

EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2019

ONE FOUR HOUR PAPER (240 MINUTES)

EXAMINER: H VAN SCHALKWYK

MODERATOR: L CILLIERS

THIS PAPER CONSISTS OF NINE (9) PAGES (INCLUDING THE COVER PAGE)

PLEASE WRITE LEGIBLY

1. QUESTION 1

Joe Clog contacted you for advice regarding his design. He has created plastic clogs which he has found to be perfect to wear on boats. The clogs are soft so that they don't cause any damage to the boat and, because they are entirely made from plastic, they are water resistant and quick to dry. Mr Clog shows a picture of his plastic clog, which is included below as Figure 1.

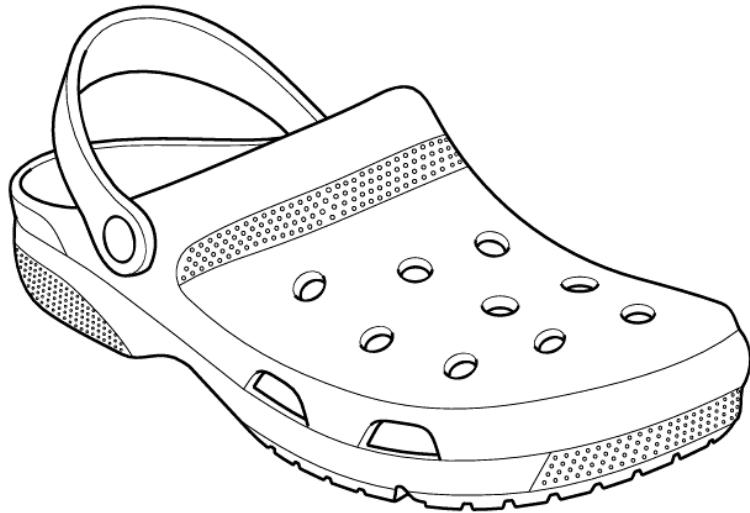


Figure 1 - Illustration of Mr Clog's plastic clog

- 1.1. Mr Clog is aware that South African design law distinguishes between aesthetic designs and functional designs. He mentioned that this is somewhat confusing to him considering that his clogs are functionally superior to other boat shoes for the reasons given above. Advise Mr Clog on whether to file an aesthetic or functional design. In your answer include the definition of each.

(5)

1.2. Mr Clog further mentions that in the US he simply had to claim protection for the ornamental design of the clogs. Advise Mr Clog on the protectable features of a design in South Africa and the interpretation that you would give to each feature.

(5)

1.3. Mr Clog further advises you that, due to the clogs being manufactured exclusively from plastic, he can easily produce them in a wide range of colours. He is concerned that he would have to file multiple applications to protect all of the different colours. Advise him on the role of colour in a design and whether multiple applications would be required.

(3)

In a consultation with Mr Clog earlier in June 2019 you learned that the clogs were first launched at a boat show in Florida, United States on 1 November 2018. The clogs were an instant hit and he started selling his clogs throughout the US on 1 February 2019. Mr Clog filed a US design application on 1 April 2019. His clogs have gained some popularity globally and he is now concerned about competitors entering the South African market.

1.4. Advise Mr Clog on whether or not the clogs meet the novelty requirement as set out in the South African Designs Act.

(5)

1.5. Mr Clog has heard that there are some disclosures that do not destroy the novelty of the design and would like to know what these are and whether the launch of his clogs at the foreign boat show is perhaps one of these exclusions. Advise Mr Clog.

(5)

1.6. It has subsequently come to light that the reason Mr Clog wants to file urgently in South Africa is that there is a local company that is currently selling knock-offs of his clogs. Your research shows that the local company started selling their clogs on 1 March 2019. Assuming that the disclosure on 1 November 2018 was not novelty destroying, advise Mr Clog on the enforceability of his eventual registered design against the competitor. How would your answer have differed if the competitor had not already started selling their products but had already set up a small factory to make the products?

