

SUPPLEMENTARY EXAMINATION

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2016

ONE FOUR HOUR PAPER (240 MINUTES)

EXAMINER: H VAN SCHALKWYK

MODERATOR: L CILLIERS

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

(12)

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. Your client is the official supplier of the soccer jerseys to a number of clubs. The pattern applied to the shirts are quite common, but the colour combinations (i.e. the way that different colours are used in the 'known' patterns) are, in his opinion, very unique. Advise your client as to the effect of colour in registered designs with reference to this particular situation.

(3)

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. Draft definitive statements for the designs illustrated in Figures 1 to 5. In the figures, the features that are shown in broken line should not form part of the claimed design. In each case, also indicate the part of the register in which you would file the design application.

(15)

[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 tells you that his friend sold him the rights in a registered design for a lighter (Figure 6). He said the transaction was concluded over a few beers in a pub, and he has no paperwork to show for it. He furthermore advises that the previous owner granted a licence under the design, which licence was apparently recorded. The understanding is that this licence will remain in force.

It has now transpired that a third party is advertising a lighter in a trade journal, even though the product has not been released to the South African market yet. The third party is, however already manufacturing the products in China and exporting the same to Europe. The allegedly infringing lighter is shown in Figure 7.

The definitive statement of the design reads as follows:

“The features of the design for which protection is claimed reside in the shape of a lighter substantially as shown in the accompanying representations”

Your client is aware of a prior art lighter shown in Figure 8.

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

(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)

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)

2.4.3. How would your answers to 2.2.1 and 2.2.2 differ once the application has proceeded to grant? (2)

(6)

2.5. Briefly set out the requirements and procedure for restoring a lapsed design registration.

(4)

[35]

TOTAL MARKS 100

- END OF PAPER -



FIGURE 1

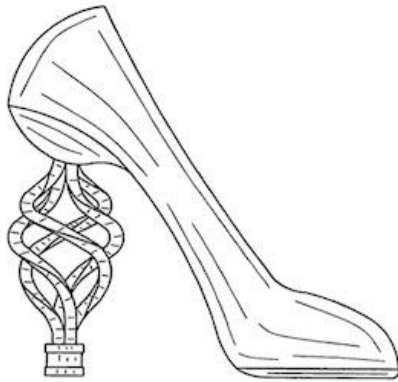


FIGURE 2

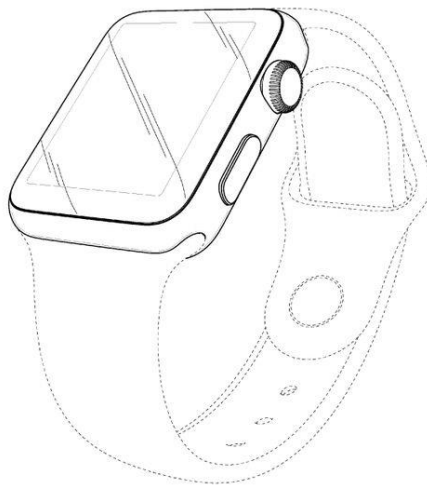


FIGURE 3

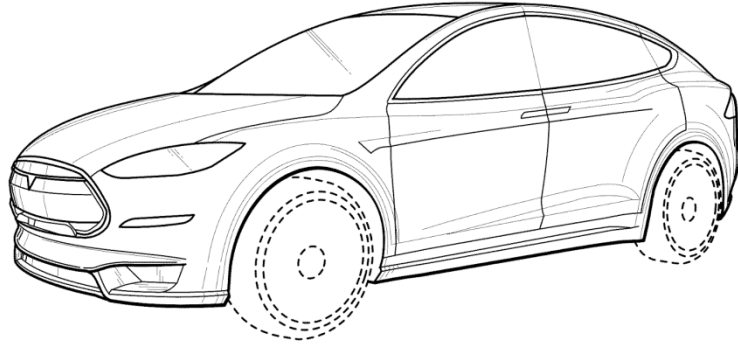


FIGURE 4



FIGURE 5



FIGURE 6 – REGISTERED DESIGN

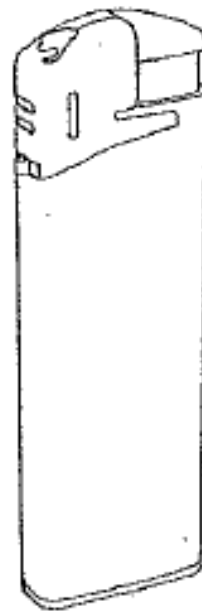


FIGURE 7 –ALLEGEDLY INFRINGING DESIGN

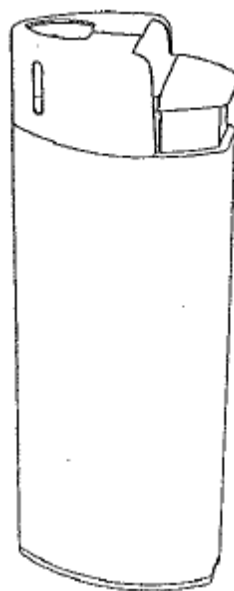


FIGURE 8 – PRIOR ART