IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1999] SGHC 108

Suit 1489/1997

Between

Hunter Manufacturing Pte Ltd
ABB Industry Pte Ltd
(formerly known as ABB
Industrial Systems Pte Ltd)

… *Plaintiff*

And

Soundtex Switchgear &
Engineering Pte Ltd

… *Defendant*

GROUNDS OF DECISION

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

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Hunter Manufacturing Pte Ltd and Another v Soundtex Switchgear & Engineering Pte Ltd

[1999] SGHC 108

Suit 1489/1997
Lee Seiu Kin JC
28 April 1999

Judgment:

Cur Adv Vult

1. The first plaintiffs ("Hunter") are the registered proprietors of a Registered Design of an electrical meter box, known as the "AMB box" which is registered under the United Kingdom Registered Designs Act 1949 ("the UK Act") as Registered Design No. 2058167 on 31 July 1996 ("the Registered Design"). The notice of registration was published in *The Straits Times* on 26 April 1997.

2. An electrical meter box of the type which concerns this action is a casing which is mounted on the corridors walls of upgraded as well as new Housing & Development Board ("HDB") flats. It is used to house the miniature circuit breaker ("the MCB"), the main switch (called the isolator) and the kilowatt meter for each household. The MCB automatically trips the electricity supply when there is a short-circuit. The isolator cuts off electricity supply to a household e.g. during an electrical installation. The kilowatt meter records the quantity of electricity supplied to the household.

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3. The second plaintiffs ("ABB") are, and were at all material times, the exclusive distributors of the AMB box and had advertised, promoted and marketed it. They are well known manufacturers of various other electrical meter boxes in the industry in Singapore. The defendants were the manufacturers and suppliers of electrical meter boxes to contractors tendering for HDB wiring projects. The plaintiffs brought this action against the defendants, alleging that one of the electrical meter boxes manufactured by the defendants ("the Soundtex box") infringed the plaintiffs' rights in the Registered Design under the UK Act as applicable to Singapore by virtue of the United Kingdom Designs (Protection Act). The plaintiffs seek an injunction to restrain the defendants from infringing their Registered Design, for the delivery up or destruction of all infringing products and other articles and materials and an inquiry as to damages or an account of profits. In the original Statement of Claim, the plaintiffs also brought a further cause of action of passing off but this was abandoned by the plaintiffs shortly prior to the commencement of the trial.

4. The defendants admitted that they manufactured the Soundtex box. In their defence, they pleaded that the Registered Design was invalid for the reasons set out in the Particulars of Objection. In the alternative, they denied that they had infringed the Registered Design. In the Particulars of Objection, the defendants relied on the following grounds of invalidity:

(1) that the Registered Design was not new at the date of registration for the following reasons:-

> (a) publication by the HDB around April 1994 and June 1996 of identical or similar electrical meter boxes;
>
> (b) publication by EM Services Pte Ltd ("EMS") in November 1995 of identical or similar electrical meter boxes;

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(c) sale or exposure or offer for sale of electrical meter boxes by ABB around May 1996;

(d) sale or exposure or offer for sale by Hunter to ABB around June 1996 of identical or similar electrical meter boxes;

(e) sale or exposure or offer for sale of electrical meter boxes by Sunlight Electrical Pte Ltd in January 1996; and

(f) common general knowledge.

(2) that the Registered Design did not comply with section 1 of the amended UK Act, in particular, that it was for:-

(a) features which do not appeal to or are not judged by the eye; and

(b) features of shape and configuration which are dictated solely by the function which the electrical meter box has to perform.

5. On the first day of the trial, the defendants applied for leave to amend their defence to include a plea that Hunter are not entitled to apply to be registered proprietors of the Registered Design, and to include the defence of innocent infringement and of acquiescence, waiver or estoppel. In addition, they applied for leave to amend the Notice of Objections to change the date at which ABB were alleged to sell or offer to sell the electrical meter boxes. After hearing the parties, I granted leave for the defendants to amend their defence with costs occasioned by the amendment awarded to the plaintiffs in any event. The third set of amendments to the defence was made on 25 August 1998. These comprised essentially consequential amendments to those made on 9 June 1998.

6. The defendants say that they were victims of circumstances. They had no idea that the AMB box was the subject of any registered design. Electrical meter boxes similar to the AMB box have been in use in the market for a number of years. An earlier electrical meter box, which the parties termed the "SMB-III box", was sold by ABB since 1993: see figures 4, 5 and 6. Its design was not

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registered under the UK Act. The defendants also say that the HDB, Town Councils and EMS reproduced and used the Registered Design for their public tenders. The defendants were one of the tenderers of those projects and they had to utilise the design set out in the tender documents in order to comply with the specifications. The consequence was that they supplied electrical meter boxes identical or similar to the Registered Design. The plaintiffs had never objected to the use by the HDB, Town Councils or EMS of the Registered Design.

