IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1997] SGHC 280

Suit 63/1995

Between

Essen System Builders (S) Pte Ltd
Coverland S A (formerly known as Generale Francaise de Ceramique)

… *Plaintiff*

And

Essential Roofing Systems Pte Ltd
Ang Kian Kok
Sim Guan Seng

… *Defendant*

GROUNDS OF DECISION

Version No 1: 20 Nov 2026 (00:35 hrs)

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Essen System Builders (S) Pte Ltd and Another v Essential Roofing Systems Pte Ltd and Others

[1997] SGHC 280

Suit 63/1995
Lai Siu Chiu J
31 October 1997

Judgment:

Cur Adv Vult

The facts

1. Essen System Builders (S) Pte Ltd (the plaintiffs) are a Singapore company (incorporated on 15 July 1983) and carry on the business of general building contractors including the manufacture and supply of roofing materials and tiles. Together with Coverland SA (Coverland) a French company, the plaintiffs are the registered proprietors of Registered Design No.1038049 (the Registered Design) in respect of a roof tile (which the plaintiffs say is the Singapore tile) under the United Kingdom Registered Designs Act 1949 (the UK Act). Under s 2 of the United Kingdom Designs (Protection) Act Cap 339 (the Singapore Act), the Registered Design enjoys the like privileges and protection in Singapore as afforded under the UK Act. The certificate of registration of the Registered Design was issued on 13 November 1986 and upon its expiry on 13 November 1996, the plaintiffs applied for its renewal for another five (5) years.

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On 4 November 1992, the plaintiffs placed notices in "The Straits Times" in Singapore and in "The New Straits Times" in Malaysia, informing the trade and the public of their rights in the Registered Design.

2. Essential Roofing Systems Pte Ltd (the first defendants) are a Singapore company incorporated on 12 August 1994 and carry on the business of renovation contractors and roofing works. The second and third defendants were the only directors and shareholders of the first defendants at the time of incorporation.

3. Some time in November 1994, it came to the attention of the plaintiffs that the first defendants were manufacturing and or selling roof tiles which were substantially similar to the Singapore tile; the first defendants supplied and or sold such tiles to various contractors in Singapore. On 5 December 1994, the plaintiffs wrote to give notice of the Registered Design to the first defendants (with copies to the second and third defendants) and requested the latter to cease dealing in the offending tiles within ten (10) days of the date of their letter. Apart from a request to the plaintiffs for details of the design registration by their reply dated 15 December 1994, the first defendants did not accede to the plaintiffs' request; they continued to deal in the offending tiles. Consequently on 5 January 1995, the plaintiffs' solicitors issued a 'cease and desist' letter to the first defendants. There followed an exchange of correspondence between the plaintiffs' and the defendants' solicitors, with no result.

4. Meanwhile, on 11 September 1994 the plaintiffs' managing director one Jared Chew Boon Hee (Chew) left their services. Chew was also a shareholder of the plaintiffs, the other shareholder (who held the majority shares) was Kengfu Industries (S) Pte Ltd (Kengfu). Chew then set up a company called J-Roberts

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Media Pte Ltd which occupied the same premises as the first defendants, namely at #07-03, Midland House. Soon after Chew's resignation, the plaintiffs lost the services of ten (10) of their key personnel who later joined the first defendants. On 2 October 1995, Chew became a director of the first defendants.

5. Five (5) days after their solicitors' letter dated 5 January 1995, the plaintiffs arranged for HS Intellectual Property Services (the private investigators) to purchase some of the offending tiles from the first defendants; this was followed by the issue of the writ herein two (2) days later by the plaintiffs and Coverland. Subsequently, on 16 March 1995, the plaintiffs and Coverland obtained an interim injunction against the defendants to restrain them from infringing the Registered Design until the trial or further order.

The pleadings

6. Coverland and the plaintiffs alleged in their statement of claim that the first defendants had infringed their copyright in the Registered Design by making, importing, selling, offering for sale or otherwise using in Singapore for the purposes of trade or business, a roof tile (the China tile) to which the registered design or, a design not substantially different therefrom, had been applied. The two (2) plaintiffs gave two (2) instances of such infringement, including the sale to the private investigators.

7. The two (2) plaintiffs further alleged that the second and third defendants had control and management of the first defendants at all material times, as shareholders and directors. As such, they knew and/or must have known of the acts of infringement by the first defendants and/or authorised, directed and/or procured the commission of such acts.

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8. Coverland and the plaintiffs averred that the second and third defendants were aware and/or had reasonable grounds for supposing that the design of the Singapore tile was registered due to the fact that the plaintiffs' former employees joining the first defendants' services and, the notices placed in the Singapore and Malaysian newspapers.

9. The two (2) plaintiffs prayed for injunctive reliefs with consequential orders and claimed damages, alternatively an account of profits, against all the defendants.

10. The first defendants in their defence admitted the validity and subsistence of the Registered Design in Singapore but denied they had infringed the same as alleged by the two plaintiffs or at all. Alternatively, the first defendants contended that if they did infringe the copyright, they did so without knowledge of the existence of the Registered Design.

11. In the further alternative, the first defendants contended that neither the plaintiffs nor Coverland had acquired exclusive privileges and rights in the Registered Design in Singapore, and particularised their objections as follows:

a. the Registered Design as at the date of the registration was neither new nor original -- it is general knowledge that the registration was in respect of V-shaped roof tiles which have been commonly used in Singapore since pre-war days;

b. the Registered Design does not comply with s 1(3) of the UK Act in that it does not consist of or contain any features of shape configuration pattern or ornament applied to a roof tile by any industrial process or means or features which in the finished article appeal to and or are judged solely by the eye;

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c. if (which is denied) the design as registered has any features of novelty, the same are purely matters of pattern or ornament and not of shape or configuration.

Therefore the plaintiffs and Coverland were not entitled to the reliefs claimed or to any reliefs.

12. Consequent on their objections, the first defendants counterclaimed for a declaration that the plaintiffs and Coverland had not acquired exclusive privileges and rights in the Registered Design, in Singapore. They further counterclaimed for loss and damage which they suffered resulting from the allegations of infringement made by the two plaintiffs.

13. On their part, the second and third defendants filed a joint defence. Apart from admitting the validity and subsistence of the Registered Design, the two (2) defendants denied that they had infringed the same as alleged by the plaintiffs or at all, for the same reasons raised in the defence of the first defendants. Both defendants also contended they could not have authorised, directed and/or procured the commission of the infringing acts by the first defendants, pointing out that the first defendants were only incorporated on 12 August 1994 whereas the certificate of registration for the Registered Design was issued since 13 November 1986.

The evidence

(i) the plaintiffs' case

14. The plaintiffs called only one (1) witness for their case, Kho Choon Keng (Kho) who has been their director since 1991 and in charge of their operations

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since 1994. In his affidavit evidence-in-chief, Kho set out the facts I have outlined above. He clarified that the certificate of registration for the Registered Design was originally issued to John Lysaght and CMPR which was the former name of Generale Francaise de Ceramique (Generale Francaise) which in turn changed its name to Coverland. By an assignment dated 7 June 1987 (the assignment) between Generale Francaise, John Lysaght and the plaintiffs, John Lysaght assigned its rights in the Registered Design and in another design (registered as no.1038048) to the plaintiffs. The assignment was lodged with the Patent Office of the Design Registry in the United Kingdom on 30 July 1987 and recorded on 22 July 1988. On 12 July 1988, Generale Francaise applied to record its change of name from the former CMPR and the same was effected on 22 July 1988.

