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SET 2

IN THE COURT OF APPEAL OF NEW ZEALAND

C.A. 184/86

BETWEEN

UPL GROUP LIMITED a duly  
incorporated company  
having its registered  
office in Queensland,  
Australia, Manufacturer &  
Merchant

First Appellant

A N D

CAROMA PLASTICS PTY LTD a  
duly incorporated company  
having its registered  
office in New South Wales,  
Australia, Plastic Products  
Manufacturer

Second Appellant

A N D

CAROMA SALES LIMITED a  
duly incorporated company  
having its registered  
office at 112 Stoddard  
Road, Mt Roskill, Auckland,  
Manufacturer & Merchant

Third Appellant

A N D

DUX ENGINEERS LIMITED a  
duly incorporated company  
having its registered  
office at Third Floor,  
Borthwick House, The Terrace,  
Wellington, Manufacturer &  
Merchant

First Respondent

A N D

PLUMBERS LIMITED a duly  
incorporated company having  
its registered office at  
412 Cuba Street, Lower  
Hutt, Merchant Distributor

Second Respondent

Coram:

Richardson J (presiding)  
McMullin J  
Somers J  
Casey J  
Bisson J

Hearing:

19, 20, 21, 22 September 1988

Counsel: A.H. Brown and A.F. Grant for Appellants  
I.L. McKay and I.R. Millard for Respondents

Judgment: 14 December 1988

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JUDGMENT OF THE COURT DELIVERED BY SOMERS J

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This is an appeal against a judgment of Jeffries J delivered in the High Court at Wellington on 22 August 1986 dismissing the appellants' action for infringement of copyright in artistic works and a registered design and their claim that the first respondent is passing off its products as theirs. .

The appellants are three of a group of companies engaged in the manufacture and sale of plastic products, including lavatory seats, lids and cisterns with which this case is concerned. The first, UPL Group Ltd, is an Australian company having a wholly owned subsidiary called Caroma Holdings Ltd, which in turn wholly owns the second appellant, Caroma Plastics Pty Ltd, an Australian manufacturer of plastic products, and the third appellant, Caroma Sales Ltd, a similar New Zealand manufacturer and merchant. Unless otherwise necessary, we will refer to the appellants collectively as Caroma.

The first respondent, Dux Engineers Ltd, is a New Zealand company also engaged in the manufacture and sale of

lavatory seats, lids and cisterns. The second respondent, Plumbers Ltd, another New Zealand company, is the sole distributor of the first respondent's products but is otherwise unconnected with it. Its fate in these proceedings must follow that of its supplier and we do not refer to it separately again.

Up until 1972 Dux had a virtual monopoly in New Zealand in the manufacture and supply of domestic lavatory appliances and remained dominant in that market up until about 1978. Its leading product, called Dux Lowline, comprised a wall cistern with an exposed pipe connected to the pan and a seat and lid. Until 1970 the cistern had to be placed far enough above the pan to allow a head of water sufficient to flush it. In that year Dux designed an underwater valve which efficiently flushed the pan with a pipe 1'6" in length. But until about 1979-1980 most local authorities, those in Christchurch and Dunedin were exceptions, did not permit its use.

In 1972 Caroma commenced operations in New Zealand. In 1978 it introduced a new plastic unit called Caroma Uniset. This comprised a seat, lid and backflap, a cistern operated by an underwater valve, and a plate called a connector piece or bridging plate having no functional purpose which linked the cistern to the back flap on the lid so that the whole appeared as one unit. It was immediately successful and drastically reduced the share of the market previously enjoyed by Dux. By 1980 it seems that most local

authorities would accept an underwater valve stimulated no doubt by its efficiency and by the demand for Caroma's product whose system included such an item.

In 1983 Dux introduced a new unit called Dux Twinline. It consisted of the same items as already described in the case of Caroma's unit. This had an immediate effect on Caroma's sales. In the year ended 30 June 1982 Caroma had sold 27,304 units. For each of the following 4 years its sales were in the vicinity of 13-14,000. In the first of those 4 years 3,229 Dux Twinlines were sold. In the next 3 years sales were between 12,400 and 13,800.

Short though it is that narrative provides a sufficient general outline of the circumstances and economic impulses which have led to the present litigation. A much fuller statement may be found in the judgment of Jeffries J. We will describe the competing units and their constituent parts in the consideration of the several causes of action to which we now turn.

#### Registered Design

The first appellant, UPL Group Ltd, was the proprietor of a design for a lavatory seat registered under the Designs Act 1953 as from 17 July 1970. Following two extensions the copyright expired on 17 July 1985. The appellant's claim of infringement relates to a period before that date.

