers to be cautious in affirmative definitions or rules on the subject. In dealing with so nebulous a matter Mr. Justice Jackson holds that precision in language is out of the question. He cites for practical use as a rough and ready standard a sentence from the opinion in *Lincoln Engineering Company of Illinois v. Stewart Warner Corporation*, 303 U. S. 545, 549 (1938). "The mere aggregation of a number of old parts or elements which in the aggregation perform or produce no new or different function or operation than theretofore performed or produced by them is not patentable invention." See also *Toledo Press Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350 (1939). In the instant case he is at least more concrete if not more precise. "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics." In a word, the entity must have a significance and perform a function over and above that which lies in the mere aggregation of its several parts—or there is no invention. The intent of the Court is to rid the economy of claims for tribute which do not represent genuine invention. For the present holding it is enough that, in the words of Mr. Justice Jackson, "Neither court below has made any finding that old elements make up this device or perform any additional or different function in the combination than they performed out of it."

The case of *Kono Manufacturing Co. v. Vogue Optical Manufacturing Co., Inc.*, 94 F. Supp. 251 (S.D. N.Y. 1950), deserves recitation because the criteria by which invention is there judged are widely applied. This is a suit for the infringement of a design patent. The design lies in a pair of spectacles framed in the harlequin type worn by women. The prevailing feature of the design is "the provision of an undulating or sinuous outline to the outer margins or edges of the eyeglass frame, that is, at the outer edge of the portion of the frame on both the left and right-hand sides there are curves, or bumps or scallops immediately below and

flowing into the region where the temple bars are attached to the frames." The court decided that placing the patented frames and the imitating frames side by side the eye could distinguish no significant difference between them and concluded that clearly there was infringement. The court then went on to consider the validity of the design patent and reached out for criteria with which to decide the question. In this pursuit it cites *Rowley v. Tresenberg*, 123 F. 2d 844 (2d Cir. 1941), to the effect that "the grant" of a design patent "really amounts to no more than saying that the patent lurks somewhere among the possible combinations which will fit upon the disclosure." In short, to find a valid reason for such a grant is virtually to look for a needle in a haystack. In *Knickerbocker Plastic Co., Inc., v. Allied Molding Corporation*, 184 F. 2d 652 (2d Cir. 1950), the same court is cited as laying down four requirements for granting a design patent. "The design must be new, original, ornamental, and must be the product of invention." The court evidently for the lack of criteria in its own field makes the requirement for invention "the same exceptional talent that is required for a mechanical patent". The demand for invention is, in addition to the demand for novelty, originality and ornamentation. "The design must reveal a greater skill than that exercised by the ordinary designer who is chargeable with knowledge of the prior art." The court then cites as authority for the invalidity of the design patent in question the *Great Atlantic and Pacific Tea Company v. Super Market Equipment Corporation*, 340 U. S. 147, and with an eye to public policy quotes from the concurring opinion of Mr. Justice Douglas in that case. He remarks that "every patent is a grant of a privilege of exacting tolls from the public. The framers"—that is of the Constitution of the United States—"plainly did not want those monopolies freely granted. Through the years the opinions of the court commonly have taken inventive genius as the test." In the instant case it is only one feature of the pleasing appearance which the frames, called the hussy and the hussette, make for which novelty is claimed, and this is not enough. As the Judge puts it, "any craftsman of ordinary skill in this field constantly mindful of improving the appearance to the eye of ladies' frames would in due time devise a frame either exactly like plaintiff's or one that would contain the pleasing-to-the-eye features in plaintiff's frame. There was nothing startling about plaintiff's series of curves, nor did it show any inventive genius." Thus, holdings in cases involving mechanical patents are made authoritative in the field of industrial design.

The legislative language providing for encouragement to the progress of the decorative arts is comprehensive in character. As the sections of the Patent Act concerned with industrial design have been written and rewritten, they have become less verbose and more terse. In the Act of 1842, which has endured in substance even though its language is gone, the coverage of the statute is set down in the following terms: "It is a new and original design for a manufacture, whether of metal or other material; a new and original design for a bust, statue, bas relief; or composition in alto or basso relievo; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woolen, silk, cotton, or other fabrics; a new and useful pattern, print or picture to be either worked into or on any article of manufacture; or a new and original shape or configuration of any article of manufacture—it is one or all of these that the law has in view." *Gorham Manufacturing Co. v. White*, 81 U.S. 511 (1872). In the

current statute this catalog has been condensed into the words "any new, original and ornamental design for an article of manufacture."

V

VALUES AND PUBLIC POLICY

It is, of course, no part of this task to suggest to the Royal Commission a line of recommendation, but the experience passed in review in the pages above is not without its lessons, and it may not be amiss briefly to set down the guidance which it affords.

1. *The Conflict of Values.* The experience of the American courts is marked alike by a clear-cut recognition of the conflict of values and by a somewhat blurred conception of the objective the letter patent for industrial design is intended to serve. Its specific end of promoting "the progress of the decorative arts" is in conflict with the general public policy of keeping the channels of commerce open. Its commitment to free enterprise has its hazard in the endowment of a series of petty monopolies with the legal right to exact a toll. In every case the opposing values must be balanced alike by the legislature and by the courts. In this domain even more than in the field of technological invention the courts are explicit in recognizing the conflict. Here, too, by the application of rigid standards they are more inclined to give preference to the larger good. The qualified purpose is manifest in the recognition of industrial design as a commercial asset. A design which attracts the eye, commands public attention and gives to a commodity an enhanced lustre is a valuable thing and as such is entitled to the law's protection. It is hard to tell which intent is the stronger with the courts—to further the creative arts or to give legal recognition to a technique useful in the pursuit of gain.

2. *The Problem of a Balance.* An employment of statecraft to give limited protection to industrial design involves of necessity a balancing of values. It involves a legal recognition of private rights, exclusive in character, in the public domain. The grant of such petty monopolies confers upon their owners the right to go into court and to sue for infringement parties who trespass upon their domains. The power to sue involves the power to harass by threat to sue, and such a potential power as judge after judge in England and the United States has recognized, may well be used to restrain trade, to block honest enterprise and to arrest rather than promote the progress of industry. The source of mischief is clearly present, but how widely and how effectively it has been employed to the advantage of the design owner and to the detriment of commerce and the public, it is impossible to say. In this domain little information becomes public unless cases get into the courts, and the number of such suits is so small as to present at best only fragments of the story. There is no available measure of the silent effect, the hesitation or even the failure of business enterprises to venture far into industrial design because of the fear of suits for infringement. Here, as in the realm of technology, the business corporation, particularly the one small in size, demands security against having to answer in court for its practices. For that reason, in giving shape and form to its products, it is likely to stop far short of the line which would be drawn by the courts in protection of the registry or the letter patent for industrial design held by a large competitor. So long, too, as the criteria attesting novelty and distinction remain uncertain, the domain of legal conflict is far broader than

the overlap which represents real trespass. For these and like reasons the information which must be weighed to strike a rightful balance between the promotion of the design art and the harm to the public is unavailable or non-existent. In such circumstances the projection of a public policy into so nebulous a field cannot escape its chances. The cautious way, a way often taken by the courts, is to say that the legal recognition of the exclusive right in an industrial design carries with it the power to harass, and that the very existence of such power is dangerous. A bolder course is to assert that an adequate incentive should be given to endow wares of trade with the utmost of beauty in form and shape. The one is to withhold reward to the end of preventing mischief; the other is to insist that progress in decoration is a value of such consequence as to be worth whatever it may cost. It is unfortunate that the issue must be resolved upon the basis of information which falls far short of all the relevant facts.

