

BETWEEN :

CIMON LIMITED AND LUIGI TIENGO } PLAINTIFFS;

AND

BENCH MADE FURNITURE COR- } DEFENDANTS.  
PORATION AND SAMUEL EDWARDS }

1964  
Oct. 26-30  
Nov. 2, 3,  
9-13  
Dec. 14

*Industrial designs—Registration—Infringement—Copyright—Liability of servant or agent for tort—Design registrable under Industrial Design and Union Label Act—Ornamenting of an article—Design not*

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.

*limited to something applied to an article after it comes into existence—Design applied to ornamenting of an article—Design to be applied for the ornamenting of an article by making it in a particular shape or configuration—Registration of design to be applied by making an article in a particular shape or configuration not registration of article itself—Originality of design—Photograph of article as drawing required by s. 4 of Industrial Design and Union Label Act—Novelty of design—Reference from revised statute to form of legislation as enacted by Parliament—Sufficiency of proprietor's name on label as required by s. 14 of Industrial Design and Union Label Act—Fraudulent imitation of registered design—Injunction against infringement of registered design—Industrial Design and Union Label Act, R.S.C. 1952, c. 150, ss. 3-12, 14 and 15—Copyright Act, R.S.C. 1952, c. 55, s. 46—Exchequer Court Act, R.S.C. 1952, c. 98, s. 21.*

This is an action for infringement of a registered industrial design of which the plaintiff company is the owner and for infringement of copyright in a work the copyright of which was vested in either the plaintiff company or the individual plaintiff. The industrial design was for a chesterfield sofa and was registered by the plaintiff company on November 20, 1962 as No. 187, Folio 25140.

The plaintiff company has been in the business of manufacturing and selling upholstered furniture in Montreal since 1938. In 1960 it entered into an arrangement with the plaintiff, Tiengo, who had been employed until that time as a designer and illustrator for Cortini Furniture Manufacturing Limited, under the terms of which Tiengo designed upholstered furniture for the plaintiff company as an independent contractor, being paid a royalty on furniture designed by him and sold by the plaintiff company, which thereby was entitled to exclusive rights to and property in all such designs. In 1961 Tiengo designed a chesterfield sofa and a matching chair for the plaintiff company, prototypes of which were shown at the Toronto Furniture Show in January 1962, and of which the production and sale by the plaintiff company commenced in February 1962.

The defendant, Edwards, had been employed by Cortini Furniture Manufacturing Limited when Tiengo was also employed by it, but in 1960 he became associated with Furniture Craft Corporation, which company began manufacturing and selling a chesterfield sofa and chair very similar in design to the plaintiff company's sofa in March or April 1962, but ceased doing so in January 1963. Shortly thereafter the defendant, Edwards, left that company and became associated with the defendant company, which, early in 1963, began manufacturing and selling sofas and chairs of virtually the same design as those previously manufactured by Furniture Craft Corporation, and is continuing to do so.

*Held:* That it is no answer to a claim in tort that the tortfeasor was acting as a servant or agent for some other person.

2. That the sort of design that can be registered under the *Industrial Design and Union Label Act* is a design to be "applied" to the "ornamenting" of an article; it is something that determines the appearance of an article, or some part of an article, because ornamenting relates to appearance, and it must have as its objective making the appearance of an article more attractive because that is the purpose of ornamenting. It cannot be something that determines the nature of an article as such (as opposed to mere appearance) and it cannot be something that determines how an article is to be created, that is, it cannot

- create a monopoly in "a product" or "a process" such as can be acquired by a patent for an invention.
3. That there is nothing in the legislation that limits the type of design that may be registered to that providing for something that is applied to an article after the article comes into existence.
  4. That s. 11 of the *Industrial Design and Union Label Act* contemplates a "design" being "applied" to the "ornamenting" of any article and is not restricted to a "design" being "applied" to an "article".
  5. That when reference to the various classes of design as set out in s. 11 of the pre-Confederation Act of the Province of Canada, c. 21 of the Statutes of Canada, 1861, was omitted from the original industrial design legislation enacted by Parliament, c. 55 of the Statutes of Canada, 1868, which did not differ in its principal provisions from the present Act, that legislation applied to all the classes that were specified in the previous legislation as well as to any other class of "design" that is capable of being "applied" for the "purposes of ornamenting" any article, if any such other class there be.
  6. That the design registered by the plaintiff company is not a design for sofas or for some particular kind of sofa but it is truly a "design" for the ornamentation of sofas that can be applied by making the sofas in certain shapes. The narrow but fundamental distinction is the difference between the shape of a thing and a thing of that shape.
  7. That there can be registration under the Canadian Act of a design to be applied for the ornamenting of an article by making it in a particular shape or configuration.
  8. That there can be no registration under the Canadian Act of an article of manufacture as such, but the registration of a design to be applied by making an article in a particular shape or configuration is not registration of the article itself.
  9. That none of the authorities relied upon by the defendant establishes that a design applicable to the ornamenting of an article of manufacture by reference to shape or configuration is not good subject matter for design registration under the Canadian Act.
  10. That the plaintiff company's design is a design applicable to the ornamenting of an article and is not a claim to an article itself within the meaning of the authorities.
  11. That to be entitled to registration the "design" must be "original".
  12. That there is some doubt as to whether a photograph of a sofa to the ornamenting of which the design has been applied is a "drawing" of the design as required by the first few sections of the *Industrial Design and Union Label Act*.
  13. That the novelty of the sofa in the photograph filed with the plaintiff company's application for registration of the design in question is the peculiar shape or configuration of the back and the arms and the registered design, therefore, consists of a design applicable to the ornamenting of a four-legged sofa by creating its arms and back in the shape and configuration illustrated by the arms and back of the sofa in the photograph.
  14. That the distinctive feature of the design in question is an oval-shaped back having the appearance of being free of the balance of the sofa, made to harmonize with the almost uninterrupted flow of the lines of the seat and arms, the arms having been constructed as slight curves at angles of about 60° from the line of the seat.

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*

1964  
 CIMENT LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.

15. That there is such a radical difference between the design in question and the design of any other previously existing furniture to which attention has been directed that the submission that the design was not original must be rejected.
16. That in the case of ambiguity in the provisions of a statute arising from the work of a statute revision commission it is legitimate to refer back to the form of the legislation in which it was enacted by Parliament.
17. That it is a sufficient compliance with the provisions of s. 14 of the *Industrial Design and Union Label Act* for the plaintiff company to use a name on the label required to be attached to the article such that it communicates to those who might be interested, who, in fact, the proprietor is, and, in furniture circles in Canada, the word "Cimon" would indicate the plaintiff company.
18. That while there are certain differences between the plaintiff company's registered design and the designs of the defendants' allegedly infringing articles, there is no doubt that the design of the sofas produced by the defendants is the plaintiff company's registered design and, if it is not, it is certainly "a fraudulent imitation thereof".
19. That under s. 15 of the *Industrial Design and Union Label Act* the plaintiff company, as proprietor of the registered design that has been infringed, is entitled to the damages that it has sustained by reason of the infringement.
20. That although there is no provision in the *Industrial Design and Union Label Act* for an injunction; this is a proper case for an injunction and the Court has jurisdiction to grant it under s. 21 of the *Exchequer Court Act*.
21. That in view of the determination that the plaintiff company's design is capable of being registered under the *Industrial Design and Union Label Act* and the plaintiffs' concession that if such were the case, they would have no cause of action for infringement of copyright because of s. 46 of the *Copyright Act*, the plaintiffs' claim for infringement of copyright is dismissed.

*Practice—Rule 138 of General Rules and Orders—Use of examination for discovery of individual defendant as officer of co-defendant company against him personally—Use of examination for discovery of individual defendant as officer of co-defendant company under Rule 138.*

*Held:* That while the answers given by the defendant, Edwards, on his examination for discovery as an officer of the defendant company could have been used as evidence against him personally, to the extent that they consisted of admissions against his interest, to constitute such evidence they had to be put in at the trial as part of the case against him and this could have been done by way of admissions obtained pursuant to a notice to admit facts or by way of evidence from the reporter or other person who was present at the examination for discovery.

2. That the use of the examination for discovery of the defendant, Edwards, as an officer of the defendant company, under Rule 138 binds only the defendant company.

ACTION for infringement of an industrial design and a copyright.

The action was tried by the Honourable Mr. Justice Jackett, President of the Court, at Ottawa.

*J. D. Kokonis* for plaintiffs.

*J. C. Osborne, Q.C.* and *R. G. McClenahan* for defendants.

The facts and questions of law raised are stated in the reasons for judgment.

JACKETT P. now (December 14, 1964) delivered the following judgment:

In this action, relief is sought in respect of two different causes of action, namely,

- (a) infringement of a registered industrial design of which the plaintiff company is the owner, and
- (b) infringement of copyright in a work the copyright of which was vested either in the plaintiff company or the individual plaintiff.

A third claim by the plaintiff company in respect of a breach of section 7 of the *Trade Marks Act* was abandoned by counsel for the plaintiffs at the commencement of the argument. He also conceded, at that time, that, if the plaintiff company's design is a design that was capable of being registered under the *Industrial Design and Union Label Act*, R.S.C. 1952 c. 150, the plaintiffs have no cause of action for infringement of copyright inasmuch as section 46 of the *Copyright Act*, R.S.C. 1952, c. 55, provides that that Act does not apply to designs capable of being registered under the *Industrial Design and Union Label Act*.

