

SUPPLEMENTARY 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 EIGHT PAGES (INCLUDING COVER) OF WHICH THE LAST TWO
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 designed a new bottle. The shape of the bottle and a logo applied to the bottle are new. 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 bottle and logo 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. (4)

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. (5)

(15)

1.2. One of your clients owns a washing machine repair company. He has designed a new seal for washing machines that has improved performance compared to seals currently available on the market. Your client explains to you that, if he could secure design rights for his new seal, he stands to make a fortune seeing that washing machine seals require frequent replacement due to operational wear. Advise your client on whether or not he will be able to secure design rights for his product.

(5)

1.3. A prospective client wants to know if she can file registered design applications for the various articles listed below. Give 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. (5)

1.3.2. A new hand-made basket. Even though every single basket 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. (3)

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 application has been filed. (4)

1.3.4. Glassware, including wine glasses, beer glasses and tumblers, which all have the same decorative pattern applied to them. (3)

(15)

1.4. You receive a call from one of your clients who is concerned about the validity of his registered design. He filed a design application on 15 September 2015, and the design has recently proceeded to registration. The application specified a release date of 15 April 2015. However, it has now transpired that one of his competitors filed a patent application for a device similar in appearance to the article depicted in your client's design registration. The patent application was filed on 15 July 2015, and was not open to public inspection when your client filed his design application.

1.4.1. Advise your client as to the validity of his registered design.

1.4.2. Would your advice have been any different if your client's design did not have a release date?

(5)

1.5. Provide the definition of state of the art in accordance with the Designs Act.

(5)

1.6. You receive a call from one of your foreign clients who is busy updating their records to include the duration and renewal dates for their South African registered design. Advise your client on the duration of a South African registered design as well as on the payment of renewal fees.

(5)

1.7. One of your clients has read an article on traditional designs and believes that she has a protectable design. Provide the definitions of an indigenous design and a derivative indigenous design.

(5)

1.8. A jewellery designer has asked you for advice on a new necklace that she would like to register. The necklace is made up of individual links which each has a unique shape. The designer would like to protect the appearance of the necklace irrespective of the order in which the individual links are connected to one another. Advise the designer on the registrability of the necklace.

(5)

1.9. Your client recently learned that despite entering into a non-disclosure agreement with an industrial designer, the designer published your client's design on his website without authorisation to do so. Your client is upset seeing that the publication on the website happened about 7 months ago and according to his understanding a release date can no longer be claimed. Advise your client.

(5)

[65]

2. ENFORCEMENT / AMENDMENT / RESTORATION

2.1. Your client is the joint proprietor of a registered design. He wants to enforce the registered design against a third party, but his relationship with his joint proprietor has soured. The renewal fees are 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. List the grounds on which one may apply for a compulsory licence in case of an abuse of rights.

(5)

2.3. Your client sends you a copy of a letter of demand as received from an attorney acting on behalf of your client's competitor. The letter of demand asks for an undertaking that your client immediately ceases infringement of a design application for a sink faucet as shown in Figure 6 otherwise infringement proceedings shall be instituted. The letter of demand states that your client has run an advertisement campaign in which he advertised the sink faucet as shown in Figure 7.

2.3.1. Without drafting a response dealing with the merits of potential infringement, briefly set out the basis on which you would respond to the letter of demand. (3)

A few months later you receive another letter from the attorney acting on behalf of your client's competitor. Attached to this letter is a copy of the registered design from which you note that the definitive statement reads as follows:

"The features of the design for which protection is claimed reside in the shape and/or configuration of a faucet substantially as shown in the accompanying representations".

2.3.2. Your client has asked you for an opinion on the likelihood of a court finding that there is indeed infringement of the registered design based on the sale of your client's faucet of Figure 7. Figure 8 shows the closest prior art. Draft an opinion citing case law where appropriate. (12)

(15)

2.4. The definitive statement of a design application reads as follows:

"The features for which protection is claimed reside in the shape of a container and the pattern applied to the container substantially as shown in the accompanying drawings."

The representation accompanying the design application also shows features of ornamentation.

2.4.1. Can the definitive statement be amended by removal of the phrase "*and the pattern applied to*"? Motivate.

2.4.2. What about amending the definitive statement to “...reside in the shape of and pattern and ornamentation applied to a container...”? Motivate.

2.4.3. How would your answers to 2.4.1 and 2.4.2 differ once the application has proceeded to grant?

(5)

2.5. While inspecting the register sheet of client’s design in 2.4 above, you note that, to your client’s surprise, the design has lapsed nine months earlier due to the non-payment of renewal fees. Your client explains that they moved offices at the time, and that he forgot to update his mailing address. He subsequently did not receive any renewal reminders. Explain the potential remedy and procedure to your client, and also advise as to the implication of this on his intended infringement action.

