

IPSP055 - Essential Industrial Design Law

Assignment 02 - 898979

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26 April 2018



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NOTE

Please note that footnotes will be denoted as ¹ and will appear at the bottom of the page.

References will be denoted by [1] and will appear at the end of the document.

¹This is a footnote.

1 Analyse the possibility of design infringement. [20]

As per the definitions of [section 2(1)][2] and given that the Republic is both a Paris Convention as well as a World Intellectual Property Organisation (WIPO) Member State, [article 15(1)][3], [article 1(2)][4], [5], South African statutory design legislation is in compliance with International Conventions and legal instruments.

As per the provisions of [6], patent rights seek to protect the principle underlying an inventive process or product. In contrast the South African Designs Act No. 195 of 1993 [1], provides provisions for the protection of only the physical form of articles of manufacture intended to be multiplied by industrial processes, [section 14(4)][1].

As per the provisions of [section 20(1)][1], the effect of registration of the design in **Figure 2** shall grant the registered proprietor in the Republic, for the [section 22(1)][1], duration of registration the exclusive right to exclude others from **making** or **using** any article included in the class in which their design is registered and embodying the registered design or a design not substantially different from the registered design.

1.1 Infringement

As per the provisions of [section 35(1)][1], the registered proprietor of the design in **Figure 2** may institute proceedings for infringement against Deniz Karasahin, adesignaward.com, for the **unauthorised manufacture** of their Osteoid design, which bears resemblance not substantially different to the registered design as an article of the same class.

1.2 Visual Judgement of Similarity

As per *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another* [7], the test for infringement is a purely visual judgement according to the observation of the likely customer where Judge Corbett referred to Judge Eloff in preceding case law,

“to hold that while the eye is to be the eye of the Court, the Court should view the design through the spectacles of the customer”

wherein the designs are viewed and considered both independently as well as side by side,

“an article must have some special feature which appeals to the eye and distinguishes it from other of its class... This must be decided by the eye; and in applying this visual test the Court must bear in mind the reaction of the likely customer. The two designs must be viewed and compared side by side and also separately.”

1.3 Novelty and Originality

When analysing the possibility of infringement, the state of the art and the degree of novelty and originality achieved by the registered design is also an important factor, in reference to preceding case law, Judge Corbett stipulates, [7] that,

“If only small differences separate the registered design from what has gone before, then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement...”

There are however significant differences between the two designs, in **shape** and / or **configuration**, and there is no risk of a member of the public or likely customer confusing the two designs, where in substantiating proceedings for design infringement applicants have in the past relied on alleged infringement of their registered designs as well as on the delict of passing off, *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another* [7], *Slavepak Holdings (Pty) Ltd and Another v Buddy Manufacturers CC* [8], *Koninklijke Phillips Electronics NV and Another v Kenwood Home Appliances (pty) Ltd* [9].

As per the provisions of [section 35(3)][1], the plaintiff would likely seek and interdict [subsection (a)], assuming the prototype is still in the developmental stages and has not as yet gone into production, and would not likely pursue surrender of goods or damages [subsections (b)-(-d)]. Based on the above arguments however, the plaintiff is not likely to succeed with any design infringement actions within the Republic.

1.4 Recommendation for design and patent protection

The designer Deniz Karasahin, would be strongly recommended to not only seek aesthetic and functional design protection, but also patent protection for their Osteoid design. As per the definitions specified in [section 2][6] and [Article 27(1)][3], the Osteoid prototype need satisfy the provisions for a patent to be granted under [section 25][6], wherein subsection (1) of that section of the Act stipulates that a patent may be granted for a **new** invention², involving an **inventive step**³ and has application to trade or industry⁴.

1.4.1 Aesthetic design registration

As per the provisions of [section 1(1)][1], which stipulates that “...*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 these purposes, and by whatever means is applied, having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof...*”, as was stipulated by Judge Corbett in *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another*:

To qualify as a design, an article must have some special feature which appeals to the eye and distinguishes it from others of its class.”

The **proprietor** of the Osteoid would be advised to pursue aesthetic design registration for their **article**.

1.4.2 Functional design registration

Again as per the provisions of [section 1(1)][1], the definition of a function design is “...*any design applied to any article, either for the pattern or the shape or the configuration thereof, or for any two or more of these 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...*”.

The **proprietor**, Deniz Karasahin, is strongly recommended to lodge both functional and aesthetic design registration applications in respect of their **article**, as per the provisions of [section 14(1)(b)(ii)][1], and the methods and principles of it’s construction² [section 14(4)][1], “*that are not commonplace in the art in question*” and the functional features of the 3D-printed medical cast that requires protection of purely functional design features³.

²Novel 3D-printed design.

³Innovative low-intensity pulsed ultrasound system.

⁴Contributing to the medical healing process.

References

- [1] Designs Act No. 195, 1993.
- [2] Trade Marks Act No. 194, 1993.
- [3] Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994.
- [4] Paris Convention for the Protection of Industrial Property, 1883.
- [5] Hague Agreement Concerning the International Registration of Industrial Designs, 1925.
- [6] Patents Act No. 57, 1978.
- [7] *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another*, 1984 1984 (3) SA 681 (A).
- [8] *Slavepak Holdings (Pty) Ltd and Another v Buddy Manufacturers CC*, 2002 BIP 221 (T).
- [9] *Koninklijke Phillips Electronics NV and Another v Kenwood Home Appliances (pty) Ltd*, 2002 BIP 206 (T).