

SUPPLEMENTARY EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2015

ONE FOUR HOUR PAPER (240 MINUTES)

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MODERATOR: L CILLIERS

**THIS PAPER CONSISTS OF NINE PAGES (INCLUDING COVER) OF WHICH THE LAST THREE
PAGES ARE DRAWINGS**

PLEASE WRITE LEGIBLY

1. REGISTRATION

1.1. According to the Designs Act, an Aesthetic Design means "... *any design applied to any article, whether for the pattern or the shape or the configuration or the ornamentation thereof, or for any two or more of those purposes...*". Explain briefly the interpretation that you would give to the different protectable aspects, i.e. pattern, shape, configuration and ornamentation. Also explain, citing case law if applicable, whether you are of the view that colour plays any part in any of the aforesaid. Finally, also indicate to what extent a functional design differs from an aesthetic design insofar as the protectable aspects are concerned.

(10)

1.2. Whilst pondering the relevance of your newly acquired knowledge, you recall that it seems to be common practice to use the wording "shape **and/or** configuration..." in a definitive statement.

1.2.1. What is the effect of using these words insofar as the scope of protection is concerned?

1.2.2. What are your views on the validity of such a statement?

(5)

1.3. A prospective client wants to know if one can file registered design applications for various articles. Give him your reasoned opinion, supported by case law where relevant.

1.3.1. The shape of a watch shaped sweet, which shape has been based on an existing, conventional watch, although it is not a replica.

1.3.2. A new handmade pot. Even though every single pot is individually hand crafted and decorated, when seen for the first time and placed next to each other they appear to have been mechanically mass-produced.

1.3.3. A design application for a toy car. The toy car is a replica of an actual car which is already known in the market, and for which a design has been filed.

1.3.4. A set of cutlery, all sharing the same handle design.

(15)

1.4. After an exhausting day at the office you realise that you will have to start supplementing your income from other sources, as IP law clearly does not pay. You decide to resurrect your career as part-time vacuum cleaner salesman, but upon inspection of your old KIRBY® demonstration model, you notice that one of the seals has completely disintegrated, as they tend to do over time. Not one to be deterred by minor setbacks, you quickly make a new seal using toothpaste, a paperclip and a post-it pad. To your surprise, you find that this new seal has a new shape that really works rather well – in fact, it works better than the original seal!! As a young and upcoming Design Law Practitioner, explain what goes through your mind insofar as protecting your design is concerned.

(5)

1.5. Provide the definitions of an indigenous design and a derivative indigenous design.

(5)

- 1.6. Draft definitive statements for the following designs, whilst also indicating the part (functional / aesthetic) in which the designs will be filed. Select the most important part if you are of the view that it can be filed in both.
- 1.6.1. Figure 1. Water tank. The tank has structural reinforcing ribs required for underground use. Client expects to manufacture larger tanks as well, which will simply be longer.
- 1.6.2. Figure 2. Perfume bottle. Client specifically advised that the cap design has not been finalised yet.
- 1.6.3. Figure 3. Fabric with new appearance.
- 1.6.4. Figure 4. Tube. Tube has internal reinforcements to prevent it from collapsing when used under vacuum.
- 1.6.5. Figure 5. Mug. According to your client the design of the ear of the mug is new, and he wants to use the same ear design with different receptacles. Even though the text and ornamentation applied to the mug is extremely popular, he does not want to limit it to that shown in the representation.

(20)

[60]

2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. You plan to file your own functional design application for a protective glove that protects one's hand when paginating court files. Your wealthy friend kindly offered to fund the application, provided he is listed as a co-applicant. Set out in bullet point format what a joint proprietor of a design can and can't do before you make your final call as to the advisability of this arrangement.

(6)

2.2. In order to reduce costs you decided not to involve your very expensive senior partner in drafting the definitive statement for your design application. The definitive statement includes the wording "**shape and/or pattern**". Sadly, after filing you realise that your definitive statement requires some amendment. Consider the following potential amendments and advise...

2.2.1. Pre-grant: Amend to "**shape and pattern**".

2.2.2. Post-grant: Amend to "**shape and pattern**".

2.2.3. Pre-grant: Amend to "**shape and/or pattern and/or ornamentation**" – ornamentation added to drawings during amendment.

