

COPYRIGHT/DESIGN OVERLAP

OGDEN INDUSTRIES PTY. LTD. AND OTHERS v.
KIS (AUSTRALIA) PTY. LTD.¹

1. Introduction

Copyright, under the Copyright Act 1968-1982 (Cth.), in an original artistic work is essentially a negative right, namely to prevent others from copying the work without permission. Copyright arises automatically as soon as the work is made; no formal step by way of registration or otherwise is necessary. This right lasts the lifetime of the author plus fifty years. By contrast, if a new or original design is registered under the Designs Act 1906-1968 (Cth.) an exclusive right is obtained to apply the design to certain articles; the maximum period of protection is fifteen years. Consequently the more attractive statutory protection is under the Copyright Act: it lasts longer and does not require registration. The nature of protection under the two statutes is quite different, but confusingly they both use the expression "copyright" to describe the rights of the owner of the work. Recent amendments to the Designs Act have attempted clarification by referring to the rights under that Act as the "monopoly" under the registered design.² The word monopoly will be used in this note.

The definitions of "artistic work"³ in the Copyright Act and that of "design"⁴ in the Designs Act are so framed that a drawing may fall within the ambit of both definitions and thus in theory could claim protection under both Acts. There are arguments both for and against dual protection. The principal argument in favour, is that the creator of an artistic work should be allowed to make the maximum use he can of the work without undergoing a loss of copyright protection if his work is taken into the industrial area.⁵ The first argument against dual protection is that the Designs Act affords a monopoly protection which not only enables the designer to prevent others copying his creation, but also enables him to prevent a person who independently produces the same invention from making use of it during the monopoly period; thus it is considered unfair to allow a "designer" with monopoly rights for 15 years to have copyright protection at the same time, and on the expiration of the design protection period, a further period of copyright protection which could in an extreme case last

¹ (1982) 2 N.S.W.L.R. 283 (hereinafter referred to as *Ogden*).

² 30(1) Designs Act (as amended).

³ "Artistic work" is defined in s. 10(1)(a) of the Copyright Act to include a *drawing* whether the drawing is of artistic quality or not.

⁴ "Design" is defined in s. 4 of the Designs Act, the definition is set out at n. 34 (*infra*). Some comments on the difference between an "artistic work" and a "design" were made by Sankey, J. in *Con Plank Ltd. v. Kolynos Incorporated* (1925) 2 K.B. 804 at 814-815.

⁵ Design Law Review Committee's Report on the Law Relating to Designs, February 1973 ("the Designs Committee's Report"), paras. 251-252 (*infra* n. 55).

for one hundred years. The second argument, based on economic considerations, is that the long term of protection under the Copyright Act is undesirable in so far as it would impose undue limits on commodity production. The arguments against have been seen as more cogent by the legislature, and as a result, the complicated statutory provisions in ss. 74-77 of the Copyright Act were enacted. The operation of s. 77 was considered by Kearney, J. in *Ogden Industries Pty. Ltd. and Others v. Kis (Australia) Pty. Ltd.*

It is important to note that the facts in *Ogden* arose prior to the commencement of the Designs Amendment Act (1981). Two of the more important amendments will be discussed below.

2. The Facts and Decision

The plaintiff, Ogden Industries Pty. Ltd., manufactured locks, keys, and "key blanks" and installed security key systems. A key blank is the body of a key before it has the teeth cut into the top of the blade. The term "key profile" describes the cross sectional shape of the blade of the key. The plaintiff's key blanks were manufactured in accordance with its drawings of two key profiles. The defendant, Kis (Australia) Pty. Ltd., imported key cutting machines and associated accessories, including key blanks, from its parent company in France. The plaintiff claimed that the defendant had infringed its copyright in the key profile drawings by importing and selling⁶ key blanks, which the defendant conceded were reproductions in a three dimensional form of these drawings.

