



LOOKING GOOD

An introduction to aesthetic designs for small and medium-sized enterprises



the dtic

Department:
Trade, Industry and Competition
REPUBLIC OF SOUTH AFRICA

the dticc - together, growing the economy

the dticc Customer Contact Centre: 0861 843 384

the dticc Website: www.thedtic.gov.za



© Department of Trade, Industry and Competition, March 2018

Photos are courtesy of **the dtic** image library

the dtic Campus
77 Meintjies Street
Sunnyside
Pretoria
0002

the dtic
Private Bag X84
Pretoria
0001

the dtic Customer Contact Centre: 0861 843 384

the dtic Website: www.thedtic.gov.za

World Intellectual Property Organisation (WIPO)

34, Chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20 Switzerland
Fax: +41 22 338 87 60
E-mail: sme@wipo.int
Website: <http://www.wipo.int/sme>

This publication has been customised, and reproduced with the prior express permission of the World Intellectual Property Organisation (WIPO), the copyright owner of the original English version, which is available at www.wipo.int/sme/en/documents/guides. As such, WIPO is not liable or responsible for the accuracy or correctness of the customised version of the publication, as that liability or responsibility rests solely with the Department of Trade, Industry and Competition of South Africa.

Contents

LIST OF ACRONYMS4

1. Introduction5

2. Policy guidelines to regulate gambling in South Africa as recommended by the
Wiehahn Commission5

3. Regulation of gambling in South Africa7

4. Legal forms of gambling in South Africa8

5. Legal gambling activities8

6. Illegal gambling activities in South Africa12

7. Exclusions from participating in gambling activities13

8. National Responsible Gambling Programme.....13

REFERENCES14

NOTES:15

PREFACE

This is the second in a series of guides developed under the World Intellectual Property Organisation (WIPO) Development Agenda project to assist small and medium-sized enterprises (SMEs) to navigate and optimally utilise the South African intellectual property (IP) rights system. It focuses on aesthetic designs as a key factor in determining the success of products in the marketplace.

In IP law, aesthetic design relates to the outward appearance of a product and is what makes it attractive to the customer, playing a key role in consumers developing a preference for one product over another. Aesthetic design helps companies to differentiate their products from those of competitors and enhances their brand image. That is why it is so important that companies ensure the proper protection of their aesthetic designs.

This guide is an introduction to the protection of aesthetic designs for small and medium-sized enterprises (SMEs) in South Africa. It includes questions and answers, as well as examples and illustrations of aesthetic designs.

The guide has been adapted to the national context by the Department of Trade, Industry and Competition (the dtic). Readers are invited to contact the dtic or the WIPO SME section for further information on the use of IP rights.

REGISTERED DESIGNS

What is a registered design?

For businesses, designing a product generally implies developing its functional and aesthetic features, while taking into consideration issues such as marketability, manufacturing costs as well as ease of transport, storage, repair and disposal. A registered design allows its proprietor to protect the IP that vests in a product's form and/or function. Design law provides a mechanism through which to obtain exclusive rights to a product's functional and/or aesthetic features.

Under South African law, a distinction is made between aesthetic and functional designs.



What is a design in terms of the South African Designs Act?

The South African Designs Act 195 of 1993 governs the registration of designs in South Africa.

In terms of the Act, an aesthetic design is defined as “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, and by whatever means it is applied, having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof”.

In terms of the Act, a functional design is defined as “any design applied to any article, whether for the pattern or the shape or the configuration thereof, or for any two or more of those purposes, and by whatever means it is applied, having features which are necessitated by the function which the article to which the design is applied, is to perform, and includes integrated circuit topography, a mask work and a series of mask works”.

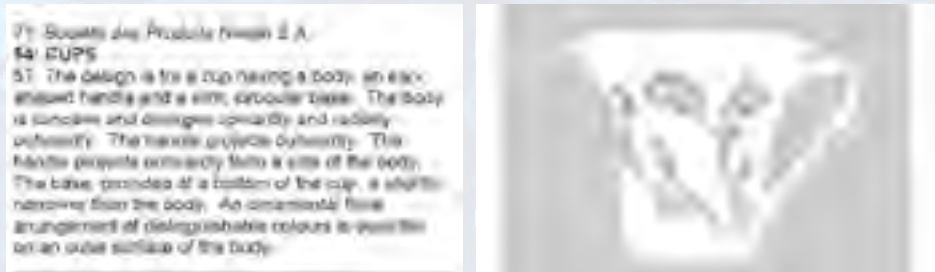
An aesthetic design will focus only on the aesthetic nature of the finished product, regardless of whether there is a technical or functional aspect. As a general rule, an aesthetic design consists of: three dimensional features such as the shape of a product; two dimensional features such as ornamentation, patterns, lines or colour of a product; or a combination of one or more such features.

A functional design focuses only on the features of the design that are necessitated by the function the article is to perform. If it is not clear whether a design has purely aesthetic or functional characteristics, or if it has both aesthetic and functional features, it may be advantageous to register it as both an aesthetic and a functional design.

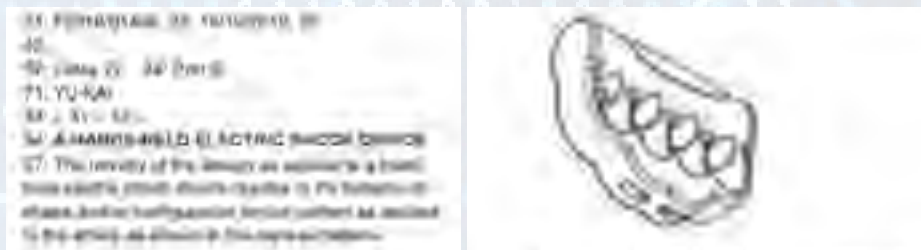
and aesthetic features, while taking into consideration issues such as marketability, manufacturing costs as well as ease of transport, storage, repair and disposal. A registered design allows its proprietor to protect the IP that vests in a product's form and/or function. Design law provides a mechanism through which to obtain exclusive rights to a product's functional and/or aesthetic features.

