

REPUBLIC OF SOUTH AFRICA



IN THE HIGH COURT OF SOUTH AFRICA
GAUTENG DIVISION, PRETORIA

Case Number: 079625/2024

(1)	REPORTABLE: YES
(2)	OF INTEREST TO OTHER JUDGES: YES
(3)	REVISED: YES
16/3/2026	
DATE	SIGNATURE

In the matter between:

ZENTIA TRADING (PTY) LTD

Applicant

and

EVA-LAST DISTRIBUTORS (PTY) LTD

First Respondent

THE REGISTRAR OF DESIGNS

Second Respondent

Heard on: 13 February 2026

Delivered: 16 March 2026 - This judgment was handed down electronically by circulation to the parties' representatives by email, by being uploaded to the *CaseLines* system of the GD and by release to SAFLII. The date and time for hand-down is deemed to be 14:00 on 16 March 2026.

Summary: Designs – Designs Act 195 of 1993 – revocation application in terms of section 31 – alleged lack of novelty – designs disclosed to the public – “public availability” – information communicated to a person and such person is free both in law and equity to do what they like with the information – information was given to a member of the public.

Novelty – two main enquiries – prior act was publicly available before registration or the release date – disclosure sufficient to destroy the novelty of the designs – both requirements were met.

Disclosure – two-step process – whether the evidence submitted by the applicant proves an event of disclosure – whether the design holder was able to demonstrate that the event of disclosure could not reasonably have become known in the normal course of business to the relevant circles.

Regulation 12(1)(c) of the Designs Act – Form D3 must include a declaration by the applicant that it is the proprietor of the design; alternatively, a power of attorney is required where an agent is appointed.

“Prescribed manner” – section 15 – the registrar was required to consider the application “in the prescribed manner” – in accordance with the Act and its Regulations.

ORDER

It is ordered that:-

1. The registration of the following designs are revoked in accordance with section 31(1)(a), (c) and (e) of the Designs Act 195 of 1993 and the registrar of Designs is ordered to remove the following designs from the Design Register:
 - a. A2016/01137;
 - b. F2016/01138;
 - c. A2016/01139;
 - d. F2016/01140;
 - e. A2016/01141;
 - f. F2016/01142;
 - g. A2016/01143;
 - h. F2016/01144;

- i. A2016/01145;
- j. F2016/01146;
- k. A2016/01147;
- l. F2016/01148;
- m. A2016/01149;
- n. F2016/01150;
- o. A2016/01151 and
- p. F2016/1152.

- 2. The first respondent is ordered to pay the costs of this application on scale C.
- 3. The counter-application is dismissed with costs on scale C.

JUDGMENT

KOOVERJIE

[1] The applicant, Zentia Trading (Pty) Ltd ("Zentia"), instituted this application in terms of section 31 of the Designs Act 195 of 1993 as amended ("the Act"). It seeks revocation of the registered designs of the first respondent. The first respondent is Eva-Last Distributors (Pty) Ltd ("Eva-Last"), who is the proprietor of 16 registered designs pertaining to arched deck boards ("the boards").

[2] Eva-Last has opposed this application and further instituted a counter-application. In opposition, it raised the defence of *res judicata* and, alternatively, abuse of process. In its counter-application, Eva-Last seeks to prevent Zentia from importing, selling, and distributing products which are similar to Eva-Last's registered designs. In order to bolster its counter-application, Eva-Last filed an additional affidavit. Zentia has opposed the filing of such an affidavit.

- [3] Zentia's revocation application is premised on two main grounds, namely that:
- 3.1 The design registrations are invalid as the designs lack novelty. The designs that formed part of the state of the art prior to the date of the application for registration, or *alternatively*, the release date of the registered designs, are rendered ineligible for registration.
 - 3.2 Eva-Last had deliberately made misrepresentations in completing the D3 form submitted to the registrar of designs during the application process for the designs. This constitutes a ground for the revocation of the designs.

