

# South Africa

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## I. REQUIREMENTS FOR DESIGN PROTECTION

### A. Legal Framework

#### 1. *Basics of Design Right*

The underlying philosophy of designs, as stated by Baron Pollock in 1892,<sup>1</sup> is to afford protection to that which is not patentable. This notion is supported by the developments of legislature, in which various provisions have aligned the intellectual property law statutes of the Republic of South Africa with one another.

Currently in South Africa, the registration of designs is governed by the Designs Act No. 195 of 1993 (hereinafter referred to as ‘the Designs Act’), as amended by the Intellectual Property Laws Amendment Act No. 38 of 1997, the Companies Act No. 71 of 2008 and the Intellectual Property Laws Amendment Act No. 28 of 2013.

The Designs Act repealed the Designs Act No. 57 of 1967, which was preceded by the Patent, Designs and Trade Marks Amendment Act No. 19 of 1947 and the Patents, Designs, Trade Marks and Copyright Act No. 9 of 1916 (hereinafter referred to as ‘the 1916 Act’), which came into effect on 1 January 1917. The 1916 Act was the earliest intellectual property Act in South Africa (then called the ‘Union of South Africa’), which consolidated the four separate British colonies, those being the Cape of Good Hope, Natal, the Orange River and the Transvaal colonies. It is important to note that the 1916 Act was based on the British Patents and Designs Act of 1907 and thus, the principles of interpretation were based largely on British precedents and case law. For this reason, intellectual property practitioners in South Africa often keep British jurisprudence in mind when interpreting intellectual property law statutes.

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1. *See Moody v. Tree*, 9 RPC 333 at 335 (1892).

However, over the last decade, the South African intellectual property system has developed independently from British jurisprudence to be more in line with various international treaties to which South Africa has subscribed. These treaties include:

- The Paris Convention for the Protection of Industrial Property (1883): The Design priority rights set out in the Paris Convention were adopted in Section 44 of the Designs Act.
- The Agreement on Trade-Related aspects of Intellectual Property Rights (1994) (hereinafter referred to as the 'TRIPS Agreement'): The minimum standards for protection and enforcement of intellectual property rights that member states had to adhere to were incorporated in the drafting of the Intellectual Property Laws Amendment Act No. 38 of 1997.
- The Locarno Agreement Establishing an International Classification for Industrial Designs: South Africa has not officially acceded to the Locarno Agreement. However, the Locarno classification system was adopted under the Designs Regulations of 1999.
- The Hague Agreement for the International Deposit of Industrial Designs provides the opportunity to file a single design application at the International Bureau of WIPO, which extends to several jurisdictions to take effect as a national application. The Parliament of South Africa has approved accession to the Hague Agreement, but this has yet to be effected. At this stage, whether such accession will be effected in the foreseeable future is uncertain.

In July 1999, the Minister of Trade and Industry published Government Notice No. R.843, which set out the Design Regulations (Regulation') in terms of Section 54 of the Designs Act.

The Companies Act No. 71 of 2008 transformed the Companies and Intellectual Property Registration Office (CIPRO), of which the South African Designs Office ('Designs Office') formed part, to the Companies and Intellectual Property Commission (CIPC). The CIPC falls under the dominion of the Department of Trade and Industry, with the Designs Office located in Pretoria and providing services to the public during office hours.<sup>2</sup> Intellectual property practitioners should note that various services are offered online by CIPC ([www.cipc.co.za](http://www.cipc.co.za)). However, caution should be taken when relying on the information on the website without consulting a local practitioner. The Designs Office undertakes only formal examinations of design applications. As such, design applications are not examined substantively in terms of the requirements of the Designs Act.

Section 1(1)(vii) of the Designs Act states that 'court' 'means the division of the Supreme Court of South Africa having jurisdiction in respect of that matter.' The High Court in Pretoria has jurisdiction as the court of first instance to hear litigious matters under the Designs Act. On appeal, provision is made for appeal to a full bench of judges consisting of three judges. However, matters on appeal are normally brought before the Supreme Court of Appeal of South Africa (SCA) in Bloemfontein, previously referred to as the Appellate Division. Leave to appeal may be sought from the court of first instance, or may be sought on petition directly to the SCA. The courts are not presided over by judges specialising in intellectual property, but

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2. See Regulation 2(1).

matters are normally brought to the court by specialist advocates being briefed by specialist intellectual property law firms.

## 2. *Overview of Statutory Requirements*

The Designs Act No. 195 of 1993 enacted a significant, innovative provision with regard to the concept of functionality as applied to design rights. Section 1(1) of the Designs Act provides for *two* types of design registrations as follows:

‘(i) “*aesthetic design*” means 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;’

‘(xi) “*functional design*” means 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;’

Practically, the part of the Register in which the design has been filed can be seen from the registration number which is preceded either by an ‘A’ of an ‘F’ for aesthetic designs and functional designs respectively.

The interpretation of ‘article’ in the definitions of ‘aesthetic design’ and ‘functional design’ is further clarified in Section 1(1)(iv), which states that “‘article’ means any article of manufacture and includes a part of such article if manufactured separately.’

Through the examples discussed below, it will become clear that the South African legislature has attempted to legislate the interpretation of the difference between functional designs and aesthetic designs, thereby making specific provision for both aspects of designs.

The requirements for registrability of the two types of designs differ and are set out in Section 14(1) of the Designs Act, which states:

- ‘(1) The proprietor of a design which
- (a) in the case of an aesthetic design, is
    - (i) new; and
    - (ii) original,
  - (b) in the case of a functional design, is
    - (i) new; and
    - (ii) not commonplace in the art in question,

may, in the prescribed manner and on payment of the prescribed fee, apply for the registration of such design.’

The Designs Act stipulates explicit definitions for the concepts of ‘new’ and ‘the state of the art,’ as quoted hereunder. In terms of novelty, Section 14(2) states:

‘A design shall be 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 date of application for registration thereof or the release date thereof, whichever is the earlier:

‘Provided that in the case of the release date thereof being the earlier, the design shall not be deemed to be new if an application for the registration of such design has not been lodged

- (a) in the case of an integrated circuit topography, a mask work or a series of mask works, within two years; or
- (b) in the case of any other design, within six months, of such release date.’

The definition of the ‘state of the art’ is specified in Section 14(3):

‘The state of the art shall comprise –

(a) 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

(b) all matter contained in an application –

- (i) for the registration of a design in the Republic; or
- (ii) in a convention country for the registration of a design which has subsequently been registered in the Republic in accordance with the provisions of section 44,

of which the date of application in the Republic or convention country, as the case may be, is earlier than the date of application or the release date contemplated in subsection (2).’

Furthermore, Section 14(4) states that ‘Designs for articles which are not intended to be multiplied by an industrial process shall not be registrable under this Act.’

*Bress Designs (Pty) Ltd v. G Y Lounge Suite Manufacturers (Pty) Ltd and Another 1999 (2) SA 455 (W) C* interpreted this provision to not be restricted to articles produced by an automated process. Handmade articles may constitute ‘an industrial process’ provided that an intention exists for the manufacturing process to be repeated multiple times, thereby producing multiple identical designs. Should a single article be made, albeit novel and original, the article will not fulfil the industrial process requirement and as such, shall not be subject to design protection.