Under South African law, a distinction is made between aesthetic and functional designs.

An example of an aesthetic design that protects not only the shape of the cup, but also the floral ornamental design depicted (published in the Designs Journal, May 2012):



In South Africa personal security devices are frequently protected by patents and registered designs. Below is an example of a hand-held safety device for which a registered design has been filed. This design has been registered as a functional design (published in the Designs Journal, November 2011):



PROTECTING DESIGNS

Why protect designs?

A design adds value to a product by making it attractive and appealing to customers, and may even be its unique selling point. Protecting valuable designs should therefore be a crucial part of the business strategy of any designer or manufacturer.

Protecting a design through its registration at the national or regional intellectual property office gives the owner the exclusive right to prevent its unauthorised copying or imitation by others. This makes business sense as it improves the competitiveness of a business and often brings in additional revenue.

- By registering a design, you are able to prevent it from being copied and imitated by competitors, and thereby strengthen your competitive position.
- Registering a valuable design contributes to obtaining a fair return on investment made in creating and marketing the relevant product, and thereby improves your profits.
- Registered designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher its value to the company.
- A protected design may also be licensed (or sold) to others for a fee. By licensing it, you may be able to enter markets that you are otherwise unable to serve.
- Registration of designs encourages fair competition and honest trade practices, which, in turn, promote the production of a diverse range of aesthetically attractive and/or functional products.



Exclusive rights

Let us assume that your company has developed an innovative design for an umbrella, and registered it at the South African Designs Office to obtain exclusive rights over that design. If you now discover that a competitor is making, selling or importing umbrellas that bear the same or a substantially similar design, you will be

able to prevent that competitor from using your design in South Africa and possibly even obtain compensation for damages your business has suffered from the unauthorised use of that design. So, while you cannot stop competitors from making competitive products you may prevent them from making products that look just like yours and having a free ride on your creativity. For details on how to enforce your rights you are advised to consult an attorney that specialises in IP law.

How do you obtain protection for designs in South Africa?

To register a design in South Africa, you must file an application at the South African Designs Office in Pretoria. For protection abroad, see Section 3. (A list of websites of IP offices is provided in Annexure II.)

Recent legislation in some countries or common economic areas, such as the European Union (EU), has made it possible to obtain limited protection for unregistered aesthetic designs for three years from the date on which the design is first made available to the public. This gives companies the opportunity to test the success of their products in the marketplace before going through the effort and expense of registering their designs, and is also a good alternative for designs that may remain on the market for a very short time, such as fashion designs. Once the product is manufactured, however, designers have up to 12 months in which to register it. The protection provided to an unregistered aesthetic design is limited in that it is more difficult to enforce than for a registered design and is also shorter, lasting for three years as opposed to the 25 years provided to registered aesthetic designs in the EU.

While this guide focuses mainly on registered aesthetic designs, it is important to point out that in some countries there may be alternative ways of protecting designs (see also section 5):

- Copyright law generally provides exclusive rights for literary and artistic works. In some countries, however, some designs may be considered works of art or applied art and so copyright protection may apply and represent an attractive option for SMEs. The South African Copyright Act specifically lists what is included in the definition of “artistic work” and is quite limiting and does not provide a suitable alternative to design protection. It is therefore not advisable to rely on copyright law to protect either an aesthetic or functional design in South Africa.
- In some countries, including South Africa, an aesthetic design that functions as a trade mark in the marketplace may be protected as a three-dimensional mark. This may be the case when the shape of the product or its packaging is considered to be distinctive, such as a bottle shape.

Creative designs in business

Enterprises often devote a significant amount of time and resources to enhancing the design appeal of their products. New and original designs are often produced to:

1. customise products to appeal to specific market segments – small modifications to the design of some products (e.g. a watch) may make them suitable for different age groups, cultures or social groups. While the main function of a watch remains the same, for example, children and adults generally have very different tastes in design.
2. create a new niche market – in a competitive marketplace, many companies seek to create a niche market by introducing creative designs to differentiate their products from those of their competitors. This could be the case for ordinary items such as locks, shoes, cups and saucers to potentially expensive items such as jewellery, computers or cars.
3. strengthen brands – creative designs are often also combined with distinctive trademarks to enhance the distinctiveness of a company's brand(s). Many companies have successfully created or redefined their brand image through a strong focus on product design.

What rights are provided by registered designs?

When a design is protected by registration, the owner or proprietor of the design is granted the right, for the duration of the registration of the right, to exclude other persons from the making, importing, using or disposing of any article included in the class in which the design is registered, and embodying the registered design or a design not substantially different from the registered design, so that he/she shall have and enjoy the whole profit and advantage accruing by reason of the registration.

What can be registered as an aesthetic design?

Designs must meet the following basic requirements to be registered in South Africa as aesthetic designs:

- it must be “new”. A design will be considered new if it does not form part of the state of the art immediately before the application for registration or the release date (whichever is earlier); and
- it must be “original”. A design will be considered original if it has been independently created by the designer and is not a copy or an imitation of existing designs.

Traditionally, protectable designs relate to manufactured products such as the shape of a shoe, the design of an earring or the ornamentation on a teapot. In the digital world, however, protection is gradually extending in some countries to a number of other products and types of design. These include electronic desktop icons generated by computer codes, typefaces, the graphic display on computer monitors and mobile telephones, etc.