7. The issues which I have to determine are:

(i) whether the plaintiffs have locus standi to sue the defendants in respect of the Registered Design;

(ii) whether the plaintiffs' Registered Design under the UK Act is valid;

(iii) if so, whether the defendants had infringed the plaintiffs' Registered Design; and

(iv) whether any of the defences are available to the defendants.

8. The certificate of registration of design says:

"This is to certify that, in pursuance of and subject to the provisions of the Registered Designs Act 1949, the Design, of which a representation or specimen is attached, has been registered as of the date of registration shown above in the name of Hunter Manufacturing Pte Ltd in respect of the application of such design to: Electrical meter box."

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9. The certificate of registration of the electrical meter box shows the front, plan, side and perspective view from above and one side of the box: see figures 1, 2 and 3. The Statement of Novelty in the certificate of registration states:

"The Features of the design for which novelty is claimed reside in the shape and configuration of the article as shown in the representations".

10. The AMB box is a casing made up of metallic and non-metallic materials: see figures 7, 8 and 9 (which show the AMB box alongside the Sountex box). The AMB box has two compartments. The upper compartment has a cover which is fixed on the casing by four screws. This has two small flaps which allow separate access to the isolator and the MCB without having to unscrew the upper compartment cover. The ABB logo is embossed on this cover. The lower compartment houses the kilowatt meter. It has an access door which has a protrusion with a transparent window for reading the meter. The lock to this door is attached to a hinged plate at the bottom of the casing. At the top of the box are two gland plates. Those cover the 2 openings for the entry into the casing of the electrical wiring.

11. The history and development of electrical meter boxes is given by PW2, Koh Hock Lian. They are largely not in dispute. PW2 testified that, from 1976 to 1988, the MCB and the kilowatt meter were mounted on a teakwood panel. In 1988, the SMB-I box was introduced by ABB to house all the electrical components. It had a cover which could be removed to gain access to the components. ABB later produced the SMB-II which had a flap on the cover which made it more convenient to open to gain access to the components. In 1993, the SMB-III box was introduced into the market by ABB.

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The case for the plaintiffs

12. It was the case for the plaintiffs that Hunter were the proprietors of the Registered Design. According to PW3, Ang Ah May, she was the principal designer of the electrical meter box. As the design was finalised after the incorporation of Hunter and when PW3 was under their employment, Hunter were the rightful proprietors of the Registered Design. According to her affidavit of evidence in chief, PW3 had extensive experience as a designer for metal and plastic enclosures for a period of 20 years. Though she had no professional qualifications, she had hands-on experience. She joined Hunter as their manager in charge of design when they were incorporated in April 1996 and was involved in sales, principally to the ABB group of companies.

13. Whilst PW3 said that she was the principal designer, it was apparent from the evidence there were others involved as well. PW4, Teo Boon Yeow, the Vice-President of ABB, was involved in the liasing with the electrical department of the HDB, Power Grid and Power Supply. PW3's husband, Chan Foo Wah, designed the technical aspects. He was not called as a witness.

14. PW4 was not in the original line-up of witnesses. After PW3 completed giving evidence, counsel for the plaintiffs applied for leave to call PW4 to give evidence on the ground that the defence and counter-claim were amended. Counsel for the defendants did not object and I granted leave accordingly. PW4's evidence was that the AMB box was an important product in ABB. The sale of the AMB box since November 1996 was over $3 million. He testified that he was only involved in the co-ordination of the design of the AMB box, i.e. liaison with the HDB and passing the feedback to the designer. The discussions with PW3 and PW4 took place from the beginning of the third

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quarter of 1995 to the end of 1995. His evidence was that only PW3 was the designer, not her husband who only assisted in producing the electrical meter box from the design.

15. PW4 testified that ABB wanted a totally different electrical meter box from the SMB-III box. During the discussions with the HDB, he used cardboard mock-up models. There were no drawings. By the end of 1995, they had three different models of the electrical meter box: one was rectangular in shape, one was a square and the third was a two-piece model which had a rectangular piece to house the MCB and the isolator, and a square piece to house the meter. For the rectangular model, the long edge was horizontal, with the MCB at the left, the meter in the centre, and the isolator on the right. He received both positive and negative feedback on each of the three models.

16. In his discussions with the HDB, the SMB-III box was referred to. PW4 said that the representative from the HDB complained that the SMB-III box was bulky and not user-friendly in installation. It was difficult to install the box where there was a corner unit in an HDB flat. However, PW4 agreed with counsel's suggestion that the new AMB box was created to fit the new meters which were of a smaller size.

17. In the course of his discussions with EMS, PW4 gave them the design of the AMB box. EMS then incorporated the AMB design into their tender documents. He only found out about this in October 1996. He had no objection to the use of drawings by the HDB or EMS in their tender documents. He agreed that the use of the drawings by the HDB or EMS in their tender documents would mean that any third party could use the designs as a basis to manufacture. He agreed that the HDB would not show any preference for any tenderer in the tendering

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process and would award the contract to anyone who could comply with the contractual requirements.

