

Study unit 3

The requirements for design protection

Overview

<i>Learning outcomes</i>	<p>After completion of this study unit, you should be able to:</p> <ul style="list-style-type: none"><input type="checkbox"/> understand the difference between functional and aesthetic designs<input type="checkbox"/> understand the requirements for aesthetic design protection<input type="checkbox"/> understand the requirements for functional design protection<input type="checkbox"/> explain the exclusions from aesthetic design protection<input type="checkbox"/> explain the exclusions from functional design protection<input type="checkbox"/> understand the interdependence between the different forms of design protection and the exclusions under each form of protection.
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Introduction

The Designs Act of 1993 provides that at its commencement all existing design registrations (i.e. those registered under the repealed 1967 Act) will fall into part A of the register (sect 7(6)), and no amendment may alter a current registration from a part A to a part F registration (sect 27(6)(b)). In the case of a new application for registration, the same design may be registered in both part A and part F of the register (sect 15(3)). The requirements for aesthetic design registration will first be discussed, where after we will turn to a discussion of the requirements for functional design registration.

Aesthetic Designs

definition

The term "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 (sect 1(1)).

1967 Act

An aesthetic design, which is new, original, and intended to be multiplied by an industrial process, can be registered (sect 14(1)(a) read with sect 14(4)). Note that the aesthetic quality of an aesthetic design is irrelevant. This definition is essentially the same as the definition of the term design under the repealed 1967 Act. The principles that were laid down by our courts in interpreting the definition under the 1967 Act may thus be used with the same force and effect that what it had under the 1967 Act. Most of your prescribed cases were decided in terms of the 1967 Act. The principles laid down by our courts under the 1967 Act apply with equal force to aesthetic designs registered under the 1993 Act (refer to *Koninklijke Phillips NV v Kenwood Home Appliances (Pty) Ltd* BIP 206 (TPD) at 210F-G).

Design protection has traditionally rested on three pillars. In *Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd* (1984 (3) SA 681 (A)) these three principles which had long been accepted in the law relating to designs were enumerated.

Reading 3.1

Read *Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd* 1984 (3) SA 681 (A) and find the following three principles:

- ☐ that design protection extends to features of design applied to industrial articles which appeal to, and is judged solely by the eye;
- ☐ that a feature which is necessarily determined by the function of the article in question is not registrable as a design; and
- ☐ that modes of manufacture cannot be registered.

Discussion

Naturally, designs which incorporate registrable as well as unregistrable features may be registered, but only the registrable features will enjoy the protection afforded by registration (see

Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd
(supra at 692G-H).

*Features of pattern, shape, configuration
and ornamentation*

*Shape
configuration*

These features of pattern, shape, configuration or ornamentation should not be regarded as sharply defined and mutually exclusive. Shape and configuration are for all practical purposes regarded as synonymous and signify the three-dimensional contours of something solid, such as the shape of a brush or an iron (see *Kestos v Kempat Ltd & Kemp* (1936) 53 RPC 139 at 152; *Sargent Ltd v Mobbs Ltd* 1937 EDL 131 at 140). Pattern and ornamentation may also be regarded as synonymous and they signify something substantially in two dimensions as opposed to three dimensions, such as the engraved flowers on a watch strap or an embossed pattern on fabric (see *Kestos v Kempat Ltd & Kemp* [1936] 53 RPC 139 at 152; *Wells v Attache Case Manufacturing Co Ltd* [1932] 49 RPC 113 at 118; *Rollason's Design* [1898] 15 RPC 441 at 446; *Bayer's Design* [1907] 24 RPC 65 at 73).

Features which appeal to the eye

The visual norm have been held to be of vital importance and it is the basic premise which forms the cornerstone of aesthetic design protection under the 1993 Act and design protection under the 1967 Act. The eye appeal criterion is not only used to determine whether the design meets the requirements of the definition for protection, but also in deciding the criteria of novelty and originality.

Whose eye?

The “eye” which must judge whether features appeal to and are judged solely by the eye is, according to South African case law, the eye of the court. However, the eye of the court means that the court should view the design through the spectacles of a customer. It is interesting to note that the court may, in a given case, be persuaded that the customer of an article embodying the design may comprise of a class of persons in respect of whom it may be said that they will be influenced solely and exclusively by the function which the article in question is supposed to achieve and not at all by its appearance. In other instances the eye of the court may be that of a young school-going child (read *Slavepak Holdings (Pty) Ltd v Buddy Manufacturers CC* 2002 BIP 221 (TPD) at 227A).