Certain facts would appear to be outside the realm of controversy in so far as the plaintiffs and the defendant company are concerned. Such facts may be stated in chronological order as follows:

- (a) The plaintiff company has been in the business of manufacturing and selling upholstered furniture in Montreal since 1938.
- (b) Prior to the bankruptcy some time in 1960 of Cortini Furniture Manufacturing Limited, a company in the business of manufacturing furniture in Montreal, the individual plaintiff, Tiengo, worked for that company as a designer and illustrator, the individual defendant, Edwards, worked for that company in a senior management capacity, and one John Salus was its president.

1964  
 {  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 ———

1964  
CIMON LTD.  
*et al.*  
*v.*  
BENCH  
MADE  
FURNITURE  
CORP. *et al.*  
—  
Jackett P.  
—

- (c) Commencing some time in 1960, Tiengo and the plaintiff company had an arrangement, which was still in existence at the time of the trial, under which Tiengo, as an independent contractor and not as an employee, designed upholstered furniture for the plaintiff company and under which the plaintiff company was bound to pay to Tiengo a royalty on all sales of furniture made in accordance with his designs and was entitled to exclusive rights to, and property in, all designs of upholstered furniture created by him.
- (d) Shortly after the bankruptcy of the Cortini company, Edwards became associated with Furniture Craft Corporation, a company incorporated at that time to engage in the furniture manufacturing business in Montreal. Salus also found employment with that company.
- (e) In September 1961, Salus left Furniture Craft Corporation and joined with others in promoting a new furniture manufacturing company known as Cortini Furniture Manufacturing (1961) Limited and stayed with that company until it went bankrupt in 1963.
- (f) In or about October 1961, Tiengo produced to the plaintiff company under their agreement a sketch illustrating a design for a chesterfield sofa, which design the plaintiff company decided to use in its business. At the request of the plaintiff company, Tiengo produced working drawings for the application of such design to a sofa and a sketch of an imaginary sofa to which it had been applied; and the plaintiff company then, with Tiengo's aid and direction, produced, as a prototype, a sofa to which the design represented by the sketch and drawings had been applied. The plaintiff company also produced a prototype of a chesterfield chair to which a matching design, also produced by Tiengo, had been applied—there were certain differences between the design of the sofa and that of the chair, which differences Tiengo deemed necessary having regard

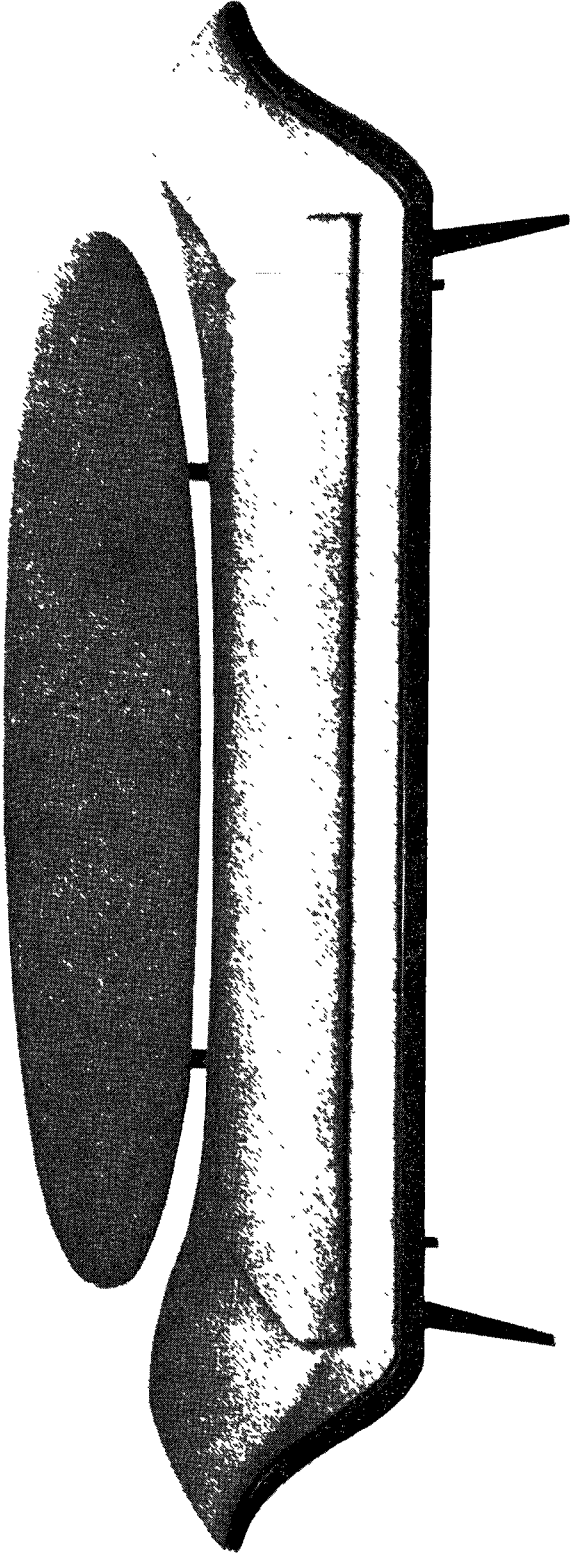
to the difference between the proportions of a sofa and the proportions of a chair.

- (g) When the plaintiff company had the prototypes—that is, the chesterfield sofa and the chesterfield chair—constructed to the satisfaction of the two plaintiffs, they were secreted away and brought out to be shown at the Toronto Furniture Show in January 1962. That show is the show of outstanding importance in the furniture business each year.
- (h) After the prototypes were shown at the January 1962 Toronto Furniture Show, that is, in February 1962, the plaintiff company commenced production and sale of chesterfield sofas and chairs patterned on the prototypes. It found that they sold very well.
- (i) Furniture Craft Corporation, in March or April 1962, inspired by the plaintiff company's new chesterfield line, commenced to manufacture and sell a chesterfield sofa to which had been applied a design that was very similar to the design applied to the plaintiffs' sofa. It also commenced at the same time to manufacture and sell a chesterfield chair to which had been applied a design that was like the design applied to the plaintiff company's sofa rather than the design applied to the plaintiff company's chair. The defendant Edwards was the officer of Furniture Craft Corporation who, more than anybody else, was responsible for the production and sale of this sofa and chair.
- (j) On November 20, 1962, the plaintiff company registered under the *Industrial Design and Union Label Act*, as No. 187, Folio 25140, an industrial design for a "Chesterfield Sofa"

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

characterized by an elongated seat member, rectangular in form, having upwardly divergent, tapering, gently rounded arm members, a back consisting of a shallow portion and an elongated oval portion spaced thereabove, the upper edge of said shallow portion extending in a gentle downward curve from the top of one arm to the top of the other arm, said upper edge being nearly even with the top of the seat member at the middle of said shallow portion, and four downwardly depending legs as per the annexed pattern and application,

The annexed "pattern" is a photograph of a sofa, which I reproduce here:





(Counsel for both parties agreed that the photograph was a sufficient compliance with the requirement in sections 4 *et seq.* of the *Industrial Design and Union Label Act*, when read with the regulations, that there be a "drawing" of the "design". That question is not therefore in issue in this case although it does appear to me to raise a problem of some difficulty.) A copy of the "drawing" and description with the certificate provided for by subsection (1) of section 7 of the Act was put in evidence by the plaintiffs at the trial of this action.

1964  
 CIMON LTD  
*et al.*  
*v*  
 BENCH  
 MADE  
 FURNITURE  
 CORP *et al.*  
 Jackett P.

(k) On or about December 3, 1962, the plaintiff company sent to every manufacturer of upholstered furniture in Canada, as listed in a publication known as "Furniture and Furnishings Directory", which included Furniture Craft Corporation, a circular dated December 3, 1962, reading as follows:

TO ALL FURNITURE MANUFACTURERS IN CANADA

Gentlemen:

We wish to advise that Canadian Design Registration No. 187/25140 covering the chesterfield sofa illustrated in the attached drawing (our style 2050/13) was granted to us by the Canadian Patent Office. By virtue of such registration, we have the exclusive right to manufacture and sell in Canada chesterfield sofas of the design illustrated.

We understand that chesterfield sofas which are copies of that illustrated in the attached drawing are being manufactured in Canada by furniture manufacturers other than ourselves and are being offered for sale to a number of furniture dealers in many parts of this country. The Manufacture and/or sale of such chesterfield sofa competes directly with and is detrimental to our business in this country, and accordingly, we believe you would want us to advise you of the existence of our afore-said Registration as well as the fact that any such chesterfield sofas which have not originated with us constitutes an infringement of our registered design. We must of course protect our position in the trade in Canada and will take all steps necessary, including legal action, to prevent such infringement.

Yours very truly,  
 CIMON LIMITED.

(signed) René Cimon.

(1) On December 4, 1962, the plaintiff company also sent to the defendant Edwards a letter bearing date December 3, 1962 and reading as follows:

1964  
 {  
 CIMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 ———  
 Jackett P.  
 ———

Mr. Edwards,  
 Furniture Craft Corp  
 9697 St-Lawrence  
 Montreal,  
 Dear Mr. Edwards.