In the High Court Dux counterclaimed for an order for the deletion of the entry in the register on the grounds

that the design was neither new nor original and was ambiguous. The Judge rejected those claims and upheld the registration. There is no cross appeal from that finding. A challenge in the High Court as to the sufficiency of the evidence of UPL's ownership of the design was not the subject of any express finding. Nothing now turns on this for the point was not pursued by Dux in this Court. It follows that the question of infringement or not is to be determined on the footing of UPL's ownership of a validly registered design.

The relevant provisions of the Designs Act 1953 are the definition of design in s.2, and ss. 5 and 11(1). Section 5(1) provides that a design may, upon application made by the person claiming to be the proprietor, be registered in respect of any article or set of articles specified in the application. Section 5(2) sets out the conditions necessary for registration -

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

It may be added here that regulation 23(2) of the Designs Regulations 1954 provides that, except in certain cases not here material, the application for registration 'shall be further accompanied by a statement of the features of the

design for which novelty is claimed'.

The definition of design in s.2(1) is as follows -

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

The rights given by registration are stated in s.11(1) -

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

The statutory provisions mentioned are the same as those contained in the Registered Designs Act 1949 (U.K.) and they, and earlier provisions, have been the subject of judicial consideration on many occasions. The most recent is in the decision of the Privy Council in Interlego A.G. v Tyco Industries Inc. [1988] 3 W.L.R. 678 in which the principal issue was whether certain drawings constituted 'designs' and if so whether they were 'capable of registration under the Registered Designs Act 1949' in which case artistic copyright under the Copyright Act would not subsist. Lord Oliver of Aylmerton delivering the judgment of the Board said -

... the purpose of the Act, as appears both from its terms and its legislative history, is to protect novel designs devised to be "applied to" (or, in other words, to govern the shape and construction of) particular articles to be manufactured and marketed commercially. ... the whole purpose of a design is that it shall not stand on its own as an artistic work but shall be copied by embodiment in a commercially produced artefact. Thus the primary concern is what the finished article is to look like and not with what it does and the monopoly provided for the proprietor is effected by according not, as in the case of ordinary copyright, a right to prevent direct reproduction of the image registered as the design but the right, over a much more limited period, to prevent the manufacture and sale of articles of a design not substantially different from the registered design. The emphasis therefore is upon the visual image conveyed by the manufactured article. ((1988) 3 W.L.R. at pp 685-6).

Whether there is an infringement of copyright in a registered design is a question of fact of which the eye is the judge. See e.g. Hecla Foundry Co v Walker Hunter & Co (1889) 14 App.Cas. 550, 555. It is not necessary for a plaintiff to establish a causal connection between the design and the infringing article as it is in the case of infringement of copyright under the Copyright Act. That emerges from the provisions of s.11 of the Designs Act 1953, set out above.

The test is whether the article alleged to be an infringement has substantially the same appearance as the registered design. This involves a comparison between the article complained of and the representations of the article contained in the application for registration. It is not always easy to compare a two-dimensional design with a three-dimensional object. That difficulty and the fact that a design means features of shape etc. applied to an article

by industrial process makes it evident, and it has been so held, (see Dunlop Rubber Co Ltd v Golf Ball Developments Ltd (1931) 48 R.P.C. 268, 277, 280 and Benchairs Ltd v Chair Centre Ltd [1974] R.P.C. 429, 441, 442) that articles manufactured by the plaintiff which embody the design may be compared with the artefact said to infringe. In the instant case, as we shall explain, the seat and lid of the Caroma Uniset produced in evidence do not appear to us to be a substantial representation of the registered design and no seat and lid manufactured by Caroma embodying the design was exhibited - indeed we are not clear that such a seat and lid was ever produced.

The statement of novelty under Regulation 23(2) was in the time-honoured phrase - 'The design is to be applied to a toilet seat and the novelty resides in the features of shape and configuration as shown in the accompanying representations'. The registration is accordingly for the seat and lid as a whole and infringement must rest upon imitation of the shape or configuration as a whole : see Jones and Attwood v National Radiator Co Ltd (1928) 45 R.P.C. 71, 83; Kevi A/S v Suspa-Verein U.K. Ltd [1982] R.P.C. 173, 177; Sommer Allibert (U.K.) Ltd v Flair Plastics Ltd [1987] R.P.C. 599, 620. There is also a relationship between the degree of novelty or originality of a registered design and the issue of infringement. If there is substantial novelty or originality small variations in the article alleged to infringe will be unlikely to save the



defendant. On the other hand if the features of novelty or originality are but little removed from prior art small differences may avoid an infringement. On this reference may be made to Simmons v Mathieson & Co Ltd (1911) 28 R.P.C. 486; Negretti and Zambra v W.F. Stanley & Co Ltd [1925] 42 R.P.C. 356; Dean's Rag Book Co Ltd v Pomerantz & Sons (1930) 47 R.P.C. 485; Sommer Allibert (U.K.) Ltd v Flair Plastics Ltd [1987] R.P.C. 599; Russell-Clarke on Copyright in Industrial Designs 5th Ed., 85-89; Morris and Quest, Design: The Modern Law and Practice 116-121.

