

Study unit 6

Cumulative protection

Overview

In this unit we will briefly examine the relationships between the design protection of industrial articles and other forms of intellectual property protection that may also be available. We will also examine whether one work may be protected simultaneously by more than one form of intellectual property protection.

<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 differences between the legal requirements for the intellectual property protection of works<input type="checkbox"/> understand the relationship between the different forms of protection
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Guidelines on how to study cumulative of intellectual property protection

It is not a summary of the work - it will merely give you a framework within which to study cumulative of protection. We have divided this framework into six steps.

What is protected?

The starting point is to determine whether the object in question can *potentially* qualify for protection. The object will only qualify if it is the kind of object that is protected by that specific branch of intellectual property.

Law of patents protects an invention. Therefore, you must first

determine whether the object in question is an invention before you even look at the requirements for patent protection. The Patents Act does not stipulate what will be regarded as an invention - rather, it stipulates what will NOT be regarded as an invention.

Copyright protects a “work”. Only a work that falls within the classes of works listed in the Copyright Act can possibly qualify for protection. If something does not fall within any of those categories, it cannot enjoy copyright protection even if it meets the inherent and formal requirements for protection.

Law of trade marks protects trade marks. A trade mark is a specific type of mark. First determine whether the object in question is a mark in terms of the Trade Marks Act, and then whether it is a trade mark. Once again, even if an object meets the requirements for trademark registration, if it is not a trade mark in terms of the Act, it will not qualify for trademark protection.

Design law protects any novel design that is original or not commonplace in the art in question, applied to industrial articles.

When will the object enjoy protection?

The object (an invention in the case of a patent, a work in the case of copyright, and a trade mark in the case of trade marks a design in the case of design law), will only enjoy protection if it meets the requirements for protection. Remember that a patent, a design and a trade mark need to be registered, while copyright protection arises automatically the moment the inherent and formal requirements are met.

Do not confuse the requirements for protection with infringement. Infringement occurs when a person other than the rights holder performs any of the acts that falls within the monopoly of the rights holder without his or her permission. An object can meet the requirements for intellectual property law protection even if it infringes the intellectual property rights of another object.

Students get confused especially in two areas. The first is in the field of law of copyright. Students tend to confuse the requirement of originality with copyright infringement. Remember that the test for originality in South Africa is whether the creator expended sufficient

skill and labour. Where a person translates a book without permission, he indeed expends skill and labour, and thus meets the requirement of originality. However, since the translation was made without permission, it will infringe the copyright in the original language. We therefore have the interesting situation that an infringing work can qualify for separate copyright protection.

The second point of confusion relates to law of trade marks. Most commonly, students tend to confuse the requirements for the registration of a trade mark with the infringement of a trade mark. A mark may not be registered as trade mark if, for instance, it is similar to an existing trade mark. This seems very similar to section 34 that deals with infringement, but it is not. With registration the Registrar will refuse registration, while in the case of infringement the proprietor will bring an action against the user of the infringing mark (the infringer).

Who is the rights holder?

In intellectual property law it is important to distinguish between the creator of an object and the person entitled to commercially exploit the object. The exploitation rights do not always vest in the creator of the object.

The creator of a patent is the inventor. However, it is not the inventor, but the patentee or the licensee who is entitled to exploit the work.

With copyright, the original author is entitled to moral rights, while the copyright owner enjoys the exploitation rights. Sometimes the author is also the copyright owner, but this is not always the case; please study the exceptions listed in the Act as they are very important. Similar exceptions are applicable to design law as the proprietor of a design will not always be the designer.

What are the rights of the person entitled to protection?

We have already explained that the right holder is entitled to exploit the intellectual object. What does this entail? It means that the right holder enjoys certain exclusive rights which only he or she can exercise, or authorise others to exercise.

When will these rights be infringed?

Infringement occurs when someone, without permission, does anything that falls within the monopoly of the rights holder.

Copyright infringement occurs when a person other than the copyright owner exercises any of the copyright owner's exclusive rights without his or her permission. Rights, such as the right to make a reproduction or adaptation or to publish the work, are examples of the exclusive rights of the copyright owner.

In law of trade marks infringement occurs when another uses an identical mark or a mark similar to the registered trade mark in relation to the same, similar, or in the case of a well-known mark, in respect of dissimilar goods or services. Remember to distinguish this from the requirements for registration.

Patent infringement takes place where the monopoly rights are exploited without authorization. Design rights are infringed when a design that is substantially similar is applied to an article for which the design has been registered.

Dual copyright/design protection

copyright protection of aesthetic designs

Under the Copyright Act, 98 of 1978, any original artistic work, whether

it is of a functional or aesthetic nature, may obtain protection.

