

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

PLEASE WRITE LEGIBLY

1. REGISTRATION

- 1.1. On new client duty you receive a call from a client who advises you that she has created a new logo which she applies to a new bottle which she has also designed. She informs you that she has read about the different forms of intellectual property on your firm's website but she is still unsure how best to protect her logo and bottle designs.
- 1.1.1. Advise your client on the difference between the available forms of protection, as well as the advantages and disadvantages of each. (6)
- 1.1.2. Provide your views on the validity of a class 32 design registration for the logo. (3)
- 1.1.3. Your client is adamant that she will rely on copyright law when required to take action against a potential infringer who makes replicas of her bottle. Advise your client on whether or not this would be an effective strategy. (3)
- 1.2. According to the Designs Act, a Design means "*an aesthetic design or a functional design*". Provide the definitions of aesthetic and functional designs 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)
- 1.3. A recent development in South African design legislation is the introduction of traditional designs.

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

(6)

1.3.2. Briefly set out the differences in registrability requirements between indigenous designs and derivative indigenous designs.

(3)

1.3.3. List three steps that need to be taken in order to obtain rights in a derivative indigenous design.

(3)

1.4. You receive a phone call from the head of legal at a motor vehicle manufacturer. She explains to you that they filed a design application for one of their vehicles about two years ago. At the time they only filed an application in class 12 for motor vehicles. However, they have now determined that there is a substantial market in the manufacture and sale of a toy car embodying the actual vehicle. She is looking for confirmation that their earlier class 12 design registration for the vehicle will protect the toy car. During the discussion it also transpires that a local toy manufacturer has already been selling toy cars embodying the actual vehicle for a while. Advise.

(6)

1.5. After having impressed the legal adviser with your knowledge on design law in the matter referred to in 1.4 above, she decides to ask you about the validity of their registered designs for a bonnet, grille and front bumper of the vehicle. From the discussion it transpires that each of the designs of the bonnet, grille and front bumper is protected by an aesthetic and functional design registration. Advise, with reference to case law, as to the validity of both the aesthetic and functional design registrations.

(6)

1.6. Briefly explain what the release date of a design is and how it impacts on the state of the art.

(3)

1.7. Prepare definitive statements for the following designs, whilst also indicating the part (functional / aesthetic) in which the designs will be filed. Provide your reasons if you are of the view that it can be filed in both.

NOTE: Please answer in the following format:

Article: *A bottle* (Identify article)

Part: *Part A* (List only most relevant part)

Features: *Shape* (List features)

Disclaimer: *Irrespective of xxx*(only if required)

1.7.1. Figure 1. Hairdryer.

1.7.2. Figure 2. A pipe socket for connecting two pieces of piping to one another in a fluid tight manner.

1.7.3. Figure 3. A bottle carrying a decorative finish on its exterior surfaces.

1.7.4. Figure 4. An integrally formed toothbrush. The head of the toothbrush may vary between different models.

1.7.5. Figure 5. Cutlery carrying a new handle design.

(16)

[65]

2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Your client has created a new design and would like to file a design application for the design. However, the filing fees are prohibitive at this stage and your client therefore considers approaching an investor to finance the design application. Your client mentions to you that he is not too concerned about filing the application in both of their names as co-applicants. Advise your client as to the rights of joint owners of a registered design.

(5)

2.2. List the grounds on which one may apply for the revocation of a design registration.

(5)

2.3. You friend has designed a kettle and proceeded to protect the design by obtaining registered design protection in South Africa. A representation of your friend's design is shown in Figure 6. While paging through a local newspaper your friend noticed that a local bulk retail store is advertising a kettle as shown in Figure 7. Your friend immediately contacts you to take action against the local store for "stealing the design". As you are familiar with the requirements for registrability of a design you start doing some investigation and stumble upon a representation of a kettle (Figure 8) which was in the market prior to the filing date of your friend's design application. In order to advise your friend you order a copy of the D6 and note the definitive statement, which reads as follows:

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

2.3.1. Explain in detail how you would advise your friend as to the potential infringement of his registered design by the kettle of Figure 7. Cite case law where appropriate.

(15)

2.3.2. After considering your advice in 2.3.1 above your friend would like to know whether or not he would be able to amend the design registration to focus on certain features of the design. Advise.

(4)

2.3.3. Would your advice in 2.3.2 have been different if the design application had not yet proceeded to registration?

(1)

2.4. On new client duty you receive a call from a client whose registered design has lapsed due to non-payment of renewal fees which fell due in 2012. Your client advises that he was in financial trouble at the time when the renewal fees fell due and, in view of the fact that the registered design was not critical to their business interests at the time, they had decided not to pay the renewal fees. However, in the light of recent developments in their business the design has become critical and he would like to reinstate the design. Advise your client.

