

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2023 – GROUP 1(c)

Paper 1 of 1

29 June 2023

Examiner: C. Jackson

Moderator: H. van Schalkwyk

Time: 4 Hours (240 minutes)

Total marks: 100

This paper consists of 15 pages (including this cover page and 2 annexures marked “A” and “B”, respectively)

Instructions:

- This is a **closed-book examination**. No study or reference material is allowed into the examination venue.
- Answer all the questions.
- Write legibly. Answers that cannot be read will not be awarded marks.
- Answers for multiple choice questions 1 to 5 must state only the letter of the selected answer. Additional writing will result in a zero mark for the answer.
- All other answers must be answered using full sentences.

QUESTION 1

Your firm filed the application for South African Aesthetic Registered Design no. A2022/02846 on behalf of the proprietor. The South African application claims priority from United States Design Patent application no. 16/861,564 which was filed on 16 March 2021. The proprietor made the design available to the public on 10 June 2021. The application for A2022/02846 was filed in South Africa on 8 December 2022, and your firm received the notice of registration on 3 March 2023. Registration of A2022/02846 was published in the Patent Journal on 31 May 2023.

Choose the correct option out of (a) to (e) below:

- a. The first renewal fee for A2022/02846 falls due on or before 10 June 2024.
- b. The first renewal fee for A2022/02846 falls due on or before 16 March 2024.
- c. The first renewal fee for A2022/02846 falls due on or before 31 May 2026.
- d. The first renewal fee for A2022/02846 falls due on or before 8 December 2025.
- e. The first renewal fee for A2022/02846 falls due on or before 3 March 2026.

(3)

QUESTION 2

Your firm filed the application for South African Functional Registered Design no. F2022/01538 on behalf of the proprietor. The South African application claims priority from European Registered Community Design application no. 08962514-00001 which was filed on 12 May 2021, and which was published on 26 May 2021. The application for F2022/01538 was filed in South Africa on 10 November 2022, and your firm received the notice of registration on 15 February 2023. Registration of F2022/01538 was published in the Patent Journal on 26 April 2023.

Choose the correct option out of (a) to (f) below:

- a. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 15 February 2038.
- b. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 12 May 2036.
- c. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 10 November 2032.
- d. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 12 May 2031.

- e. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 26 April 2038.
- f. Assuming all renewal fees are paid, F2022/01538 will reach the end of its duration and expire on 26 May 2036.

(3)

QUESTION 3

Your firm filed the application for South African Functional Registered Design no. A2020/00889 on behalf of the proprietor. The South African application was filed on 10 March 2020 claiming no priority but declaring a release date of 12 September 2019. Notice of registration was received on 9 July 2020, and the registration was advertised in the Patent Journal on 26 August 2020.

Your firm is responsible for paying the renewal fees for A2020/00889 and, on the instruction received from the registered proprietor, paid the first renewal fee on 22 August 2022. Despite having sent several reminders, no further instructions to renew A2020/00889 have been forthcoming from your client.

When did A2020/00889 finally lapse, or when will A2020/00889 finally lapse, if no instructions can be obtained from the client, due to non-payment of renewal fees? Choose the correct option out of (a) to (j) below:

- a. A2020/00889 already lapsed on 10 March 2023.
- b. A2020/00889 will lapse on 10 September 2023.
- c. A2020/00889 will lapse on 12 September 2023.
- d. A2020/00889 already lapsed on 12 January 2023.
- e. A2020/00889 will lapse on 12 January 2024.
- f. A2020/00889 will lapse on 9 July 2023.
- g. A2020/00889 already lapsed on 9 Jan 2023.
- h. A2020/00889 will lapse on 12 March 2024.
- i. A2020/00889 will lapse on 22 August 2024.
- j. A2020/00889 will lapse on 26 August 2023.

(3)

QUESTION 4

Consider the following statements:

- i. A design shall be deemed to be new if it is different from or if it does not form part of the state of the art immediately before the date of application for registration thereof or the release date thereof, whichever is the earlier.
- ii. In the case of the release date thereof being the earlier, the design shall not be deemed to be new if an application for the registration of such design has not been lodged, in the case of an integrated circuit topography, a mask work or a series of mask works, within one year of such release date.
- iii. In the case of the release date thereof being the earlier, the design shall not be deemed to be new if an application for the registration of such design has not been lodged, in the case of any other design, within six months of the priority date.
- iv. The state of the art shall comprise (i.e. include) all matter that has been made available to the public in the Republic by written description, by use, or in any other way.
- v. The state of the art shall comprise (i.e. include) all matter contained in an application for the registration of a design in the Republic of which the date of application in the Republic is earlier than the date of application or the release date of the later design.
- vi. The state of the art shall comprise (i.e. include) all matter contained in an application in a convention country for the registration of a design of which the date of application in the convention country is earlier than the date of application or the release date of the later design.