Why is the release date relevant?

In South Africa, a distinction is made between a release date and a date of application. The release date refers to the date on which the design was first made available to the public with the consent of the proprietor. If a design is released prior to filing an application for registration, it will only be deemed new if an application is filed in South Africa within six months of the release date. See also reference to the grace period on page XX.

What cannot be protected as an aesthetic design?

The following cannot be registered as aesthetic designs in South Africa:

- designs that do not meet the requirements of novelty and originality;
- any feature in an article insofar as it is necessitated solely by the function that the article is intended to perform;
- a method or principle of construction; and
- designs that are not intended to be multiplied by an industrial process, which could possibly include handicrafts.

It is advisable to consult an IP attorney specialising in design law to discuss any limitations to a design.

How do you register a design?

All the documentation required for the registration of a design in South Africa can be obtained, free of charge, from the Design Office in Pretoria or downloaded from the Companies and Intellectual Property Commission (CIPC) website at www.cipc.co.za. The following documents are required:

- **Form D1 Application and Acknowledgement Form**

This form is lodged in duplicate at the South African Designs Office and includes the classification details. If you require assistance in classifying the design, it is possible to apply to the Registrar of Designs for assistance at a fee of R220.00. Alternatively, you can obtain the services of a specialised IP attorney. A copy of this form is annexed to this document as Annexure V.

- **Form D2 Register of Designs**

This form forms part of the official records and includes details such as the release date, date of application, whether the design is registered in Part A aesthetic designs or Part F functional designs, the articles to which the design is applied, the address for service, and whether there is a priority date claimed. It is lodged in duplicate.

- **Form D3 Declaration and Power of Attorney**

The applicant is the proprietor of the design and must sign the declaration. A power of attorney may be incorporated into Form D3 and will be required if the application form is filed by a third party representing the applicant. It is advisable to consult with a specialised IP attorney and, in such cases, a power of attorney will be required. The originally signed form must be filed at the designs office, and copies are not accepted.

Form D6 Definitive Statement and Explanatory Statement

The definitive statement is required for all applications while the explanatory statement is not required unless the design is for an integrated circuit topography, mask work or series of mask works (see guide 3 on functional designs). The form is lodged in duplicate. The definitive statement should be a description of the features of the design for which protection is sought such as pattern, shape, configuration, ornamentation, as applicable. In general, an explanatory statement can be used to assist in the interpretation of the design and provides details of the actual design.

- **Form D8 Publication Particulars**

This is lodged in duplicate and includes the definitive statement, the classification as well as the figure that will be used in the publication. It can also include a brief statement of features (of no more than 100 words), which can be used to provide further details of the design that may not be clear from the publication figure. Essentially, this is a combination of the definitive and explanatory statement.

Together with the documentation listed above, “representations” in the form of drawings or photographs need to be included. These should:

- consist of seven identical representations, be these drawings or photographs. Each drawing should be on A4 paper, or each photograph mounted on A4 paper;
- include different perspectives (as applicable), e.g. top, side and front view (seven of each are required);
- a single view must be selected as the publication figure, and two copies clearly indicating “for publication” must be included; and
- all drawings and/or photographs, except those designated for publication, should be signed.

How long does it take to register a design?

Once the application has been lodged at the South African Designs Office, a filing receipt (one of the originally lodged D3 forms) is issued. This provides the official filing date and number. The application is then formally examined. In South Africa, design applications are not published and kept secret until granted. This generally takes about six months. If satisfied, the Registrar of Designs issues a notice of registration that includes notification that the design must be published in the *Patent Journal*. Once the design is published, the application documents become open for public inspection and a registration certificate is issued.

How important is it to keep the design confidential before registration?

If you wish to protect your design under a registration system, keeping the design secret is absolutely crucial. The reason for this is that the central requirement for design protection is that the design must be “new”. If you show your design to others, you should have confidentiality clauses in written agreements, clarifying that the design is confidential.

A design that has already been disclosed to the public by, for example, advertising it in your company's catalogue or brochure may no longer be considered “new”. It becomes part of the public domain and cannot be protected, unless the applicable law of the country provides for a “grace period” or unless the priority of an earlier application can be claimed (see also the section on “How do you protect your designs abroad?”).

Note that South African design law makes provision for the prior disclosure of a design, but since not all countries make this allowance, you should protect your design by registration prior to disclosure, particularly if you are interested in protection in several countries.

What is the grace period?

South African design law makes provision for a grace period if a design is made public or disclosed prior to the filing of an application. This is the case when articles bearing

the design are sold, displayed at a trade show, exhibition or fair, or are published in a catalogue, brochure or advertisement prior to filing an application. The novelty of the design will not be lost provided that an application is filed at the South African Designs Office within six months from the date of first disclosure.

Design protection and business strategy

Decisions on how, when and where to protect a company's industrial designs may have an important impact on other areas of design management. It is crucial to integrate issues of design protection into the broader business strategy of an enterprise. For example, the type of protection, the costs, the effectiveness of protection and issues of ownership of designs, may be important considerations when deciding:

- whether to undertake design development in-house or to commission an outside agency;
- the timing of the initial use of a new design in advertising, marketing or public display in an exhibition; and
- which export markets to target.

How long does protection for aesthetic designs last?

The term of protection for a registered design varies from country to country. In South Africa, an aesthetic design is granted for a period of 15 years from the date of application or the release date (whichever is the earlier).

In many countries, right holders are required to renew their design protection. In South Africa renewal fees become payable on the third anniversary of the release date or the application date (whichever is earlier) and are due annually thereafter.

