

# **INTELLECTUAL PROPERTY LAW CASE NOTES**



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Sample

## ***Malleys Ltd v J W Tomlin Pty Ltd* [1961] HCA 77; (1994) 180 CLR 120 (30 November 1961)**

### **- Court details**

High Court of Australia.

### **- Procedural history**

The respondent, J W Tomlin (who was the plaintiff in the suit) obtained registration of a design in “Bottom for toilet pan” under the *Commonwealth Designs Act 1906* in 1957. The primary judge, McLelland CJ in Eq., found that the registration of this design was valid and that this design was infringed by the appellant, Malleys (the defendant in the suit). McLelland CJ in Eq. granted an injunction and ordered an inquiry into damages. However, the appellant appealed from this decree and called into question the findings of McLelland CJ in Eq. in this High Court case.

### **- Facts**

The representation of the design depicted on the certificate of registration shows three views, each in the form of a diagram, of what appears to be a round piece of metal. The toilet pan design was represented diagrammatically in views from above, below and a side cross-section.<sup>1</sup>

However, no dimensions were specified in the registration. The Court drew conclusions about the relative sizes of various parts relative to other parts of the design as depicted on the representation of the design.<sup>2</sup>

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<sup>1</sup> *Malleys Ltd v J W Tomlin Pty Ltd* [1961] HCA 77; (1994) 180 CLR 120 (30 November 1961) (“*Malleys*”), 2.

<sup>2</sup> *Ibid.*

A new or original design may be registered by virtue of sections 4 and 17 of the *Designs Act 1906* applicable to the shape or configuration of an article which has not yet been published in Australia.<sup>3</sup>

McLelland CJ in *Eq.* found that before the respondent's application for registration of the design, any bottom for a toilet pan had not been made in respect to the shape described in the design nor had there been any earlier publication or description of the bottom of a toilet pan of this shape.<sup>4</sup> However, the appellant argued that an arrangement of the three sections of the design was not indicated with any precision, and accordingly that the "design" was too vague to be registered as a design.<sup>5</sup>

### - Issues

The principal issue in this case is whether or not the design was registrable. This issue turns on the further issue of whether the dimensions of the product, in respect of which design rights were claimed by J W Tomlin, were disclosed with precision in order to be capable of registration as a design.<sup>6</sup> This further issue was put differently in the form of the appellant's argument that:

*any person inspecting the certificate of registration, although shown the features of the design, could not know the extent to which a different arrangement of those features would be protected by the registration of the design.*<sup>7</sup>

Justices Taylor, Menzies and Owen reasoned that the answer to these issues lies "in the recognition of what is essential to distinguish a design from a mere shape."<sup>8</sup>

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<sup>3</sup> *Malleys*, 3.

<sup>4</sup> *Malleys*, 4.

<sup>5</sup> *Ibid.*

<sup>6</sup> *Ibid.*

<sup>7</sup> *Ibid.*

<sup>8</sup> *Ibid.*

## - Reasoning / Decision (commentary)

### Elements of a design

The Court's reasoning stems from the proposition that "every shape is not a design".<sup>9</sup> It was reasoned that, in order for a shape to be a design, the following elements must be satisfied:

1. There must be "sufficient individuality of appearance"; and
2. The existence of the sufficient individuality of appearance must be "determined by the eye and not by measuring dimensions".<sup>10</sup>

Accordingly, it was reasoned that a fundamental feature of a design is its shape or configuration as it appears to the eye and therefore not the precision of a "working drawing".<sup>11</sup>



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<sup>9</sup> *Malley's*, 4.

<sup>10</sup> *Ibid.*

<sup>11</sup> *Ibid.*