

EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2021

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

QUESTIONS

Your client contacts you for advice on protecting the design of his acoustic guitar shown in Figure 1 below. Your client tells you that the design is radically different to anything on the market. He explains to you that his design philosophy is one of “form follows function” in that the design features are inspired by their function. For example, instead of the opening to the sound box being in the front panel as with traditional acoustic guitars, the opening to the sound box is located in the side of the guitar body for superior acoustics, such as increased projection, reduced feedback when plugged in and an amplified bass response. The guitar also has a cut-away on its underside to allow for superior access to the 22nd fret (i.e. to the part of the neck near the body) while playing.

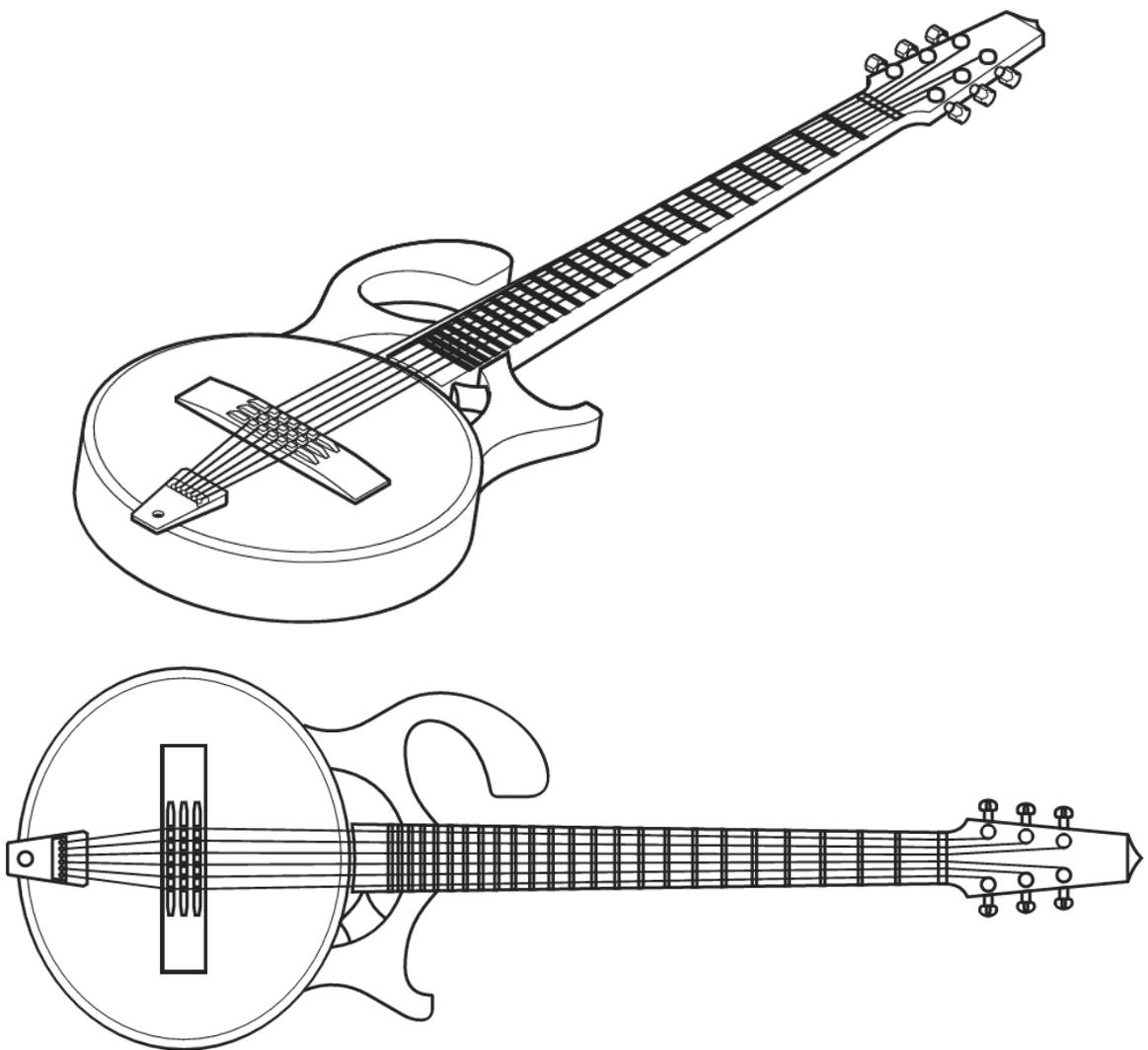


Figure 1 - Illustrations of your client's new guitar

1. Your client further advises that his guitars are handmade from local Kiaat hardwood and, accordingly, some customers describe them as wooden sculptures. Your client is of the view that the guitar can therefore be protected under copyright law. Advise your client on the suitability of relying on copyright law.

