

IPSP055 - Essential Industrial Design Law

Assignment 01 - 751243

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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]

[2]

[3]

[4]

As per the definitions of [section 2(1)][5] and given that the Republic is both a Paris Convention as well as a World Intellectual Property Organisation (WIPO) Member State, [article 15(1)][6], [article 1(2)][7], [8], South African statutory design legislation is in compliance with International Conventions and legal instruments.

As per the provisions of [9], 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 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, so that he shall have and enjoy the whole profit and advantage accruing by reason of the registration./

1.1 Requirements for design protection

1.1.1 Aesthetic design protection

1.1.2 Function; design protection

1.2 Infringement

1.3 Visual Judgement of Similarity

1.4 Innocent Infringement

1.5 Proceedings for Infringement

2 Advise whether the design will qualify for design protection and what the steps are to register it. [20]

2.1 Requirements for design protection

Judson Beaumont, who will henceforth be referred to as the “**proprietor**” of the Beaver Cabinet design which will in turn be referred to as the “**article**”, as per the provisions of [section 1(1)][1] and his Straight Line Designs studio should be advised that the legislation makes provision for both aesthetic designs (Part A) as well as functional designs (Part F) registrations, as per the provisions of [section 14(1)(a-b)][1].

2.1.1 Aesthetic designs

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** would be advised to pursue aesthetic design registration for their **article**.

2.1.2 Functional designs

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...*”.

Whilst it is possible for the **proprietor** 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], it is not obviously apparent that there are any functional features of the Beaver Cabinet article that require protection of purely functional design features or methods and principles of its construction [section 14(4)][1], “*that are not commonplace in the art in question*”. Without any evidence to the contrary, Straight Line Designs would most likely be unsuccessful in seeking functional design registration for their **article**.

2.1.3 Novelty requirements

As per the provisions of [section 14(1)(a)][1], should Judson be able to demonstrate that his Beaver Cabinet is both **new** and **original**, he may in the prescribed manner and on payment of the prescribed fee, apply for aesthetic design registration. Moreover the Beaver Cabinet must be different from or not form part of the **state of the art** within a grace period of six months from the date of first disclosure, or release date [section 14(2)(b)][1]. Where state of the art comprises of all matter which has been made available to the public, within or outside the Republic, by written means, usage or any other form [section 14(3)(a)][1], including all matter contained in pending registration applications [section 14(3)(b)][1]. Courts of the Republic have interpreted the meaning of ‘*original*’ to coincide with that definition outlined in [10], and which was further elaborated on by Judge Van Heerden in *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd*, where he explained that:

“I have accordingly come to the conclusion that applicant’s registered design 68/346 was not new or original by reason of the fact that a design not substantially different therefrom had already been described in a printed publication before the date of application for registration.”

2.2 Requirements and procedure for registration

As per the provisions of [section 44][1], should Judson have either already registered or applied for protection of the Beaver Cabinet design in a convention member state outside of the Republic, then as the **proprietor** of said **article**, in accordance with [1], he may indeed apply for registration within the Republic. Judson may also ensure that he himself is protected by clearly articulated, binding employment agreements with his staff of eight full-time craftspeople, to ensure that he is the unequivocal sole proprietor of the design [section 14(7)][1].

As per the provisions of [section 15][1], there is neither examination nor provision for opposition with regards to the Beaver Cabinet’s registrability. The Registrar will consider Judson’s application and should he be satisfied that all formal requirements have been met in the prescribed manner [section 16][1], he will register the Beaver Cabinet design and issue the official Certificate of registration [section 18][1]. After the certificate is issued and the design is published as per [section 18(b)][1], the official file is released to the public for inspection [section 19][1]. Judson should expect the process to be completed within 12 months

of the date of filing. Moreover there are provisions for him to correct any clerical errors upon application [section 26][1].

2.2.1 Prescribed filing requirements

Judon's application for the registration of his Beaver Cabinet, must comply with the above mentioned statutory requirements, and be accompanied by the prescribed forms, containing all the required information including but not limited to:

- As the proprietor of the article's design, Judson must provide his name and physical address,
- Article for which design protection is to be applied (Cabinet), and the corresponding international classification [12],
- Type of Design (Aesthetic only *recommended*),
- Number, date and country of the basic application if Convention priority is to be claimed,
- A declaration of novelty or definitive statement outlining all the features of the design for which protection is sought.

References

- [1] Designs Act No. 195, 1993. [Online]. Available: <http://www.wipo.int/wipolex/en/details.jsp?id=13086>.
- [2] *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another*, 1984 1984 (3) SA 681 (A).
- [3] *Slavepak Holdings (Pty) Ltd and Another v Buddy Manufacturers CC*, 2002 BIP 221 (T).
- [4] *Koninklijke Phillips Electronics NV and Another v Kenwood Home Appliances (pty) Ltd*, 2002 BIP 206 (T).
- [5] Trade Marks Act No. 194, 1993. [Online]. Available: http://www.wipo.int/wipolex/en/text.jsp?file_id=130446.
- [6] Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994. [Online]. Available: https://www.wto.org/english/tratop_e/trips_e/trips_e.htm.
- [7] Paris Convention for the Protection of Industrial Property, 1883. [Online]. Available: http://www.wipo.int/treaties/en/text.jsp?file_id=288514.
- [8] Hague Agreement Concerning the International Registration of Industrial Designs, 1925. [Online]. Available: <http://www.wipo.int/wipolex/en/details.jsp?id=12528>.
- [9] Patents Act No. 57, 1978. [Online]. Available: <http://www.wipo.int/wipolex/en/details.jsp?id=6256>.
- [10] Copyright Act No. 98, 1978.
- [11] *Xactics (Pty) Ltd v Tailored Containers (Pty) Ltd*, 1971 (2) SA 562 (C).
- [12] Locarno Agreement Establishing an International Classification for Industrial Designs, 1979. [Online]. Available: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=286253.