15. Since the date of the registration of the Registered Design, Kho said the plaintiffs had manufactured and supplied the Singapore tile (see D1) to many contractors and customers for use in various building projects including restoration/conservation projects such as Bugis Junction, Clarke Quay, Tanjong

Pagar, Telok Ayer, Empress Place Museum, Raffles Hotel and shophouses in "Little India". The average annual sales for these tiles for the past five (5) years exceeded $1.3m.

16. Kho further deposed in his affidavit to proceedings which Chew had instituted against the plaintiffs after his departure from the company, one was Companies Winding Up Petition 211 of 1994 and the other was Originating Petition No 2 of 1995. On 2 February 1995 the court (which heard both petitions) dismissed the Originating Petition and the Winding-Up Petition was

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stayed and eventually withdrawn after Kengfu complied with the court's order to buy out Chew's shares.

17. Kho deposed that on 31 October 1996 Coverland applied to withdraw from the proceedings and the order was granted, with the defendants' consent, on 20 November 1996. He believed it was because Coverland felt that it was not commercially feasible to incur the substantial costs involved in such litigation.

18. Kho deposed that the first defendants published a notice in "The Straits Times" on 11 December 1995 (see 1AB84), on registered design no.2046774 (the defendants' tile) which roof tile was substantially similar to the Registered Design, stating that the novelty lay in its shape and configuration and warned against infringement. The notice contradicted the defence filed by the defendants that there was no novelty in the Registered Design. There was no basis for the defendants' allegation that the Registered Design was invalid as Kho believed that customers chose the Singapore tile for its aesthetic appeal. He disclosed that the first defendants were sued by another party Chua Chye Hong Company (Chua) in similar proceedings (Suit 263 of 1995) for infringement of registered design no.2024323 (Chua's tile) and that the first defendants consented to a permanent injunction in that suit.

19. Turning now to his cross-examination, Kho said it was Chew who had designed the Singapore tile prior to Kho's joining the plaintiffs. Kho agreed that it was designed such that one of the tile's four (4) sections, namely the second quadrant, was narrower than the rest (hereinafter this narrow part will be called the kink). Kho agreed that the kink in the Singapore tile was different from the kink in the defendants' tile where it was positioned in the first quadrant but, the shape of the two (2) tiles was the same. Whatever the position of the kink, Kho

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agreed that its purpose was to serve as an interlocking mechanism so that the tiles, when laid on a sloping roof in an overlapping pattern, will not slide. Without a kink, tiles will have to be held down by cement or steel wires, which was the practice in the old days. Because of the different positioning of the kink, Kho acknowledged that one type of tile, in this case the Singapore tile, cannot be interlocked with another type of tile, for example the offending China tile (exh D2) of the first defendants. This was because in the China tile, although the kink was also in the second quadrant, its dimensions were different from those of the Singapore tile. Kho disagreed with counsel's suggestion that the kink (and also the legs in the case of the Singapore tile) served a functional purpose; he felt another purpose of the design was its aesthetic appeal. He acknowledged however that once tiles are laid, only the profile can be seen, not the kinks and legs save perhaps for those tiles at the edge of the roof.

20. Kho was unaware that the defendants' tile (D4) had been rejected by the Urban Redevelopment Authority (URA) for conservation projects; however he was aware that the URA required tiles which have **V** not **U** profile. Kho agreed that V profile tiles are commonly used in Singapore and that customers of tiles would normally be people in the trade such as architects, contractors and developers with perhaps, some homeowners. For government projects, it would sometimes be the Public Works Department (PWD) that specified the type of tile required.

21. Kho clarified that Chew did not in fact resign from the plaintiffs' employment -- Chew's service contract was not renewed when it expired on 11 September 1994, because of the winding-up petition he had filed earlier. Subsequently the plaintiffs instituted proceedings against Chew to enforce a restraint of trade clause in his service contract but failed.

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22. Kho admitted that he had no evidence that Chew was in the employment of the first defendants at the time this suit was filed. Neither did he have any proof that the second and or third defendants induced the plaintiffs' former employees to leave the plaintiffs' services. Kho denied he had a personal vendetta against Chew but agreed that a person like Chew, who had years of experience in the roof tile industry, would most likely join another company in the same line of business after leaving the plaintiffs' services; similarly so would the plaintiffs' former employees.

23. It emerged from Kho's cross-examination and which was supported by copies of the newspaper notices produced in court (see 1AB17-18), that the Registered Design made no reference to the Singapore tile; neither was the Registered Design number affixed to the Singapore tile. Hence no one reading the advertisements would think it referred to the Singapore tile. Kho however felt that people in the trade would know that it was the plaintiffs' tile, but counsel pointed out that this may not be correct as, the plaintiffs (by Kho's own admission) sold probably ten (10) if not more, types of tiles of which at least two (2) were registered designs; it would not be possible to equate the Singapore tile with the Registered Design.

24. I turn now to the testimony adduced from the defendants' witnesses starting with Chew. In his affidavit evidence-in-chief, Chew (PW1) deposed that he founded the company and was the managing-director of the plaintiffs until 11 September 1994. During his period of employment with the plaintiffs, Chew said he worked on several prototypes of V profile tiles that would provide the same aesthetic appeal as existing V shape clay tiles found on the roofs of pre-war shophouses in Singapore.

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25. In 1984 Chew sent to Coverland's office samples (the samples) of roof tiles he had taken from the building now known as CHIJMES. Subsequently he visited Coverland's headquarters in France and discussed the possibility of designing a V profile tile similar to the samples. Eventually Coverland came up with a design which was a cross between the samples and their own Canal-stop profile tile (see 1AB91); it became known as the "baby stop" tile -- it had a V profile but was three (3) times the size of the samples and was rounded at the apex. He was unable to obtain a patent for the design on his lawyer's advice so he decided to apply for design registration instead. Chew's lawyers then advised him to try to obtain a patent for a total roof system so that if he failed, it would still be possible for him to apply for the design of the "baby stop" tile to be registered. He was unsuccessful in his patent application because it was not a new invention but an improvement on an existing V profile tile. However, he succeeded in obtaining design registration namely the Registered Design; this was the first design registration (see prototype in D3) the ownership of which was later assigned to the plaintiffs at his request for the sum of $1, since he was the prime mover behind the registration.

26. After the Registered Design was obtained, Chew said he started marketing and selling the "baby stop" tile to the URA for the first ever roof restoration project in Singapore. However the "baby stop" tile was not considered suitable for URA projects for various reasons including the fact that the apex was more **U** than **V** shaped. In order to secure URA's tender, Chew completely modified the "baby-stop" tile such that it was totally different from the Registered Design; it was the birth of the Singapore tile.

27. Chew explained that the Singapore tile became the most popular and standard tile for use on the roofs of local houses after having been used for

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almost every roof restoration project put up for tender, including the most prestigious and sought after Raffles Hotel project. To secure the Raffles Hotel tender, Chew made further modifications to the Singapore tile by: 1) producing a five (5) colour range to give a "rustic" appearance and to create a "staggered" effect, 2) reducing the extent one (1) tile overlapped another so that usage was reduced from 120 to 100 pieces per square metre and correspondingly construction costs; the V profile however was retained; Chew's modifications were accepted by the URA.