Which of statement(s) (i) to (vi) is/are entirely true? Choose the correct option from (a) to (f) below:

- a. All of statements (i) to (vi).
- b. None of statements (i) to (vi).
- c. Statement (i) and (v).
- d. Statement (i), (iii), and (v).
- e. Statement (v).
- f. Statement (iii) and (vi).

(3)

QUESTION 5

Consider the amendments shown below to the definitive statement. Text deletions are shown by struck-through text, and text additions are shown by underlined text.

- i. The features of the design for which protection is claimed are those of the shape ~~and/or~~ and configuration ~~and/or~~ and pattern ~~and/or~~ and ornamentation of a container, substantially as illustrated in the accompanying representations.
- ii. The features of the design for which protection is claimed are those of the shape ~~and~~ or configuration ~~and~~ or pattern ~~and~~ or ornamentation of a container, substantially as illustrated in the accompanying representations.
- iii. The features of the design for which protection is claimed are those of the shape and/or configuration and/or pattern and/or ornamentation of ~~a container~~ a crate, substantially as illustrated in the accompanying representations.
- iv. The features of the design for which protection is claimed are those of the shape and/or configuration and/or pattern and/or ornamentation of a chair, substantially as illustrated in the accompanying representations. ~~Arms marked "A" in the representations do not form part of the design and are disclaimed.~~
- v. The features of the design for which protection is claimed are those of the shape and/or configuration and/or pattern and/or ornamentation of a chair, substantially as illustrated in the accompanying representations. Arms marked "A" in the representations do not form part of the design and are disclaimed.

Answer the statements below regarding whether they are allowable or not after a design application has proceeded to registration. Choose the correct option out of (a) to (f) below:

- a. None of the above are allowable.
- b. The amendments to (i), (ii), and (iii) are allowable.
- c. The amendments to (i), (ii), and (v) are not allowable.
- d. Only the amendments to (ii) and (iv) are allowable.
- e. The amendments to (ii) and (v) are not allowable.
- f. Only the amendment to (iii) is not allowable.

Question 6

Your client has a “plastic timber” product, created from recycled plastic, as an alternative to wood. The plastic timber has various advantages, including that it does not require the maintenance that wooden timber would otherwise have required, like periodic sanding and varnishing. The plastic timber is used for outdoor items such as benches, fence poles, and patio furniture. Your client says that to the eye of the customer the plastic timber is indistinguishable from real pieces of wood. As proof, the client places a real piece of wood and a piece of his “plastic timber” before you and you are unable to tell the difference. Your client wishes to protect the appearance of his plastic timber. Advise your client as to whether or not it is protectable by means of a registered design and refer to relevant case law in your answer.

(6)

QUESTION 7

Your client is Fly Braais (Pty) Ltd (“Fly Braais”), and its sole director and shareholder is Jan Braai Junior. His father, Jan Braai Senior, is retired and keeps busy by designing braai gadgets. Jan Braai Senior has designed a new braai grid that can be tilted at various angles, but has no desire to commercialise the new braai grid himself and decided to approach Fly Braais to see whether a deal could be struck. Fly Braais (through Jan Braai Junior) has made a handshake agreement with Jan Braai Senior to manufacture and distribute the new braai grid and, in exchange, has paid Jan Braai Senior a once-off payment.

Explain whether or not Fly Braais may apply for the registration of the design?

(7)

QUESTION 8

What is the effect of a registered design?

(6)

QUESTION 9

Your client is the registered proprietor of South African registered design number A2017/10567. While consulting with you, your client alleges that a competitor is selling exact copies of articles as illustrated in their registered design in South Africa. The client is very upset. The product (i.e. the article to which the design is applied) forms the bedrock of his business and the business is suffering financial loss as a result of the copying. The thought of losing revenue and market share to his competitor (who happens to be his arch-nemesis) is furthermore causing the client tremendous

emotional hardship. He has had to have medical treatment for a stomach ulcer caused by the stress brought about by this situation. Your client describes the competitor as a shady businessman, who needs to be taught a lesson once and for all.