The Judge began his decision on this part of the case by saying -

The complaint of Caroma is that the Deluxe seat has been copied by Dux in the production of the Dux Twinline. It says its copyright in the registered design has been infringed by the manufacture sale and offer for sale in New Zealand of the Dux Twinline toilet seat being an article to which the registered design, or a design not substantially different from the registered design, has been applied.

After dealing with the defences of ambiguity and want of novelty he said -

I begin by examining the two seats with the lids down, starting with the back flaps. First, however, I note both are squared off front and back, although the Caroma seat is more sharply squared at front. These features were common in the prior art. The back flaps have similarity in shape and configuration, but they also have easily observable differences. The Caroma back flap, although tapering to the rear, follows the outside curve of the lid making one curving line each side. The Dux back flap is clearly recessed leaving the line of the lid. Both are on a different plane to the lid but Caroma appears to be deeper with the tubular hinge visible. The hinge for the Dux is not visible from above. The most significant differences in my view are

to be found in the lid. Three striking features are the chamfer, the lip at the front, and the exposed hinge which I have already referred to. The Dux lid is an uninterrupted clear slightly convex plane. The front of the two lids differ in that the Caroma is obviously squarer with the sides leaving the front at an angle rather than the curve of the Dux. With the lid raised and the seat visible in the outside squared front a change takes place. The Dux seat is squarer and the Caroma much less so. I do not think to the eye the differences in the curve in front of the hinge where a change of plane occurs are significant, but the Caroma is markedly narrower. I have already observed earlier in this judgment the underside of the flaps on the respective seats appear quite differently to sight inspection, with the Dux more complicated.

In summary, the court's view is that bearing in mind the registered design and the Caroma Deluxe seat, the Dux Twinline seat is not an infringement.

Two matters advanced on behalf of the appellants can be disposed of shortly. First it is said that the Judge erroneously considered that the plaintiff's case involved proof of copying. We are satisfied that is not so. The use of the word 'copied' in the first extract, set out above, upon which the submission is based was not used in the sense of a causal link as in the law of copyright. It was no more than a general introductory statement about the case under this head. When the Judge came to the issue of infringement he correctly stated the position. The second is that the Judge recorded the fact that the appellants had an independent claim for infringement of copyright under the Copyright Act. This, it was said, was an inference that there was an inconsistency in their claims. We are satisfied there is nothing in this point.

The major grounds are that the Judge compared the

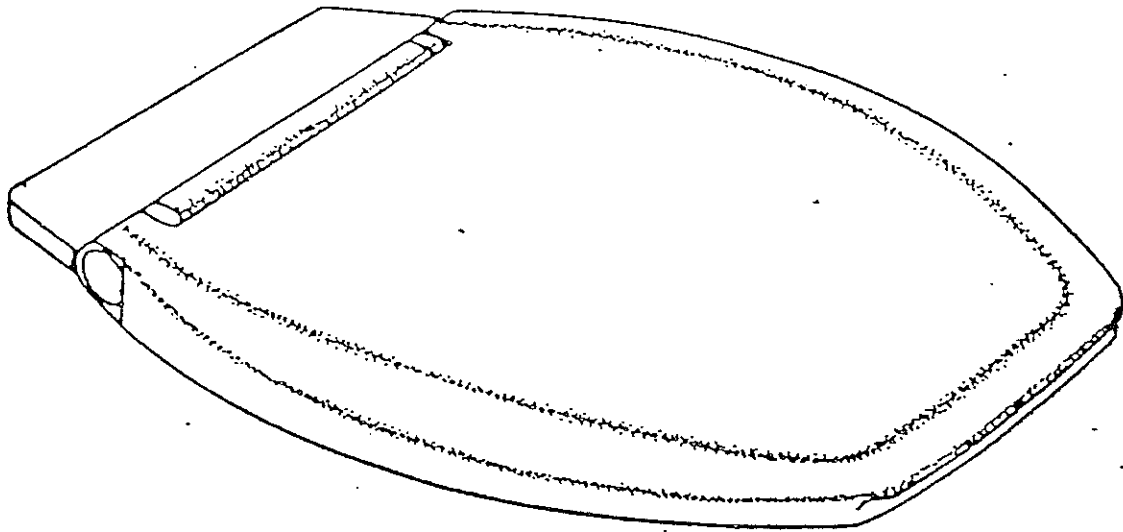
Caroma product, acknowledged by its counsel as not manufactured precisely to the representations on the design application, with the Dux seat when the proper comparison is between the representations and the alleged infringing product and that he erroneously took account of features of the registered design dictated solely by function, this being a reference to the means by which the seat is connected to the pan.