It has been brought to our attention that you have manufactured and sold copies of one of our sofas (our No. 2050/13 picture attached) which is registered with the Canadian Patent Office and carries Industrial Design Registration No. 187/25140.

As our firms always have been on a friendly basis, rather than take action that would be distasteful to both of us, we are requesting that you discontinue the sale of this sofa. Would you be kind enough to confirm this by return letter so that we can close our file on this.

It is our belief that you did not do this to hurt us deliberately but your action has caused us some embarrassment and loss of business and we are sure you will correct this.

For your information, it is our intention to register with the Canadian Patent Office all original designs of our manufacture.

Yours very truly  
 CIMON LIMITED

René Cimon

- (m) At the furniture show in Toronto in January 1963, there was a meeting between René Cimon, an executive officer of the plaintiff company, and the defendant Edwards. Cimon accused Edwards of copying the plaintiff company's design and told Edwards that the design was registered. Edwards admitted receiving a letter from the plaintiff company, but said he had been too busy to answer the letter, which he regarded as unimportant. Edwards further said that the registered design did not mean anything and that his company's sofa was not like the plaintiff company's sofa because he had put buttons on his.
- (n) One Peter Kerr, who had become president of Furniture Craft Corporation in May 1962, was present at the meeting between Edwards and René Cimon in January 1963 and, from that time on, Furniture Craft Corporation ceased producing sofas and chairs to which had been applied designs that were like the plaintiff company's registered design. Mr. Kerr agreed at that time that Furniture Craft Corporation would "stay away from the Cimon line".
- (o) Shortly after that decision was taken by Furniture Craft Corporation, the defendant Edwards left that

company and became associated with the defendant company. The defendant company has been, since early 1963, manufacturing and selling sofas and chairs to which have been applied designs that are, for all practical purposes, the same as the designs that had been applied to the sofas and chairs that Furniture Craft Corporation had been manufacturing before it decided to "stay away from the Cimon line". The sofas and chairs in question are illustrated by a page of the defendant company's catalogue that I reproduce on the following page.

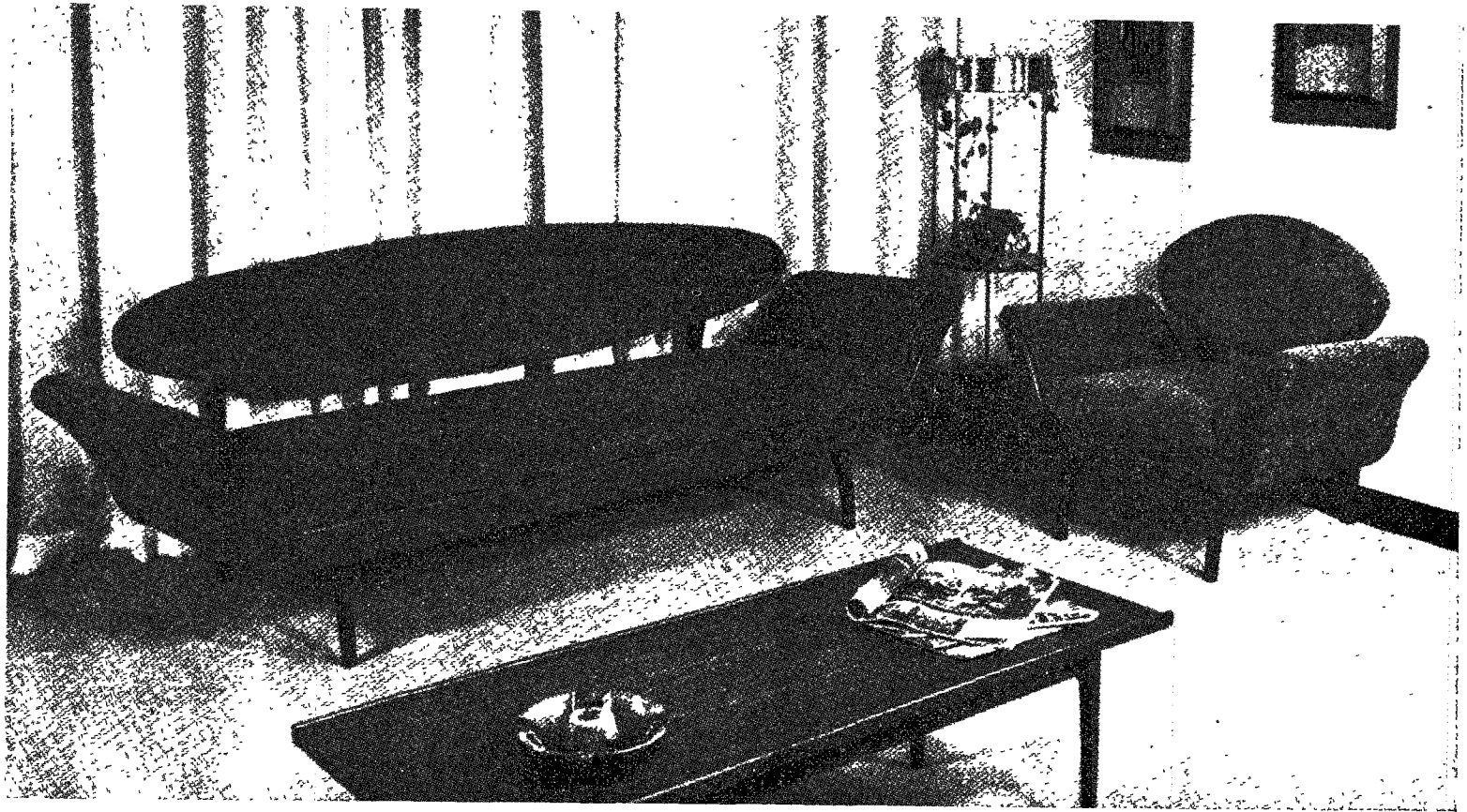
1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

The defendant Edwards is general manager of the defendant company and has complete and exclusive authority in respect of all decisions as to what furniture the defendant company produces and sells.

- (p) The defendant company has every intention of continuing to produce and sell the articles in question as long as there is a demand for them unless enjoined by judgment in this action against so doing.

As indicated earlier, the facts that I have just recited appear to me to be outside the realm of controversy in so far as the plaintiffs and the defendant company are concerned. They are equally outside the realm of controversy in so far as the plaintiffs and the defendant Edwards are concerned with the exception of the fact that the defendant company is producing and selling sofas and chairs to which the designs used by Furniture Craft Corporation have been applied, and intends to continue doing so, and the fact that the defendant Edwards is general manager of the defendant company and has complete and exclusive authority in respect of all decisions as to what furniture the defendant company produces and sells. These latter facts were established against the defendant company by an examination for discovery of the defendant Edwards as an officer of the defendant company, part of which was used by the plaintiffs as evidence under Rule 138 of the Exchequer Court Rules, which reads, in part, as follows:

Where any departmental or other officer of the Crown, or an officer of a corporation has been examined for the purpose of discovery, the whole or any part of the examination may be used as evidence by any party adverse in interest to the Crown or corporation; and if a part only be used



**5006-SOFA—**  
Overall Length 96"  
Height 33"  
Depth 30½"  
Seat Depth 22"

**5007-CHAIR—**  
Overall length 36"  
Depth 30½"  
Height 33"  
Seat depth 22"  
Foam rubber seat over rubber slats

the Crown or corporation may put in and use the remainder of the examination of the officer, or any part thereof, as evidence on the part of the Crown or of the corporation.

1964  
CIMON LTD.  
*et al.*  
*v.*  
BENCH  
MADE  
FURNITURE  
CORP *et al.*  
Jackett P.

While there can, in my view, be no doubt that the answers given by the defendant Edwards on his examination for discovery as an officer of the defendant company could have been used as evidence against him personally, to the extent that they consisted of admissions against his interest, to constitute such evidence against him they had to be put in at the trial by way of evidence that constituted part of the case against him. This could have been done by way of admissions obtained pursuant to a notice to admit facts or by way of evidence from the reporter or other person who was present at the examination for discovery. No such evidence was put in against Edwards, and, in my view, the use of the examination for discovery under Rule 138 only binds the defendant company. I am of opinion that it would be unfortunate if such an omission resulted in such an obvious miscarriage of justice as would result if it had the effect that the plaintiffs were to be deprived of success against Edwards for lack of proof of facts that, according to the record, have been established by the sworn testimony of Edwards himself. On the facts of this case, however, I do not think it can affect the outcome for, if there has been any infringement of any of the plaintiffs' rights, there was an infringement by Furniture Craft Corporation during the period from the time when Edwards became aware of the registration of the plaintiff company's industrial design on November 20, 1962, until that company ceased production of the sofas and chairs in question in January or February of 1963, the defendant Edwards was clearly a party to any such infringement and any such infringement falls within the allegations in the Statement of Claim. (I have carefully considered the written submission by counsel for the defendants on this point and I cannot agree that the Statement of Claim is so worded as to restrict the claim against Edwards to acts done by Edwards on behalf of the defendant company. The Statement of Claim is in perfectly general terms and the defendants were content to go to trial without requiring any particulars as to the time or place of alleged acts of infringement. Neither can I accept the argument that the Statement of Claim does not extend to Edwards' participation

1964  
 CIMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

in manufacture and sale of the infringing articles by Furniture Craft Corporation. It is no answer to a claim in tort that the tortfeasor was acting as a servant or agent for some other person.)

