

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1997] SGHC 135

Suit 2063/1995

Between

Solite Impex Pte Ltd

... Plaintiff

And

Ang Lay See trading as Beng
Poh Heng Trading
Allwin Hardware & Plastic
Mfg Pte Ltd
Oong Chin Poh

... Defendant

GROUND OF DECISION

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**Solite Impex Pte Ltd v Ang Lay See trading as Beng Poh Heng
Trading and Others**

[1997] SGHC 135

Suit 2063/1995
Lai Kew Chai J
26 May 1997

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Judgment:

2 The plaintiffs are the registered proprietors of Registered Design

No. 2043962 in respect of frames and corner pieces under the United Kingdom
Design Act

1949 ("the UK 1949 Act") as amended by the UK Copyright, Designs and
Patents Act

1988. The corner pieces are made of plastic materials; they are manufactured
out of

moulds. They serve a decorative purpose for the corners of window frames.
Many HDB flats

are installed with aluminium window frames. The corner pieces are targeted for sale to

decorate what would otherwise be very angular corners of those aluminium window frames. A

copy of the Certificate of Registration issued and the statement of novelty showing the

perspectives and elevations of the registered design are annexed to this judgment. The

novelty of the design was claimed to "reside in the shape and/or configuration of the

parts of the article coloured blue" (the colour was for descriptive purposes and

obviously was not part of the claim of novelty). The date of the application of the

registered design is 19 December 1994. It is well known that the provisions of the UK 1949

Act are extended to Singapore by virtue of the United Kingdom Designs (Protection) Act,

Cap. 339 ("our Act") which has been in effect since 16 September 1938.

3 2 This action, which was commenced on 18 November 1995 against the defendants, is for infringement of the plaintiffs' registered design by the defendants.

The plaintiffs sought the usual remedies which included orders for an injunction, delivery

up of all infringing products, inquiry as to damages, for payment of all sums found due

and costs. It was apparent from the pleadings and from the evidence tendered that the main

defence was an attack on the validity of the registration, although the defendants in

denying infringement asserted that their corner pieces were "substantially different".

4 3 It was, and remains, as will be explained later, the case of the defendants that the registered design is invalid for two principal reasons. First, they

assert that there was use of the registered design which was applied to corner pieces

before the registration filing date of 19 December 1994. In other words there had been

prior use in Singapore and the novelty, if any, was thereby lost within the meaning of the

UK 1949 Act. Secondly, they further assert that the registered design is the same as or

differs 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. Both

issues turn on the meaning of ss 1(4)(b) and the next limb of the UK 1949 Act, as amended.

5 4 By an ex-parte application, the plaintiffs obtained an Anton Piller order and an interlocutory injunction against the defendants on 18 November 1995.

That order was executed at the business premises of the first and second defendants on 21

November 1995. The defendants applied to discharge the Anton Piller order and

injunction.

Their application was heard in May 1996. The application was dismissed but no order was

made as to costs and a speedy trial was ordered.

6 5 The action came on for trial on 18 November 1996. On the fourth day of the trial, the court was informed that there had been agreement on the facts in

issue. The defendants admitted that their corner piece is not substantially different from

the plaintiffs' registered design. On the part of the plaintiffs, they admitted that their

2 curve design corner piece, subsequently registered as Design No. 2043962, was published

in Singapore before 19 December 1994, the date of the application for registration. It was

accepted as a fact that the registered design had been applied to corner pieces in

Singapore before the date of registration of the registered design. It was also common

ground that the various objects, as photographed in the defendants' bundle of documents

(1DBD 128-154), were found in Singapore before 19 December 1994. These photographs

depicted the features of the shapes and configuration and possibly the "pattern"

of windows of older Chinese houses, Chinese temples and Chinese wooden furniture.