3. *The Question of Standards.* It has long been a principle of the general law that any privilege granted by the state is to be narrowly defined and strictly construed. In the United Kingdom and in the United States alike, the statutes specify standards which must be met before any exclusive right is to issue from an agency of Government. In this domain as well as elsewhere such standards must serve a double purpose. Since the exclusive rights are at the expense of the public domain, the general benefit must be in excess of the privilege granted. The standards must also have that degree of precision which makes them easy—or at least not too difficult—to administer.

The age-old concept of “the reasonable man” has long been an admonition that standards are flexible. Yet standards which are evasive or which are subjective in character threaten equality before the law. As applied over the decades by a diverse and widely scattered group of judges, such standards tend to become invitations to personal decision. In the paragraphs above it appears that the standards employed in the English courts are far more objective than those used in the courts of the United States. The test of the eye at first glance is definite enough for at least a rough judgment of form, shape or configuration. It is adequate for approximate definition; and even ornamentation, if the aesthetic connotations are taken away, need not be too troublesome. But when the courts of the United States set up a criterion of beauty they invoke a test which as yet has not been reduced to terms. And when they insist that the degree of innovation must rise to invention they borrow a concept from an alien field which is quite irrelevant. Here the way of England is far more certain than that of the United States. The serious shortcoming of the British system is that its lower standards are easier to meet and make for a multiplication of grants. If the public domain is to be protected, the grants need to be very severely defined. Such a strict definition presents a challenge to the casual character of the elementary test of the eye. The object for which the protection of industrial design is sought should be sharply distinguishable not only from the prior state of the art, but also from other industrial designs concurrently employed.

In this field, as in others, unless the law in the books becomes the law in action it ceases to be law. If standards are made too exacting, or if procedures become too stringent, the objective which the law is designed to serve may be thwarted. The intent of a statute may be defeated in its application. The law

is tolerant of the approximation; it can never operate with machine-like precision. But if standards are so intangible and so uncertain that judgment becomes speculative, an ordeal of chance is substituted for the process of law. If a statute is to be written, the initial task is to ask what function it is intended to perform. If the end is to give identity and distinction to an article of merchandise in order that its value may be enhanced by an eye appeal, its provisions will not necessarily be different from those which would be embodied in an ordinance whose sole purpose is to promote the progress of the decorative arts. Next arises the question of setting up standards for registration or issue of letters patent which are as precise as circumstance will allow and which in employment will do approximate justice between people similarly situated. Then comes the framing of provisions to insure that the recognition of property rights in these intangibles will not result in the erection of barricades along avenues of commerce to the detriment of the public. It is evident that these latter problems will be differently solved in accordance with the principal function which the grant is supposed to serve. If the decorative arts are to be encouraged, questions will be raised as to whether the designs on trial do or do not serve an aesthetic purpose. Attempts to answer such questions will almost inevitably end in a morass. If, on the contrary, the objective is only to give identity and distinction to shapes, forms and configurations, the problem is a far simpler one. It is to determine whether the design on trial is sufficiently distinct from those that have gone before and those which have concurrent existence as to stand apart. If the design meets this particular test there seems no reason why, under proper safeguards, limited rights in it may not be privately vested without harm to the community. In the latter case the protection accorded to industrial design is a counter in the world of commerce and should be treated as such. Its divorce from the world of art should be clean-cut and definitive.

4. *The Range of Protection.* Creative effort attends all the activities of mankind. In some fields legal protection can easily be given to inventive work; in others it is difficult or impossible to do so. The law seems to have concerned itself most with the mercantile, the scientific, and the artistic. In its corpus one or more codes has been worked out to serve each of these purposes. To some extent these codes operate in different domains, but along their frontiers they are all overlapping. Long before there were statutes on the subject the law separated competitive practices into the "fair" and the "unfair". In England and the United States this distinction has been carried over into statutes and as petty trade has given way to the great economy the range of these codes has been widened and their prohibitions made more explicit. In the field of mechanics, and later in such new provinces as metallurgy and chemistry, the inventor has been granted a letter patent for a limited time conveying an exclusive right to his specific discovery. At first creative writing enjoyed a common law protection and later was brought under the aegis of copyright and administered through a system of registry. In the field of processing and fabrication the manufacturer has long enjoyed an exclusive right in the distinctive name or mark affixed upon or attached to the products which issue from his shop. Ancient usage has been caught up into the common law and elaborated into a system of statutory protection. Legal recognition has been given to the shape and form as separate from the utility of an article through a system of registration of or letters patent for industrial design. The standards set for the issue of these various exclusive rights differ widely. Legal protection which they give to the recipient of the grant may be wide or narrow; it may run for a limited time or in perpetuity, and each form invites its own specific method of administration. These

various protections are not alternatives and they do not invite election on the part of the applicant. If the conditions set down for any one of them are met, the appropriate grant issues quite irrespective of whether other protections are available. An uncooked breakfast food, for example, may emerge from a process covered by letters patent; it may reach the public in a container, the graphic matter upon which is copyright, and bear a famous name as part of a trade-mark which has been registered. A pair of bookends may be copyright, blessed with a trade-mark and enjoy the protection afforded to industrial design. Such a lack of symmetry in protection is itself a manifestation of the ad hoc way in which the law has developed. If here there is to be protection the task is to carve out for industrial design its distinct province. This demands a clean-cut judgment as to the purpose for which protection is to be afforded. It requires that a choice be made between "the promotion of the decorative arts" and the commercial objective of endowing the manufacturer or distributor with an exclusive right in the distinct design imposed upon his merchandise. If the latter is the chosen objective, the dominant requirements are distinct identity of the design and clear-cut differentiation from others of its kind. Again, if this objective is to be served and the channels of trade are to be kept clear of barriers, it is the specific design no more and no less, to which protection is to be accorded.

5. *The "Limited Time."* In a field like this the "limited time" always presents a difficult question. The object, as in the Patent Act, is to make the time long enough to serve as an incentive to the inventor and yet short enough to allow the earliest possible return of the invention to the public domain. In the case of patents the term was originally set at fourteen years, that is, a period long enough to allow the training of two sets of apprentices. Later, in the United States, the term was extended to seventeen years. The tempo of modern industry is far faster than that which prevailed in the period of handicraft, and no attempt has officially been made to accommodate this limited time to current conditions. It happens, however, that in the economy a number of patent pools have been organized with arrangements by which the companies in an industry have access to each other's technology. It is usual in such understandings for the inventor to enjoy a monopoly of his invention for a limited time before it goes into the pool. In the automobile industry there has been a varied, if lengthening, period applying to most inventions for not more than five years. In other patent pools different limited times are set but all of them for periods far shorter than the legal seventeen years.