The major issue in the case was whether the plaintiff's drawings were unregistered designs within the meaning of the Designs Act so that the plaintiff was precluded from relying on its copyright by s. 77 of the Copyright Act. Kearney, J.'s rejection of the plaintiff's argument on s. 77 meant that its action failed. The case raised a number of minor issues which are of interest from the point of view of the Copyright/Design overlap:

(i) *Whether copyright subsisted in the plaintiff's drawings.*

The defence to the first minor issue rested on the proposition that the drawings lacked originality.⁷ According to the defendant, the mere selection of a new shape of key did not involve sufficient originality because of the variety of keys already on the market. Kearney, J. examined the meaning of "original" in copyright law.⁸ Relying on a passage by Peterson, J. in *University of London Press Ltd. v. University Tutorial Press*⁹ to the effect that if the work is a result of skill, labour and experience expended by the author, the requisite originality for copyright purposes is established, and after a lengthy consideration of the plaintiff's research, development and design of the key profiles, Kearney, J. found "a formidable case of originality".¹⁰

⁶ Copyright in a drawing (*infra* n. 3) is infringed by the importation for sale of an article (s. 37 Copyright Act), or the sale of an article (*Id.* s. 38).

⁷ *Supra* n. 1 at 288.

⁸ *Id.* 289.

⁹ (1916) 2 Ch. 601 at 608 and 609.

¹⁰ *Supra* n. 1 at 289.

The defendant's submission confused the concept of *novelty* in the sense of patent law, which requires that an invention is new in that it form no part of the state of the art, and *originality* in the copyright sense, which by contrast requires a certain minimum standard of "skill, labour and experience" in the creation of the work.

(ii) *Whether the defendant had infringed the plaintiff's copyright.*

S. 71(a) of the Copyright Act provides that the making of an object in three dimensions does not infringe the copyright in an artistic work that is in two dimensions, "... if the object would not appear to persons who are *not experts* in relation to objects of that kind to be a *reproduction* of an artistic work".¹¹

Relying on this defence, the defendant submitted: (1) there were obvious differences between the head of the key as depicted in the drawings and their allegedly infringing reproduction; (2) any similarity which was apparent was a feature of any key of that type; and (3) there were several points of dissimilarity between their key and the key profiles depicted in the drawings.

The authorities establish that the defence provided by s. 71(a) involves two steps: in the first place the court must find that the object is in fact a *copy* of the drawing; and secondly a non expert (a man of "reasonable and average intelligence")¹² must make a visual comparison of the object and of the drawing and decide whether the object is a *reproduction* of the drawing.¹³ The concept of "non expert" has been the subject of much criticism by the courts. In *Dorling v. Honnor Marine*,¹⁴ Danckwerts, J. found that the corresponding U.K. provision¹⁵ presented the court "with a difficult if not impossible task":

The courts are well used to matters depending on evidence of experts, whose opinion can thus be readily obtained, even if they are not in agreement. But how is the impact of an object on a non expert ("perhaps the man on the Clapham bus") to be ascertained?¹⁶

If a layman was to give evidence as to whether the X key was a reproduction of the Y key it would be difficult for the court to determine whether the process by which the layman had reached his determination was the correct process. Therefore the practice has developed that the judge assumes the role of non expert. In *Ogden, Kearney, J.* assumed the role of qualified non expert in reliance on the *Dorling Case*.¹⁷ Kearney, J.'s formulation of the s. 71 test correctly draws the distinction between the role of the *court* (which determines whether there has been *copying*) and that of the *non expert* (who decides whether the object is a *reproduction* of the

¹¹ Emphasis added.

¹² *Merchant Adventurers Ltd. v. M. Grew & Co. Ltd. (Trading as Eness Lighting)* (1972) Ch. 242 at 255; *Supra* n. 1 at 289.

¹³ *LB (Plastics) Ltd. v. Swish Products Ltd.* (1979) R.P.C. 611 at 622 *per* Ld Wilberforce.

¹⁴ (1965) 1 Ch. 1.

¹⁵ S. 9(8) of the Copyright Act 1956 (U.K.).

¹⁶ *Supra* n. 14 at 21.