28. Thereafter Chew said he standardised all the tiles to the specifications of those used for Raffles Hotel and he called them the "Raffles baby stop" tiles. Therefore all purchases from Coverland of the Singapore tile were in truth purchases of the new "Raffles baby stop" tiles. Hence the plaintiffs were wrong when they claimed that the Singapore tile was based on and that it was the same as, the Registered Design -- the Registered Design is substantially different from the Singapore tile in length, size and angle of the ends; the two (2) tiles cannot be interlocked either, the Singapore tile being smaller.

29. Chew pointed out that as the person solely responsible for its introduction in the market he, better than anyone else, would know that the Singapore tile is not the same as the Registered Design. The first defendants' allegedly offending China tile is also substantially different from the Registered Design for the same reasons as for the Singapore tile.

30. The Registered Design is also not novel as its design is based on existing V profile tiles -- all the features are functional in nature although they may vary slightly from tile to tile; the purpose of the kink is to hold the adjoining tile to

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prevent sliding of the tiles when laid. V shape tiles are very common and are found practically on all roofs in Singapore.

31. Cross-examined, Chew agreed that the Registered Design was novel and had eye-appeal as otherwise it would not have obtained registration in the first place. However he believed that he obtained approval of the Registered Design because of the interlocking feature of the kink, not because of eye-appeal. Indeed it was the first tile to have the interlocking feature, hence its novelty. Similarly Chua's tile (see P3) is special because of the kink, so also the China tile (P2); it cannot be aesthetics because, if you compare the three (3) tiles, they all have a **V** shape. Chew agreed however, that the designs of the kink in the Registered Design, Chua's tile and the China tile are different, despite their common V shape.

32. Chew explained that in 1992, he intended to but, was unable to register the Singapore tile because he was advised by his lawyers that it was too late, the tile having been used for many years. He intended to register the Singapore tile for commercial reasons, not because it had eye-appeal although that was one of the factors. Similarly he registered the China tile for commercial reasons and not because it was novel or had eye-appeal. The Registered Design was never used for any restoration projects and, competitors copied not that but the Singapore, tile. Without design registration protection, his lawyers advised Chew that his chances of success against his competitors who copied the Singapore tile were slim, so he did not sue.

33. Chew pointed out that the Singapore tile is the same as the China tile in that both can interlock but the China tile is substantially different in appearance from the Registered Design. Further, the interlocking mechanism of the Singapore

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tile is unique as it is the only tile that can hold 3-4 pieces together without falling, for which its wavy edge was part of the design, although not an essential feature. Similarly, all V profile tiles have a tapered end. However, to a layman, the impression is that the Singapore tile and the China tile are the same, even Kho did not realize the difference.

34. Chew said he became a director of the first defendants in October and its managing director in December, 1995. He said his company J-Roberts Media only started operating at the first defendants' premises in September 1994. He explained that he was not involved with the first defendants immediately after he left the plaintiffs' services as he went to work in Malaysia, where he effected a joint venture between Essential Roofing Sdn Bhd of which he was a director, and another company. After he had joined the first defendants, and just before the plaintiffs obtained their interim injunction, the third defendant asked Chew about the Singapore tile, Chew said it was not design registered. He added however that that factor would not stop the plaintiffs from suing the first defendants; Kho had sued the first defendants previously regardless of whether the plaintiffs could win. Based on his assurance to the third defendant, Chew said the first defendants placed orders with their supplier for the China tiles. In fact, China was the first defendants' only source of supply as Kho made sure the first defendants could not buy from Coverland. Although by then one of the plaintiffs' former employees had started working for the first defendants, none of these ex-employees (including Chew's wife Yeo Puay Soon who was the plaintiffs' senior sales executive) knew that the Singapore tile was not registered (and for that matter neither did Kho) because only he, Chew, was in charge of such matters when he worked for the plaintiffs.

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35. Chew explained that the second defendant was only a passive investor and was not involved in the running of the first defendants' business. Similarly the third defendant was not involved in the business of the first defendants as he was/is an accountant. Neither the second nor the third defendant were involved in the negotiations leading to the Malaysian joint venture. In any case, Chew only liaised with the third defendant, never with the second. However, it was the third defendant who instructed solicitors to act for the first defendants and handled all the subsequent correspondence, Chew was not involved, not even in the decision by the first defendants to consent to judgment on Chua's suit in January 1996. In any case the first defendants had clearly infringed Chua's registered design as, their Chinese manufacturer supplied to them Chua's tiles for one order of China tiles, to cover a shortfall in the supply of the latter.

36. In support of Chew's evidence, the defendants called one Alan Bourgeois (Bourgeois) to testify. Bourgeois (DW2) is the managing-director of F. Bourgeois Restoration Consultant Asia Pte Ltd (FBRCA) and is a specialist in roofing works and all matters relating to the same. FBRCA carried out the roof restoration for such buildings as the Victoria Memorial Hall, St. Andrew's Cathedral and CHIJMES. Because of his speciality, Bourgeois said he was familiar with almost all the roof tiles in Singapore, West Malaysia and France. He had compared the Registered Design with the Singapore tile and opined they were substantially different, namely: (i) in the angle of curve at the apex; (ii) the exposed lengths (after overlapping) and (iii) in size, the Registered Design being larger. The two (2) tiles cannot be interlocked either. He deposed there were similar differences between the Registered Design and the China tile. As for the kinks, found in all V profile tiles, its purpose was solely functional -- to interlock one piece of tile with another piece of the same design.

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37. Cross-examined, Bourgeois said FBRCA and a Malaysian company (Batu Arang Bricks & Tiles Bhd) were the joint applicants for a registered design in respect of a roof tile which he designed; it had a V profile and its novelty was in the stopper the purpose of which was to ensure the stability of the tile for different kinds of pitch roofs and to prevent it from sliding down. He acknowledged that V shape tiles come in different dimensions but, the curvature was the same although some V profile tiles in the market are more eye-catching than others.

38. The third defendant Sim Guan Seng (Sim) testified next. In his affidavit Sim (DW3) denied that the first defendants had infringed the Registered Design. Even if there was such infringement, Sim said neither he nor the second defendant should be liable as they had no knowledge of the Registered Design. Although he is/was a director of the first defendants, he was/is a certified public accountant and practised accordingly under his own firm. He invested in the first defendants and persuaded the second defendant (Ang) who is his cousin, to do the same, because he thought the business of selling tiles was potentially very profitable; he introduced Chew to the second defendant. Sim said he was particularly interested in and had hoped that the first defendants would be able to obtain, tiles (other than those which had design registration) from Coverland as well as secure Coverland's agency but, that did not materialize. As investors, there was no reason for Sim and the second defendant, to be aware or to make themselves aware of, the existence of the Registered Design as the first defendants were only incorporated on 14 August 1994, well after the Registered Design was registered in November 1986.

39. Although he was not an expert in the field, Sim said he was nonetheless aware that V profile tiles had been around in Singapore for a very long time,

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since before the Second World War, albeit in various sizes and with variations in shape. For that reason he instructed a firm of private investigators (Commercial Private Investigation and Security) to gather such evidence (see affidavit of private investigator Moy Yik Wah). On his part, Sim was aware of at least three (3) companies which distributed V profile tiles, besides the first defendants and the plaintiffs.