It happens, however, that all industries do not move in lock step, and commerce in various lines does not go forward at a single, uniform pace. Personal rights in intangibles are always hard to define and various types of equities therein may, because of the practical circumstances which impinge, have to be accorded protection for quite different periods. At one extreme is the protection of the property rights in news by its gatherers. Here, protection is largely a matter not of statute but of the common law of unfair competition, and as it happens in the classic case of *International News Service v. Associated Press*, 248 U. S. 215 (1918), the United States Supreme Court, as well as the lower court, grappled with this problem. In the decree as it was finally written, protection was given for only a few hours. This represents perhaps the most ephemeral case.

In respect to dress designs, the fundamental fact is that the period of creation is far longer than the span of the design's life. The designer, like the composer, picks up ideas and themes from far and near, and it may take months or more for them to fall into place in a distinctive design. The design has to be shown to the trade

through fashion shows, the fashion magazines, and other organs of publicity. This build-up is a time-consuming process. Eventually the design reaches the public, goes into high gear rather quickly or never gets there, has its day in the sun and passes. The limited time needs to be adapted to this cycle of events. It is quite unlikely that all parties in interest would agree upon a definite period, but for want of one which is better, a span of six months ought to be more than enough. In unusual circumstances a renewal for another quarter year might be given.

Fashion, however, as it shapes the silhouette, is far more fleeting than the cloth or textile out of which the garment is cut. Here the rate of mutation is slower, the investment in creating the new design demands a longer period of time for return, and the grant of an exclusive right ought to run for a longer period, say three years, with a renewal for another year, or even two years, if the balance between private right and public interest so demands.

As we move from intangibles and soft goods to articles whose value lies largely in their durability, we enter another world of merchandise. A family is not in the market for an electric washing machine, deep freeze, refrigerator or television set every month or every year. It may go a decade or more without recourse to replacement. The form, shape, lines and configuration which give to the article its distinction must endure for a longer period of time. The initial grant may be for a period of five years or less, but for the reasons stated if the article has proved to be a commercial success a renewal may be given upon conditions which would guard the public interest. It is of note, however, that the touch of high fashion is now falling upon durable articles which become obsolete while their physical utility still remains unimpaired. In automobiles, for example, cars which for purposes of transportation are virtually as good as new are disposed of because their lines have lost the popular appeal. Here a longer period of protection for a design will do something to arrest the tyranny of fashion. Articles of the fine arts may well be excluded from the protection of industrial design; their artistic value is far better served by copyright than by letter patent. But if they are to be brought within the orbit of industrial design, it is hard, at least on any logical basis, to fix a definite limited time during which they are to enjoy protection.

These illustrations are chosen almost at random. It's easy enough to increase their number, but few as they are they indicate the character of problem which "limited time" imposes. In an economy in which the number of articles of merchandise, even within a single department store, run into the tens of thousands, the great majority of which invite something at least in the way of form, shape and configuration, it is impossible to divide wares of trade into categories and by statute set down a fixed period for each. Moreover, such articles not only vary from season to season and from region to region, but items are constantly passing into oblivion while new ones replace them. In such circumstances the only practical thing is to recognize that the problem of the limited time calls for administrative action as a supplement to statutory enactment. The statute establishing the protection of industrial design should impose upon the administrative agency which it creates the duty of setting up a scheme of categories and of assigning to each of them specific items of merchandise. To each of these categories items should be assigned and each should specify a limited time during which protection is to run. It goes without saying that such a scheme is temporary in character. On the basis of experience, items may be moved from one category to another. Experience, too, may dictate that in certain cases the limited time should be lengthened and in others

shortened. The system of categories needs to be kept a flexible instrument of administration.

But the task is not wholly administrative in character. The agency charged with the enforcement of the act must be guarded against unnecessary work. There is no reason why time and expense should be incurred in respect to industrial designs which have ceased to be current. Reports, therefore, need to be called for at periodic intervals, and if reports are not made the presumption should be that the designs are no longer alive and should be stricken from the rolls. As an aid, the practice now invoked in Great Britain of graduating fees with the passage of the years might be elaborated and employed. A somewhat steep graduation with relatively short initial periods would insure the survival of only those industrial designs which have continued to serve a useful purpose. Charging for renewal at least a part of what the traffic will bear will do much to keep the number of outstanding grants at a minimum and keep out of circulation grants which no longer have practical validity.

6. *The Form of the Grant.* The grant of protection for industrial design may take one of three forms. It may, as with copyright, require no more than nominal registry. It may, as in England at the present time, require registry after examination, or it may, as in the United States, take the form of a letter patent to be issued after formal procedure. The analysis made above and the evidence adduced seems clearly to indicate that registration after examination is the preferable procedure. A simple register like that of the copyright office would allow any item of design to enjoy protection at the will of its owner and would put into circulation papers which have little that is tangible to back them up. The issue of letters patent will invite a procedure like that followed by the Patent Office in respect to mechanical invention. It will bring into the field of merchandise the criteria for invention which has been perplexing enough in the field of technology, and will there invite confusion. It will be argued that in the realm of industrial design time moves fast and examination within any government agency is a slow and tedious process, but if the scheme of categories suggested above is followed and if administrative divisions corresponding thereto are set up, applications will go to the appropriate groups of examiners. In each division a procedure can be set up which moves at slow or quick step in accordance with the limited time for which protection is to run. The administration of the Industrial Designs Act in England exhibits speedy as well as efficient examination and proves that it is practical to pass on applications promptly and to give protection for even short periods of time.

In any case the grant of protection carries with it a corresponding responsibility. It is the public which makes the grant, and the public is entitled to its return. If, then, at the end of the initial period the industrial design has not been put to use, it should not be eligible for a renewal period. Instead, a procedure should be set up contrived to insure its prompt cancellation. In this way the public domain will be guarded against improvident grants.

APPENDIX D

REGISTERED DESIGNS ACT, 1949

12, 13 & 14 Geo. 6. Ch. 88

ARRANGEMENT OF SECTIONS

Registrable designs and proceedings for registration

Section

1. Designs registrable under Act.
2. Proprietorship of designs.
3. Proceedings for registration.
4. Registration of same design in respect of other articles, etc.
5. Provisions for secrecy of certain designs.
6. Provisions as to confidential disclosure, etc.

Effect of registration, etc.

7. Right given by registration.
8. Period of copyright.
9. Exemption of innocent infringer from liability for damages.
10. Compulsory licence in respect of registered design.
11. Cancellation of registration.
12. Use for services of the Crown.

International Arrangements

13. Orders in Council as to convention countries.
14. Registration of design where application for protection in convention country has been made.
15. Extension of time for applications under s. 14 in certain cases.
16. Protection of designs communicated under international agreements.

