

DESIGNS ACT 195 OF 1993

[ASSENTED TO 22 DECEMBER 1993]

[DATE OF COMMENCEMENT: 1 MAY 1995]

(English text signed by the State President)

as amended by

Intellectual Property Laws Amendment Act 38 of 1997

Regulations under this Act

DESIGNS REGULATIONS

ACT

To provide for the registration of designs and for matters connected therewith.

1 Definitions

(1) In this Act, unless the context otherwise indicates-

'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;

'agent' means a patent agent referred to in section 20 of the Patents Act, 1978 (Act 57 of 1978), or an attorney;

'applicant' includes the legal representative of a deceased applicant or of an applicant who is a person under legal disability;

'article' means any article of manufacture and includes a part of such article if manufactured separately;

'cessionary' includes the personal representative of a cessionary, and any reference to the cessionary of any person shall be construed as including a reference to the cessionary of the personal representative of that person;

'convention country' means any country or group of countries in respect of which there is in force a proclamation in terms of section 43 declaring such country or group of countries to be a convention country or convention countries for the purposes of this Act;

'court', in relation to any matter, means the division of the Supreme Court of South Africa having jurisdiction in respect of that matter;

'date of application' means-

- (a) in relation to an application made in terms of section 44, the date on which the application in respect of the relevant design was lodged in the convention country concerned; and
- (b) in relation to any other application, the date on which the application was lodged at the designs office;

'design' means an aesthetic design or a functional design;

'designs office' means the designs office referred to in section 4;

'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;

'integrated circuit' means an article, in final or intermediate form, containing electrical, electromagnetic or optical elements and circuitry, which is capable of performing an electrical or an optical function, and in which at least a part of the

electrical, electromagnetic or optical elements and circuitry are integrally formed, in accordance with a predetermined topography, in a semiconductor material;

'integrated circuit topography' means a functional design which consists of the pattern, shape or configuration of the three-dimensional disposition of the electrical, electromagnetic or optical elements and circuitry of an integrated circuit;

'journal' means the patent journal published in terms of section 14 of the Patents Act, 1978 (Act 57 of 1978);

'mask work' means a functional design which consists of a pattern of an image however fixed or encoded, having or representing at least a part of an integrated circuit;

'Minister' means the Minister of Trade and Industry;

'personal representative'

[Definition of 'personal representative' deleted by s. 69 of Act 38 of 1997.]

'prescribed' means prescribed by regulation;

'proprietor', in relation to a design, means-

- (a) the author of the design; or
- (b) where the author of the design executes the work for another person, the other person for whom the work is so executed; or
- (c) where a person, or his employee acting in the course of his employment, makes a design for another person in terms of an agreement, such other person; or
- (d) where the ownership in the design has passed to any other person, such other person;

'register' means the register of designs kept at the designs office in terms of section 7;

'registered proprietor' means the person whose name is for the time being entered in the register as the proprietor of the design;

'registrar' means the registrar of designs appointed or deemed to have been appointed under section 6;

'regulation' means any regulation made under this Act;

'release date', in relation to a design, means the date on which the design was first made available to the public (whether in the Republic or elsewhere) with the consent of the proprietor or any predecessor in title;

'series of mask works' means a related group of mask works which together represent the three-dimensional disposition of the electrical, electromagnetic or optical elements and circuitry of an integrated circuit;

'the repealed Act' means the Designs Act, 1967 (Act 57 of 1967);

'this Act' includes the regulations.

(2) Any reference in this Act to an article shall be deemed, according to the context, to be a reference to-

- (a) a set of articles; or
- (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.

(3) For the purposes of this Act, 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.

(4) Any question arising under this Act as to whether a number of articles constitute a set of articles shall be determined by the registrar.

2 Application of Act

(1) The provisions of this Act shall apply in respect of all registered designs, whether registered before or after the date of commencement of this Act: Provided that a design registered pursuant to an application made before such commencement shall not be revoked except upon any ground on which it could have been revoked in terms of the repealed Act.

(2) All applications and proceedings commenced under the repealed Act shall be dealt with in accordance with the provisions of that Act as if it had not been repealed.

3 State bound

A registered design shall in all respects have the same effect against the State as it has against any person.

4 Continuation of designs office

The designs office established by section 2 of the repealed Act shall continue to exist.

5 Seal of designs office

There shall be a seal of the designs office, and the impression of the seal shall be judicially noticed.

6 Registrar of designs

(1) The Minister shall, subject to the laws governing the public service, appoint a registrar of designs, who shall exercise the powers and perform the duties conferred or imposed upon the registrar by this Act and who shall, subject to the directions of the Minister, have the chief control of the designs office.

(2) The Minister shall similarly appoint one or more deputy registrars of designs, who shall, subject to the control of the registrar, have all the powers conferred by this Act on the registrar, and the senior of whom shall, whenever the registrar is for any reason unable to fulfil his duties, act temporarily in his stead.

(3) The registrar of designs and a deputy registrar of designs appointed under section 3 of the repealed Act shall be deemed to have been appointed under this section.

(4) Any power conferred or duty imposed upon the registrar by this Act may be exercised or performed by the registrar personally or by an officer in the public service acting under a delegation from or under the control or direction of the registrar.

7 Register of designs

(1) There shall be kept at the designs office a register in which shall be entered-

- (a) the names and addresses of applicants for the registration of designs and of persons to whom registration has been granted and the classification of such designs according to subject-matter; and
- (b) such other particulars as may be prescribed.

(2) Copies of all deeds, agreements, licences and other documents affecting any registered design or application for the registration of a design which are required to be recorded in the register, shall be supplied to the registrar in the prescribed manner for filing in the designs office.