2.2.4. Post-grant: Amend to "**shape and/or pattern and/or ornamentation**" – ornamentation already shown in drawings.

(10)

2.3. Your next client is the recorded licensee of a design application that was lodged two months ago, and which has not been granted yet. One of his competitors has been advertising an identical product in the Sunday newspaper. As far as your client knows, the competitor has not started selling the product, but he wants to stop him before anything else happens. Advise your client as to the best way forward.

(6)

2.4. Referring to relevant case law, describe the test that you would apply to determine if a product will infringe a registered design, and then apply the test to the 'case of the roll-on bottles' depicted in Figures 6, 7 and 8.

(8)

2.5. List the grounds on which one may apply for a compulsory licence.

(5)

2.6. Your client's registered design has lapsed due to non-payment of renewal fees four years ago. Your client advises that he was in financial trouble at the time when the renewal was due, and he was therefore simply not in a position to pay the renewal fee. He claims that he never intended for the design to lapse, but that he had no other option given his circumstances. His financial situation has since improved, and he now wants to revive the design. Advise.

(5)

TOTAL MARKS 100

- END OF PAPER -



FIGURE 1

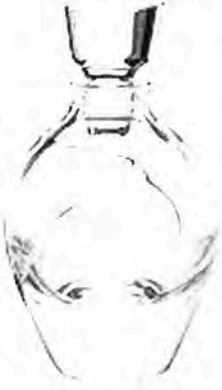


FIGURE 2

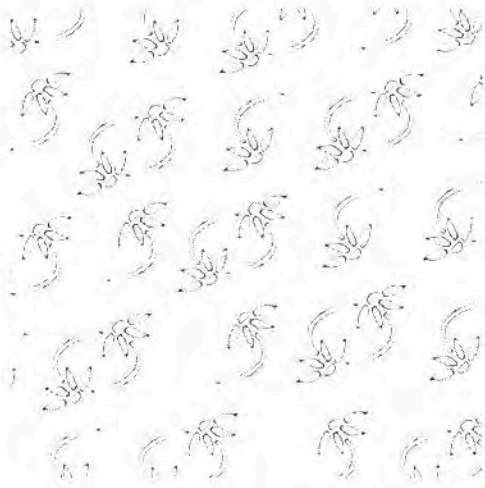


FIGURE 3

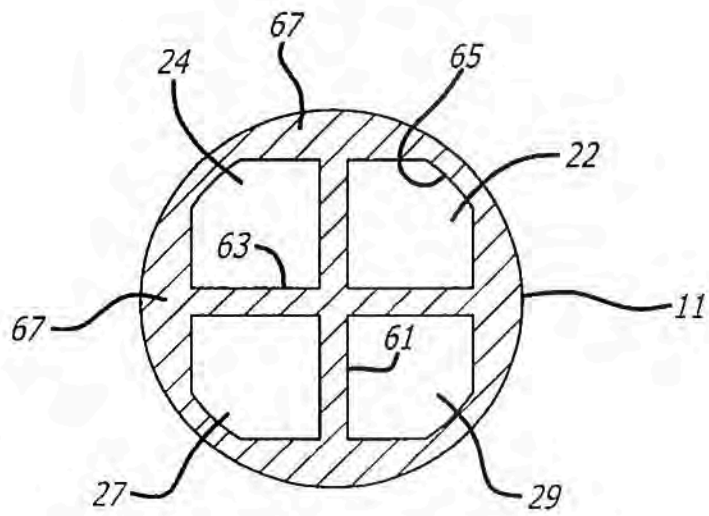


FIGURE 4

**TRUST ME
I'M A
PATENT
ATTORNEY**

FIGURE 5



FIGURE 6 – DESIGN

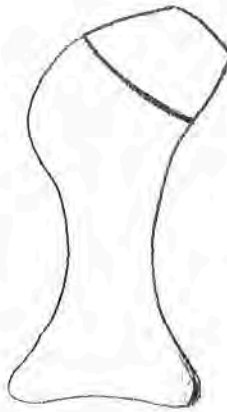


FIGURE 7 – ALLEGEDLY INFRINGING PRODUCT



FIGURE 8 – PRIOR ART