

South Africa

Contributing firm
Spoor & Fisher



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Legal framework

South African design law is governed by the Designs Act (195/1993) and proceedings under the act are governed by the Design Regulations (1999). South Africa is party to the Paris Convention and the Agreement on Trade-Related Aspects of IP Rights, but not to the Hague Agreement for the International Deposit of Industrial Designs. Although design protection cannot be obtained by filing an international application in terms of the Hague Agreement, priority can still be claimed from such an international application. South Africa has not signed the Locarno Agreement for the International Classification of Industrial Designs. However, the Locarno classification system was adopted through the Design Regulations.

South Africa has a depository design system, which makes no provision for the substantive examination of design applications. Design applications are examined in terms of formalities only, and if all formal requirements

are met, the design will be registered. A unique aspect of South African design law is that it provides for two types of registered design: aesthetic designs and functional designs. In both cases, the focus of the design is on the appearance of an article to which the design is applied. In the case of an aesthetic design, the features of the design which appeal to the eye are protected, whereas the features necessitated by the function which the article is to perform are protected by a functional design. Functional designs are not to be compared with utility models available in many other jurisdictions, as a functional design protects only the appearance of an article and not the underlying concept.

Unregistered designs

South African design law makes no provision for the protection of unregistered designs. A design that is applied to an article for which no design application has been filed enjoys no protection under the Designs Act.

Registered designs

Only the proprietor of a design may apply for its registration. The proprietor of a design is any

one of the following:

- the author (creator) of the design;
- a party for which the author executed the design;
- the employer of an employee who, in the course of his or her employment, created the design; or
- a party to which ownership of the design has passed (eg, by assignment from the author).

As mentioned above, provision is made for the registration of both aesthetic and functional designs. The features that may be protected by way of an aesthetic design registration are those of shape and/or configuration of the article, and/or a pattern and/or ornamentation applied to the article. The same features, with the exception of ornamentation, may be protected by way of a functional design. Both functional and aesthetic design applications may be lodged in respect of the same article. However, an aesthetic design registration affords the proprietor of the registration no rights in respect of the purely functional features of the article which is the subject of the registration or its method of construction. Thus, if it is important that a functional feature of an article also be protected, then it may be necessary to file aesthetic and functional design applications.

In order to be registrable, an aesthetic design must be new and original, whereas a functional design must be new and not commonplace. The novelty requirement for both aesthetic and functional designs is absolute. However, the Designs Act does allow a two-year grace period in the case of an integrated circuit topography, a mask work or a series of mask works, and a six-month grace period in all other cases. In addition, for both aesthetic and functional design, the article to which the design is to be applied must be intended to be manufactured through an industrial process. The term 'industrial process' should be seen as a requirement for multiple copies. Regardless of the process being used to manufacture the articles, it is imperative that the design for which protection is sought be copied onto each of the multiple copies.

The classification of designs is crucial, as registered design rights are limited to the class in which the design has been registered. It is possible to file applications in more than one class, but these will all be separate and

independent applications. Multiple designs are not protectable in a single application; separate design applications must be filed for different designs. However, a set of articles can be protected through a single design. Any number of articles of the same general character which are ordinarily on sale together or intended to be used together, and in respect of which the same design is applied, constitute a set of articles.

Under Section 14(6) of the Designs Act, a functional design application cannot be filed for the design of an article which is "in the nature of" a spare part for a machine, vehicle or equipment. The exact meaning of the term 'spare part' has not been considered by the South African courts. However, the preceding wording implies a broad interpretation. It is generally believed that the term 'spare part' should be interpreted to include both parts that are designed to wear out and be replaced (eg, brake pads) and those that are replaceable regardless of the fact that the designer did not intend for them to have a limited lifetime (eg, a car bumper).

The spare parts exclusion relates only to functional designs. If an article which is in the nature of a spare part has features that appeal to the eye and which are judged solely by the eye, it may be possible to obtain protection for it as an aesthetic design. However, the Supreme Court of Appeal has ruled that certain vehicle components, including bonnets, grilles, headlight assembly and front fenders, are purely functional and therefore cannot be protected by way of aesthetic designs.

The cost of filing an application for a registered design at the South African Designs Office is typically between \$1,000 and \$1,500, including official and formal fees.

Procedures

An application for the registration of a design must be made on Form D1, accompanied by the following documents:

- Form D2 – register sheet;
- Form D3 – declaration and power of attorney, which declares that the applicant is the proprietor of the design and grants power of attorney to an attorney to file the application on behalf of the applicant;
- Form D6 – indicating, among other things, the classification, the article to which the design is to be applied, the release date (if applicable),

- the type of design, a definitive statement setting out the features for which protection is claimed and, optionally, an explanatory statement for additional clarification;
- representations of the article to which the design is applied; and
- Form D8 – publication particulars.

When filing a convention design application, the following additional documents must be filed in support of the priority claim:

- a certified copy of the first filed application; and
- an assignment of priority rights if the South African applicant is not the same as the applicant in the priority application.

No substantive examination is conducted; on compliance with the formal requirements, a notice of registration is issued by the registrar of designs. Thereafter, the registrar proceeds to publish the notice in the *Patents and Designs Journal*, from which date the registered design is open to public inspection. On publication, a certificate of registration is also issued to the registered proprietor. The application process typically takes between nine and 12 months from filing to publication.