(3) The registrar shall maintain at the designs office such indexes in relation to

particulars entered in the register in terms of subsection (1) as may be prescribed.

(4) The register kept in terms of section 9 (1) of the repealed Act shall be incorporated with and form part of the register to be kept under this section, and all copies of deeds, agreements, licences and other documents supplied to the registrar in terms of section 9 of the repealed Act shall be deemed to have been supplied to the registrar in terms of subsection (2).

(5) The register shall consist of a Part A with regard to aesthetic designs and a Part F with regard to functional designs.

(6) The existing register shall be deemed to form part of Part A of the register.

8 Inspection of register

(1) Subject to the provisions of this Act, the register or any document lodged at the designs office shall, on payment of the prescribed fee, be open to inspection by the public during the prescribed hours.

(2) The right of inspection conferred by subsection (1) shall not include the right to make copies of or take extracts from the register or any document referred to in that subsection by mechanical means: Provided that the registrar may, where owing to circumstances beyond his control copies of any document required in terms of section 9 cannot be furnished without undue delay, permit any person to make such copies by mechanical means.

9 Registrar to furnish information from register on request

The registrar shall, at the request of any person and on payment of the prescribed fee, furnish copies of any documents lodged at the designs office and which are open to public inspection, or particulars from the register, or furnish a certificate in respect thereof.

10 Publication in journal

The registrar shall arrange for the publication in the journal of such details in respect of designs as he considers desirable or which must be published therein in terms of this Act.

11 Powers of registrar

(1) The registrar may, for the purposes of this Act-

- (a) receive evidence and determine whether and to what extent it shall be given by affidavit or orally upon oath;
- (b) award costs against any party in any proceedings before him; and
- (c) tax costs so awarded according to the prescribed tariff:

Provided that such award and taxation shall be subject to review by the court.

(2) The payment of any costs so awarded and taxed may be enforced in the same manner as if they were costs awarded by a judge of the Transvaal Provincial Division of the Supreme Court of South Africa in civil proceedings.

12 Exercise of discretionary power by registrar

(1) Whenever any discretionary power is conferred by this Act upon the registrar, he shall not exercise that power adversely to an applicant or an objector or other person who according to the register appears to be an interested party, without (if so required by the applicant or objector or other interested party within a time fixed by the registrar) giving that applicant or objector or interested party an opportunity of being heard.

(2) Whenever by this Act any time is specified within which any act is to be performed or thing is to be done, the registrar may, save where it is otherwise expressly

provided, extend that time either before or after its expiry.

13 Representation

Any person is entitled to be represented by an agent to act on his behalf in connection with any matter or proceedings in terms of this Act.

14 Application for registration

(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.

(2) 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.

[Sub-s. (2) amended by s. 70 (a) of Act 38 of 1997.]

(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) (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).

[Para. (b) substituted by s. 70 (b) of Act 38 of 1997.]

(4) Designs for articles which are not intended to be multiplied by an industrial process shall not be registrable under this Act.

(5) 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.

(6) 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.

(7) In the absence of an agreement to the contrary, joint proprietors may apply for the registration of a design in equal undivided shares.

15 Registration of design

(1) The registrar shall examine in the prescribed manner any application for the registration of a design and, if it complies with the requirements of this Act, register the design in Part A of the register if it is an aesthetic design or in Part F of the register if it is a functional design.

(2) A design when registered shall be registered as from the date of application.

(3) The same design may be registered in both Part A and Part F of the register.

(4) The same design may be registered in more than one class and, in case of doubt as to the class in which the design ought to be registered, the registrar shall determine such class.

(5) Where an application for the registration of a design has been made or a design has been registered and a further application is made by the same applicant to register the design or a part thereof in the same or the other Part of the register and in the same class or in one or more other classes, such further application shall not be invalidated on the ground that the design-

(a) in the case of-

(i) an aesthetic design, is not new and original;

(ii) a functional design, is not new and is commonplace in the art in question,

by reason only that the design forms the subject of such previous application or registration; or

(b) was previously made available to the public by reason only that the design has been applied to articles within the class in which such previous application or registration was lodged.

[Sub-s. (5) added by s. 71 of Act 38 of 1997.]

16 Refusal of application

If it appears to the registrar that an application was not made in the prescribed manner, he shall refuse the application.

17 Disclosure without proprietor's knowledge or consent

The registration of a design shall not be invalid by reason only of the fact that the design was disclosed, used or known prior to the release date if the proprietor proves that such knowledge was acquired, or such disclosure or use was made, without his knowledge or consent, and that the knowledge acquired or the matter disclosed or used was derived or obtained from him, and that he applied for and obtained protection for his design with all reasonable diligence after learning of the disclosure, use or knowledge.

18 Certificate of registration

As soon as practicable after the registration of a design under section 15 (1) the registrar shall-

(a) issue a notification of registration to the applicant; and

(b) cause to be published in the journal in the prescribed form a notice of such registration and, upon such publication, issue a certificate of registration to

the registered proprietor.

[S. 18 substituted by s. 72 of Act 38 of 1997.]

19 Inspection by public

After the publication contemplated in section 18, the entry in the register, as well as the application and all the documents lodged in support thereof, shall on payment of the prescribed fee be open to public inspection in the designs office.

20 Effect of registration of design

(1) The effect of the registration of a design shall be to grant to 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 the 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.

(2) The disposing of an article embodying a registered design by or on behalf of a registered proprietor or his licensee shall give the purchaser the right to use and dispose of that article.