Register of designs, etc.

17. Register of designs.
18. Certificate of registration.
19. Registration of assignments, etc.
20. Rectification of register.
21. Power to correct clerical errors.
22. Inspection of registered designs.
23. Information as to existence of copyright.
24. Evidence of entries, documents, etc.

Legal proceedings and Appeals

25. Certificate of contested validity of registration.
26. Remedy for groundless threats of infringement proceedings.
27. The Court.
28. The Appeal Tribunal.

Powers and Duties of Registrar

Section

- 29. Exercise of discretionary powers of registrar.
- 30. Costs and security for costs.
- 31. Evidence before registrar.
- 32. Power of registrar to refuse to deal with certain agents.

Offences

- 33. Offences under s. 5.
- 34. Falsification of register, etc.
- 35. Fine for falsely representing a design as registered.

Rules, etc.

- 36. General power of Board of Trade to make rules, etc.
- 37. Provisions as to rules and Orders.
- 38. Proceedings of Board of Trade.

Supplemental

- 39. Hours of business and excluded days.
- 40. Fees.
- 41. Service of notices, etc., by post.
- 42. Annual report of registrar.
- 43. Savings.
- 44. Interpretation.
- 45. Application to Scotland.
- 46. Application to Northern Ireland.
- 47. Isle of Man.
- 48. Repeals, savings and transitional provisions.
- 49. Short title and commencement.

SCHEDULES:

First Schedule.—Provisions as to the use of registered designs for services of the Crown and as to rights of third parties in respect of such use.

Second Schedule.—Enactments repealed.

An Act to consolidate certain enactments relating to registered designs.

[16th December 1949.]

BE IT enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Registrable designs and proceedings for registration

1.—(1) Subject to the following provisions of this section, a design ^{Designs} may, upon application made by the person claiming to be the proprietor, ^{registrable} be registered under this Act in respect of any article or set of articles ^{under Act.} specified in the application.

(2) Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

(3) In this Act the expression “design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.

(4) Rules made by the Board of Trade under this Act may provide for excluding from registration thereunder designs for such articles, being articles which are primarily literary or artistic in character, as the Board think fit.

2.—(1) Subject to the provisions of this section, the author of a ^{Proprietor-} design shall be treated for the purposes of this Act as the proprietor of ^{ship of} the design: ^{designs.}

Provided that where the design is executed by the author for another person for good consideration, that other person shall be treated for the purposes of this Act as the proprietor.

(2) Where a design, or the right to apply a design to any article, becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design or as the proprietor of the design in relation to that article.

Proceedings
for registra-
tion.

3.—(1) An application for the registration of a design shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.

(2) For the purpose of deciding whether a design is new or original, the registrar may make such searches, if any, as he thinks fit.

(3) The registrar may refuse any application for the registration of a design or may register the design in pursuance of the application subject to such modifications, if any, as he thinks fit.

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

(5) Except as otherwise expressly provided by this Act, a design when registered shall be registered as of the date on which the application for registration was made, or such other date (whether earlier or later than that date) as the registrar may in any particular case direct:

Provided that no proceedings shall be taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(6) An appeal shall lie from any decision of the registrar under subsection (3) of this section.

Registration
of same
design in
respect of
other articles,
etc.

4.—(1) Where the registered proprietor of a design registered in respect of any article makes an application—

(a) for registration in respect of one or more other articles, of the registered design, or

(b) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

the application shall not be refused and the registration made on that application shall not be invalidated by reason only of the previous registration or publication of the registered design:

Provided that the period of copyright in a design registered by virtue of this section shall not extend beyond the expiration of the original and any extended period of copyright in the original registered design.

(2) Where any person makes an application for the registration of a design in respect of any article and either—

(a) that design has been previously registered by another person in respect of some other article; or

(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application the applicant had been the registered proprietor of that design.

5.—(1) Where, either before or after the commencement of this Act, an application for the registration of a design has been made, and it appears to the registrar that the design is one of a class notified to him by a competent authority as relevant for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the design, or the communication of such information to any person or class of persons specified in the directions.

Provisions
for secrecy
of certain
designs.

(2) Rules shall be made by the Board of Trade under this Act for securing that the representation or specimen of a design in the case of which directions are given under this section shall not be open to inspection at the Patent Office during the continuance in force of the directions.

(3) Where the registrar gives any such directions as aforesaid, he shall give notice of the application and of the directions to a competent authority, and thereupon the following provisions shall have effect, that is to say:—

- (a) the competent authority shall, upon receipt of such notice, consider whether the publication of the design would be prejudicial to the defence of the realm and unless a notice under paragraph (c) of this subsection has previously been given by that authority to the registrar, shall reconsider that question before the expiration of nine months from the date of filing of the application for registration of the design and at least once in every subsequent year;
- (b) for the purpose aforesaid, the competent authority may, at any time after the design has been registered or, with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design filed in pursuance of the application;
- (c) if upon consideration of the design at any time it appears to the competent authority that the publication of the design would not, or would no longer, be prejudicial to the defence of the realm, that authority shall give notice to the registrar to that effect;
- (d) on the receipt of any such notice the registrar shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application or registration, whether or not that time has previously expired.

(4) No person resident in the United Kingdom shall, except under the authority of a written permit granted by or on behalf of the

registrar, make or cause to be made any application outside the United Kingdom for the registration of a design of any class prescribed for the purposes of this subsection unless—

- (a) an application for registration of the same design has been made in the United Kingdom not less than six weeks before the application outside the United Kingdom; and
- (b) either no directions have been given under subsection (1) of this section in relation to the application in the United Kingdom or all such directions have been revoked:

Provided that this subsection shall not apply in relation to a design for which an application for protection has first been filed in a country outside the United Kingdom by a person resident outside the United Kingdom.

(5) In this section the expression “competent authority” means a Secretary of State, the Admiralty or the Minister of Supply.

Provisions
as to
confidential
disclosure,
etc.

6.—(1) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of—

- (a) the disclosure of the design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;
- (b) the disclosure of the design in breach of good faith by any person other than the proprietor of the design; or
- (c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design.

(2) An application for the registration of a design shall not be refused and the registration of a design shall not be invalidated by reason only—

- (a) that a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the proprietor of the design, at an exhibition certified by the Board of Trade for the purposes of this subsection;
- (b) that after any such display as aforesaid, and during the period of the exhibition, a representation of the design or any such article as aforesaid has been displayed by any person without the consent of the proprietor; or
- (c) that a representation of the design has been published in consequence of any such display as is mentioned in paragraph (a) of this subsection,

if the application for registration of the design is made not later than six months after the opening of the exhibition.

(3) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of the communication of the design by the proprietor thereof to a Government department or to any person authorised by

a Government department to consider the merits of the design, or of anything done in consequence of such a communication.

Effect of registration, etc.

