

EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2016

ONE FOUR HOUR PAPER (240 MINUTES)

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MODERATOR: L CILLIERS

**THIS PAPER CONSISTS OF TEN PAGES (INCLUDING COVER) OF WHICH THE LAST FOUR
PAGES ARE DRAWINGS**

PLEASE WRITE LEGIBLY

1. REGISTRATION

1.1. Give the definitions of an aesthetic design and a functional design, and 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.

(10)

1.2. Your client informs you that a new product of hers forms the subject of a pending patent application filed 10 months ago. She is however concerned that the patent rights that will eventually issue might be invalid for a lack of inventiveness. Please advise her on the option of filing a design application for her product. Include the definition of the “state of the art” in your answer.

(5)

1.3. You receive a call from a prospective client who has read about the “Please call me” case in the local newspaper. He explains to you that he is a designer working for a product development company. He would like to know who owns the design rights in the designs that he has created in the course of his employment. Advise your prospective client. In your advice, include the definition of “proprietor” as stated in the Designs Act.

(5)

1.4. A good trade mark client of yours has recently read an article on using intellectual property law, other than trade mark law, in obtaining protection for brands. Your client has an extensive portfolio of trade marks, including both old, registered marks which have been in use and new marks which they would like to use in the future. Advise your client on the availability of design law as a means to obtain protection for the mark in their portfolio. Your advice should deal with potential risks as well as compare the advantages and disadvantages associated with the available options provided to your client.

(6)

- 1.5. A recent development in South African design legislation is the introduction of traditional designs.
- 1.5.1. Provide the definitions of an indigenous design and a derivative indigenous design. **(4)**
- 1.5.2. Briefly set out the differences in registrability requirements between indigenous designs and derivative indigenous designs. **(3)**
- 1.5.3. List three steps that need to be taken in order to obtain rights in a derivative indigenous design. **(3)**
- 1.6. Your client is the proprietor of a registered design for a pattern as applied to an article of clothing. The design is registered in class 2 and your client has been selling the clothing for a number of years. Your client has also been selling suitcases carrying the same pattern for 5 months and would now like to file a design application in class 3 to protect the pattern as applied to suitcases. Advise your client. **(5)**
- 1.7. A new client brings a range of hand-made baskets, all varying in size but carrying the same decorative design, to a new client meeting and asks you whether the baskets could be protected by design rights. Your client is the owner of a start-up and cannot afford to file multiple design applications. Advise your client. **(5)**
- 1.8. Your client is a manufacturer of jewellery and has been selling a particular jewellery range including a watch, a necklace and earrings for 8 months. The range has proven to be a success in the market and your client would now like to protect the design of the range so that competitors are not allowed to copy it. Your client has indicated that the success of the range is probably due to the elaborate adornment applied to the range. Advise your client on

whether any of the items in the range is capable of being protected by design law and/or copyright law.

(5)

1.9. Provide the citation of the case law which you will consult on the following topics:

1.9.1. Whether the state of the art includes designs of the same general character but not included in the same class of the design in question.

1.9.2. Whether features of an article could be both aesthetic and functional.

1.9.3. A set of articles.

1.9.4. The registrability of spare parts for vehicles.

(4)

1.10. Draft definitive statements for the designs illustrated in Figures 1 to 5. In the figures, the features that are shown in broken line should not form part of the claimed design.

(10)

[65]

2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Advise your client on the rights of joint proprietors of a registered design.

(5)

2.2. List the grounds for the revocation of a design registration.

(5)

2.3. Your client sends you a copy of a letter of demand as received from an attorney acting on behalf of your client's competitor. The letter of demand asks for an undertaking that your client immediately ceases infringement of a design application for a sink faucet as shown in Figure 6 otherwise

infringement proceedings shall be instituted. The letter of demand states that your client has run an advertisement campaign in which he advertised the sink faucet as shown in Figure 7.

- 2.3.1. Without drafting a response dealing with the merits of potential infringement, briefly set out the basis on which you would respond to the letter of demand.