(3) Notwithstanding subsection (1), the rights of the registered proprietor of a registered design in the form of an integrated circuit topography shall not be infringed by a person who-

- (a) makes an article embodying the registered design or a design not substantially different from the registered design, for private purposes or for the sole purpose of evaluation, analysis, research or teaching;
- (b) imports or disposes of an integrated circuit embodying the registered design which has been unlawfully produced or an article incorporating such an integrated circuit and proves that at the time of acquiring the integrated circuit or article he or she was not aware and had no reasonable grounds of becoming aware that the integrated circuit or article embodied a registered design which had been unlawfully produced: Provided that when the person receives sufficient notice that the registered design was unlawfully produced, the person may dispose of any stock of such integrated circuits or articles but shall be liable to pay to the registered proprietor a sum calculated on the basis of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the registered design concerned.

[Sub-s. (3) added by s. 73 of Act 38 of 1997.]

21 Compulsory licence in case of abuse of rights

(1) Any interested person who can show that the rights in a registered design are being abused, may apply to the court in the prescribed manner for the granting of a compulsory licence in respect of the registered design.

(2) The rights in a registered design shall be deemed to be abused if-

- (a) articles embodying the registered design are not available to the public in the Republic on a commercial scale or to an adequate extent after the registration date, and there is in the opinion of the court no satisfactory reason therefor;
- (b) the availability of articles embodying the registered design in the Republic

- on a commercial scale or to an adequate extent is being prevented or hindered by the importation of such articles;
- (c) the demand for the articles embodying the registered design in the Republic is not being met to an adequate extent and on reasonable terms;
 - (d) by reason of the refusal of the registered proprietor to grant a licence or licences upon reasonable terms, the trade or industry or agriculture of the Republic or the trade of any person or class of persons trading in the Republic, or the establishment of any new trade or industry in the Republic, is being prejudiced, and it is in the public interest that a licence or licences should be granted; or
 - (e) the demand in the Republic for the articles embodying the registered design is being met by importation and the price charged by the registered proprietor, his licensee or agent for the said articles is excessive in relation to the price charged therefor in countries where the said articles are manufactured by or under licence from the registered proprietor or his predecessor or successor in title.

(3) The registered proprietor or any other person appearing from the register to be interested in the registered design may in the prescribed manner oppose the application.

(4) (a) The court may order the grant to the applicant of a licence on such conditions as it may deem fit, including a condition precluding the licensee from importing into the Republic any articles embodying the registered design.

(b) If the court is of the opinion that an order directing the grant of a licence is not justified, it may refuse the application.

(5) If the only abuse found by the court to have been established is that set out in subsection (2) (a), any licence granted shall be non-exclusive but shall not be transferable except to a person to whom the business or the part of the business in connection with which the rights under the licence were exercised has been transferred.

(6) In all other cases the court may grant an exclusive licence if, having regard to all the circumstances of the case, it considers it justified, and for that purpose the court may revoke any existing licence on such conditions as it may deem fit.

(7) In determining the conditions on which any licence is granted the court shall have regard to all relevant facts, including the risks to be undertaken by the licensee, the research and development undertaken by the registered proprietor or his predecessor and the terms and conditions usually stipulated in similar licence agreements in respect of registered designs between persons who voluntarily enter into such agreements.

(8) Any order of the court under this section shall be made with a view to avoiding the abuse found by the court to have been established.

(9) The court may amend or revoke any licence granted under this section.

(10) Subject to the provisions of subsection (11) and to the conditions that may be attached to the licence, a licensee under this section shall have the same rights and obligations as any other licensee under a registered design.

(11) An exclusive licensee under this section may, subject to the conditions attached to the licence, institute any proceedings which may be necessary to prevent infringement, and to recover damages as a result of infringement, of the design in question, as if he were the registered proprietor: Provided that-

- (a) the registered proprietor concerned shall be joined as a party to such

- proceedings;
- (b) the registered proprietor may join in the proceedings either as co-plaintiff or as co-defendant; and
 - (c) the registered proprietor shall not be liable for any costs in connection with such proceedings unless he enters an appearance and takes part in those proceedings.

(12) Notwithstanding the provisions of subsection (11), a registered proprietor whose design is the subject of an exclusive licence in terms of this section may institute any proceedings which are necessary to prevent infringement and to recover damages as a result of such infringement: Provided that-

- (a) the exclusive licensee shall be joined as a party to such proceedings;
- (b) the exclusive licensee may join in the proceedings either as co-plaintiff or as co-defendant; and
- (c) the exclusive licensee shall not be liable for any costs in connection with such proceedings unless he enters an appearance and takes part in those proceedings.

(13) (a) The court may award costs against the applicant or registered proprietor concerned or any person opposing the relevant application whenever it orders the grant of a licence under subsection (4) (a).

(b) In so awarding costs, the court shall *inter alia* have regard to-

- (i) the nature and extent of the abuse found by it to have been established; and
- (ii) whether the application for a licence under this section might have been avoided by the grant, by the registered proprietor concerned to the applicant, of a voluntary licence on reasonable terms.

(14) If the registered design in respect of which an application is made under subsection (1) for the granting of a compulsory licence is an integrated circuit topography, a mask work or a series of mask works-

- (a) subsections (2) (b), (5), (6), (11) and (12) shall not apply;
- (b) the court shall consider that application on its merits in deciding whether or not to grant a licence as provided for in subsection (4);
- (c) a licence granted under subsection (4) upon that application shall include a provision that, subject to adequate protection of the legitimate interests of the licensee, the licence shall, on application by the registered proprietor of the registered design, be terminated if the circumstances which led to its grant cease to exist and, in the opinion of the court, are unlikely to recur; and
- (d) a licence granted under subsection (4) upon that application shall be non-exclusive and shall not be transferable except to a person to whom the business or part of the business in connection with which the rights under the licence were exercised has been transferred.