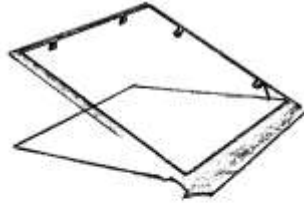
In *Robinson v D Cooper Corporation of SA (Pty) Ltd* (1984 (3) SA 699 (A)) the appellant was the proprietor of a registered design for the metal frame of a ceiling trap door. The validity of the registration was placed in dispute in an infringement action.

Activity 3.1

- ☐ Refer to **Figure 3.1** below, namely that of the registered design for the ceiling trap door of Robinson in *Robinson v D Cooper Corporation of SA (Pty) Ltd* (supra).
- ☐ Read the case and summarise the court's ruling regarding the eye appeal of the trap door.

Figure 3.1

A metal frame trap door at issue in *Robinson v D Cooper Corporation of SA Ltd*



Isometric view



Feedback

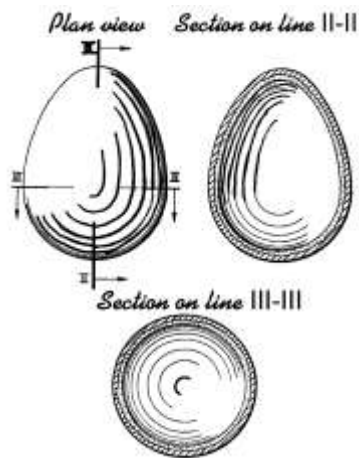
The court held that the features of the design in question must be judged with reference to the article to which it is applied.

The court must consider how and to what extent the design or features of the design will appeal to the eye of the likely customer and influence her in her choice. The court held that the feature of the design for which protection is sought, namely the curve of the edge of the trap door, would not have the effect of influencing the customer to buy that trap door instead of another (see *Robinson v D Cooper Corporation of SA (Pty) Ltd supra*).

Discussion

Chocolate egg

The eye appeal need not immediately be apparent to the person purchasing the article. For example, in *P Ferrero and CSPA Application* ([1978] RPC 473) the registrability of the design of the inside of a chocolate egg was at issue. The court held that the design was eligible for protection even though it only became visible when the customer bit into the chocolate egg (see **Figure 3.2** below). It is not sufficient for the packaging of an article to appeal to the eye: the design features of the article itself must have eye appeal before registration is possible.



The design of a chocolate Easter egg which was upheld in the case of *P Ferrero and CSPA Application*) (*supra*)

Novelty

A registrable design must be new on or before the date of application for registration. The concept of "state of the art" is defined in a manner similar to the definition of this term in section 25(6) and (7) of the Patents Act 57 of 1978.

Novelty

A design is deemed to be new if it is different from or if it does not form part of the state of the art immediately before the priority date (sect 14(2)). For designs, the concept "state of the art" comprises all matter which has been made available to the public (whether in the Republic or elsewhere) by written description, by use or in any other way and all matter contained in earlier co-pending applications (s 14(3)). The criterion is thus one of

absolute novelty.

Described

In section 4(2)(b) it is provided that a design will be deemed to be novel if it has not been described in any publication in the Republic. The term "described" means more than describe in words. A verbal description of the shape or configuration of a design will not destroy the novelty or originality of the design. A visual description, as opposed to a verbal description, is necessary before the design will be deemed to have been described. It has been held that a design will be deemed to be described by a pictorial representation such as a photograph (see *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* 1971 (2) SA 562 (C); *Brudd Lines (Pty) Ltd v Badsey* (2) 1973 (3) SA 975 (T) at 978-979).

Grace period

6 months

The harshness of the absolute novelty requirement is tempered by the six-month grace period granted to the applicant for a design: a design will be deemed to be new if an application for its registration is filed within six months of the date on which the design was first made available to the public (in South Africa or elsewhere) with the consent of the proprietor or any predecessor in title (s 1(1)(xxiv) read with the proviso to s 14(2)).

*commercial
prospects*

This statutory grace period allows a manufacturer to place his/her product on the market in order to assess its commercial prospects. If it is successful, she can obtain protection if she files her application within six months of the release date of the design. This aspect is very important, for example in the context of complex products such as motor vehicles. The proprietor can announce the release of the product on the market and only where the response is positive, lodge applications for design registrations.