The main issues for determination

- [4] The main issues for determination are the following:
- 4.1 Whether Eva-Last's defence of *res judicata*, alternatively, abuse of process has merit.
 - 4.2 Whether the registration of the designs should be revoked on the grounds that:
 - (a) the designs lack novelty and form part of the state of art prior to the registration; and
 - (b) the registrations were procured through misrepresentations by Eva-Last during the registration process.
 - 4.3 Whether there is merit in the counter-application filed by Eva-Last.
 - 4.4 Whether the additional affidavit filed by Eva-Last should be condoned.

Background

- [5] Eva-Last is an importer and distributor of wood plastic composite (WPC) and bamboo polyethylene composite (BPC) products. As part of its business, it

manufactures, imports, and distributes products which include decking, cladding, railings, pergolas, decorative beams and indoor flooring. It does not install its products but sells it to contractors, who in turn sell and install the boards.

[6] Zentia trades as “Best Deck” and sells arched deck boards of different arch depths. Both Zentia and Eva-Last are competitors in this market.

[7] The defining characteristic shared by all 16 registered trade designs is the arch feature on the underside of the boards, which is referred to as “arched deck boards”. The designs reflect a distinctive arch profile on the underside of the WPC or BPC decking boards. These designs were published in the Patent Journal on 31 August 2016. They were registered as both aesthetic and functional designs (Part A and Part F of the register, respectively). Although the notices of registration were issued between 23 March 2018 to August 2018, and the registration certificates signed later, designs are deemed to be registered from the date of application (11 August 2016) or the release date (27 April 2016).

Points in limine

[8] The *res judicata* point was raised on the basis that the revocation issue has already been dealt with by the Western Cape High Court, under case number 1729/2022. In the said matter, Eva-Last applied to amend its design registration certificates to include the release date to be 27 April 2016. Zentia belatedly participated in these proceedings, joined issue with the respondent (Timmdek), and filed similar papers as Timmdek (Pty) Ltd (Timmdek) in respect of both the infringement and the revocation application. Initially, the *lis* was between Eva-Last and Timmdek.

[9] In the said application, Eva-Last sought to interdict and restrain Timmdek from its continued design infringement. In addition, it filed its application for amendment of the registered design. Timmdek, in turn, instituted revocation proceedings against Eva-Last but did so before this court. Subsequently, the revocation proceeding was transferred to the Western Cape High Court for the simultaneous adjudication of all the

issues between the parties. At some stage, Timmdek withdrew from the proceedings. This left Zentia as the only opposing respondent. Zentia took issue not only with the amendment sought by Eva-Last but argued on the revocation aspect as well. The court, after hearing the parties, granted the amendment application confirming the release date to be 27 April 2016 (Wille J's judgment).

[10] In the application for leave to appeal judgment, Wille J confirmed that he confined himself only to the application for the amendment and that another court would consider the revocation application. The relevant portions of his judgment reflect this. He expressed:

- “(11) ZT has launched a discrete revocation application that seeks, among other things, to entirely revoke all EL’s designs due to lack of novelty. In due course, this latter court will no doubt consider the designs that were registered, including the amendment of the release dates.
- (12) I say this because, upon the court’s order, the release dates were amended, and the insertion of the release dates was attended to evidently without any great effort. Self-evidently, including these release dates through the amendment process (because of the order I granted) does not prejudice or divest ZT of the right to raise issues surrounding the ‘prior art’ at the hearing of the pending revocation application.
- (13) Further in deciding whether an order is appealable, the form of the order and its effect must be considered. Also if I grant leave to appeal, resolving the fundamental issues between ZT and EL will take longer. Thus, the amendment decision appealed against would not dispose of all the problems in the case and the outcome of the revocation application will hopefully finally resolve the real issues between the parties.
- (17) The court dealing with the revocation application will be best placed to assess whether the proposed amendments I granted amounted to amendments to the actual designs themselves. In addition, the court dealing with the revocation

application would be in the best possible position to determine whether ZT could have legally relied on the grounds of continued invalidity when it opposed the amendments.”¹

[11] During argument, counsel for Eva-Last no longer persisted to advance argument on this point. On my reading of the judgment, Wille J clearly expressed that the issue of revocation would be determined by another court. Even though the court remarked on the novelty of the designs, it did not express any conclusive findings. Consequently, the *res judicata* defence, alternatively the abuse of process, have no merit.