How much does it cost to protect a registered design?

The fees will vary depending on the number of designs to be registered and the number of countries in which registration is being sought. The actual costs vary significantly from country to country, however, the following costs may be involved in the process:

- search fees to conduct a feasibility search through the official records of the designs office or to instruct a specialised IP attorney to conduct the search and/or prepare an opinion;
- registration fees to be paid to the national or regional IP office;
- fees associated with the hiring of the services of an IP agent to assist in the registration process, if you choose to rely on expert advice to file your application;
- renewal fees, usually on a five-year basis, to maintain exclusive rights over a design; and
- fees associated with the translation of the industrial design if it is to be protected abroad.

In South Africa, an updated list of all official fees that are payable can be found on the CIPC website. At the time

of going to print, the official fee for filing a single design application was R240. It is important to be aware that this fee is only the official filing fee, and if the services of a specialised IP attorney are employed it can cost upwards of R3 000 for an application.

What should you do if your design combines functional improvements with aesthetic design?

In South Africa, it is possible to file a design application for functional design and it may therefore be advisable to file the application in both Part A (for aesthetic designs) and Part F (for functional designs) of the designs register.

However, if the functional improvements meet the necessary requirements for patentability, it may be preferable to apply for a patent or, where the function is not obvious from the product, to keep it as a trade secret.

It is often the case that a new product combines functional improvements with innovative aesthetic features. For example, let us say that you have designed a new cellphone. While the phone may be the result of a series of improvements to the electronic components and could be protected by patent(s), the original design of your phone could be registered as a design. Can you apply for both? The answer is yes.

Many designers protect different aspects of their products with different intellectual property rights. It is important, however, to keep in mind the basic difference between patents and designs. Patents are for inventions that bring about functional improvements to a product, while design protection is for the appearance of the product (aesthetic designs) or for new features, which are necessitated by the function of the article (functional designs).

Who can apply for design protection?

In general, the person who created the design or anyone acquiring the right to the design from such person may apply for the registration of a design. The applicant can be either an individual (e.g. a designer) or a legal entity (e.g. a company). In either case, the application may be made directly or through an agent. If you are a foreign applicant, you may be required to be represented by an agent duly authorised by the IP office of that country.

Who owns the rights over a design?

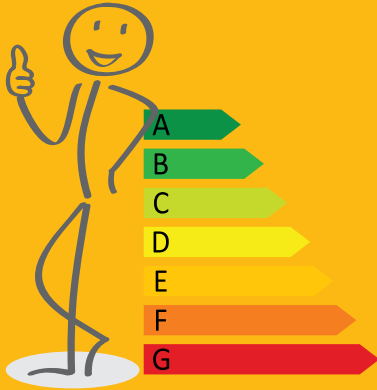
The creator of a design (i.e proprietor) is usually the first owner of the design, unless otherwise provided. Such circumstances may be that the designer created the design as part of his/her employment or that the designer was commissioned to create the design for another person. In such cases, the employer or commissioner are usually the proprietor of the design. The rights to the design could also be transferred to another party in terms of a contract or assignment.

Can you apply for the registration of many designs through a single application?

In many countries, you may apply for the registration of many designs (10, 20 or even 50 designs) through a single application as long as they all relate to the same product or class of products.

In South Africa, however, a single design application can be filed in a single class only. If protection is required in more than one class, separate design applications have to be

filed in each of those classes at the applicable tariffs. The exact details of the requirements and possibilities for seeking protection in a cost-effective manner should be established either with an IP attorney or with the CIPC.



The international classification system

Designs are generally classified or grouped into classes for ease of retrieval. You may be asked to refer to the class of products for which you intend to use the design in question in your application form. Many countries, including South Africa, use the classification of the Locarno Agreement

establishing an International Classification for Industrial Designs (see List of Classes in Annexure II).

When applying for registration of a design it is necessary to indicate in which of these classes protection is applied for. Should protection be required in a different class, a separate application must be made in that class. This has important effect since the protection afforded to a design is limited to the class in which the design has been registered. It is possible that where a registered design is applied to an article not in a class in which the design is registered, it would not constitute an infringement of that registered design. Where an article can be applied in more than one class, separate design applications must be filed in the relevant classes.

Can you license your registered designs?

Registered designs are licensed when the proprietor of the design (licensor) grants permission to another person (the licensee) to use the design for whatever mutually agreed purposes. In such cases, a licensing contract is generally signed between the two parties specifying the terms and scope of the agreement.

Licensing contracts often include limitations as to the countries where the licensee may use the design, the time for which the licence is granted and the type of products for which it can be used. In order to license the use of the design in foreign countries you would need to have previously obtained, or at least applied for, design protection in the countries concerned.

Authorising others to use your designs through a licensing contract will enable your business to receive an additional source of revenue and is a common means of exploiting a company's exclusivity over its registered designs.

Agreements to license designs are often included in broader licensing agreements, which cover all aspects (i.e. not just the visual elements) of a product.

Protecting designs abroad

Why protect designs abroad?

If your company intends to export products bearing an original design, or intends to license the manufacture, sale or export of such products to other firms in foreign countries, it should consider protecting its designs in such countries in order to enjoy the same benefits of protection abroad as it does in the domestic market.

How do you protect your aesthetic designs abroad?

Design protection is territorial. This means that it is generally limited to the country or region where you have registered your design. Hence, if you wish to have your design protected in export markets you would have to make sure that protection is applied for in those specific countries.

A South African application can serve as a basis to claim priority rights in most other countries, provided a corresponding application is filed in that other country within six months of the South African application. Once this period has lapsed, you will be unable to apply for design protection in foreign countries, as your design will no longer be considered new.