The period of monopoly granted under the Designs Act differs between functional and aesthetic designs.<sup>3</sup> Designs registered under Part F (functional designs) are granted a ten-year monopoly. Designs registered under Part A (aesthetic designs) are granted fifteen-year monopoly. For both parts, the period of monopoly commences from the date on which the application was registered or, if priority is claimed, from the convention priority date or release date, whichever of the three is earliest. The monopoly is subject to the payment of the prescribed, annual renewal fees from the third anniversary of registration and no extension of the period of monopoly is possible.<sup>4</sup>

The Intellectual Property Laws Amendment Act No. 28 of 2013, which was published for comment in 2013, made provision for, *inter alia*, third and fourth parts of the Register, in which the registration number is preceded either by a ‘TA’

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3. See Section 22(1).

4. See Section 22(1); see also Regulation 34(1)(b).

or a 'TF', designating a traditional aesthetic design or a traditional functional design respectively. Traditional designs are said to include indigenous designs as well as derivative indigenous designs,<sup>5</sup> the distinction of which is found therein that only a part of a design should be derived from a traditional origin to constitute a derivative indigenous design.<sup>6</sup>

### 3. *Non-Functionality Requirement*

As mentioned above, the Designs Act makes provision for both aesthetic and functional designs, with clear distinctions between the two. As such, one may consider the South African design system to be neither positive nor negative with regard to the non-functionality requirement, but rather impartial.

The only exclusion of protection relates not to purely functional designs as a whole but rather to individual features of a design that are found to be dictated solely by technical considerations. The exclusion is found at Section 14(5) of the Designs Act as discussed *infra* section II.A.3.

### 4. *Means for Claiming Design Rights*

The Design Regulations of 1999 regulate the form in which design rights are to be claimed. The Designs Act allows for filing of more than one application for a design. In such case, separate applications must be filed for each class/part (A or F) in which the design is to be registered.<sup>7</sup> Such applications are treated as separate and distinct applications. The application must state the article(s) to which the design is to be applied and, if the Registrar so requires, for what purpose the article(s) will be used.<sup>8</sup>

The application must contain a definitive statement, setting out the features of the design for which protection is claimed.<sup>9</sup> The definitive statement is used to interpret the scope of protection afforded by the design registration, especially in cases of alleged infringement and may refer to reference symbols appearing in or on the representations. In practice, the features claimed in the definitive statement are often guided by the definition of an aesthetic or functional design, whichever applicable. As such, reference to the 'pattern,' 'ornamentation,' 'shape' and/or 'configuration' are made where appropriate.<sup>10</sup>

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5. See Section 1(1).

6. Whilst indigenous designs are subject to most provisions of the Designs Act, selected deviations apply. Importantly, indigenous designs are not required to be 'new', 'original', or 'not commonplace in the art.' In fact, by definition, traditional designs cannot adhere to such requirements. Pursuant to Section 53B(1), a derivative indigenous design, on the other hand, must be 'new' and 'have features based on or derived from an indigenous design of an indigenous community.' Whilst this act aims to recognise and protect the intellectual property of traditional communities in the Republic, it has not yet come into operation.

7. See Regulation 13.

8. See Regulation 14.

9. See Regulation 15(1).

10. See Section 1.

The definitive statement of a design (which is not an integrated circuit topography, a mask work or a series of mask works, for which this provision is compulsory) may be accompanied by an explanatory statement. The explanatory statement may refer to features of the article(s) to which the design is to be applied, the function thereof and/or the method or principle of construction of the article(s).<sup>11</sup> The explanatory statement may be used to assist with the interpretation of the scope of protection afforded by the design registration.<sup>12</sup>

Regulation 18 makes provision for representations to be supplied with the application, in the form of drawings, photographs, specimens or other records, where the Registrar so directs. However, it is inconceivable that the Registrar would be able to handle various specimens being manually submitted and as such, this is virtually never imposed in practice.

Drawings are to be provided ‘without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction.’<sup>13</sup> The practice is to include colour photographs or drawings only where the colour forms an integral part of the design right that is claimed.<sup>14</sup>

Various other requirements may be requested by the Registrar. In cases where a pattern is claimed, each representation of the design which consists of a repeating surface pattern must indicate the complete pattern and a sufficient portion of the repeat, in length and width, to disclose the design adequately.<sup>15</sup> Where a name or alternate representation of a living person appears in the design, the consent of the person may be submitted to the Registrar.<sup>16</sup> In the case of a deceased person, the consent of a legal representative of such person may be submitted.<sup>17</sup>

In order to broaden the scope of protection provided by a design, certain features may be disclaimed. This is accomplished by either representing those features in broken lines or by adding references to those features and then disclaiming them specifically in the definitive statement.

The Designs Act includes a provision for a ‘set of articles,’ stating in Section 1(3) that, ‘a “set of articles” means a 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, or the same design with modifications or variations not sufficient to alter the character of the articles or substantially affect the identity thereof, is applied to each separate article: Provided that a series of mask works shall not be a set of articles.’ Any uncertainty as to whether a number of articles constitute a set may be determined by the Registrar.<sup>18</sup> The provision for a set of articles has been interpreted in *Clipsal Australia (Pty) Ltd and Another v. Trust Electrical Wholesalers and another 2007*.

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11. See Regulation 15(2).

12. See Regulation 15(4).

13. See Regulation 19(3).

14. See *Marley (South Africa) (Pty) Ltd v. Piping Innovations (Pty) Ltd and another 1989 (2) SA 510 (T)*

15. See Regulation 21(1).

16. See Regulation 22(1).

17. See Regulation 22(2).

18. See Section 1(4).

According to Laddie et al.,<sup>19</sup> the object of the provision regarding a set of articles is to enable an applicant to obtain registration for the design of more than one article for the price of one. If the Registrar has registered articles as a set when they in truth do not form a set, the inconsistency is at best a matter for review; such inconsistency cannot be raised as a defence to infringement or be a ground for revocation.<sup>20</sup> Therefore, the court in *Clipsal v. Trust*<sup>21</sup> raised the question of whether registration of a design as a set could be a method of interpreting the scope of the registration. The court ruled that it followed not only from the purpose of the provision relating to sets but also from other definitions and especially Section 1(2). A design must apply to an 'article' which is clearly defined to include any article of manufacture and as such, a reference to an article is deemed to be a reference to '(a) a set of articles; (b) each article which forms part of the set of articles; or (c) both a set of articles and each article which forms part of that set.'<sup>22</sup> The result of this is that each member of a set has its own individuality and must be assessed independently.

## B. Policy Considerations Behind Non-Functionality Requirement

The South African Institute of Patent Agents proposed on 21 February 1988 to the Statutory Advisory Committee, which was tasked with the review of the Designs Act No. 57 of 1967, that a specific form of protection for functional designs be introduced in South Africa. The proposal was to make provision for petty patents and/or utility models, or something aligned therewith. The Statutory Advisory Committee opted for the establishment of a novel, innovative type of design registration, that being the *functional design*. When the Designs Act No. 195 of 1993 was published on 5 January 1994, the Designs Act enacted all provisions for the protection of functional designs, save for the provisions for designs 'in the nature of spare parts,' which it specifically excluded from protection under functional designs.<sup>23</sup>

From the enactment of the Designs Act, it is clear that there was strong legislative intention to protect functional features of designs. Furthermore, these functional features were separated from aesthetic features, thereby affording functional features of designs a substantial and equal ambit of protection as with aesthetic features.