40. Sim reiterated the testimony of Chew and Bourgeois, on the differences between the Registered Design, the China and the Singapore, tiles. He added that the Registered Design tile was U not V profile. As a result of the interlocutory injunction obtained by the plaintiffs on 16 March 1995, Sim alleged that the first defendants had suffered loss and damage. This included loss of business opportunities resulting from letters sent by the plaintiffs to the first defendants' customers (see 2AB44-45) alleging that the first defendants had infringed the plaintiffs' rights as proprietor of the Registered Design. In fact, two (2) customers of the first defendants declined to order the China tiles and instead, ordered other tiles from the first defendants.

41. Cross-examined, Sim confirmed that before he received the letter of demand (dated 5 December 1994) from the plaintiffs (alleging the first defendants had infringed the Registered Design as well as the "baby stop" tile), he had checked with Chew who assured him there would be no problems if the first defendants ordered tiles from China, Chew told him the Singapore tile was not design registered. Sim also spoke to the plaintiffs' consultant one Philip Tan who was his close friend from schooldays; Philip Tan repeated Chew's assurance. As Sim had no reason to doubt what Chew said, Sim then instructed the first defendants' staff (in October 1994) to place orders for tiles from China, since Coverland was not going to be their supplier. Neither Chew nor Philip Tan nor even the

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plaintiffs' ex-employees who joined the first defendants' services, told Sim about the plaintiffs' rights in design registration.

42. After receipt of the letter of demand, Sim admitted that the first defendants continued to supply the China tiles to customers to fulfill existing orders. He explained this was a business decision; in any case the letter of demand did not give particulars of the design registration alleged -- the particulars were only furnished by the plaintiffs under cover of their letter dated 20 December 1994, upon receipt of which Sim consulted his lawyers, who then replied to the plaintiffs' solicitors on the letter of demand. As a passive investor (albeit a major shareholder), Sim said Ang did not involve himself in the business of the first defendants -- Ang relied on Chew's expertise for the operations side of the business whilst Sim took care of the administrative side; Ang would not know about the goings-on in the company, unless Sim advised him. Even then, as in the proceedings by the plaintiffs and Chua, Sim said Ang when told, left it to Sim to handle. Sim admitted that Ang would know that the first defendants ordered tiles from China since initially, Ang would have signed such documents as trust receipts and letters of credit for the company.

43. I turn now to Ang's testimony. Ang is the managing director (for 10 years) and majority shareholder of a shipbuilding and ship repair company (President Marine Pte Ltd). He reiterated Sim's testimony that he was only a passive investor in the first defendants and that it was Sim who persuaded him to invest in the company. Ang said his main contribution to the company was financial support, and he had no hand in the day to day operations of, the first defendants. He re-asserted that neither he nor Sim knew or could have known, about the Registered Design. Ang professed ignorance of V profile roof tiles and whether the tiles manufactured and sold by the first defendants breached the rights of the

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plaintiffs as proprietors of the Registered Design. Ang said he could not understand why he had been made a defendant to these proceedings when both he and Sim are non-executive directors of the first defendants. If indeed there was infringement of the Registered Design, only the company should be liable.

44. Nothing turns very much on the cross-examination of Ang as counsel for the plaintiffs essentially put to Ang the same questions he had asked of Sim. Ang explained that his 20 odd years in business were spent entirely in shipbuilding and shipping and, apart from an investment some ten (10) years ago in the construction industry, he had no other business interests, neither did he have the time. Ang said he was aware that the first defendants tendered for and did sub-contracting of, roofing works and, that one of the projects the company was interested in was Bugis Junction. Sim would pay him some money every year, for his $80,000 investment in the first defendants. Ang said he trusted Sim totally and did not question Sim on what the company did. When he received a carbon copy of the plaintiffs' letter of demand, he instructed Sim to handle the matter.

45. Counsel for the plaintiffs informed the court he was prepared to accept the affidavit evidence of the defendants' private investigator Moy Yik Wah (Moy) without cross-examination. Accordingly, Moy's testimony (as DW4), was admitted by consent and concluded the evidence for the defendants' case. Basically Moy in his affidavit deposed that he had gone round Singapore, looked at and took photographs of various shophouses, terrace houses and other buildings which had roofs laid with V profile tiles.

The submissions

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46. Before going on to my findings, I wish to refer to the closing submissions made by the parties. I turn my attention first to the defendants' submissions.

47. Counsel for the defendants emphasised the fact that the plaintiffs' tile protected by the Registered Design was not the Singapore tile -- the design covered the "baby stop" tile with a rounded or U profile whereas the Singapore tile has a V profile. The Singapore tile is not design registered, more so the modified form (P1) used in the Raffles Hotel project.

48. Counsel argued that the China tile (P2/D2) does not infringe the Registered Design as the two (2) tiles are substantially different. Chew (its designer), had made substantial modifications to the Registered Design (D3) which resulted in the "Raffles baby stop" tile. There are six (6) differences between the Registered Design and the China tile:

Registered Design China tile

(i) the apex has a wider angle, the apex has a much narrower

it is rounded at the apex; angle;

(ii) the profile is closer to U it has a classical V profile;

than V shape;

(iii) position of the kink is near the position of the kink is nearer the edge; the centre of the tile;

(iv) the clamping ridge is flat; the clamping ridge is substantially protruded;

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(v) the covered length of the tile is the covered length is longer;

shorter and has a narrower width;

(vi) the sides of the tile from the hooks the sides of the tile from the

to the kink is flat; hooks to the kink is slightly

curved.

In addition, the "baby stop" tile does not interlock well with the China tile. The fact that the URA rejected the "baby stop" tile due to its U shape supports the defendants' case that the China tile is visually different from the Registered Design. Bourgeois' testimony that the Singapore tile is not the same or substantially the same as the Registered Design, was not challenged by the plaintiffs.

49. The defendants pointed out that the Registered Design is in respect of a very common object -- a roof tile; V profile roof tiles are even more common in Singapore and have been in use well before the plaintiffs obtained their 1986 registration. A parallel can be drawn from gold plating of orchids, a common flower (see *Risis Pte Ltd v Polar Gems Pte Ltd & Ors* [infra]). Hence there is no novelty in the V profile of the Registered Design. Further, in comparing the China tile with the Registered Design (as well as with the defendants' tile), features which are purely functional should be excluded; this extents to the hooks at the base of the tile, the kinks and the tapered edge, all of which serve to interlock one piece of tile onto another, to prevent them from slipping off a (pitch) roof when laid. Again, this aspect of Chew's evidence was not disputed by the plaintiffs.

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50. If the novelty in the design lies only in its functional features, the Registered Design should not enjoy any rights and privileges in Singapore under the UK Act and the registration should be declared invalid.

51. On the issue of aesthetics, it was common ground between Kho and Chew that purchasers of roof tiles are not the ordinary men in the street but, generally architects, contractors, developers and the like. These specialists do not purchase tiles on an impulse but do so with a discerning eye for the details; they would note the dissimilarities between the China tile and the Registered Design and other tiles. The principle of 'imperfect recollection' raised by the plaintiffs therefore has no application.

52. Even if the China tile is found to have infringed the Registered Design, the second and third defendants should not be liable merely for being directors of the first defendants. Neither worked in the company nor were they aware of the existence of the Registered Design, for the reasons they had given.

53. Moving now to the plaintiffs' submissions, counsel argued that the fact the plaintiffs sold the Singapore tile which is different from the Registered Design is irrelevant. The correct comparison is between the picture of the tile as it appears in the design certificate and the offending tile of the first defendants. One looks at the appearance of the China tile (shape and configuration) and consider whether it is similar or substantially similar to or different from, the Registered Design; function, dimensions and size are irrelevant.

