**REGISTERED DESIGN PROTECTION**

The shapes of articles in commerce can fulfil a variety of functions. On the one hand, the (mere) appearance of an article, for example that of a Ferrari or a new clothing item from Armani, can have a major impact on the decision of a consumer to purchase it. On the other hand, the shape of a generator for overcoming electricity cuts can be very much in the background, with the consumer’s focus more on the “job” it has to do. The Designs Act 195 of 1993 can be relevant in both instances, by creating the possibility for protection by way of a registered design. In other words, all designs are not necessarily protected by the Designs Act – only those registered in terms of it. In given instances, design protection may overlap with patent protection (Burrell *South African Patent and Design Law* (1999) 445). A particular design may also qualify for protection in terms of the Trade Marks Act 194 of 1993, if, among others, it is of a distinctive nature. Furthermore, a design may also be protectable in terms of the Copyright Act 98 of 1978, for example, a piece of jewellery. In addition, if a design has developed a reputation and the use of another design is likely to cause confusion with it, a remedy in terms of the common law may be possible. In all four of these instances, the duration of protection can exceed those available in terms of the Designs Act, as discussed in more detail below.

As alluded to above, the Designs Act distinguishes between two types of designs: aesthetic and functional designs. An aesthetic design includes any design applied to an article, whether for the pattern or the shape, configuration or the ornamentation thereof, “having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof” (section 1(1)). A functional design means, among others, a design applied to an article, whether for the pattern or the shape or the configuration thereof, “having features which are necessitated by the function which the article to which the design is applied, is to perform…” (section 1(1)). Examples of aesthetic designs include a vehicle, a (clothing) belt, a razor head, an air freshener device and a ball. Functional designs include a signboard, a toilet seat, an antenna, an inhaler and a circuit breaker. It should be noted that a design not only relates to a three-dimensional article or the “shape” of an article. It can also involve, for instance, a fabric design.

It should be noted that no feature of an article – insofar as it is necessitated solely by the function that the article is intended to perform – or method or principle of construction will afford the proprietor of an aesthetic design any rights in terms of the Act in respect of such feature, method or principle (section 14(5)). require protection as an aesthetic design. If so, Section 14(5) may constitute a problem, insofar as the indentation is concerned.

One must also consider the issue of the classification of a design. Notwithstanding the fact that an article is of a functional nature, it seems that one could still have a choice between various functional articles and their functional nature – not excluding the combination of a number of configurations of the various aspects of design. In other words, two articles may both be bread slicers, but combination A may be preferred to combination B, with regard to such features that do “appeal” to the eye. It soon becomes clear that the question of the correct classification of an object is both difficult and important. One solution provided by the Act is contained in section 15(3), which provides that an article may be registered as both an aesthetic and a functional design.

Designs are registered in particular classes. For instance, foodstuffs fall within class 1, musical instruments within class 17 and pharmaceutical products within class 28. It is possible to register an article in more than one class (section 15(4)). The importance of the class in which a design is registered is that the infringement of a design is limited to the particular class in which the application is filed, as discussed below. Design applications are filed with the Registrar of Designs and the applicant may be represented by an attorney (section 13 read with definition of “agent” in section 1(1)). Unlike the position with the registration of patents, it is thus not necessary to use the services of a patent attorney. In view of the technical nature of a design application, which often involves principles akin to those found in patent applications, it is highly advisable to obtain advice from a patent attorney. A design application must be accompanied by a representation of the design concerned (Design Regulations, Notice R 843 Government Gazette of 2 July 1999 – Regulation 12(1)(d)).

In order to be registrable, aesthetic designs must be new and original (section 14(1)(a)). A design will 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. An important provision, which differs from patent law, is that when the release date is the earlier, a design will still be “new,” even if it has been released into the market, if an application is filed within a maximum period of up to six months after the release date (section 14(2)). In practice, this provides considerable advantages in relation to the development of designs. The state of the art will comprise, among others, matter that has been made available to the public, in South Africa or elsewhere, by written description, by use or in any other way (section 14(3)). Functional designs must be new and not commonplace in the art in question (section 14(1)(b)). It should be noted that section 14(4) provides that articles not multiplied by an industrial process cannot be registered. This means that, for example, the handmade wood carvings often put up for sale at flea markets, as, for example, in the photo, cannot be protected in terms of design law. Other bases of protection for such articles, in particular in terms of the Copyright Act, may be possible though.

The effect of registration is that the proprietor will have the right to exclude others from making, importing, using or disposing of any article included in the class for which it is registered or a design not substantially different from the registered design (section 21(1)). An important limitation on the right to prevent infringement is contained in section 14(6), which reads as follows:

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.

This provision, which was quite controversial at the time of its adoption, would seem not to exclude articles that are spare parts, but that have a measure of aesthetic appeal. An example here may be the grill of a motor vehicle. It is not replaced on a regular basis and may last the lifetime of the vehicle. Other spare parts, such as parts of the engine, which are subject to more wear and tear, will fall within the exemption.

It should be noted, lastly, that the duration of protection, in the case of aesthetic designs, is 15 years, and 10 years in the case of functional designs (section 22(1)). The difference in the duration of protection is a reflection of the higher degree of “inventiveness” accorded to an aesthetic, in contrast to a functional design, by the legislature. It is, however, nowhere near the period of protection that a design (also) protected in terms of the Copyright Act would receive. Such periods often lasts for far more than 50 years.

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