There is, we think, no doubt that the two seats and lids were compared and that some weight was put on the functional features under the back flap. That does not of itself establish UPL's case. In a case of infringement the issue is one of fact and while the findings of a trial Judge are to be accorded respect an appellate Court must, in the end, come to its own view. Where the Judge has brought extraneous matters to account this Court must form its own opinion uninfluenced by that expressed in the judgment under appeal.

The case involves a comparison of the design representations and the Dux seat and lid, and in that comparison the appellant's manufactured article can have little value.

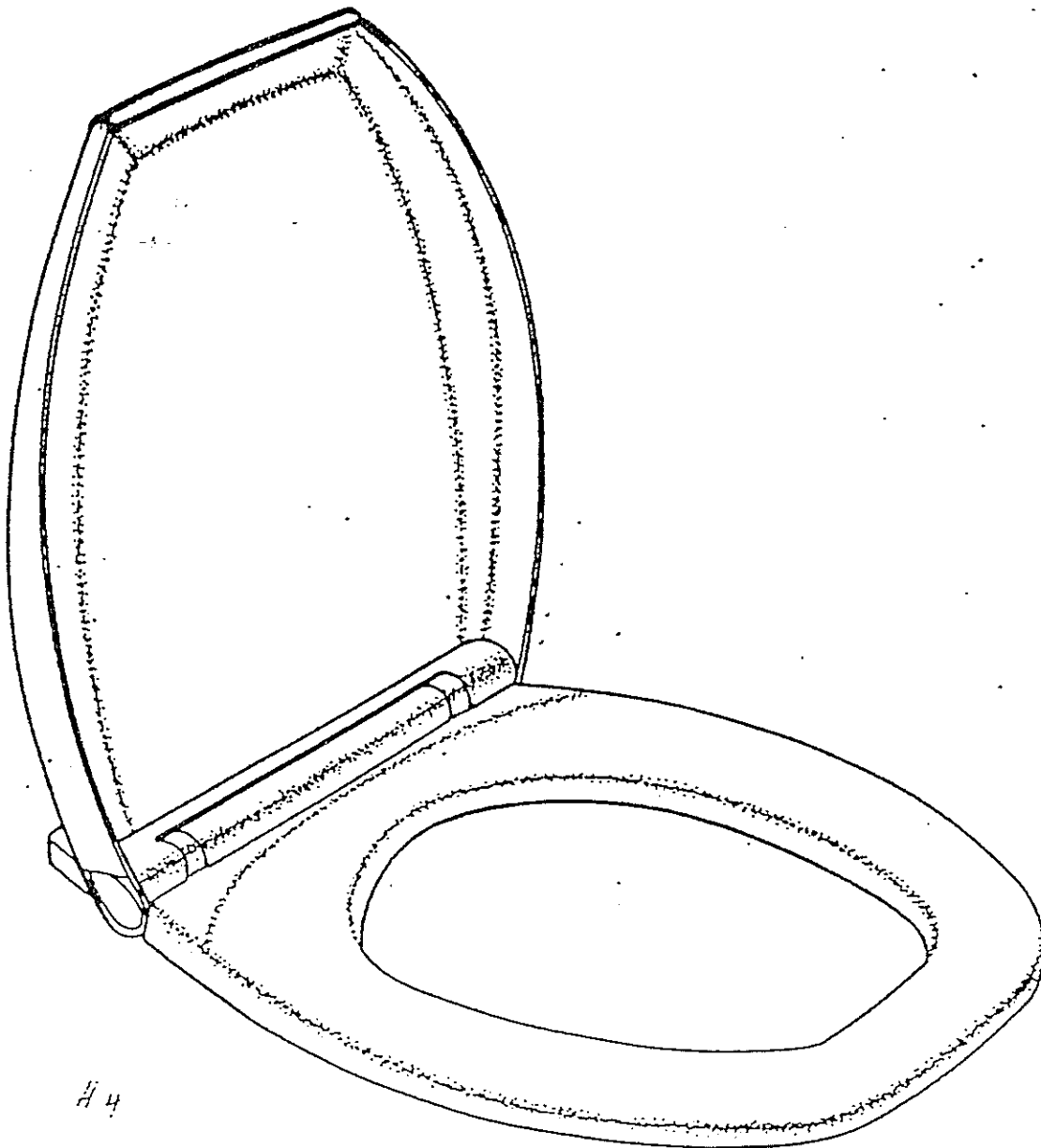
The design representations are of a lavatory seat, lid and back flap all connected by a moulded hinge. The parts of the representation showing perspective plan in closed and open position are a better medium of description than words.