7 6 There was sensibly further agreement on the reliefs. In the event that the plaintiffs succeed, it was agreed that the plaintiffs will be granted the

injunction as sought, delivery up as claimed, damages agreed at \$5,000, costs at two-third

of the taxed costs and that the defendants' counterclaim will be dismissed with two-third

of the taxed costs to the plaintiffs. If the defendants succeed, the defendants will be

granted the declaration, as claimed, that exclusive privileges and rights in the

registered design have not been acquired in Singapore, damages to be assessed, interest

and costs. It was further agreed that the plaintiffs' claims in that event will be dismissed with costs.

8 7 There are accordingly two questions for my determination:-

9 (a) Whether the prior publication of the corner pieces in Singapore is sufficient ground for the High Court to declare under s 4 of our Act that

exclusive privileges and rights in the registered design have not been acquired in

Singapore; and

10 (b) Whether the photographic evidence in the bundle marked 1DBD128-154 show that the registered design differs from designs published in Singapore

only in immaterial details or in features which are variants commonly used in the trade

and accordingly, whether this is sufficient ground for the High Court to declare

under s 4

of our Act that exclusive privileges and rights in the registered design have not been

acquired in Singapore.

11 The relevant law of registered design

12 8 The legislation governing the law of registered design is

contained in the UK 1949 Act, the full title of which was set out earlier, as amended by

the United Kingdom Copyright, Designs and Patents Act 1988. The latter Act, which became

operative on 15 November 1988 effected a number of changes to the law of registered design

which are not material for present purposes. However, it may be useful background to note

that the UK 1988 Act amended the UK 1949 Act by making it clear that aesthetic designs

should remain registrable under the UK 1949 Act. The amendment was made in the wake of the

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issue whether the design was 'capable of registration' in the Privy Council
decision of *Interlego*

AG v Tyco Industries Inc [1989] AC 217. Accordingly, s 1 of the UK 1949 Act
was

amended by the deletion of the word 'solely'. The upshot is that it now suffices
that the

finished product "appeal to and are judged by the eye". The other background

information to bear in mind is the extension on applications of the period of
registration

protection from 15 years to 25 years. The registered design in this case will
therefore

potentially enjoy 25 years of protection if its registration is not invalidated.

13 9 The defendants contend that prior publication in Singapore by

the plaintiffs as registered proprietor of the registered design in the United
Kingdom is

a valid ground for this court to exercise its power under s 4 of our Act and that
this

court should make a declaration that the exclusive rights and privileges acquired
by the

plaintiffs by virtue of the United Kingdom registration do not extend to
Singapore.

Section 4 of our Act provides:

14 "4. The High Court shall have power upon the
application of any person who alleges that his interests have been prejudicially
affected

to declare that exclusive privileges and rights in a design have not been acquired
in

Singapore under the provisions of this Act upon any of the grounds upon which
the United

Kingdom registration might be cancelled under the law for the time being in
force in the

United Kingdom."

15 10 Section 11(2) of the UK 1949 Act, as amended, provides:-

16 "At anytime after a design has been registered, any

person interested may apply to the Registrar for cancellation of the registration
of the

design on the ground that the design was not, at the date of registration thereof,
new or

original, or on any other ground on which the Registrar could have refused to
register the

design and the Registrar may make such order on the application as he thinks
fit."

17 11 The subsections under s 1 of the UK 1949 Act, as amended, which
govern the registered design in this case are reproduced below, and for present
purposes

it is useful to italicise subsection (4):

18 "1. Designs registrable under Act

19 (1) In this Act 'design' means 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 -

20 (a) a method or principle of construction, or

21 (b) features of shape or configuration of an article

which -

22 (i) are dictated solely by the function which the article

has to perform, or

23 (ii) 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.

24 (2) 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.

25 (3) A design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic

considerations are not normally taken into account to a material extent by persons

acquiring or using articles of that description, and would not be so taken into account if

the design were to be applied to the article.