I come now to the attempt that was made to cast some doubt on the clear cut evidence given by Tiengo, as a witness for the plaintiffs, both in his evidence-in-chief and on cross-examination, that the design which was subsequently the subject matter of the registration was a new and original design created by him during the latter part of 1961 under his contractual arrangement with the plaintiff company. John Salus gave evidence for the defence that, in 1958, while he was president of Cortini Corporation, there was a meeting attended by Salus, Edwards and Tiengo, at which Edwards suggested a chesterfield with sweeping arms and a "cigar-shaped back" and that Tiengo, in sketching out this concept, had produced a sketch which was substantially the same as the plaintiff company's registered design. This evidence was given although, during a prolonged cross-examination of Tiengo, no suggestion was made that any such alleged sketch had been made in 1958 or at any time or place other than as stated in Tiengo's evidence-in-chief. No such sketch was produced and Salus did not persuade me that he really remembered this furniture design incident that, according to his evidence, had happened almost six years earlier. Furniture design was no part of his duties—his position as "President" having been a nominal one. His memory in connection with more recent incidents of direct concern to him was not nearly as clear as his evidence would suggest it was concerning this much earlier incident. I observed his demeanour very carefully, and, in my opinion, his evidence is not reliable. To the extent that his evidence is inconsistent with that given by Tiengo, I do not accept it. Furthermore, I cannot help commenting on the fact that there has been no evidence with regard to the alleged incident from Edwards, from whom the suggestion in question is supposed to have come. There was no suggestion that Edwards was not available to give evidence at the trial. I find, therefore, that the design in question was created by Tiengo during the latter part of 1961 and that it was created by him for the plaintiff company and not for Furniture Craft Corporation.

There is also a conflict between the evidence tendered by the plaintiffs and the evidence tendered by the defendants with respect to the circumstances surrounding the creation by Furniture Craft Corporation of a chesterfield sofa and a chesterfield chair to which had been applied designs that were similar to the design that was subsequently registered by the plaintiff company. One Bruno Gimber gave evidence that he is a cabinet maker who was employed by Furniture Craft Corporation in the fall of 1961 as a foreman and is still employed in the same position by that company although it has now changed its name. He swore that, in the spring of 1962, a chesterfield sofa that had been manufactured by the plaintiff company appeared in Furniture Craft Corporation's factory, that the defendant Edwards instructed him and his fellow employees to copy it as it was but "with a tight seat", and that he and his fellow employees carried out such instructions. (As I understand the evidence, the plaintiffs' sofa had a removeable cushion and the instructions to create a sofa with a "tight seat" involved building up the seat to take up the same volume without having a removeable cushion.) Gimber gave his evidence in a convincing manner and went into considerable detail as to the various modifications that were made in the design that had been applied to the Cimon sofa in the course of creating the copy with a "tight seat". In my view, his evidence was not shaken on cross-examination. Reference to an incident when his present employer thought that he had stolen some furniture strengthened, rather than shook, my confidence in his testimony. Peter Kerr, who it will be recalled was the president of Furniture Craft Corporation at that time, gave evidence that, to his knowledge, Furniture Craft Corporation created their sofa along the same lines as the Cimon sofa without having a sample of the Cimon sofa to copy and that the work was done by one Gartner, whom he described as being their production supervisor at that time. Kerr was not able to swear that Edwards had not instructed Gimber to copy an actual Cimon sofa but said that "to my knowledge Mr. Edwards never instructed Mr. Gimber to copy". Kerr is now in business as a manufacturer's agent and one of the principal "lines" that he handles is the defendant company's furniture. My impression was that he was striving to make his evidence as favourable to the

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

1964  
 CIMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jakkett P.

defendants as possible. George Gartner gave evidence that he had been instructed to construct a sofa with a design similar to the plaintiff company's design by the defendant Edwards, who had given him a sketch from which to work. He said that Gimber had had nothing to do with it but that the upholstery department, whose foreman was one Bartl, had taken charge of the upholstering stage. Gartner has worked under the defendant Edwards at Cortini Corporation and Furniture Craft Corporation and is now working at the defendant company's plant. The plaintiffs called in rebuttal Arnold Bartl who, at all relevant times was, and still is, in charge of the upholstery department at Furniture Craft Corporation. He completely contradicted the story of the production of that company's copy of the Cimon sofa as told by Kerr and Gartner in so far as his part in that story is concerned and, incidentally, he corroborated Gimber's story in all important respects. Having observed the demeanor in the box of all four of these witnesses with care and anxiety, I accept the story as told by Gimber and Bartl and I reject the evidence of Kerr and Gartner in so far as it is inconsistent with that of Gimber and Bartl. Here, again, I cannot refrain from commenting on the fact that the defendant Edwards, who was the principal actor in the story, whichever version is true, did not give evidence. There was no suggestion that he was not available.

In any event, whether I accept the evidence of Gimber and Bartl or have regard only to the evidence of Kerr and Gartner, there is no doubt in my mind that Furniture Craft Corporation, acting under the control of the defendant, Edwards, inspired by the success of the new Cimon sofa, to which the registered design here in question had been applied, early in 1962 produced a line of sofas and of chairs calculated to look as much like the Cimon sofa as possible with a view to sharing in the Cimon success.

I might also say, at this point, that it is perfectly clear that Furniture Craft Corporation, acting under the direct control of Edwards, produced and sold sofas and chairs in accordance with the copies so developed until after the Toronto Furniture Show in January 1963. It is also clear, in so far as the defendant company is concerned, that, very shortly after Furniture Craft Corporation ceased to produce them, the defendant company, under the direction of the defendant Edwards, started producing sofas and chairs to



which the same design had been applied, has been doing so ever since, and intends to do so as long as it is commercially advantageous to do so.

I shall deal first with the claim for infringement of the registered design because, as indicated above, it is conceded by the plaintiffs that, if the design in question is capable of being registered under the *Industrial Design and Union Label Act*, there is no cause of action for infringement of copyright. The claim for infringement of the registered design is a claim of the plaintiff company alone. Tiengo does not claim any interest in the registered design.

The relevant provisions of the *Industrial Design and Union Label Act* are

3. The Minister shall cause to be kept a book called the Register of Industrial Designs for the registration therein of industrial designs.

4. The proprietor applying for the registration of any design shall deposit with the Minister a drawing and description in duplicate of the same, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof.

5. On receipt of the fee prescribed by this Act in that behalf, the Minister shall cause any design for which the proprietor has made application for registry to be examined to ascertain whether it resembles any other design already registered.

6. The Minister shall register the design if he finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith; and he shall return to the proprietor thereof one copy of the drawing and description with the certificate required by this Part; . . .

7. (1) On the copy of the drawing and description returned to the person registering, a certificate shall be given signed by the Minister or the Commissioner of Patents to the effect that such design has been duly registered in accordance with the provisions of this Act.

(2) Such certificate shall show the date of registration including the day, month and year of the entry thereof in the proper register, the name and address of the registered proprietor, the number of such design and the number or letter employed to denote or correspond to the registration.

(3) The said certificate, in the absence of proof to the contrary, is sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registry, and of compliance with the provisions of this Act.

8. Where the author of any design has, for a good and valuable consideration, executed the same for some other person, such other person is alone entitled to register.

9. An exclusive right for an industrial design may be acquired by registration of the same under this Part.

1964  
CIMON LTD.  
et al.  
v.  
BENCH  
MADE  
FURNITURE  
CORP. et al.  
Jackett P.

1964  
 {  
 CIMON L<sup>TD</sup>.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 —  
 Jackett P.  
 —

10. (1) Such exclusive right is valid for the term of five years, but may be renewed, at or before the expiration of the said term of five years, for a further period of five years or less on payment of the fee in this Act prescribed for extension of time; but the whole duration of the exclusive right shall not exceed ten years in all.

\* \* \*

11. During the existence of such exclusive right, whether of the entire or partial use of such design, no person shall without the licence in writing of the registered proprietor, or, if assigned, of his assignee, apply for the purposes of sale such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached, or publish, sell or expose for sale or use, any such article as aforesaid to which such design or fraudulent imitation thereof has been applied.

12. (1) The author of any design shall be considered the proprietor thereof unless he has executed the design for another person for a good or valuable consideration, in which case such other person shall be considered the proprietor.

\* \* \*

15. If any person applies or imitates any design for the purpose of sale, being aware that the proprietor of such design has not given his consent to such application or imitation, an action may be maintained by the proprietor of such design against such person for the damages such proprietor has sustained by reason of such application or imitation.

These provisions have been the subject of authoritative comment in *Clatworthy & Son, Limited v. Dale Display Fixtures Limited*<sup>1</sup>, per Lamont J., at page 431:

No definition of a "design" is given in the Act. The word must, therefore, be taken in its ordinary signification which Lindley, L.J., in *In re Clarke's Design* [1896] 2 Ch. 38, at p. 43, stated means: "Something marked out—a plan or representation of something". A "design" is, therefore, a pattern or representation which the eye can see and which can be applied to a manufactured article. To be entitled to registration the "design" must be original. The Act does not expressly call for novelty, but s. 27(3) provides that the Minister's certificate of registration shall, in the absence of proof to the contrary, be sufficient evidence of the originality of the design. Just what is contemplated by "originality" the Act does not make clear. Under the English Act a design, to be registrable, must be "new or original." As that Act uses both words it has, in a number of cases, been sought to draw a distinction in meaning between them, and it has been held that "every design which is original is new, but every design which is new is not necessarily original." *In re Rollason's Design*, (1897) 14 R.P.C. 909.