18. PW 5 is the engineering manager of ABB. He was not involved at all in the design of the AMB box, and had no knowledge as to how it was conceived. His evidence was principally a narration of how approvals were obtained from the Productivity and Standards Board ("PSB") and the HDB in respect of the AMB box, and a comparison of the features of the AMB box and the Soundtex box.

The case for the defendants

19. Two witnesses gave evidence for the defendants. DW1, Ang Choon Cheng, is the General Manager of the defendants. He testified that, in September 1996, EMS specified that two doors were required for the electrical meter box, one to give access to the kilowatt meter, and the other door to give access to the isolator and the MCB. The defendants altered the design to meet the new requirements. The incorporation of the requirements into the design took 7 months. Approval for the new design from the HDB was finally given in May 1997.

20. DW1 denied that the defendants copied the AMB box. Instead he followed the drawings on the EMS tender documents in arriving at the Soundtex box. His evidence was that the defendants only came to know of the plaintiffs' Registered Design on 12 July 1997 when they received a letter from the plaintiffs' solicitors. Neither the AMB Product News nor the advertisement placed in the newspapers of the Registered Design on 26 April 1997 was drawn to his attention. Further he testified that there were substantial differences between the Soundtex box and the AMB box.

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21. DW2, Seiu Kam Chiong, was a director of Tay Siew Kheng Plumbing & Electrical which purchased electrical meter boxes from Sunlight Electrical Pte Ltd as well as the SMB-III box from the plaintiffs. I find his evidence to be irrelevant to the issues in this action.

(i) Locus standi

22. Section 2 of the United Kingdom Designs (Protection) Act provides as follows:

"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."

23. The UK Act was amended by the Copyright, Designs and Patents Act 1988. Section 1(2) of the amended UK Act provides as follows:

"A design which is new may, upon application by the person claiming to be the proprietor, be registered under this Act in respect of any article, or set of articles, specified in the application."

Section 2(1) provides that the original proprietor of a design is the author of the design. But where a design is created by an employee in the course of his employment, section 2(1B) provides that the employer shall be treated as the original proprietor of the design. It is the plaintiffs' case that PW3 created the

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design the subject of the Registered Design, and that she had done so in the course of her employment with Hunter.

24. The first question that I need to deal with, and which can be easily disposed of, is the *locus standi* of ABB. Section 7 of the amended UK Act vests certain rights to the registered proprietor, which in this case is Hunter. Therefore there can be no question that ABB would have any rights under the UK Act. In any case ABB's position is that Hunter's employee, PW3, is the author of the design. The plaintiffs had originally included an action in passing off. However this was abandoned before commencement of the trial. Counsel for the plaintiffs confirmed that by virtue of their withdrawal of the passing off action, their remaining action was for design infringement and was pursued solely by Hunter. Accordingly, the claims of ABB in this action are dismissed.

25. In respect of the *locus standi* of Hunter, the defendants submit that it was not PW3 who designed the AMB box. Their case was that the author of the design was in fact PW4 acting in the course of his employment with ABB. Hence ABB would be the original proprietor of the design. Hunter were only a front for ABB because ABB, being a major supplier of products for the HDB, was afraid that Board would be offended by claiming exclusive rights over the design drawings. As Hunter were not the proprietor, they were not entitled to register the design in their name. There was also no evidence of an assignment of the design to Hunter. Alternatively the defendants argued that the authors of the design were PW4 and PW3 and/or her husband, in their personal capacities.

26. PW3 deposed that she was one of the designers of the AMB box. She said that there were other designers. However PW4 said that he was not involved in the design and that his involvement was in getting feedback from the HDB and

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in submitting the design to the PSB for approval. I have noted that there were some apparent inconsistencies in PW3's evidence. However, taking the evidence as a whole, I uphold PW3's claim that she was the principal designer. The difficulty here is that there is no definition of the act of "designing". Does it encompass obtaining feedback from the HDB as was done by PW4 in this instance? Or does it relate only to the act of putting the lines on paper? Both PW3 and PW4 say that PW3's husband, who possessed the technical knowledge on the moulding process, gave his input in this respect. But PW3 characterised this as part of the design process and PW4 said that this was not. Counsel for the defendants did not explore this point sufficiently for me to be able to adjudge that PW3 was not the "designer" for the purposes of the UK Act. PW3 gave evidence that she had experience as a designer for metal and plastic enclosures for almost 20 years. Therefore I find on the evidence before me that PW3 was the author of the Registered Design. There is also a question of whether the design was finalised before Hunter was incorporated in April 1996, but this point was not pursued by the defendants. Furthermore, there is nothing in the UK Act which prohibits the registration of a design by only one of the joint authors. Accordingly I find, on the basis that PW3 was an employee of Hunter, that Hunter is the original proprietor of the Registered Design.