Your client wishes to bring legal action against the competitor for the infringement of his registered design, and wants to claim R10,000,000 (ten million Rand) from the competitor as punitive damages, and compensation for his emotional suffering, his medical expenses, and lost revenue.

Advise your client to what extent the Court may grant him the relief he seeks in proceedings for infringement of a South African registered design.

(7)

QUESTION 10

A prospective client consults with you about a logo that she has designed for a new clothing brand that her company is planning to launch soon. The client asked Chat-GPT how she should proceed to protect the logo. Other than trade marks and copyright, Chat-GPT also mentioned "industrial designs". After further probing questions, Chat-GPT told her that such "industrial designs" are filed in different classes and mentioned that (among others) she should consider class 32 which has the class heading "Graphic symbols and logos; surface patterns; ornamentation".

- A) Advise the client whether there may be any advantages to filing a registered design application in addition to applications for registered trade marks.
- B) Further advise the client of any advantages of a registered trade mark versus a registered design.
- C) Lastly, advise the client regarding Chat-GPT's suggestion that she file a registered design application in class 32.

(7)

QUESTION 11

The same client as in question 10 above proceeds to show you pictures of hand weights (dumbbells) she has designed, that have vibrant colours and with the grip being shaped to accommodate smaller hands more comfortably and securely. After you suggest that she files registered designs for them and have shared the costs involved with her, she goes home and asks Chat-GPT how to obtain copyright for the weights. Chat-GPT informs her that copyright automatically vests in certain works, and that one does not need to register copyright for most works. You receive a phone call from her

the next day during which she accuses you of being a shark attorney that is trying to milk her for fees by trying to get her to file registered designs when she automatically “gets copyright” for free.

Advise the client on the merits of her accusations.

(5)

QUESTION 12

Your client, a wine sommelier, arrives for a consultation and shows you photos of what he describes as a very cleverly designed bottle opener. The shape and configuration of the bottle opener enables one to extract the corks of old vintage bottles of wine without the old and brittle cork disintegrating, possibly spoiling the wine.

After some further discussion, it emerges that your client saw the bottle opener during his travels to Bordeaux, France about 10 months ago. However, he assures you that he has searched the Designs Register and that there are no South African registered designs for such a bottle opener. He also only knows of one other wine estate in South Africa that uses the same bottle opener, namely Schoongezuipt, who have apparently been using it for about 2 months.

Your client explains that yesterday he filed an application for a registered design application in South Africa himself for the bottle opener. That way, he can commercialise it in South Africa while preventing any other people from doing the same. He looks forward to the revenue he will get from royalties once he enforces his registered design against Schoongezuipt and forces them to enter into a licence agreement with him. He has already written to them threatening them with infringement proceedings.

Point out at least 5 problems with this scenario.

(10)

QUESTION 13

Give the definitions of:

- A) A functional design **(3)**
- B) An aesthetic design **(3)**
- C) A set of articles **(3)**
- D) A traditional design **(3)**

QUESTION 14

Provide the citation of South African case law that dealt with the following topics:

- A) The registrability of designs for vehicle spare parts (1)
- B) Registrability as an aesthetic design where functional features are present (1)
- C) Whether hand-made articles are registerable as registered designs (1)
- D) A definitive statement of the omnibus type (1)
- E) The measure of novelty vs the ambit of the monopoly of a registered design (1)
- F) A two-dimensional comparison of prior art and the representations of the registered design (1)
- G) Whether a design in one class can anticipate a design in another class (1)

QUESTION 15

Explain what the terms “original” and “not commonplace in the art in question” means in terms of the requirements for registrability of a design.

(2)

QUESTION 16

Your new client, ACME Design Studios (Pty) Ltd claims to be the “owner” of South African registered design number A2018/01537 of a beverage bottle. They tell you that the application was originally filed by a company called Test and Sons Corporations (Pty) Ltd, but that they acquired the rights to the registered design by means of a written assignment agreement executed on 20 February 2023. A drawing from the registered design is shown in Figure 1 below.

