



**IN THE HIGH COURT OF SOUTH AFRICA
(WESTERN CAPE DIVISION, CAPE TOWN)**

JUDGMENT

Not Reportable

Case nos: 17499/2024; 17500/2024 and
17501/2024

In the matter between:

BALSTER JAN NIENHUIS

APPLICANT

and

AFRICO SOLAR (PTY) LTD

RESPONDENT

In re: Infringement of Registration Design No. F2022/01044 "Bracket for Mounting Solar Panels on an ABR Roof" Case no. 17499/2024

In re: Infringement of Registration Design No. F2022/00395 "Bracket for Mounting Solar Panel in Tiled Roofs" Case no. 17500/2024

In re: Infringement of Registration Design No. F2022/01043 “Bracket for Mounting Solar Panels on a Corrugated Roof” Case no. 17501/2024

Neutral citation:

Coram: COOKE AJ

Heard: 6 August 2025

Delivered: 25 August 2025

Summary: Designs Act 195 of 1993 – evidence of infringement – interpretation of s 21(1) of the Act – scope of protection – misdescription of article

ORDER

- [1] The respondent is interdicted and restrained from infringing the applicant’s South African registered designs with numbers F2022/00395, F2022/01043 and F2022/01044.
- [2] The respondent is directed to deliver to the applicant for destruction all infringing articles under its control.
- [3] An enquiry shall be conducted for the purposes of determining the extent and amount of any damages suffered by the applicant.
- [4] In the event that the parties are unable to reach agreement concerning the affidavits or pleadings to be delivered, or regarding discovery, inspection, or other procedural matters related to the enquiry, any party may make application to the Court for directions on these issues.

[5] Save as set out in paragraph 6 below, the respondent shall pay the costs of the applications under the above case numbers, with costs of counsel to be taxed on scale C.

[6] The wasted costs occasioned by the postponement of the hearing set down for 14 February 2025 shall be paid by the applicant, with costs of counsel to be taxed on scale B.

JUDGMENT

Cooke AJ:

Introduction

[1] South Africa is a country which enjoys abundant sunshine; however, it also experiences unreliable challenges with electricity supply. It is not surprising that there is a strong demand for solar panels. This demand is fuelled by tax incentives and continuing technological advances, leading us to become familiar with solar panels gracing the rooftops of various structures.

[2] This demand for solar panels poses a technical challenge. How are the panels to be attached to different kinds of rooftops? The applicant, Mr Nienhuis, solved this problem by designing brackets for mounting solar panels on three types of roofs – tiled, corrugated, and inverted box rib (IBR). These brackets were marketed and sold by Balster Machinery CC, a corporation trading as Nas Moulds. Mr Nienhuis describes himself as a co-director of this corporation, and I shall refer to these brackets as ‘the Nas Moulds brackets’.

[3] Conscious of the need to procure legal protection for his innovation, on Mr Nienhuis had these designs registered in terms of the Designs Act 195 of 1993 ('the Act') on 19 October 2022 and 28 April 2023. The designs were filed in class 13,¹ which is headed 'Equipment for production, distribution or transformation of electricity'. It is common cause that class 13 encompasses solar equipment such as brackets or supports for solar panels. As functional designs,² they were registered in Part F of the register. The designs are in fully operational , and the registration was publicised by moulding the registration numbers on the surface of the brackets.

[4] The respective definitive statements claimed protection for:

- a. 'the features of shape and/or configuration of a Bracket for Mounting Solar Panels as shown in the accompanying representations' (F2022/00395);³
- b. 'the features of shape and/or configuration of a Bracket for Mounting Solar Panels on a Corrugated Roof as shown in the accompanying photographs' (F2022/01043); and
- c. 'the features of shape and/or configuration of a Bracket for Mounting Solar Panels on an ABR Roof as shown in the accompanying photographs' (F2022/01044).

[5] The industrial design registration system is based on the principle that good design should be encouraged for the overall benefit of both public and designers. It ensures that designers are not only rewarded for their creativity but also safeguarded against the unauthorised appropriation of their work by others. Upon registration at the designs office, the owner of a design is granted exclusive rights to

¹ The various classes are listed in schedule 3 to the Designs Regulations, 1999.

² The Act defines 'functional design' as meaning 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.