(ii) Validity of the Registered Design

27. Counsel for the defendants attacked the validity of the Registered Design on the following grounds:

(a) the Registered Design has no eye appeal or is dictated solely by function; and

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(b) there was prior publication either by publication to the PSB by PW4 or by the HDB and EMS of the SMB-III series which was identical or similar to the AMB box.

(a) Eye appeal and function

28. Section 1(1) of the amended UK Act defines "design" as meaning:

> "features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include –

a method or principle of construction, or

features of shape or configuration of an article which –

are dictated solely by the function which the article has to perform, or

are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part."

29.

Amp Inc v Utilux Pty Ltd

[1972] RPC 103

concerned a registered design of an electrical terminal used in washing machines. The definition of design in the 1949 UK Act has since been amended by the Copyright, Designs and Patents Act 1988 but there is no material change in respect of exception (b)(i) of the definition. The House of Lords held that the

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features of shape or configuration in the design of the terminal fell within this exception and therefore the registration was invalid. Lord Reid said that the words "

dictated solely by the function which the article has to perform

" cannot refer to the situation where an article has to be in that precise shape in order to perform the function. It must refer to the situation where the shape is there, not to appeal to the eye, but solely to make the article work. However he added the following proviso:

"I would add to avoid misunderstanding that no doubt in the great majority of cases which the Act will protect the designer had visual appeal in mind when composing his design. But it could well be that a designer who only thought of practical efficiency in fact produced a design which does not appeal to the eye. He would not be denied protection because that was not his object when he composed the design."

30. It is clear from the speeches of all the members of the House that an important factor in that case was the fact that the terminal was a component to be installed inside the washing machine and would not be seen by the purchaser of the appliance. They held that the expression "judged by the eye" referred to the eye of the customer. In this case the final customer would not see the terminals unless he opened the machine. The terminal in this case was designed solely on the basis of its intended function. Lord Pearson embarked on a detailed analysis of the shape and configuration of the terminal and concluded that all its features were attributable to or caused or prompted by its function of forming

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an electric connection between two electric conductors. Therefore it fell within exception b(i) of the definition.

31. The *Interlego AG v Tyco International* [1988] RPC 343 case also dealt with a design that appeared at first blush to be wholly functional. The plaintiffs were the proprietor of the well known Lego bricks and the issue was whether the registered design had eye appeal or was dictated solely by function. These were plastic bricks with round knobs and clutches which enable the bricks to be interlocked so that the child could construct buildings or other objects. The Privy Council held that a design which incorporated mixed functionality and ornament was registrable. The Privy Council held that the actual shape and dimensions of the knobs and tubes were not dictated solely by their function but that the bricks were designed, in part at least, with a view to the appearance of the article as a whole. A material factor in the decision was the fact that the bricks were toys marketed to children and in order to be popular they must be designed with eye appeal in mind.

32. In the present case, the Registered Design is for a box to cover the kilowatt meter, isolator and MCB. Unlike the terminal in the *Amp* case, it is exposed. Not only is it installed on walls along HDB corridors but, there being one box for each housing unit, on each corridor there can be a dozen or more of such units. It cannot be said that eye appeal is not a factor in its design. The customer in this case is the HDB, but no doubt they will have the views of flat owners in mind in their decision to select such boxes. Therefore, unlike the terminal in the *Amp* case, it cannot be said that there will be no consideration of eye appeal in the Registered Design.

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33. I turn to the question whether the features of the Registered Design are dictated solely by the function which the electrical meter box has to perform. This function is to act as an aesthetic protective cover for the meter, isolator and MCB which will permit convenient access for the householder to the isolator and MCB, and for the electricity supplier to read and maintain the meter. The design comprises two parts: an upper rectangular compartment with two flaps housing the isolator and MCB, and a lower square compartment housing the meter. The latter compartment has a protrusion with a clear perspex cover to enable the meter to be read without the need to open the cover. There can be any number of designs that can perform the same functions. For example the edges in the covers for the upper and lower compartments are rounded; they need not be so. The upper compartment need not be rectangular; it may be square, and *vice versa* for the lower compartment. There need not be a protrusion to accommodate the meter as it is possible to make the entire lower compartment deeper to achieve the same purpose. It may also be possible to design a box with an oval rather than rectangular shape. Furthermore, it cannot be said that these features of the Registered Design did not have eye appeal. Therefore I find that the Registered Design is not dictated solely by the function that the electrical meter box has to perform.