26 (4) *A design shall not be regarded as new for the purposes of this Act if it is the same design -*

27 (a) *registered in respect of the same or any other article in pursuance of a prior application, or*

28 (b) *published in the United Kingdom in respect of the same or any other article before the date of the application,*

29 *or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.*

30

31 (5) The Secretary of State may by rules provide for excluding from registration under this Act designs for such articles of a

primarily

literary or artistic character as the Secretary of State thinks fit."

32 12 In this action, at least one proposition is beyond dispute. It

is clear that a registered design will be cancelled on the grounds of prior
publication in

the United Kingdom: s 1(4). An article which has been passed into public use
or exposure

at a public exhibition would invalidate a subsequent registration: see *Leatheries*
Ltd v

Lycett Saddle and Motor Accessories Co Ltd (1909) 26 RPC 166 and *Kangol*

(Manufacturing) Ltd v Centro Komise (London) Ltd (1937) 54 RPC 211. A
design is not

'new' after it has been disclosed to the public.

33 13 The question for my determination is whether prior publication

in Singapore had invalidated the subsequent UK registration. The relevant
words in ss

1(4)(b) of the UK 1949 Act, as amended, are these: "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...". The expression "United Kingdom" means Great Britain and

Northern Ireland; neither the Channel Islands nor the Isle of Man are within the United

Kingdom: see the UK Interpretation Act 1978 s 5, Sch I. And the expression "Great

Britain" means England, Scotland and Wales under the Union of Scotland Act 1706

preamble I and the UK Interpretation Act 1978 s 22(1), Sch 2 para 5(a). Plainly, Singapore

is not referred at all in the paragraph. The wording of s 4 of our Act and ss 1(4) of the

UK 1949 Act, as amended is clear and unambiguous.

34 14 A survey of similar local legislation suggests that the meaning

of clear words has not been displaced. Until the enactment of our own Patents Act in 1994,

the previous regime depended on first registration in the United Kingdom. Section 9 of the

Registration of United Kingdom Patents Act, Cap. 271, since repealed in 1994, conferred

power on the High Court to declare that the exclusive privileges and rights in the United

Kingdom registered patent had not been acquired in Singapore "upon any of the grounds

mutatis mutandis upon which the United Kingdom patent might be revoked under the law for

the time being in force in the United Kingdom." So far, it was conceptually identical

to s 4 of our Act. But it went on to take care of the problem of prior publication in

Singapore. It provided that the grounds "shall be deemed to include the manufacture,

use or sale of the invention in Singapore before the priority date applicable to

the

patent in the United Kingdom,...". This express deeming provision is absent
from our

Act, which was a later ordinance passed by the then Singapore colonial
legislature. In

both Nigeria and Hong Kong, the then colonial governments expressly provided
that prior

publication in Nigeria and Hong Kong respectively would be an additional
ground to

invalidate the registration.

35 15 If one is permitted or has to look at the purpose behind the
enactment of our Act, there is in my view some substance in the plaintiffs'
submission

that our Act was enacted in 1938 for the sole purpose of conferring on British
manufacturers, who already had a registered design in the United Kingdom,
design

protection in the British colonies and dependencies without the need for re-
registration.

It was, in my view, an accurate assessment that our Act was drafted in such a manner that

all matters affecting the validity of the registered design were to be judged according to

the position in the United Kingdom under the law there: see Proceedings of the Legislative

Council of the Straits Settlements for the Year 1938.

36 16 The defendants rely on the Malaysian case of *Teh Teik Boay v*

Chuah Siak Loo [1962] 28 MLJ 80. The Malaysian Act, like ours, did not contain the

deeming provision. In that case, the registered design was in respect of a stool. Steps to

register the design were only taken in 1959 and registration became effective on 15

January 1960. It was found as a fact by the learned trial judge that the plaintiff had

"been manufacturing stools since 1949 of a design similar to that which has (later)

been registered." He further found that the plaintiff had been selling considerable

quantities of substantially similar stools to members of the public since 1954. The

learned judge in the penultimate paragraph of his judgment expressed the view that the

plaintiffs's design in the circumstances was not "new or original" within the

meaning of that expression in the then version of ss 1(2) of the UK 1949 Act. However, it

was plain that the entire case proceeded on the assumption that prior publication in