³ The explanatory statement recorded that this bracket is for mounting solar panels on a tiled roof.

that design for a specified duration, which in this instance is ten years. After this period concludes, the design enters the public domain.⁴

- [6] The protection afforded by a design registration is narrower than that of a patent. For example, the protection for a design is limited to the specified features of the article and by the scope of the class in which it is registered. Patent protection, on the other hand, is not limited by classification nor is it limited to articles. It may extend to processes, methods and the like.⁵ It is thus important that the proprietors of designs carefully select the class or classes in which they wish the design to be registered.⁶

Background

- [7] According to Mr Nienhuis, on 20 July 2023 he was informed by Mr Gouws, the sales manager at Nas Moulds, that there were identical copies of the Nas Moulds brackets at the offices of the respondent ('Africo Solar'). I shall refer to these brackets as 'the Africo brackets'. Upon further investigation it appeared that a company related to Africo Solar, namely Solar Tech Wholesalers, had purchased substantial numbers of brackets from Nas Moulds during the period 29 April 2022 to 26 July 2023. Mr Nienhuis deduced that those behind Africo Solar and Solar Tech Wholesalers had filched his intellectual property.
- [8] After a written demand failed to produce a positive outcome, Mr Nienhuis brought three separate applications under the Act for relief against Africo Solar. One application for each design. The affidavits filed in the various application are, for all material purposes, the same.
- [9] On 17 September 2024 Kusevitsky J postponed the applications to be heard together on 14 February 2025. For reasons discussed below, on 12 February 2025

⁴ TD Burrell *Burrell's South African Patent and Design Law* 4 ed 2016 (Burrell) §9.1.

⁵ Burrell §9.3.

⁶ Burrell §9.81.

the applications were postponed once more by order of the Judge President for hearing on 6 August 2025.

[10] The question which arises for determination is whether Mr Nienhuis is entitled to relief under s 20(1) of the Designs Act. This section provides:

‘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’.

[11] In its answering affidavits Africo Solar raised specific *in limine* objections, such as the failure to cite the Registrar of Designs. In argument, its counsel advised that his client did not persist with these objections.

[12] The essence of the defence is that the Africo panels were used outside of class 13. Africo Solar does not deny that it was selling brackets identical to the Nas Moulds brackets, however, it disputes the claim that this constituted an infringement of Mr Nienhuis’ rights, contending instead that the selling of an identical bracket does not by itself constitute a ‘primary act of infringement’ as the bracket may be used for functions in other design classes. Africo Solar alleges that the Nas Moulds brackets could potentially be used in other contexts, for example as a mounting device for shelving, additional support structures, or lighting fixtures, which would fall outside the scope of class 13. It was also alleged that the brackets were sold to mount geysers and heat pumps.

[13] While Africo Solar denies the claim that the Nas Moulds brackets are copied, it fails to clarify how it acquired brackets that are identical. The bare denial rings

hollow. The inevitable inference is that those in control of Africo Solar and Solar Tech Wholesalers copied or facilitated the copying of the Nas Moulds brackets for their own commercial purposes.

[14] To ascertain whether there has been an infringement of a design registration, it is necessary to establish whether the following four requirements have been satisfied:

(a) the alleged act is of such a nature that it could constitute an infringement of the design registration;

(b) the article in issue is included in the class in which the design is registered;

(c) the alleged infringement falls within the scope of the registrations having regard to the representations and definitive statement filed in support of the application for registration; and

(d) the respondent has a valid defence.⁷

[15] Although Africo Solar denies that it manufactured the Africo brackets, it does not deny that it was involved in the sale of these brackets. Indeed, it was caught red-handed doing so. In the circumstances it was, at least, 'disposing of' the brackets.⁸ This constitutes an act of infringement, and the first requirement is satisfied. In addition, there is no suggestion that the registration is invalid, or that Africo Solar has a valid defence, as contemplated by the fourth requirement. That leaves the second and third requirements in issue.

Was the article in class 13?

⁷ Bayerische Motoren Werke Aktiengesellschaft v Grandmark International (Pty) Ltd and Another (50212/2010) [2012] ZAGPPHC 139 (25 July 2012) See also *Burrell* §9.79ff.

⁸ As to the meaning of 'disposing of', see *Burrell* §5.9.