(b) Prior publication

34. Counsel for the defendants contends that the design is not novel because: (1) it had been published by the plaintiffs prior to 31 July 1996; alternatively, (2) it is the same as the design of an earlier model of the electrical meter box, the SMB-III box, which was available in the market prior to 31 July 1996. Counsel for the defendants argued that the first incident of prior publication must have occurred when the contract of sale of the AMB box to ABB was

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concluded in 11 June 1996, and the second incident occurred when the AMB box was submitted to the PSB for testing.

35. Section 1(2) of the amended UK Act provides that only a new design may be registered. Section 1(4) provides that a design shall not be regarded as new if (a) it is the same as an earlier design registered of the same or any other article; or (b) it is the same as an earlier design published in the United Kingdom in respect of the same or any other article. There will be publication if the knowledge is either available to members of the public or actually in fact shown and disclosed to some individual member of the public who is under no obligation to keep it secret. Section 6(1) sets out situations involving confidentiality which are deemed not to be prior publication. Section 6(1)(a) provides that registration shall not be refused by reason only of the proprietor's disclosure of the design to some other person in circumstances where its publication or use by that person would be contrary to good faith. It has been held that disclosure to a potential customer does not fall within this exception unless a duty of confidentiality is expressly imposed: see *Blank v Footman* (1888) 5 RPC 653 at 657 and *Carflow Products v Linwood Securities* [1996] FSR 424. In *Sommer Allibert (UK) Ltd v Flair Plastics Ltd* [1987] RPC 599, it was held that communication within the group of companies is not publication.

36. The contract of sale of the AMB box by Hunter to ABB was evidenced by the letter dated 11 June 1996. I reject the argument that there was prior publication of the AMB box in that there was publication when the AMB box was shown to ABB. Hunter had conducted discussions with ABB as potential customers, with a view to perfecting the design. Such discussions would be treated as confidential. In *Charles Henry Nevill v Bennett & Sons* (1898) 15 RPC 412, the plaintiffs were owners of a registered design to be printed or

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woven on textile. F sent designs to the plaintiffs who would then print them in a reasonable working way. Hall, VC held that, assuming that F was the author of the design, the plaintiffs had acquired the right by valuable consideration. The actual design was the result of the collaboration of the plaintiffs and F. Hall, VC rejected the argument that there was prior publication of the design by F to the plaintiffs. He said, at p. 414:

"If a man chooses to put a design on the goods, and place these goods upon the market, and then, having used it and seen whether or not that design is likely to catch on …, he afterwards attempts to register the design, I can quite understand that this is prior publication, and that is really the effect of all the cases cited before me. But in this case, where everything was private and there was mere collaboration between Fotiadi, through his agent Stelfox, and the Plaintiffs, with a view to the design being put into a suitable and workable shape, which was to be the property of the Plaintiffs, but to be engaged, as was said, for the use of Fotiadi in the Persian market – to say that that private consultation, that private working together, amounted to prior publication, seems to me to be entirely unfounded. The idea of prior publication, I quite believe, is where a matter of that kind has been thrown upon the public knowledge, and has become a matter of public knowledge, not necessarily extensively, but otherwise than in the way of private preparation which I have mentioned, and it seems to me that a publication of that kind is altogether a different matter to what took place on this occasion."

37. Counsel for the defendants submitted that the transaction between Hunter and ABB was conducted at arm’s length with no express obligation of confidentiality. However the evidence demonstrates that the discussions were to be treated as confidential. Hunter’s discussions with ABB were for the

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improvement of the design and for consultation. In *Blank v Footman* (1885) 5 RPC 653, the proprietor of a design, prior to registration, showed it to H, a commission agent who had the sole right of selling the plaintiffs' goods in England. H had an interest in the design, and it was held that the communication to him must be regarded as confidential.

38. As for prior publication in showing the AMB box to the PSB, I wholly reject the contention. I cannot see how a similar confidential relationship ought not to be established in this situation, where the author of the design is submitting an article on which the design is applied to the relevant authority for safety testing. To hold that such an act would amount to prior publication under the UK Act would defeat the attempts of all designers of articles that require some form of testing or certification before such articles may be brought to the market. Disclosure to the PSB in such circumstances does not mean that the design has been *"thrown upon the public knowledge, and has become a matter of public knowledge"*, to cite the judgment of Hall, VC in *Charles Henry Nevill v Bennett & Sons*. I therefore hold that mere submission to the PSB in this case does not constitute prior publication.

39. Counsel for the defendants further contends that the presence of the SMB-III series constitutes prior art. Under s 1(2) of the UK Act, a design which differs only in immaterial details or in features which are variants commonly used in the trade from prior designs is excluded. It was argued that there was no substantial novelty in the design of the Registered Design compared to the SMB-III box which had existed since 1993 and was used in HDB tender documents since November 1994. The configuration of both boxes are the same, i.e. an overall rectangular shape comprising an upper rectangular section, with two flaps for the isolator and MCB, and a lower square section with a protrusion

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housing the meter which has a transparent window. However when the two designs are compared, it is clear that there are sufficient differences between the SMB-III box and the AMB box to prevent the SMB-III box from constituting prior art. These differences are:

(i) the SMB-III has only one compartment as opposed to two in the AMB;

(ii) the flaps in the SMB-III for the isolator and MCB are more squarish compared to the rectangular flaps in the AMB;

(iii) the protrusion in the SMB-III is greater than that in the AMB and has a different angle;

(iv) the SMB-III has protruding gland plates while those in the AMB are flush; and

(v) the SMB-III has a protrusion at the top for the hinge which the AMB does not have.