Similarly,

under the 1993 Designs Act, any novel and original aesthetic design, and any novel and not commonplace design may obtain design protection either an aesthetic design or as a functional design. Note the exclusions to design protection in section 14: no aesthetic design may be registered in respect of functional features or method or principle of construction; no functional design registration may be granted for spare parts. The protection of functional and aesthetic designs under copyright law is in principle permissible, as no statutory prohibition exists.

First, the implications of the multiplication of the work by an industrial process will be noted. Where a functional design is protected as a

copyright work, it must be noted that the multiplication of the work may have dire implications for the copyright owner in terms of section 15(3A) of the Copyright Act. Only functional design protection will remain.

industrial

process

Where an aesthetic design is protected as a copyright work, the multi-
plication of the work by an industrial process will not have any effect on the copyright protection of the work as it is not primarily of a utilitarian nature. In both cases where the work is not multiplied by an industrial process no design protection will be obtainable, but full copyright protection will be in effect for fifty years after the death of the author. (See s 14(4) which provides that designs for articles which are not intended to be multiplied by an industrial process shall not be registrable.)

Patent/design protection

A patent grants a monopoly to the patentee to exploit the invention for a limited time in exchange for the publication of the invention. Any new invention which involves an inventive step and which can be used in trade, industry or agriculture, can be patented. Section 25(2) of the Patents Act 57 of 1978 contains a list of inventions that are not patentable, which includes computer programs (See s 25(3).) This is only true insofar as the computer program relates to that invention as such.

absolute novelty

The novelty requirement is strict and requires absolute novelty. The Act further provides that any variety of animal or plant or any essential biological process for the production of animals or plants will only be patentable if it is a microbiological process or the product of such a process. (See s25(4)(b); s 32(6) contains special provisions relating to an invention comprising of a microbiological process.)

revocation

Our registration system does not include an examination of the application regarding the criteria for patentability, or opposition to applications. Interested parties may apply for the revocation of a patent once it has been granted, upon the grounds specified in section 61. Here the applicant may apply for the revocation of a patent based on the ground that it is not patentable under s 25 of the Act - (see s 61). The effect of a patent is to grant the patentee the full right to exclude others from making, using, exercising or disposing of the invention.

The term of a patent is 20 years from the date of application, but it territorially limited and applications must be lodged in other countries if the patentee wants international protection for her patent.

inventiveness

By its very nature patent protection is not available for works of applied art. In order to qualify for patent protection an invention must be new, involve an inventive step and be capable of application in industry or agriculture - (see s 25(2) of the Patents Act). An industrial design may qualify as far as two of these requirements are concerned, namely novelty and usefulness. The same level of novelty, namely absolute novelty, is required for both patent protection and design protection - (see s 25(6)). As far as usefulness is concerned, functional designs are by their very nature useful.

not obvious

However, the requirement of inventiveness forms a bar against the protection of works of applied art - (see s 25(10)). In order to be inventive, an invention must not be obvious to a person skilled in the art, having regard to all the matter that forms part of the state of the art - (see s 25(7) (8) & (10) and s 36(9)). This means that it must not be something obvious to the person skilled in the art. This requirement disqualifies industrial designs from patent protection.

exclusion of

artistic works

Furthermore, section 25(2)(d) of the Patents Act provides that any work

which is protected as an artistic work under the Copyright Act, shall not be deemed to be an invention for the purposes of the Patents Act. One exception that may be noted here is production drawings which may illustrate the invention in the specification - (see *Catnick Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 206 where it was held that a patentee is presumed to have forfeited any copyright he held in the production drawings once the patent lapses). In *Tolima (Pty) Ltd v Cugacius Motor Accessories* (1983 (3) SA 504 (W) (at 512B) and *John Waddington Ltd v Arthur E Harris (Pty) Ltd* 1968 (3) SA 405) the dicta of the *Catnic* case was noted and it was held that it is uncertain what approach our courts would follow when considering this issue. It may thus be assumed that the cumulative protection between patent law protection and design protection and/or copyright protection is for all practical purposes non-existent.

The object of protection of an industrial design is different from that of a patent, primarily because an industrial design must relate to the appearance of the object and which is not determined by technical or

functional necessity. The object of patent protection, in contrast, is determined by the functionality of an object or process since it must be an >invention=.