Interesting to consider is the enactment of the Intellectual Property Laws Amendment Act No. 28 of 2013 which, *inter alia*, provided for indigenous designs, both aesthetic and functional in nature. The Act faced harsh public criticism due to the impracticality of its implementation. For example, the granting of royalty rights to communities, as opposed to individual entities, may prove challenging where identification of the community is required. A subsequent challenge would be entering into royalty agreements with such communities.

It is evident that South Africa has the further intention to substantially protect indigenous knowledge related to patents, registered designs, trademarks and copyright

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19. Laddie, Prescott and Vitoria, *The Modern Law of Copyright and Designs*, vol. 1 (2nd edn.), para. 30.40.

20. See Section 32.

21. See *Clipsal Australia (Pty) Ltd v. Trust Electrical Wholesalers*, [2007] SCA 24 (RSA).

22. See Section 1(2).

23. See Section 14(6).

through legislation. However, the final form and scope of such protection has not yet been defined in the South African legal system.

## C. Compliance with Non-Functionality Requirement

### 1. Tests

#### *The 'Multiplicity of Forms' Approach*

As the Designs Act makes provision for both aesthetic and functional designs, the 'multiplicity of forms' approach became inapplicable in South Africa. The intent of the Designs Act is to protect the visual appearance of articles, whether aesthetic or functional articles, remains true. Section 20(1) states the South African position:

'The effect of the registration of a design shall be to grant the registered proprietor in the Republic, subject to the provisions of this Act, for the duration of the registration the right to exclude other persons from making, importing, using or disposing of any article included in the class in which the 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.'

As such, only articles which embody the registered design or which are not substantially different from the registered design will constitute infringement. Should the technical function of a functional design be achievable by another configuration which does not embody the registered design, the other configuration will not fall under the scope of protection of the registered design.

#### Test of Novelty

The test of novelty in South Africa revolves around the state of the art at the time of application or release date, whichever earlier.<sup>24</sup> In *Clipsal v. Trust*, the court held that old law states that one is not entitled to mosaic for purposes of novelty.<sup>25</sup> However, the court held that absolute identity need not be shown, only substantial identity. The court further held that 'Immaterial additions or omissions are to be disregarded, so, too, functional additions or omissions.' In practice, these additions are referred to as secondary features and are disregarded in cases of infringement. The court stated that 'what anticipates if earlier, in general terms, infringes if later' (referred to in practice as the anticipation test). Furthermore, it is known that an ordinary trade variant shall not fulfil the novelty requirement.

The case of *Schultz v. Butt* illustrates the principle of a trade variant well.<sup>26</sup> The design in question was that of a boat which allegedly differed from the prior design

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24. See Section 14(3).

25. See also *Jones & Attwood Ltd v. National Radiator Co Ltd.*, (1928) 45 RPC 71 at 83 line 5-12.

26. See *Schultz v. Butt*, 1986 (3) SA 667 (A).

through the addition of a novel and original window structure. The court held that this addition did not constitute novelty as the function thereof was to protect the occupants against water spray and wind – an ordinary trade variant. The court held further that the design in its entirety was not novel and as such, the design was invalid.

### Test of ‘the Eye’?

Another aspect to consider is that the doctrine of imperfect recollection may be taken into account when comparing two designs, as stated in *Swisstool Manufacturing Co v. Omega Africa Plastics*.<sup>27</sup> This case firstly addressed the provision in Section 24(4) of the Designs Act, which states that revocation of the registration of a design may be sought by a defendant on any of the grounds specified in Section 10(2). Considering that the registration of a design gives a plaintiff’s design *prima facie* validity, the *onus* in relation to a counterclaim for revocation of such registration (on the grounds of novelty or originality), is in consequence on the defendant. The court held that although ‘the eye’ is to be the eye of the court, the court should view the design through the spectacles of the customer. Thus, the court should keep in mind that the probing eye of the court may discern features which could escape many customers with ease. In terms of the doctrine of imperfect recollection, the court held that when it comes to comparing certain designs, the court is charged with regarding this doctrine which comprises bearing in mind that the customer, unlike the court, might not see the article embodying the design at the same time or location. Accordingly, the court should regard what is likely to appeal to the customer and what he has seen, above the critical eye of the court.

### Test of Spare Parts

In 2010, BMW took action against a spare parts manufacturer, Grandmark International, on the grounds of, *inter alia*, alleged infringement of BMW’s registered designs for motor vehicle replacement parts.<sup>28</sup> The registered designs were for a bonnet, grille, headlight assembly and front fender. The designs were registered under Class 12 in Part A of the Register (see Figure 1 below).

The court held that the BMW designs were for individual components and ‘must be judged for the qualities of the individual components, independently of the design of the built-up vehicle.’ In terms of the features appealing to and judged solely by the eye, and with reference to the South African case law,<sup>29</sup> the court held that the designs for the replacement parts possessed no aesthetic features appealing to the eye, nor could the design be substantially distinguished from the state of the art. The four aesthetic designs in question in the *BMW v. Grandmark* case, including

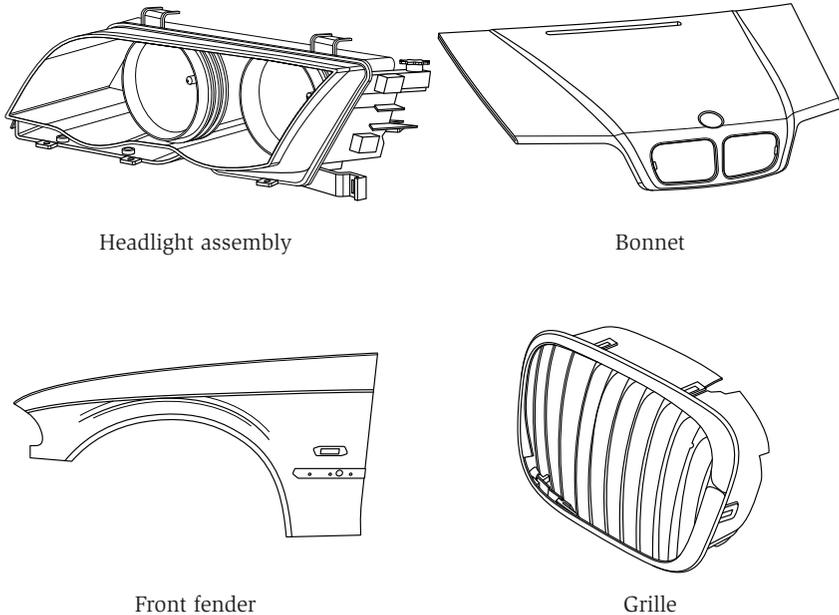
27. See *Swisstool Manufacturing Co v. Omega Africa Plastics*, 1975 (4) SA 379 (W).

28. See *Bayerische Motoren Werke Aktiengesellschaft v. Grandmark International*, 722/12 [2013] ZASCA 115.

29. Citing *Homecraft Steel Industries (Pty) Ltd v. SM Hare & Son (Pty) Ltd* 1984 (3) SA 681 (A), which quoted the English case of *Amp Incorporated v. Utilux (Pty) Ltd* [1972] RPC 103, Lord REID.

the following parts for an automobile: a headlight assembly, a bonnet, a front fender, and a front grille.

Figure 1



The presiding court, North Gauteng High Court, found that the parts were replaceable and thus, purely functional in nature:

‘Put another way, a replacement part for an E46 BMW serves only one function and that is to replace a part on that E46 BMW. It has to look the same, it has to fit the same, and it cannot look any other way.’

