

EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2020

ONE FOUR HOUR PAPER (240 MINUTES)

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MODERATOR: L CILLIERS

THIS PAPER CONSISTS OF TEN (10) PAGES (INCLUDING THE COVER PAGE)

PLEASE WRITE LEGIBLY

1. QUESTION 1

Your client contacted you for advice on extending their European design registration for the design of the bicycle shown in Figure 1 to South Africa. Your client tells you that the bicycle is the same as a standard bicycle apart from the design of the frame. Instead of the well-known diamond shape frame used on other bicycles, their new bicycle frame comprises two continuous rings (marked “A” in Figure 1). According to your client, in addition to the rings “A” providing technical advantages, this design “is a head turner just based on its looks”.

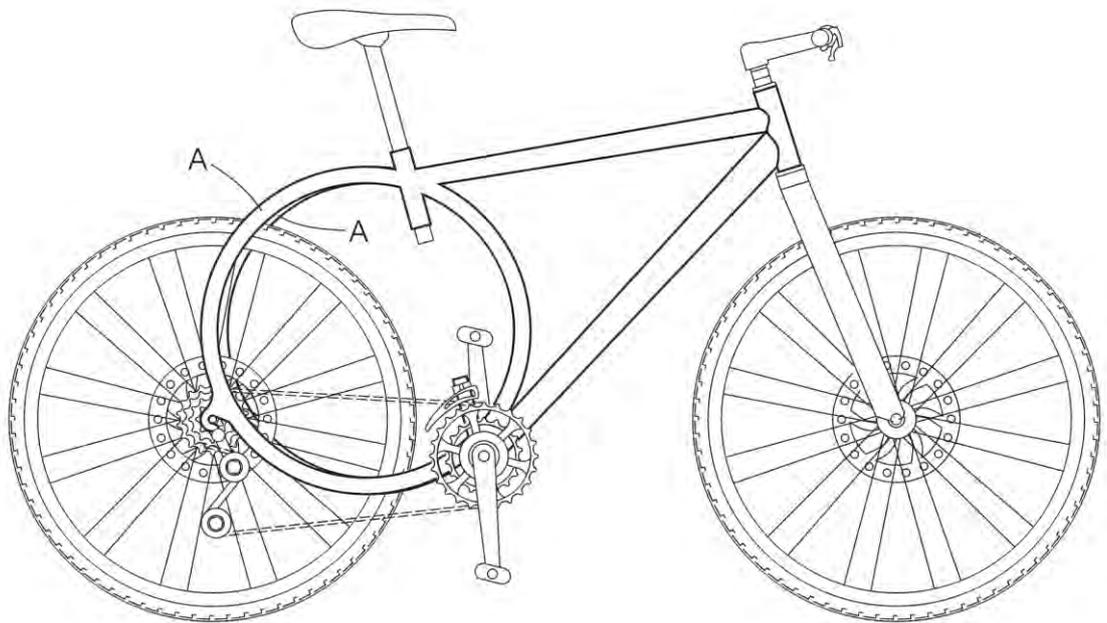


Figure 1 - Illustration of your client’s new bicycle design

1.1. Your client mentioned that he is somewhat confused by the distinction drawn between aesthetic and functional designs. Advise your client on the difference between the aesthetic and functional designs, and whether they should file an aesthetic or functional design in this instance (giving reasons explaining your answer).

(7)

1.2. Advise your client on the protectable features of a registered design in South Africa as well as the interpretation that you would give to each feature. Also indicate which of these protectable features are applicable in this case.

(5)

1.3. During the discussions with your client it became apparent that they sell a number of different bicycles with slight variations in the shape of the frame depending on the type of bicycle. For example, there are variations for road, off-road, women's and kids' bicycles. However, all variations include the two rings "A" as shown in Figure 1. Your client mentions that in Europe all of the design variations can be filed in a single design application. Advise your client on the position in South African law and on the options available to them to ensure that all of their variations are protected.