Trade Marks B Trade Marks Act 194 of 1993

<i>capable of distinguishing</i>	An Industrial Design is distinguished from a trademark primarily because it must be is constituted by the appearance of a product, which must be ornamental but not necessarily be distinctive (a prime requirement for a trademark). A trademark although it may consist of all kinds of visible signs, which may or may not be ornamental, must always be distinctive, since a trademark must always be capable of distinguishing the goods and services of one enterprise from another. Therefore the functions of, and justifications for, protecting industrial designs and trademarks are quite different.
<i>function of a trade mark</i>	A trade mark=s function is to distinguish or identify the goods and services of its proprietor from the goods or services of the same kind supplied by some other person. A trade mark is defined in the Trade Marks Act 194 of 1993 as any sign capable of being represented graphically, such as a device, name, signature, word, letter, numeral, shape configuration, pattern, ornamentation, colour or container for goods - (see s 2(1) of the Trade Marks Act).
<i>passing off</i>	Trade marks must be registered in order to receive protection under the Act. The infringement of a common law trade mark (unregistered mark) is actionable by an action for passing off. In order to be registrable, a mark must be capable of distinguishing its proprietor goods or services from that of another and there must be a <i>bona fide</i> intention to use the mark.
<i>restrictions</i>	Several restrictions on registration exist, for example confusingly similar or deceptive marks are not registrable, and the applicant must have the intention to use the mark - (see s 10). Trade marks are territorially limited, and an application for registration of the mark must be lodged in every country where protection is sought.
<i>effect of</i>	The effect of a trade mark registration is that the proprietor can prevent

<i>registration</i>	other persons from using or registering the mark or a confusingly similar mark in relation to the same or similar goods or services. The mark can be assigned, or use of it can be licensed. A trade mark can be registered in perpetuity, subject to the payment of renewal fees every ten years.
<i>trade mark</i>	A mark is infringed where an identical or confusingly similar mark is used
<i>infringement</i>	in relation to identical or similar goods or services in respect of which the mark is registered, or the use of a mark or confusingly similar mark, in relation to any goods or services, if such trade mark is registered and well known in the Republic - (the so-called anti-dilution provision; see s 34 of the Act).
	As the Trade Marks Act of 1993 expressly includes shape and configuration the definition of a trade mark includes “any...shape, configuration, pattern, ornamentation, colour or container for goods or any combination thereof”. An application for the registration of a Weber-type grill may well meet with success under the 1993 Act.
<i>utilitarian features</i>	The 1993 Act provides for certain limitations to inherent features of a trade mark that might hinder the development of any art or industry - (see s 34(2)(e) of the 1993 Trade Marks Act which provides that the <i>bona fide</i> use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern which is registered as a trade mark will not amount to an infringement). Trademark registration is also prohibited where the mark is dictated by a specific technical result or the nature of the goods themselves.
<i>shape container</i>	The rights conferred by the registration of a container for goods as a trade mark confers no right in the shape or configuration <i>per se</i> - (see s 10(11) of the Trade Marks Act of 1993 prohibits the registration of a mark where that mark consists of a container for goods or the shape, configuration, pattern or colour of goods, where the registration of such a mark is or has become likely to limit the development of any art or industry).
<i>containers: trade marks</i>	However, the right in the container shape or configuration <i>per se</i> must be obtained under the Designs Act of 1993. One of the distinctions
<i>vs designs</i>	between trade mark rights and design rights is that whereas the design right holder in a glass bottle would protect the proprietor against imitation for all purposes, the trade mark rights in the same

bottle would protect the proprietor only against imitation of the bottle for the class in which it was registered or for similar goods or services. Well-known container marks can be protected against dilution in respect of any goods or services.

trade marks

The limitations contained in section 10(5) and (11) of the Trade Marks Act of 1993 is pertinent as far as functional designs are concerned and form a bar against the registration of trade marks if the marks contain or consist of certain undesirable features. These prohibited features include those that could limit the development of any art or industry, if they are necessary to obtain a specific technical result, or if they result from the nature of the goods themselves.

functional

Should these prohibitions be compared with the definition of a functional design, namely a design applied to an article having features that are necessitated by the function the article to which the design is applied is to perform.

*no cumulative
protection*

The provisions of section 10(5) and (11) would prohibit the registration of a functional design as a trade mark, as the nature of a functional design, namely something which is necessitated by the function the article to it performs, would fall squarely within the prohibitions. The conclusion must be reached that no cumulative of protection between functional designs and trade marks exist.

Conclusion

Cumulative rights under copyright protection and trade-mark protection of industrial articles do exist, but may be disregarded due to the limitations that have been placed on copyright protection by section 15(3A). Similarly, cumulating right under design protection and trade-mark protection exist. Here the registration of a container for goods as a trade mark is pertinent. But here a distinction should be made between functional designs and aesthetic designs.