54. In making a comparison, it is the essential or striking feature of the Registered Design which is critical, one should not compare the plaintiffs' tile side by side with the China tile but, view them on the basis of 'imperfect

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recollection'. The striking feature of the Registered Design is the particular configuration of the side edges which are not straight but tapered giving a 'wavy' effect when laid and giving the tile a distinct appearance. People seeing the Registered Design would have a **general recollection** of its features and that it has a V shape. It cannot therefore be said that the shape and configuration of the China tile is substantially different from the Registered Design such that there is no infringement.

55. The plaintiffs' case on infringement is strengthened by:

a. the mistake of the defendants in comparing not the shape and configuration but in the sizes, lengths and angles, which are not within the scope of the Registered Design; it is equally immaterial that the two (2) tiles cannot be interlocked together or leaves a gap through which rainwater can seep;

b. the fact that Chew wanted to sue his competitors for infringement of the Singapore tile, which he would not, unless he believed the Singapore tile and the Registered Design were identical or sufficiently similar to maintain such an action;

c. the defendants knew of the Registered Design as early as October 1994 yet they chose deliberately as a 'business decision' to deal in the China tile and persisted despite objections from the plaintiffs and despite being put on notice by the plaintiffs and their solicitors;

d. there are numerous V profile tiles in the market and yet the first defendants chose to deal in tiles which are copies of the Registered Design and or the Singapore tile.

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56. There can be no question of innocent infringement by the second and third defendants; the first defendants started dealing in roof tiles after several of the plaintiffs' key employees left to join their services including Chew's wife who became their sales manager. Further, although he only became a director of the first defendants in October 1995, it was clear from Chew's testimony that he was very much involved in the affairs of the first defendants but was unable to participate due to financial constraints. Chew was responsible for the registration of the Registered Design initially. At the lowest, the first defendants should have been put on inquiry by Chew's intimate knowledge of the Singapore tile, whether there was a design registered for the same. The first defendants had a prior history of infringement vis a vis Chua's tile for which they filed a defence purely to gain time before consenting to judgment. Clearly, they are not averse to infringing the rights of others and an adverse inference should be drawn against them.

57. On the issue of novelty, the design registration shows that it was based on the shape and configuration of the tile as a whole, and is not restricted to the V profile. To invalidate a registered design, the defendants must show that at the date of the application, there was no novelty in the United Kingdom; the fact there was prior art in Singapore is immaterial (see *Solite Impex Pte Ltd v Ang Lay See* [infra]). The defendants have not produced any evidence of a roof tile which forms the prior state of the art in the United Kingdom. Neither have they adduced any evidence of any roof tile which anticipates the shape and configuration of the Registered Design. The photographs taken by Moy do not assist the defendants' case as there is no evidence of the age of the roof tiles he saw and, their exact shape and configuration are not apparent. Similarly the evidence of Bourgeois is speculative and hearsay -- he came to work in Singapore in 1988, after registration of the Registered Design. He would have

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no personal knowledge of what designs of roof tiles were used in Singapore prior to the registration.

58. A design is not unregistrable just because it has some features which are dictated solely by functional requirements -- the entire design has to be dictated solely by function to be unregistrable. Even if the functional aspect of the Registered Design is its kink for purposes of interlocking, the design is not dictated solely by function. The tile incorporated aesthetic elements in its kink, its legs and wavy side features. There is more than one way to design a roof tile or, an interlocking roof tile. This is supported by the different registrations obtained by Chua, Bourgeois and the first defendants themselves.

59. As for the second and third defendants, they are personally liable for the infringements of the first defendants as they authorised, directed or procured the commission by the first defendants of the tort (*C Evans & Sons Limited v Spritebrand Limited* [1985] FSR 267; *Wah Tat Bank v Chan Cheng Kum* [1975] AC 507) by the purchase of the offending roof tiles. Whether or not the second and third defendants knew the purchases they authorised would infringe the Registered Design is irrelevant as the tort does not require any mental element.

The findings

60. I shall consider the relevant law first before making my findings. I start with the UK Act which relevant sections I now set out:

1(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

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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 configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.

7 (1) The registration of a design under this Act shall give to the registered proprietor the copyright in the registered design,...in the United Kingdom....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...

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...

11 (2) At any time after a design had 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

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register the design; and the registrar may make such order on the application as he thinks fit.

61. The sections of the Singapore Act relevant to this suit are:

2. Subject to the provisions of this Act, the registered proprietor of any design registered in the United Kingdom under the Registered Designs Act 1949 or any Act amending or substituted for that Act, or any person deriving his right from such registered proprietor by assignment, transmission, or other operation of law, shall enjoy in Singapore the like privileges and rights as though the certificate of registration in the United Kingdom had been issued with an extension to Singapore.

3. The registered proprietor of a design shall not be entitled to recover any damages in respect of any infringement of copyright in a design from any defendant who proves that at the date of the infringement he was not aware nor had any reasonable means of making himself aware of the existence of the registration of the design:

Provided that nothing in this section shall affect any proceedings for an injunction.

62. The issue to be determined in this case is, what (if any) is the novelty in the tile protected by the Registered Design which the first defendants allegedly infringed by their China tile? Section 1(3) of the UK Act defines 'design' to mean features of shape, configuration, pattern or ornament. Counsel for the plaintiffs went further to say that one must look at the design (see para 53 above) as it appears in the certificate and compare that with the appearance of the offending China tile. With respect, I cannot accept that proposition. Indeed, it

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goes against the plaintiffs' own authority *Russell-Clarke* on **Copyright in Industrial Designs** (1974) 5 ed where the learned author states (at p 10) under the heading:

The Meaning of shape, configuration, pattern and ornament

Four features are given which may constitute a design, namely, shape, configuration, pattern and ornament. For all practical purposes, however, these may be reduced to two. Shape and configuration have been regarded as synonymous. They both signify something solid, in three dimensions; in fact, the form in which the article itself is fashioned....Again, it has been said that pattern and ornament can in the majority of 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....

Further, at p 84 the learned author states:

The task of the court is to consider infringement not merely on the basis of side by side comparison but to view the articles in question (or the representation and article) together and separately and each as a whole; the eye for this purpose will be the eye of the customer.

The reason is apparent when one compares the Registered Design as it appears in the certificate with the defendants' tile (registration no 2046774):

63. It is impossible, merely by looking at the representation of the designs in both certificates to see the differences in the shape or configuration which gave rise to the novelty in each design, what more if one does a comparison which is

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not like for like? The representations in the certificate for the Registered Design and for the defendants' tile are two-dimensional of a three-dimensional object. Logically therefore, one must look at actual samples of the China tile (P2/D2) and of the Registered Design (D3) to make a fair comparison as to whether the shape and or configuration of the former is similar or substantially similar to the latter; there can be no other method of comparison.