In *Dover, Limited v. Nürnberger Celluloidwaren Fabrik Gebrüder Wolff*, [1910] 2 Ch. 25, at p. 29, Buckley, L.J., defines "original" as applied to designs, as follows:—

"The word 'original' contemplates that the person has originated something, that by the exercise of intellectual activity he has started an idea which had not occurred to any one before, that a particular pattern or shape or ornament may be rendered applicable to the particular article to which he suggests that it shall be applied. If that

<sup>1</sup> [1929] S C R. 429.

state of things be satisfied, then the design will be original although the actual picture or shape or whatever it is which is being considered is old in the sense that it has existed with reference to another article before."

And further on he says:—

"There must be the exercise of intellectual activity so as to originate, that is to say suggest for the first time, something which had not occurred to any one before as to applying by some manual, mechanical, or chemical means some pattern, shape, or ornament to some special subject-matter to which it had not been applied before."

The above quotations, in my opinion, set out what is called for by our Act.

The plaintiffs relied upon the certificate under subsection (1) of section 7 as sufficient evidence, in the absence of proof to the contrary, by virtue of subsection (3) of section 7, of, *inter alia*,

- (a) the design,
- (b) the originality of the design,
- (c) the person named as proprietor being proprietor, and
- (d) compliance with the provisions of the Act.

The position of the defendants, as I understand it, may be summarized as follows:

1. that, under the Act, there can be no registration of a design for shape or configuration of an article and the registered design was an attempt to register a design for the shape or configuration of an article;
2. that, under the Act, there can be no registration of an article of manufacture and the registered design lays claim to an article of manufacture;

(Counsel for the defendants indicated that he regarded these two contentions as being merely different ways of stating the same objection and that he preferred the second way of putting it.)

3. that, under the Act, a design cannot be registered unless it is original and the registered design is not original;
4. that it is a condition precedent to a registered design, such as this one, continuing to be valid that the "name of the proprietor" shall appear upon the article to which the design applies by being marked "with the letters Rd., and the year of registration at the edge or upon any convenient part thereof" and the mark here failed to comply with the requirement

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

because the name shown upon the label relied upon as complying with the requirement was "Cimon" instead of the plaintiff company's full name of "Cimon Limited"; and

5. that the defendants did not infringe the plaintiff company's registered design because the design applied to the sofas and chairs produced by the defendants was neither the registered design nor an imitation or fraudulent imitation of it.

Put another way, the defendants have five defences to the action for infringement of registered design. They make three attacks on the validity of the plaintiff company's registered design based on contentions that there was not proper subject matter for registration, they make an attack on the validity of the registered design based on the contention that the statutory provisions about marking have not been complied with, and they deny that what the defendant has done constitutes infringement of the design. The attacks based on lack of subject matter are

- (a) that the registration is for a design for shape or configuration of an article,
- (b) that the registration is for a design for an article, and
- (c) that the registered design lacks originality.

The contentions concerning designs for shape or configuration and concerning designs for an article itself raise difficult questions as to the effect of the Canadian legislation calling for a careful examination of the relevant provisions and of the cases that have been decided thereunder.

Looking first at the statutes, without reference to any decision, I find that sections 3 to 6, inclusive, confer on the proprietor of "any design" a right to have "the design" registered in the Register of Industrial Designs kept pursuant to section 3. The only indication in these sections of the right to registration being limited to a particular class of designs is the fact that section 3 says that the Register of Industrial Designs is to be kept for the registration therein of "industrial" designs. There is, however, a fairly definite indication in other sections as to just what class of design is intended. It is sufficient to refer to

section 11 which, in effect, defines the ambit of the monopoly conferred by registration of a design by providing that no person (during the existence of the exclusive right and without a licence) shall for purposes of sale "apply" the design or a fraudulent imitation thereof "to the ornamenting" of "any article of manufacture. . ." The sort of design that can be registered is therefore a design to be "applied" to "the ornamenting" of an article. It must therefore be something that determines the appearance of an article, or some part of an article, because ornamenting relates to appearance. And it must have as its objective making the appearance of an article more attractive because that is the purpose of ornamenting. It cannot be something that determines the nature of an article as such (as opposed to mere appearance) and it cannot be something that determines how an article is to be created. In other words, it cannot create a monopoly in "a product" or "a process" such as can be acquired by a patent for an invention. There is, moreover, nothing in the legislation that limits the type of design that may be registered (as was suggested in argument) to those providing for something that is applied to an article after the article comes into existence. Section 11 contemplates a "design" being "applied" to the "ornamenting" of any article. It is not restricted to a "design" being "applied" to an "article". This is borne out by the fact that, in Ontario and Quebec, the original industrial design legislation enacted by Parliament, chapter 55 of 1868, which did not differ in its principal provisions from our present Act, replaced a pre-Confederation Act of the old Province of Canada, chapter 21 of the Statutes of Canada, 1861, which provided (section 11) for the registration of new and original designs

"whether such designs be applicable to the ornamenting of any article of manufacture, or of any substance. . ."

and that

"whether such design be so applicable for the pattern, or for the shape, or for the configuration, or for the ornament thereof, or for any two or more such purposes"

1964

CIMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

and

“by whatever means such design may be so applicable, whether by printing or by painting, or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined.”

(I take it that the word “ornamenting” where it appears in the first of these three quotations, inasmuch as it must comprehend all four cases detailed in the second quotation, has the general meaning of improving appearance and that “ornament” in the second quotation has, by reason of the context in which it appears, the more particular meaning of something that is applied physically to something else to improve its appearance.) The object of that part of section 11 of the 1861 statute set out in the second quotation, *supra*, was to make it clear that the statute extended to “everything which would ordinarily fall within the word ‘design’”. See *In the Matter of Rol-lason's Registered Design*<sup>1</sup> per Lord Herschell at page 446. Had Parliament intended to exclude from the word “design” as adopted in 1868 anything included in the pre-existing legislation, I should have thought that it would have done so specifically. The various classes of design spelled out in the second quotation from the 1861 legislation, *supra*, are, it seems to me, exhaustive and are therefore calculated to limit the ambit of that legislation. When references to various classes of design were omitted in 1868 from the Canadian legislation, that legislation, in my view, applied to all the classes that were previously spelled out as well as to any other class of “design” that is capable of being “applied” for the “purposes of ornamenting” any article, if any such other class there be.

If, therefore, my understanding of the ambit of the Act is to be determined by my reading of the statutes without reference to the cases decided thereunder, I have no difficulty in concluding that the Cimon design is not objectionable as being a design for shape or configuration and is not objectionable as being a claim for an article or product. The fact that a design relates to shape or

<sup>1</sup> (1898) 15 R.P.C. 441.

configuration of an article is not, in itself, an objection to its registration. As long as it is a design to be applied "to the ornamenting" of an article, it is eligible for registration even though it requires that its purpose of "ornamenting" be accomplished in whole or in part by constructing the article, or parts of it, in a certain shape or shapes<sup>1</sup>. (This is quite a different thing from claiming the shape or configuration that an article necessarily assumes if it is to serve a certain purpose or if it has been constructed in accordance with a certain process.) The Cimon design is furthermore not a design for an article. It is not a design for sofas or for some particular kind of sofa. It is truly a "design" for the ornamentation of sofas that can be applied by making the sofas in certain shapes. The distinction was expressed in *In re Clarke's Design*<sup>2</sup> by Lindley L.J. at page 43, as being "the difference between the shape of a thing and a thing of that shape". The distinction is narrow but is fundamental.

To summarize as to my view of the effect of the Canadian legislation on this branch of the case, my conclusion, from an examination of the legislation without reference to the cases, is that

- (a) the defendant's contention that, under the Canadian Act, there can be no registration for shape or configuration of an article is unsound inasmuch as there can be registration of a design to be applied for the ornamenting of an article by making it in a particular shape or configuration; and
- (b) the defendants' contention that, under the Canadian Act, there can be no registration of an article of manufacture as such is sound.

It follows that I do not agree with the defendants' contention that registration of a design to be applied by making an article in a particular shape or configuration is registration of the article itself.

I come now to examine the decisions that, according to counsel for the defendants, require me to reach a conclusion on these two objections to the subject matter of

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

<sup>1</sup> See *In re Clarke's Design* [1896] 2 Ch. 38 at p. 43 per Lindley L.J., "A design applicable to a thing for its shape can only be applied to a thing by making it in that shape."

<sup>2</sup> [1896] 2 Ch. 38.

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP et al.  
 Jackett P.

the plaintiff company's registered design contrary to that reached upon an examination of the statute.

While I restrict myself generally to Canadian decisions, I wish to express the warning that decisions under the United Kingdom Statute on this point must be looked at with caution because the words "to the ornamenting" do not appear in the United Kingdom legislation since 1883. Nevertheless, in my view, the United Kingdom legislation is not dissimilar in its general effect. While the words "to the ornamenting" do not appear in it, nevertheless, its protection is restricted to "cases where the object is to please the eye". See "Copyright in Industrial Designs" by Russell Clark, quoted with approval in *Stenor, Ltd. v. Whitesides (Clitheroe), Ltd.*<sup>1</sup> per Lord Porter at page 126.