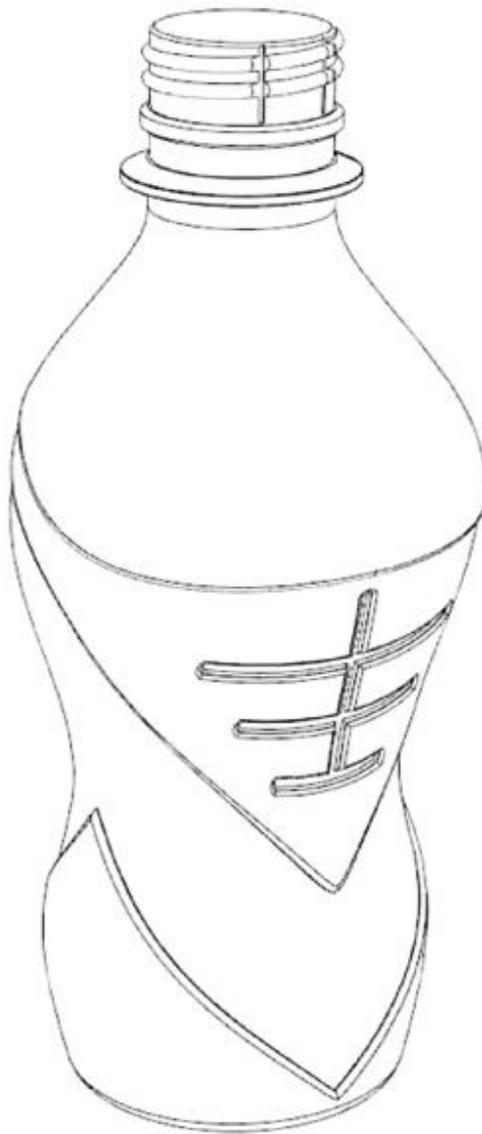


Figure 1: Registered design

A sports drink called “PRIDE” originating from the United States has just launched in South Africa and people are apparently lining up from the crack of dawn at retailers all over the country to get their hands on it at exorbitant prices. Your client considers the PRIDE bottle shown in Figure 2 to be substantially similar to their registered design and are considering whether to pursue legal action against the owners of PRIDE, and possibly also against some of the larger retailers.

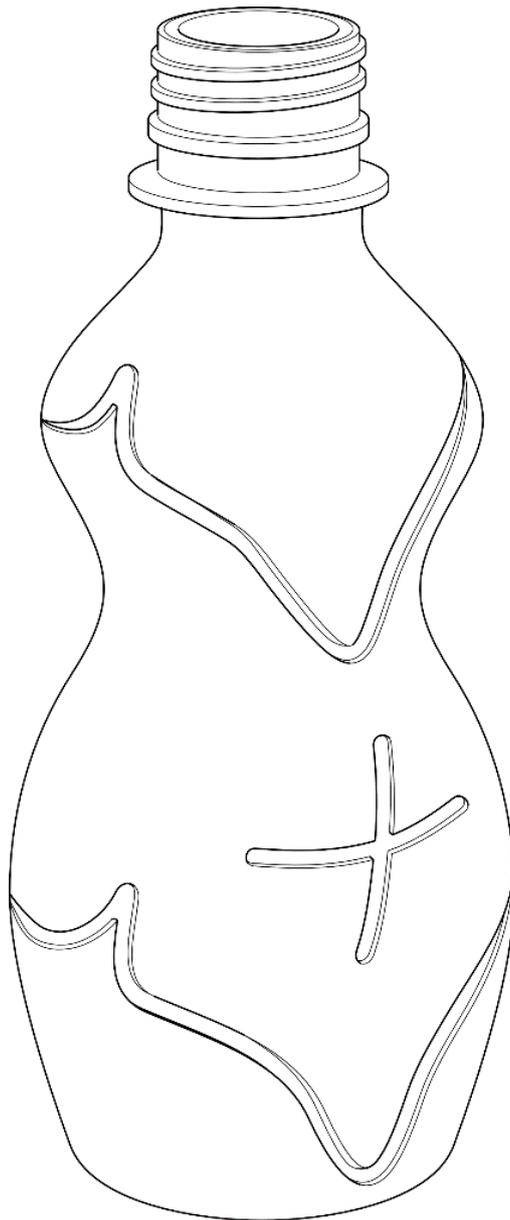


Figure 2: PRIDE bottle (allegedly infringing article)

As a first step you have obtained a copy of the designs register shown in Annexure “A”, as well as a copy of Form D6 shown in Annexure “B”. A prior art search also reveals the prior art bottle shown in Figure 3, which became available to the public on 1 January 2018.