(7)

1.7. Mr Clog further mentions to you that, although it is not his style, he has noticed that in some parts of the country customers prefer wearing socks with their clogs. He is therefore considering launching a brand of socks. He thinks that it would be a wonderful idea to use local decorative patterns that he has seen while travelling through South Africa. Mr Clog thinks that this is a great idea as it would give a true African feel to the socks, something which he believes would appeal to his US and European customers too. Advise Mr Clog on the filing of a South African design application directed to the socks. In your answer, provide the definitions of an indigenous design and a derivative indigenous design, and provide the registration requirements for the one applicable to Mr Clog's socks.

(10)

2. QUESTION 2

- 2.1. Your client would like to start producing a baby carrier almost identical to the one being sold by another manufacturer, which is only a start-up and therefore cannot satisfy the market like your client can. The freedom to operate searches you've conducted did not reveal any registered form of IP, including no design rights. Advise your client on whether or not they can launch a baby carrier into the market without fear of infringing any rights of their competitor. (No consideration should be given to trade mark rights or common law rights)

(5)

- 2.2. Your client eventually decides to redesign the baby carrier in order to create one that has greater visual appeal. Following your advice your client filed a design application on 15 April 2019 claiming a release date of 1 March 2019. You filed the signed Form D3 at the time of filing and requested expedited registration, which took place on 15 May 2019. Publication in the Patent Journal is scheduled to take place on 31 July 2019.

- 2.2.1. Is the design enforceable against potential infringers?
- 2.2.2. What is the effective date of registration of the design?
- 2.2.3. When will the first renewal fee be payable?
- 2.2.4. When will the design expire?

(5)

3. QUESTION 3

One of your clients recently heard about registered designs but after reading up on design rights on a few websites cannot quite figure out whether it is a suitable form of protection for his type of business. Your client informs you that they design icons for use on digital devices such as cellular telephones, tablets, PC's and just about any device that has a touchscreen. In many instances they create a range of icons according to a particular theme, which results in a similarity of design features across the range of icons.

- 3.1. Advise your client on the registrability of digital icons in terms of the South African design law.

(5)

- 3.2. Taking into consideration that the icons only appear after switching on the device, advise your client on whether the icons meet the intrinsic requirements as set out in the definition of an aesthetic design.

(3)

- 3.3. Assuming that your client would like to proceed with design protection, advise on a filing strategy in order to obtain protection for the icons.

(5)

4. QUESTION 4

You receive an email from an old client of yours who is a jeweller. You assisted her a few years ago to register a design for the necklace shown in Figure 2 below. In the email your client mentions that while browsing through Instagram she came across the design of an armband shown in Figure 3 below. Your client instructs you to send the alleged infringer an email threatening them with infringement proceeding if they do not immediately delete all images of the armband from their Instagram account.

- 4.1. With reference to the applicable sections in the Designs Act, advise your client on whether or not her proposed course of action is advisable and take into account any possible recourse the other party might have.

(7)

- 4.2. After advising your client in 4.1 above, she is concerned about the possible revocation of her design. Advise your client on the grounds for revocation of a South African registered design.

(5)

4.3. Irrespective of your answer in 4.1 above, you inspect the designs register and noticed that the design is registered in class 12 (which covers means of transport or hoisting) instead of class 11 (which covers articles of adornment). After getting over the initial shock upon noticing this error you start reviewing your file and discover that your instruction sheet to your secretary indicated the correct class and that there must have been a typo at the time of filing the application. Explain whether it is possible to change the class and, if so, the procedure that you will follow.

(7)

Assuming that the design is now registered correctly in class 11, you obtain the following information form the official register and file at CIPC:

The proprietor is Jeweller (Pty) Ltd. No assignment has been recorded but a licence has been recorded in favour of Licensee (Pty) Ltd.

The registered design is in force considering that all renewal fees due have been paid.

The design is registered in Part A of the register.

The definitive statement reads as follows:

"The features for which protection is claimed reside in the shape and configuration of a piece of jewellery and/or the pattern and ornamentation of the piece of jewellery substantially as shown in the accompanying representations."