[16] A registered proprietor is only entitled to exclude others from committing acts of infringement in relation to any article 'included in the class in which the design is registered'. Africo Solar disputes that the articles in question are included in the class in which Mr Nienhuis' design is registered. The inquiry, therefore, revolves around whether Mr Nienhuis has demonstrated that Africo Solar was marketing brackets that fall under class 13.

[17] Africo Solar's counsel submitted that even if the bracket's shape and configuration are similar, using it for an alternative purpose does not constitute an infringement of Mr Nienhuis' design registration as it falls outside the class for which the design is registered.

[18] In my view counsel's emphasis on the use to which the article is put is misplaced as far as the second requirement is concerned. Section 20(1) of the Act empowers the registered proprietor to exclude persons from making, importing, using or disposing of any article included within the specified class. In terms of reliance on disposing, it is the 'article' that should be included in the class, rather than the 'disposing'.⁹. The question in this case is thus whether the article itself falls within the class, rather than whether the way it is disposed of leads to its use within that class. used in

[19] The Africo brackets are substantially identical to the Nas Moulds brackets, and thus plainly fall within class 13. It follows that Africo Solar is disposing of an article which is included in class 13.

[20] In the circumstances I am satisfied that Mr Nienhuis has met the second requirement.

Does the infringement fall within the scope of the registration?

⁹ Article is defined in s 1(iv) of the Act as meaning 'any article of manufacture and includes a part of such article if manufactured separately'.

[21] Regarding the third requirement, Africo Solar's counsel emphasised that the definitive statements¹⁰ expressly claim protection for mounting solar panels on a roof. He submitted that merely selling a bracket, without more, does not constitute an act of infringement. The bracket might serve additional purposes beyond just mounting solar panels, and unless Mr. Nienhuis can demonstrate that Africo Solar uses or promotes the design for the protected purpose, infringement cannot be proven..

[22] On the other hand, counsel for Mr Nienhuis submitted that the reference in the definitive statements to the purpose of the design (ie mounting solar panels) is irrelevant. He placed reliance upon regulation 15 of the Designs Regulations which provides in sub-regulation (1) that the definitive statement must set out the features of the design. He submitted further that designs are par excellence judged by the eye. In the circumstances, so his argument ran, the use to which the product will be put is irrelevant. .

[23] The authorities that determine that an infringement is to be 'decided by the eye'¹¹ are more easily applied to aesthetic designs than functional designs. As the late Marius le Roux observed shortly after the Act came into being, it is difficult to imagine how this test for infringement will be applied to functional designs since, by definition, they do not include features which are judged by the eye.¹²

[24] The very name 'functional design' suggests that the design's function or purpose holds significance. Similarly, the definition of 'functional design' refers to

¹⁰ In terms of regulation 15(1) the definitive statement shall be used to interpret the scope of the protection afforded by the design registration, and regulation 15(4) provides that the explanatory statement may be used to assist in interpreting the scope of the protection afforded by the design registration. See in this regard *Clipsal Australia (Pty) Ltd and Another v Trust Electrical Wholesalers and Another* 2009 (3) SA 292 (SCA) (*Clipsal*) para 6.

¹¹ *Homecraft Steel Industries (Pty) Ltd v S M Hare & Son (Pty) Ltd and Another* 1984 (3) SA 681 (A) at 694l.

¹² M le Roux 'The Protection of Functional Designs' in C Visser (ed) *The New Law of Trade Marks and Designs* 1995 at 75.

the characteristic features which are necessitated by the function which the article is to perform, and regulation 15(2) of the Design Regulations states that the explanatory statement may refer to features of the article to which the design is to be applied, including the function. Viewed within this context, it may well be that the scope of protection is to be assessed with reference not only to the features of the article, but also the purpose for which the article is to be used, particularly where that purpose is identified in the definitive and explanatory statements.

[25] Plainly the Africo brackets have the same, or substantially the same features as the protected design.

[26] I shall assume in favour of Africo Solar, without deciding the point, that it is also necessary for Mr Nienhuis to show that the infringing articles were used for the same or a substantially similar purpose as reflected in the definitive and explanatory statements, namely the mounting of solar panels. The inquiry, therefore, revolves around whether it has been demonstrated that Mr. Nienhuis' design is utilised or endorsed by Africo Solar for the installation of solar panels.