[Sub-s. (14) added by s. 74 of Act 38 of 1997.]

22 Duration of registration

(1) The duration of the registration of-

- (a) an aesthetic design shall be fifteen years;
- (b) a functional design shall be ten years,

from the date of registration thereof or from the release date, whichever date is earlier, subject to the payment of the prescribed renewal fee.

(2) Registration of a design shall lapse at the end of the period prescribed for the payment of any prescribed renewal fee, if it is not paid within that period: Provided that the registrar may upon application and subject to the payment of such additional fee as may be prescribed, extend the period for payment of any such fee for a period not exceeding six months.

23 Restoration of lapsed registration

(1) Where, after the commencement of this Act, the registration of a design has lapsed owing to non-payment of any prescribed renewal fee within the prescribed period or the extended period referred to in section 22 (2), the registered proprietor may in the prescribed manner and on payment of the prescribed fee, apply to the registrar for the restoration of such registration.

[Sub-s. (1) substituted by s. 75 of Act 38 of 1997.]

(2) If the registrar is satisfied that the omission to pay the prescribed renewal fee was unintentional and that no undue delay has occurred in the making of the application, he shall advertise the application in the prescribed manner, and thereupon any person (hereinafter in this section referred to as the objector) may within such period as may be prescribed, give notice in the prescribed manner of opposition to the restoration of such registration.

(3) If there is no opposition to such restoration, the registrar may, subject to the provisions of subsection (5), issue an order restoring such registration, or dismiss the application.

(4) If notice of opposition is given, the registrar shall, after hearing the applicant and the objector, decide the matter and issue an order restoring such registration, or dismiss the application.

(5) Any order restoring the registration of a design shall be subject to the payment of such prescribed fee as remains unpaid on the date of the order.

24 Compensation arising from restoration

(1) Where registration of a design has been restored in terms of section 23, any person who, during the period between the lapse of such registration and its restoration, has expended any money, time or labour with a view to making or disposing of articles embodying the registered design, may apply in the prescribed manner to the court for compensation in respect of the money, time and labour so expended.

(2) The court may, after hearing the parties concerned, assess the amount of such compensation if in its opinion the application ought to be granted, and determine the time in which such compensation shall be paid.

(3) Any amount assessed under subsection (2) shall not be recoverable as a debt or damages but, if it is not paid within the time determined by the court, the registration of the design shall lapse.

25 Joint ownership of registered design

(1) Where registration of a design is granted to two or more persons jointly, each of them shall, in the absence of an agreement to the contrary, be entitled to an equal undivided share in the registered design.

(2) Subject to the provisions of subsections (4) and (6), a joint registered proprietor shall, in the absence of an agreement to the contrary and in the absence of

consent of the other joint registered proprietor or proprietors, not be entitled-

- (a) to perform any of the acts reserved exclusively for a registered proprietor in section 20;
- (b) to grant a licence or to assign the whole or any part of his interest in the registered design; or
- (c) to take any steps or institute any proceedings relating to the registered design:

Provided that he may pay any renewal fee that is payable without recourse to any other joint registered proprietor.

(3) Where an article embodying a registered design or a design not substantially different from the registered design is disposed of by a joint registered proprietor, the acquirer or any person claiming through him shall be entitled to deal with it in the same manner as if the article had been disposed of by the registered proprietors jointly.

(4) Any joint registered proprietor may institute proceedings for infringement and shall give notice thereof to every other joint registered proprietor, and any such other joint registered proprietor may intervene as co-plaintiff and recover any damages in respect of any damage he may have suffered as a result of the infringement.

(5) If in any proceedings under subsection (4) damages are awarded to a plaintiff, damages shall be awarded to him as if he were the sole registered proprietor, and the defendant shall not be obliged to compensate any other joint registered proprietor in respect of the infringement in question.

(6) Where any dispute arises between joint registered proprietors as to their respective rights in or to the registered design, the institution of proceedings relating to the registered design or the manner in which they should deal with the registered design, any joint registered proprietor may apply to the court to decide the matter in dispute.

(7) If in considering any application under subsection (6) the court is satisfied that a joint registered proprietor, not being obliged thereto, is unable or unwilling to remain a registered proprietor, the court may order him to assign his rights to any other joint registered proprietor able and willing so to remain: Provided that where it appears to the court to be just and equitable, it may order the payment of compensation to the joint registered proprietor who is so ordered to assign his rights.

(8) In considering any application under subsection (6) the court shall, unless it appears to it that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation and exploitation of the registered design.

26 Correction of clerical errors and amendment of documents

(1) The registrar or the court may authorize-

- (a) the correction of any clerical error or error in translation in any certificate of registration, application for the registration of a design or document lodged in pursuance of such application, or in the register;
- (b) the amendment otherwise of any document for the amending of which no express provision is made in this Act.

(2) A correction may be made in accordance with this section, either upon a request in writing accompanied by the prescribed fee or without such a request.

(3) If a correction is contemplated otherwise than upon such a request, the registrar shall give notice thereof to the registered proprietor or the applicant for the registration of the design, as the case may be, and to any other person who appears to him

to be concerned, and shall give any such person an opportunity of being heard before the correction is made.

(4) If a correction is requested and it appears to the registrar that the correction would materially alter the scope of the document to which the request relates and the document is open for public inspection, the registrar may require notice of the request to be published in the journal and to be served upon such persons as he or she may deem necessary.

[Sub-s. (4) substituted by s. 76 of Act 38 of 1997.]