(3)

A few months later you receive another letter from the attorney acting on behalf of your client's competitor. Attached to this letter is a copy of the registered design from which you note that the definitive statement reads as follows:

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

- 2.3.2. Your client has asked you for an opinion on the likelihood of a court finding that there is indeed infringement of the registered design based on the sale of your client's faucet of Figure 7. Figure 8 shows the closest prior art. Draft an opinion citing case law where appropriate.

(12)

- 2.4. After filing of a design application for a container your client advises you that he would like to make amendments thereto. Consider the potential amendments set out below and advise whether your client would be able to make the amendment. In your advice deal with the validity of the amendment both before and after registration of the design.

- 2.4.1. Amend the drawings to add a decorative pattern to the container.
- 2.4.2. Amend the definitive statement from "shape and configuration" to "shape and/or configuration and/or pattern" (assume that the decorative pattern was shown in the drawings at the time of filing the application).

2.4.3. Amend the definitive statement from "shape and/or configuration" to "shape and configuration and pattern" (assume that the decorative pattern was shown in the drawings at the time of filing the application).

(5)

2.5. Your client informs you that a competitor's registered design has been restored. Your client is devastated seeing that they have taken a loan and set up a factory to produce the product protected by the competitor's registered design. Your client conducted searches a year ago, which revealed that their competitor's registered design had lapsed due to the non-payment of a renewal fee. Your client would like to know what the requirements for restoration are and whether they are allowed to continue manufacturing the product even though your competitor's registered design has been restored. Advise your client.

(5)

[35]