7.—(1) The registration of a design under this Act shall give to Right the registered proprietor the copyright in the registered design, that given by registration is to say, the exclusive right in the United Kingdom and the Isle of Man to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything for enabling any such article to be made as aforesaid, whether in the United Kingdom or the Isle of Man or elsewhere.

(2) Subject to the provisions of this Act and of subsection (3) of section three of the Crown Proceedings Act, 1947, the registration of a design shall have the same effect against the Crown as it has against a subject.

8.—(1) Copyright in a registered design shall, subject to the provisions of this Act, subsist for a period of five years from the date of registration. Period of copyright.

(2) The registrar shall extend the period of copyright for a second period of five years from the expiration of the original period and for a third period of five years from the expiration of the second period if an application for extension of the period of copyright for the second or third period is made in the prescribed form before the expiration of the original period or the second period, as the case may be, and if the prescribed fee is paid before the expiration of the relevant period or within such further period (not exceeding three months) as may be specified in a request made to the registrar and accompanied by the prescribed additional fee.

9.—(1) In proceedings for the infringement of copyright in a registered design damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the marking of an article with the word "registered" or any abbreviation thereof, or any word or words expressing or implying that the design applied to the article has been registered, unless the number of the design accompanied the word or words or the abbreviation in question. Exemption of innocent infringer from liability for damages.

(2) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of copyright in a registered design.

10.—(1) At any time after a design has been registered any person interested may apply to the registrar for the grant of a compulsory licence in respect of the design on the ground that the design is not applied in the United Kingdom by any industrial process or means to Compulsory licence in respect of registered design.

the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case; and the registrar may make such order on the application as he thinks fit.

(2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties, granting a licence in accordance with the order.

(3) No order shall be made under this section which would be at variance with any treaty, convention, arrangement or engagement applying to the United Kingdom and any convention country.

(4) An appeal shall lie from any order of the registrar under this section.

Cancellation
of registra-
tion.

11.—(1) The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

(2) At any time after a design has been registered any person interested may apply to the registrar for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration thereof, new or original, or on any other ground on which the registrar could have refused to register the design; and the registrar may make such order on the application as he thinks fit.

(3) An appeal shall lie from any order of the registrar under the last foregoing subsection.

Use for
services of
Crown.

12. The provisions of the First Schedule to this Act shall have effect with respect to the use of registered designs for the services of the Crown and the rights of third parties in respect of such use.

International Arrangements

Orders in
Council as
to convention
countries.

13.—(1) His Majesty may, with a view to the fulfilment of a treaty, convention, arrangement or engagement, by Order in Council declare that any country specified in the Order is a convention country for the purposes of this Act:

Provided that a declaration may be made as aforesaid for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

(2) His Majesty may by Order in Council direct that any of the Channel Islands, any colony, any British protectorate or protected state, or any territory administered by His Majesty's Government in the United Kingdom under the trusteeship system of the United Nations, shall be deemed to be a convention country for the purposes of all or any of the provisions of this Act; and an Order made under this subsection may direct that any such provisions shall have effect, in relation to the territory in question, subject to such conditions or limitations, if any, as may be specified in the Order.

(3) For the purposes of subsection (1) of this section, every colony, protectorate, territory subject to the authority or under the suzerainty of another country, and territory administered by another country in accordance with a mandate from the League of Nations or under the trusteeship system of the United Nations, shall be deemed to be a country in the case of which a declaration may be made under that subsection.

14.—(1) An application for registration of a design in respect of which protection has been applied for in a convention country may be made in accordance with the provisions of this Act by the person by whom the application for protection was made or his personal representative or assignee: Registration of design where application for protection in convention country has been made.

Provided that no application shall be made by virtue of this section after the expiration of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

(2) A design registered on an application made by virtue of this section shall be registered as of the date of the application for protection in the convention country or, where more than one such application for protection has been made, the date of the first such application:

Provided that no proceedings shall be taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(3) An application for the registration of a design made by virtue of this section shall not be refused, and the registration of a design on such an application shall not be invalidated, by reason only of the registration or publication of the design in the United Kingdom or the Isle of Man during the period specified in the proviso to subsection (1) of this section as that within which the application for registration may be made.

(4) Where a person has applied for protection for a design by an application which—

- (a) in accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,

he shall be deemed for the purposes of this section to have applied in that convention country.

15.—(1) If the Board of Trade are satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, they may make rules empowering the registrar to extend the time for making application under subsection (1) of section fourteen of this Act for registration of a design in respect of which protection Extension of time for applications under s. 14 in certain cases.

has been applied for in that country in any case where the period specified in the proviso to that subsection expires during a period prescribed by the rules.

(2) Rules made under this section—

- (a) may, where any agreement or arrangement has been made between His Majesty's Government in the United Kingdom and the government of the convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of case specified in the rules, that an extension of time shall not be granted under this section unless the design has been communicated in accordance with the agreement or arrangement;
- (b) may, either generally or in any class of case specified in the rules, fix the maximum extension which may be granted under this section;
- (c) may prescribe or allow any special procedure in connection with applications made by virtue of this section;
- (d) may empower the registrar to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the rules;
- (e) may provide for securing that the rights conferred by registration on an application made by virtue of this section shall be subject to such restrictions or conditions as may be specified by or under the rules and in particular to restrictions and conditions for the protection of persons (including persons acting on behalf of His Majesty) who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a) of this subsection, and before the date of the application in question or such later date as may be allowed by the rules, may have imported or made articles to which the design is applied or may have made an application for registration of the design.

Protection
of designs
communi-
cated under
international
agreements.

16.—(1) Subject to the provisions of this section, the Board of Trade may make rules for securing that, where a design has been communicated in accordance with an agreement or arrangement made between His Majesty's Government in the United Kingdom and the government of any other country for the supply or mutual exchange of information or articles,—

- (a) an application for the registration of the design made by the person from whom the design was communicated or his personal representative or assignee shall not be prejudiced, and the registration of the design in pursuance of such an application shall not be invalidated, by reason only that the design has been communicated as aforesaid or that in consequence thereof—
 - (i) the design has been published or applied, or

- (ii) an application for registration of the design has been made by any other person, or the design has been registered on such an application;
- (b) any application for the registration of a design made in consequence of such a communication as aforesaid may be refused and any registration of a design made on such an application may be cancelled.

(2) Rules made under subsection (1) of this section may provide that the publication or application of a design, or the making of any application for registration thereof shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the rules, be presumed to have been in consequence of such a communication as is mentioned in that subsection.

(3) The powers of the Board of Trade under this section, so far as they are exercisable for the benefit of persons from whom designs have been communicated to His Majesty's Government in the United Kingdom by the government of any other country, shall only be exercised if and to the extent that the Board are satisfied that substantially equivalent provision has been or will be made under the law of that country for the benefit of persons from whom designs have been communicated by His Majesty's Government in the United Kingdom to the government of that country.

(4) References in the last foregoing subsection to the communication of a design to or by His Majesty's Government or the government of any other country shall be construed as including references to the communication of the design by or to any person authorised in that behalf by the government in question.

Register of designs, etc.