The earliest case that has been drawn to my attention of an action under the Canadian Act for infringement of a registered industrial design is *Findlay v. The Ottawa Furnace and Foundry Company (Limited)*<sup>2</sup>. In that case the plaintiffs had registered an industrial design for a cooking stove of a distinctive shape and with extensive scroll-work ornamenting its various side panels. The defendants procured a stove made by the plaintiffs according to their registered design, took it apart and made a set of patterns of the parts. From these patterns, the defendants made a stove but they made alterations in the ornamental scroll-work and adopted a different medallion. They also made minor alternations in the interior construction. Counsel for the defendants argued that the plaintiffs could not prevent the defendants from manufacturing a cook stove when all they had registered was an ornamental design for a cook stove. He put his contention in these words, "If we differentiate the ornamentation, we have a clear right to manufacture a stove of the shape and dimensions of that of the plaintiffs". Burbidge J., it is true, did not discuss this submission. He disposed of the case by finding that it was clear that the plaintiffs had a registered design in respect of which they were entitled to protection and that it had been infringed.

<sup>1</sup> [1948] A C 107.

<sup>2</sup> (1902) 7 Ex C R 338.



The first case upon which counsel for the defendants placed reliance in connection with his contention that shape or configuration cannot be subject matter is *Kaufmann Rubber Company Limited v. Miner Rubber Company Limited*<sup>1</sup>. That was an action for infringement of registered industrial designs. The design was the usual outline or representation of an overshoe and the means of fastening the flaps of the overshoe, the means being the usual metal buckle arrangement on the lower part, and cross straps on the upper part, to which dome fasteners, well known in gloves, were applied. The only description of the design was a statement that the design consisted of "the novel configuration of overshoes or galoshes as shown". After reviewing the provisions in the legislation, Mr. Justice Maclean said that they would seem to indicate that

- (a) in the statute, "industrial designs" is intended to mean some design or mark which is to be attached to a manufactured article,
  - (b) the use of the word "ornamenting" would indicate that a design might be adapted to purposes of ornamentation,
  - (c) dealing with designs, the legislature had primarily before it the idea of "shape or ornamentation" involving artistic considerations,
  - (d) a design cannot be an article of manufacture but "something to be applied to an article of manufacture, or other article to which an industrial design may be applied, and capable of existence outside the article itself",
  - (e) the registration of a design would afford no protection for any mechanical principle or contrivance, process or method of manufacture, or principle of construction, and
  - (f) there must be something original in a registered design.
- He summarized by saying that "A design to be registrable must therefore be some conception or suggestion as to shape, pattern or ornament applied to any article, and is judged solely by the eye, and does not include any mode or principle of construction." After reviewing the legal effect of the legislation, Mr. Justice Maclean said that the design

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP et al.  
 Jackett P.

<sup>1</sup> [1926] Ex. C.R. 26.

1964  
 CUMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jakkett P.

before him covered the shape or configuration of the whole overshoe "together with the buckles and straps, the means of fastening" and said that it was not to be seriously considered that this was a registrable design within the contemplation of the statute. Having said that, he gave his reasons as follows: "The registrations are but an attempt to protect a mode of construction" and "There is nothing original or novel in the configuration of an overshoe as shewn by the plaintiff's designs, or any part of them". Nowhere, in this judgment, as far as I can find, does Maclean J. reject the idea that a design may be applied to the ornamenting of an article by requiring that the article be constructed in whole or in part in accordance with a shape dictated by the design. On the contrary, he says that a design "must be some conception or suggestion as to shape, pattern or ornament applied to any article". It is clear, therefore, that this case does not establish that a design is not registrable merely because it relates to the shape or configuration of an article.

The next case upon which counsel for the defendants relied was *Clatworthy & Son, Limited v. Dale Display Fixtures Limited*<sup>1</sup>. In this case, there was a claim for infringement of a registered design for a display stand. The registered design related to a rack or stand consisting of a straight horizontal bar so supported at its extremities that garments could be hung on it on ordinary coat or garment hangars. Each of the side supports consisted of a vertical bar the lower end of which was fitted into a base or footing which rested upon the floor, and these footings were connected by another horizontal bar which held the rack firm. The footing at each side where it connected with the bar was ornamented so that, in conjunction with an ornamented boss which encircled the upright at the lower end and rested on the footing, the effect produced was pleasing to the eye. The junction of each upright with the top horizontal bar was also ornamented. At page 162 of the Exchequer Court report, Maclean J. said, "The Act is not clear when the design is merely for the shape of a thing, and it may be doubtful if a design for shape or configuration, which can only be applied to a thing by making it in that shape, comes within the Act. In the corresponding English Act,

<sup>1</sup> [1928] Ex. C.R. 159; [1929] S.C.R. 429.

1907, it does, but the statute there states that 'Design' means any design applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, etc., and the same was true of the English Act of 1883." Having raised this question, Mr. Justice Maclean did not pursue it but said that for the purposes of that case, he was going to assume that under the Act the design was applicable for the shape or configuration. He then proceeded to hold that the plaintiff's registered design was invalid because the design was not original. (The superficial distinction between the Canadian legislation and the English legislation of 1883 and 1907 was the fact that the Canadian legislation was expressly restricted to designs to be applied "to the ornamenting" of any article whereas, under the English Act of 1883, and also the Act of 1907, the legislation did not contain such words and did expressly refer to any "design" that was "applicable to any article of manufacture... whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof".) In the Supreme Court of Canada, Mr. Justice Maclean's decision in the *Clathworthy* case was upheld on the anticipation point. [Reference to "Canadian Law of Trade Marks and Industrial Designs" by Harold G. Fox, (1940) page 454, shows that, during the argument of the case in the Supreme Court of Canada, Duff J., as he then was, expressed the view that a design may be registered for the external shape or configuration of an article.] It is worthy of note that in the course of the judgment of Lamont J., who delivered the judgment of the Supreme Court of Canada, he makes reference to the "shape" feature of design without any indication that it had no validity under the Canadian Act. At page 431 of the Supreme Court report, he said that "It is upon the shape of the base or footing and the character of the ornamentation that the appellant relies to justify the conclusion that the combination is artistic, new and original." Again, at page 433, he said: "It must be remembered, however, that to constitute an original design there must be some substantial difference between the new design and what had theretofore existed. A slight change of outline or configuration, or an unsubstantial variation is not sufficient to enable the author to obtain registration."

1964

CIMON LTD.

et al.

v.

BENCH

MADE

FURNITURE

CORP. et al.

Jackett P.

1964  
 CUMON LTD.  
*et al.*  
*v.*  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

The next case cited by counsel for the defendants as being in line with the position which he took about designs for shape or configuration not constituting good subject matter is *Canadian William Rodgers Limited v. International Silver Company of Canada, Limited*<sup>1</sup>. The design registered in that case was described as follows:

The said industrial design consists of a knife wherein the handle is substantially three-fifths and the blade substantially the remaining two-fifths of the total length of the knife, the whole being of a shape substantially as shown.

The drawings accompanying the application simply indicated the outlines of the table knife and the only feature peculiar to the design of the knife was that the handle and blade respectively were in the proportions, relative to the whole length of the knife, stated in the application for registration. Maclean J. said at page 65 "... the sole question for determination is whether the outline of a table knife, distinguished only by having the length of the handle and blade in the proportions mentioned, constitutes a registrable design, under the provisions of The Trade Mark and Design Act." He referred to his discussion of the provisions of the Act in the *Kaufmann Rubber Company* case and said that in that case he had expressed the opinion "... that an 'industrial design,' under the Act, was intended only to imply some ornamental design applied to an article of manufacture, that is to say, it is the design, drawing, or engraving, applied to the ornamentation of an article of manufacture, which is protected, and not the article of manufacture itself." He pointed out that, in the earlier English Design Acts, this same principle had been applied and that, in his view, the Canadian legislation still adhered to it inasmuch as, while the words "for the ornamentation of" had been omitted from the English Act in later years, they are still in the Canadian Act. Mr. Justice Maclean said further that, even if the statute did not confine the registration of design to ornamental designs applied to an article of manufacture, he was of opinion that the dimensions of the handle and blade of a table knife do not constitute subject matter for a design, and are not properly registrable as a design. He rejected the idea that "the shape or configuration of the knife" was claimed as a design, saying that "it is only a knife in

<sup>1</sup> [1932] Ex. C.R. 63.

which the handle is one-fifth longer than the blade, that is claimed as the design; any reference to 'shape' in the application was merely to indicate this fact." He said that "It is true that a knife constructed in this fashion produces an effect, but an effect is not a design". He does comment that the words "shape or configuration" as employed in the present English Design Act are not to be found in our Act and expresses the opinion that English decisions based upon those words are not applicable here. This is a different thing, however, from saying that, in his opinion, a design applicable for shape or configuration cannot be applicable "to the ornamenting of any article". I do not understand Mr. Justice Maclean as having expressed any such opinion.

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 Jackett P.

