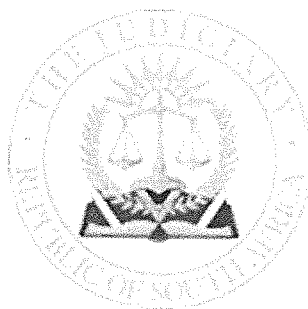
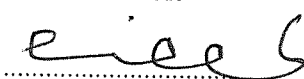




IN THE HIGH COURT OF SOUTH AFRICA

(GAUTENG DIVISION, PRETORIA)

DELETE WHICHEVER IS NOT APPLICABLE	
(1)	REPORTABLE: YES/NO
(2)	OF INTEREST TO OTHER JUDGES: YES/NO
(3)	REVISED No
DATE:	25 OCTOBER 2019
SIGNATURE:	

Case No. 69172/2019

In the matter between:

INNOVATIVE WATER CARE LLC

FIRST APPLICANT

INNOVATIVE WATER CARE SOUTH AFRICA (PTY) LTD

SECOND APPLICANT

and

FLUIDRA WATERLINX (PTY) LTD

RESPONDENT

JUDGMENT

MILLAR, A J

1. The Applicants and the Respondent conduct business as manufacturers and suppliers of water treatment chemicals within the Republic. In issue in the present application is the registered design¹ of what is commonly referred to as a "pool floater". This is a container, which is placed into a swimming pool, floats in an upright position, and the portion of the container which contains chemicals - that dissolve over a period of time - is immersed under the surface of the water. The purpose of the "pool floater" is to treat and to maintain the pool water.
2. The products of the Applicants are marketed under the brand "HTH" and those of the respondent under the brand "Blu52". For convenience, the respective products will be referred to as the "HTH floater" and the "Blu52 floater". The HTH floater has been manufactured, marketed and sold commercially since 2013.
3. During the latter part of August 2019, the Applicants discovered that the Respondent was manufacturing, marketing and selling the Blu52 floater (the Blu52 Big Easy Multifunctional floater), a product which it contends infringes upon its registered design. The present motion proceedings were brought by way of urgency by the applicants to *inter alia* interdict the respondent from manufacturing marketing and selling the infringing product.

¹ Registered by the applicant with the Registrar of Designs on 26 October 2011 as F2011/001701. The first applicant is the owner of the design and the second applicant its exclusive licensee within the republic.

4. From the time that the applicants design was registered on 26 October 2011 there has been no challenge² to the applicant's design.
5. It is common cause between the parties that other manufacturers, besides themselves, manufacture, sell and distribute pool floaters with a substantially similar shape and appearance and have done so before the registration of the design and afterward. Neither the shape nor the form of a pool floater is in issue.
6. In issue is whether or not the specific design and functional features registered by the Applicants and the HTH floater currently manufactured and sold, are sufficiently closely connected so as to afford the Applicants the protection of the Act³.
7. The Designs Act "provide(s) for the registration of designs" The Act recognizes that two distinct types of designs may be registered. Section 1 provides:

"aesthetic⁴ design" means any design applied to any article, whether for the pattern or the shape or the configuration or the ornamentation thereof, or for any two or

² Section 31(1) of the Act specifically provides that "any person may at any time apply to the court in the prescribed manner for the revocation of the registration of a design" and then sets out various grounds upon which such an application may be made.

³ The protection afforded to a registered design holder is set out in section 20 of the Act which provides - "*The effect of the registration of a design shall be to grant to the registered proprietor in the Republic, subject to the provisions of this Act, for the duration of the registration the right to exclude other persons from the making, importing, using or disposing of any article included in the class in which the design is registered and embodying the registered design or a design not substantially different from the registered design, so that he shall have and enjoy the whole profit and advantage accruing by reason of the registration. The disposing of an article embodying a registered design by or on behalf of a registered proprietor or his licensee shall give the purchaser the right to use and dispose of that article*

⁴ *Bayerische Motoren Werke Aktiengesellschaft v Grandmark International Ltd and Another* 2014 (1 SA 323 (SCA)) at paragraph 11 where it was stated that: "aesthetic designs are those that invite customer selection – and customer discrimination between articles – solely by their visual appeal."

more of those purposes, and by whatever means it is applied, having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof;

"design" means an aesthetic design or a functional design;

"functional⁵ design" means any design applied to any article, whether for the pattern or the shape or the configuration thereof, or for any two or more of those purposes, and by whatever means it is applied, having features which are necessitated by the function which the article to which the design is applied, is to perform, and includes an integrated circuit topography, a mask work and a series of mask works;