(5)

2. Assuming that your client has decided to seek registered design protection, advise your client on the type of design, i.e. aesthetic or functional, he should be filing. Give reasons explaining your answer.

(7)

3. Draft a definitive statement for the design shown in Figure 1. Also explain why you have opted to claim protection for those features included in the definitive statement.

(6)

4. Your client is concerned that his design may not be protectable under registered design law because the guitars are handmade. Advise your client on the requirements around the manner in which the articles are produced as set out in the Designs Act and advise him on whether or not the article in this instance meets these requirements.

(5)

5. Your client further tells you that he has already sold a few of the guitars of Figure 1. Advise your client under which circumstances the design shall still be deemed to be new in terms of the Designs Act.

(6)

During further discussions with your client it comes to light that he has a second guitar design based on many of the same design principles of the first design of Figure 1. This second design is shown in Figure 2. The guitar design of Figure 2 also has of an opening to the sound box located in the side of the guitar and, accordingly, achieves the same advantages as discussed above with reference to the first design of Figure 1.

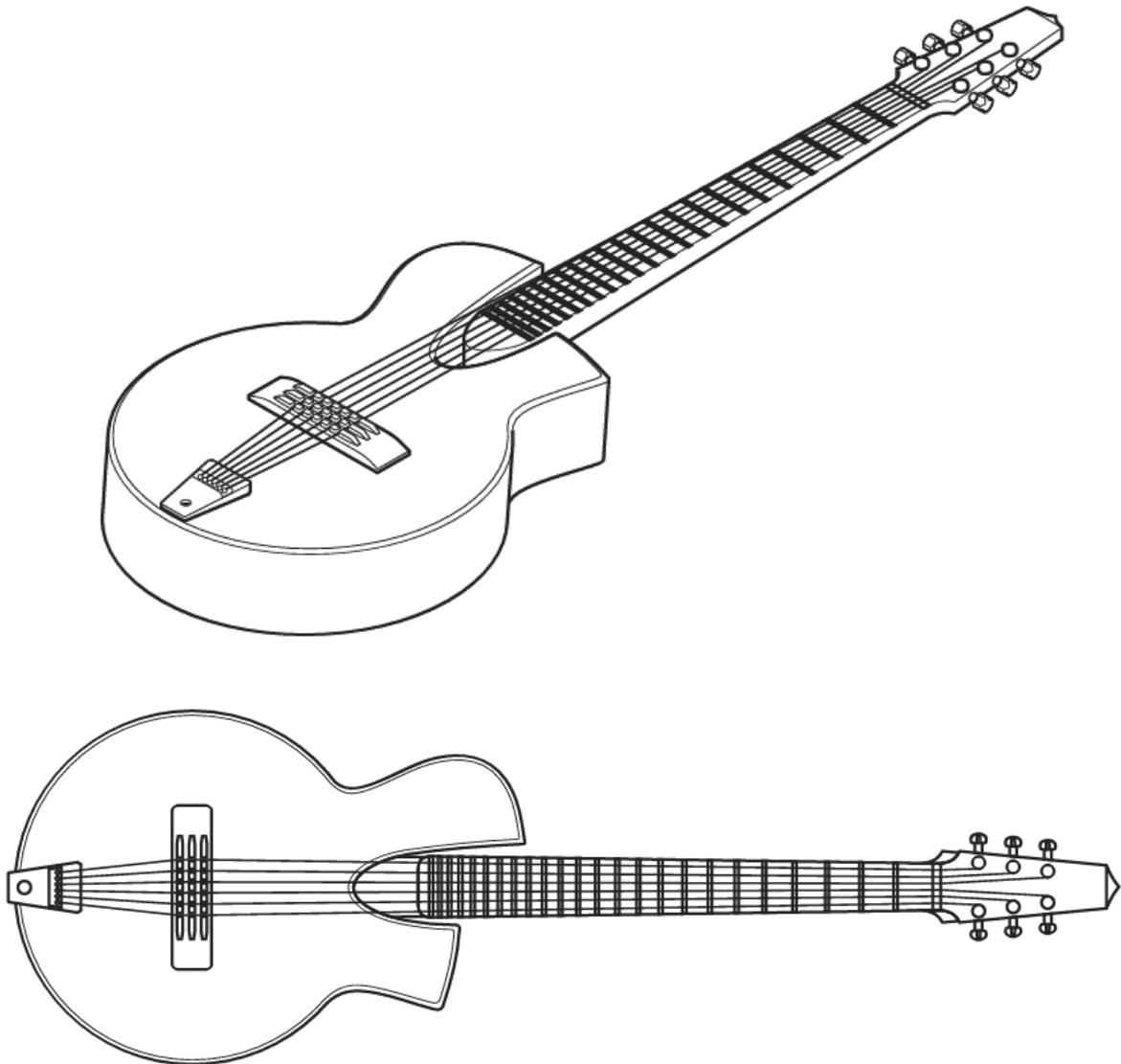


Figure 2 - Illustrations of your client's guitar according to the second design