There are three ways of protecting your aesthetic designs abroad:

1. national route – companies may seek protection by applying separately to the national IP offices (see Annexure II) of each country in which they intend to obtain protection. The process can be rather cumbersome and expensive as translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees.
2. regional route – if you are interested in a group of countries that are members of regional agreements that enable the registration of designs in more than one country, then you can consider filing a single application at the regional IP office concerned. Regional IP offices include:
 - The African Regional Industrial Property Office (ARIPO) for industrial design protection in English-speaking African countries;
 - the Benelux Office for Intellectual Property (BOIP) for protection in Belgium, the Netherlands and Luxembourg;
 - the Office for Harmonisation in the Internal Market (OHIM) for community designs in the countries of the EU;
 - the Organisation Africaine de la Propriété Intellectuelle (OAPI) for protection in French-speaking African countries.

(See Annexure II for website addresses of regional IP offices.)

international route – companies that wish to register their aesthetic designs internationally in several countries may also use the procedures offered by the Hague Agreement concerning the International Deposit of Industrial Designs, a WIPO-administered treaty. An applicant from a Member country to the Hague Agreement can file a single international application with WIPO; the design will then be protected in as many member countries of the treaty as the applicant wishes. The agreement provides applicants with a simpler and cheaper mechanism for applying for aesthetic design registration in various countries. The costs of an aesthetic design registration under the Hague Agreement vary depending on the number of designs to be protected and the number of countries where protection is sought. However, the entitlement to file an international application under the Hague Agreement is limited to natural persons or legal entities having a real and effective

industrial or commercial establishment, or a domicile, in at least one of the contracting parties to the Hague Agreement, or being a national of one of these contracting parties, or of a member state of an intergovernmental organisation that is a contracting party. Currently, South Africa is not a member of the Hague Agreement. For full information about the Hague Agreement, including a list of member states and the application form, visit the WIPO [whague/](http://www.wipo.int/hague/).



International design protection

In 2001, the 10 largest users of the Hague System for the International Deposit of Aesthetic Designs in terms of the number of applications were the Swatch Group, Interior, Sony Overseas, Hermès, Daimler Chrysler, Nokia, Villeroy and Boch A.G., Moulinex, Philips Electronics and Salomon. In that year, the Swatch Group,

the largest user of the system, deposited 103 applications for design registration using the Hague System. The distinctive “look” of its watches is considered a crucial feature that influences its customers in favouring its products over others. In view of this, companies like the Swatch Group invest large sums of money and expertise in the development of winning designs and make sure they have exclusive rights to the exploitation of their designs through registration in many countries.

ENFORCING REGISTERED DESIGNS

How can you enforce your rights when your design is being imitated, copied or infringed?

Enforcing any IP right may be a complex issue for which it is usually advisable to seek professional assistance from a competent IP attorney. It is important to bear in mind that the main responsibility for identifying and taking action against imitations or infringement

of a design lies with its owner. In other words, you are responsible for monitoring the use of your design in the marketplace, identifying any imitators or counterfeiters and deciding whether, how and when to take action against them.

An IP attorney would normally be the competent person to give you information about the possibilities in South Africa to take legal action against imitators, infringers and counterfeiters and provide you with advice on how to settle any dispute.

Whenever you believe there is infringement, you may choose, as a first step, to send a “letter of demand” informing the infringer of a possible conflict between his design and your exclusive rights. The assistance of a lawyer in drafting such a letter is recommended. If the infringement persists, it may be necessary to institute legal proceedings against the infringer.

If you know the location of the infringing activity, it may be possible to take surprise action by obtaining a search and seize order (usually from a competent court or the police) to conduct a raid, without prior notice to the allegedly offending company/individual.

Measures at the international border are available to the design owner in many countries through the national customs authorities to prevent the importation of infringing goods. This is also the case for South Africa. As a general rule, if infringement is identified, it is highly advisable to seek professional legal advice.

OTHER LEGAL INSTRUMENTS FOR PROTECTING AESTHETIC DESIGNS

There is a measure of overlap between protection granted to artistic works under the Copyright Act and protection granted to the design of articles under design law in South Africa. The first step before taking any decision on how best to protect your design is to understand the differences between these two forms of protection. Some of the main differences are outlined below:

Registration

Under design law, the design generally needs to be registered by the applicant before publication or public use anywhere, or at least in the country where protection is claimed. As mentioned, in South Africa there is a six-month grace period that allows for prior disclosure of a design.

The registration certificate, provided by protection under design law, may prove useful in the case of infringement, as it provides a more solid basis from which you may enforce your exclusive rights.

Copyright subsists automatically in an artistic work provided certain conditions are met. The main conditions are that the work must be original, i.e. the product of independent effort on the part of the author or maker of the article, and the author of the work must be a South African subject or the subject of a country that is a member of the Berne Copyright Convention. Alternatively, if the work is a published work, first publication must have taken place in South Africa or in a Berne Convention country. No copyright register exists in South Africa, although it is possible to register copyright in cinematograph film.

Duration

Aesthetic design protection lasts for a period of 15 years in South Africa. It must also be borne in mind that the process of registration of designs may take some time, and may not always be adequate for products that are linked to passing trends (e.g. fashion designs).

Copyright is immediate and for artistic works (except for photographs). Copyright endures for the entire lifetime of the author and for a period of 50 years after his death. In the case of photographs (also cine films and computer programs), the period of copyright is 50 years after the work is first lawfully made available to the public.

Scope of protection

The right conferred by the registration of a design is an absolute right in the sense that there is infringement whether or not there has been deliberate copying.

