

PATENT EXAMINATION BOARD
SOUTH AFRICAN DESIGN LAW AND PRACTICE – Group 1(c)

3 December 2010

SUPPLEMENTARY EXAMINATION

ONE FOUR HOUR PAPER (240 MINUTES)

EXAMINER: L CILLIERS

MODERATOR: A VAN DER MERWE

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

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 aspects, i.e. pattern, shape, configuration and ornamentation. Also explain whether you are of the view that colour plays any part in any of the aforesaid. (6)
- 1.2. Your client mentions that he read in your firm's design booklet that, in order to be registerable, an aesthetic design must be new and original, whereas a functional design must be new and not commonplace, but he wants more clarity... Explain to him the meaning of new, original and not commonplace in the context of registered designs. (6)
- 1.3. Back in the office after your first consultation for the morning, you find a friendly reminder on your desk from your principal – he is awaiting the memorandum that you were supposed to prepare on “Filing a set of articles in a single registered design application”. Provide him with your first draft, and also include an example of such a set of articles, including your reasoning as to why the particular example constitutes a set in terms of the Designs Act. (6)
- 1.4. The Designs Act furthermore defines an ‘article’ as “...*any article of manufacture and includes a part of such article if manufactured separately...*”. The Act also prescribes that a design registration may be filed for a single design only. Assess, with proper motivation, the validity of the following definitive statements relating to:

A unitary molded shoe:

1.4.1. *The features for which protection is claimed reside in the shape and/or configuration and/or pattern applied to an upper for a shoe substantially as shown in the accompanying representations.*

(3)

1.4.2. Do you think that the definitive statement could have been worded differently? If so, provide your suggestion.

(2)

A cap for a bottle:

1.4.3. *The feature for which protection is claimed resides in the shape and configuration of a cap for a bottle substantially as shown in the accompanying representations.*

(2)

1.5. Your client tells you that she has recently designed a jewellery set (comprising earrings, a necklace and a ring), each article featuring a similar opal stone, and all articles furthermore being manufactured from the same base metal (being your clients own revolutionary copper and iron alloy that created the impression that the jewellery is made of gold). She has been advised that she will be able to file a single design protecting her novel jewellery set, as they all include the same stone, and are in particular all made of the new metal alloy. Advise your client.

(3)

1.6. Your next client sells vacuum cleaners. After you convinced him that, as candidate attorney, you do not have sufficient funds to buy a vacuum cleaner, you get down to business. He shows you a new seal that he designed for use in the vacuum cleaner, and would now like to protect his design by way of a functional and/or aesthetic design. Advise.

(6)

- 1.7. It's 23:00 on a Friday night, and just as you prepare to leave the office for the weekend you take a call from a frantic client. Your client informs you that he designed a new beer bottle, and that he has disclosed the design in confidence to a business associate. However, the business associate has in turn disclosed the design to the SAB without your client's permission. He wants to know what can be done from a design perspective.

(3)

- 1.8. Would your advice in 1.7 be any different if your client in addition reveals that he has also been providing some of the bottles to Nam Breweries, and that they have been selling beer in such bottles for the past 8 months under the guise of a reasonable technical trial?

(3)

- 1.9. A new day with new challenges, and finally you get to do some work. Draft definitive statements for the following designs, whilst also indicating the part (functional / aesthetic) in which the designs will be filed.

1.9.1. Figure 1. Appearance of head may vary.

1.9.2. Figure 2. Part marked 'A' is a stick-on label.

1.9.3. Figure 3. Many different sole designs are foreseen. Sole is glued to the shoe upper after manufacturing thereof.

1.9.4. Figure 4. Blank for the box shown in figure 5.

1.9.5. Figure 5. Box made of blank of figure 4.

(20)

2. ENFORCEMENT / AMENDMENT / RESTORATION

- 2.1. Your client jointly owns a registered design with his mother-in-law. He wants start manufacturing the articles embodying the registered design, but his relationship with his joint proprietor has soured. At the same time he also wants to enforce the design against a third party, but will have to amend the design before he can do so. It does not seem as if the dispute between the joint proprietors will be resolved on an amicable basis... Advise your client. (6)
- 2.2. The definitive statement of a design application reads as follows:
- “The features for which protection is claimed reside in the shape of and pattern applied to a container substantially as shown in the accompanying drawings.”*
- 2.2.1. Can the definitive statement be amended by removal of the phrase *“and the pattern applied to”* ? Motivate. (3)
- 2.2.2. What about amending the definitive statement to *“...reside in the shape of and pattern and ornamentation applied to a container...”*? Motivate. (3)
- 2.2.3. How would your answers to 2.2.1 and 2.2.2 differ once the application has proceeded to grant? (3)
- 2.3. List the grounds based on which one may apply for a compulsory license. (5)
- 2.4. Your client has received a letter of demand from a competitor, being the proprietor of the registered design shown in figure 6, which he claims is in force and has recently been assigned to him. The letter of demand included the representation shown in figure 6, but the number of the design was not clearly identified. Your client will shortly commence with the manufacturing and sale of the lighter shown in figure 7, but has decided first to advertise his

intended design in a trade journal in order to test the market interest. Your client is also aware of the prior art lighter shown in figure 8, which has been known in the market long before the filing date of his competitor's registered design.