¹⁷ *Supra* n. 1 at 290.

drawing).¹⁸ The court found that the defendant had copied the plaintiff's drawings, and the non expert (that is Kearney, J.), found that the defendant's key blanks were reproductions of the drawings.¹⁹ The subsection does not distinguish between the degree of non expertise of the total non expert on the one hand and the non expert with some expertise on the other.²⁰ It is submitted that the total non expert who lacks the ability to read and interpret highly technical drawings would be less likely to consider that the object was a reproduction of the drawings. In this respect the application of s. 71 leads to arbitrary results.

(iii) *The applicability of s. 77.*

As an alternative to its major argument on s. 77 (*infra*) the defendant submitted that the section was not intended simply to prevent dual protection, it was intended to prevent a design which is applied industrially from getting copyright protection whether or not it was capable of getting Designs Act protection.²¹ The logical conclusion to this submission is that in enacting s. 77, the legislature contemplated that some people would be left without any protection at all. The plaintiff relied on *Dorling v. Honnor Marine*²² which rejected that argument. Kearney, J. said that if he had been called upon to decide the question he would have followed the *Dorling Case*.²³

(iv) *The Catnic Defence*

In 1962 the plaintiff had obtained patents for its two key profiles, the patent expiring in 1978.²⁴ The defendant relied on the so called *Catnic* defence²⁵ to submit that a patentee could not rely on concurrent copyright protection. Kearney, J. rejected the defence. It has been the subject of much criticism by the courts and is contrary to other authority.²⁶

3. Section 77 of The Copyright Act

Section 77 provides that:

(1) Where —

- (a) *copyright* subsists in an *artistic work*;
- (b) a *corresponding design* is *applied industrially* by, or with the licence of, the owner of the copyright in the work;
- (c) articles to which the corresponding design has been so applied (in this section referred to as "articles made to the corresponding design") are *sold, let for hire or offered or exposed for sale or hire in Australia*; and

¹⁸ *Id.* 290.

¹⁹ *Ibid.*

²⁰ The cases establish that the judge does not have to be a total non expert. *LB (Plastics) Case* (1979) R.P.C. 565 at 573, *per* Whitford, J. at first instance.

²¹ *Supra* n. 1 at 297.

²² *Supra* n. 14.

²³ *Supra* n. 1 at 298.

²⁴ *Id.* 286.

²⁵ The defence stems from a statement made by Whitford, J. at first instance in *Catnic Components Ltd. v. Hill & Smith Ltd.* (1978) F.S.R. 405 at 427.

²⁶ *Supra* n. 1 at 299-300.

- (d) at the time when those articles are so sold, let for hire or offered or exposed for sale or hire, they are not *articles* in respect of which the *corresponding design has been registered* under the Designs Act 1906-1968,

the succeeding sub-sections of this section have effect.

(2) During the period of 15 years commencing on the date on which articles made to the corresponding design were first sold, let for hire or offered or exposed for sale or hire in the circumstances referred to in paragraph (1)(d), *it is not an infringement of the copyright in the work to do anything that, at the time when it is done, would have been within the scope of the monopoly in the corresponding design* if the corresponding design had, immediately before that time, been *registered* in respect of all articles made to the corresponding design that had, before that time, been sold, let for hire or offered or exposed for sale or hire in those circumstances.

(3) After the expiration of the period referred to in the last preceding sub-section, it is *not an infringement of the copyright* in the work to do anything that, at the time when it is done, would, if the *corresponding design* had been *registered* immediately before that time, have been within the scope of the *monopoly* in that *design* as extended to all associated designs and articles.²⁷

The complexity of the provision suggests it may be useful to give simple example of how it operates. Suppose a person draws a design sketch of a chair of new or original shape, that person will enjoy *copyright* in the *sketch* as it falls within the definition of *artistic work* in the Copyright Act. Among other things, the owner has the exclusive right "to reproduce the work in a material form".²⁸ It will be an infringement of the owner's copyright to copy the sketch, to make a chair which reproduces the sketch in three dimensional form,²⁹ or to make a chair by copying one which itself reproduces the sketch. If the sketch falls within the statutory definition of design in the Designs Act and the design is not registered, s. 77 will apply with the effect that it will *not* be an infringement of the *copyright* in the *sketch* to do anything which would have been within the scope of the monopoly in the *design* had it been *registered*. Assume chairs are made by applying the design industrially,³⁰ and the chairs are then sold. If a third party reproduces the design sketch in three dimensional form without the owner's authorisation, the owner cannot rely on his Copyright Act protection and because he has *not registered* his *design*, he will not be able to bring an action against the third party under the Designs Act.