Next in the line of the defendants' authorities is *Allaire v. Hobbs Glass Ltd.*<sup>1</sup>. In this case, there was a registration of an industrial design described as "A device For Covering a Wall In The Vicinity of A Switch, composed of a flat plate of elliptical configuration having a central aperture disposed to register with the front plate of an electrical switch, . . ." The defendant does not appear to have raised the objection that this particular registration lacked subject matter because the design was for a utilitarian purpose rather than for ornamentation and Mr. Justice Angers did not deal with this objection. The defence did raise the objection that the design was invalid because it did not require any ingenuity and, at page 182, Mr. Justice Angers rejected this argument holding that, in his opinion, the design did constitute an innovation in electrical switch plates which merited protection under the statute. However, he dismissed the action in any event because he found that there was a failure to comply with the requirements of the marking provisions. In my view, this decision is no authority either for or against the submissions made by the defence in this case concerning designs for shape or configuration.

Counsel for the defendants placed greatest reliance on the decision of Mr. Justice Cameron in *Renwal Manufacturing Company, Inc. v. Reliable Toy Company, Limited*<sup>2</sup>. This was an action for infringement of a registered industrial design and Mr. Justice Cameron was able to dismiss the action on more than one ground. The only ground that is

<sup>1</sup> [1948] Ex. C.R. 171.

<sup>2</sup> [1949] Ex. C.R. 188.

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 Jackett P.

of interest here is that which was dealt with at pages 196 to 198 inclusive. In this part of his judgment, he explains his reasons for holding that the design that had been registered in that case was not a design to be applied to the ornamentation of an article of manufacture but was, indeed, a design of the article itself. On this ground, he held that the registration was invalid. Mr. Justice Cameron does refer to the doubt raised by Maclean J. in the *Clatworthy* case "as to whether a design for shape or configuration which can only be applied to a thing by making it in that shape comes within the Canadian Act" and points out that, according to the statute, the design must be something capable of application to the article "for the ornamentation thereof". Counsel for the defendants placed considerable stress on these comments by Cameron J. and sought even greater support for his proposition from a passage from the learned Judge's reasons where, after referring to some of the provisions of the Act, he said:

I have been unable to find in the Act anything which would indicate that the shape or configuration of an article of manufacture may itself be the subject of a registered design. As I have stated above, all the registered designs here in question are for the articles of manufacture themselves. and upon a subsequent passage where, after referring to the terms of the certificate of registration of one of the designs in question he said:

I think there can be no question whatever that the certificate in question was for "a toy sink", which is an article of manufacture, and not for any design for the ornamenting of a toy sink. The description of the toy sink contained in the certificate is a description of every part of the toy sink itself, and that description indicates the very shape or configuration of an article of manufacture. There is no suggestion of any particular ornamentation, decoration, pattern, engraving, or anything of that nature to be applied or attached "to the ornamenting of any article of manufacture".

Read by themselves, these passages might appear to tend towards the proposition urged by counsel for the defendants that a claim for a design to be applied by reference to shape or configuration is a claim for the article of manufacture itself. However, the passages must be read in relation to the issue before Cameron J., which was whether "shape or configuration of an article of manufacture" may "itself" be the subject of a registered design, and with due regard to his repeated emphasis on the necessity of the design being something applied to the "ornamenting" of the article. There was no suggestion on the facts before

him that the object of the design was "ornamenting". He was dealing with a design that described "every part of the toy sink itself" and not merely what is apparent "to the eye". There was no need for him to consider whether a design for the shape or for the configuration applicable "to the ornamenting" of an article was good subject matter and, clearly, in my view, what he says was not addressed to that question at all.

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 JACKETT P.

*Angelstone Limited v. Artistic Stone Limited*<sup>1</sup> was the next case relied upon by counsel for the defendants. This was a decision of Fournier J., holding that a registered design for a building block was invalid because it was a design for an article of manufacture, because it lacked novelty and because it was not a design for the ornamenting of an article. At page 293, Fournier J. said: ". . . what was desired to be protected by the registration was the building block itself". On the next page, he referred to a judgment in an English case where it was said, ". . . A registered design is not in any way a minor type of patent. It is something that is protected in respect of its appearance or form alone. It is for this reason that all attempts to make registered designs cover modes of manufacture have rightly failed . . ." At page 295, Mr. Justice Fournier said, "I have come to the conclusion that this description is that of an article of manufacture, to wit the building block in respect of which the certificate of registration of the design was issued. It has been held on many occasions that an industrial design may be protected only when it is applicable to the ornamentation of any article and not to the article of manufacture itself." Fournier J. refers to the decisions of Maclean J. and Cameron J. in the *Clatworthy* case and the *Renwal* case, respectively, and adopts the position taken by them with reference to designs that are for shape or configuration and are not applicable to the ornamenting of an article of manufacture.

Mr. Justice Kearney's decision in *Ribbons (Montreal) Limited v. Belding Corticelli Limited*<sup>2</sup> was also mentioned by counsel for the defendants but he rightly indicated that that decision has no bearing on the matter either way inasmuch as no attack had been made upon the registrability of the design that had been registered there by

<sup>1</sup> [1960] Ex. C.R. 286.

<sup>2</sup> [1961] Ex. C.R. 388.

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

reason of the fact that it had to do with shape or configuration. In that case, the industrial design was known as a "transparent acetate blister" used for the ornamental display of its contents consisting of bows and ribbons for tying and decorating wrapped articles. As the question that I am considering did not arise in that case, the decision is not of assistance. However, it is fair comment that that was an obvious case in which to attack the validity of the registration if there is any basis for the defendants' contention.

Finally, reference was made to a judgment of Chief Justice McRuer of the Ontario High Court delivered on May 25 of this year in *Eldon Industries Inc., et al. v. Reliable Toy Company, Ltd., et al.* (unreported). This was an action for the copying of the design of the plaintiffs' toy trucks. There was no registered design and no action for infringement of registered design but an argument had been put forward that the plaintiffs were entitled to recover for infringement of copyright. Chief Justice McRuer held that the claim in copyright was not open to the plaintiffs on the pleadings but held, in any event, that an action for infringement of copyright would have been barred by section 46 of the *Copyright Act* as the drawings for the truck would have been registrable as an industrial design under the *Industrial Design and Union Label Act*. After referring to section 11 of the *Industrial Designs Act*, Chief Justice McRuer referred to the fact that there had been observations in cases that have indicated a judicial view (although not a finding) that an industrial design does not include mere configuration although configuration is included under the definition of "industrial design" in the English Act, and he said: "There is considerable strength lent to the argument that configuration is not within the Canadian Act by the confused language used in section 11". Chief Justice McRuer then said, "However, I do not see much difficulty in interpreting section 11 in such a way that the Act would include a charming design, to take the illustration of a vase. The design has to be created; it may be distinctive and charming, and it is intended to be put on the market commercially by multiple production. It is hard for me to believe that that could not be registered as an industrial design that has been applied to the manufacture of that article. First you have a design, and in order



to manufacture an article you must apply the design to the article. It seems to me strange to suggest that the *Industrial Design Act* merely applies to some form of ornamentation applied to an article, that is, to the exterior of the article in the manufacture or after it has been manufactured—for example, if you ornamented the handle of a pitcher, that design might be registered but you could not register the graceful handle of the pitcher as a design; or if you had a scroll or etching that was to be applied to a beautiful vase, you could register the etching but you could not register the design of the vase. That may be the interpretation of it, but I hesitate so to find.”

I have now examined all of the authorities upon which counsel for the defendants relied in support of his first two attacks upon the registrability of the plaintiff company’s design and, as I have indicated, I am satisfied that none has established that a design applicable to the ornamenting of an article of manufacture by reference to shape or configuration is not good subject matter for design registration under the Canadian Act. As indicated before I started the review of the Canadian authorities, I am satisfied that the plaintiff company’s design is a design applicable to the ornamenting of an article and is not a claim to an article itself within the meaning of the authorities. I therefore reject the first two attacks made by the defendants upon the validity of the plaintiff company’s registered design.

The defendants’ third attack on the validity of the plaintiff company’s design registration is the contention that the design was not original.

It has, of course, been established that “To be entitled to registration the ‘design’ must be original”. See *Clatworthy & Son, Limited v. Dale Display Fixtures Limited*<sup>1</sup>.

The plaintiff company’s registered design is described in the Certificate of Registration as being an “industrial design” for a “Chesterfield Sofa” characterized by

- (a) an elongated seat member, rectangular in form, having upwardly divergent, tapering, gently rounded arm members,
- (b) a back consisting of
  - (i) a shallow portion, and

1964  
 CIMENT LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 Jackett P.

<sup>1</sup> [1929] S.C.R. 429 at 431.

1964

CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*

Jackett P.  
 ———

(ii) an elongated oval portion spaced thereabove, the upper edge of the shallow portion extending in a gentle downward curve from the top of one arm to the top of the other arm, said upper edge being nearly even with the top of the seat member at the middle of the said shallow portion, and

(c) four downwardly depending legs.

This description is followed by the words "as per the annexed pattern and application" and the "pattern" annexed is the photograph of a chesterfield a copy of which is reproduced earlier in these reasons.

As indicated earlier in this judgment, I have some doubt as to whether a photograph of a sofa to the ornamenting of which the design has been applied is a "drawing" of the design as required by the first few sections of the *Industrial Design and Union Label Act*. If there had been a proper drawing of the design, it would probably have been a little more informative as to precisely what the design consisted of. Nevertheless, the parties, as well as the Commissioner of Patents, have accepted such a photograph as being an adequate "drawing" in this case and I must therefore do the best I can in the circumstances. Obviously, the sofa reproduced in the photograph is not the "design". It is a sofa to the ornamenting of which the design has been applied. I must therefore use my common sense and general knowledge to determine, when reading the description and looking at the photograph, just what the design consists of.