6. Advise your client on whether or not the first and second designs of Figures 1 and 2 can be included in the same design application.

(10)

7. Your client is further concerned that someone else may already be working on a guitar design that is very similar if not identical to his designs. This is all based on rumours that he has picked up on an online blog but he has not yet seen this other design. Advise your client on the position should this other person release his/her design before or after the filing date of your client's application(s) for a registered design.

(8)

The same client sends you the logo shown in Figure 3 below.

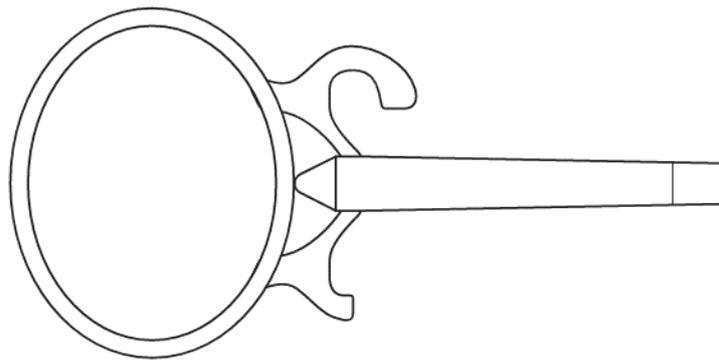


Figure 3 - Illustration of your client's logo

8. Advise your client on the registrability of the logo as a registered design.

(7)

9. Your client further tells you that, although he makes the guitars himself in his workshop, he is not too tech savvy and therefore used a design agency to create the logo for him. He has no contract with the agency and simply paid them for their services in designing the logo for him. Assuming that your client would like to proceed with the filing of a design application for the logo, advise your client on the ownership of the design.

(5)

Assume that your client has a registered design for the guitar design of Figure 1. The same client sends you the drawing of his latest design shown in Figure 4 below. The design of Figure 4 is based on the design of Figure 1 but is a silent version in that it does not have a sound box. The guitar of Figure 4 is intended to be played plugged in.