(5) If the registrar has not required such notice to be so published and served or, if it had been so published and served and there is no opposition to such a correction, the registrar may decide the matter or, in the latter case, refer it to the court, which shall decide it as it may deem fit.

[Sub-s. (5) substituted by s. 76 of Act 38 of 1997.]

(6) Where such notice has been so published and served, any person may oppose the request mentioned in subsection (2) within the prescribed time and in the prescribed manner, and thereupon the matter shall be dealt with by the court as it may deem fit.

27 Amendment of application for registration, and of registration, of design

(1) An applicant for the registration of a design or a registered proprietor of a design may at any time apply in the prescribed manner to the registrar for the amendment of the application for the registration of a design or of the registration of a design, as the case may be, and shall in making such application, set out the nature of the proposed amendment and furnish his full reasons therefor.

(2) An application for amendment shall be advertised in the prescribed manner.

(3) (a) If the registration of a design to be amended is open for public inspection, any person may oppose the application for amendment of the registration of the design within the prescribed time and in the prescribed manner.

[Para. (a) substituted by s. 77 (a) of Act 38 of 1997.]

(b) The court shall deal with such opposition in the prescribed manner, and determine whether and on what conditions, if any, the amendment ought to be allowed.

(4) If no person opposes the application as contemplated in subsection (3) (a), the registrar may determine whether and on which conditions, if any, the amendment ought to be allowed.

(5) An amendment of an application for the registration of a design, or the registration of a design, may be allowed if it is by way of correction, including the correction of a mistake.

(6) No amendment of-

- (a) an application for the registration of a design, or a registration of a design, shall be allowed if-
 - (i) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the application for the registration of a design or the registration of the design before amendment; or
 - (ii) registration of a design as amended would include any matter not fairly based on matter disclosed in the document before amendment;

(b) a registration of a design shall be allowed if-

- (i) the effect would be to alter a registration in terms of the repealed Act from a Part A to a Part F registration; or
- (ii) the scope of the registration after amendment would be wider than that before amendment.

[Sub-s. (6) substituted by s. 77 (b) of Act 38 of 1997.]

(7) Any amendment made in conflict with the provisions of this section, other than an amendment allowed by a court, may be set aside by the court at any time on application made to it.

(8) An application for the registration of a design made after the commencement of this Act, may be amended from a Part A to a Part F application or *vice versa*, but not after it has been granted.

28 Rectification of register

The registrar may order the register to be rectified by the making, amendment or deletion of any entry therein, and such order may be made either on a request in the prescribed manner or without such a request: Provided that where the registrar intends to make an order otherwise than upon a request, he shall give notice of his intention to do so to the applicant for the registration of a design or to the registered proprietor, as the case may be, and to any other person who appears to him to be concerned, and shall give such applicant, registered proprietor or other person an opportunity of being heard before making the order.

29 Assignment and devolution by operation of law

(1) The rights vested in an applicant for the registration of a design or a registered proprietor shall be capable of assignment and of devolution by operation of law.

(2) Any condition in a contract of employment which-

- (a) requires an employee to assign to his employer a design made by him otherwise than within the course of his employment; or
- (b) restricts the right of an employee in a design made by him more than one year after the termination of the contract of employment,

shall be null and void.

30 Assignment of rights in and attachment or hypothecation of registered designs

(1) (a) An applicant for the registration of a design or a registered proprietor may assign his rights in an application or design to any other person, and unless such assignment is in writing it shall not be valid.

(b) Upon application in the prescribed manner and on payment of the prescribed fee to the registrar, such assignment shall be recorded in the register.

(c) Unless such assignment is so recorded it shall not be valid, except as between the parties thereto.

(2) A registered design or an application for the registration of a design may be attached by recording the warrant of execution or attachment order concerned in the register in the prescribed manner.

(3) Upon the discharge of any attachment, the person who caused such warrant or order to be entered into the register shall cause that entry to be deleted: Provided that any other interested person may apply to the registrar to cause such entry to be deleted.

(4) An attachment shall lapse on the expiry of a period of three years from the date of recording it in terms of subsection (2), unless it is renewed within that period.

(5) The hypothecation of a registered design or an application for the registration

of a design may on application in the prescribed manner be entered in the register.

(6) After the entry of an attachment or hypothecation in terms of this section, the registered proprietor or applicant for the registration of a design shall not alienate or encumber the attached or hypothecated registered design or application for the registration of a design or grant any licences in respect of such registered design: Provided that such attachment or hypothecation shall not affect the granting of a licence in terms of section 21.

31 Grounds for application for revocation of registration of design

(1) Any person may at any time apply to the court in the prescribed manner for the revocation of the registration of a design on the following grounds, namely-

- (a) that the application for the registration of the design was not made by a person entitled thereto under section 14;
- (b) that the registration of the design is in fraud of the rights of the applicant or of any person under or through whom he claims;
- (c) that the design in question is not registrable under section 14;
- (d) that the application for the registration of the design contains a false statement or representation which is material and which the registered proprietor knew was false at the time when the statement or representation was made;
- (e) that the application for the registration of the design should have been refused in terms of section 16.

(2) An application for revocation shall be served on the registered proprietor and lodged with the registrar in the prescribed manner, whereafter it shall be dealt with in the prescribed manner.

(3) The court shall decide whether the registration shall be revoked or not.

32 Registration comprising more than one design

Registration of a design shall be granted for one design only, but no person may in any proceedings apply for the revocation of such registration on the ground that it comprises more than one design.