Activity 3.2

- ☐ Refer to the following design depicted in **Figure 3.3** below.

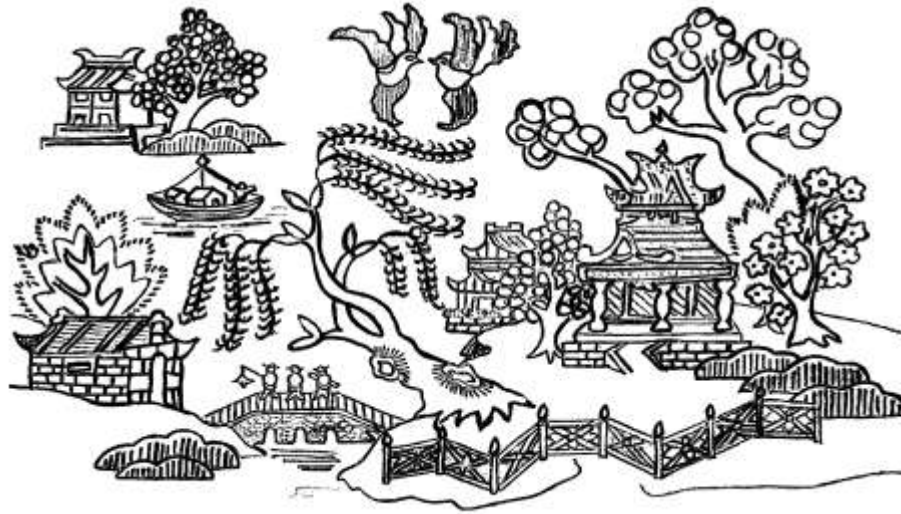
The novelty of the design was at issue in *Screentex v Lyons* 1967 (2) SA 375.

- ☐ Read that case.
- ☐ Would the outcome of this case, if heard today, be

different? Give reasons for your answer.

Figure 3.3

Design that was applied for in *Screenex v Lyons* (supra)



Feedback

Note that this case was decided under the 1918 Act in the absence of a provision similar to section 6 of the 1967 Act (or s 14(2) of the 1993 Act). Section 6 of the 1967 Act and section 14(6) of the 1993 Act allows the proprietor of a design later, even after commercial exploitation of her registered design, to file applications for registration in classes other than those in which her design is registered.

Discussion

Originality

Creative activity

The requirement of originality is only applicable to aesthetic-design registrations, whereas the requirement of not commonplace in the art in question applies only to functional-design registrations. It has been suggested that the requirement of originality should be understood to connote a higher level of ingenuity than not commonplace in the art in question. This is based on the basic premise that the features of a functional design that are necessitated by the function of the article, afford less scope for original, creative activity.

Exclusion of functional features

No feature of an article in so far as it is necessitated solely by the function which the article is to perform, and no method or principle of construction shall give the registered proprietor of an aesthetic design any rights under the Act in respect such feature, method, or principle (sect 14(5)).

Lego bricks

In *Interlego AG v Tyco Industries Inc* ((1988) 2 All ER 949) it was held that the term solely renders the exclusion very narrow. However functional features may be (for example the knobs on Lego bricks) they will not be excluded from protection, provided that their particular proportions are selected with eye appeal in

mind. This means that a design with both eye appeal and functional features can be registered in its entirety, but such functional features will not give the proprietor of the aesthetic design any rights in respect of such functional features.

Criteria

The reasoning of the court in *Amp Inc v Utilux (Pty) Ltd* ([1972] RPC 103) has been accepted as part of South African design law (see *Burrell Design* par 83; see also the similarity of the definition of “design” in both s 1(3) of the UK 1949 Act and s 1(1)(vi) of the 1967 Act). According to these principles the criteria to be used is that of the customer’s choice or selection of the article to which the design is applied.