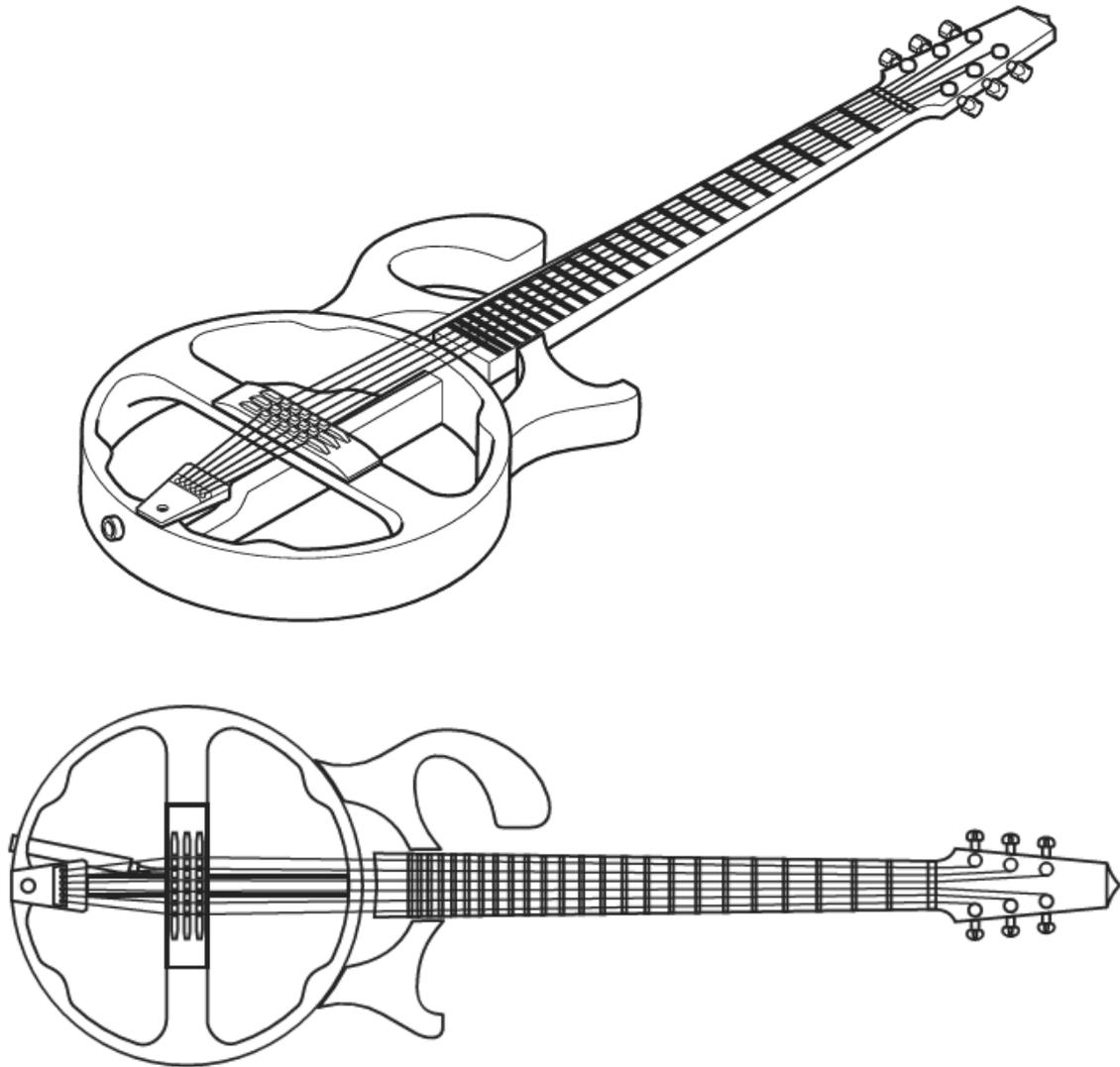


Figure 4 - Illustration of your client's latest design

10. Your client is of the view that, considering that the design of Figure 4 is based on the design of Figure 1 covered in his existing design registration, the drawings of the new design of Figure 4 can simply be added to the existing design registration.

- i) Advise your client on whether his existing design registration can be amended to include the drawings of the new design.
- ii) Advise your client on whether the scope of the existing design registration can be amended by disclaiming some of the features of the design of Figure 1 in order to extend protection to the design of Figure 4.
- iii) Would your answers above have differed if it was still a pending application?

(5)

11. After discussing your client's request in question 10 with him, you discover that the true reason for your client's request to include the design of Figure 4 in the design registration for the design of Figure 1 is that a visitor to your client's workshop had taken photographs of the design of Figure 4 and posted them on Facebook. Advise your client on any remedy that may be available to him in terms of the Designs Act.