If one puts the two designs side by side one can immediately tell that they are different designs because of these differences. I conclude therefore that the Registered Design is valid.

(iii) Whether there was infringement

40. I now turn to consider whether the defendants, in selling the Soundtex box, had infringed Hunter's right in the Registered Design under the amended UK Act. Section 7(1) of that Act provides as follows:

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"(1) The registration of a design under this Act gives the registered proprietor the exclusive right -

(a) to make or import -

(i) for sale or hire, or

(ii) for use for the purposes of a trade or business, or

(b) to sell, hire or offer or expose for sale or hire, an article in respect of which the design is registered and to which the design or a design not substantially different from it has been applied."

The question is whether the design of the Soundtex box is substantially different from the Registered Design.

41. It is well established that if the design is only of limited novelty in that only certain of its features can be regarded as new, equally small differences between this design and any subsequent design will be sufficient to avoid infringement – see *Simmons v Mathieson & Co Ltd* [(1911) 28 RPC 113, 486 (CA), *Negretti and Zambra v W.F. Stanley & Co Ltd* (1925) 42 RPC 358. I need only to cite *Russel-Clarke on Copyright in Industrial Designs* (Fifth Edition) at p.85:

" In deciding whether any differences between the alleged infringement and the registered design are or are not substantial difference, the same considerations will apply as in determining whether the registered design is or is not novel as compared with previous designs. Thus, the alleged infringement and the registered design should be looked at, not only together, but apart, and at different times, and a little distance off. Since the principle which applies in

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ordinary artistic copyright, that there can be no copyright in a mere idea, is also presumably applicable in the case of copyright in a registered design, there can presumably be no infringement if all that has been done by the defendant is to take the broad idea and not the particular method of representing it.

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.

In *Simmons v Mathieson & Co Ltd* [(1911) 28 RPC 113], Swinfen Eady J. said:

'… and I think under these circumstances, seeing what the defendants have done in producing something independently, something bearing some resemblance to it, but I think differing as much from the plaintiffs' as the plaintiffs' differ from any of its predecessors, it would be impossible to hold that there was sufficient novelty in the design, without at the same time deciding that the defendants' is so different that it cannot be held to infringe. I think, therefore, on the question of infringement, that the defendants have not infringed the plaintiffs' registered design.'

And on appeal, Fletcher Moulton LJ, as he then was, said:

'The only possible way in which this registration could be good would be to magnify the importance of minute details so as to give it novelty or originality, and then if you magnify the importance of small details for that purpose, you must also keep them on that scale for the purpose of deciding whether there is infringement.' "

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42. I now consider the differences between the SMB-III box, the AMB box and the Soundtex box. The overall configuration of the AMB box is not new; it adopts the same configuration as the SMB-III, i.e. location of the isolator and MCB above the meter in an overall rectangular shape with two flaps for the isolator and MCB and a protrusion with window for the meter. Therefore there is no novelty in this configuration. The SMB-III is larger than the AMB, but dimension is not a factor to be considered as novelty is claimed only in the shape and configuration, and furthermore no dimension is specified in the registration certificate. The general dimensions of the AMB and the Soundtex boxes are virtually the same, i.e. they are the same length and breadth in the overall box as well as in the top and bottom compartments. Even the flaps are the same size. However these dimensions are dictated by the HDB tender documents. The differences between the AMB and Soundtex boxes that are apparent upon a visual comparison are:

(i) The angle of the protrusions housing the meter are noticeably different. The protrusion in the Soundtex box is nearer the perpendicular than that in the AMB box;

(ii) The transparent windows are noticeably different. That in the Soundtex box covers the entire area of the protrusion while in the AMB box there is a border. The window in the Soundtex box sticks out from the protrusion whereas in the AMB box it is flush with it. I should add that two distinctive features of the window in the Soundtex box are as follows:

(a) eight knobs are visible at the edges of the window, two on each of the four edges;

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(b) a thin black line borders the window.

These features do not exist in the AMB box and they certainly make the Soundtex box visually distinct from the former;

(iii) At each side of the AMB box, at both top and bottom, there are joint lines running at 45 degrees from the top and bottom corners, forming two triangles. The joint line in the Soundtex box runs 90 degrees from the middle of the box;

(iv) The Soundtex box is deeper than the AMB box.