(10)

1.4. Assume that, in response to your advice, your client filed a South African design application on 1 May 2020 claiming priority from the earlier European application filed on 1 February 2020. As a precautionary measure you also claimed a release date of 1 March 2020, which was the date on which the bicycle design was first made available in Europe. You requested expedited registration and the notice of registration was issued on 1 August 2020. The advertisement of registration has not yet been published in the Patent Journal. Advise your client on the following:

1.4.1. The date on which the first renewal fee is payable?

(1)

1.4.2. The expiration date of the design, in the case of both an aesthetic design and a functional design?

(1)

1.4.3. The enforceability of the registered design against potential infringers prior to publication?

(1)

1.4.4. The enforceability of the design against an infringer who started producing infringing designs on 1 April 2020.

(5)

1.4.5. The rights of someone who started working in early 2019 on producing bicycles using the same design but who are now being stopped from selling the bicycles by virtue of your client's design registration.

(2)

1.5. Your client is planning on using the same bicycle frame design on a stationary bicycle for indoor training. You immediately check the Locarno classification and discover that stationary bicycles are classified in class 21. Advise your client.

(5)

1.6. Your client further tells you that they are also partnering with a local South African clothing manufacturer to produce cycling jerseys. They inform you that they intend using indigenous prints on their jerseys and during research and development they came across an article on the misappropriation of traditional designs. Your client would like to make sure they do everything correctly and ask your advice on the following:

1.6.1. Which form of traditional design is applicable here? Give reasons for your answer with reference to the definitions.

1.6.2. The registration requirements for the relevant type of designs?

(8)

2. **QUESTION 2**

2.1. You receive a telephone call from your client, who is a large producer of bottled milk. Your client informs you that they believe that their idea of using blue milk bottles instead of the traditional white bottles will be a great market success. Your client instructs you to file an application for a registered design for their new blue bottle. The bottle is identical to their previous bottle with the only difference being that the bottle is blue instead of white. Advise your client on the registrability of their new bottle.

(5)

2.2. The same client tells you that they have another bottle design that they would like to protect. During the discussion about this other bottle your client tells you that they produced a small number of bottles in December 2019 and tested them in the market during January 2020. Your client further tells you that the market test was carried out in Eswatini to limit exposure thereof to the South African public. Your client tells you that they are now ready for a large scale launch in South Africa but would like to ensure that they have protection in place before launching. Advise your client.

(5)

2.3. Your client eventually decides against the filing of a design application “because it is in any event cheaper to rely on copyright law in getting protection for our bottles.” Advise your client on their proposed strategy.

(5)

2.4. Your client has also included a new design feature that interacts with an app on a smartphone. The design feature is invisible on the bottle and it only becomes visible on the screen of the smartphone when viewing the bottle using their app. There is a range of designs to be ‘collected’ by saving them on the app. Advise your client on the registrability of such a digital design in terms of South African design law.

(5)

3. QUESTION 3

Your client manufactures and sells the dispenser as shown in Figure 2 (a) to (b) below. Figure 2 (a) shows a photograph of the dispenser in an empty state at the time of sale while Figure 2(b) shows a photograph of the dispenser in use in which a light coloured fluid such as olive oil is typically contained in an outer compartment and a darker fluid such as balsamic vinegar is typically contained in an inner compartment. Drawings of the same dispenser is shown in Figure 2 (c) and (d) in which the outer container is marked “A” and the inner container marked “B”. The dashed lines illustrate the fluids in compartments “A” and “B” respectively. The contrast between the lighter and darker fluids creates a bold design that, according to your client, appeals to a lot of their customers.

However, your client recently received a letter from the Homeware Designs (Pty) Ltd advising them that “*your dispenser is a blatant copy of our registered design and we will not hesitate to sue you for copying our dispenser. We will also not hesitate to post on social media the fact that you are copying our design.*” Your client is naturally concerned about these threats as they cannot afford the bad publicity during these times. The dispenser of the design registration is shown in Figure 3(a) in its empty state and in Figure 3(b) in its use state.

3.1. Despite your best efforts you cannot find the design registration on the designs register and there is no indication of the registration number on Homeware Design’s product or website. Advise your client on the recourse available to them other than that provided for in Section 37 (i.e. groundless threats of infringement).