17.—(1) There shall be kept at the Patent Office under the control of the registrar a register of designs, in which there shall be entered the names and addresses of proprietors of registered designs, notices of assignments and of transmissions of registered designs, and such other matters as may be prescribed or as the registrar may think fit. Register of designs.

(2) Subject to the provisions of this Act and to rules made by the Board of Trade thereunder, the register of designs shall, at all convenient times, be open to inspection by the public; and certified copies sealed with the seal of the Patent Office of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(3) The register of designs shall be prima facie evidence of any matters required or authorised by this Act to be entered therein.

(4) No notice of any trust, whether expressed, implied or constructive, shall be entered in the register of designs, and the registrar shall not be affected by any such notice.

18.—(1) The registrar shall grant a certificate of registration in the prescribed form to the registered proprietor of a design when the design is registered. Certificate of registration.

(2) The registrar may, in a case where he is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he thinks it expedient, furnish one or more copies of the certificate.

Registration
of assign-
ments, etc.

19.—(1) Where any person becomes entitled by assignment, transmission or operation of law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a registered design, he shall apply to the registrar in the prescribed manner for the registration of his title as proprietor or co-proprietor or, as the case may be, of notice of his interest, in the register of designs.

(2) Without prejudice to the provisions of the foregoing subsection, an application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a registered design, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the registrar shall, upon proof of title to his satisfaction—

- (a) where that person is entitled to a registered design or a share in a registered design, register him in the register of designs as proprietor or co-proprietor of the design, and enter in that register particulars of the instrument or event by which he derives title; or
- (b) where that person is entitled to any other interest in the registered design, enter in that register notice of his interest, with particulars of the instrument (if any) creating it.

(4) Subject to any rights vested in any other person of which notice is entered in the register of designs, the person or persons registered as proprietor of a registered design shall have power to assign, grant licences under, or otherwise deal with the design, and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the design may be enforced in like manner as in respect of any other personal property.

(5) Except for the purposes of an application to rectify the register under the following provisions of this Act, a document in respect of which no entry has been made in the register of designs under subsection (3) of this section shall not be admitted in any court as evidence of the title of any person to a registered design or share of or interest in a registered design unless the court otherwise directs.

Rectification
of register.

20.—(1) The court may, on the application of any person aggrieved, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.

(2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the court under this section shall be given in the prescribed manner to the registrar, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the court.

(4) Any order made by the court under this section shall direct that notice of the order shall be served on the registrar in the prescribed manner; and the registrar shall, on receipt of the notice, rectify the register accordingly.

21.—(1) The registrar may, in accordance with the provisions of this section, correct any error in an application for the registration or in the representation of a design, or any error in the register of designs. Power to correct clerical errors.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the registrar proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the registered proprietor or the applicant for registration of the design, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

22.—(1) Subject to the following provisions of this section and to any rules made by the Board of Trade in pursuance of subsection (2) of section five of this Act, the representation or specimen of a design registered under this Act shall be open to inspection at the Patent Office on and after the day on which the certificate of registration is issued. Inspection of registered designs.

(2) In the case of a design registered in respect of an article of any class prescribed for the purposes of this subsection, no representation or specimen of the design filed in pursuance of the application shall, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to articles of that class, be open to inspection at the Patent Office except by the registered proprietor, a person authorised in writing by the registered proprietor, or a person authorised by the registrar or by the court:

Provided that where the registrar proposes to refuse an application for the registration of any other design on the ground that it is the same as the first-mentioned design or differs from that design only in immaterial details or in features which are variants commonly used in the trade, the applicant shall be entitled to inspect the representation or specimen of the first-mentioned design filed in pursuance of the application for registration of that design.

(3) In the case of a design registered in respect of an article of any class prescribed for the purposes of the last foregoing subsection,

the representation or specimen of the design shall not, during the period prescribed as aforesaid, be inspected by any person by virtue of this section except in the presence of the registrar or of an officer acting under him; and except in the case of an inspection authorised by the proviso to that subsection, the person making the inspection shall not be entitled to take a copy of the representation or specimen of the design or any part thereof.

(4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation or specimen of the design filed in pursuance thereof shall at any time be open to inspection at the Patent Office or be published by the registrar.

Information
as to
existence of
copyright.

23. On the request of any person furnishing such information as may enable the registrar to identify the design, and on payment of the prescribed fee the registrar shall inform him whether the design is registered, and if so, in respect of what articles, and whether any extension of the period of copyright has been granted and shall state the date of registration and the name and address of the registered proprietor.

Evidence
of entries,
documents,
etc.

24.—(1) A certificate purporting to be signed by the registrar and certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done shall be prima facie evidence of the matters so certified.

(2) A copy of any entry in the register of designs or of any representation, specimen or document kept in the Patent Office or an extract from the register or any such document, purporting to be certified by the registrar and to be sealed with the seal of the Patent Office, shall be admitted in evidence without further proof and without production of the original.

Legal proceedings and Appeals

Certificate of
contested
validity of
registration.

25.—(1) If in any proceedings before the court the validity of the registration of a design is contested, and it is found by the court that the design is validly registered, the court may certify that the validity of the registration of the design was contested in those proceedings.

(2) Where any such certificate has been granted, then if in any subsequent proceedings before the court for infringement of the copyright in the registered design or for cancellation of the registration of the design, a final order or judgment is made or given in favour of the registered proprietor, he shall, unless the court otherwise directs, be entitled to his costs as between solicitor and client:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

Remedy for
groundless
threats of
infringement
proceedings.

26.—(1) Where any person (whether entitled to or interested in a registered design or an application for registration of a design or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of the copyright in a registered design,

any person aggrieved thereby may bring an action against him for any such relief as is mentioned in the next following subsection.

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of the copyright in a registered design the registration of which is not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he has sustained thereby.

(3) For the avoidance of doubt it is hereby declared that a mere notification that a design is registered does not constitute a threat of proceedings within the meaning of this section.

27. Subject to the provisions of this Act relating to Scotland, ^{The Court.} Northern Ireland and the Isle of Man, any reference or application to the court under this Act, shall, subject to rules of court, be dealt with by such judge of the High Court as the Lord Chancellor may select for the purpose.

28.—(1) Any appeal from the registrar under this Act shall lie ^{The Appeal} to the Appeal Tribunal. ^{Tribunal.}

(2) The Appeal Tribunal shall be a judge of the High Court nominated for the purpose by the Lord Chancellor.

(3) The expenses of the Appeal Tribunal shall be defrayed and the fees to be taken therein may be fixed as if the Tribunal were a court of the High Court.

(4) The Appeal Tribunal may examine witnesses on oath and administer oaths for that purpose.

(5) Upon any appeal under this Act the Appeal Tribunal may by order award to any party such costs as the Tribunal may consider reasonable and direct how and by what parties the costs are to be paid; and any such order may be made a rule of court.

(6) The Appeal Tribunal shall, with regard to the right of audience, observe the same practice as before the first day of November, nineteen hundred and thirty-two, was observed in the hearing of appeals by the law officer.