TOTAL MARKS 100

- END OF PAPER -

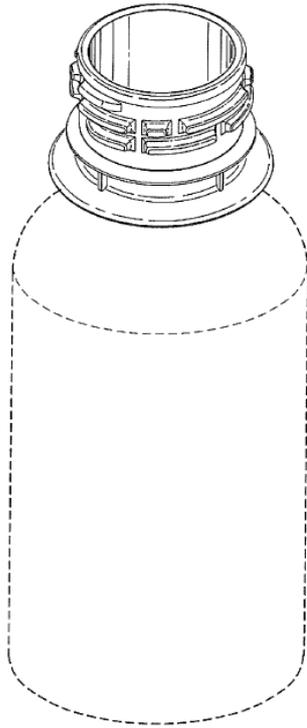


FIGURE 1

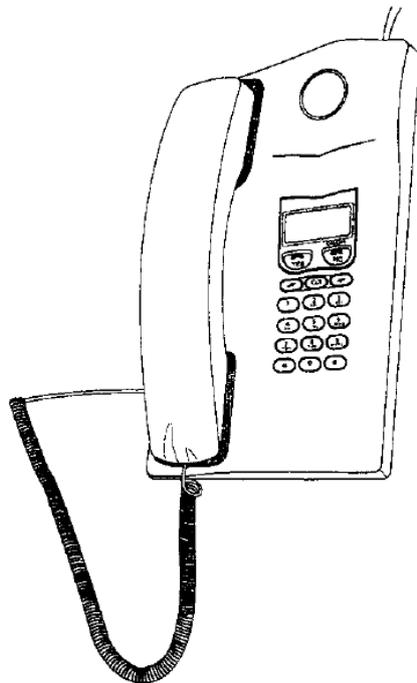


FIGURE 2

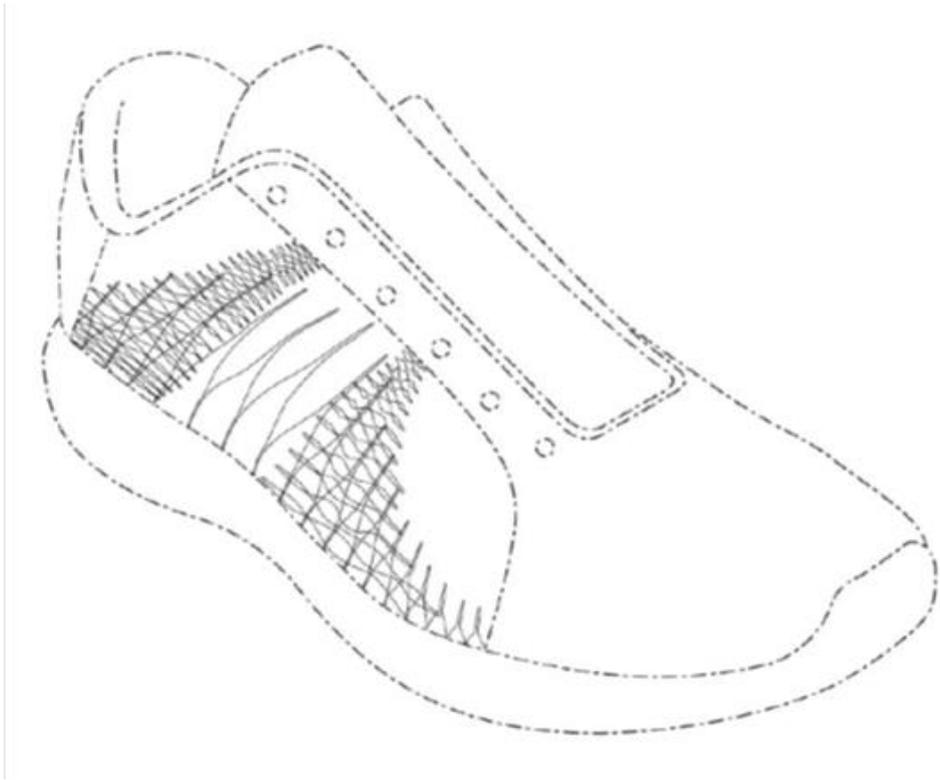


FIGURE 3

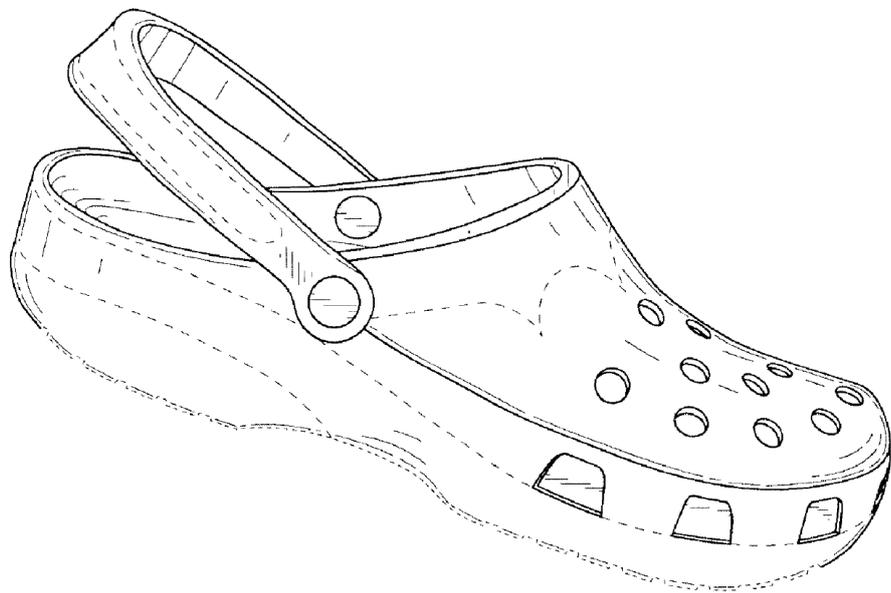


FIGURE 4