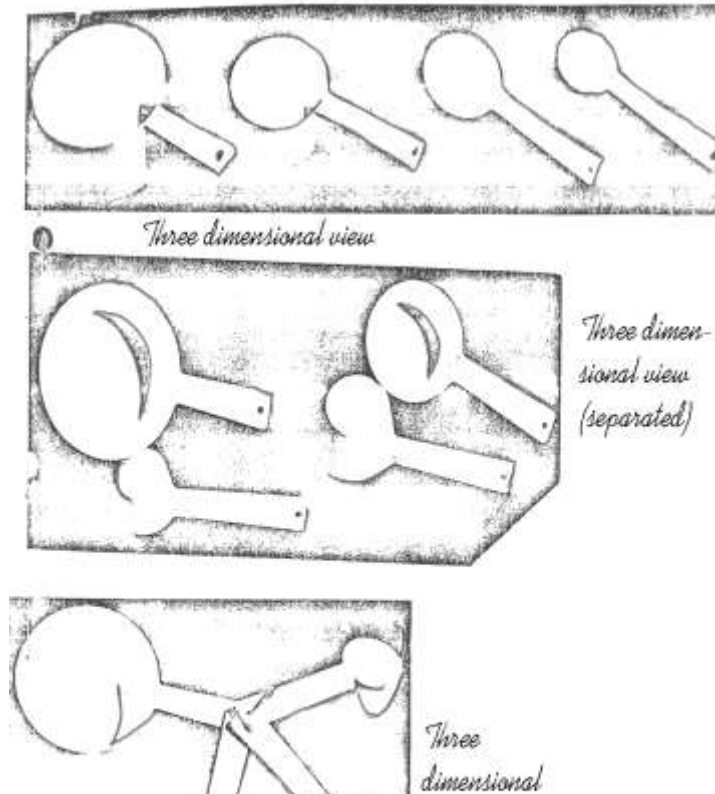
*blend of function
and appearance*

If the selection is solely performance, then the design is not registrable (refer to **Figure 3.4** below and *WRB Enterprises (Pty) Ltd v Plasbox Industrial Appliances (Pty) Ltd* 1975 (1) SA 803 (T)); if the criterion is appearance or a blend of appearance and function, then the design is registrable (see *Swisstool Manufacturing Co v Omega Africa Plastics* 1975 (4) SA 379 (W)).

In *Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd* (supra at 693A) where it was held that a fluting design for building and construction components was registrable because it not only performs a function of imparting additional rigidity to the component, it also has visual appeal.

Figure 3.4

The set of measuring receptacles at issue in *WRB Enterprises (Pty) Ltd v Plasbox Industrial Appliances (Pty) Ltd* (supra)



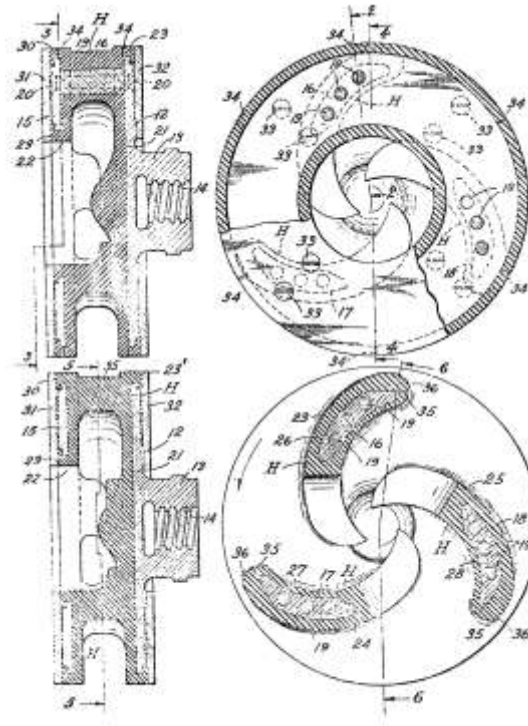
Reading 3.2

Refer to *Allen-Sherman-Hof Co v Registrar of Designs*. Read this case and refer to **Figure 3.5** depicting the design applied to a rubber impeller for a centrifugal pump.

The applicant sought to register a design applied to a rubber impeller for a centrifugal pump. His design application was refused by the Registrar of Designs.

Figure 3.5

The design of a rubber impeller for a centrifugal pump at issue in *Allen Sherman-Hof v Registrar of Designs* (supra)



One of the first cases that dealt with the exclusion of functional features from design registration was *Allen-Sherman-Hof Co v Registrar of Designs* (1935 TPD 270). In this case the registrability of functional designs was examined

[illegible][illegible]

The design registration was refused on the grounds:

- ☐ that the design of the article was imposed on the designer by the choice of material.
- ☐ the shape of the design as applied to the article was necessarily determined by its function.