To enforce rights under copyright law, the copyright owner must prove that the allegedly infringing work is a direct or indirect reproduction of the work protected by copyright.

Types of products

In most countries, copyright will not protect all designs, but primarily those that may be considered as works of art. The South African Copyright Act defines an artistic work as:

- “irrespective of the artistic quality thereof -
 - i. paintings, sculptures, drawings, engravings and photographs;
 - ii. works of architecture, being either buildings or models of buildings; or
 - iii. works of craftsmanship not falling within either para a or b.”

Artistic works, as defined, essentially refer to visual representations of ideas or the results of intellectual effort in a material form. An article having an aesthetic design will not be protected from being copied under design law insofar as the features that are copied are necessitated solely by the function that the article is intended to perform, or the subject of the copying is a method or principle of construction. Irrespective of the functional nature or otherwise of the features of that article, it will be protected by copyright if what is copied is the original work itself or a two-dimensional reproduction of it. It will, however, not be protected against reverse engineering if the article being copied primarily has a utilitarian purpose.

Costs

Registering your design in the countries you are interested in means that you will have to pay the applicable fees. In addition, it may be useful or necessary to use the services of an IP agent to assist you in drafting the application, which will incur additional costs.

Due to the fact that registration is not required for copyright protection by most national copyright laws, there are generally no direct costs relating to copyright protection. However, there may be costs related to demonstrating proof of ownership in case of disputes.

In summary, while the protection granted by registered designs is stronger in that it covers even unintentional infringement and provides a registration certificate that

may be important proof in case of infringement, it involves more effort (financial and administrative) because it requires registration and is shorter in duration.

In any case, and particularly if the design is not registered, it is generally advisable to keep good records of every step in the development of the design. Signing and dating each sketch, and properly archiving them, may help in case of infringement.

Example: In a recent survey of fabric designers in the United Kingdom, 80% of respondents said they always kept a record of their original design documents and were aware of their importance for proving copyright ownership.

When can trademark law protect a design?

An original and innovative design may also be protected under trademark law in South Africa.

A trademark is a distinctive sign (generally a word, a logo or a combination of the two) used to differentiate the products of one company from those of others. There are circumstances in which the form, design or packaging of a given product may be considered to be a distinctive feature of the product in question and may be protectable as a three-dimensional trademark. The bottle of Coca-Cola or the triangular shape of the Toblerone chocolate bar are some such examples.

It is advisable to consult an IP attorney, particularly one who specialises in trademark law, to determine whether a particular design may be considered a three-dimensional trademark.

Trademark protection has the advantage of being renewable indefinitely, while aesthetic designs are only protectable for 15 years. Trademark protection is more expensive, however, as the fee for a single application is R590 (at time of going to print), while a single design application costs R240.

Do laws on unfair competition protect your design?

South African common law enables the proprietor of a design to prevent others from exploiting a confusingly similar design on the basis of passing off or unfair competition. The

law of unfair competition provides, in general, that anyone who intentionally or negligently causes loss or damage to the owner of a design, through his wrongful conduct, will be liable for damages, and his conduct can be stopped or prevented by way of an interdict.

ANNEXURES

Annexure I: Useful websites

www.wipo.int/sme/ - for more information on intellectual property issues from a business perspective

www.wipo.int/about-ip/en/ - for general information on industrial designs

www.wipo.int/directory/en/urls.jsp - practical aspects relating to the registration of industrial designs

www.wipo.int/hague/en/ - the Hague Agreement for the International Deposit of Industrial Designs:

esigns: www.wipo.int/classifications - the Locarno Agreement Establishing an International Classification for Industrial Designs

www.wipo.int/amc/en/ - arbitration and mediation

Annexure II: National offices

Afghanistan	http://moic.gov.af/en
Albania	http://www.alpto.gov.al/home.asp?l=en
Algeria	http://www.inapi.org/
Andorra	http://www.ompaa.ad/
Angola	http://www.mingmi.gov.ao/
Antigua and Barbuda	http://www.antigua.gov.ag/
Argentina	http://www.inpi.gov.ar/templates/index.asp
Armenia	http://www.aipa.am/hy/
Australia	http://www.ipaustralia.gov.au/
Austria	http://www.patentamt.at/
Azerbaijan	http://www.azstand.gov.az/
Bahamas	http://www.bahamas.gov.bs/rgd/
Bahrain	http://www.moic.gov.bh/moic/en/
Bangladesh	http://www.dpdt.gov.bd/
Barbados	http://www.caipo.gov.bb/site/index.php
Belarus	http://www.belgopatent.org.by/
Belgium	http://economie.fgov.be/en/enterprises/ intellectualproperty
Belize	http://www.belipo.bz/
Benin	See OAPI regional office below
Bhutan	http://www.ipbhutan.gov.bt/aboutus.aspx
Bolivia	http://www.senapi.gob.bo/
Bosnia and Herzegovina	http://www.ipr.gov.ba/en/
Botswana	http://www.mti.gov.bw
Brazil	http://www.inpi.gov.br/
Brunei Darussalam	http://www.agc.gov.bn/
Bulgaria	http://www.bpo.bg/
Burkina Faso	http://www.commerce.gov.bf/
Burundi	http://www.commerceetindustrie.gov.bi/
Cambodia	http://www.moc.gov.kh/
Cameroon	See OAPI regional office below
Canada	http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic. nsf/eng/Home
Cape Verde	URL not available
Central African Republic	See OAPI regional office below