²⁷ (Emphasis added) A "corresponding design", in relation to an artistic work means a design, that, when applied to an article, results in a reproduction of that work (s. 74(1) Copyright Act). The design is deemed to be applied industrially if it is applied to more than fifty articles. Consequential amendments to the Copyright Act have been made by s. 33 of the Designs Amendments Act 1981. As the design registration is now 16 and not 15 years (under a renewable system) the appropriate amendment is made to s. 77(2).

²⁸ S. 31(1)(b)(i) of the Copyright Act.

²⁹ *Id.* s. 71(a).

³⁰ *Id.* s. 77(1).

There are at least three situations in which this overlap will not arise: (1) where the design does not fall within the statutory definition; (2) where the design is one expressly excluded by the Designs Regulations;³¹ and (3) where the design in question is not a drawing but a prototype of, for example, furniture for which no design sketch exists, such prototype not being a work of "artistic craftsmanship" and thus not the subject of copyright protection.³²

The defendant in *Ogden* submitted that the plaintiff's drawings were "designs", within the definition of s. 4 of the Designs Act, and thus s. 77 applied.³³ Design was defined as follows:

. . . an industrial design applicable in any way or by any means, to the purpose of ornamentation, or pattern, or shape, or configuration of an article or to any two or more of those purposes.

This definition was derived from the U.K. provision which was amended in 1919 and again in 1949. The Australian definition was not however amended until 1981. The definition in the Registered Designs Act 1949 (U.K.) provides 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.³⁴

The plaintiff argued that the unamended Australian definition should be read so as to include the element of appeal to the eye and to exclude functional designs.³⁵ It was submitted firstly that because the shape of the design did not appeal to the eye it was not within the definition and in the second place, that because the shape was dictated solely by *function* it followed *ex hypothesi* that the shape was not applied for any purpose of appealing to the eye.³⁶ Kearney, J.'s rejection of both submissions followed analysis of the separate development of the English and Australian authorities on the concept of appeal to the eye and the place of functional designs in the statutory system.³⁷

(i) *Appeal to the Eye.*

Even prior to 1919, English cases implied into the definition appeal to

³¹ Designs Regulations Rule 72 of 1982.

³² A work of "artistic craftsmanship" unlike an "artistic work" must have some artistic merit (s. 10(1) Copyright Act). In *George Henscher Ltd. v. Restawile Upholstery Limited* (1975) R.P.C. 31, a prototype of furniture was held not to be a work of artistic craftsmanship because it lacked the requisite artistic quality which mean that the plaintiffs lost an action for infringement of copyright in their furniture. They may have been successful if they had drawings of the furniture, the copyright in which would have been protected as an artistic work.

³³ *Supra* n. 1 at 292.

³⁴ Emphasis added.

³⁵ *Id.* 292-293.

³⁶ *Id.* 292.

³⁷ *Id.* 292-297.

the eye, and so did Australian cases.³⁸ The present English position as expounded in *Amp Inc. v. Utilux Pty. Ltd.*³⁹ is a subjective test of appealing to the eye of the customer. Kearney, J. summarised this as follows: "The later English authorities . . . carry the concept of 'appeal to the eye' further . . . the customer must choose the article because of its appearance, not because the shape will be more useful for the job that the article is to do".⁴⁰ The present Australian position as expounded in *Malleys Ltd. v. J.W. Tomlin Pty. Ltd.*,⁴¹ indicates that the test is an objective one. In deciding whether a design appeals to the eye an Australian court asks; is there sufficient individuality of appearance to distinguish the design from a mere shape? His Honour concluded that the subjective approach of the English courts was "an impermissible development" under the Australian definition having regard to the test propounded by the High Court in *Malleys v. J.W. Tomlin*.