[27] The answering affidavits deposed to by Mr Brink, a director of Africo Solar, can fairly be described as coy. Mr Brink's affidavit is conspicuous for what it does not say. In addition to alleging that some of the brackets are used for other purposes, and supporting this allegation by affidavits deposed to by electricians, one of whom used the Africo brackets for mounting closed-circuit television cameras and solar geysers, he played his cards close to his chest. The affidavit fails to offer any specifics about the conditions under which Africo brackets are sold. For instance, the source of the brackets remains unidentified, and there is no explanation provided on how they are marketed, nor is there any specific information regarding the buyers. If this information supported the defence, I have no doubt that it would have been disclosed.

[28] In his founding affidavit Mr Nienhuis alleged that the Africo brackets are solar panel brackets for mounting solar panels on roofs and are included in class 13 and have the same purpose and function as his design. The response from Mr Brink is instructive. All he says is:

‘I note the contents of the paragraph under reply, and it should be noted that this bracket could also be registered or find function in Class 20, which relates to furniture and parts thereof and could (and is in fact) used for other purposes as set out above.’

[29] Mr Brink does not explicitly deny that the Africo brackets are intended for mounting solar panels. Nor does he deny that they serve the same purpose and function as Mr Nienhuis’ design. The defence is limited to the contention that the Africo brackets might serve additional functions.

[30] This is a case where relevant facts lie purely within the knowledge of the disputing party. Africo Solar must necessarily possess knowledge regarding whether the Africo brackets are sold for use as solar panel brackets, and if so, the extent of such sales. In relation to several allegations made by Mr Nienhuis, instead of providing countervailing evidence, Africo Solar rests its case on bare or ambiguous denials. In these circumstances I have difficulty in finding that there is a real, genuine and bona fide dispute of fact.¹³

[31] To my mind there are several facts from which it may be inferred that Africo Solar sold the Africo brackets predominantly for use in relation to the mounting of solar panels. In particular:

(a) Africo Solar’s name suggests that it is in the business of solar products.

¹³ See *Wightman t/a JW Construction v Headfour (Pty) Ltd and Another* 2008 (3) SA 371 (SCA) para 13.

- (b) The Africo bracket uses the brand and trademark 'VOLTA'. This trademark is owned by Africo Trading Company (Pty) Ltd, which is associated with Africo Solar. It is probable that the product was named after Professor Alessandro Volta, the Italian chemist and physicist who is credited with inventing the electric battery, and from whom we derive the words voltage and volt. By naming the product after Professor Volta, it was indicated that the product is intended for use in relation to the production of electricity.
- (c) The 'VOLTA' mark and logo were registered in various classes covering solar panel brackets.
- (d) Mr Nienhuis alleged in his replying affidavit that Africo Solar's main business, as it relates to the infringing product, is solar panel sales and installations. Even though this was raised in reply, I do not understand Africo Solar to dispute this.
- (e) The Africo bracket is advertised, albeit by a separate entity, as a 'solar panel mounting system'.
- (f) The Nas Moulds brackets were designed by Mr Nienhuis for use as solar panel brackets. The overwhelming probability is that Solar Tech Wholesalers purchased them for use as solar panel brackets. The panels having been purchased for such use, and Africo Solar having caused copies to be made, it is highly unlikely that they were then marketed for some other purpose.

[32] In light of all these circumstances, I confidently conclude that Africo Solar was and is selling the Africo brackets predominantly for use as solar panel mounting. Does it make any difference that the brackets were also used for other purposes falling outside the protected purpose?

[33] In my view, if an article is predominantly used within the scope of the registered design, considering the representations and the definitive statement, it should be

covered by the protection afforded by s 20(1), even if the article is also used within other classes. Were this not the case, it would place an intolerable burden on the proprietor to foresee every possible use to which the article may be put. It would also enable individuals replicating the design to circumvent the protection by the simple expedient of contriving an alternative purpose for the article. Such a construction is necessary to ensure that the proprietor of the design 'shall have and enjoy the whole profit and advantage accruing by reason of the registration'.