Explain in detail how you would approach this issue, from receiving the letter of demand from your client up to advising your client what he should do next.

(20)

TOTAL MARKS 100

- END OF PAPER -

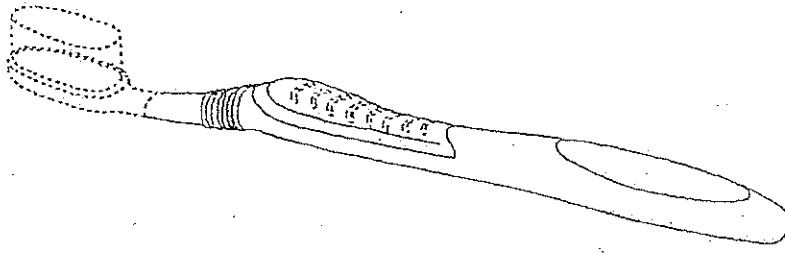


Figure 1

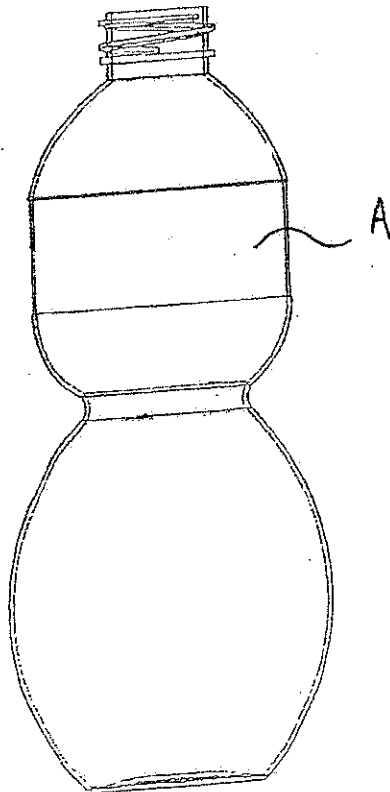


Figure 2

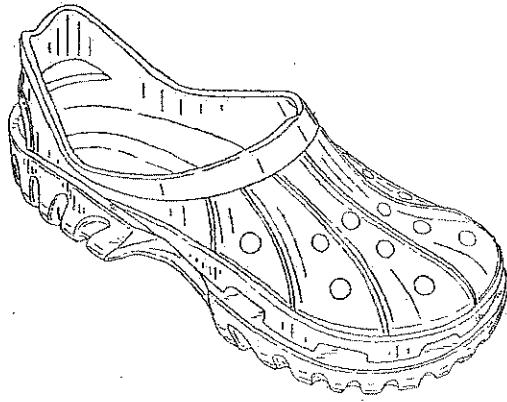


Figure 3

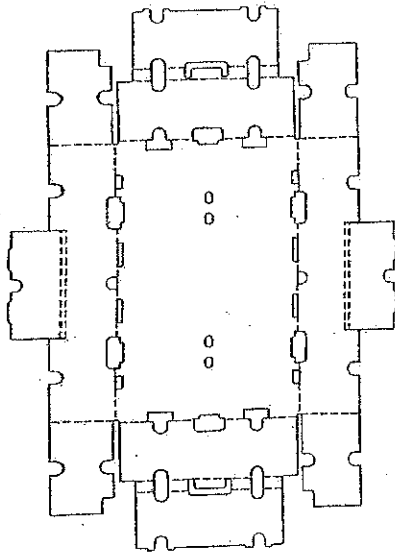


Figure 4

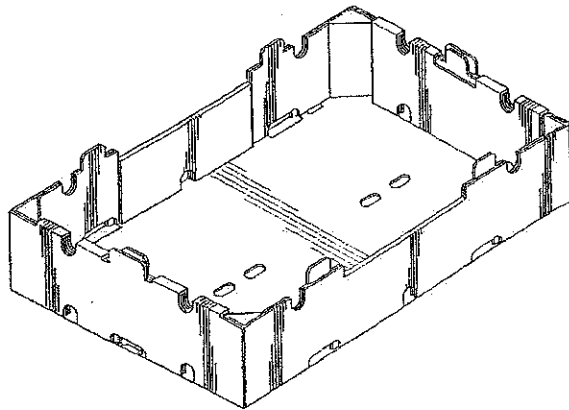


Figure 5

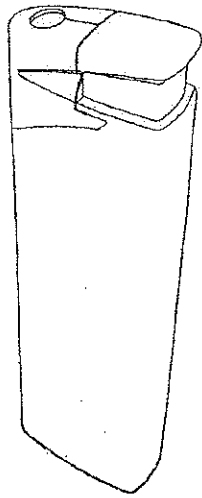


Figure 6

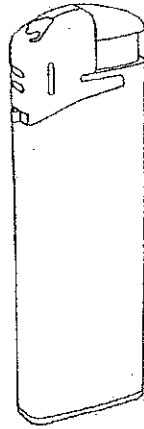


Figure 7

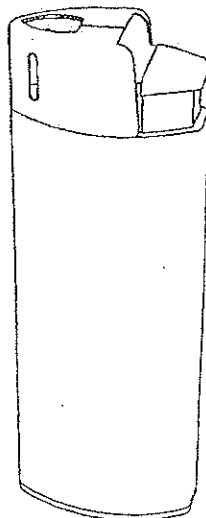


Figure 8