(5)

[35]

TOTAL MARKS 100

- END OF PAPER -

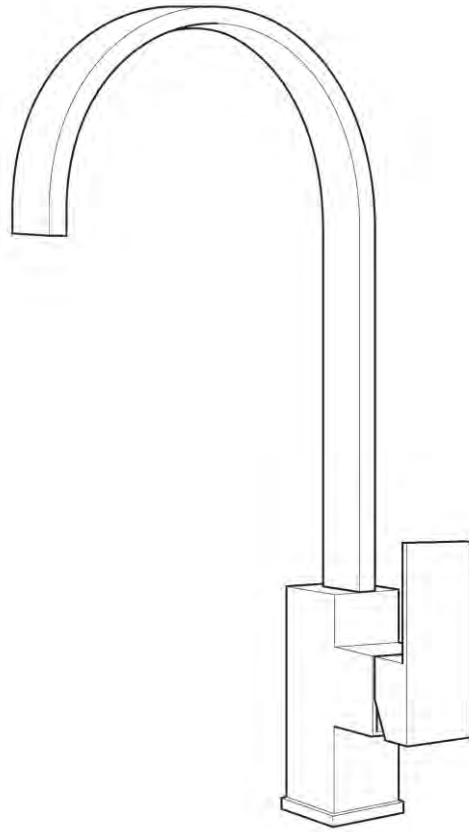


FIGURE 6 – REGISTERED DESIGN

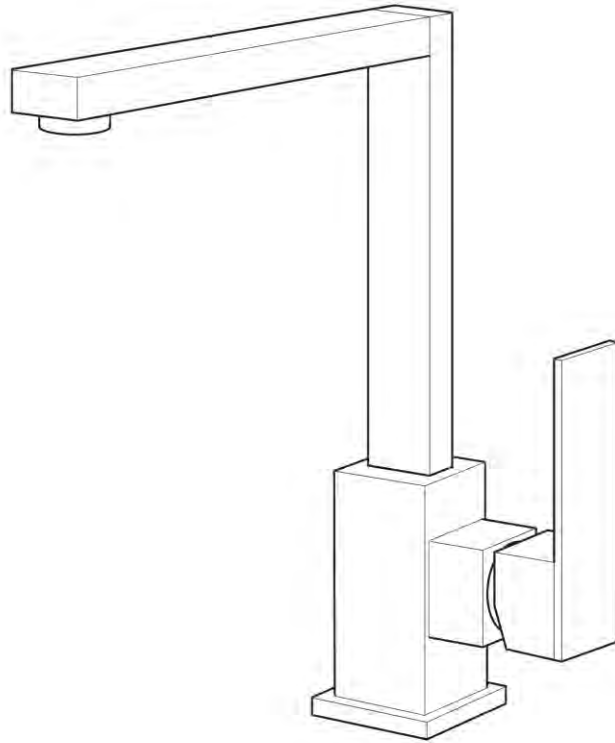


FIGURE 7 – YOUR CLIENT’S ALLEGEDLY INFRINGING DESIGN

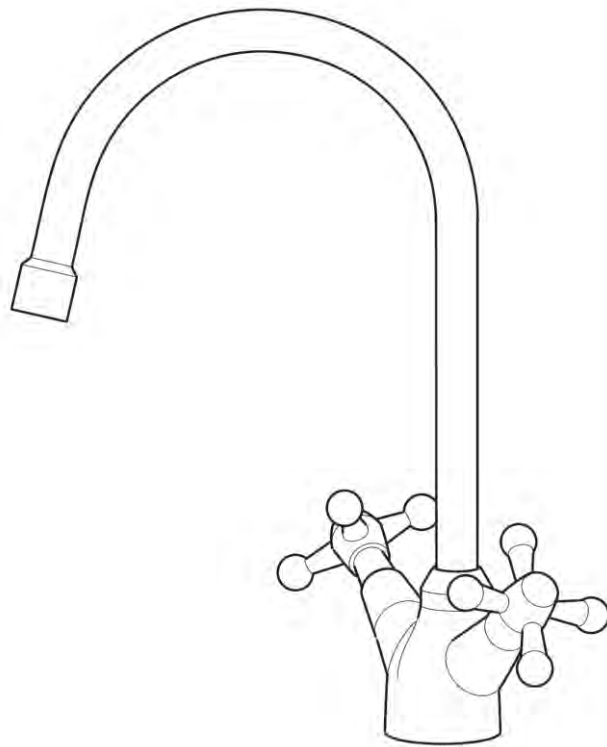


FIGURE 8 – PRIOR ART