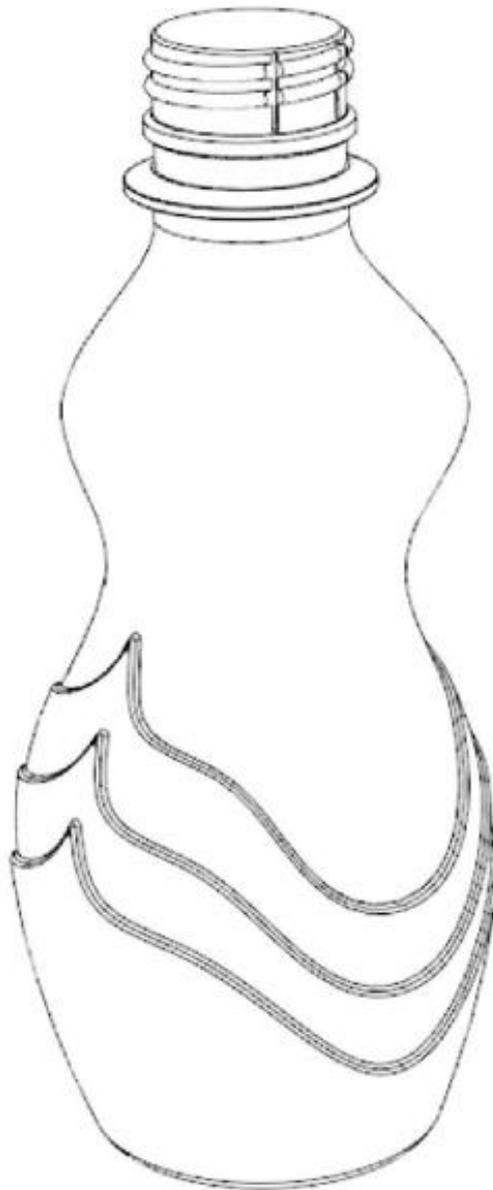


Figure 3: Closest prior art

In light of these facts, advise the client as to whether, in your opinion, the PRIDE bottle infringes A2018/01537, and whether they can take action against PRIDE and some of the larger retailers.

(16)

TOTAL: 100

Three annexure pages to follow

REPUBLIC OF SOUTH AFRICA

DESIGNS ACT, 1993

REGISTER OF DESIGNS

Official Application No:
A2018/01537

Date of Lodgement:
9 April 2018

Classification
09 (Containers including bottles)

Applicant(s):
TEST AND SONS CORPORATION (PTY) LTD
12 Church Street, Cape Town

Type of design Part A Part F

Release date (if applicable): N/A

PRIORITY CLAIMED	COUNTRY	NUMBER	DATE

Article to which design is to be applied: **BOTTLE**

ADDRESS FOR SERVICE

The IP Firm

Docex 11, Cape Town

P O Box 113, Cape Town

1001, South Africa

RENEWALS			
Year	Date Paid	Receipt	Penalty
4	15 February 2021	RD2021-00056	
5	20 April 2022	RD2022-02124	R82,00
6	5 March 2023	RD2023-00105	

Restoration				
Date applied for	Advertised	Opposed	Restored by	Date of restoration

Amendments and rectifications, etc.					
Document	Date	Advertisement date	Opposition date	Allowance/ refusal	Date

Licences, assignments, attachments, etc.			
Nature	In favour of	Date registered	Date cancelled

REPUBLIC OF SOUTH AFRICA

DESIGNS ACT, 1993

DEFINITIVE STATEMENT AND EXPLANATORY STATEMENT

(Regulation 15)

Official Application No:	Date of Lodgement:
A2018/01537	9 April 2018

Full name(s) of applicant(s):
TEST AND SONS CORPORATION (PTY) LTD

Classification: **09 (Containers including bottles)**Articles to which design is to be applied: **BOTTLE**Release date (if applicable): **N/A**Type of design Part A Part F

Definitive statement:

The features of the design for which protection is claimed are those of the shape and/or configuration and/or pattern and/or ornamentation of a bottle substantially as shown in the accompanying representations.

Explanatory statement:

(None)

Address for service:

The IP Firm

Docex 11, Cape Town

P O Box 113, Cape Town

1001, South Africa