



Design law: a welcome reminder

by Rowan Forster

Two recent European IP decisions are a welcome reminder of that much-overlooked area of IP law: registered designs. If patent protection is primarily about functionality, design protection is primarily about product appearance (more on this later). These European cases are worth discussing because there are very few court decisions on registered designs in South Africa. They are also worth discussing because they highlight two fundamental aspects of design law. They further highlight a very important difference between design law in South Africa and design law elsewhere.

Novelty

The first of the fundamental aspects highlighted is novelty. A design can only be registered if it is new. Section 14 of the South African Designs Act, 1993 talks of a design having to be “new” and “original”, and it goes on to say that a design is new if it “is different from or if it does not form part of the state of the art” prior to the filing.

The European case involved a product that divides opinion sharply: the Crocs shoe. Although apparently worn by, among others, George W Bush, Michelle Obama and Prince George, *Time* magazine named the Crocs shoe one of the 50 worst inventions. Some 300 million pairs have been sold worldwide and it’s clearly popular in South Africa.

The makers of Crocs had a 2004 EU design registration for the Crocs shoe. This registration was attacked by a French company called Gifi Diffusion, which alleged that the design lacked the required novelty. In the EU, the novelty standard is that the design must not have been known by the market for more than 12 months prior to the filing date or priority date. The evidence showed that the Crocs shoe had been displayed at a trade fair in Fort Lauderdale, USA, more than 12 months prior to the priority date for the EU registration. In addition, the shoe had appeared on the manufacturer’s website more than 12 months earlier. The court held that these disclosures had destroyed the novelty, making the registration invalid. The fact that the trade fair was not in the EU did not matter because the shoe would have been known by relevant circles in the EU. As for websites, well, they are of course accessible to all and sundry.

This case highlights a dilemma that many designers and inventors face: do they adopt a wait-and-see approach and if it transpires that the product is successful, spend big on IP protection, or do they back themselves and incur what are perceived to be heavy legal costs before the product starts making money? Unfortunately, those who take the cautious approach often find that they’ve blown their chances of getting valid IP protection.

Aesthetics

The second of the fundamental aspects highlighted, is that design law protects aesthetic features. In the South African Designs Act, 1993, you’ll find a definition of “aesthetic design”, which talks of “features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof.”

The idea of something appealing to and being judged solely by the eye has been interpreted by a number of courts. In the old British case of *Amp Inc v Utilux (Pty) Ltd*, the court spoke of “features which will influence choice or selection” and features that are “calculated to attract the attention of the beholder.” In the South African case of *Swisstool Manufacturing Co v Omega Africa Plastics*, the court said that aesthetic designs are “those that invite customer selection – and customer discrimination between articles – solely by their visual appeal.”

In the recent *Doceram vs Ceramtec* decision, the issue before Europe’s highest court, the Court of Justice of the European Union, was whether the appearance of a product (a weld centering pin) was solely dictated by its function, and therefore disentitled to design protection. The court said that the appropriate test in these matters is the so-called “no aesthetic consideration test”, which looks at whether the technical function was the only factor that determined the design of those features. According to this test, if it can be established that there were aesthetic considerations that contributed to the design then the design was not solely dictated by technical function, and it is therefore registrable.

The South African difference

This brings us to a major distinction between design law in South Africa and design law in many other countries. South African design law does obviously protect aesthetic features, but the reason why there is a definition of “aesthetic design” in the Designs Act is because the law also makes provision for the registration of a “functional design”. This term is defined as “features which are necessitated by the function which the article to which the design is applied is to perform.”

Novelty remains a requirement, and in the case of a functional design, the wording is “new” and “not commonplace in the art in question.” A further important distinction between the two types of design, is that it is expressly stated that a functional design cannot cover a spare part for a vehicle, machine or equipment. A functional design also gets shorter protection than an aesthetic design, 10 years rather than 15.

The interplay between aesthetic designs and functional designs came up in the South African case of *BMW v Grandmark*, where the court held that various aesthetic design registrations that BMW had obtained for car parts such as bonnets, grills, headlight assemblies and front fenders were invalid. The reason: these goods are functional, because vehicle components “are not selected by customers for their appeal to the eye”, but rather “for the function they perform – which is to replace components so as to restore the vehicle to its original form.”

South African companies should not overlook the valuable protection they can get through registered designs, particularly given that the costs for doing so are relatively low in comparison to patents, both in South Africa and abroad.



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