The court held that in deciding the question whether such purely functional designs are registrable, regard should be had to the following:

..whether that which is desired to register is something which can be treated as a design appealing to the eye, or whether the shape is obviously nothing more than part and parcel of the function without any appeal to the eye as a design, in which case there should be no registration (supra at 273-274).

It was concluded that the design was unregistrable.

Reading 3.3

Refer to **Figure 3.6** and **Figure 3.7**. Do you consider these two designs to be registrable? Now read:

- ☐ *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* (supra)
- ☐ *Swisstool Manufacturing Co v Omega Africa Plastics* (1975 (4) SA 379 (W))

Figure 3.6

The design of a bottle at issue in *Xactics (Pty) Ltd* (supra)



Figure 3.7

The container at issue is *Swiss Tool Manufacturing Co v Omega Africa Plastics* (supra)



[illegible][illegible]

In *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd* (supra) the court addressed the question of functionality. The respondent had registered a design for ribbed plastic bottles. The court noted that the function of the ribbing in relation to plastic bottles is to secure the stability and rigidity required to withstand the forces exerted during the filling and evacuating process. The court noted that evidence pointed to the fact that uniform ribbing gives the greatest strength and that the peaks of the ribs should have flat surfaces (though not too flat). Functionality also dictated that sharp corners should be avoided.

The court noted that a compromise between a rounded rib and a square rib was necessary to be obtained. The trapezoidal rib as found in both the respondent and the applicant bottles proved to be the most suitable choice at (565A-B). The court also noted that the type of ribbing of the registered design was within the optimum range. The court held that the design bottle had no features other than those necessary to enable it to perform its function. No endeavour was present to introduce features which were not connected solely with the function, such as a waist in the cylindrical body or some overall other variation (at 565B-C). If the selection is solely performance, then the design is not registrable. The court thus concluded that the design registration was invalid as the ribbing is purely functional and not a feature of the registered design.

In *Swisstool Manufacturing Co v Omega Africa Plastics* (supra) the court discussed the definition of a registrable design with reference to the eye for determining whether the design embodies those features which are necessary to render the design registrable. The court upheld the dicta expounded in the case of *Amp Inc v Utilux (Pty) Ltd* (supra). The court held that the eye in assessing the design should be the eye of the court, but the court should view the design through the spectacles of the customer. The court held that the features of the design in question were given their appearance partly for visual impact and partly for their function (see *Swisstool Manufacturing Co v Omega Africa Plastics* supra at 384E-F). The design registration was thus held to be valid. Both designs were thus held to be invalid.

Discussion

Exclusion of method or principle of construction

This exclusion embodies earlier dicta that a registered design should not in any way mirror a type of patent; therefore one cannot register a method of manufacture. It has been noted that the real meaning of this exclusion is not to deny a design registration because its shape amounts to a method of construction.

Trap door

In *Robinson v D Cooper Corporation of SA (Pty) Ltd* (supra refer to **Figure 3.1**) the appellant sought to register registration of a design for a metal frame for a ceiling trap door. The court held that the design feature basically involved the bending of the frame of the trap door in order to impart rigidity to it. The court noted that it was an old and well-known principle of construction to bend frames to make it more rigid (supra at 706B). The court held that to enforce such a design would be akin to extend a monopoly on this method of construction to the appellant. The design registration was accordingly found to be invalid (supra at 706E-F).

Since the exclusion of a method or principle of construction from protection as an aesthetic design is not stated to apply to functional designs, one could argue that functional-design protection can extend to features that relate to or are the results of a method or principle of construction.

Conclusion : Aesthetic designs

The protection of aesthetic designs under the 1967 Act and the 1993 Act is in most instances internationally respected and uniform to that of British design law. The outstanding principles are the protection of design features applied to an article, which appeal to and are judged solely by the eye, excluding those features which are dictated solely by the function they are to perform, and excluding any method or principle of construction.

Functional Designs

The unquestionable principles on which design registration rest include novel and original eye-appeal features and the exclusion

of the functional features of the design. The protection of functional features also became the object of design protection as functional designs. This form of design registered protection is not accepted universally. In some jurisdictions, such as the EU and the UK, protection is extended to functional designs, but only in a limited form of unregistered design protection.