(5)

3.2. Irrespective of your answer in 3.1 above, you learn that the registered proprietor of the design registration is recorded as Creative Designs (Pty) Ltd and there is no recorded assignments or licensees. In a telephone call to Homeware Designs (Pty) Ltd they advise that they do not see a problem with this considering that “*the registered design was transferred to them verbally and verbal contracts as just as good as written ones.*” What is the position in terms of the South African Designs Act?

(5)

Irrespective of your answers in 3.1 and 3.2 above, you note the following from the Form D2 and Form D6 of the registered design:

Homeware Designs (Pty) Ltd is now recorded as assignee.

The design is registered in Part A of the register.

All renewal fees due to date have been paid.

The definitive statement reads as follows:

“The features for which protection is claimed reside in the shape and configuration of a dispenser and/or the ornamentation of the dispenser resulting from the contrast in using two fluids of different colours in compartments “A” and “B”, substantially as shown in the accompanying representations, irrespective of the appearance of the features shown in broken line.”

The explanatory statement reads as follows:

“The design is applied to a dispenser and in particular to a dispenser for dispensing two different fluids. In use, the first fluid is contained in compartment “A” while the second fluid is contained in compartment “B”. The first fluid is typically lighter in colour while the second fluid is darker in colour, thereby, in use, creating ornamentation resulting from a contrast in colours.”

3.3. Your client informs you that they used the prior art bottle design shown in Figure 4 as reference when designing their bottle. Your client advises you that they intentionally copied the shape of the prior art bottle shown in Figure 4 so that they would not infringe on the registered design of Figure 3. Advise your client on whether or not their dispenser of Figure 2 infringes on the registered design of Figure 3. Cite case law where appropriate.

(15)

3.4. Your client is interested in revoking Homeware Designs' registered design. Advise your client on the grounds for bringing an application for the revocation of the design and indicate which ground(s) you will use and briefly set out your reasons.

(5)

3.5. Your client is concerned that Homeware Designs (Pty) Ltd may amend the design registration. In each of the following instances indicate whether the amendment is allowable:

3.5.1. Deleting the feature of shape so that the definitive statement reads: *“...the configuration of a dispenser and/or the ornamentation of the dispenser...”*.

3.5.2. Deleting the feature of ornamentation so that the definitive statement reads: *“...shape and configuration of a dispenser...”*.

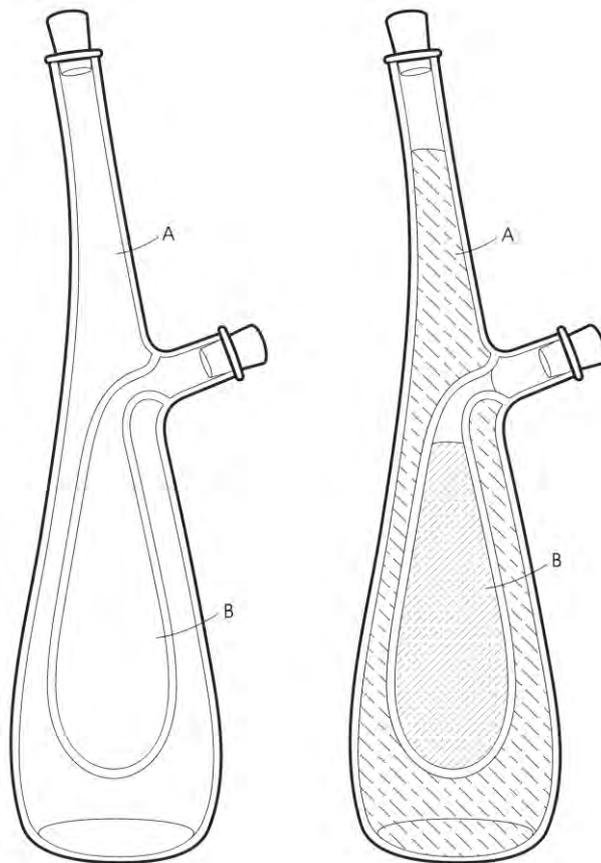
3.5.3. Deleting the phrase *“resulting from the contrast in using two fluids of different colours in compartments “A” and “B”* from the definitive statement.