On appeal, the Supreme Court of Appeal (SCA) held that ‘most customers will not even see the component before it is fitted to the vehicle, nor make any selection at all, other than by giving instructions for the restoration of the vehicle.’ As such, and according to the definition of an aesthetic design, the parts may not be protected under aesthetic designs (Part A).

Importantly, due to the exclusion of spare parts from functional designs (Part F) in the Section 14(6) of the Designs Act, the motor vehicle replacement parts may not be filed under Part F either.

It should be noted that although the SCA upheld this *BMW v. Grandmark* decision in 2013, the opinion in practice remains split. One school of thought considers the fact that a spare part manufacturer may manufacture a part which exhibits an identical periphery to the original part (to fit the vehicle) yet has a different surface profile. However, the decision held by the court implies that a consumer purchases a spare part only to restore the aesthetic harmony of the vehicle and not to alter

the aesthetics of the vehicle in any way. Moreover, the court held that ‘We are not concerned, of course, with components of a different design that might be fitted to BMW vehicles, but with BMW’s components.’

Significantly, the SCA held that certain vehicle parts may be afforded aesthetic design protection (e.g. wing mirrors, seats, wheels and steering wheels) subject to the requirements of the Designs Act and that the parts are intended to be interchangeable between vehicles. It is thought that these exceptions pertain predominantly to after-market articles which exhibit clear, primary aesthetic features.

In summary, this case has far-reaching ramifications and reiterates that the restriction on spare parts contained in the Designs Act cannot be circumvented by the filing of an aesthetic design. Furthermore, the South African jurisprudence interpretation of ‘spare parts’ of any ‘machine, vehicle or equipment’ is broad in nature and the monopoly of original equipment manufacturers is evidently limited. However, in practice, many original equipment manufacturers continue to file design applications for replacement parts, generally under Part A of the Register.

## **2. *Impact of Related IP Rights and Must-Fit Parts***

### *a. Related IP Rights*

Over the years, South African legislation has aimed at rectifying the overlap between the Designs Act and other intellectual property related legislation.

Legislation in South Africa has aimed at preventing the protection of articles under both the Designs Act and the Copyright Act. In this regard, the Copyright Amendment Act No. 13 of 1988 excludes functional articles from copyright protection. A potential overlap between copyright and design protection remains with regard to three-dimensional articles. Section 15(3)A of the Copyright Act No. 98 of 1978 stipulates that

‘The copyright in an artistic work of which three-dimensional reproductions were made available, whether inside or outside the Republic, to the public by or with the consent of the copyright owner (hereafter referred to as authorized reproductions), shall not be infringed if any person without the consent of the owner makes or makes available to the public three-dimensional reproductions or adaptations of the authorized reproductions, provided the authorized reproductions primarily have a utilitarian purpose and are made by an industrial process.’

The wording of this section indicates that works which have a primary utilitarian purpose are not protectable in terms of the Copyright Act.

The overlap between designs and trade marks in South Africa and other jurisdictions became evident with the introduction of Class 32 into the International Classification for Industrial Designs under the Locarno Agreement. Class 32 extends design protection to ‘Graphic symbols and logos, surface patterns, ornamentation’ and further includes get-up. The Trade Marks Act No. 194 of 1993 defines a mark to include ‘any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned’ and as such, the overlap in terms of Class 32 is evident. However, whilst a trade mark registration

serves to distinguish the goods and/or services of one trader from another, a design registration (under Class 32) for a similar mark, serves to protect the general visual appearance of the mark.

Importantly, Section 2(1) of the definition of a mark under the Trade Marks Act No 194 of 1993 includes a 'container for goods' which distinctly expanded the range of potential marks as compared to the Trade Marks Act No. 62 of 1963. This is another area of overlap between the Trade Marks Act and the Designs Act, as the features of the container, including shape, configuration, pattern and/or ornamentation, may also be protected under the Designs Act. Furthermore, it should be borne in mind that Section 10(5) of the current Trade Marks Act seeks to 'prevent trade mark protection from granting the proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the product of competitors'.

In practice, it may be advantageous to file both a design registration and a trade mark registration simultaneously. The advantages of a design registration in South Africa include (i) minimal time from application to granting, (ii) the lack of any substantive examination, (iii) the broad scope of protection acquired (i.e. no requirement of being able to distinguish), and (iv) the lack of a use requirement. The advantages of a trade mark registration include (i) substantive examination, thus indication of being able to distinguish, (ii) no novelty requirement, and (iii) most significantly, the extended duration of protection afforded.

There is no restriction on the possible overlap between inventions protectable under the Patents Act No. 57 of 1978 and designs protectable under the Designs Act, particularly in terms of functional parts. Therefore, the practice in South Africa is to register a patent for an invention that complies with the requirements of the Patents Act and, if an embodiment of the invention is also protectable in terms of the Designs Act, to register a design for such embodiment, once in its final form.

#### *b. Must-Fit Parts*

Although South African design jurisprudence paralleled British design jurisprudence in its early years, it has subsequently diverged to such a significant degree that observing British judicial pronouncements as precedents in South Africa should be performed with caution. The Designs Act does not make provision for 'must-fit' or 'must-match' parts, nor does it contain any equivalents, as seen in other jurisdictions. Instead, the Designs Act enacted a limitation in the form of Section 14(6) which excludes any article in the form of a spare part from being eligible to functional design protection. However, the Designs Act did not elaborate on the position of spare parts in terms of aesthetic designs and this concept was later decided in *BMW v. Grandmark*, as described above.

### **3. Designs Not Viewable in Normal Use**

The only case where visibility of components were considered was *Klep Valves (Pty) Ltd v. Saunders Valve Co Ltd*.<sup>30</sup> In this case, the Appellate Division upheld the ruling

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30. See *Klep Valves (Pty) Ltd v. Saunders Valve Co Ltd.*, 1987 (2) SA 1 (A).

of the Transvaal Provincial Division, with reference to copyright legislation and also with reference to the British Patents and Designs Act of 1907. The court was required, *inter alia*, to consider the effect of Section 22(1) of the British Copyright Act of 1911, which provided that the Act would not apply to designs capable of being registered under the British Patents and Designs Act of 1907. The court, relying on the *Allen – Sherman – Hoff Co v. Registrar of Designs*,<sup>31</sup> held that the drawings did not qualify as ‘designs’ in that the general shape and other visible features of the valves in question were determined by purely functional features. Moreover, some of the components depicted on the drawings of the valves were on the interior and would not ordinarily be visible to a consumer. Although the position in the *Klep Valves v. Saunders* case was stated before the Designs Act 195 of 1993 came into effect, it is believed these principles set a suitable precedent.

#### D. Case Law Examples Dealing with Non-Functionality Requirement

In *Robinson v. DCooper Corporation of SA (Pty) Ltd.*,<sup>32</sup> design registrability in terms of the Designs Act No. 57 of 1967 was considered. The design in question was that of a metal frame for a ceiling trapdoor, and the functional aspects of the trapdoor were considered. The primary feature considered was that of the outside of the metal frame which was bent upwards slightly, thereby providing rigidity. The court held that the bend of the frame would be detected if judged solely by visual means. However, it is improbable that an individual would render this bend for visual purposes only. The court held that an individual detecting the frame bend would do so purely for functional reasons. Thus, considering that (i) the frame bend was absolutely necessary for its purpose, (ii) the method of construction thereof was excluded from the Designs Act No. 57 of 1967,<sup>33</sup> and (iii) that bending a metal strip to increase rigidity would be considered obvious, the court held that the registered design be deemed invalid. Importantly, considering that the Designs Act of that time did not make provision for functional designs, this case would have had a different outcome under the Designs Act No. 195 of 1993 should the design have been filed under Part F. However, the precedent set in terms of the features necessitated by function remains true.