8. In order for a design to be registered, it must in the case of an aesthetic design be new and original⁶ and in the case of a functional design, new and not commonplace in the art in question⁷. Designs may be registered as aesthetic⁸, functional⁹ or even both¹⁰. When a design is registered, it must be accompanied by a definitive statement on the prescribed form. This statement *"shall be used to interpret the scope of the protection afforded by the*

⁵ "functional"- used as an adjective "of, pertaining to, or serving a function, office, or purpose; relating to activity rather than to structure or form" The Shorter Oxford English Dictionary, ibid, vol 1-page 1049

⁶ See section 14(1)(a)(i) and (ii)

⁷ See section 14(1)(b)(i) and (ii)

⁸ Section 15(1)-part A of the Register

⁹ Ibid part F of the Register

¹⁰ Section 15(3) specifically provides for registration in both parts.

*design registration*¹¹ and regard may also be had to the explanatory statement which accompanies it, as an aid to interpretation¹².

9. It is not in dispute that that the Applicant's design, a functional design, as registered fulfills the requirements of Section 14(1)(b), 14(2), 14(3) or 14(4) of the Act or that in terms of Section 22(1)(b) that the Applicants are entitled to the protection of their functional design for a period of 10 years from registration until 26 October 2021¹³.
10. The specific design registered by the First Applicant is described in the "*definitive statement and explanatory statement*" filed with the Registrar as follows:

"The features of the design for which protection is claimed include the shape and/or configuration of a container for water treatment chemicals, substantially as illustrated in the accompanying representations, it being a definitive feature of the container that the tubular container portion, indicated by reference letter "A" in the representations, is transparent or translucent, to enable the contents of the tubular portion, indicated by reference letter "B" in the representations, to be viewed by the eye from outside the container. The contents B of the container are disclaimed.

Explanatory statement:

The design provides for container for water treatment chemicals. The tubular container portion houses the chemicals, particularly, but not exclusively, in table

¹¹ Regulation 15(1) of the Regulations promulgated in terms of the Act.

¹² Regulation 15(4)

¹³ The period for which aesthetic designs are protected in terms of section 22(1)(a) is 15 years.

form, and depends from a float. The tubular portion may be of a clear material and transparent or it may be of translucent material that may be colour-tinted and adapted to enable the contents of the container to be viewed by the eye from outside the container."

11. The dispute in the present matter relates to the "tubular portion" of the design which holds the chemicals. The Applicants argued that the specific features of transparency and translucency of that portion of the design are protected by the registration. The graphic representations of the container as a whole, submitted when the design was registered were simply indicative of the shape of the container and that the explanatory and definitive statements make it clear what specific functional design was registered.
12. The Respondent on the other hand argued that the registered design must be considered as an indivisible whole and that the graphic representations of the design did not correspond precisely with the actual product. It is for this reason that the functional features of transparency or translucency of the tubular portion which the Respondent has copied, are not on their own capable of protection within the registered design.
13. It is not in dispute that the specific physical features depicted on the graphic representation forming part of the definitive statement and explanatory statement, for the Applicant's design, do not match precisely the Applicants HTH floater that is presently available on the market.
14. Clear colour photographs of both the HTH floater and the Blu52 floater were attached to the papers in this matter and the parties also made available at the hearing of the

application physical examples of the HTH floater and Blu52 floater. Photographs and physical examples of other commercially available pool floaters were also made available.

15. In common, both the HTH floater and the Blu52 floater have the tubular portion which contains the chemicals, manufactured from a transparent plastic material through which in particular, insofar as the chemicals in the tubular portion are concerned, they can be seen with the naked eye.
16. The respondent compared the applicant's graphic representation of the container with the actual product and identified a number of differences on the tubular portion, but these are not particularly significant due to the transparent nature of the material from which the tubular portion of the floater is manufactured. Other differences such as the size of the apertures through which the water enters and exits the container, or the colours of different parts or the size of the float portion were identified.
17. Notwithstanding what differences there may be, visually both the HTH floater and Blu52 floater appear substantially the same insofar as the transparent tubular portion are concerned..
18. In *Clipsal Australia (Pty) Ltd & Another v Trust Electrical Wholesalers & Another*¹⁴, the Supreme Court of Appeal held that:

“[20] ...