(5)

Assume that your client also has a design registration in part F of the register for a guitar plectrum shown in Figure 5. The definitive and explanatory statements of the design registration read as follows:

Definitive statement: *The features for which protection is sought reside in the features of shape and/or configuration and/or pattern of a plectrum substantially as shown in the accompanying representations.*

Explanatory statement: *The design is applied to a plectrum used in picking the strings of a guitar while playing. The plectrum has a surface pattern applied thereto in order to improve the user's grip on the plectrum so as to avoid slippage while playing.*

Your client recently noticed that a competitor has started marketing a new plectrum range shown in Figure 6. Each plectrum of Figure 6 carries a symbol that is debossed on the face of the plectrum (i.e. the symbol is formed on the face of the plectrum to create a depressed/sunken effect). Although your client's competitor is not marketing their range to offer improved grip while playing, your client is of the view that this result is nevertheless achieved. Before taking action against the competitor, your client asks you for an opinion on the likelihood of a court finding in favour of infringement of your client's design registration.

The closest prior art is the plectrum shown in Figure 7, which is a plastic moulded plectrum on which the wording “Made in South Africa” appears. The wording “Made in South Africa” is applied in the same moulding process and, accordingly, is raised off the surface of the plectrum.

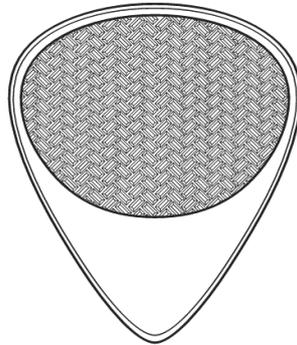


Figure 5 – Your client’s design registration

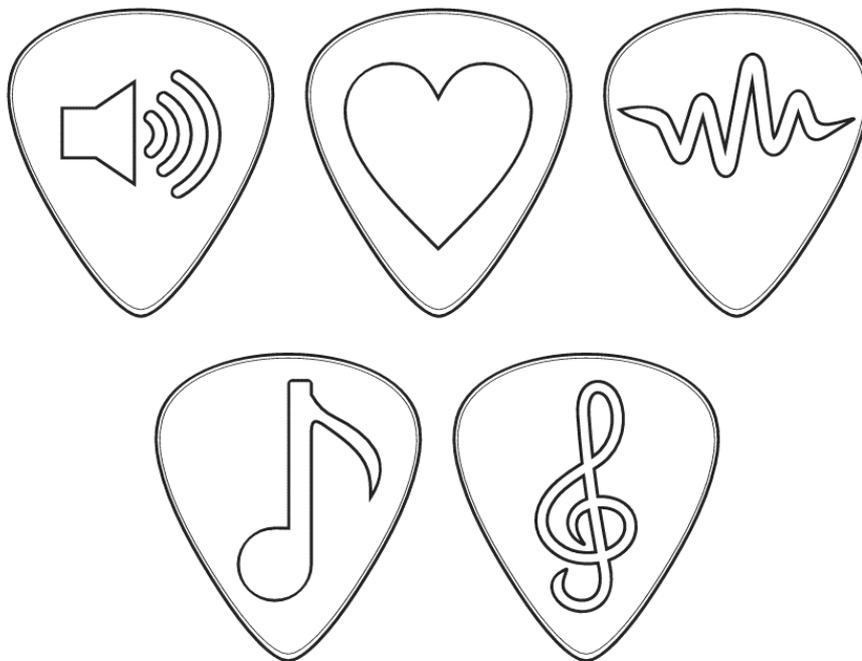


Figure 6 – Competitor’s product



Figure 7 – The prior art

12. Advise your client on the likelihood of a court finding in favour of infringement of his registered design. Cite case law in your opinion to client.

(15)

13. Irrespective of your answer in question 12, your client is concerned that the competitor will nevertheless attack his design registration. The reason for his concern is that, although he has not disclosed this to you previously, he started selling his plectrum before the filing date of the application for the design registration. Advise your client on the grounds on which a design registration may be attacked. Indicate which ground(s) is/are of particular importance in this case and briefly explain your answer.

(5)

14. During discussions with your client you suddenly remember that the design is registered in the names of both your client and his former business partner, who is no longer involved in the business. When mentioning this to your client he instructs you to transfer the design registration into his name because his previous business partner will not cooperate due to a nasty falling-out they had. Advise your client on his rights to the design registration.

(5)

15. Upon inspection of the design register at CIPC you discover that the design registration had in fact lapsed in 2019 due to the non-payment of the renewal fee that was due in 2019. Advise your client on the following:

- i) whether there are any steps available to him to reinstate the design registration; and
- ii) what the effect is of his competitor starting commercialising a competing product now while his design is not in force.

(6)

TOTAL MARKS: 100