(5)

[35]

TOTAL MARKS 100

- END OF PAPER -

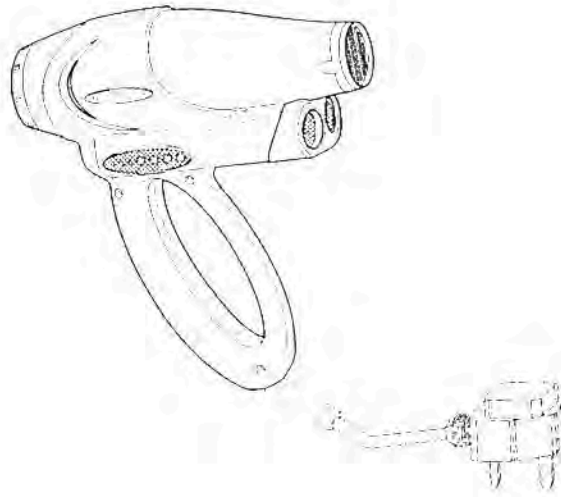


FIGURE 1

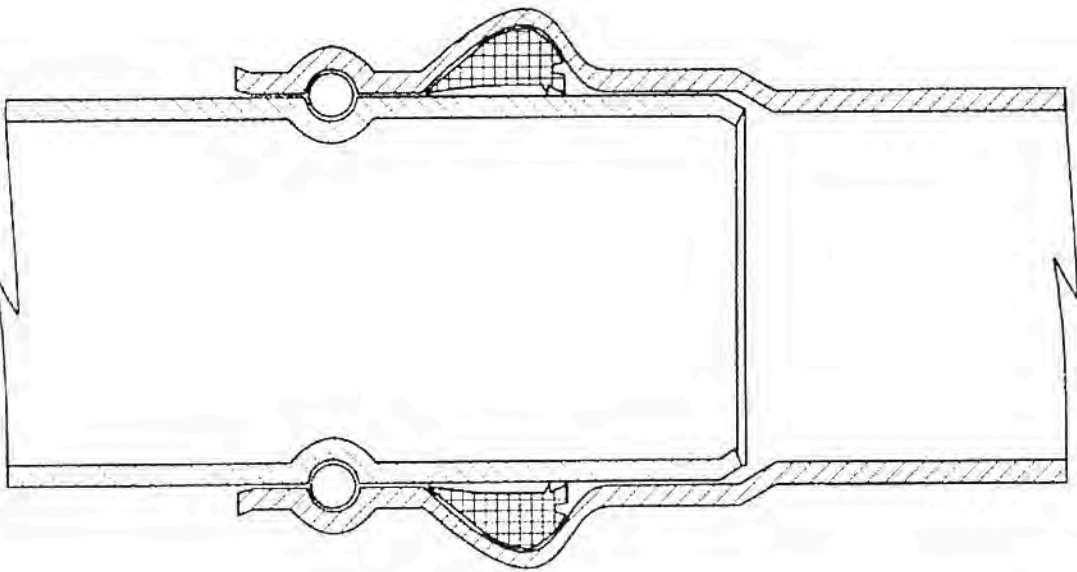


FIGURE 2



FIGURE 3



FIGURE 4

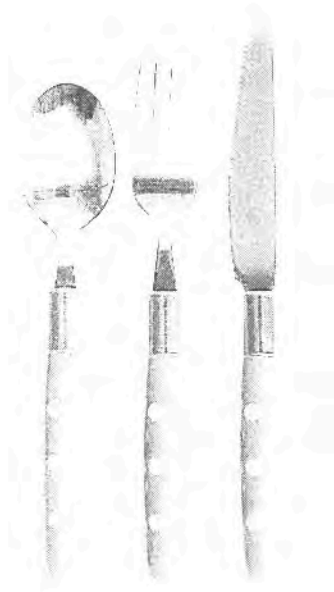


FIGURE 5

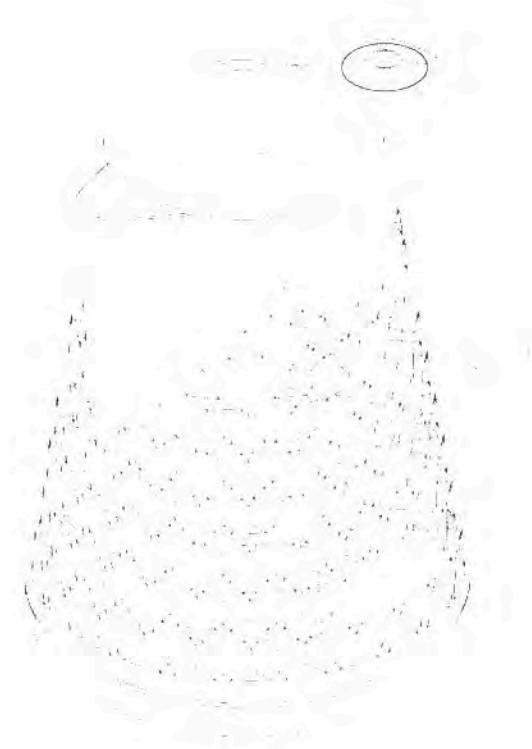


FIGURE 6 – DESIGN

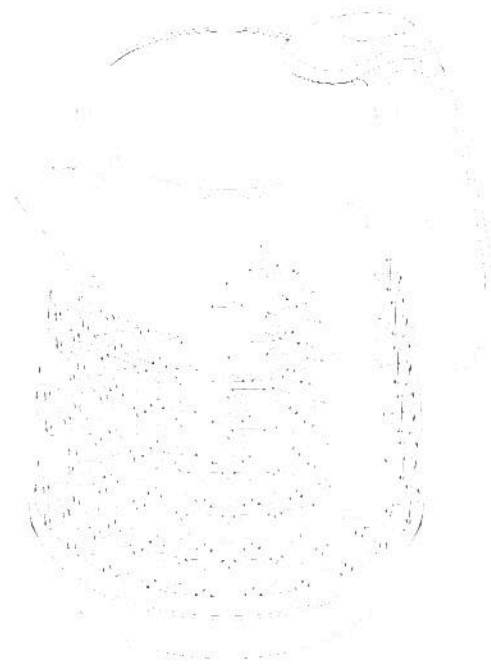


FIGURE 7 – INFRINGING ARTICLE



FIGURE 8 – PRIOR ART