Legal framework

[12] It is appreciated that the design registration system encourages good designs, which would ultimately be to the benefit of the public. The designer who initiated the design should therefore be rewarded for such design and protected against those who seek to “steal” the designs. This protection is offered to the proprietor for several years. It is only after the expiration of the design registration that the design becomes available for general utilisation.

[13] This revocation application is instituted in terms of section 31(1)(a);(c) and (e) of the Act which stipulates:

“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;....
- (c) that the design in question is not registrable under section 14;
- (e) that the application for the registration of the design should have been refused in terms of section 16.”

¹ Emphasis added and footnotes omitted.

[14] Section 16 states:

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

[15] Section 14(1) of the Act makes provision for a proprietor of a design to apply for the registration of such designs, provided that the requirement of novelty as set out in section 14(2) is met. Section 14(2) stipulates:

“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 the 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 work within two years; or
- (b) in the case of any other design within six months, of such release date.”²

[16] Generally, a design registration will be valid upon presentation of a certificate of registration. This constitutes *prima facie* proof of the registration of the design and the ancillary aspects stipulated in the certificate.

[17] In this case, the designs were both functional and aesthetic and could only be registered if they were “new”. As alluded to above, in terms of section 14(2) of the Act, a design shall be deemed to be new if it is different from or it does not form part of the state of the art immediately before the date of the application for registration thereof or the release date thereof, whichever is the earlier.

[18] The “release date” is the date on which the design is first released to the public with the consent of the proprietor. If the release date occurs before the application for registration is filed, it may constitute a novelty destroying occurrence. In this case, the

² Emphasis added.

“registration date” was 11 August 2016, and the “release date”, as confirmed by Wille J, was 27 April 2016.

The test in assessing disclosure to the public

[19] I find guidance from the matter of *Seventh Generation Ventures Inc v Formaster SA*,³ where the court outlined a two-step process in assessing if disclosure had been made and held that an overall assessment must be made taking into account all factors. It expressed:

“The assessment of disclosure therefore requires a two-step-analysis, namely the assessment of whether the evidence submitted by the invalidity applicant proves an event of disclosure prior to the filing date of the contested RCD followed by the assessment of whether the design holder was able to demonstrate that this event of disclosure could not reasonably have become known in the normal course of business to the relevant circles” (*Crocs Inc* EU: T:2018:137 [48]).

In order to establish the disclosure of a prior design, an overall assessment must be made taking into account all the relevant circumstances of the particular case. The disclosure cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence. Such evidence must be considered in its entirety. While some elements of the evidence considered on their own may be insufficient to demonstrate the disclosure of a prior design, the fact remains that, when combined or in conjunction with other documents or information they can contribute to the proof of disclosures. In order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information which that document contains taking into account, inter alia the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears to be sound and reliable (*Basil v EUIPO - Artex (Paniers spéciaux pour cycles)* (T-760/16) EU:T:2018:277, [42]; *Gramberg v EUIPO - Mahdavi Sabet (Étui pour telephone portable)* (T-166/15) EU:T:2018:100, [23]–[25]; *Coverpla* EU:T:2012:117, [24]–[26]).”⁴

³ [2019] ECDR 20 at paras 24-25.

⁴ Emphasis added.

The disclosure of the price list

[20] It is Zentia's case that the designs are no longer new due to the various disclosures made. It was argued that Eva-Last availed the designs to the public during December 2015 and 27 January 2016 and that these disclosures constituted novelty destroying occurrences. The novelty of the designs had been destroyed on two occasions, namely:

20.1 when Eva-Last distributed its price list in January 2016, and;

20.2 when the boards were installed at the Century City Stay Easy Hotel (Hotel) in December 2015.

[21] In opposition, Eva-Last defends the novelty of the designs on the grounds that: first, it was afforded a 6 months' grace period (a protection afforded by the Act) which allowed it to market and test the commercial viability of the boards. Second, the price lists were intended only for its contractor clients and did so on a confidential basis. Third (and in the alternative), in the event that the court finds that disclosure was made to the public, it invokes section 17 of the Act on the basis that it did not give consent for the designs to be shared with the public.