Chad	See OAPI regional office below
Chile	http://www.inapi.cl/portal/institucional/600/w3-channel.html
China	http://sbj.saic.gov.cn/
Columbia	http://www.sic.gov.co/
Comoros	URL not available
Congo	See OAPI regional office below
Costa Rica	http://www.mjp.go.cr/
Cote d'Ivoire	See OAPI regional office below
Croatia	http://www.dziv.hr/
Cuba	http://www.ocpi.cu/
Cyprus	http://www.mcit.gov.cy
Czech Republic	http://www.upv.cz/cs.html
Democratic People's Republic of Korea	http://www.dprkorea-trade.com/patents/rspatent.htm
Democratic Republic of the Congo	See OAPI regional office
Denmark	http://www.dkpto.org/
Djibouti	http://www.mci.dj/
Dominica	URL not available
Dominican Republic	http://onapi.gob.do/
Ecuador	http://www.iepi.gob.ec/
Egypt	http://www.mfti.gov.eg/
El Salvador	http://www.cnr.gob.sv/
Equatorial Guinea	See OAPI regional office below
Eritrea	URL not available
Estonia	http://www.patentinfo.ee/
Ethiopia	http://www.eipo.gov.et/
Fiji	http://www.ag.gov.fj/
Finland	http://www.prh.fi/
France	http://www.inpi.fr/
Gabon	http://cepig.net/
Gambia	See OAPI regional office below
Georgia	http://www.sakpatenti.org.ge/
Germany	http://www.dpma.de/
Ghana	See OAPI regional office below
Greece	URL not available. See OHIM regional office below
Grenada	URL not available

Guatemala	https://www.rpi.gob.gt/
Guinea	See OAPI regional office below
Guinea Bissau	See OAPI regional office below
Guyana	URL not available
Haiti	URL not available
Holy See	http://www.vaticanstate.va/FR/homepage.htm
Honduras	http://www.digepih.webs.com/
Hungary	http://www.hipo.gov.hu/English/
Iceland	http://www.els.is/
India	http://www.ipindia.nic.in/
Indonesia	http://merek-indonesia.dgip.go.id/
Iran (Islamic Republic of)	http://iripo.ssaa.ir/
Iraq	URL not available
Ireland	http://www.patentsoffice.ie/
Israel	http://index.justice.gov.il/
Italy	http://www UIBM.gov.it/
Jamaica	http://www.jipo.gov.jm/
Japan	http://www.jpo.go.jp/
Jordan	http://www.mit.gov.jo/
Kazakhstan	http://www.kazpatent.kz/
Kenya	http://www.kipi.go.ke/
Kiribati	URL not available
Kuwait	URL not available
Kyrgyzstan	http://patent.kg/en
Lao Peoples Democratic Republic	http://www.stea.la.wipo.net/index.html
Latvia	http://www.lrpv.lv/
Lebanon	http://www.economy.gov.lb/
Lesotho	URL not available
Liberia	URL not available
Libya	URL not available
Liechtenstein	http://www.avw.llv.li/
Lithuania	http://www.vpb.lt/
Luxembourg	http://www.eco.public.lu/
Madagascar	http://www.omapi.mg/
Malawi	See ARIPO regional office below
Malaysia	http://www.myipo.gov.my/

Maldives	http://www.trade.gov.mv/
Mali	See OAPI regional office below
Malta	https://secure2.gov.mt/IPO/default.aspx?ct=2&date=22022013111244
Mauritania	See OAPI regional office
Mauritius	http://www.gov.mu/portal/site/mfasite/menuitem.d26b8c9d73facdfa4522e10a0208a0c/
Mexico	http://www.impi.gob.mx/
Monaco	http://en.gouv.mc/Government-Institutions/The-Government/Ministry-of-Finance-and-Economy/Business-Development-Agency
Mongolia	http://www.ipom.mn/
Montenegro	http://www.ziscg.me/
Morocco	http://www.ompic.org.ma/
Mozambique	http://www.ipi.gov.mz/
Myanmar	URL not available
Namibia	URL not available
Nauru	URL not available
Nepal	http://doind.gov.np/index.php
Netherlands	http://www.agentschapnl.nl/en
New Zealand	http://www.iponz.govt.nz/cms
Nicaragua	http://rpi.mific.gob.ni/
Niger	See OAPI regional office below
Nigeria	See OAPI regional office below
Norway	http://www.patentstyret.no/
Oman	http://www.mocioman.gov.om/
Pakistan	http://www.ipo.gov.pk/
Palau	URL not available
Panama	http://www.digerpi.gob.pa/
Papua New Guinea	http://www.ipopng.gov.pg/
Paraguay	http://www.mic.gov.py/v1/index.php
Peru	http://www.indecopi.gob.pe/0/home.aspx?PFL=0&ARE=0
Philippines	http://www.ipophil.gov.ph/index.php
Poland	http://www.uprp.pl/strona-glowna/Menu01,9,0,index,pl/
Portugal	http://www.marcaspatentes.pt/index.php?section=1
Qatar	URL not available
Republic of Korea	http://www.kipo.go.kr/

