

So the question is whether the application by way of counterclaim is an application in the prescribed manner. The appropriate rule seems to be Order 94, Rule 50, which is:

"Save as otherwise provided by the Acts or this order, every application to the Court under the Industrial and Commercial Property (Protection) Acts 1927-58, the Trade Marks Act 1963, the Copyright Act 1963 or the Patents Act 1964 shall be made by special summons. The summons shall be served upon the Controller and upon all other persons (if any) interested."

In the circumstances I do not think I am entitled to go as far as directing that the registration be expunged. However, it seems to me that it would be sufficient for the purposes of the Defendants to make a declaration that the design was invalidly registered and also that the Defendants are entitled to have the design expunged from the Register. It seems to me that the effect of my order will be that this registration wrongly remains on the Register and, accordingly, an application under section 129(6) of the Act can be made to the Controller to expunge the registration.

In the circumstances I dismiss the Plaintiff's claim and make the two declarations just referred to on the counterclaim of the Defendants.

Approved

17. 5. 1990

J. H. Stanger

design of the Plaintiff was disclosed by some person in breach of good faith. The final set of circumstances is totally inapplicable. It is the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, and there is no question here of a textile design being involved.

So I am satisfied in the circumstances that by reason of the Plaintiff's registration of the design being invalid, there cannot have been any infringement of that design.

The only question that concerns me is as to what order I should make in the circumstances on the counterclaim. The counterclaim seeks an order not merely declaring the registration invalid but also an order expunging the registration from the register. There is also a counterclaim for a declaration that the design is not novel and was invalidly registered and for an order pursuant to the provisions of the Industrial and Commercial Property (Protection) Act 1927 directing that Design Registration No.D7621 be expunged from the Register of Designs, and for the costs of the counterclaim.

While the Defendants are entitled to a declaration that the design was invalidly registered and to a declaration that they are entitled to have the registration expunged, I have some doubt as to whether I am entitled to make an order expunging the registration having regard to the provisions of section 129(1), which says:

"Subject to the provisions of this Act the court may, on the application in the prescribed manner of any person aggrieved..."

that the latter could not at the time of the registration be said to be new or original.

The Plaintiff said in his evidence that he believed the Defendants had copied his design. In my opinion there is no evidence to support this belief. There is clearly a great similarity between the Plaintiff's 'Croydon', 'Avondale' and 'Ormond' doors on the one hand and the Plaintiff's 'Pembroke Round' door on the other hand but it is impossible to say which influenced which, and the registered design incorporates only a slight alteration on these designs.

The Plaintiff submitted that in so far as the 'Pembroke Round' constituted a publication of the Plaintiff's design before its registration, it should be ignored because of the provisions of section 72 of the Industrial and Commercial Property (Protection) Act 1927, but in my opinion this is not so. The section applies in three different sets of circumstances and none of these circumstances, in my opinion, is to be found in the present case. Firstly, the section applies in regard to the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design. Here there is no evidence that the alleged prior publication was constituted by the disclosure of the design by the Plaintiff to some other person. That was the first set of circumstances envisaged by the section. The second is the disclosure of a design in breach of good faith by any person other than the proprietor of the design. Again, there is no evidence here that the

is claimed as the feature of novelty and that is what is necessarily claimed as being entitled to protection. Once it is clear that that is the position, in my mind it is equally clear that the registration is invalid. The design of the whole door was not either new or original. It was very little different from the 'Croydon', 'Avondale' or 'Ormond' doors in the Plaintiff's 1985 brochure and was very little different from the 'Pembroke Round' door of the Defendants, all of which constituted the relevant prior art.

I accept the principle that was cited on both sides, which essentially is that in judging this difference between prior art and registered design, an impression of the eye is involved; and looking at the prior designs of the 'Croydon', 'Avondale' and 'Ormond' on the one hand and the 'Pembroke Round' on the other hand, it seems to me that there is very little difference between them and the design registered. The only difference is that the segment below the semi-circle on each side is slightly different in shape from that which was formerly there. It is smaller and slightly shorter than the segments which were in the other designs.

In regard to the 'Pembroke Round' door, I find as a fact that it was imported into this country by the Defendants as early as May 1987 and that one of these doors was sold to a Mrs Timmons of Finglas on 12 June 1987 and that five more of the same type of door were sold between August and December 1987. I find that the resemblance between the design of this door and the registered design is such

I reserved my judgment in this case yesterday not because I had not made up my mind in the case but because the hour was late and I wanted time to gether my thoughts on the various issues that had arisen. I had already come to the conclusion that the Plaintiff was not entitled to succeed in the case and on reflection I am confirmed in that view.

The action was for infringement of the copyright in a registered design. The defence was that the registration of the design was invalid because the design was not new or original as it had been published prior to its registration by the Plaintiff.

The first thing that has to be considered is what is the design which is the subject of the registration because what is protected is the feature or novelty embodied in the shape and configuration as shown in the drawings.

The Plaintiff claimed that the feature or novelty is the two segments below the four panels which form a semi-circle at the top of the door. He says that the design registered is that of these two segments or panels and that it is this design that has been infringed. It may have been the Plaintiff's intention that that was all that should be registered but this is not, in fact, what happened. What was registered was the design of the entire door, and I accept Mr Kinsella's evidence in regard to this. So it is the design of the whole door, the shape and configuration as shown in the drawings, that

APPEARANCES

For the Plaintiff: Eoin McCullough, SL

Instructed by Tom Collins & Co.

For the Defendants: Fidelma Macken, BL

Instructed by Cunningham & Co.

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THE HIGH COURT

1990 No.1812P

BETWEEN

FRANCIS R COSTELLOE

Plaintiff

AND

MARGARET JOHNSTON
STEPHEN JOHNSTON
AND WE FIT DOORS LIMITED
t/a DOORWAYS

Defendants

TRANSCRIPT OF JUDGMENT

DELIVERED BY THE HONOURABLE MR JUSTICE JOHN BLAYNEY
ON 16TH MAY 1990

An Kern
Official Stenographer

17th May 1990