[22] Section 17 reads:

"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."⁵

The distribution of the price list

⁵ Emphasis added.

[23] Section 14(2)(b) of the Act requires that the application for the registration of the design be made within six months of the release date (grace period). A design product can be released prior to registration, and in this period (6 months), the proprietor will not lose its entitlement to register. This grace period allows proprietors to test the products for commercial viability prior to the design registration. Zentia alleged that in this case, the designs lost their novelty when Eva-Last made the disclosures prior to the release date (that is, before 27 April 2016).

[24] It is not in dispute that Eva-Last availed the price lists on 27 January 2016, wherein the design profiles were included. The boards were referred to as the “arched decking” profile and marketed as “infinity arched “boards. It utilised the services of an independent party (Low Fat) to transmit the price list. Eva-Last maintained that the price list was only circulated to its contractor clients and was never intended for the public. It was established that Low Fat, an independent entity who assisted clients in marketing their products, had assisted Eva-Last in a similar way.

[25] To demonstrate that the price list was only circulated to its contractor clients, Eva-Last contended that the product was sent to one of its clients, Euro Decking, who installed the product at the hotel. It also relied on the affidavits of two of its contractor clients, Mr. Davis and Mr. Potgieter, who confirmed that the price list was intended to be confidential.

[26] At this juncture, it is convenient to have regard to the affidavits, namely that of Mr. Schumann and Mr. Schultz, who presented their version supporting Zentia’s version, and Mr. Davis and Mr. Potgieter, who supported Eva-Last’s version. Having considered same, I am inclined to treat them with caution as the probability exists that their affidavits may have been crafted to support the parties’ versions.⁶

⁶ In *Kavanagh Balloons Pty Ltd v Cameron Balloons* [2014] RPC 87 (*Kavanagh Balloons*) at para 56 the court expressed:

“Witnesses whose memories prodded by the eagerness of interest of interested parties to elicit testimony favourable to themselves are not usually to be depended upon for accessible information.”

[27] It was brought to my attention that Mr. Schumann had previous business dealings with Eva-Last that soured. In these papers, both Mr. Schumann and Mr. Schultz are identified as contractor clients of Eva-Last. According to Eva-Last's version, their business relationship with Eva-Last deteriorated. They particularly alleged, in their respective affidavits, that they received the price lists, but were not informed that it should be treated as confidential. Mr. Schumann also alleged that between December 2015 to February 2021, he installed boards for customers on their premises without being advised that the installations were not to be accessed by the public. He exercised no confidentiality restrictions when liaising with his customers. This version is corroborated by Mr. Stumges, whose evidence is dealt with below.

[28] Eva-Last relied on the versions of Mr. Davis and Mr. Potgieter. The wording in Mr. Davis's and Mr. Potgieter's affidavits is identical. They are, however, of little assistance to the court as they do not address the pressing issue, that is, whether they were informed by Eva-Last to keep the price list confidential. They merely allege that it was considered to be industry practice to treat the price lists in a confidential manner. They expressed:

“.. the price list is not for the public disclosure as it lists the recommended retail prices or base retail prices for calculation of final retail prices, and to which an installing contractor would purchase the decking boards and related products for Eva-Last.”

[29] I have also noted that they do not explain how they marketed Eva-Last's products to their respective customers. In my view, it was inevitable that the design profiles had to be made available to their customers even if the prices were not shared. Customers would only purchase products if they had sight of what they were purchasing.

[30] Mr. Chapman belatedly filed an additional affidavit where he set out the relationship between Eva-Last and Mr. Reardon of Low Fat. It was alleged that Mr. Reardon distributed the emails from his business platform to the recipients on behalf of Eva-Last. Having noted Eva-Last's contentions, I am inclined to allow the affidavit

as it is in the interest of justice to consider it. Moreover, Zentia is not prejudiced as it had responded thereto, and which version I duly considered.