**WORLD
RUGBY**

FIGURE 5

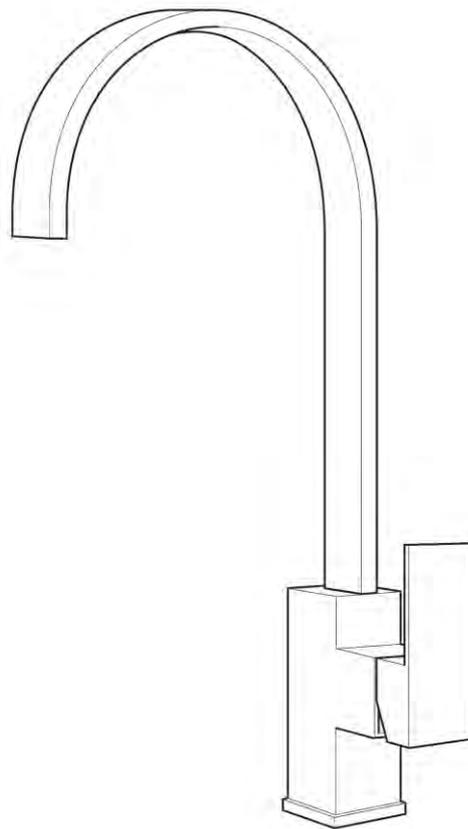


FIGURE 6 – REGISTERED DESIGN

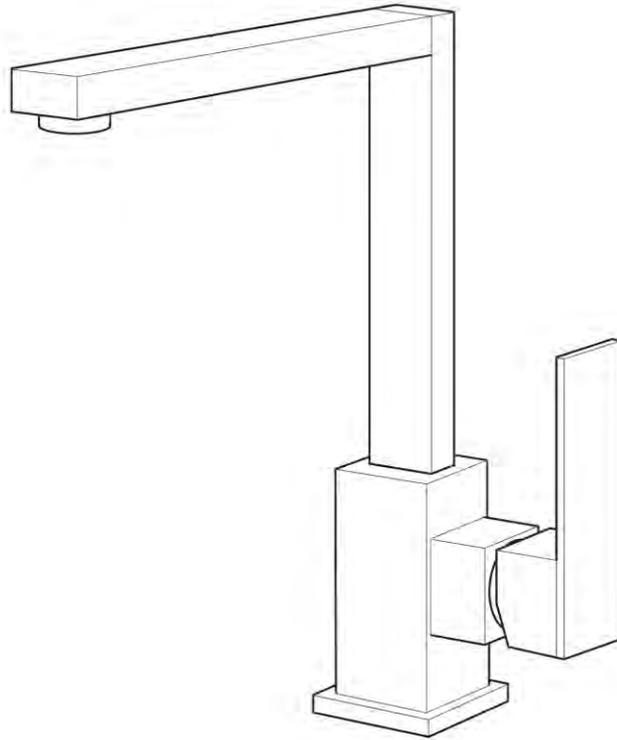


FIGURE 7 – YOUR CLIENT’S ALLEGEDLY INFRINGING DESIGN

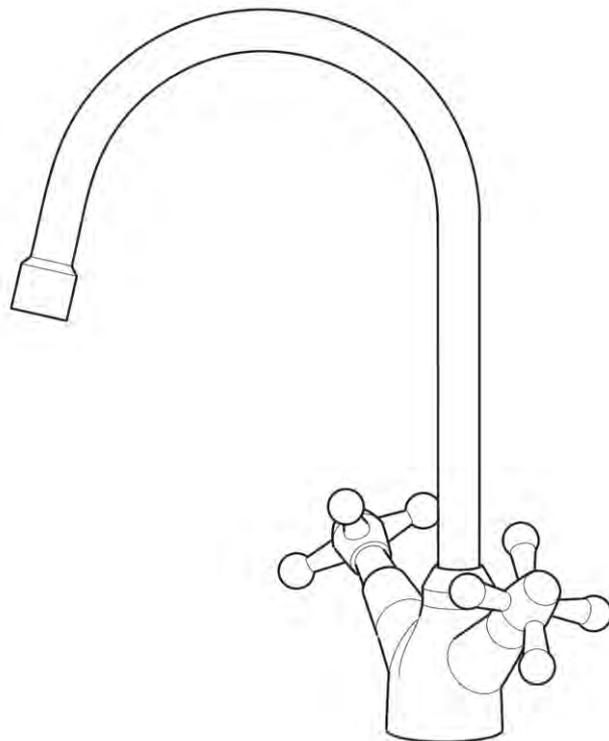


FIGURE 8 – PRIOR ART