33 After revocation on ground of fraud proprietor may in certain circumstances again register design

Where registration of a design is revoked on the ground of fraud, or where registration fraudulently obtained has been surrendered and revoked, the court may, on the application of the proprietor of the relevant design or his assignee or his agent, made in accordance with the provisions of this Act, direct that registration of such design be granted to him, bearing the same date as the registration so revoked.

34 Voluntary surrender of registered design

(1) A registered proprietor may at any time, by giving notice in the prescribed manner to the registrar, offer to surrender the design, and the registrar shall give notice of the offer to any person shown in the register to have an interest in that design.

(2) Any interested person may within the prescribed time lodge in writing with the registrar an objection to the surrender of the design.

(3) If no objection is so lodged or if any such objection is overruled by the court after having given the registered proprietor and the objector an opportunity to be heard, the registration shall be deemed to have been revoked as from the date of receipt by the registrar of the offer of surrender, and the registrar shall advertise the revocation of the

registration in the journal and make the necessary entries in the register.

(4) An offer to surrender a registered design shall not be considered as long as any proceedings for infringement or revocation of that registered design are pending before the court, except by consent of the parties to such proceedings or with the leave of the court.

35 Proceedings for infringement

(1) Proceedings for infringement of a design may be instituted by the registered proprietor.

(2) Before the registered proprietor institutes such proceedings, he shall give notice thereof to every licensee in respect of the registered design in question whose name is recorded in the register, and any such licensee shall be entitled to intervene as a co-plaintiff: Provided that no such notice is necessary in the case of a compulsory licence in terms of section 21.

(3) A plaintiff in proceedings for infringement shall be entitled to relief by way of-

- (a) an interdict;
- (b) surrender of any infringing product or any article or product of which the infringing product forms an inseparable part;
- (c) damages; and
- (d) in lieu of damages, at the option of the plaintiff, an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the registered design concerned.

[Para. (d) substituted by s. 78 of Act 38 of 1997.]

(4) For the purposes of determining the amount of any damages or reasonable royalty to be awarded under this section, the court may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as to it may seem fit.

(5) In any proceedings for infringement the defendant may counterclaim for the revocation of the registration of the design and, by way of defence, rely upon any ground on which the registration may be revoked.

(6) Any person who represents that any design is registered, without such representation disclosing the number of the registered design concerned, and from whom the number of such registered design has been requested in writing by registered post by any other person unaware of such number, may not recover from such other person damages, or obtain an interdict against him, in respect of any infringement of such registered design by such other person, committed during the period commencing with the representation and terminating two months after the date on which such other person was notified in writing by the first-mentioned person of the number of the registered design concerned.

(7) Any person who, having made a request referred to in subsection (6), expends during the period referred to in that subsection, any money, time or labour with a view to making, using or disposing of any article embodying the registered design or a design not substantially different from a registered design, as the case may be, may apply in the manner prescribed to the court for compensation in respect of the money, time or labour reasonably so expended, and the court may issue such order as it may deem fit.

(8) If proceedings are instituted in respect of infringement of a registered design, committed after the failure to pay any prescribed renewal fee within the prescribed

period, and before any extension of the period for such payment, the court may, if it thinks fit, refuse to award any damages in respect of the infringement.

(9) Nothing in this Act shall entitle the registered proprietor to interfere with or restrain any person performing any of the acts contemplated in section 20 (1) where such person commenced performing any such act before the date of registration of the design.

(10) Where a design has been registered, any person who, before the date of registration of that design, expended any money, time or labour with a view to performing any of the acts contemplated in section 20 (1), and who is then prevented from performing any of such acts by virtue of the registration of such design, may apply in the prescribed manner to the court for compensation by the registered proprietor in respect of money, time and labour so expended.

(11) The court may, after hearing the parties concerned, assess the amount of such compensation if in its opinion the application ought to be granted, and determine the time in which such compensation shall be paid.

(12) Any amount assessed under subsection (11) shall not be recoverable as a debt or damages but, if it is not paid within the time determined by the court, the registration of the design shall lapse.

36 Declaration as to non-infringement

(1) A declaration that the making, importing, using, disposing or reproducing of an article by any person does not or would not constitute an infringement of a registered design, may be made by the court in proceedings between that person and the registered proprietor, notwithstanding that no assertion to the contrary has been made by the registered proprietor or licensee, if it is proved that-

- (a) such person has applied in writing to the registered proprietor or licensee for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars of the article in question; and
- (b) the registered proprietor or licensee has failed to give such an acknowledgement.

(2) The costs of all parties to proceedings for a declaration instituted by virtue of this section shall be awarded in such manner as the court may deem fit.

37 Remedy for groundless threats of infringement proceedings

(1) If any person, by circular, advertisement or otherwise, threatens any other person with proceedings for infringement of a registered design, a person aggrieved thereby may, whether the person making the threats is or is not entitled to or interested in a registered design, or an application for the registration of a design, institute proceedings against him and obtain a declaration to the effect that such threats are unjustifiable and an interdict against the continuance of such threats, and may recover such damages, if any, as he has sustained thereby, unless the person making the threats proves that the acts in respect of which the proceedings are threatened, constitute or, if performed, would constitute an infringement of a registered design which is not shown by the plaintiff to be invalid: Provided that a circular, advertisement or communication addressed to any person which comprises only a notification of the existence of a particular registered design upon which the registered proprietor relies for protecting his interest shall not, by itself, be deemed to be a threat of proceedings for infringement.

(2) The defendant in any such proceedings may apply by way of a counterclaim in the proceedings for any relief to which he would be entitled in separate proceedings in

respect of any infringement by the plaintiff of the registered design to which the threat relates.