[34] The approach proposed is, to my mind, businesslike and sensible and is consistent with the context and purpose of the legislation.¹⁴

[35] There is a complication which arises only in respect of case number 17449/24 in relation to design F2022/01044. The registration forms, along with the definitive statement, specified the articles to which the design is to be applied as 'bracket for mounting solar panels on an ABR roof' (Emphasis added). The documents should have referred to an 'IBR' roof. In reply, Mr Nienhuis alleged that it is clear and obvious to any person with basic knowledge of roof types that this is merely a spelling error. He added that there is no such thing as an 'ABR' roof.

[36] I consider that the reference to 'ABR' should be read as 'IBR'. The photographs which accompanied the registration show that the roof in question is an IBR type roof. Africo Solar knew was aware that the bracket in question was for an IBR roof. This much appears from its invoice which reveals that it called its version of the bracket 'Nylon – IBR Roof Mount Bracket' (Emphasis added). In my view, a reasonable person, bringing reasonable intelligence to bear upon the language in the definitive statement, rather than 'studied obtuseness',¹⁵ and reading the

¹⁴ *Natal Joint Municipal Pension Fund v Endumeni Municipality* 2012 (4) SA 593 (SCA) para 18.

¹⁵ *Letraset Ltd v Helios Ltd* 1972 (3) SA 245 (A) at 251A; *Roman Roller CC and Another v Speedmark Holdings (Pty) Ltd* 1996 (1) SA 405 (AD) at 419D-H.

definitive statement in context, would have understood the proprietor to have meant 'IBR' rather than 'ABR'.¹⁶

[37] I am therefore satisfied that Africo Solar marketed and sold the design predominantly for purposes covered by the definitive statements - namely, mounting solar panels on different roof types. It follows that the infringement falls within the scope of the registration, and the third requirement has been met.

[38] Mr Nienhuis has therefore satisfied the four requirements described above. He is entitled to a monopoly in respect of his design, and he must be rewarded for his innovation and protected against the unlawful exploitation of the fruit of his labour. The pirated use of his design must be stopped. These imperatives are, in my view, attained by the granting of the relief discussed in the next section.

Relief

[39] Section 35(3) of the Act provides that 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.

¹⁶ For a discussion of the principles relating to interpretation in the analogous context of patent protection, see *Burrell* §5.18-5.28.

- [40] In terms of s 35(4) of the Act: '(f)or 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 deem appropriate. t'.
- [41] In my view Mr Nienhuis has shown that he is entitled to interdict Africo Solar from infringing his registered designs.
- [42] As regards the surrender of infringing products, I considered the possibility of qualifying such an order by directing that only those products being used in class 13 must be surrendered. The relevance of the use to which the products are being put is not without challenge. (see above). Regardless, I do not think that it would be practical to draw such a distinction, and it may be difficult to enforce the order if Africo Solar remains entitled to sell Africo brackets for certain purposes, but not others. In the result I am satisfied that Mr Nienhuis is entitled to an order directing Africo Solar to surrender all infringing articles.
- [43] As regards the prayer for an order that there be an enquiry into damages, I have formulated the relief in accordance with the relief granted in similar matters by the Supreme Court of Appeal,¹⁷ taking into account specific practical considerations that may arise in subsequent proceedings.
- [44] Counsel for Africo Solar submitted both in written and oral argument that the postponement of the hearing set down for 14 February 2025 was caused by Mr Nienhuis' legal representatives not complying with the applicable practice directives. It was submitted further that the wasted costs occasioned by this postponement, on scale B, should be paid by Mr Nienhuis. Counsel for Mr Nienhuis did not dispute this submission and I therefore accept that the postponement was indeed attributable to

¹⁷ *Sunsmart Products (Pty) Ltd v Flag & Flagpole Industries (Pty) Ltd t/a National Flags* 2007 JDR 0226 (SCA); *Clipsal* para 26; *Strix Ltd v Nu-World Industries (Pty) Ltd* 2016 (1) SA 387 (SCA) para 26.

the non-compliance with the practice directives. A costs order against Mr Nienhuis in respect of the postponement will be made.

[45] For these reasons I make the order set out above.

DJ COOKE
ACTING JUDGE OF THE HIGH COURT

Appearances

For applicant: R Michau
Instructed by: Hahn & Hahn Attorneys

For respondent: PJ Rabie
Instructed by: Hannes Pretorius, Bock & Bryant