[31] However, I find that the additional submissions do not assist Eva-Last. In particular:

31.1 Mr. Rabie (the attorney for Zentia) who deposed to the answering affidavit in opposition to the additional affidavit filed by Eva-Last, alleged that he directly contacted Mr. Reardon, who informed him that he was unable to remember to whom he sent the emails, as they were sent a long time ago.

31.2 Mr. Reardon also advised Mr. Rabie that the mailing list was stored on his personal laptop, but after the closure of his business, such data was not backed up. He also indicated that the hard drive on the laptop had been damaged and thus cannot be accessed. Simply put, he was unable to provide the list of recipients to whom he had sent the emails. However, in a later version, it was, however, alleged that the mailing list was treated confidentially, that the list was deleted, and the mailing list reflected only the details of the contractor clients of Eva-Last. These allegations are once again not substantiated.

31.3 It is further necessary to highlight the manner in which Mr. Reardon became involved in the matter. Mr. Reardon was initially contacted by the legal representative of Zentia. This caused Mr. Reardon to then contact Eva-Last. It was arranged that his affidavit would be filed supporting Eva Last's version.

[32] What is meant by the expression "made available to the public" was decided in *McCauley Corporation v Brickor Precast (Pty) Ltd*,⁷ where the court with reference to

⁷ *McCauley Corporation v Brickor Precast (Pty) Ltd* 1989 BP 314 (CP) at 333–334. The court expressed at 333: "In short, in deciding whether an invention is new, a Court has first to ascertain what formed part of the state of the art at the priority date. The state of the art comprises all matter made available to the public

the handbook prepared by the Chartered Institute of Patent Agents on the British Patent Act of 1997, expressed that:

".... the state of the art includes anything which is in possession of any member of the public which he may disclose to others without any inhibiting fetter of confidence whether express or implied ... there must be a non-confidential disclosure to another: mere disclosure (as in *Catnic v Evans* [1983] FSR 410) would not appear to surface."

[33] I further refer to the matter of *Humpherson v Syer*,⁸ where the court distilled the test to be applied when determining the concept of "public availability". The said court, in essence, held that if information is communicated to a person, and that person is free both in law and equity to do what they like with the information, then it entails that the information was given to a member of the public. The court expressed:

"I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, had this information been communicated to any member of the public who was free in law and equity to use it as he pleased. Was Widmer a person to whom this communication had been made in a manner which left him free both in law and equity to do what he liked with the information, if so, the information, of course, had been given to a member of the public, and there was nothing further to serve as consideration for any patent."⁹

[34] In summary, having considered the evidence holistically, in my view, Eva-Last has failed to prove that the price list was not shared with the public for the following reasons:

34.1 No correspondence in the form of a note on the price list to the contractor clients or in an email correspondence with Low Fat, setting out that the price list was to be treated confidentially, has surfaced. Put

without any geographical limitation. It can be made available by written or oral description, by use or in any other way. The essential question is whether the material was available to the public. As to what is meant by this expression will depend on the facts of each particular case. If the invention deals with a highly involved technical subject the word "public" must mean something more than the ordinary man in the street and I think it means those persons to whom the specification is addressed. Similarly the question whether the material is "available to the public" would appear to cover the concept that it is available to the public anywhere in the world." (Emphasis added.)

⁸ [1887] 4 RPC 407 (CA) at 413. See also *Monsanto Company (Brignac's) Application* [1971] RPC 153 at 159 and *Kavanagh Balloons* above n 6 at paras 45 and 46.

⁹ Emphasis added.

differently, Low Fat was not informed that the price list should only be distributed to the contractor clients and was not intended for the public.

- 34.2 The confidentiality argument is unassailable. Even if Eva-Last intended the price list to be circulated only to its clients, it had no control over how the recipients would deal with the price list. Such recipients were at liberty to distribute the price list to whom they pleased.
- 34.3 There can be no doubt that the contractor clients, in their own marketing, would at least share the designs with their customers. Customers would only show interest if they understood the products, particularly the specifications and quality of the boards.
- 34.4 Neither Eva-Last nor Low Fat could provide a list of the contractor clients to whom the price list was sent to. In fact, Eva-Last alleged that the list of its clients cannot be disclosed to its competitor, Zentia.¹⁰
- 34.5 Moreover, the disclosures were not made during the 6-month trial period, that is, between the release date and the registration date. It is common cause that the disclosures were made in December 2015 and January 2016.