(7) Upon any appeal under this Act the Appeal Tribunal may exercise any power which could have been exercised by the registrar in the proceeding from which the appeal is brought.

(8) Subject to the foregoing provisions of this section the Appeal Tribunal may make rules for regulating all matters relating to proceedings before it under this Act.

(9) An appeal to the Appeal Tribunal under this Act shall not be deemed to be a proceeding in the High Court.

Powers and Duties of Registrar

29. Without prejudice to any provisions of this Act requiring the registrar to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, the registrar shall give to ^{Exercise of discretionary powers of} registrar.

any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the registrar by or under this Act.

Costs and
security for
costs.

30.—(1) The registrar may, in any proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid; and any such order may be made a rule of court.

(2) If any party by whom application is made to the registrar for the cancellation of the registration of a design or for the grant of a licence in respect of a registered design, or by whom notice of appeal is given from any decision of the registrar under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the registrar, or, in the case of appeal, the Appeal Tribunal, may require him to give security for the costs of the proceedings or appeal, and in default of such security being given may treat the application or appeal as abandoned.

Evidence
before
registrar.

31.—(1) Subject to rules made by the Board of Trade under this Act the evidence to be given in any proceedings before the registrar under this Act may be given by affidavit or statutory declaration; but the registrar may if he thinks fit in any particular case take oral evidence in lieu of or in addition to such evidence as aforesaid, and may allow any witness to be cross-examined on his affidavit or declaration.

(2) Subject to any such rules as aforesaid, the registrar shall in respect of the examination of witnesses on oath and the discovery and production of documents have all the powers of an official referee of the Supreme Court, and the rules applicable to the attendance of witnesses in proceedings before such a referee shall apply to the attendance of witnesses in proceedings before the registrar.

Power of
registrar to
refuse to deal
with certain
agents.

32.—(1) Rules made by the Board of Trade under this Act may authorise the registrar to refuse to recognise as agent in respect of any business under this Act—

- (a) any individual whose name has been erased from, and not restored to, the register of patent agents kept in pursuance of rules made under the Patents Act, 1949;
- (b) any individual who is for the time being suspended in accordance with those rules from acting as a patent agent;
- (c) any person who has been convicted of an offence under section eighty-eight of the Patents Act, 1949;
- (d) any person who is found by the Board of Trade (after being given an opportunity to be heard) to have been convicted of any offence or to have been guilty of any such misconduct as, in the case of an individual registered in the register of patent agents aforesaid, would render him liable to have his name erased therefrom;
- (e) any person, not being registered as a patent agent, who in the opinion of the registrar is engaged wholly or mainly in acting as agent in applying for patents in the United Kingdom or

elsewhere in the name or for the benefit of a person by whom he is employed;

- (f) any company or firm, if any person whom the registrar could refuse to recognise as agent in respect of any business under this Act is acting as a director or manager of the company or is a partner in the firm.

(2) The registrar shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Offences

33.—(1) If any person fails to comply with any direction given under section five of this Act or makes or causes to be made an application for the registration of a design in contravention of that section, he shall be guilty of an offence and liable— Offences under s. 5.

- (a) on summary conviction, to imprisonment for a term not exceeding three months or to a fine not exceeding one hundred pounds, or to both such imprisonment and such fine, or
- (b) on conviction on indictment, to imprisonment for a term not exceeding two years or to a fine not exceeding five hundred pounds, or to both such imprisonment and such fine.

(2) Where an offence under section five of this Act is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to be guilty of that offence unless he proves that the offence was committed without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

34. If any person makes or causes to be made a false entry in the register of designs, or a writing falsely purporting to be a copy of an entry in that register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour. Falsification of register, etc.

35.—(1) If any person falsely represents that a design applied to any article sold by him is registered in respect of that article, he shall be liable on summary conviction to a fine not exceeding five pounds; and for the purposes of this provision a person who sells an article having stamped, engraved or impressed thereon or otherwise applied thereto the word "registered", or any other word expressing or implying that the design applied to the article is registered, shall be deemed to represent that the design applied to the article is registered in respect of that article. Fine for falsely representing a design as registered.

(2) If any person, after the copyright in a registered design has expired, marks any article to which the design has been applied with the word "registered", or any word or words implying that there is

a subsisting copyright in the design, or causes any such article to be so marked, he shall be liable on summary conviction to a fine not exceeding five pounds.

Rules, etc.

General
power of
Board of
Trade to
make rules,
etc.

36.—(1) Subject to the provisions of this Act, the Board of Trade may make such rules as they think expedient for regulating the business of the Patent Office in relation to designs and for regulating all matters by this Act placed under the direction or control of the registrar or the Board, and in particular, but without prejudice to the generality of the foregoing provision—

- (a) for prescribing the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be filed at the Patent Office, and for requiring copies to be furnished of any such representations, specimens or documents;
- (b) for regulating the procedure to be followed in connection with any application or request to the registrar or in connection with any proceeding before the registrar and for authorising the rectification of irregularities of procedure;
- (c) for regulating the keeping of the register of designs;
- (d) for authorising the publication and sale of copies of representations of designs and other documents in the Patent Office;
- (e) for prescribing anything authorised or required by this Act to be prescribed by rules made by the Board.

(2) Rules made under this section may provide for the establishment of branch offices for designs and may authorise any document or thing required by or under this Act to be filed or done at the Patent Office to be filed or done at the branch office at Manchester or any other branch office established in pursuance of the rules.

Provisions as
to rules and
Orders.

37.—(1) Any rules made by the Board of Trade under this Act shall be advertised twice in the Journal.

(2) Any rules made by the Board of Trade in pursuance of section fifteen or section sixteen of this Act, and any order made, direction given, or other action taken under the rules by the registrar, may be made, given or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the coming into operation of the rules or of this Act, as may be specified in the rules.

(3) Any power to make rules conferred by this Act on the Board of Trade or on the Appeal Tribunal shall be exercisable by statutory instrument; and the Statutory Instruments Act, 1946, shall apply to a statutory instrument containing rules made by the Appeal Tribunal in like manner as if the rules had been made by a Minister of the Crown.

(4) Any statutory instrument containing rules made by the Board of Trade under this Act shall be subject to annulment in pursuance of a resolution of either House of Parliament.

(5) Any Order in Council made under this Act may be revoked or varied by a subsequent Order in Council.

38.—(1) Anything required or authorised by this Act to be done by, to or before the Board of Trade may be done by, to or before the President of the Board of Trade, any secretary, under-secretary or assistant secretary of the Board, or any person authorised in that behalf by the President. Proceedings of Board of Trade.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary, under-secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Supplemental

39.—(1) Rules made by the Board of Trade under this Act may specify the hour at which the Patent Office shall be deemed to be closed on any day for purposes of the transaction by the public of business under this Act or of any class of such business, and may specify days as excluded days for any such purposes. Hours of business and excluded days.