The claiming of colour in a design is not *per se* excluded and as set out above, colour photographs and drawings are sometimes filed as part of a design application. In *Marley v. Piping Innovations*, the design in question was applied to a copper-coloured pipe. The design’s definitive statement claimed novelty in ‘the copper colouring of a synthetic plastic pipe substantially as shown in the representation.’ Whilst the applicant submitted that the design registration is void in terms of the definition of a ‘design’ in Section 1(1) and that colour did not constitute a design, the respondent argued that nothing in the Designs Act explicitly excluded colour and that colour could be accommodated under ‘pattern’ and/or ‘ornamentation.’<sup>34</sup> The court deemed the dispute to be whether ‘the notion of a monochrome applied

31. See *Allen – Sherman – Hoff Co v. Registrar of Designs*, 1935 TPD 270.

32. See *Robinson v. DCooper Corporation of SA (Pty) Ltd.*, 1983 (1) SA 88 (T).

33. See Section 1(1).

34. See Section 1(1)(i).

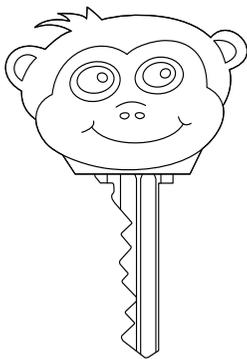
to an article and seen in conjunction with the article could qualify as a design as defined in the (Designs) Act.’

Due to the lack of South African authoritative law on the matter, the court regarded English law precedents. Specifically, the summary of the practice followed by the Designs Registry Office in England, under the rubric ‘General,’ which was attached to the report in the case of *Smith Kline and French Laboratories, Application* (1974) 9 RPC 253. The applicable paragraph reads:

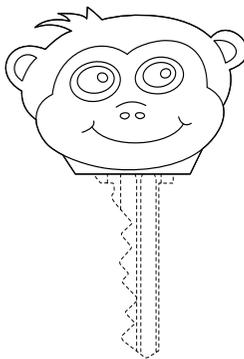
‘General: the office practice concerning the part played by colour in design registration is based on the understanding that, on the reported authorities, whilst colour may form an element in a design, colour or colouring as such does not constitute design: that is, that, unless the change of colour creates a new pattern or ornament, registration itself will be refused.’

The court reiterated that the notion is to be judged solely by the eye.<sup>35</sup> It held that where a design was a strong distinguishing shape or pattern (forming the primary features), colour (forming the secondary features) would play no part. However, where the colours are dominant in the design (forming the primary features), with a simple pattern playing a secondary role (secondary features), another design with the same pattern but distinctly different colours would be seen to be a different design and the later design would be deemed novel. The court further held that a set of facts could be derived where a single colour applied to a new article or pattern could, together with the article itself, form a novel and original design.

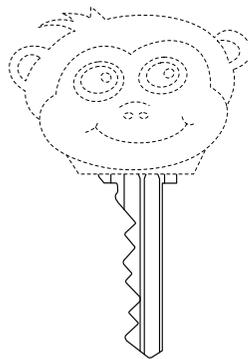
#### E. Hypothetical Fact Patterns (‘Monkey Key’ Hypothetical)



Example 1.1



Example 1.2



Example 1.3

As the Designs Act makes provision for filing of either, or both an aesthetic design and a functional design, the ‘Monkey Key’ example will be described in relation to filing of either an aesthetic or a functional design. It is assumed that the key is filed in Class 8 for ‘Tools and Hardware’. The outcome of the discussion will be different of the key is filed in Class 21 for ‘Games, Toys, Tents and Sports goods’.

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35. See Section 1(i).

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*Example 1.1 (Entire Key, Including Key Handle and Key Blade)*

*Aesthetic design:* An aesthetic design will protect the pattern and/or shape and/or configuration and/or ornamentation of the key depending on what is claimed in the definitive statement. Specifically, the protection will be for the handle and its overall arrangement relative to the blade. The blade would be afforded minimal design protection, as the specific shape of the blade may be argued to serve the function of opening a specific lock.

*Functional design:* A functional design will protect the specific shape of the blade because its features are ‘necessitated by the function’ that it has to perform. The primary feature of the handle being a handhold for the blade will be protected, but the secondary features, which include the ornamentation thereof, will not be protected.<sup>36</sup>

*Example 1.2 (Key Handle Only)*

*Aesthetic design:* An aesthetic design will protect the pattern and/or shape and/or configuration and/or ornamentation of the handle for a key (as the registration should state to which article the design is to be applied). However, the design will not be limited to the specific arrangement of the handle relative to the blade portion, or the specific blade.

*Functional design:* A functional design will aim to protect the primary function of the handle as a flat body attachable to a blade. No other aesthetic features of the handle will be protectable as it does not have ‘features which are necessitated by the function which the article to which the design is applied, is to perform.’

*Example 1.3 (Key Blade Only)*

*Aesthetic design:* No features of the key blade will be protectable by an aesthetic design as all the features will be excluded in terms of Section 14(5)(a).

*Functional design:* A functional design will protect the pattern and/or shape and/or configuration of the key blade.

## **F. Tactical Considerations**

### **1. Procurement**

This section is discussed only with regard to aesthetic designs, as provision is specifically made for functional design registrations in the Designs Act. The South African practitioner will assess the appropriate form of protection that should be applied for, that being the class(es) in which the filing should be done as well as the part (A and/or F) of the register in which the filing is to be done.

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36. See Section 14(5)(a).

If a design has important aesthetic features and functional features, it is advisable to file both an aesthetic design and a functional design in the relevant classes for which protection is sought. At the relatively low cost of filing design applications in South Africa, the option of filing in both parts of the Register is generally commercially viable for the client. Furthermore, most practitioners offer a discount for second and further filings of a similar/identical design.

The question then arises how to protect against a finding of functionality in an aesthetic design registration.

The first strategy to follow will be to disclaim specific aspects of which might be found to be functional. The feature does not have to be disclaimed as a whole, but certain aspects thereof can be disclaimed. For example, in the Monkey Key example, the specific orientation and/or configuration of the blade portion can be disclaimed. This would create enough width of protection to cover other orientations and blade configurations, without eliminating the blade from the design all together.

Another strategy available to the practitioner is to use the definitive and explanatory statements to describe the ambit of protection sought. This might be accomplished by describing the primary features of the design for which protection is sought in wording. Particular reference may be made to pattern, shape, configuration and/or ornamental aspects which are prominent.

The articles to which the design are to be applied may be selected to be a broad category instead of a very specific article. In practice, the headings of the Locarno Classification are generally used as a starting point to identify the articles to which the design is to be applied.

## **2.        *Litigation***

The question of functionality arises in instances such as in designs for vehicle tyre treads or shoe sole patterns, where the function is intimately linked to the pattern on the tyre or sole. Again, the practice of South African practitioners is to draft the definitive statement as broadly as possible and not to provide an explanatory statement. The definitive statement may read something akin to: ‘The features of the design for which protection is claimed include the pattern and/or the shape and/or the configuration and/or the ornamentation of the article, substantially as shown in the representations.’