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H<sub>3</sub>  
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PERSPECTIVE PLAN  
CLOSED POSITION



H<sub>4</sub>

PERSPECTIVE PLAN  
OPEN POSITION

PERSPECTIVE INVERTED PLAN

The features which stand out are the downward slope or bevel on the top of the lid beginning and ending with curves, the squared off front of the lid, the lip on the front of the lid, the tubular hinge exposed when the lid is both open and closed, and the back flap extending across the back of the lid forming a nearly continuous line with its inwards curve. Of these the most striking feature to the eye is the shape of the top of the lid conveyed by the slope along the edges and front. The appellants draw attention also to the fact that when the lid is closed it overlaps the seat at the front corners. We did not understand it to be suggested that the seat itself had any particular features of shape or configuration which distinguish it in any substantial way from the prior art.

The set exhibited by the appellants, itself a part of its Caroma Uniset, corresponds with the design representations save for one feature. The bevel on the lid of the manufactured article is sharply delineated on its edges; it commences with a distinct angle and not, as depicted, by a curve. It is a distinctive feature to which the eye is drawn.

The Dux Twinline seat lid and back plate differ in the following respects from the registered design (and also from the Caroma product). The back flap does not extend fully across the back of the lid; the lid has no bevel as shown on the design; but is an uninterrupted slightly convex plane; the lid has no lip; the hinge is not exposed when the lid is

shut and when open presents a different appearance; when opened the Dux lid shows a rounded contour where the Caroma lid shows an angled change of direction to the slightly convex lip.

Having considered the design representation and the Dux seat and lid over a lengthy period both separately and together and closely and at distance, we are of opinion that the Dux seat does not infringe the registered design.

#### Copyright

As well as being the registered proprietor of the design of the Caroma deluxe toilet seat and accessories UPL Group was the owner of the copyright in the drawings and tooling of the same items as well as the bridging plate or connector piece joining seat and lid to the cistern. The second appellant, Caroma Plastics, had, until 1983 when it was assigned to UPL Group, a like copyright in a seat and lid called the Hibiscus.

Section 30(1) of the Copyright Act 1913 provided that the Act did not apply to designs capable of registration under the Patents Designs and Trade Marks Act 1908 (and later the Designs Act 1953) except in the case of designs not used or intended to be used as models or patterns to be multiplied by any industrial process. This limitation was deliberately omitted from the Copyright Act 1962 - see paras 300-310 of the Report of the Copyright Committee 1959 known as the Dalglish Report. The result was that in the case of

a registered design intended to be applied industrially there was a double protection during the term of design registration and at its expiry a continuing copyright protection. Because it is an infringement of copyright to make without licence an article from a copyright drawing or to copy indirectly from an artefact made with licence copyright also afforded protection against the reproduction of solely functional articles although protection in such cases is the general object of the Patents Act. In this area New Zealand evidently stood alone in respect of industrial copyright - see the note at p.412 of Cornish on Intellectual Property.

These features are the subject matter of the Copyright Amendment Act 1985. By a new s.20B inserted in the Copyright Act, in force as from 1 October 1986, it is provided that the making of an object in three dimensions does not infringe the copyright in an artistic work if, when the object is made, the artistic work has been lawfully applied industrially (as that term is defined) in New Zealand or in any other country more than 16 years before the object is made. (Sixteen years is the term of a patent). By a new s.20A the making of a three dimensional object does not infringe copyright in an artistic work if the work forms part of a representation of a design open to public inspection in the Patent Office in respect of a design for which registered protection in New Zealand has ceased and is used for the purpose of making the object.

Section 20A came into force on 1 October 1985.

It follows that insofar as the copyright claimed to be infringed relates to the registered design the action can only relate to infringement prior to 1 October 1985. The protection provided by the remainder of the copyright so far as it was lawfully applied industrially will terminate 16 years after that application. In this case defences to the claims for infringement founded on ss. 20A and 20B were abandoned in this Court. Those sections may have relevance in relation to relief if the cause of action is otherwise made good.

By their amended statement of claim, after claiming the subsistence of the two copyrights, one in the Caroma seat lid and connector-piece and the other in Hibiscus seat and lid, the appellants asserted that in or about April 1983 and continuously thereafter Dux 'infringed the First and Second Plaintiff's copyright in the drawing and tooling' of the Caroma deluxe toilet seat and its component including the connector-piece and of the Hibiscus toilet seat and its components by 'reproducing the artistic works or one or both of them in a material form more particularly being the Dux Twinline toilet seat and curved matching flush fitting bridging plate'. The appellants' pleadings do not indicate what features it alleged were copied from either or both copyrights and no particulars were sought or given.



This unsatisfactory pleading caused the Judge some difficulty. We were told that Mr Gault, leading counsel for the appellants in the High Court, stated in opening the case -

The plaintiffs claim that the Dux product is derived in part from the Hibiscus and in part from the Uniset. The front portion of the Dux Twinline ... matches the front part of the Hibiscus seat and lid to a striking degree. Towards the rear, because they took the longer plate/connector, there is something of a transition from one to the other. Of course the resemblance in the area of the backflap and connector between Dux Twinline and the Uniset is very apparent.