No provision is made for opposition proceedings in the design registration process. Should a third party wish to challenge the validity of a design registration, formal revocation proceedings must be brought in a court of law.

An application for revocation takes the form of an application to the High Court of South Africa, in which both the registered proprietor of the design and the registrar are cited as respondents. No special provision is made for legal proceedings relating to design matters and, accordingly, normal rules of court apply. Evidence on affidavit setting out the facts on which the applicant relies is filed in support of the application for revocation. The application concludes in a hearing and the court decides whether the design should be revoked. Revocation proceedings can take between a few months and a year from application to court judgment.

Enforcement

Under Section 20 of the Designs Act, the proprietor of a registered design has the

exclusive right to exclude others from manufacturing, importing, using and disposing of any article that embodies the registered design, or a design that is not substantially different from the registered design.

Proceedings for infringement of a design may be instituted only by the registered proprietor of the design; prior thereto, the proprietor must give notice to every recorded licensee.

The first step is to ascertain whether a competing article in fact infringes the registered design. The assessment takes the form of a direct visual comparison between the competing article and the representations filed in support of the registered design, while also having consideration to the scope of protection claimed in the definitive statement. South African courts have adopted a test – informally referred to as the ‘step test’ – based on the principle that the scope of protection is determined by the difference of the registered design from the prior art. Where a registered design constitutes only a small advance on the prior art, the scope of the registered design will also be reasonably narrow. On the other hand, where a registered design constitutes a major advance on the prior art, the scope of the registered design will also be reasonably broad.

Infringement proceedings must be instituted in the High Court, either as action proceedings or as application proceedings. In an action for infringement, the issues between the plaintiff and the defendant are defined by an exchange of pleadings; the action terminates in a trial at which oral evidence is heard. In application proceedings, evidence is exchanged on affidavit and terminates at a hearing on paper, without oral evidence being heard.

A successful plaintiff in an action for infringement is usually entitled to the following remedies:

- an interdict (ie, an injunction) ordering the defendant to refrain from further infringement;
- an order for the delivery up of any infringing articles or any article of which the infringing article forms an inseparable part;
- damages for infringement (only in action proceedings); and
- costs of suit.

South African law provides for actual damages only, not punitive damages. The quantum of damages can include any loss of profits that the proprietor of the design has sustained in respect of those infringing articles that would have been made and sold by the proprietor were it not for the sales of infringing articles carried out by the infringer. In view of the difficulty in calculating and proving damages, it is not unusual to ask the court initially only for an enquiry into damages. Such a request can be made without abandoning any rights to claim damages. In lieu of damages, the plaintiff has the option to be awarded an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee in respect of the relevant design.

A judgment of the High Court is subject to appeal to the appeal or full bench of the particular division of the High Court or directly to the Supreme Court of Appeal. A decision of the appeal bench of the court of first instance is also subject to appeal to the Supreme Court of Appeal.

Infringement proceedings typically take between one and two years to resolve.

Ownership changes and rights transfers

The proprietor of a design registration may assign or license its rights in the registration to another person or entity. The recordal of an assignment or licence at the South African Designs Office is not compulsory, but has no validity except as between the parties to the assignment if not recorded. A possible consequence of not recording an assignment is that a third party which has no knowledge of the assignment can deal with the original proprietor as if that person were still the proprietor. This could be extremely detrimental for the new owner, which would have only a contractual claim against the original proprietor.

The Designs Act makes no express provision for the grant of a licence of right. However, the concept of the grant of a licence of right is not foreign to South African law, as the Patents Act provides for the grant of such licence.

Related rights

Designs and trademarks

Developments in both design and trademark law have resulted in a degree of overlap between these two different types of right.

Although registered designs are intended to protect the appearance of an article and not to distinguish the articles of one supplier from those of another, in some cases it would be appropriate to file a trademark application and a design application for the same design. For example, the appearance of a container can be protected by filing a design application and a trademark application, provided that it meets the requirements for both forms of protection.

The introduction of Class 32 for graphic symbols, logos, surface patterns and ornamentation into the ninth edition of the Locarno classification system is another example of the overlap between designs and trademarks. For example, a graphic symbol could be protected as both a registered design and a trademark.

Designs and copyright

The Copyright Act (98/1978) provides limited design-like protection, in that technical drawings used to manufacture articles are subject to copyright as artistic works. In terms of the Copyright Act, another party is not permitted to reproduce the drawings or to make a three-dimensional (3D) article from the drawings without the rights holder's authorisation. However, the protection afforded to designs of articles by the Copyright Act is limited, in that reverse engineering is specifically provided for. The reproduction of 3D articles is allowed if the following three requirements are met:

- The articles have been made available to the public by or with the consent of the rights holder;
- The articles primarily have a utilitarian purpose and are made by an industrial process; and
- The 3D reproductions are made from authorised articles and not from the protected drawings themselves.

Considering the example of a newly designed vehicle, copyright will subsist in the technical drawings – even to an artistic concept model. However, protection will not extend to an actual 3D production model, because the production model will fall within the reverse-engineering clause. However, the 3D production model will be protectable by way of a registered design and, more particularly, an aesthetic design. [WTR](#)

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