38 Special provisions as to vessels, aircraft and land vehicles of convention countries

(1) Subject to the provisions of this section, the rights of a registered proprietor shall not be deemed to be infringed-

- (a) by the use on board of a convention vessel of the registered design in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, if the vessel comes into the territorial waters of the Republic temporarily or accidentally only, and such design is used exclusively for the actual needs of the vessel; or
- (b) by the use of the registered design in the construction or working of a convention aircraft or land vehicle or accessories thereof if the aircraft or vehicle comes into the Republic temporarily or accidentally only.

(2) For the purposes of this section, vessels and aircraft shall be deemed to be vessels and aircraft of the country in which they are registered, and land vehicles shall be deemed to be vehicles of the country within which the owners are ordinarily resident.

39 Register to be evidence

(1) The person appearing from the register to be the proprietor or applicant for the registration of a design shall, subject to any right appearing from the register to be vested in any other person, have power to deal with the registered design or the application for the registration of a design as the owner thereof.

(2) The provisions of subsection (1) shall not protect any person dealing with a proprietor or applicant as aforesaid otherwise than as a *bona fide* licensee, purchaser, hypothecary or judgment creditor and without notice of any fraud on the part of such proprietor or applicant.

(3) Except for the purposes of section 28, a document or instrument in respect of which no entry has been made in the register in terms of section 7, shall not be admitted in evidence in any proceedings in proof of the title to a registered design or application for the registration of a design or to any interest therein unless the court, on good cause shown, otherwise directs.

(4) The register shall be *prima facie* evidence of any matter directed or authorized by this Act to be entered therein.

40 Certificates of registrar to be *prima facie* evidence

(1) A certificate purporting to be signed by the registrar, to the effect that any entry authorized by this Act to be made, has or has not been made or that any other thing so authorized to be done has or has not been done, shall be *prima facie* evidence of the matters specified in that certificate.

(2) A copy or an extract purporting to be a copy of an entry in the register or of a document kept at the designs office or an extract from the register or any such document, and purporting to be certified by the registrar and to be sealed with the seal of the designs office, shall be admitted in evidence in all courts without further proof or production of the originals.

(3) If any document or book bears a date purporting to be the date in which it became available to the public, that date shall, unless the contrary is proved, be deemed to be the date on which it became so available.

41 Certification of validity

(1) If in any proceedings the validity of any registration of a design is in issue, the court finding that registration to be valid, may certify to that effect.

(2) If in any subsequent proceedings the validity of that registration is unsuccessfully attacked by any party, that party shall, unless the court otherwise directs, pay to the other party his full costs, charges and expenses as between agent or attorney and client so far as that registration is concerned.

42 Appeal to court

(1) Any party to proceedings before the registrar may appeal to the court against any order or decision of the registrar pursuant to such proceedings.

(2) The order or decision of the registrar referred to in subsection (1) shall be deemed to be an order or judgment of a magistrate in a civil action heard by such magistrate.

43 Proclamations as to convention countries

(1) The State President may, with a view to the fulfilment of a treaty, convention, arrangement or engagement, by proclamation in the *Gazette* declare that any country or group of countries specified in the proclamation is a convention country or are convention countries for the purposes of any or all of the provisions of this Act.

(2) For the purposes of subsection (1) every territory for whose international relations another country is responsible shall be deemed to be a country in respect of which a declaration may be made under that subsection.

44 Registration of design where application for protection has been made in convention country

(1) An application for registration of a design in respect of which protection has been applied for in a convention country, by way of an application for registration of a design or similar right, may be made in accordance with the provisions of this Act by the person by whom the application for protection in the convention country was made or his or her cessionary: Provided that no application shall be made by virtue of this section after the expiry of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application: Provided further that if after the filing of the first application for protection in a convention country in respect of any design or similar right, a subsequent application is filed in that country in respect of the same design or similar right, such subsequent application shall be regarded as the first application in that country in respect of that design or similar right, if at the time of filing thereof-

- (a) the previous applications had been withdrawn, abandoned or refused without having been open to public inspection; and
- (b) no priority rights have been claimed on the strength of such previous applications; and
- (c) no rights are outstanding in the convention country in question in connection with such previous applications.

[Sub-s. (1) amended by s. 79 of Act 38 of 1997.]

(2) An application which has been withdrawn, abandoned or refused shall not after the filing of the subsequent application be capable of supporting a claim for priority rights under this section.

(3) A design registered on an application made under this section shall be

registered as of the date of the application or, where more than one such application for protection has been made, the date of the first such application or, as the case may be, the date of the application which is regarded as the first such application: Provided that no proceedings shall be instituted in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(4) Where a person has applied for protection for a design by an application which-

- (a) in accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) in accordance with the laws of any convention country, is equivalent to an application duly made in that convention country,

he shall be deemed for the purposes of this section to have applied in that convention country.

45 Extension of time for applications in certain cases

(1) If the Minister is satisfied that provision substantially equivalent to the provision to be made by or under this section has been made or will be made under the law of any convention country, he may, by notice in the *Gazette*, make regulations empowering the registrar to extend the time for making application under section 44 (1) for registration of a design in respect of which protection has been applied for in that country in any case where the period specified in the first proviso to that subsection expires during a prescribed period.

(2) Regulations made under this section may-

- (a) where any agreement or arrangement has been made between the government of the Republic and the government of the convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of case specified in the regulations that an extension of time shall not be granted under this section unless the design has been communicated in accordance with the agreement or arrangement;
- (b) either generally or in any class of case specified in the regulations, fix the maximum extension of time which may be granted under this section;
- (c) prescribe or allow any special procedure in connection with applications made under this section;
- (d) empower the registrar to extend, in relation to an application made under this section, the time limited by or in terms of the foregoing provisions of this Act for performing any act, subject to such conditions, if any, as may be imposed by or in terms of the regulations;
- (e) provide for securing that the rights conferred by registration on an application made under this section shall be subject to such restrictions or conditions as may be specified by or in terms of the regulations and in particular to restrictions and conditions for the protection of persons who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a), and before the date of the application in question or such later date as may be allowed by the regulations, may have imported or made articles to which the design is applied or may have made an application for registration of

the design.

