

**EXAMINATION**

**PATENT EXAMINATION BOARD**

**SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW**

**SOUTH AFRICAN DESIGN LAW AND PRACTICE 2018**

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

EXAMINER: H VAN SCHALKWYK

MODERATOR: L CILLIERS

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

**PLEASE WRITE LEGIBLY**

## 1. REGISTRATION

1.1. In an attempt to combat theft of expensive copper piping your client approaches you with the idea of using plastic piping and applying a copper surface finish thereto. Your client is convinced that you will be able to assist him in applying for registered design protection for the appearance of copper coloured plastic piping. Advise your client on whether or not the filing of a registered design application will be effective. In your answer, explain briefly the interpretation that you would give to the different protectable features, i.e. shape, configuration, pattern and ornamentation. 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 client of yours has made a design and tells you in the consultation that the design is new. Being diligent you would like to clarify that your client's understanding is aligned with the Designs Act. Advise your client under which circumstances the design shall be deemed to be new in terms of the Designs Act.

**(5)**

1.3. On recent travels to the US your client came across a product that is doing well commercially in the US. Your client did some investigation and discovered that the product has only been available on the market for about five months, which according to your client's understanding of the Designs Act is within the grace period. Your client instructs you to file a South African design application for the product so as to secure the South African rights. Advise your client.

**(5)**

1.4. You filed an application for a registered design on behalf of a client on 1 September 2017 claiming priority from a foreign design application filed on 1 May 2017. The design was registered on 15 March 2018 and registration was published in the Patent Journal on 25 April 2018.

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. Assuming that instead of claiming priority from the foreign design the South African registered design has a release date of 1 May 2017, how would your answers in 1.4.1 and 1.4.2 have differed?

**(5)**

1.5. Your client would like to know the difference between an indigenous design and a derivative indigenous design. Provide the definitions for both and set out the differences in registration requirements, including any step that should be taken by your client prior to registering the design.

**(10)**

1.6. Your client is the manufacturer of motor vehicle tyres. As part of the design process they spend considerable time designing the thread of the tyre to ensure that it performs well in wet weather conditions as well as appeals to customers from a visual perspective. Advise your client on the different factors that need to be taken into consideration when deciding whether to file the design for the tyre in Part A or Part F of the register.

**(5)**

1.7. A new client has an idea for a new business and would like your advice on the effect of a registered design. Your client tells you that she is planning to set up a facility where she would repair products brought in by her customers. Your client is aware of a registered design protecting the appearance of the product that he intends repairing but mentions that she is not too concerned because "surely customers who have bought the product can decide what they want to do with it". Advise your client.

**(5)**

1.8. What is the definition of a set of articles?

**(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.

1.10.1. A design of handmade furniture. The intention is to make identical copies but not more than 50 copies of the same piece of furniture.

1.10.2. A design for a seal used in a vacuum cleaner. The seal has a unique shape, is designed to last about two years and is not visible in use.

1.10.3. A design of a chocolate bar having a unique decorative pattern, which is only visible after having taken the first bite or after having broken off a piece.

1.10.4. A design of a new bridge.

**(10)**

**[65]**

## 2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Your client would like to commercialise a product that is protected by a South African registered design in the name of a third party. Your client advises you that there is currently no commercialisation of the product in South Africa and the general public stand to benefit from commercialisation thereof. Several attempts to negotiate a licence with the proprietor of the design have failed. Advise your client.

(5)

2.2. In the event that your proposed course of action in 2.1 above is unsuccessful, your client would like to apply for the revocation of the registered design. List the grounds for the revocation of a design registration.

(5)

2.3. Your client, Saving Kids (Pty) Ltd, is the manufacturer of a personal flotation device for kids as shown in Figures 1 and 2. Saving Kids (Pty) Ltd acquired the South African registered design from Floating Kids (Pty) Ltd around two years ago. Saving Kids (Pty) Ltd has now come across a competitor selling the life jackets shown in Figures 3 and 4 and would like your advice on their likelihood of success if they were to institute infringement proceedings against the potential infringer.

You immediately inspect the official register and get a copy of the official file from CIPC. From these documents you notice the following:

The proprietor is Floating Kids (Pty) Ltd and no assignment has been recorded.

The registered design is in force considering that all renewal fees due have been paid.

The design is registered in Part A of the register.

The definitive statement reads as follows:

*“The features for which protection is claimed reside in the shape and/or configuration and/or pattern and/or ornamentation of a*

*personal flotation device substantially as herein described, irrespective of the appearance of the features shown in broken line.*”

The explanatory statement reads as follows:

*“The design is applied to a flotation device. The device has a body, which in use fits around the wearer’s chest, and two flotation armbands through which the wearer’s arms extend in use. Primary features of the design include the configuration of the flotation armbands relative to the body and that they are connected to the body.”*

You have also done a prior art search and, apart from the well-known floating armbands commonly referred to as “wings”, the closest prior art that you could find is the life jacket shown in Figure 5.