(2) Any business done under this Act on any day after the hour specified as aforesaid in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

40. There shall be paid in respect of the registration of designs and applications therefor, and in respect of other matters relating to designs arising under this Act, such fees as may be prescribed by rules made by the Board of Trade with the consent of the Treasury. Fees.

41. Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post. Service of notices, etc., by post.

42. The Comptroller-General of Patents, Designs and Trade Marks shall, in his annual report with respect to the execution of the Patents Act, 1949, include a report with respect to the execution of this Act as if it formed a part of or was included in that Act. Annual report of registrar.

43.—(1) Nothing in this Act shall be construed as authorising or requiring the registrar to register a design the use of which would, in his opinion, be contrary to law or morality. Savings.

(2) Nothing in this Act shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use articles forfeited under the laws relating to customs or excise.

Interpre-
tation.

44.—(1) In this Act, except where the context otherwise requires, the following expressions have the meanings hereby respectively assigned by them, that is to say—

“Appeal Tribunal” means the judge nominated under section twenty-eight of this Act.

“article” means any article of manufacture and includes any part of an article if that part is made and sold separately;

“assignee” includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

“copyright” has the meaning assigned to it by subsection (1) of section seven of this Act;

“court” means the High Court;

“design” has the meaning assigned to it by subsection (3) of section one of this Act;

“Journal” means the journal published by the comptroller under the Patents Act, 1949;

“prescribed” means prescribed by rules made by the Board of Trade under this Act;

“proprietor” has the meaning assigned to it by section two of this Act;

“registered proprietor” means the person or persons for the time being entered in the register of designs as proprietor of the design;

“registrar” means the Comptroller-General of Patents Designs and Trade Marks;

“set of articles” means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

(2) Any reference in this Act to an article in respect of which a design is registered shall, in the case of a design registered in respect of a set of articles, be construed as a reference to any article of that set.

(3) Any question arising under this Act whether a number of articles constitute a set of articles shall be determined by the registrar; and notwithstanding anything in this Act any determination of the registrar under this subsection shall be final.

(4) For the purposes of subsection (1) of section fourteen and of section sixteen of this Act, the expression “personal representative”, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside the United Kingdom.

45. In the application of this Act to Scotland—

Application
to Scotland.

- (1) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to designs; and with reference to any such proceedings, the term "the Court" shall mean the Court of Session;
- (2) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the registrar, and he shall rectify the register accordingly;
- (3) The expression "injunction" means "interdict"; the expression "arbitrator" means "arbiter"; the expression "plaintiff" means "pursuer"; the expression "defendant" means "defender".

46. In the application of this Act to Northern Ireland—

Application
to Northern
Ireland.

- (1) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Northern Ireland in any proceedings relating to designs; and with reference to any such proceedings the term "the Court" means the High Court in Northern Ireland;
- (2) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the registrar, and he shall rectify the register accordingly;
- (3) References to enactments of the Parliament of the United Kingdom shall be construed as references to those enactments as they apply in Northern Ireland;
- (4) References to a Government department shall be construed as including references to a department of the Government of Northern Ireland;
- (5) The expression "summary conviction" shall be construed as meaning conviction subject to, and in accordance with, the Petty Sessions (Ireland) Act, 1851, and any Act (including any Act of the Parliament of Northern Ireland) amending that Act.

47. This Act shall extend to the Isle of Man subject to the following modifications:—

Isle of Man.

- (1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a design competent to those courts;
- (2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court;

- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeals,
savings, and
transitional
provisions.

48.—(1) Subject to the provisions of this section the enactments specified in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that Schedule.

(2) Subject to the provisions of this section, any Order in Council, rule, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request or thing made, issued, given or done under any enactment repealed by this Act shall, if in force at the commencement of this Act, and so far as it could have been made, issued, given or done under this Act, continue in force and have effect as if made, issued, given or done under the corresponding enactment of this Act.

(3) Any register kept under the Patents and Designs Act, 1907, shall be deemed to form part of the corresponding register under this Act.

(4) Any design registered before the commencement of this Act shall be deemed to be registered under this Act in respect of articles of the class in which it is registered.

(5) Where, in relation to any design the time for giving notice to the registrar under section fifty-nine of the Patents and Designs Act, 1907, expired before the commencement of this Act and the notice was not given, subsection (2) of section six of this Act shall not apply in relation to that design or any registration of that design.

(6) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.

(7) Nothing in the foregoing provisions of this section shall be taken as prejudicing the operation of section thirty-eight of the Interpretation Act, 1889, (which relates to the effect of repeals).

Short title
and commen-
cement.

49.—(1) This Act may be cited as the Registered Designs Act, 1949.

(2) This Act shall come into operation on the first day of January, nineteen hundred and fifty, immediately after the coming into operation of the Patents and Designs Act, 1949.

Appendix E

ARTICLE 4

A.—1. Any person who has duly deposited an application for a patent, or for the registration of a utility model, industrial design or model or trade mark in one of the countries of the Union, or his legal representative or assignee, shall enjoy, for the purposes of deposit in the other countries, a right of priority during the periods hereinafter stated.

2. Every application which, under the domestic law of any country of the Union, or under international treaties concluded between several countries of the Union, is equivalent to a regular national application, shall be recognised as giving rise to a right of priority.

B.—Consequently, a subsequent deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another deposit, by publication or exploration of the invention, by the putting on sale of copies of the design or model, or by use of the mark, and these acts cannot give rise to any rights of third parties or of personal possession. Rights acquired by third parties before the date of the first application which serves as a basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C.—1. The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs or models and trade marks.

2. These periods start from the date of deposit of the first application; the day of deposit is not included in the period.

3. If the last day of the period is a dies non or a day when the Office is not open to receive the deposit of applications in the country where protection is claimed, the period shall be extended until the first following working day.

D.—1. Any person desiring to take advantage of the priority of a previous deposit shall be bound to make a declaration giving particulars as to the date of such deposit and the country in which it was made. Each country will determine for itself the latest time at which such declaration must be made.

2. These particulars shall be mentioned in the publications issued by the competent authority, in particular on the patents and the specifications relating thereto.

3. The countries of the Union may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings, etc.) previously deposited. The copy, certified as correct by the authority by whom the application was received, shall not require any legal authentication, and may in any case be deposited at any time within three months from the deposit of the subsequent application without payment of fee. They may require it to be accompanied by a certificate from the proper authority showing the date of the deposit, and also by a translation.

4. No other formalities may be required for the declaration of priority at the time of depositing the application. Each of the countries of the Union shall decide for itself what consequence shall follow the omission of the formalities prescribed by the present article, but such consequences shall in no case be more serious than the loss of the right of priority.

5. Subsequently, further proof in support of the declaration may be required.

E.—1. Where an application for the registration of an industrial design or model is deposited in a country in virtue of a right of priority based on a previous deposit of an application for registration of a utility model, the period of priority shall only be that fixed for industrial designs or models.

2. Further, it is permissible to deposit in a country an application for the registration of a utility model in virtue of a right of priority based on the deposit of a patent application and vice versa.