

**EXAMINATION**

**PATENT EXAMINATION BOARD**

**SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW**

**SOUTH AFRICAN DESIGN LAW AND PRACTICE 2010**

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

**EXAMINER: L CILLIERS**

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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. A new day with new challenges awaits... Upon arrival at the office just after 4am (you slept a little later than usual this morning) you realize that it may be a good idea to start the day by doing some studying for the upcoming Design Law examination, as you cannot afford to fail it for the fourth consecutive time. The first issue that catches your weary eyes is the definition of an aesthetic design. 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. After sorting through all the spam in your INBOX (surprisingly, you have won the UK Lottery for an unprecedented 6<sup>th</sup> time!!!) you start to prepare some

draft replies to substantive enquiries. One 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. It's 1:00 in the morning, and insomnia is driving you crazy. Luckily you know that nothing puts you to sleep like Design Law. You decide to 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.

- 1.5.1. Figure 1. A cutter designed to be able to cut into a soft material.
- 1.5.2. Figure 2. Tread of a tire. The design of the wall of the tire may vary.
- 1.5.3. Figure 3. New safety belt design.
- 1.5.4. Figure 4. Handle portion of a toothbrush.
- 1.5.5. Figure 5. Metal extrusion profile used in a frame.
- 1.5.6. Figure 6. Bottle.

(20)

**[55]**

## 2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Your client jointly owns a registered design with his ex-wife. He wants to enforce the registered design against a third party, but his relationship with his joint proprietor has soured. The renewal fees are also due for payment, and he needs to amend the design, prior to enforcing the same. It does not seem as if the dispute between the joint proprietors will be resolved on an amicable basis... Advise your client.

(5)

2.2. In addition to the above, your client is not sure whether the amendment that he refers to should be a correction in terms of S26 of the Designs Act, or an amendment in terms of S27. Briefly set out the difference between S26 and S27 amendments insofar as the nature of the amendment / correction as well as the process is concerned.

(10)

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

(5)

2.4. Your client, *Mr D Ecibel*, is a licensee under a South African registered design for a "Musical Apparatus" as shown in Figure 7. The joint owners of the design registration are *Mr Vuvu*, and his business associate, *Mr Zela*. Your client advises that he recently saw a product from a competitor at a European trade fair, and he expects that the product will be imported into South Africa shortly. *Mr Ecibel* has taken this matter up with *Messrs Vuvu and Zela*. *Mr Vuvu* is keen to take this matter further, but *Mr Zela* (having previously burnt his fingers) is adamant that he wants nothing to do with it, and that he will not support such an action. The competing product is shown in Figure 8.

Your client is aware of a similar product, fondly referred to as the "*Cochlear Compromiser*", which was apparently used in the second world war as a

torturing device, but which later caught on as a handy instrument to keep spectators awake during bowls games. This prior art device is shown in Figure 9.

The registered design is accompanied by a definitive statement which reads as follows:

*“The features for which protection is claimed reside in the shape of, and ornamentation applied to, a musical instrument substantially as shown in the accompanying representations.”*

Explain in detail how you would approach this issue, citing relevant case law where necessary.

(20)