64. Before I set out the differences between the tiles in question, I wish to make some observations on the testimony of Kho and Chew regarding the Registered Design and the defendants' China tile. Kho was confused as to the actual tile protected by the Registered Design. This is not surprising as he had no personal knowledge of the registration process nor was he aware of the history before its registration. Kho was under the (wrong) impression that the Registered Design referred to the Singapore tile (see para 12 of his affidavit evidence in chief and paras 11(g)(h) of plaintiffs' closing submissions); the Registered Design protected the original 'baby stop' tile created by Coverland (which is a cross-breed of existing V profile tiles and Coverland's Canal stop tile), with Chew's assistance. My view is reinforced by 1AB86 which original brochure of the plaintiffs was produced in court. There it was clearly stated:

Roofing System: 'Heritage' Roofing System

Consists of: (1) Zincalume decking from John Lysaght

(2) 'Baby Stop' roof tiles from Generale Francaise de Ceramique

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The interlocking feature of the 'Baby Stop' roof tile differs from that used in Empress Place (emphasis mine). This roof tile is also Design Registered with the UK Patent Office in 1986.

My view is confirmed by Kho's evidence that the Singapore tile was used for the Empress Place Museum. The Singapore tile (either P1 or D1) was not and was never registered by the plaintiffs, for the reasons given by Chew, set out in para 32 above. Otherwise, there was no reason why the plaintiffs' press notices (1AB17-18) of 4 November 1992 would not have referred to the Registered Design as the Singapore tile. According to Chew's unchallenged testimony, the design registered "baby stop" tile was modified by him (in terms of dimensions, thickness, profile and overlap exposure) for URA conservation projects and he called it and it became known as, the Singapore tile only from 1986 onwards. The Singapore tile was further modified by him for the Raffles Hotel project until it bore no resemblance to the Registered Design; Chew then called it the "Raffles baby stop" tile. Therefore, if the plaintiffs' case is based on infringement by the first defendants of the Singapore tile, they fail from the outset because

...an article will only infringe a registered design if it is an article in respect of which the design is registered .....

(**Industrial Design Law** by *Christine Fellner* at p 260 para 5.162).

Accordingly I cannot put any weight on Kho's evidence on what he said were the distinctive features of the Registered Design as he was looking at the wrong tile -- the Singapore tile, when he produced P1.

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65. By the same token, I am unable to accept the testimony of the second and third defendants on the features which distinguished the Registered Design from the China tile; neither of them have the expertise of Chew so as to be able to comment on the differences. Similarly, Moy's testimony is of little assistance as there is no evidence of the vintage of the tiles he saw on different buildings. Certainly there is no proof that those roof tiles dated from pre-war days. At best, Moy's testimony showed that V profile roof tiles were/are very common in Singapore. For the same reason, I put little weight on the testimony of Bourgeois as he first came to Singapore to work in 1988, two (2) years after the Registered Design was registered.

66. In making a comparison on the similarities or differences between the Registered Design and the China tile, the court would have to put the sample in D3 not P1 or D1 (which are the Singapore tiles), side by side with, P2 or D2. As to their differences, I can do no better than to refer to those set out in the defendants' closing submissions, reproduced in para 48 above. Having examined and compared D3 with P2/D2, I agree with the six (6) differences highlighted by the defendants.

67. Moving next to the similarities, all the tiles produced in court (save the Registered Design) had a pronounced V profile (including Chua's), are of the same reddish brown colour (save again for the Registered Design which has a lighter tone), taper towards one end and, have similar dimensions. It is therefore meaningless to claim that the design registered tiles, be it the plaintiffs', the first defendants' or Chua's have novelty in their shape and configuration because the ordinary layman would be hard put to distinguish one tile from another by their shape and configuration. It is not disputed that although tiles are common objects, they are purchased by specialists in the building industry -- architects,

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contractors and developers, it is not an item which a shopper sees or picks off the shelf of a supermarket or departmental or a DIY (do it yourself) store. Therefore, the doctrine of 'imperfect recollection' has no application nor cases such as *Interlego AG v Tyco Industries Inc* [1988] 3 AER 949 and *Valor Heating Company Limited v Main Gas Appliances Limited* [1972] FSR 497 cited by counsel for the plaintiffs. The three (3) classes of specialists mentioned are trade as opposed to consumer purchasers and are unlikely to confuse one brand of tiles with another; they know better or should know better than the average person (see *Kevi A/S v Suspa-Verein UK Ltd* [1982] RPC 173). The houseowner would, in all likelihood, rely on the recommendations of these specialists as to the type of tile he should use, subject perhaps to budget and other considerations. One such other consideration I can think of would be the design of the house; a modern design would clearly not be compatible with old style V profile roof tiles.

68. Counsel for the plaintiffs repeatedly stressed the issue of eye-appeal in the Registered Design. My view is that, roof tiles are roof tiles and when laid on a roof top, whatever eye-appeal they have must surely be very limited. Indeed, if I accept Chew's testimony (and there is no reason why I should not), the only eye-appeal was in the "Raffles baby stop" tile which, when laid with the five (5) shades of colours he had invented, created a rustic effect. What is so striking about D3 which catches the eye and which is missing from the Singapore tile, Chua's tile or even the China tile? Frankly I cannot see. The novelty about the Registered Design, according to Chew was, it was the first tile with a kink, on the market. Counsel for the plaintiffs referred to the jagged edges of the Registered Design as a distinctive feature. He said it created a 'wavy' effect when the tiles were laid; I believe that aesthetic effect (together with the five [5] colours) was created by the Singapore tile, not the Registered Design.

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69. What I do note when I compared all the tile samples produced in court was, their distinctiveness lay in the positioning of the kink. According to Kho, the kink of the Registered Design was in the second quadrant, similarly that of the China tile whereas in the defendants' tile, it was in the first quadrant; in Chua's tile the two (2) kinks were positioned in the first and second quadrants. Whatever their position, it is not disputed that the purpose of the kinks is to interlock one tile with another, to prevent them from sliding off the roof when laid. According to the learned authors *Christine Fellner* (at p 260 para 5.163) and *Russell-Clarke* (at pp 23 and 27) of the textbooks I have cited, this is a functional feature which has to be discounted as it relates to methods of construction.

70. I refer next to some of the authorities relied on by the parties. Counsel for the defendants had cited *Kevi A/S v Suspa-Verein UK Ltd* (supra). There, the plaintiffs complained that the defendants infringed their registered design in furniture castors. The evidence showed that the customers for the castors in question were furniture manufacturers only. The defendants accordingly submitted that it was through the notional eye of the trade only that the question of infringement should be judged and that the court was not in this respect concerned with the public who were ultimate purchasers of furniture fitted with the castors in issue. The plaintiffs contended that the comparison to be made for the purposes of infringement was through the eye of both the trade and the ultimate customer. The defendants contended that certain features of the design in issue were either wholly or very substantially dictated by the function which furniture manufacturers required those parts to perform and had thus to be excluded as relevant features of the design. In assessing the proper scope to be accorded to the design, they also pointed to the existence of certain features of the design in issue which were present in the prior art.

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71. The court found for the plaintiffs and held that the scope of the design fell to be assessed through both the eye of the trade and that of the ultimate purchaser of furniture fitted with the castors in issue. One feature of the castor in issue was dictated wholly by function, however judged and had to be excluded from consideration as a feature of the design. The other features, though having functional purposes, were not dictated solely by the functions which they performed. In my view, therein lies the distinction with our case: unlike roof tiles, castors are found on furniture pieces which a houseowner would purchase and it would also be bought by the furniture manufacturer.