In his final submissions Mr Gault stated the appellants' case in relation to the Hibiscus copyright as being that the lid appearance and the front area of the seat and lid components of the Dux seat and lid were virtually identical with the same parts of the Hibiscus unit. As to the Caroma Uniset copyright he said 'The first defendant has taken the visual design features at the rear of the set and extending through the connector up to the cistern. The assembly or arrangement (although constructionally different in areas not visible in the assembly) has the same essential design features in this area'. The copying was said to be in respect of the connector piece, the back flap, the hinging, the angle on the side view of the seat and lid towards the rear and the contouring or sculpturing round the back of the seat.

Much was sought to be made of some comments by the Judge on the relation between the plaintiffs' pleadings on copyright and the other issues. He referred to a hidden conflict, a dilemma, and the fading or dissolving of one

plea into another. In the end however he dealt with the matter as it was put to him by Mr Gault in his closing address. Nothing is to be gained by further elaborating on these expressions. The issue is whether the Judge was correct in holding that no infringement had been made out.

Where a composite work is claimed to infringe one copyright as to a part and another copyright as to another part each requires to be separately considered. This seems self-evident in the case of a literary work where a defendant is said to have plagiarised two works and we do not think it can be different in the case of an artistic work. No doubt if copying is proved in one case, similarity in the other may more easily lead in the latter case to a finding of infringement.

It is convenient to refer first to the asserted infringement of the Caroma copyright, this being summarised in the appellants' written material as being in relation to the connector piece, the rear of the seat or lid, comprising the tubular hinge, the side angle of the seat and lid and the contour of the seat at the back, and the back flap.

The success of the Caroma Uniset practically drove Dux out of the market for lavatory components and led it to the design and production of a new version. It is hardly surprising that its new product should bear some similarity with that of Caroma which had proved so successful. Whether there was an infringement depends whether the parts of the

Dux Twinline mentioned bear a sufficiently close resemblance to those of the Caroma Uniset and, if so, whether that resemblance is due to copying. There need not be an exact imitation; it is enough that there has been a substantial appropriation of the appellants' skill, work and labour. What is substantial is a matter of fact and degree in which the quality of what is appropriated is more important than the quantity. In that value judgment there lies the balance between the private right to exploit the expression of the author's ingenuity, skill, labour or imagination and the public interest in obtaining the benefit of creative work and thought.

Viewed separately or together the single most striking feature of the competing units is the continuous line between seat and cistern provided in each case by the connector piece. There is of course no claim to protection or monopoly for the idea or concept which it illustrates. Each of the plates in its general expression, visible when the unit is assembled, comprises a flat horizontal surface of nearly the same width turning to the vertical in a curve whose radius in each case is either identical or so nearly the same as to appear identical. The similarity of width at the pan end of the plate is to enable it to fit, by means of attachments, the various lavatory pans permitted to be used. Of these features it is the flat plane of the horizontal cover which stands out when assembled. There the similarities cease. The vertical part of the Dux piece is

considerably higher than that of the Caroma this being, according to the evidence, to allow the cistern to be placed slightly higher on the pan and hence give it better flush. The vertical part of the Dux plate is of the same width as the horizontal and its upper edge (not readily visible when assembled) is straight. The vertical part of the Caroma is slightly tapered inwards and the top is concave so as to match the concavity of the cistern to which it is attached. The manner in which the top of the plate is affixed to the cistern differs substantially as does the connection to the pan itself. Although we have little doubt that Dux has filched the idea of a connector piece from Caroma, that which it has produced is in our opinion not substantially the same as that of Caroma.

Much the same may be said of the two back flaps. The functional parts of each, which are not visible when the units are assembled, are quite different. So too is their link within the hinge; on the Caroma the long line of the tubular hinge is a part of the back flap, it is not so on the Dux. The flap on the Dux is longer and has a bulkier appearance. Both taper from the seat backwards. The base of the Caroma flap extends to the edge of the seat lid, that of Dux is not as wide as the back of the seat lid. Save for the similarity of idea there is in our view no substantial similarity.

Nor do we think the remaining features relied on by the

appellants demonstrate a sufficient degree of similarity. A tubular hinge is used in each case. That of Caroma is visible when the seat lid is down; it cannot be seen on the lid of the Dux which extends completely over the hinge. The other features relied on also have material differences.

We are of opinion that whether each of the parts mentioned are looked at individually or all are looked at collectively they do not evidence such a degree of resemblance as to surmount the first hurdle in a claim of infringement of the copyright in the relevant parts of the Caroma seat lid and connector piece.