43. The learned editor of *Russel-Clarke* suggests that in a case such as this, in which the Registered Design is an evolution of an earlier design in the market, the test for substantial difference in a claim of infringement is in many respects similar to the test for substantial novelty of the Registered Design compared to previous designs. I think this is borne out in the *Simmons* case. The differences listed in the previous paragraph clearly show that the design of the Soundtex box is as different from the Registered Design as the latter is from the design of the SMB-III box. I therefore conclude that in producing the Soundtex box, the defendants have not infringed the Registered Design.

(iv) Defences

44. The defendants say, in the alternative, that if they had infringed the Registered Design, it was done innocently, without knowledge that it was registered. Section 9 of the amended UK Act provides as follows:

"(1) In proceedings for the infringement of the right in a registered design damages shall not be awarded against a defendant who proves that at the date

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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 ground for supposing as aforesaid by reason only of the marketing of an article with the words "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 the infringement of the right in a registered design."

45. Counsel for the plaintiffs suggests that the defendants had prior knowledge that the design was a registered design because there was a registration number of the Registered Design printed on the product brochures. However DW1 denied he had any knowledge of the brochure and there was no evidence that he had received it. As for the advertisement of the registration of the design in the newspaper, DW1 said that he did not see it at the time and the plaintiffs have not produced any evidence to the contrary. The advertisement was a small notice published on one issue and it was not difficult for DW1 or any of the defendants' employees to have missed it. I cannot find any reason to disbelieve DW1. I therefore find that the defendants were not aware of the Registered Design until 12 June 1997 when they received notice of it. Accordingly, even if there was infringement, by operation of section 9(1) of the UK Act, no damages are to be awarded in respect of any infringement by the defendants up to 12 June 1997.

46. The defendants also say that the defences of waiver, acquiescence and estoppel are available to them because of the behaviour of Hunter and ABB in

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this matter. Their argument is as follows. PW4 submitted the product brochure of the AMB box, which contained drawings depicting the Registered Design, to the HDB and EMS when he was promoting the AMB box. This was done in August 1996. The HDB and EMS then reproduced the Registered Design in their tender drawings. This would have the effect of requiring contractors tendering for HDB projects to propose electrical meter boxes of the same or a similar design. When PW4 became aware of the use of the designs by the HDB and City Centre Town Council, he raised no objection. In fact it was his evidence that he was pleased with this because it meant that his marketing strategy had worked. When the defendants followed the tender drawings and specifications in coming up with the Soundtex box, the plaintiffs decided to sue the defendants for infringement of the Registered Design.

47. The defendants say that PW4 had deliberately allowed the HDB, Town Councils and EMS to use the Registered Design in the public tender documents. Not only did he not stop them from doing it, he also did not request that they inform the public that the design was a registered design. There was nothing in the tender documents to show that the designs were in fact registered designs, and that permission had to be sought from ABB before they could be used. For instance, in the Conditions of Tendering prepared by EMS for the project in City Centre Town Council, the drawing annexed to the Conditions had a column on the right hand side stating that it was drawn by one Low, and checked by one Heng, and the name "EM Services Pte Ltd" was on the title block. This suggested that it was the HDB which came up with the specifications. Under the circumstances, not only did ABB impliedly allow the HDB and the public bodies to use the Registered Design, they were also representing by conduct that anyone else may use the Registered Design.

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48. The defendants contend that it was ABB's marketing strategy for EMS to use its own designs in the tender documents, no doubt hoping that the contractor would purchase the AMB from ABB in order to comply with the tender requirements. However ABB must have realised that once the drawing containing the Registered Design was provided in that manner, without any indication that it was a registered design, it was quite possible that the contractor would lift the design from the tender drawing to comply with the requirements. In fact it was PW4's evidence that he was prepared to take the risk of people copying their design.

49. Based on these matters, the defendants say that they were entitled to the defences of waiver, acquiescence and estoppel. Counsel cited the relevant paragraphs from Halsbury's Laws of England. In respect of waiver, paragraph 922 of Volume 16 of the Fourth Edition Reissue (1992) states as follows:

"

Waiver.

The expression 'waiver' may, in law, bear different meanings. The primary meaning has been said to be the abandonment of a right in such a way that the other party is entitled to plead the abandonment by way of confession and avoidance if the right is thereafter asserted, and is either express or implied from conduct. It may arise by virtue of a party making an election, for example whether or not to exercise a contractual right. … Waiver may also arise by virtue of equitable or promissory estoppel; unlike waiver arising from an election, no question arises of any particular knowledge on the part of the person making the representation, and the estoppel may be suspensory only. …

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Where the waiver is not express, it may be implied from conduct which is inconsistent with the continuance of the right, without the need for writing or for consideration moving from, or detriment to, the party who benefits by the waiver, but mere acts of indulgence will not amount to waiver; nor may a party benefit from the waiver unless he had altered his position in reliance on it. …

It seems that, in general, where one party has, by his words or conduct made to the other a promise or assurance which was intended to affect the legal relations between them and to be acted on accordingly, then, once the other party has taken him at his word and acted on it, so as to alter his position, the party who gave the promise or assurance cannot afterwards be allowed to revert to the previous legal relationship as if no such promise or assurance had been made by him, but he must accept their legal relations subject to the qualification which he had himself so introduced, even though it is not supported in point of law by and consideration…."