- 2.5. 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 -



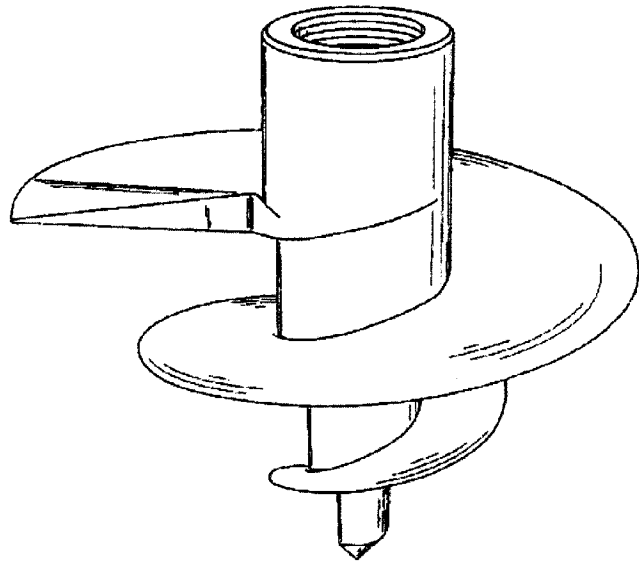


FIGURE 1

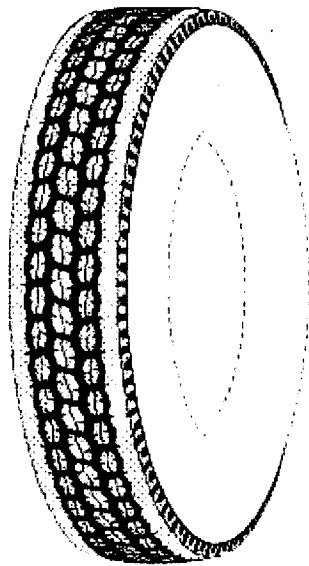


FIGURE 2



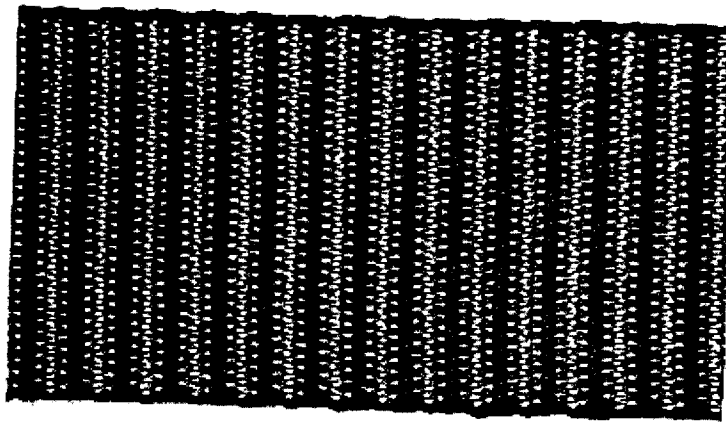


FIGURE 3

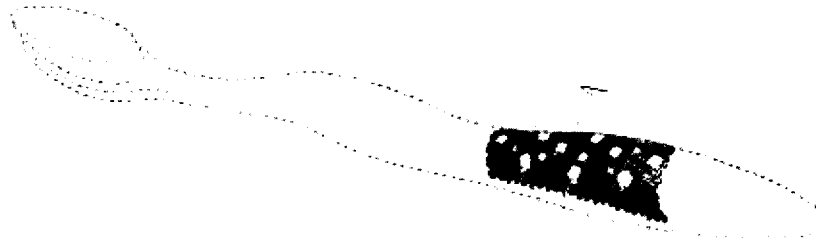
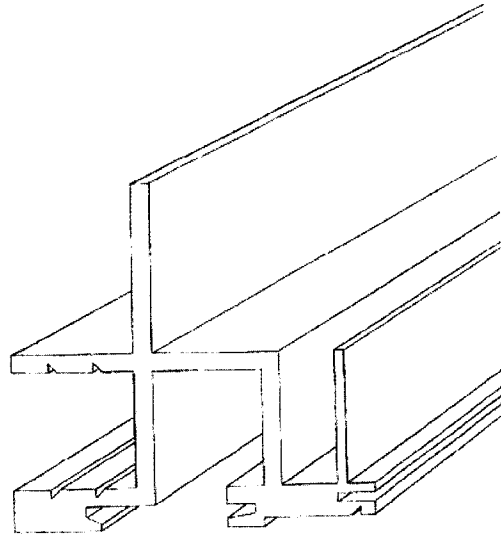
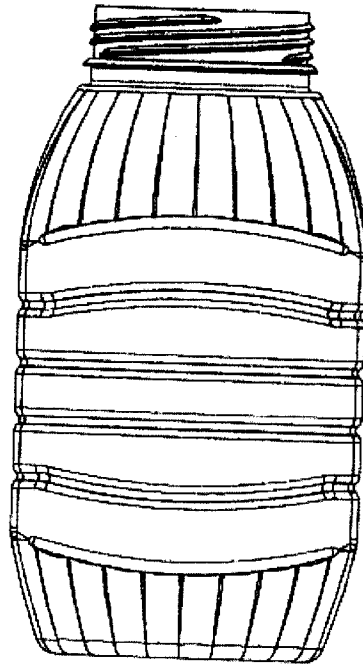


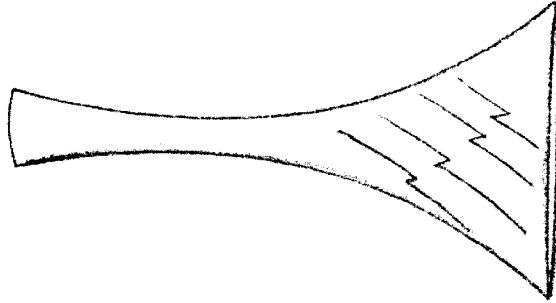
FIGURE 4



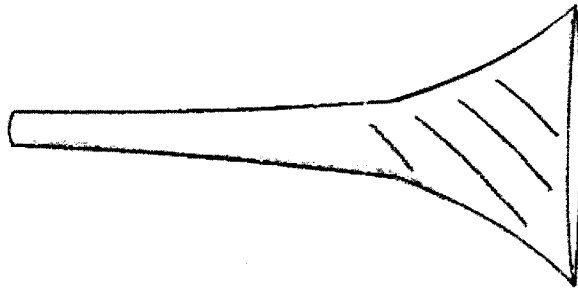
**FIGURE 5**



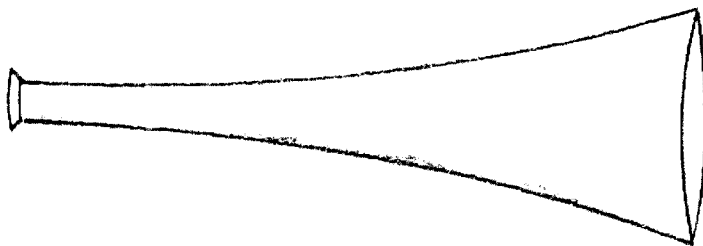
**FIGURE 6**



**FIGURE 7 – DESIGN**



**FIGURE 8 – ALLEGEDLY INFRINGING PRODUCT**



**FIGURE 9 – PRIOR ART**