The claim of infringement of the Hibiscus copyright is stated in the appellants' written material as being that 'the lid appearance and the front area of the Dux Twinline seat and lid components are virtually identical'. Those components do not include a back flap, the Hibiscus had none, nor a tubular hinge for that on the Hibiscus appears as an enclosed square when the lid is raised. The lid appearance apparently refers to the general appearance of the lid at least when closed.

The evidence of Mr Poore, an expert called by the appellants was that -

In the front part half of both of these shapes I found that there was a very close conformity very very similar almost exactly the same shapes, both in the seat and in the lid, and similarity continued on the inside of the hole in the seat; it did not extend to the outside of the back part of the seat or the back part of the lid.

Particular reliance was placed on two matters. First the curves on the front of the Dux seat and lid were claimed to be in virtual correspondence with those of the Hibiscus, and secondly the underside of front folds of the lid do not in either case exactly match the contour of the seat. As a result there is a small gap at that point. The way this mismatch arose in the case of Hibiscus was explained; it is enough to say that it was not the product of deliberate design. This feature, also present in the Dux seat, is said to demonstrate copying as a fingerprint establishes identity.

The designer of the Dux seat was no longer alive when the case was heard. Drawings prepared by him were produced and explanations of them given by his son so far as he was able to do so. The sequence of the drawings was not in dispute. The first, Exhibit ID7 drawing 9 of seat and lid, is in considerable detail and shows the front curve of the lid in what appear to be two different shapes as does the front curve of the seat on ID7 drawing 12. The outer was eventually adopted and the inner is said to resemble the curve on the Caroma seat. The first drawing is in considerable detail and the son said that as far as he knew it was not preceded by any other drawing. These and other drawings indicate that the designer had some difficulty in fixing the radii of the curves necessary for the construction of moulds. It was explained that the curve on the Hibiscus seat was created by the use of flexible or

tactile material called flexi-curve while that of the Dux seat is supposed to have emerged in the first drawing mentioned.

Our consideration of the whole of the evidence as to deliberate copying leads us to the conclusion that it is finely balanced. It is not inconsistent with Caroma's case but seems to us to be consistent also with that of Dux, namely that it was independently produced.

In that state of affairs a visual comparison of the features of the two seats is critical. It has to be made in the light of the existing state of the art and the trends of fashion. So far as the latter is concerned the slightly squarer look of the front curves of seat and lid had become popular. As to the former the wealth of material put in evidence shows varying curves many with little visual difference. One of the exhibits in the case is formed by placing the front part of an Hibiscus lid on to the front half of the Dux lid so as to present the top and edge or curve of each to a comparative view. This reveals some differences. The curves, while nearly the same, do not exactly match. As well the Hibiscus lid is more convex than that of the Dux so as to form an increasingly wider edge than that of the Dux. The front of the seats similarly exhibited, display like differences, in particular the similarity of curve is not so close and the width of the Dux seat is somewhat greater.

In the case of common domestic appliances such as lavatory seats and lids to cover the same, the range of curves adapted to a front having a square appearance is probably not large and small differences will be enough to rebut the inference of copying. Sufficient differences exist in this case and we therefore reject the appellants' claims.

Passing off

It is not disputed that since 1972 Caroma has distributed its 'Caroma Uniset' in New Zealand. This is described in its amended statement of claim as an integrated set comprising and featuring '(a) matching toilet seats and toilet cisterns (b) a connecting curved matching flush-fitting bridging piece (c) a back flap to the toilet seat connecting to the bridging piece (d) a toilet seat with squared front and back edges (e) a lid fully covering the toilet seat'. After averring the existence of reputation in New Zealand by reason of extensive promotion by reference to 'the distinctive appearance or 'get up' of the component products in matching attractive colours in integrated sets' Caroma's pleading continued -

27. A person seeking in New Zealand or seeing toilet cisterns and seats of matching, attractive colours connected by flush fitting curved matching bridging pieces presented or advertised as to appear to be integrated sets would expect the products with which he would be supplied or which were so presented to be the first and third plaintiffs' Caroma Uniset products.



28. Since in or about April 1983 the first defendant has promoted and sold a combination toilet seat and cistern in matching colours known as the Dux Twinline, incorporating:-

- (a) a curved matching flush-fitting bridging plate between the toilet seat and the cistern
- (b) a back flap to the toilet seat connecting to the bridging plate
- (c) a toilet seat with squared front and back edges
- (d) a lid fully covering the toilet

all being the same features as have become distinctive of the first and third plaintiffs' Caroma Uniset products.

It was then claimed that in adopting and incorporating the features referred to in para 28 Dux passed off its product as being that of Caroma.

The Judge found that Caroma had established a reputation or goodwill and that there was evidence of some confusion but that the necessary misrepresentation had not been made out, and accordingly dismissed the claim of a passing off.