Obviously, a sofa has existed for many years as a piece of furniture having a bench for sitting on, a back for leaning against, two arms, and legs. There is, therefore, nothing original about the fact that this particular piece of furniture has all those component parts. Furthermore, one glance at the legs of the sofa in the photograph makes it quite clear that there is nothing original about the legs of the particular sofa. Indeed, there would appear to be no doubt that the novelty of the sofa in the photograph is the peculiar shape or configuration of the back and the arms. The registered design therefore, in my view, consists of a design applicable to the ornamenting of a four-legged sofa by creating its arms and back in the shape and configuration illustrated by the arms and back of the sofa in the photograph. In my judgment, the distinctive feature

of the design is an oval-shaped back (having the appearance of being "free" of the balance of the sofa, or "floating", although it is, of course, attached) made to harmonize with the "almost uninterrupted flow" of the lines of the seat and arms, the arms having been constructed as slight curves at angles of about 60 degrees from the line of the seat.

The defendants' counsel based his submission that the design was not original upon a comparison of the plaintiff company's design with the design of furniture which was in existence at some time prior to the registration of the plaintiff company's design, pictures of which were introduced as evidence, and the submission that the plaintiff company's design was a mere modification or development from the design of some one or more of such earlier pieces of furniture. While I am not prepared to reject the opinion of one of the expert witnesses that the design in question had its origin in certain furniture known as "Empire" furniture (although I must confess that it is not apparent to my eye), after giving the matter the most anxious consideration, and utilizing the assistance that was given to me by expert witnesses appearing for both sides, it still seems obvious to me that there is such a radical difference between the design that is the subject matter of the registration and the design of any of the other furniture to which my attention was drawn that I have no alternative but to reject the submission that the design was not original.

The one remaining ground upon which the defendants base an attack on the plaintiff company's monopoly rights under the statute is their contention that the plaintiff company has failed to comply with the marking requirements of section 14 of the Act, which reads as follows:

14. (1) In order that any design may be protected, it shall be registered within one year from the publication thereof in Canada, and, after registration, the name of the proprietor shall appear upon the article to which his design applies by being marked, if the manufacture is a woven fabric, on one end thereof, together with the letters *Rd.*, and, if the manufacture is of any other substance, with the letters *Rd.*, and the year of registration at the edge or upon any convenient part thereof.

(2) The mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label with the proper marks thereon.

1964  
 SIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

1964  
 CIMENT LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.

In the absence of some authority on the subject, I should have had some doubt as to whether section 14 attaches to the failure to comply with the marking provisions contained therein, in respect of every single article manufactured in accordance with the design, the somewhat drastic consequence of automatic forfeiture of all rights in respect of the registered design. The section does not so state in so many words unless the words at the beginning of the section, "In order that any design may be protected", are applicable not only to the requirements that the design "be registered within one year from the publication thereof in Canada" but also to the marking provisions to be found in the rest of subsection (1). I should, myself, have doubted that the subsection bears that interpretation and, in this connection, I refer to section 23 of chapter 22 of the Statutes of Canada of 1879, which, subject to an immaterial amendment made by chapter 28 of the Statutes of 1923, would appear to be the form in which the section was last enacted by Parliament (as opposed to having been reconstructed by a statute revision commission). Section 23 read as follows:

23. Every design to be protected must be registered before publication; and, after registration, the name of the proprietor, who must be a resident of Canada, shall appear upon the article to which his design applies; if the manufacture be a woven fabric, by printing upon one end; if another substance, at the edge or upon any convenient part, the letters Rd., with the mention of the year of the registration; the mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label containing the proper marks.

In case of ambiguity arising from the work of a statute revision commission, I should myself have thought that it is legitimate to refer back to the form of the legislation in which it was enacted by Parliament. I am, however, aware that in *Allaire v. Hobbs*<sup>1</sup>, this Court held, without discussing this question, that failure to comply with the marking provisions of section 14 terminates the rights of the proprietor of the registered design.

I come, therefore, to the contention of the defendants under section 14 upon the facts of this case. It is established by the evidence that the plaintiff company did attach to every sofa made in accordance with the registered design a label reading as follows:

<sup>1</sup> [1948] Ex. C.R. 171.

C I M O N  
D E S I G N  
Rd 1962

1964  
}  
C I M O N L T D .  
et al.  
v.  
B E N C H  
M A D E  
F U R N I T U R E  
C O R P . et al.  
J a c k e t t P .  
—

In addition, the plaintiff attached to each of the sofas at two different places a label which, among other things, had printed on it "Cimon Limited". These latter labels were attached to an entirely different part of the sofa than the part of the sofa where the label quoted above was attached. The defendants' counsel submitted that the label quoted above did not comply with section 14 because the proprietor's name was "Cimon Limited" and not "Cimon". Having regard to the evidence that the plaintiff company was generally known in trade circles as "Cimon", I am of the view that the label quoted above is a sufficient compliance with section 14. The obvious reason for the requirement in section 14 is to warn a person who might be thinking of using the design of an article bearing the label that it is registered and to inform him of the name of the proprietor of the design. Knowing the name of the proprietor, such a person might check the validity of the claim that the sofa was registered and might, if so inclined, negotiate with the proprietor for a licence. Whether that be the purpose for requiring that the name of the proprietor be attached to the article or not, it must be sufficient that the name be such that it communicates to those who might be interested, who, in fact, the proprietor is. I am satisfied that, in furniture circles in Canada, the word "Cimon" would indicate the plaintiff company and that, therefore, there was compliance with the requirements of the section. I reject the contention that section 14 was not complied with.

With regard to infringement, there is no doubt that each of the defendants has been a party to the manufacture or sale of one or more chesterfield sofas and chesterfield chairs, the designs of which had their origins in a deliberate act of copying the design of the Cimon sofa that is the subject matter of the registered design. It is true that there are certain differences between the registered design and the designs of the alleged infringing articles. In my view, however, comparing the articles as best I can with the aid of the expert testimony, there is no doubt that the design of the sofas produced by the defendants is the plaintiff

1964  
 CIMON LTD.  
 et al.  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. et al.  
 Jakkett P.

company's registered design and, if it is not, it is certainly "a fraudulent imitation thereof". No matter how often my attention was drawn to the many differences between the construction of the alleged infringing sofas and the construction of the sofa created by the plaintiff company pursuant to its design, there has never been any doubt in my mind that the sofas produced by the defendants were designed to look as much like the plaintiff company's sofa as possible. From the point of view of appearance, the fact that the one sofa was made with a tight seat and the other with a removeable cushion is quite irrelevant. The fact that that difference led to the omission of the shallow back, in my view, merely gave the defendants' sofa the appearance of a rather awkward effort to do the same thing as was accomplished by making the plaintiff company's sofa. The addition of buttons to the upholstery, the enlarging of the walnut applique on the front and the use of somewhat different legs and back support structure do not in any way detract from the fact that the one sofa is a rather cheap looking edition of the other. I need say nothing with reference to the design of the defendants' chesterfield chairs as, during argument, counsel for the plaintiffs abandoned the claim that the defendants' chairs constituted infringement of the registered industrial design.

During argument, counsel for the plaintiff company made it clear also that, in the event that the plaintiff company is successful in its claim for infringement of its registered design, the only relief that it is seeking is damages, the amount of which is to be determined upon a reference, and an injunction. Under section 15 of the *Industrial Design and Union Label Act* the plaintiff company, as proprietor of the registered design that has been infringed, is entitled to the damages that it has sustained by reason of the infringement. There is no provision in the statute for an injunction but I am satisfied that this is a proper case for an injunction and that the Court has jurisdiction to grant it under section 21 of the *Exchequer Court Act*. See *Findlay v. The Ottawa Furnace and Foundry Company*<sup>1</sup>. In respect of the claim for infringement of the registered industrial design, there will be judgment for the plaintiff company against both defendants for an injunction

<sup>1</sup> (1902) 7 Ex. C.R. 338 at 349.

and damages. The amount of the damages is to be determined upon a reference. If there is any difficulty in settling the terms of the judgment, the matter may be spoken to.

In view of my determination that the plaintiff company's design was capable of being registered under the *Industrial Design and Union Label Act* and the plaintiffs' concession concerning the operation of section 46 of the *Copyright Act*, the plaintiffs' claim for infringement of copyright is dismissed.

The plaintiff company's claim under section 7 of the *Trade Marks Act*, which was abandoned at the commencement of the argument, is dismissed.

The plaintiffs will have the costs of the action except that portion thereof attributable exclusively to the claim under the *Trade Marks Act*. The defendants will have the costs of that portion of the action attributable exclusively to the claim under the *Trade Marks Act*. To facilitate the taxation of costs, I may say that I am of opinion that the portion of the trial that was attributable exclusively to the claim under the *Trade Marks Act* amounted in all to one-half day.

*Judgment accordingly.*

1964  
 CIMON LTD.  
*et al.*  
 v.  
 BENCH  
 MADE  
 FURNITURE  
 CORP. *et al.*  
 Jackett P.