*necessitated by
function*

The term "functional design" is defined in the 1993 Act to connote 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 an integrated circuit topography, a mask work and a series of mask works (sect 1(1)).

No eye appeal

The omission of the requirement for features which appeal to and are judged solely by the eye represents a basic and very important deviation from the traditional approach to design protection. In the absence of an eye appeal requirement, it would seem that the design need not be visible, at least not to the naked eye, since the internal configuration of topography of an integrated circuit is protectable as a functional design. This would also appear to open the door to statements of novelty relating to methods or principles of construction in so far as they result in features of pattern, shape, or configuration of an article. The general view is that functional-design registration may well become a useful vehicle for the protection of technology for which patent protection is unavailable for some or other reason.

Requirements for protection

A functional design can be registered if it is new, not commonplace in the art in question, and intended to be multiplied by an industrial process (sect 14(1)(b) read with sect 14(4)).

Not commonplace

It is not clear what is meant by the requirement that the design must not be commonplace in the art in question. The phrase commonplace in the design field in question appears also in section 213(4) of the British Copyright, Designs and Patents Act 1988, but there it serves to define the concept of originality. But in the 1993 Act the phrase commonplace in the art in question cannot relate to the originality requirement for aesthetic designs (see s 14(1)(a)(ii)), for then Parliament would have used the same terminology.

EU Directive

Perhaps this functional-design requirement entails that the design in question should have an individual character (as is required by art 6 of the European Parliament and Council Directive on the Approximation of the Legislations of the Member States on the Legal Protection of Design (COM (93) 344 final COD 464), *Official Journal of the European Communities* C 345/14 (23 December 1993)). Another opinion is that this requirement appears to be intended to exclude the mere commonplace application of existing workshop practices and techniques (see Dunlop 1995 136). Should this be the case, this requirement seems to raise the level of protection to those designs that embody some element of unusualness.

Reading 3.4

Refer to *C & H Engineering v F Klucznick & Sons Ltd* [1992] FSR 421 (Ch D) on the question whether a design drawing is original and not commonplace in the art in question.

Discussion

Exclusion of spare parts

Section 14(6) states that

[I]n the case of an article which is in the nature of a spare part for a machine, vehicle or equipment, no feature of pattern, shape or configuration of such article shall afford the registered proprietor of a functional design applied to any one of the articles in question, any rights in terms of this Act in respect of such features.

Excluded

Note that section 14(6) excludes spare parts only from functional-design protection. The protection of the aesthetic features of a spare-part design is not affected. So, for example, in the case of vehicle body panels such as doors, wings, or hubcaps the aesthetic features of the spare parts can still be protected. In addition, only spare parts for machines, vehicles, or equipment are adversely affected: thus spare parts for other articles (such as furniture) may still enjoy functional-design protection.

The meaning of the term *spare part* is not clear.

Spare part?

In the first instance, it is not clear what an article which is in the nature of a spare part is. Is it a replacement part or is it one that requires to be and is replaced regularly? Should all constituent parts for machinery, vehicles or equipment be defined as spare parts? That would mean that all machines, vehicles and equipment would be excluded from functional-design protection. But the term spare qualifies the term parts and points to a more restrictive interpretation of the term.

not consumables

In *Flogates Ltd USX Corp and USX Engineers and Consultants Inc v Refco Ltd* (High court 4 March 1994 (IPD 17072 June 1994)) it was held that under the term spare parts consumables like coffee filters for a coffee machine or dust bags for vacuum cleaners are not included. *In casu* the court held that the refectories (i.e. the heat-resistant components of valves) that had to be replaced regularly are not spare parts used for repair, but merely consumables, and were known to be part of the cost of purchasing the systems.

The *Flogates* case is of considerable persuasive force in South Africa as no local court has ruled on this point (see *Waylite Diary CC v First National Bank Ltd* 1995 (1) SA 645 (A) at 652G). It may therefore be assumed that section 14(6) will not form a bar against the enforcement of functional-design registrations for items that can be classified as consumables.

Secondly, the meaning of the term vehicle seems reasonably clear. But the same cannot be said for machine and equipment, as these terms may well cover all articles with functional purposes.

Conclusion

We have now seen the characteristics which aesthetic designs and functional designs must display before they will be deemed to be registerable as designs. In the next study unit we will explain the registration process and we will analyse the rights and obligations of designers in more detail.