Take the example shown in Figure 2 below.

This application was filed in Part A of the Register. If it is assumed that the definitive statement is very broad, there would be no indication of any features that are non-functional. The question arises as to how the applicant will get around the argument that the tread design should not be excluded from protection under Section 14(5)(a).

The question should be asked whether the design should not have been filed in Part F of the Register, or at least that some effort should have been made to incorporate wording in the definitive statement to refer to aesthetic aspects of the design. Practitioners often describe the features of the design in the brief statement, but the brief statement is not used to interpret the scope of protection, and such descriptions are thus disregarded in the interpretation of the scope of protection.

Figure 2: South African Registered Design A2016/00200



It is suggested that South African practitioners should consider using wording similar to what is used in the brief statement in the definitive statement thereby pointing a judge presiding over the case in the right direction regarding the scope of protection that the applicant sought.

## II. SCOPE OF PROTECTION

### A. Legal Framework

#### 1. *Articulation of Scope of Protection*

The relevant regulations relating the use of a definitive statement and an explanatory statement have been discussed above. The only prohibition on protecting functional features is set out in Section 14(5), which restricts functional features from being eligible for protection by the registration of an aesthetic designs, as well as any ‘method or principle of construction’.

Working within the provisions of the Design Regulations of 1999, the practice is to provide only a very broad, omnibus-type description in the definitive statement. For a functional design, the definitive statement may read something akin to: ‘The features of the design for which protection is claimed include the pattern and/or shape and/or configuration of the article, substantially as shown in the representations.’ For an aesthetic design, the definitive statement may read: ‘The features of the design for which protection is claimed include the pattern and/or shape and/or configuration and/or ornamentation of the article, substantially as shown in the representations.’

The principle behind this practice is simply to frame the protection as broadly as possible. To further broaden the scope, as discussed earlier non-essential aspects may be disclaimed through the addition wording to the effect of: ‘the portion marked ‘A’ does not form part of the design and is disclaimed’ or, alternatively, ‘the portion indicated in broken lines does not form part of the design and is disclaimed.’

The provision set out in Regulation 15(2) regarding the inclusion of an explanatory statement is very often not exercised. However, if exercised, the explanatory

statement serves only to *assist* in the interpretation of the scope of protection afforded by the design registration.<sup>37</sup>

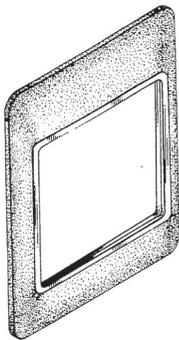
It is suggested that, depending on the ambit of protection sought after, as well as the relevant prior art, the provisions of a definitive statement and an explanatory statement be employed to limit the ambit of protection, for the purposes of overcoming relevant prior art by directing the protection of the design towards those features rendering the design novel. As with patents, the line between the ambit of protection and the relevant prior art should be considered carefully when claiming design rights.

## 2. *Effect of Prior Art Corpus on Scope of Protection*

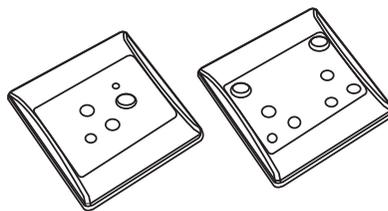
The closeness of the prior art impacts the scope of protection afforded to a registered design. In short, when prior art is close the scope of the protection afforded to a design right will be narrower. Conversely, when the prior art is not close, the scope of the protection afforded to a design right will be broader. Features of an overall design that are

The question of novelty and infringement arose in the case *Clipsal v. Trust*, which sets forth the current test for infringement in South African. The design in question (A 96/0687) was registered under the Designs Act as an aesthetic design in Class 13, which covers equipment for the production, distribution or transformation of electricity. The articles to which the design registration applied was ‘a set of electrical accessory plates with surrounds.’ According to the definitive statement, protection is claimed for ‘the features of shape and/or configuration of a set of electrical accessory plates with surrounds as shown in the accompanying drawings.’ Figure 3 (right) shows two configurations, hence the reference to a ‘set’ in both the title and definitive statement.

Figure 3



Prior art (US D327,212)



South African design right (A 96/0687)  
(Set of electrical accessory plates with surrounds)

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37. See Section 15(4).

The respondents opted for defence on the grounds that the design was neither new, nor original, as required by Section 14(1)(a), which are grounds for revocation under Section 31(1)(c) of the Designs Act. Furthermore, they denied infringement, alleging that their products did not embody either of the two designs and differ substantially thereto. In this case, the court instituted what is referred to in practice as the 'step test.' As the articles were clearly derived from the same class, the first issue was to determine the scope of protection afforded by the design registration. As discussed above, this is determined by analysis of the definitive statement and the drawings provided therewith. In this case, the definitive statement was in the alternative, a general omnibus type claim. The court further found that novelty is to be assessed against the prior art. The question is whether the design forms part of the prior art or not.

There is no provision for mosaicing of prior art (i.e. combining prior art references) as the court held that old law states that one is not entitled to mosaic for purposes of novelty.<sup>38</sup> Immaterial additions to the prior art or functional features (in the case of aesthetic designs) are also to be disregarded in assessing the novelty of a design against the prior art. The court further held that 'a design is not novel if it forms part of the prior art – meaning that it is to be found in the prior art – and not if it can be patched together out of the prior art.' The second issue was for the court to consider the difference between the allegedly infringing article and the registered design. Should the difference between the allegedly infringing article and the registered design be smaller than the monopoly afforded by the registered design (with reference to the prior art), the article would be deemed to infringe, in accordance with the court's statement: 'where the measure of novelty of a design is small, the ambit of the 'monopoly' is small.'

The relevant aspects taken into consideration for determining the scope of registered design protection arise from the Designs Act definitions of aesthetic and functional designs respectively. In terms of aesthetic designs, the features thereof must 'appeal to' and be 'judged solely by the eye.' According to *Homecraft Steel Industries (Pty) Ltd v. SM Hare & Son (Pty) Ltd.*,<sup>39</sup> although the court is considered the final arbiter, the first step should be evaluating how the design at hand would be visually judged by a likely consumer. Secondly, these visual features should be utilized for the determination of whether the design meets the requirements of the Designs Act, as well as deciding questions of novelty or infringement. Thirdly, the court should only pay recognition to those design features which 'will or may influence choice or selection' and as they have some 'individual characteristic' are 'calculated to attract the attention of the beholder.'<sup>40</sup> Furthermore, the court in the *Amp v. Utilux* case quoted Lord Pearson on this matter, stating that there must be at least one aspect of the design which is 'special, peculiar, distinctive, significant or striking' in terms of the appearance, that catches the eye and as such, appeals to the eye.

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38. See *Jones & Attwood Ltd v. National Radiator Co Ltd* (1928) 45 RPC 71 at 83 line 5-12.

39. See *Homecraft Steel Industries (Pty) Ltd v. SM Hare & Son (Pty) Ltd.*, 1984 (3) SA 681 (A)

40. *Amp Incorporated v. Utilux (Pty) Ltd* 1972 RPC 103.

In *Ocular Sciences Ltd v. Aspect Vision Care Ltd.*,<sup>41</sup> Laddie J. explained that:

‘[t]he proprietor can choose to assert design right in the whole or any part of his product. If the right is said to reside in the design of a teapot, this can mean that it resides in design of the whole pot, or in a part such as the spout, the handle or the lid, or, indeed, in a part of the lid. This means that the proprietor can trim his design right claim to most closely match what he believes the defendant to have taken.’