The argument on this part of the case ranged widely. We propose to deal with one criticism of the judgment in the High Court before turning to what we consider are the essential features of the case.

It was submitted that it is implicit in the judgment in the High Court that some form of intentional misrepresentation is necessary. This it is said emerges from the distinction drawn by the Judge between confusion and misrepresentation. There is no doubt that an intent to

deceive is not an ingredient of the tort of passing off. The point is referred to in Dominion Rent A Car Ltd v Budget Rent A Car Systems (1970) Ltd [1987] 2 N.Z.L.R. 395 at 420. A fraudulent intention is only material in that once established a Court is likely to conclude that its purpose has been achieved : see e.g. Claudius Ash Son & Co Ltd v Invicta Manufacturing Co Ltd (1912) 29 R.P.C. 465, 475. Our reading of the judgment does not suggest that the Judge misunderstood these elementary points.

The products of the parties are respectively sold under the names 'Caroma' and 'Dux'. That there has been some confusion is plain enough. Perhaps the best evidence is that contained in advertisements by the retail firm of Smiths City Market. In the Christchurch Press of 18 August 1983 and the Christchurch Star of 20 February 1984 the Caroma Uniset is depicted while the wording refers to Dux. There is other evidence too.

We consider it quite likely that numbers of prospective purchasers may think that both the Caroma Uniset and the Dux Twinset are products of the same manufacturer. But for reasons which we will set out later in this judgment, we do not think they could suppose that the two are the same.

This is not a case of get up in the sense of packaging or the presence of some 'capricious addition to the article itself': see per Fletcher Moulton L.J. in J.B. Williams Co. v H. Bromley & Co Ltd (1909) 26 R.P.C. 765, 773. It is a

case in which Caroma claims a distinctiveness arising from the actual shape and appearance of its product and a passing off arising from its simulation by Dux.

Logically the shape or appearance of a product or some feature of it may, as in the case of distinctive packaging, become identified in the market with its maker or its distributor. Just as the words 'camel-hair belting' became synonymous with Reddaway see (Reddaway v Banham [1896] A.C.199) so the features of a product may be sufficiently distinctive as to become synonymous with its maker. Logic here, however, may come into conflict with policy. It is one thing to restrain a passing off which does not prevent the marketing of a similar product only requiring its garb, mark or other such distinguishing features to be avoided. It is another thing to prevent competitors marketing an identical product and thereby giving the plaintiff a monopoly not protected by patent, registered design or copyright.

This point has been adverted to in many cases, in some directly in others implicitly. Reference may be made to Edge v Nicholls [1911] A.C. 693; Dunhill v Bartlett & Bickley (1922) 39 R.P.C. 426, 438; Hawkins & Tipson Ltd v Fludes Carpets Ltd v British Floorcloth Coy Ltd [1957] R.P.C. 8; British American Glass Co Ltd v Winton Products (Blackpool) Ltd [1962] R.P.C. 230; Benchair Ltd v Chair Centre Ltd [1974] R.P.C. 429, 431-436 (at first instance); G. Hensher Ltd v Restawile Ltd [1973] 1 W.L.R. 144, 148-150; Jarman &

Platt Ltd v I. Barget Ltd [1977] F.S.R. 260. The policy issues involved are also referred to in Ricketson's, Law of Intellectual Property at pp 545, 546; Kerly's Law of Trademarks and Trade Names, 12th Ed., para 16.67; and, more extensively, by J.M. Evans in (1968) 31 M.L.R. 642.

The present case, however, does not call for any consideration of this issue. The general similarity of the Caroma Uniset and the Dux Twinline arises from the appearance of integration between seat and lid and cistern. In that similarity the connecting piece or bridge plate is the most important feature - it welds or draws together the two main parts. In actual and visual bulk the cistern and seat and lid are dominant. Caroma's cistern and its lid have a concave front with angular edges. The cistern forming part of the Dux Twinline is slightly convex with rounded edges and looks much bulkier. They are quite dissimilar. We have already referred to the differences between the lids of each set. Neither closely resembles the other. The dissimilarities in the connecting plates have also been noticed.

In addition to those features each bears its mark on the flushing button on the top of the cistern, one 'Caroma Uniset' below a crown or coronet, the other the word 'Dux' and in lesser print the words 'Twinline'.

We are of opinion that the Dux Twinline is patently different in appearance from the Caroma Twinset and accordingly that there is no misrepresentation. The confusion that may exist as to the makers or distributors arises from the fact that each set is a unit, made in plastic, and having the unity provided by the connector piece. These features provide no grounds for holding that Dux has represented its product as that of Caroma.

For the foregoing reasons the appeal is dismissed. The appellants must pay the respondents' costs which are fixed at \$8,000 together with reasonable disbursements as fixed by the Registrar.

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