

**EXAMINATION**

**PATENT EXAMINATION BOARD**

**SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW**

**SOUTH AFRICAN DESIGN LAW AND PRACTICE 2017**

**ONE FOUR HOUR PAPER (240 MINUTES)**

EXAMINER: H VAN SCHALKWYK

MODERATOR: L CILLIERS

**THIS PAPER CONSISTS OF EIGHT PAGES (INCLUDING COVER) OF WHICH THE LAST TWO  
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 features, i.e. pattern, shape, configuration and ornamentation. Also explain, citing case law if applicable, whether colour can be protected. Finally, also explain with reference to the definition of a functional design the reason why the feature of ornamentation is not protectable in a functional design registration.

**(10)**

1.2. A jewellery designer has asked you for advice on a new necklace that she would like to register. The necklace is made up of individual links which each has a unique shape. The designer would like to protect the appearance of the necklace irrespective of the order in which the individual links are connected to one another. Advise the designer on the registrability of the necklace.

**(5)**

1.3. A foreign client started selling his new product in Europe on 1 March 2016. Using the 12 month grace period in Europe he filed his European design application on 1 March 2017. He has now instructed you to file a South African design application claiming priority in terms of the Paris Convention before the expiry of the 6 month period under the Paris Convention. Advise your client on the filing of a South African design application.

**(5)**

1.4. You filed an application for a registered design on behalf of a client on 1 April 2016 claiming a release date of 1 February 2016. The design was registered on 1 September 2016 and registration was published in the Patent Journal on 26 October 2016.

1.4.1. When is the first renewal fee payable?

1.4.2. What is the effective date of registration of the design?

1.4.3. When can your client, i.e. the proprietor, start enforcing the registered design?

1.4.4. How would your answers have differed if, instead of claiming a release date of 1 February 2016, the South African registration claimed priority from a foreign application filed on 1 February 2016?

**(5)**

1.5. Whilst paging through a book on the impact of the traditional form of Ndebele wall paintings on modern art your client realised that with some creativity he could apply the traditional designs to contemporary home décor products. Before launching the products your client would like to file design applications. However, your client has read an article in the local newspaper about traditional designs and is concerned about the ownership of the rights to the designs. Answer the following questions from your client:

1.5.1. Are the designs considered to be indigenous designs or derivative indigenous designs, and why?

**(4)**

1.5.2. What are the differences in registrability requirements between indigenous designs and derivative indigenous designs?

**(3)**

1.5.3. What steps should be taken for your client to obtain the rights in his designs?

**(3)**

1.6. Your client recently learned that despite entering into a non-disclosure agreement with an industrial designer, the designer published your client's design on his website without authorisation to do so. Your client is upset seeing that the publication on the website happened about 7 months ago and according to his understanding a release date can no longer be claimed. Advise your client.

**(5)**

1.7. A new client would like to know what the effect of the registration of a design is. A customer of your client is buying products covered by your client's design registration from your client and re-selling them throughout Africa. Your customer would like to know whether this is allowed or not. Advise your client.

**(5)**

1.8. Who is the proprietor of a design?

**(5)**

1.9. Distinguish between the roles of the definitive statement, explanatory statement and the statement of features, as well as their impact on the scope of the design.

**(5)**

1.10. For each of the designs mentioned below, indicate whether or not you would advise your client to file a design application and, if so, indicate whether you would file the application in part A or part F of the register. Provide reasons for your answers and refer to case law where applicable.

1.10.1. A design of a replacement front bumper for a vehicle.

1.10.2. A design of a cool drink crate for carrying bottles.

1.10.3. A design of a handmade necklace. The designer intends making identical copies but only on a small scale.

1.10.4. A design of a new skyscraper building.

**(10)**

**[65]**

## 2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Your client advises you that he has acquired ownership of a design registration by way of a verbal assignment and now wishes to enforce his rights against a potential infringer. Advise your client.

(5)

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

(5)

2.3. Your client requests you to send a letter of demand asking for an undertaking from his competitor to cease infringement of your client's design registration as shown in Figure 1. Your client advises you that his competitor is advertising the design of Figure 2 on their website.

2.3.1. Advise your client on whether or not it is an opportune time to send a letter of demand.

(3)

The definitive statement of your client's design registration reads as follows:

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

2.3.2. Your client has asked you for your opinion on the likelihood of succeeding in infringement proceedings against his competitor. You have done a novelty search and the closest prior art is shown in Figure 3. Advise your client citing case law where appropriate.

(12)

2.4. The definitive statement of an application reads as follows: "Protection is claimed for the features of shape and configuration of a container substantially as shown in the accompanying drawings". Your client now wishes to make amendments to the design. Advise in each instance whether the amendment is allowed and give reasons for your answers.