Malaysia (or in its predecessor Federation of Malaya) would suffice to invalidate the UK

registered design. That the course of the action had proceeded on this assumption was

noteworthy since the point was not raised on behalf of the plaintiffs who were represented

by learned counsel of eminence, Mr Eusoffe Abdoolcader, as he then was. In

the result, the defendant succeeded in his counterclaim. Accordingly, this case is of no assistance to the defendants in the present case as I could find no arguments from learned counsel nor any pronouncements on the point from the learned judge.

37 17 Counsel for the plaintiffs rely on *Mem Company Inc v Cussons (International) Ltd* [1974] RPC 7 in which Sedgwick J. considered The (Bermuda)

Patents, Designs and Trade Marks Act. That Act provides that a proprietor of a UK mark may

register that mark in Bermuda, and upon registration in Bermuda, it will be conferred all

the privileges and rights of the UK registration. Provisions are made for invalidation by

the Bermudan courts. Subsection 60(1) confers power on the Supreme Court to declare that

the exclusive privileges and rights conferred by the UK registration "have not

been

acquired on any of the grounds upon which the UK registration might be
cancelled under the

law for the time being in force in the United Kingdom." Significantly, ss 60(2)

states that "(s)uch grounds shall be deemed to include the use of the trade mark
in

these Islands prior to the date of registration in the United Kingdom." The
learned

judge was of the view that but for the deeming provision in the subsection all
matters

affecting the validity of the mark had to be judged according to the position in
UK under

UK law.

38 18 On behalf of the defendants, it is submitted that s 4 of our

Act should be construed to reflect the basic doctrine of the law of designs that
novelty

is lost by prior publication or prior use. It is said that the extension of the UK
1949

Act, as amended, should be subject to necessary changes. The submissions went further to

suggest that a literal interpretation of s 4 of our Act would lead to absurd results and,

more importantly, it would be inconsistent with ss 74(2), 74(3) and 74(4) of the Copyright

Act 1987. It is undeniable that the situation is unsatisfactory. However, I am reluctantly

constrained by the plain words of ss 1(4) of the UK 1949 Act, as amended.

39 19 I turn to the next issue. The items relied on by the defendants

have only been "published" in Singapore. As I am of the view that prior publication in Singapore is not sufficient ground to make the declaration, the narrower

second issue of fact does not arise. However, I shall deal with the issue briefly.

40 20 I need to repeat that ss 1(4) of the UK 1949 Act, as amended,

provides that a design is not new if it differs from a design registered or published in

the United Kingdom in respect of the same or any article "only in immaterial details

or in features which are variants commonly used in the trade". The items which are

photographed are in my judgment very different in nature from the registered design.

Secondly, none of the items come within the meaning of the word "article" as

defined in ss 44(1) of the UK 1949 Act, as amended, which provides that the word

"article" means "any article of manufacture and includes any part of an

article if that part is made and sold separately." Thirdly, the items relied on by

the defendants are not variants commonly used in the trade. There is no evidence to show

that double curve in the registered design as a feature must be used, let alone commonly

used, in the trade of the fabrication of plastic products for use with aluminium

extrusions. Finally, in my judgment the plaintiffs must have derived inspiration

from the
configurations of the items which were used in their cultural contexts and had,
in my
view, captured them in a novel way (including the double curve) as to appeal to
the eye of
the ordinary consumer.

41 21 Accordingly, the plaintiffs' claims are allowed and the
defendants' counterclaims are dismissed. There will be an order in favour of the
plaintiffs in the terms as agreed.

42 Sgd:

43 LAI KEW CHAI J

44 Judge

Lai Kew Chai J

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Toh Kok Seng and Mark Lim [Lee & Lee] for the plaintiffs
Alex Thian Phin Hock and Lee Kuan Choon [Yeo Wu & Thian] for
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