Effectively, this results in whatever claimed in the definitive statement being considered in its entirety, not only in terms of novelty and originality, but also when determining infringement.

In *Screentex (Pty) Ltd v. J Lyons & Co (Pty) Ltd and Others 1967 (2) SA 375 (D)*, where a willow pattern was in question, the court held an authoritative stand point on the influence of prior art under the 1916 Act. The court held that should a design be exhibited for a commercial purpose, otherwise than in confidential contexts, before the design registration, it is ‘previously used.’ Thus, although the proprietor claims not to be a party to such use, the subsequent registration of a design is invalid. Importantly, this holds true even for designs applied to articles of a different class to that in which the subsequent registration is to be filed, subject to the articles sharing (i) the same general character, and (ii) the same general use.

### **3. Effect of Functional Features on Scope of Protection**

Given the two-part register created by the Designs Act, practitioners in South Africa are required to critically evaluate the nature of the design to be registered in the context of the authoritative law which stands, including relevant case law discussed herein. The practitioner is charged with advising clients as to the most appropriate form of protection for the article and to filing that design in the appropriate class(es) and part(s) of the register. It goes without saying that the requirements for patentability under the Patents Act No. 57 of 1978 are also considered and it may be that a client is advised to file both a patent application and design application(s).

#### *a. Features Dictated Solely By Technical Function*

For aesthetic designs, purely functional features are excluded pursuant Section 14(5) which states that:

‘No  
(a) feature of an article in so far as it is necessitated solely by the function which the article is intended to perform; or  
(b) method or principle of construction,  
shall afford the registered proprietor of an aesthetic design any rights in terms of this Act in respect of such feature, method or principle.’

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41. *Ocular Sciences Ltd v. Aspect Vision Care Ltd.*, [1997] RPC 289 at 422.

This exclusion relates only to designs in the aesthetic part (Part A) of the Register. In this section, the exclusion is phrased restrictively as the Designs Act states that a ‘feature of an article in so far as it is necessitated *solely* by the function’ is excluded from protection. Therefore, as set out in *Chespak (Pty) Ltd v. MCG Industries (Pty) Ltd 2014*, if the primary feature is in the form of a functional feature which also has aesthetic features, and is not *solely* functional, this restriction will not apply.

b. *Features Not Dictated Solely by Technical Function, but Nevertheless Serving a Function*

In South Africa, many designs are filed for vehicle rims, as shown in Figure 4. In advising clients to file such design applications, the practitioner shall enquire whether the design is functional or aesthetic in nature. It would be clear to a layman that the wheel exhibits functional features, such as being round, having four holes for the wheel studs (or wheel bolts) to protrude through, having a central cavity for the hub to protrude through and having a single hole to receive a non-return air valve. Furthermore, the outer circumferential shape of the wheel has functional features in that the tyre should be able to seat onto the outer rim. Moreover, these features are industry standards that any rim design must conform to perform its function. The vehicle rim, as set forth in the South African Patent Journal of February 2017 Part 2, provides an example of the debate as to what constitutes aesthetic and functional features.

Figure 4: South African Registered Design A2016/00520



It should be considered that whilst the six radially extending spokes do have a functional feature, in that they space the central hub portion of the rim from the circumferential tyre portion, they also have aesthetic features which are not ‘solely dictated’ by the function. Therefore, in this example, an aesthetic design has been filed to protect the aesthetic features of the design, as such features were deemed to form a primary feature of the design. Furthermore, there is no need to disclaim the functional aspects from the design as these would be excluded from design protection automatically, in terms of Section 14(a) of the Designs Act. It is further noted that the design was filed in Class 12 and in Part A of the Register. The description provided

is referred to as a 'brief statement.' However, the brief statement does not have any bearing in the interpretation of the scope of protection afforded by the definitive statement.

Practitioners should consider utilizing the provisions in the Designs Act relating to both the definitive statement and the explanatory statement to define the scope of protection sought, thereby ensuring that those features of the design are regarded as important primary features by the court.

*c. Impact of Related IP Rights, Industry Standards, Must-Fit Components*

An exclusion of spare parts is made in relation to functional features of designs in Section 14(6) which states that:

'In 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.'

**B. Test(s) for Determining Whether a Feature is 'Dictated Solely by Technical Function'**

In the South African context, features of an aesthetic design which are purely functional will be dealt with in terms of Section 14(5) of the Designs Act. An aesthetic design that includes functional features will not be disqualified as a whole due to the inclusion of such functional features. However, such functional features will not be afforded protection by an aesthetic design. In *Homecraft Steel Industries (Pty) Ltd v. SM Hare & Son (Pty) Ltd.*, the court stated: 'Naturally a design which incorporates both registrable and non-registrable features may be registered, but in that case only the registrable features will enjoy the protection afforded by registration.'<sup>42</sup> To date, no test has been established to determine whether a feature is '*necessitated solely* by the function...' However, the wording of Section 14(5) of the Designs Act is restrictive and the exclusion should thus be interpreted restrictively.

**C. Policy Considerations Underlying Treatment of Functional Features**

Prior to the Designs Act 195 of 1993, no provision was made for the registration of functional features under designs.<sup>43</sup> However, when the Immaterial Property Committee was tasked with reviewing the Designs Act 57 of 1967, the Committee

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42. See *Homecraft Steel Industries (Pty) Ltd v. SM Hare & Son (Pty) Ltd.*, 1984 (3) SA 681 (A)

43. See generally, Christopher V. Carani, *Design Patent Functionality: A Sensible Solution*, 7 LANDSLIDE 19 (2014) (discussing doctrinal and logistical flaws with an approach whereby visual elements, whether old or dictated solely by function, are excluded from the overall appearance of a design; advocating for a holistic approach whereby novelty and functionality are judged at the overall appearance level not at the feature-by-feature level.)

extended an invitation to the public to comment on the protection of functional designs. The majority view put forward by the South African Institute of Patent Agents (now called the South African Institute of Intellectual Property Law) was that some form of protection should be established for functional designs, a protection akin to petty patents or utility models. After reviewing the commentaries, the Committee opted to provide only limited protection to functional designs, thereby fostering an undeniable existence of such rights. As such, the current Designs Act 195 of 1993 enacted the dual system of both aesthetic and functional designs. In drafting the current Designs Act, it became prudent to establish a clear distinction between aesthetic and functional designs and thus certain definitive provisions were included (See discussion on Section 14(5) in II.A.3.a. *infra*). These provisions have been construed in case law, as discussed herein.

#### **D. Case Law Examples of Treatment of Functional Features in Infringement and Validity Analyses**

*Chespak (Pty) Ltd v. MCG Industries (Pty) Ltd*<sup>44</sup> involved a bottle carrier in the form of a crate. A design was filed in the aesthetic part (Part A) of the Register, in Class 9. The court held, *inter alia*, that Section 14(5) of the Designs Act refers to features which are necessitated 'solely' by the function which the article is intended to perform. It does not refer to features which serve a functional purpose but also have aesthetic features. As a consequence thereof, the fact that a specific design feature, or a design in its entirety, performs a function is not decisive. The court therefore held that the question to be asked is whether the function, which that article to which the design is applied performs, dictates or necessitates the 'shape and/or configuration' of the design (as claimed in the definitive statement).