¹⁴ 2009 (3) SA 292 (SCA) at 297A – 298C

*The 1993 Act requires that aesthetic designs must be new and original and that functional designs must be new and not commonplace. Originality and being “not commonplace”, consequently, cannot mean the same. The only other meaning ‘original’ can bear is one that is the same or akin to the meaning of copyright law, something that is not far-fetched if regard is had to the fact that the 1916 Act spoke of design copyright. As was said by Mummery LJ in *Farms Build v Carier* [1999] RPC 461 at 482:*

The court must be satisfied that the design for which protection is claimed has not simply been copied (eg like a photocopy from the design of an earlier article. It must not forget that, in the field of design of functional articles, one design may be very similar to or even identical with another design and yet not be a copy: it may be an original and independent shape and configuration coincidentally the same or similar. If, however, the court is satisfied that it has been slavishly copied from an earlier design, it is not an ‘original’ design in the ‘copyright sense’”

[21] ...

[22] *The designs test is closer to the patent infringement test. This dictum from *Incandescent Gas Light Co v de Mare etc System* in a patent infringement context is equally applicable to the present context:*

When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and those left or varied; it is seldom that the infringer does the

thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits and the only protection the patentee has in such a case lies, as has often been pointed out by every Court, from the House of Lords downward, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated"

19. The transparent or translucent tubular portion of the HTH floater, while not original in terms of shape and form, is original and not commonplace in respect of the transparent portion when one has regard to the various pool floaters marketed and sold before and after the registration of the design.
20. For 8 years after the registration of the design and 5 years since its introduction to the market in 2013 by the Applicants, no other pool floater, until the respondents Blu52 floater, had the transparent or translucent tubular portion through which the chemicals could be viewed. The "substance" of the design was the transparency or translucency of the tubular portion.
21. The question then arises as to whether the "substance" on its own is capable of the protection afforded by the Act or whether it is only the whole of the registered design? The answer to this question lies in the definitive statement and explanatory statement.
22. In regard to the definitive statement, in the Clipsal¹⁵ case, the Supreme Court of Appeal held:

¹⁵ Supra at 295F - H

[7] *The definitive statement in this case is of the omnibus type because it does not isolate any aspect of the design with the object of claiming novelty or originality in respect of any particular feature. As Laddie J explained in Ocular Sciences Ltd v Aspect Vision Care Ltd [1997] RPC 289 at 422:*

The proprietor can choose to assert design right in the whole of any part of this product. If the right is said to reside in the design of a teapot, this can mean that it resides in design of the whole pot, or in a part such as the spout, the handle or the lid, or, indeed, in a part of the lid. This means that the proprietor can trim his design right claim to most closely match what he believes the defendant to have taken.

This means that the shape or configuration as a whole has to be considered, not only for purposes of novelty and originality, but also in relation to infringement.

23. If one has regard to the definitive and explanatory statements forming part of the registered design, it was neither contemplated nor intended by the Applicants that the general design, shape or form of the pool floater or the specific graphic rendering thereof was intended to be indivisible from the function of the transparent or translucent tubular portion.
24. This is clear from the use of the word "substantially" in the definitive statement in regard to the general shape and form of the container that the design was not intended to specifically encompass this.

25. The isolation of a particular feature being the transparency or translucence of the tubular portion as being "*definitive*" of the design, in the definitive statement, demonstrates clearly that this was the specific functional feature that was being registered – the substance.
26. The present design is in the circumstances distinguishable from the "*omnibus type*" design referred to in the Clipsal case. and it is for this reason that the general shape and form, together with the graphic representations can be considered separately from the substance.
27. Accordingly, I find that the functional feature of the transparency or translucency of the tubular portion, on its own, falls within the registered design and that the applicants are entitled to the relief sought. The costs will follow the result.
28. In the circumstances I make the following order:
- 28.1 The Respondent is interdicted from infringing the Applicant's South African design registration number F2011/001701 by making and or importing and/or using and or disposing of the Blu52 Big Easy Multifunctional floater or any variant or adaptation thereof that embodies the registered design or is not substantially different from the registered design.
- 28.2 The Respondent is ordered, within 30 days, at its cost to deliver up to the Applicants for destruction, all articles in the possession of or under the control of the Respondent that embody the design and/or that are not substantially different from the design including all stock of the Blu52 Big Easy Multifunctional floater.

28.3 The Respondent is ordered pay the costs of the Application.



A MILLAR

ACTING JUDGE OF THE HIGH COURT
GAUTENG DIVISION, PRETORIA

HEARD ON: 2 OCTOBER 2019

INTERIM ORDER: 4 OCTOBER 2019

JUDGMENT DELIVERED ON: 25 OCTOBER 2019

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ADV. PP FERREIRA

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INSTRUCTED BY: KISCH AFRICA INC.

REFERENCE: MR. J THEUNISSEN