- 4.4. Upon reviewing the definitive statement you are considering making some amendments prior to sending a letter of demand. In each of the following instances indicate whether the proposed amendment is allowable:

Changing “shape and configuration of a piece of jewellery and/or the pattern and ornamentation of the piece of jewellery” to “shape or configuration of a piece of jewellery” only.

The inclusion of the following phrase at the end of the definitive statement: “irrespective of the ornamentation resulting from any diamonds or diamond-like elements being applied to the piece of jewellery”

(3)

- 4.5. You decide against making any of the amendments in 4.4. above and instead decide to retain the definitive statement as it appears on the register sheet. You have however conducted a prior art search and the closest prior art that you could find is the necklace as shown in Figure 4 below. Provide your client with an opinion on whether or not the armband of Figure 3 infringes the registered design of Figure 2. Cite case law where appropriate.

(15)

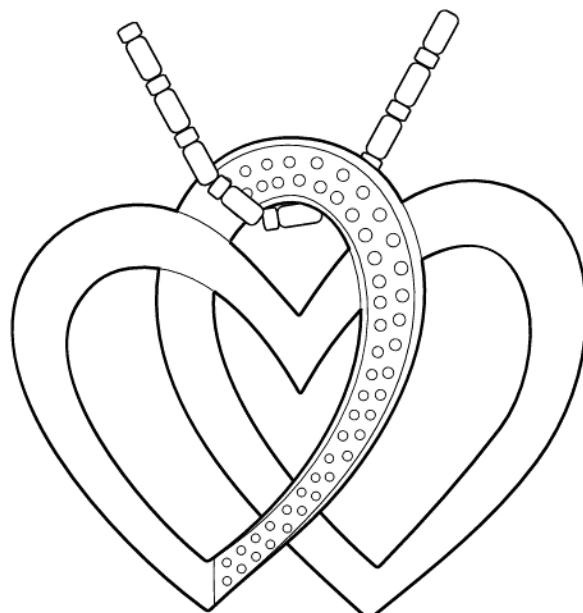


FIGURE 2: REGISTERED DESIGN

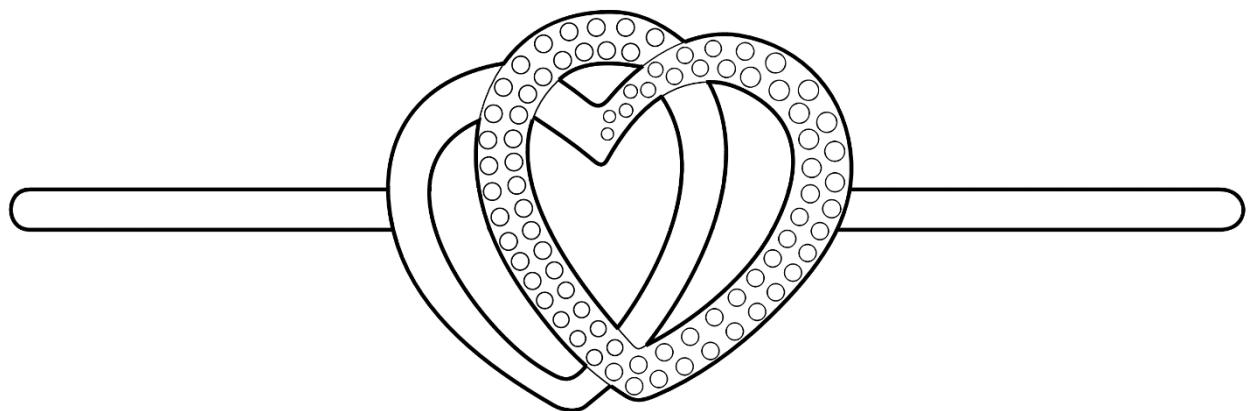


FIGURE 3: ALLEGEDLY INFRINGING PRODUCT



FIGURE 4: PRIOR ART

TOTAL MARKS: 100

- END OF PAPER -