50. In respect of acquiescence and estoppel, paragraph 924 states as follows:

"

Acquiescence and estoppel

. The term ‘acquiescence’ is used where a person refrains from seeking redress when there is brought to his notice a violation of his rights of which he did not know at the time; and in that sense acquiescence is an element in laches. There may, however, be a case of acquiescence which does not depend on delay at all. Subject thereto, a person whose rights have been infringed without any knowledge or assent on his part has vested in him a right of action which, as a

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general rule, cannot be divested without accord and satisfaction or deed of release.

The term ‘acquiescence’ is, however, properly used where a person having a right, and seeing another person about to commit, or in the course of committing, an act infringing that right, stands by in such a manner as really to induce the person committing the act, and who might otherwise have abstained from it, to believe that he assents to its being committed; a person so standing by cannot afterwards be heard to complain of the act. In that sense the doctrine of acquiescence may be defined as quiescence under such circumstances that assent may be reasonably inferred from it, and is no more than an instance of the law of estoppel by words or conduct, the principle of estoppel by representation applying both at law and in equity, although its application to acquiescence is equitable. The estoppel rests upon the circumstance that the person standing by in effect makes a misrepresentation as to a fact, namely, his own title; a mere statement that he intends to do something, for example to abandon his right, is not enough. Furthermore, equitable estoppel is not applied in favour of a volunteer."

51. The common thread running through these equitable doctrines is that a party must, by words or conduct, have induced the other party to act to his detriment, or has stood by despite knowledge of an infringement of his rights. I cannot see any merit in the defendants’ contention that in this case, Hunter, in permitting the HDB or EMS to use the drawing, had waived their rights in the Registered Design *vis--vis* the defendants. The defendants were not aware that such rights existed; indeed they did not even know that there was a design by Hunter. Without any knowledge of the existence of Hunter’s rights, I cannot see how the defendants could have understood Hunter’s action as a waiver of those

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rights. The same consideration applies to the argument that Hunter was estopped or had acquiesced to the infringement. There simply was no communication by word or action between Hunter or ABB and no knowledge on their part of the infringement. Counsel for the defendants has not cited any authorities that extend these equitable doctrines to the situation before us.

52. Furthermore, I cannot see any reason to extend these doctrines in this case. Assume for the moment that the defendants had infringed the Registered Design. If they knew about the Registered Design, then it would not be equitable to deny Hunter the right to damages and an injunction merely because the plaintiffs had encouraged the HDB and EMS to incorporate the Registered Design in the tender drawings. If the defendants did not know that the design in the EMS drawing was a Registered Design, then the defence of innocent infringement is available to them.

53. Counsel for the defendants submitted that the HDB and EMS had a policy of discouraging any particular tenderer from having a monopoly over a certain product in the market. DW1 had said in his affidavit of evidence-in-chief that if part of the tender could only be supplied by a particular person because of intellectual property rights, the tender would no longer be a public tender as such. Hence the defendants would not expect the AMB box to be a registered design. However the defendants did not produce any evidence from the HDB or EMS on this and I did not place any weight on that aspect of the evidence.

Counterclaim

54. In the counterclaim, the defendants seek a declaration that the Registered Design is invalid and that the exclusive privileges and rights in the Registered

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Design have not been acquired or extended to Singapore. As I have found that the design was registrable, I accordingly dismiss the counterclaim.

Costs

55. In view of my finding that the Soundtex box does not infringe the Registered Design, the plaintiffs' claim is dismissed. On the question of costs, the defendants have succeeded in respect of the claim but failed on the counter-claim. However the issues in the counterclaim are the same as those in the claim, i.e. they relate to the question whether the design was registrable. The prayer in the counterclaim would have been a logical one to make had the defendants succeeded on that question. I therefore order the costs of this action in both the claim and counterclaim to be paid by the plaintiffs to the defendants.

Order accordingly

LEE SEIU KIN

JUDICIAL COMMISSIONER

SUPREME COURT

Figure 1: Registered Design - front view

Figure 2: Registered Design - plan view and side view

Figure 3: Registered Design - perspective view

Figure 4: SMB-III box – front view

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Figure 5: SMB-III box – perspective view

Figure 6: SMB-III box – bottom view

Figure 7: AMB box and Soundtex box - front view

Figure 8: Soundtex box and AMB box – perspective view

Figure 9: Soundtex box and AMB box – bottom view

Lee Seiu Kin JC

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