Thus, the court should determine whether the feature is included as part of the design purely for performing that function, or whether the article has, in addition, aesthetic appeal. The court held that in relation to the definitive statement for which protection was claimed, residing in the 'shape and/or configuration' of the crate as a whole, the 'shape' would generally refer to the external form or contour of the item and the 'configuration' will generally refer to the conformation of the item or the arrangement of the parts in a particular form.

Whilst the court found that the visual impact of the registered design undoubtedly had aesthetic appeal in that the shape and configuration were unique, the court found itself hard-pressed to identify individual features of shape and/or configuration which could be regarded as solely functional. The court held further that the exercise by the appellant to isolate every separate feature of the design and to allege that the feature had a purely functional advantage, was not only wrong in the context of the case, but was also futile having regard to the shape and/or configuration of the design as a whole. There were most certainly individual characteristics of the design which were calculated to attract the eye, which may have influenced customer selection through visual appeal and which was not there solely to assist the article in functioning.

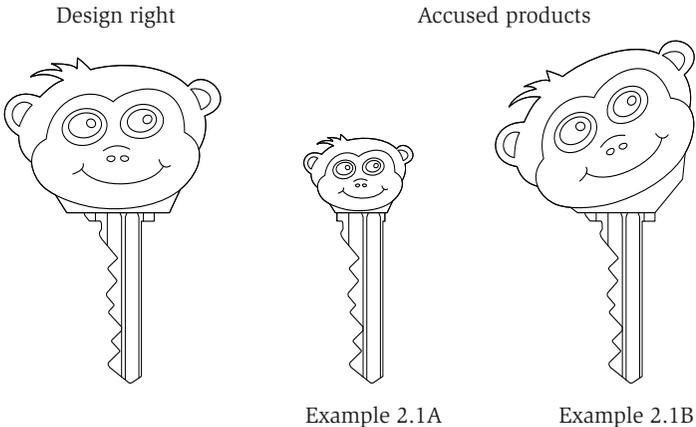
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44. See *Chespak (Pty) Ltd v. MCG Industries (Pty) Ltd.*, 2014 BIP 465 (GP).

Thus, it can be concluded that should the definitive statement not be directed otherwise, the registered design should be considered as a whole, including both ‘old’ features forming part of the prior art and new features in combination. Such an inclusive policy results in the scope of protection afforded to the registered design being narrower than that of a design directed to particular novel features. Moreover, functional features cannot be relied upon in infringement proceedings relating to an aesthetic design.

**E. Hypothetical Fact Patterns (‘Monkey Key’ Hypothetical)**

**1. Infringement Examples**

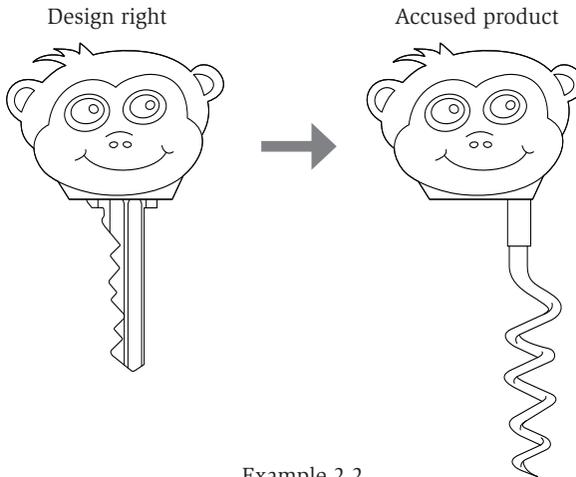


As a functional design will not protect any aesthetic features of the design which are not ‘necessitated by the function which the article has to perform’, it is assumed that the designs will be protected by an aesthetic design and the examples will be discussed in relation to this premise. Furthermore, for the purposes of this discussion, it is assumed that the key is not considered a spare part, and is registered under class 8 for keys and that the definitive statement is framed in broad terms.

In Example 1.1 discussed above, the entire overall appearance of the design is claimed. No parts are indicated in broken lines thus all parts are considered claimed as a whole. However, inasmuch as the shape of the key blade design is dictated solely by functional considerations, it shall be excluded from design protection pursuant to Section 14(5)(a).

The question of infringement will be whether Examples 2.1A and 2.1B are products which are not substantially different to the registered design. The design has to be taken as a whole, as no features were disclaimed. The aesthetic features of the handle will be a primary feature of the design whilst the specific key blade design and orientation will be a secondary feature. Therefore, it is our opinion that Examples 2.1A and 2.1B will be held to infringe on the design; the key handles of the accused keys of Examples 2.1A and 2.1B are identical to the key handle of the design right. A better option for claiming the aesthetic design right would be to disclaim

the specific shape and configuration of the key blade relative to the handle to avoid arguments that might be raised in defending infringement of Examples 2.1A and 2.1B.

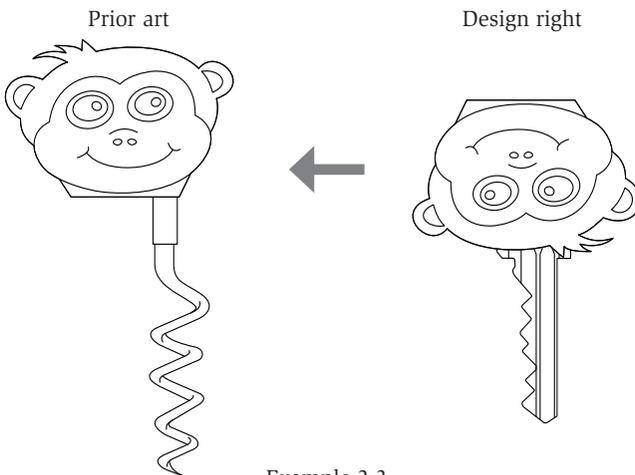


Example 2.2

Referring to Example 2.2, the aesthetic design registration would have to state to which article the design is to be applied (regulation 14).

In this instance, the article would be a key in class 8. However, the accused product, a corkscrew, will fall in class 7 and thus will not constitute infringement on the design of class 8. Should the proprietor of a design wish to protect other embodiments of the design, such as the corkscrew embodiment, he is permitted to register further designs in other classes.

2. **Validity Example**



Example 2.3

Referring to Example 2.3, the issue at hand regards not infringement but validity of the design right.

To be eligible for protection, a design must be new and original.<sup>45</sup> A design shall be deemed to be new if it is different from or does not form part of the prior art.<sup>46</sup> The state of the art shall comprise all matter which has been made available to the public.<sup>47</sup> Therefore, the prior art is not limited to the class in which the design falls.

The decisive issue will be the visual similarity of the overall design of the design right compared to that of the prior art. Here, the handle is, in the authors' opinion, is a primary aesthetic feature of the design. Therefore, the key with the handle design which is identical to the prior art might be held to be invalid on grounds of novelty. There may be countering arguments of orientation being different than the prior art and that the overall design, taking the type of implement into account, is different from the prior art. However, these arguments are, in the authors' opinion, weak. The definitive statement and explanatory statement may be phrased to direct the claimed design right towards the overall features of the key. If the design is of significant commercial value to the client, it would be advisable for an applicant to file the design, keeping in mind the potential risk of invalidity if the prior art was known.

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45. See Section 14(1)(a)

46. See Section 14(2)

47. Section 14(3)(a)