Republic of Moldova	http://www.agepi.md/
Romania	http://www.osim.ro/
Russian Federation	http://www.rupto.ru/en_site/index_en.htm
Rwanda	http://org.rdb.rw/
Saint Kitts and Nevis	URL not available
Saint Lucia	URL not available
Saint Vincent and Grenadines	http://www.cipo.gov.vc/
Samoa	http://www.mcil.gov.ws/
San Marino	URL not available
Sao Tome and Principe	http://senapi-stp.net/spip.php?rubrique1
Saudi Arabia	URL not available
Senegal	See OAPI regional office below
Serbia	http://www.zis.gov.rs/pocetna.1.html
Seychelles	URL not available
Sierra Leone	URL not available
Singapore	http://www.ipos.gov.sg/
Slovakia	http://www.upv.sk/
Slovenia	http://www.uil-sipo.si/
Solomon Islands	URL not available
Somalia	URL not available
South Africa	http://www.cipc.co.za/
Spain	http://www.oepm.es/
Sri Lanka	http://www.nipo.gov.lk/
Sudan	URL not available
Suriname	URL not available
Swaziland	http://www.gov.sz/index.php?option=com_content&view=article&id=228&Itemid=306
Sweden	http://www.prv.se/
Switzerland	https://www.ige.ch/
Syrian Arab Republic	http://www.spo.gov.sy/
Tajikistan	http://www.ncpi.tj/index2.php
Thailand	http://www.ipthailand.go.th/ipthailand/index.php?lang=en
The former Yugoslav Republic of Macedonia	http://www.ippo.gov.mk/
Timor-Leste	http://www.mj.gov.tl/
Togo	See OAPI regional office below

Tonga	http://www.mci.gov.to/?page_id=1042
Trinidad and Tobago	http://www.legalaffairs.gov.tt/ipo/
Tunisia	http://www.innorpi.tn/Fra/accueil_46_4
Turkey	http://www.turkpatent.gov.tr/
Turkmenistan	URL not available
Tuvalu	URL not available
Uganda	See ARIPO regional office below
Ukraine	http://sips.gov.ua/en/index.html
United Arab Emirates	http://www.economy.gov.ae/Arabic/Pages/default.aspx
United Kingdom	http://www.ipo.gov.uk/
United Republic of Tanzania	See ARIPO regional office below
United States of America	http://www.uspto.gov/
Uruguay	http://www.dnpi.gub.uy/
Uzbekistan	http://www.ima.uz/ru/
Vanuatu	URL not available
Venezuela (Bolivarian Republic of)	http://www.sapi.gob.ve/
Vietnam	http://www.noip.gov.vn/
Yemen	http://www.yipo.gov.ye/
Zambia	http://www.pacra.org.zm/
Zimbabwe	See ARIPO regional office below

Regional offices

African Intellectual Property Organisation (OAPI)	http://www.oapi.int/
African Regional Intellectual Property Organisation (ARIPO)	http://www.aripo.org/
Benelux Office for Intellectual Property (BOIP)	http://www.boip.int
Gulf Cooperation Council	http://www.gcc-sg.org/eng/
Office for Harmonisation in the Internal Market (OHIM)	http://oami.europa.eu/ows/rw/pages/index.en.do

Annexure III: Locarno Agreement

International Classification for Industrial Designs of the Locarno Agreement

List of classes

1. Foodstuffs
2. Articles of clothing and haberdashery
3. Travel goods, cases, parasols and personal belongings, not elsewhere specified
4. Brushware
5. Textile piece goods, artificial and natural sheet material
6. Furnishing
7. Household goods, not elsewhere specified
8. Tools and Hardware
9. Packages and containers for the transport or handling of goods
10. Clocks and watches and other measuring instruments, checking and signalling instruments
11. Articles of adornment
12. Means of transport or hoisting
13. Equipment for production, distribution or transformation of electricity
14. Recording, communication or information retrieval equipment
15. Machines, not elsewhere specified
16. Photographic, cinematographic and optical apparatus
17. Musical instruments
18. Printing and office machinery
19. Stationery and office equipment, artists' and teaching materials
20. Sales and advertising equipment, signs
21. Games, toys, tents and sports goods
22. Arms, pyrotechnic articles, articles for hunting, fishing and pest killing
23. Fluid distribution equipment, sanitary, heating, ventilation and air-conditioning equipment, solid fuel

24. Medical and laboratory equipment
25. Building units and construction elements
26. Lighting apparatus
27. Tobacco and smokers' supplies
28. Pharmaceutical and cosmetic products, toilet articles and apparatus
29. Devices and equipment against fire hazards, for accident prevention and for rescue
30. Articles for the care and handling of animals
31. Machines and appliances for preparing food or drink not elsewhere specified
32. Miscellaneous

Note: For up-to-date information, visit website at the following url: <http://www.wipo.int/classifications/locarno/en/>

Annexure IV – Hague Agreement

Members of the Hague Agreement Concerning the International Deposit of Industrial Designs (as of July 2013)

African Intellectual Property Organisation (OAPI)

Albania

Armenia

Azerbaijan

Belgium

Belize

Benin

Bosnia and Herzegovina

Botswana

Bulgaria

Côte d'Ivoire

Croatia

Democratic People's Republic of Korea

Denmark

Egypt

Estonia

European Union (EU)

Finland

France

Gabon
Georgia
Germany
Ghana
Greece
Holy See
Hungary
Iceland
Italy
Kyrgyzstan
Latvia
Liechtenstein
Lithuania
Luxembourg
Mali
Monaco
Mongolia
Montenegro
Morocco
Namibia
The Netherlands
Niger
Norway
Oman
Poland
Republic of Moldova
Romania
Rwanda
Sao Tome and Principe
Senegal
Serbia
Singapore
Slovenia
Spain
Suriname
Switzerland
Syrian Arab Republic

Tajikistan

Former Yugoslav Republic of Macedonia

Tunisia

Turkey

Ukraine

the dtic Campus

77 Meintjies Street

Sunnyside

Pretoria

0002

the dtic

Private Bag X84

Pretoria

0001

the dtic Customer Contact Centre: 0861 843 384

Website: www.thedtic.gov.za



the dtic

Department:
Trade, Industry and Competition
REPUBLIC OF SOUTH AFRICA

the dticc - together, growing the economy

the dticc Customer Contact Centre: 0861 843 384

the dticc Website: www.thedtic.gov.za