(ii) *Dictated Solely by Function*

The plaintiff submitted that the Australian definition should be read as incorporating the exclusion of designs dictated solely by function, which appears in the English definition.

In *British Franco Electric Pty. Ltd. v. Dowling Plastics Pty. Ltd.*,⁴² Wootten, J. had rejected the same argument stating:

. . . I do not think that it is possible to read the words now expressed in the English Act as no more than an explication of the words which were in the English Act prior to 1919, and hence implicit in the very similar Australian definition.⁴³

Wootten, J. reached this conclusion after an examination of the treatment of functional designs in English authorities decided prior to the 1919 amendment, which had regarded the functional characteristic as irrelevant to the statutory definition: moreover in a number of Australian authorities the courts had emphasised that functional attributes could not be used in aid of the characterisation of a design.⁴⁴

Because the plaintiff placed so much emphasis on *British Franco* the case requires fuller discussion. The plaintiff had sought an injunction to restrain the defendant from infringing the plaintiff's monopoly in a registered design for a furniture castor. The defendant's cross-claim for an order for cancellation of the registration was based on two grounds: firstly that the registered design was neither new nor original; and in the second place that the design was incapable of registration because all its features were dictated solely by function.⁴⁵ The defendant's argument raised similar

³⁸ *Geodesic Constructions Pty. Ltd. v. Gaston* (1976) 16 S.A.S.R. 453 at 465, 466; *British Franco Electric Pty. Ltd. v. Dowling Plastics Pty. Ltd.* (1981) 1 N.S.W.L.R. 448 at 458.

³⁹ [1972] R.P.C. 103.

⁴⁰ *Supra* n. 1 at 293.

⁴¹ (1961) 35 A.L.J.R. 352.

⁴² (1981) 1 N.S.W.L.R. 448.

⁴³ *Id.* 453.

⁴⁴ *Id.* 454-458.

⁴⁵ *Supra.* n. 42 at 453.

questions to those in *Ogden*: namely, whether a design had to appeal to the eye, and whether solely functional designs were registrable. Wootten, J. in *British Franco* considered that the requirement of appeal to the eye was implicit in the Australian definition.⁴⁶ On the facts, however, the novel feature of the design was concealed and for this reason His Honour held that it could not possibly appeal to the eye and that it should be expunged from the register. Wootten, J. said *obiter*:

To me it seems quite possible that a design may fall within that definition and at the same time be "dictated solely by the function which the article to be made in that shape or configuration has to perform".⁴⁷

It is submitted that his Honour's rejection of the defendant's argument in the latter statement combined with his opinion that appeal to the eye is implicit in the Australian definition, amounted to a finding that a functional design was registrable provided it also made some appeal to the eye. The plaintiff in *Ogden* made three submissions regarding the application of *British Franco*:

1. That Wootten, J.'s decision that a design may be registrable even though dictated by function did not amount to a decision that to be registrable a design must not be dictated by function. It is unclear what the plaintiff hoped to achieve by juxtaposing the latter statement with Wootten, J.'s findings in *British Franco*, as apart from being confusing, it does not add anything to the submission.
2. That a design was registrable although dictated by function, provided that in addition the design made some appeal to the eye. This submission is uncontroversial and is clearly consistent with Wootten, J.'s findings in *British Franco*.
3. The plaintiff then repeated the second submission and went on to distinguish the facts in *Ogden* by arguing that because its designs were dictated solely by function and did not appeal to the eye they were not registrable. This submission requires unravellings as it is in some respects ambiguous.

It could be interpreted in at least two ways: the first and most straightforward interpretation is that a functional design which did not appeal to the eye was not registrable. However, if the words "did not" mean "therefore", a second interpretation of the plaintiff's submission is possible, *i.e.* that the design was dictated solely by function and therefore did not appeal to the eye. This interpretation of the submission is supported by the different wording of the second and third submissions. In the latter, the plaintiff is talking about designs which are solely functional but in the former the word "solely" is not used. The submission is reminiscent of the House of Lords' interpretation of the phrase "dictated solely by function"

⁴⁶ *Id.* 458.