72. I turn next to a local case relied on by the defendants *Risis Pte Ltd v Polar Gems Pte Ltd* [1995] 1 SLR 88 in which the plaintiffs were manufacturers and distributors of inter alia, gold-plated orchids marketed under the Risis label, which included Singapore's national flower Vanda Miss Joaquim. In 1982, the plaintiffs' predecessor Setsco started producing and marketing an ornament based on its own interpretation and conception of the national flower. In 1985, the plaintiffs took over the business of Setsco and on 23 December 1985, they applied under the UK Act for and obtained, registration of their interpretation of the national flower in respect of 'an ornamental piece for use in the construction of a fashion accessory such as a pendant, brooch or earring'. In 1986, the plaintiffs started producing and selling ornaments allegedly fashioned to the registered design. The defendants were manufacturers or retailers of gold-plated ornamental orchids incorporated as part of jewellery items like earrings, bracelets, pendants and the like. When the plaintiffs discovered that the defendants were selling products which they considered infringed their registered design, they commenced proceedings against the defendants who counterclaimed for damages arising from the interim injunction and Anton

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Pillar order obtained by the plaintiffs. Khoo J dismissed the claim and allowed the defendants' counterclaim. He held:

(i) on a comparison between the registered design and Setsco's product, there was a substantial similarity between the two but there were also differences, the registered design was an evolution of Setsco's product rather than a duplicate of it or something differing in minor detail from it;

(ii) Nevertheless there is no infringement of a design which is based on a common object provided the article complained of differs even in comparatively small aspects.

73. Picking up from holding (ii) above of Khoo J's judgment, I refer to the following passage (at p 85) from *Russell-Clarke* (supra):

If only small differences separate the registered design from what has gone before, then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement.

If I accept the plaintiffs' argument that the correct comparison to be made should be between the design as shown in the certificate (of the Registered Design) and a sample of the China tile (P2 or D2), the distinguishing factor between them is, that the Registered Design has a wider and more rounded or U profile whereas the China tile has a narrower and more V, profile. Adopting Khoo J's words, it seems clear that the Singapore tile and the "Raffles baby stop" tile were evolved from the Registered Design but they are not identical to the latter.

74. Now I turn to some of the cases cited by the plaintiffs. Counsel had referred to *Amp Incorporated v Utilux Proprietary Limited* [1972] RPC 103. There, the

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House of Lords dismissed the plaintiffs' claim against the defendants for infringement of two (2) registered designs in electric terminals because the terminals (unseen in the machines for which they were required) were judged by performance and not by appearance. Lord Morris however, indicated (at p 113 letter 25) he would not exclude from possible validity for registration:

...a case where someone set out to produce an article that would perform a particular function but where in producing it he added or applied (by any industrial process or means) some feature of shape that was additional to or supplementary to what was functionally needed, with the result that in the furnished article there was a feature that appealed to the eye. There might, then, be a feature of shape which was not solely dictated by or governed by the consideration that the article should do what it was required to do...

The above obiter dictum while useful as a guide in appropriate cases would have no application here as I have already said that the eye-appeal was not in the Registered Design but, in the Singapore tile and particularly the "Raffles baby stop" tile, which evolved therefrom.

75. I had earlier mentioned *Interlego AG v Tyco Industries Inc* (supra) a case on which counsel for the plaintiffs placed much emphasis. In that case, the appellants owned the intellectual property rights for a well known children's model-building system consisting of interlocking plastic bricks which they marketed under the brand names "**Lego**' and '**Duplo**' (designed for smaller children). In 1983 the respondents, by a process known as reverse engineering, copied elements of the appellant's system with the aim of manufacturing and marketing a compatible but competing system. The respondents' reverse engineering indirectly copied the drawings from which the appellants' bricks

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were made. The respondents notified the appellants of their intention to manufacture their competing system in Hong Kong through a subsidiary. The appellants brought an action seeking an injunction to restrain the respondents from infringing copyright in its design drawings. The trial judge upheld the appellants' claim for infringement of copyright in their design drawings for all but one item. The Hong Kong Court of Appeal reversed his decision so far as it related to the appellants' pre-1973 drawings but upheld his decision in relation to the post-1973 drawings. The appellants appealed to the Privy Council on the pre-1973 drawings whilst the respondents cross-appealed on the post 1973 drawings contending that they were merely copies of previous drawings and therefore could not constitute original artistic works under s 3(2) of the United Kingdom Copyright Act 1956 (the 1956 Act). The Privy Council dismissed the appellants' appeal and allowed the respondents' cross appeal in part.

76. The significance of pre/post-1973 dates in the decisions of the courts lay in the application to Hong Kong of the 1956 Act; it was extended to Hong Kong by the Copyright (Hong Kong) Order 1972 which effective commencement date was 1 January 1973. The UK Act was not extended to Hong Kong in the same way as the 1956 Act but the United Kingdom Designs (Protection) Act Ordinance provided (subject to certain provisions which are not relevant here) that the registered holder of design in the United Kingdom would enjoy in Hong Kong the same privileges and rights as if the United Kingdom certificate of registration had been issued with an extension to Hong Kong. For practical purposes the parallel rights conferred by the UK Act and the 1956 Act extended to Hong Kong.

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77. I would now like to refer to salient parts of the judgment; Lord Oliver (at p 956) referring to the issue of eye-appeal as defined under s 1(3) of the UK Act, said:

There are....three possible constructions of the definition taken a whole...it could mean that all that is registrable or is to be considered in connection with an application for registration is that part of the shape or configuration which has eye-appeal, any purely functional feature being excluded from registration. Alternatively, it could mean that any design which includes any feature which is dictated solely by function is to be excluded from registration. Or, finally, it could mean that a design which, ex hypothesi, has eye-appeal will be excluded from registration only if every feature of it is one which is dictated solely by function.

No one has contended for the first of these possibilities and such a construction would, indeed, make very little sense... the effective choice must be between excluding the whole shape or configuration from registration because there is a part of it that is purely functional or treating the whole shape or configuration as registrable (assuming that it has eye-appeal) unless the whole of it is dictated solely by functional considerations.

In their Lordships' view the latter construction is the one which makes better sense and it is in fact the construction which is supported by the authorities. ...Moreover it makes no sense to exclude from registration designs for articles which have and indeed, may be intended to have as their principal attraction, a distinctive and novel appearance merely because they contain also features, perhaps even very minor ones, which are dictated by functional requirements.

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Lord Oliver referred to *Amp v Utilux Proprietary Limited* (supra) and set out the following principles (at p 957) their lordships had extracted from that case:

First, the primary essential before a shape can be registered as a design is that it should have eye-appeal and in this context (a) the eye is that of the prospective customer and (b) appeal is that created by a distinctiveness of shape, pattern or ornamentation calculated to influence the customer's choice...Second, the negative part of the definition does not involve, in order to demonstrate that a particular shape is 'dictated solely' by function, showing that that function could not have been performed by an article in some other shape. All that has to be shown is that the relevant features of the shape were brought about only by, or attributable only to, the function which the article in that shape is to perform, even if the same function could equally well be performed by an article of a different shape. Third, if every feature of the shape is one which is attributable solely to the function which the finished article is to perform, then the exclusion operates even though the shape may also have eye-appeal.

78. Further on (at p 958) Lord Oliver continued:

.. the incorporation into the shape as a whole of some (perhaps a majority of) features dictated only by functional requirements will not bring the exclusion into operation so as to deprive it of protection if there are also some features of the shape which are not attributable solely to function.