Advise your client citing case law where appropriate.

**(15)**

2.4. Ignoring your answer in 2.3 above, can Saving Kids (Pty) Ltd make the following amendments to their registered design (give reasons for your answers):

- 2.4.1. Add additional drawings showing the same flotation device but with decorative surface patterns printed thereon.
- 2.4.2. Amend the definitive statement to claim the features of “shape and configuration” instead of “shape and/or configuration and/or pattern and/or ornamentation”.
- 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 was still pending?

**(5)**

2.5. You receive a call from a client for whom you registered a design a couple of years ago. Your client has noticed that a competitor of theirs has started selling very similar products and believes that this is hurting their business. When your client contacted their competitor to tell them that they can expect to be sued for infringement the discussion got very heated quickly. According to your client's recollection of the discussion their competitor is now refusing to stop selling because they are of the view that similar products have been in the market for more than 20 years. Your client is furious and instructs you send a letter to their competitor telling them that they will be sued "for every cent they ever made from the blatant copying of the design". Advise your client.

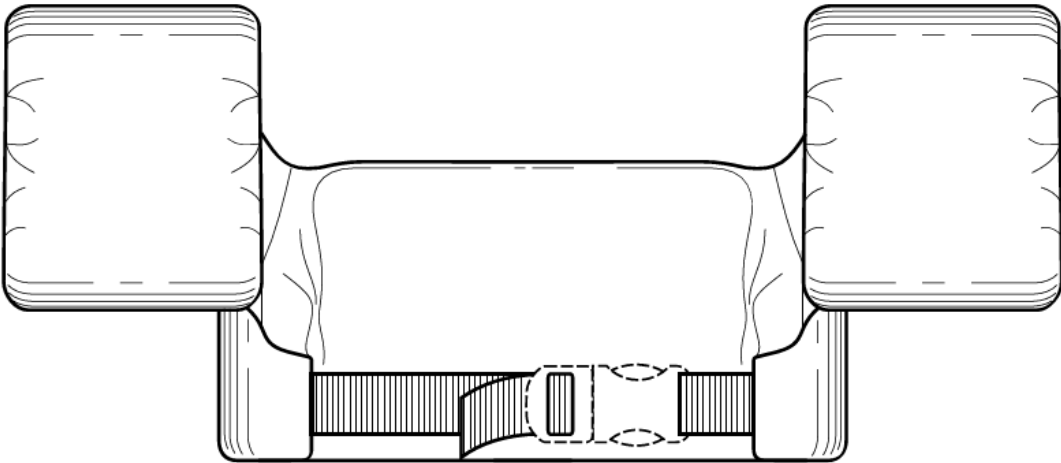
**(5)**

**[35]**

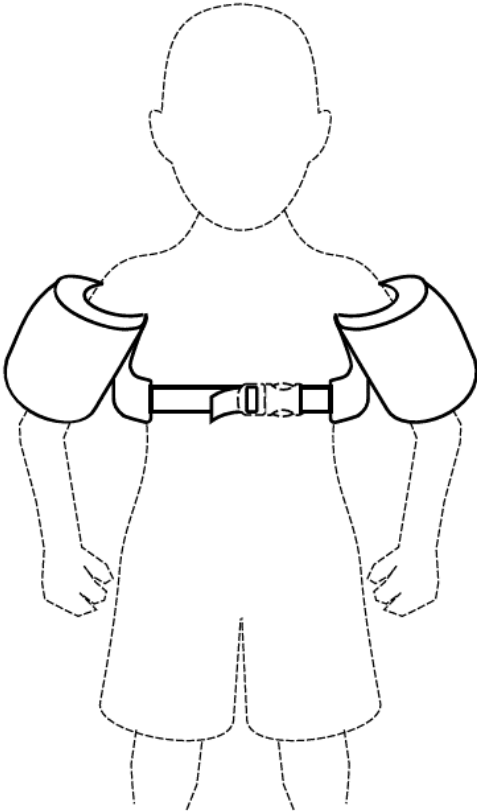
**TOTAL MARKS 100**

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**REGISTERED DESIGN**



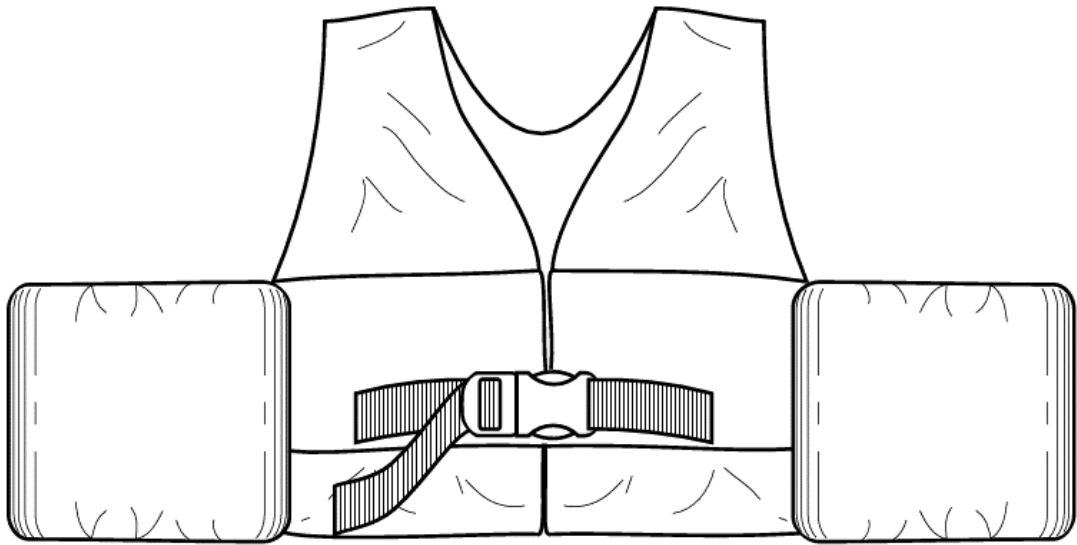
**FIGURE 1: FRONT VIEW OF REGISTERED DESIGN**



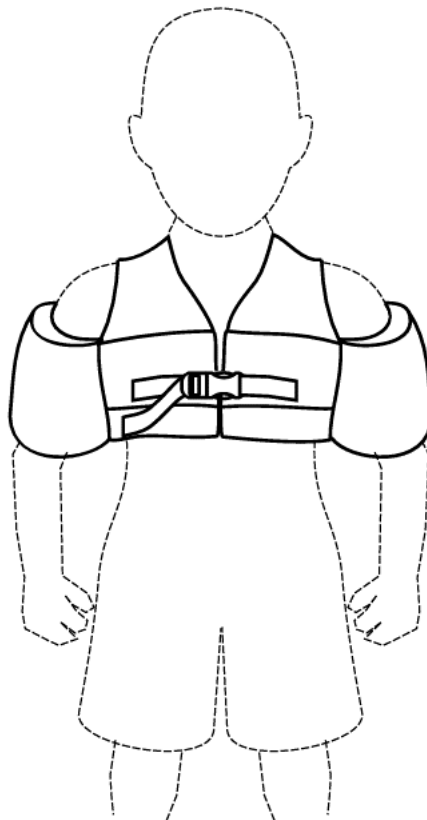
**FIGURE 2: PERSPECTIVE VIEW OF REGISTERED DESIGN IN USE**



**ALLEGEDLY INFRINGING PRODUCT**



**FIGURE 3: FRONT VIEW OF ALLEGEDLY INFRINGING PRODUCT**



**FIGURE 4: PERSPECTIVE VIEW OF ALLEGEDLY INFRINGING PRODUCT IN USE**

PRIOR ART

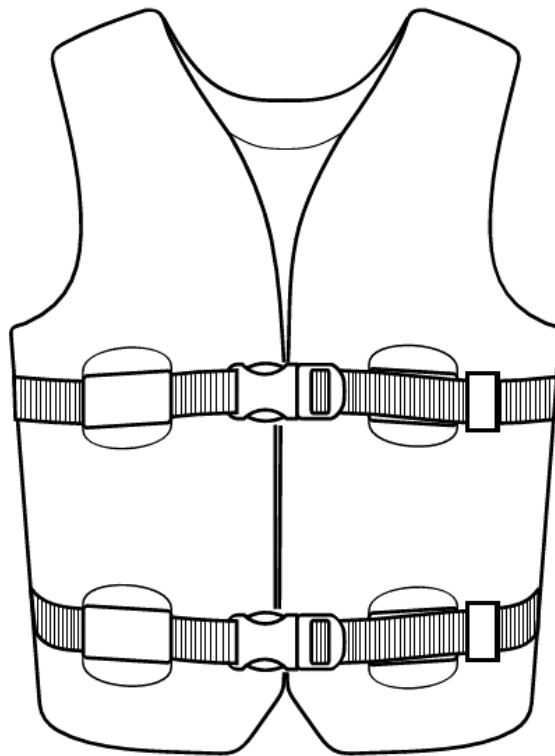


FIGURE 5: FRONT VIEW OF PRIOR ART