⁴⁷ *Ibid.*

in *Amp v. Utilux*. The speeches in the case are not entirely straightforward, but it is submitted that the following sets forth the *ratio* of the decision: where a shape is adopted by a designer due to functional requirements, to make the article work and not to appeal to the eye, then the English definition excludes it from registration. Lord Morris commented on the design in *Amp v. Utilux*:

In the present case the terminal was simply devised so that it would "do the job". It was to perform the function that was defined by Hoover's requirement. The terminal is . . . to be looked at as a unit. . . . There was nothing extra. There was nothing that would be regarded as any kind of embellishment. First and last the key note was function. The terminals . . . would be judged by performance and not by appearance.⁴⁸

It is submitted that the second interpretation is illogical, as it does not necessarily follow that a design which is solely functional cannot also appeal to the eye. Kearney, J. did not comment on the first two submissions; of the third he said:

It seems to me that this submission breaks down at the outset on the facts in the *British Franco Electric* case. Wootten, J. (at p. 455) had found that the distinctive feature of the design in question:

. . . is clearly dictated by function only; the appearance of this part of the wheel is of no significance as in the assembled castor it is covered by a hubcap

Accordingly, I do not accept that Wootten, J.'s finding can be rationalized by reference to the suggested proviso. The case before him was one where appearance, and hence appeal to the eye, were necessarily excluded from consideration. Indeed, the *British Franco Electric* decision is an *a fortiori* one on the facts compared with the facts in the present case, where the features of the design are visible and individual.⁴⁹

In this passage Kearney, J. appears to be saying that Wootten, J. decided that a functional design which does not appeal to the eye is registrable. But in fact he did not regard *British Franco* as authority for that proposition. This is clear from another passage that Kearney, J. cited from *British Franco*:

. . . that the design is incapable of registration because all the features of it are dictated solely by the function or functions which the article, the subject of the registered design, has to perform.⁵⁰

The confusion in the passage quoted above stems from Kearney, J.'s concern to distinguish the plaintiff's submission from the facts in *British Franco*. It is submitted that the first interpretation of the submission, *i.e.*

⁴⁸ *Supra* n. 39 at 113.

⁴⁹ *Supra* n. 1 at 295.

⁵⁰ *Ibid.*

that a functional design which does not appeal to the eye is not registrable, is in law consistent with *British Franco*. In any event the submission would not have enabled the plaintiff to succeed due to Kearney, J.'s finding that the designs appealed to the eye.

The plaintiff in *Ogden* submitted in the alternative, that Wootten, J. had made an error of law because he had confused the question of registrability with that of newness or originality of the design, and had considered only one feature of the design rather than all its features.⁵¹ Kearney, J. held that there had been no such confusion and that Wootten, J. had correctly considered all the features of the design. Thus both limbs of the plaintiff's submission failed.⁵²

4. Recent Developments

Two of the amendments to the Designs Act are of particular interest to the foregoing discussion:

(i) Section 4 contains a new definition of design which provides as follows:

... "Design" means features of shape . . . being features that, in the finished article, can be *judged by the eye*⁵³

Whilst the design must be capable of being judged by the eye, which in part brings the definition in line with the U.K. provision, there is no corresponding requirement that it appeal to the eye.⁵⁴ The Design Law Review Committee recommended that the words "judged solely by the eye" should be included in the new definition because they convey the essential quality of a design as something concerned with appearance.⁵⁵ The Committee further recommended that the design should be judged by "the eye of the court".⁵⁶ The new definition does not include that phrase. Would an Australian Court in the absence of express statutory guidance adopt the English approach and use the eye of the customer? This seems unlikely as the underlying policy of the U.K. Act which is to preserve to the owner of the design the commercial value resulting from customers preferring the appearance of articles which have the design to that of those which do not have it⁵⁷ is quite different to the policy of the Australian Act. Furthermore, there are a number of problems inherent in the approach of the English Courts: firstly it would be difficult for the court to determine whether a design appeals to a customer and in the second place to determine who are

⁵¹ *Id.* 294.