46 Minister may require designs to be kept secret in certain circumstances

(1) If the Minister is of opinion that in the national interest an application or any other document relating to any design should be kept secret, he may order the registrar to keep the design secret and to notify the applicant accordingly.

(2) Whenever any order issued by the Minister under this section is withdrawn, any steps which were prior to the date of that order taken under this Act in connection with the application which was the subject of that order, and which were interrupted in consequence of that order, may be proceeded with as if the interruption had not occurred, and any period which may have elapsed between the date on which that order was lodged with the registrar and the date of withdrawal thereof shall not be taken into account in the computation of any period of time prescribed by or under this Act.

(3) If the proprietor of a design has suffered loss or damage by reason of that design having been kept secret in pursuance of an order under subsection (1), the Minister shall pay to him such reasonable compensation as may be agreed upon or as may, in default of agreement, be determined by arbitration or, if the parties so agree, by the court.

47 Penalties for making false entries in register, or making, producing or tendering false entries or copies

Any person who-

- (a) makes or causes to be made a false entry in the register;
- (b) makes or causes to be made a writing falsely purporting to be a copy of an entry in the register; or
- (c) produces or tenders or causes to be produced or tendered as evidence any such entry or copy thereof knowing it to be false,

shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a period not exceeding one year.

48 Penalties for making false statements for purpose of deceiving or influencing registrar or officer

Any person who-

- (a) for the purpose of deceiving the registrar or any officer in the execution of the provisions of this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder,

makes a false statement or representation knowing it to be false, shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a period not exceeding one year.

49 Penalties for certain false representations

(1) Any person who-

- (a) falsely represents that there is a registered design in respect of any article; or
- (b) represents that any article is the subject of an application for the registration of a design knowing that no such application has been made or that an application made in respect thereof has been refused or withdrawn or has lapsed,

shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a

period not exceeding one year.

(2) If any person disposes of any article on which is stamped, engraved or impressed or to which is otherwise applied the word 'design' or 'registered design' or any other word expressing or implying that-

(a) there is a registered design in respect of the article; or

(b) the article is the subject of an application for registration of a design,

or to which any marking is applied in any manner so expressing or implying, he shall be deemed for the purposes of this section to represent that there is a registered design in respect of the article or that the article is the subject of an application for registration of a design.

(3) The provisions of subsection (2) shall not apply to a person who disposes of articles in good faith in the ordinary course of trade, provided, when called upon to do so, he discloses the identity of the person from whom he acquired the article in question.

(4) Any person who is of the opinion that he is prejudiced by a representation referred to in subsection (1) (a) or (b), may apply to the court for an interdict against the continuation of that representation.

50 Documents may be sent by post

Any application, notice or document authorized or required in terms of this Act to be lodged, made or given at the designs office or to the registrar or any other person, may be delivered by hand or sent through the post.

51 Address for service

(1) With every application, notice or other document authorized or required in terms of this Act to be lodged or given, the applicant or other person concerned shall furnish in the prescribed manner an address within the Republic as an address for service, which shall for the purposes of this Act be deemed to be the address of such applicant or other person, and all documents in relation to such application, notice or other document may be served by leaving them at or sending them to such address for service.

(2) Any address for service may be changed by notice in the prescribed manner.

52 Calculation of periods of time

(1) Where any period of time is specified by this Act as running from the performing of any act, it shall be reckoned as commencing on the day next following the performing of that act.

(2) Whenever the last day on which, in terms of this Act, any act may or is required to be performed or any document may or is required to be lodged, falls on a day on which the designs office is closed, that act may be performed or that document may be lodged on the next following day on which the designs office is open for the transaction of business.

53 Condonation or correction of irregularities in procedure

The registrar or the court may authorize the condonation or correction of any irregularity in procedure in any proceedings before him or it, provided such condonation or correction is not detrimental to the interests of any person.

54 Regulations

The Minister may make regulations-

(a) with the concurrence of the Minister of State Expenditure, prescribing the matters in respect of which fees shall be payable, and the tariff of such fees;

- (b) prescribing the tariff of fees which shall be allowed on taxation in connection with proceedings before the registrar or the court;
- (c) prescribing the procedure in any proceedings before the registrar or the court;
- (d) prescribing the service of notices and other documents required in terms of this Act to be served in connection with proceedings before the registrar;
- (e) providing for the conduct and administration of the designs office, including the keeping and preservation of any records in the designs office, the removal from such office and preservation in any other place of such records, and as to the circumstances in which any such records may be destroyed;
- (f) prescribing the contents of any application, notice or form provided for in this Act;
- (g) as to any other matter required or permitted by this Act to be prescribed by regulation; and

generally, as to any matter which he considers it necessary or expedient to prescribe in order that the purposes of this Act may be achieved.

55 Repeal of laws

(1) The Designs Act, 1967 (Act 57 of 1967), is hereby repealed.

(2) Any proclamation issued under the repealed Act declaring any country to be a convention country, and any regulations made under that Act, shall continue in operation until repealed or amended by proclamation issued or regulations made under this Act.

56 Short title and commencement

This Act shall be called the Designs Act, 1993, and shall come into operation on a date fixed by the State President by proclamation in the *Gazette*.