- 2.4.1. Amend the definitive statement to claim the features of “shape and/or configuration”.
- 2.4.2. Amend the definitive statement to claim the features of “shape and configuration and pattern”. The pattern is clearly visible in the drawings as originally filed.
- 2.4.3. Amend the application from part A of the register to part F.
- 2.4.4. How would your answers have differed in 2.4.1 to 2.4.3 if the design application had already proceeded to registration?

**(5)**

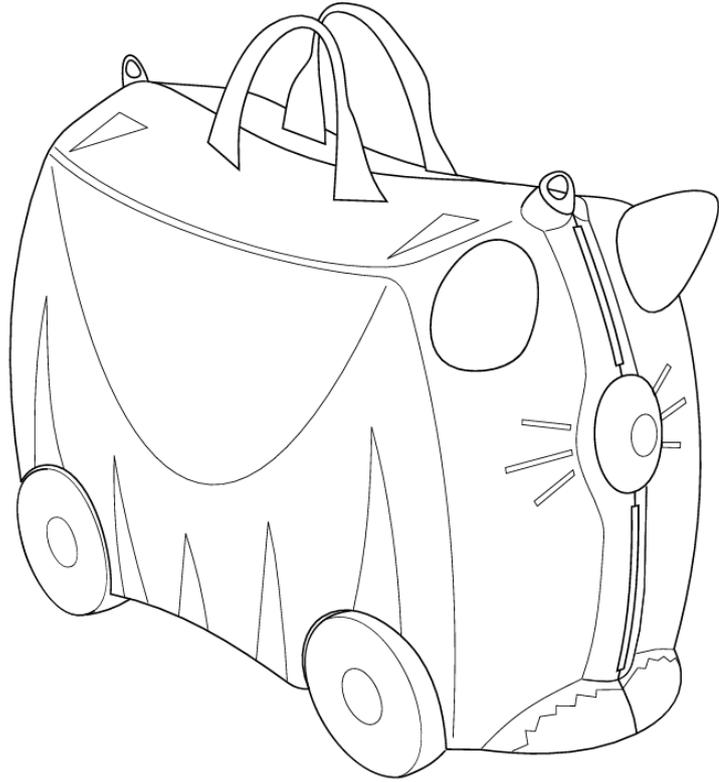
2.5. Your client instructs you to verify the status of a competitor’s design registration. Although you advise your client that the registration has lapsed your client is hesitant to proceed with the manufacturing of the product covered by the lapsed registration because of the large capital investment required in order to manufacture the product. Your client is concerned that his competitor could reinstate the design at any time and then request your client to cease manufacturing. Advise your client.

**(5)**

**[35]**

**TOTAL MARKS 100**

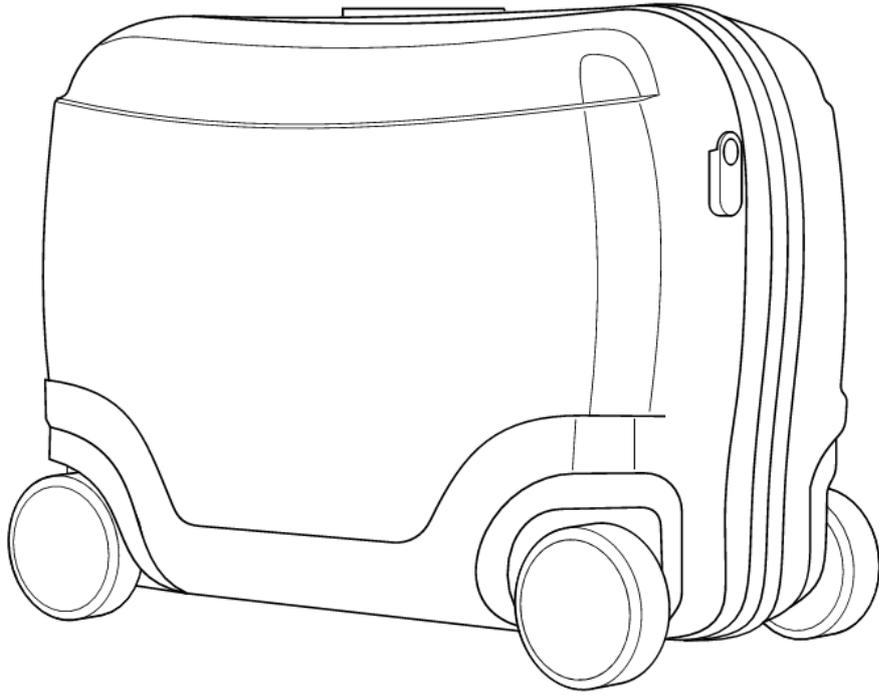
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**FIGURE 1 – REGISTERED DESIGN**



**FIGURE 2 – THE ALLEGEDLY INFRINGING DESIGN**



**FIGURE 3 – PRIOR ART**