



“...creating your IP solutions”

Dimitrios G Eliades

Barrister - B Th. LLB LLM

Level 5
Bank of N.S.W Chambers
22 Queen Street
Brisbane QLD 4003

P.O Box 13375
George Street P.O 4003

deliades@qldbar.asn.au
Fax: (07) 3211 0021
Ph: (07) 3211 0020
Mobile: 0414 304 446
www.odyssey.ez.ro



FEDERAL COURT OF AUSTRALIA

Designs - massage device - infringement - application of the design - obvious imitation - essential features of the design - directions for consumer construction provided with device

Foggin v Lacey [2003] FCAFC 147 (Moore, Emmett & Bennett JJ, 30 June 2003)

This is an encouraging decision for intellectual property owners. As designs concern the aesthetic aspects of an item, variations to the appearance have historically been found to avoid the statutory monopoly of the registered design. The design owner succeeded on appeal in this matter.

This case raised an interesting issue. The competing product clearly didn't infringe the registered design at point of sale, but did, it was found, infringe after the ultimate buyer manipulated the device in accordance with directions accompanying the device. Emmett J dissented as he considered the directions may have in theory produced results that would not have been an application of the design or a fraudulent or obvious imitation.

Background

This case concerned a non electrical head massage device registered under the *Designs Act* (Cth) 1906 (the design).

The reasons appear at <http://www.austlii.edu.au/au/cases/cth/FCAFC/2003/147.html> and a diagram of the design is at [2].

The applicant (Lacey) owned the design, which was marketed as “Orgasmatron”. The respondent (Foggin) sold a massage device called the “Shiver Me Timbers!” head massager.

The primary judge

The determination of the primary judge is reported at: *Lacey v Foggin* (2002) 56 IPR 436.

The primary judge described the significant visual features of the Design as:

- a cage, or inverted wine glass, effect;
- stalk-like handle shape to which the prongs were attached; and
- centripetal tendency of the ends of the prongs.

“Shiver Me Timbers!” was sold as a handle to which were attached 8 prongs extending in a straight line from the handle. Directions were included.

His Honour concluded that if, as he found was the case here, a usual method of following the directions would result in something only trivially different from the design or if the infringing article could, in the ordinary course of events, be manipulated so as to correspond sufficiently with the design, there was infringement by reason of the application of the design (*Schmitzhe v Roberts* (1955) 72 RPC 122 at 125).

The Full Court

The Full Court considered that infringement was determined by a visual comparison between the registered design and the allegedly infringing article. They considered that it was possible to take the salient features of a design, but still produce a design distinct from the registered design (*Firmagroup Australia Pty Limited v Byrne & Davidson Doors (Vic) Pty Limited* (1987) 180 CLR 483 at 488-489).

Relevantly, the Full Court (in the joint reasons of Moore and Bennett JJ), considered that:-

- If, to the eye, the shapes of the design and the article were substantially the same, there was infringement (*Malleys Ltd v J W Tomlin Pty Limited* (1961) 180 CLR 120 at 123;
- It was for the court to rule on the meaning of the design and the question of infringement, as determined by reference to the eye of the consumer (*Dart Industries Inc v Decor Corporation Pty Ltd* (1989) 15 IPR 403 at 408-409 per Lockhart J;
- In relation to the eye of the consumer, the decision of the trial judge was to be given particular weight, in the absence of a demonstrated error (*Dart* (at 412));
- The comparison between the designs should be between the registered design and the competing design in its condition after the directions were followed.

Decision

The Full Court found that the design was validly registered and the Foggin device infringed the design (Moore and Bennett JJ; Emmett J dissenting).

In particular, the article obtained after following the directions did have each of the significant visual features described by the primary judge. The only difference was the introduction by reason of the directions, of the two angles in each prong.

Accordingly, the appeal was dismissed with costs.