79. I have quoted from the judgment of Lord Oliver *in extenso* to show that the **Lego** and **Duplo** bricks are poles apart from the roof tiles in question here; the former is a consumer product, the latter a construction item. There is no doubt, as Lord Oliver found (see p 959), that the **Lego** brick has, by its very nature of

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being a child's toy, to appeal to the eye; indeed it is designed to be looked at. Hence the bricks come in eye-catching colours like blue, yellow, red and black. He said the brick could also not have achieved the commercial success that it has if it did not look as much like an authentic building brick as is consistent with its technical function. In that sense its function is to appeal to the eye, which cannot be the type of function referred to in the negative part of the definition, which can only sensibly be construed as referring to what the article is intended mechanically to do.

80. Finally, I refer to a local case (unreported) cited by counsel for the plaintiffs. In Suit No 2063 of 1995 (*Solite Impex Pte Ltd v Ang Lay See & 2 ors*) the plaintiffs were/are the registered proprietors of a registered design in respect of frames and corner pieces made of plastic, which serve a decorative purpose for the corners of window frames particularly for Housing and Development Board flats. The plaintiffs sued the defendants for infringement of their registered design, the defendants contended that there had been prior use in Singapore and the novelty if any, was thereby lost. Secondly, they asserted that the registered design differed from such designs published in Singapore before the date of registration only in immaterial details or in features which are variants commonly used in the trade. The defendants failed in their defence of prior art based on the court's interpretation of s 1(4)(b) of the UK Act (as amended). Section 1(4)(b) of the (amended) UK Act states that " A design shall not be regarded as new for the purposes of this Act if it is the same as a design...published in the United Kingdom in respect of the same or any other article before the date of the application or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade." Read with the Interpretation Act 1978 s 5 schedule 1 which defines 'United Kingdom" to mean Great Britain and Northern Ireland and schedule 2

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para 5(a) of s 22(1) thereof which defines "Great Britain" to mean England, Scotland and Wales, Lai Kew Chai J held that s 1(4)(b) of the UK Act (as amended) did not apply to prior publication in Singapore; prior publication had to be in England itself. He further held that there was no express provision in the Singapore Act to the effect that prior publication in Singapore would be a ground to invalidate registration.

81. Counsel for the defendants argued that the decision in *Solite Impex* should not be followed. He explained that the 1978 Interpretation Act interpreted the amended UK Act; we are concerned with the UK Act without the amendments. As at 1949, the Interpretation Act which is applicable is the 1889 not the 1978, version. Even so, I note that under the Interpretation Act 1889, the expression "United Kingdom" also referred to Great Britain and Northern Ireland "*unless the context otherwise requires"*. Counsel argued that the decision in *Solite Impex* would lead to injustice and an anomaly as it meant that someone can take the design of a local person, get it registered in England, come back to Singapore and even sue the designer for infringement. It cannot have been Parliament's intention to deprive an owner of his pre-existing rights in Singapore. The only solution was to read the words "*unless the context otherwise requires*" in the expression "United Kingdom" to include countries where the UK Act was the governing law. This would be in line with *Maxwell* on the Interpretation of Statutes (at p 184) which states that judges should not select an interpretation of a statute which would lead to obvious unjustice.

82. I need not concern myself unduly with the implications of the decision in *Solite Impex* for the simple reason that the defence of prior art cannot succeed. In the objections raised by the first defendants to the validity of the registered design (para 5 of the defence), they pleaded that it was common general

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knowledge that V shape roof tiles have been commonly used in buildings in Singapore since pre-war days. Although there is no doubt that V shape roof tiles are common in Singapore (just as J and S profile tiles are also common judging from the brochures produced in court), the defendants have not proved from Moy's testimony, that such V profile tiles date from pre-war days. The evidence of Bourgeois does not take this defence any further as Bourgeois has no knowledge of the state of tiles in Singapore before the Registered Design was registered in 1986, he only came to Singapore in 1988.

The decision

83. In any event, having reviewed the relevant authorities and legislation, I find that the plaintiffs have failed to prove that the first defendants' China tile infringed the Registered Design for the following reasons:

(i) as the Registered Design is based on a common object namely a roof tile, there is no infringement if the China tile differs even in comparatively small aspects, following the decision in *Risis Pte Ltd v Polar Gems Pte Ltd.* Aside from the other distinguishing features highlighted by counsel for the defendants (see para 48 above), what is very obvious is, that the Registered Design is U shaped at the apex whereas the China tile has a distinct V profile;

(ii) the common factor shared by the Registered Design and the China tile is that both have their kinks in the second quadrant. However it has already been established that the purpose of the kink in various V profile tiles is to interlock with an adjoining tile to prevent the tiles when laid, from sliding off the roof. The mechanism being purely functional, the similarity is to be disregarded, pursuant to s 1(3) of the UK Act;

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(iii) the novelty of the Registered Design was in the fact that it was the first tile on the market with such a kink; aside from that, it had no eye-appeal as the aesthetic effects created by the "wave" of the jagged edges and the "rustic" five (5) tone colours were peculiar to the "Raffles baby stop" tile which evolved from but was not, the Registered Design;

(iv) the fact that the first defendants consented to judgment for infringement of Chua's tile cannot be construed as an adverse factor against them; Chew had explained that the first defendants' Chinese and only supplier shipped Chua's tiles to the first defendants to make up for a shortfall in their order for China tiles, and it was not Chew but the third defendant Sim who instructed solicitors initially to resist Chua's suit.

84. In the light of my findings, the claims against all the defendants are dismissed with one (1) set of costs to the first defendants and a separate set of costs to the second and third defendants. Even if I had found the first defendants liable for infringement of the Registered Design, I would still have dismissed the claims against the other two defendants as I am of the view that they have succeeded in their defence under s 9(1) of the UK Act. I cannot accept the closing submission of the plaintiffs that Ang and Sim should have been put on inquiry as they knew of the Registered Design as early as October 1994 or at least, of the possibility that the plaintiffs might commence proceedings over the tiles sold by the first defendants. It cannot be disputed that Ang and Sim were investors who put their money into the first defendants' business in the hope that Chew's expertise in tiles and the roofing business would reap returns for them. There was no reason for Sim to disbelieve Chew when the latter informed him that the Singapore tile was not design registered -- Chew was the person who was instrumental in creating the Registered Design when he was with the

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plaintiffs (with whom he was employed for more than eleven (11) years); surely Chew would know better than anyone else, including ex-employees of the plaintiffs who joined the first defendants' services, whether the Singapore tile was or was not design registered. As for Ang, he was an even more passive investor than Sim, he had nothing whatsoever to do with the business of the first defendants apart from financing it. The threat of the plaintiffs commencing proceedings was nothing new to Chew who, by October 1994 had himself filed two petitions against the plaintiffs and was then sued in turn by the plaintiffs for restraint of trade.

85. In the event therefore, the plaintiffs' action fails completely. Pursuant to the undertaking they gave the court when they obtained an interim injunction against the first defendants on 16 March 1995, the Registrar shall hold an inquiry to ascertain what loss and or damages if any, the first defendants have sustained, by the granting of that injunction. In addition, on the first defendants' counterclaim, I grant an order in terms of the declaration sought in prayer (2) as well as an injunction against the plaintiffs in terms of prayer (3), and costs.

Lai Siu Chiu

Judge

Lai Siu Chiu J

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Essen System Builders (S) Pte Ltd and Another v Essential Roofing Systems Pte Ltd and Others [1997] SGHC 280

Tan Tee Jim & Jason Chan (Allen & Gledhill) for the plaintiffs
Alban Kang & Cyril Chua (Alban Tay Mahtani & De Silva) for the defendants

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