(5)

TOTAL MARKS: 100

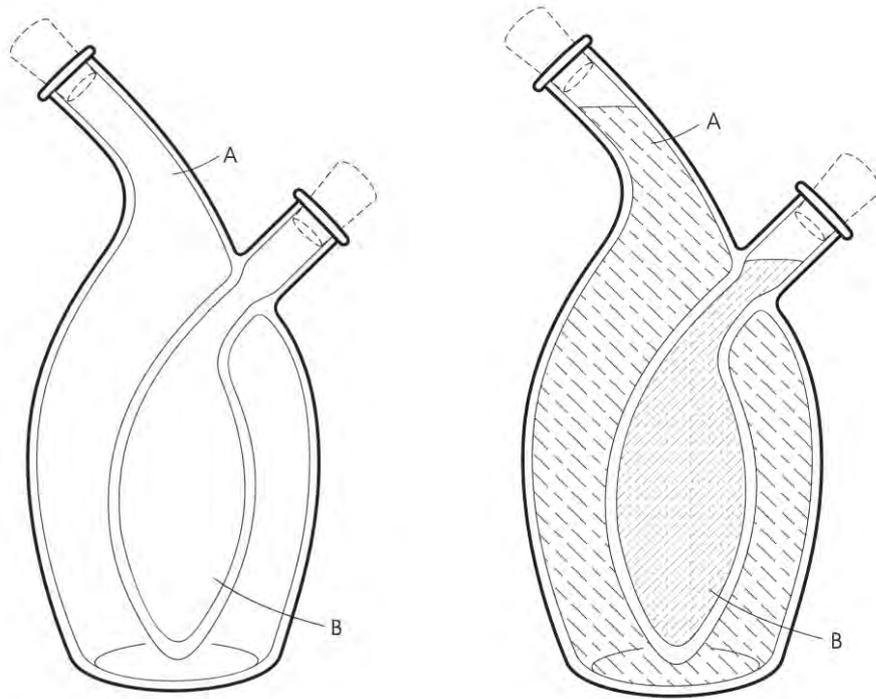


(a) Photograph of Empty Dispenser (b) Photograph of Dispenser In use



(c) Drawing of Empty Dispenser (d) Drawing of Dispenser In Use

FIGURE 2: YOUR CLIENT'S PRODUCT



(a) Drawing of Empty Dispenser (b) Drawing of Dispenser In Use

FIGURE 3: THE REGISTERED DESIGN

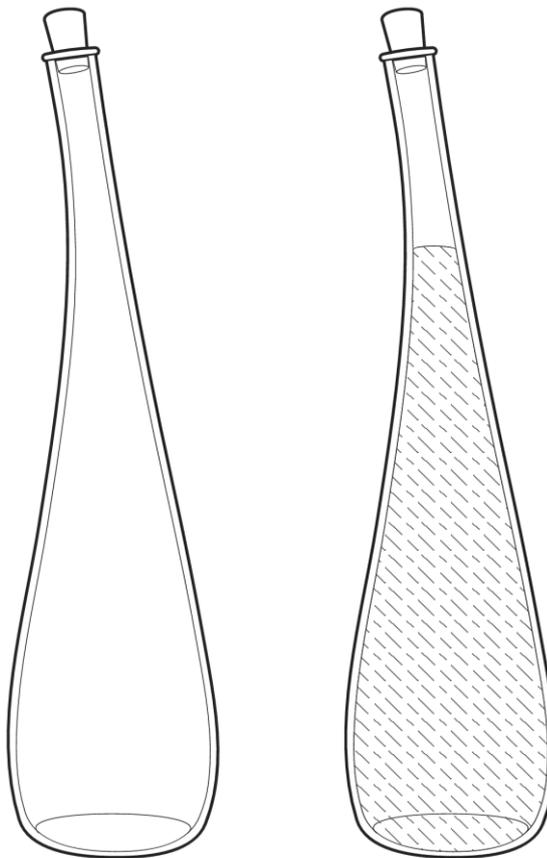


FIGURE 4: PRIOR ART DISPENSER

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