⁵² *Id.* 296-297.

⁵³ Emphasis added.

⁵⁴ The Designs Committee (*infra* n. 59) considered that the phrase "appeal to the eye" was unnecessary to the definition as the Australian courts have always treated the definition as though it included the phrase: *Malleys v. Tomlin* (*Supra* n. 41).

⁵⁵ The Designs Law Review Committee ("The Designs Committee") was appointed in 1970 under the Chairmanship of Mr. Justice Franki to examine the Australian law in relation to designs and to recommend any alterations to the law that were thought desirable. Their recommendations are found in, Report on the Law Relating to Designs, February 1973.

⁵⁶ *Id.* para 39.

⁵⁷ *Supra* n. 39 at 108 *per* Ld. Reid.

the appropriate customers to consider, *Kevi A/S v. Suspa-Verin U.K. Ltd.*⁵⁸ The new definition does not clarify the question as to whether the design must be capable of being judged by the naked eye or whether the use of a magnifying glass is permissible. In *Stenor Ltd. v. Whitesides (Clitheroe) Ltd.*⁵⁹ Romer, J. held that a fuse which was so small that it could only be seen with the aid of a magnifying glass was not registrable as a design. The case went on appeal to the House of Lords. Regrettably, however, the size of the article was not argued and the question as to the effect of the minuteness of the object on registrability remains open.⁶⁰

(ii) Section 18 provides that a design which possesses functional features will not be disqualified from registration for that reason. As a result of this amendment, the designs legislation affords protection on a very broad basis, and reflects a commercial orientation which stands in contrast to the aesthetic approach to the issue of designs protection in England as evidenced by *AMP v. Utilux*.

If the facts in *Ogden* had arisen after the amendments had come into effect, the plaintiff may not have commenced this action for the reason that its argument on the distinction between functional designs which appeal to the eye on the one hand, and designs dictated *solely* by function on the other, would have had even less chance of success.

(iii) An unreported judgment of Brinsden, J. of the Supreme Court of Western Australia, *S.W. Hart & Co. Pty. Ltd. v. Edwards Hot Water Systems*⁶¹ provides an interesting contrast to Kearney, J.'s findings on the definition of design in s. 4 of the Designs Act. The plaintiff alleged that the defendant had infringed its copyright in drawings by their reproduction in a material form and offer for sale. The defendant relied on the s. 77 defence. In deciding whether the drawings were properly described as designs, Brinsden, J. rejected Wootten, J.'s finding in the *British Franco Case*; that the exclusion of functional designs could not be implied under s. 4 of the Designs Act, and relied on the decision of the House of Lords in *Amp v. Utilux*. The defence under s. 77 failed.⁶² An appeal from the decision was heard by a Full Bench of the Federal Court.⁶³ It was not necessary for the Federal Court to decide whether the drawings were designs, as all three judges held that the respondent's copyright had not been infringed. Franki, J. however, referred to *British Franco* and *Ogden v. Kis*⁶⁴ and the uncertainty as to whether functional designs were registrable prior to the 1981 amendment.

SHEILA MCGREGOR, B.A.(Hons.) – Third Year Student

⁵⁸ Unreported judgment of Falconer, J. (8 April, 1983). A summary of the case can be found in News Section: *European Digest* (1981) 7 E.I.P.R. D-141.

⁵⁹ 63 R.P.C. 81 at 87.

⁶⁰ (1948) A.C. 107 Morton, L.J. in the Court of Appeal (63 R.P.C. 89 at 96) differed from Romer, J. on this point. His Lordship commented that, "I am by no means sure that 'the eye' . . . means the eye unassisted by a magnifying glass". Cf. comments made by Buckley, L.J. in *Dover v. Nurnberger Celluloid-waren Fabrick Gebruder Wolff* (1910) 2 Ch. 25 at 31, who supports the opposite conclusion.

⁶¹ Unreported judgment (27 September, 1982).

⁶² *Id.* The reasons are set out on pp. 36-37.

⁶³ Delivered on 12 October 1983.

⁶⁴ At p. 33 of the unreported judgment.