Installation of the products prior to the release date

[35] It is common cause that in December 2015, the products were installed at the hotel. Zentia argued that due to this occurrence, the novelty of the designs was destroyed. Eva-Last contended that the installation was part of a market research phase and it was entitled to a grace period to conduct its product research and the installation was conducted at a controlled site and product development was necessary before it could introduce the new product into the market. The purpose of these

¹⁰ Eva-Last however had the option to disclose the list to the court in confidence.

processes was to ensure that the new product was market-ready. Hence, at the end of 2015, Eva-Last undertook product trials to validate the new arch deck board designs. It was under these circumstances that Eva-Last provided the arch deck boards to Euro-decking to install at control sites for testing.

[36] In my view, Eva-Last's explanation does not assist it. Section 14(2)(b) of the Act makes provision for testing products over a six-month period, that is, between the release date and the date of registration. A proprietor thus has a maximum of six months for product testing. The Act specifically does not provide for a grace period trial beyond the six-month grace period. In this matter, the installation occurred in December 2015 outside of the six-month grace period.

[37] Furthermore, Mr. Stumges, the hotel manager at the time, as well as Mr. Schumann of Euro-Decking, responsible for installing the boards at the hotel, confirmed that the boards were installed in the ordinary course of trade with no obligation on them to maintain confidentiality or restrict access to the boards. I have further noted that the boards were also installed by Euro-Decking, at another of its client's site "Welgelegen", during the period January to March 2016.

[38] To counter this evidence, particularly Mr. Stumges' version, and persist with its view that the disclosure was not made to the public, Eva-Last was required to furnish credible evidence in the form of *inter alia* non-disclosure clauses or correspondence to Low Fat and its contractor clients informing that the design profiles were not to be made available to the public.

[39] Zentia also pointed out that Eva-Last was actively marketing and selling its product. It referred to two specific tax invoices issued in April 2016 and May 2016 which reflected that the products had in fact been sold. This again demonstrates that this period was not merely a product testing phase.

[40] Further, in applying the “Humpherson principle”, Eva-Last had no control over the disclosure of the price lists. In this instance, nothing prevented the contractor clients from disclosing the price lists and/or the design profiles to the public.

[41] The section 17 defence also does not assist Eva-Last as it was unable to prove that such knowledge was acquired or such disclosure or use was made, without its knowledge or consent.

[42] It was pointed out that section 17 of the Act could have assisted Eva-Last if it had applied for the earlier registration of its designs when it made the premature disclosures.

[43] In applying the test set out in the *Seventh Generation Ventures* matter, and having considered all the evidence holistically, in my view, Eva-Last has been unable to demonstrate that the disclosures were not made public.

Has the novelty been destroyed

[44] To assess the novelty of the design, two distinct enquiries are necessary, first, whether the prior art was publicly available before the registration date or release date and whether it met the legal criteria for anticipation. In this instance, the probabilities exist that disclosure of the designs was made to the public.

[45] The second enquiry, then, is to determine if the alleged anticipation is deemed effective. In other words, was it sufficient to destroy the novelty of the alleged design as claimed in the definitive statement?¹¹

[46] By virtue of section 14(3)(b) of the Act, the following disclosures and factors qualify as effective anticipation if occurring immediately before the date of application

¹¹ This second stage of the test, namely whether the alleged anticipation which have been found to qualify as an effective anticipation is a quantitative comparative test. Burrell *Burrell's South African Patent and Designs Law* 4th ed (LexisNexis, Durban, 2016) at 500 (para 9.72.8).

for registration of the design or the release date (whichever is the earlier), namely, all matters contained in an application:

- (i) for design registration in the Republic or
- (ii) in a convention country for a design which has subsequently been registered in the Republic 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.¹²

[47] The test is whether the registered designs are different from, or they do not form part of the state of the art. The determination of novelty turns on whether a particular single prior art article, publication, or illustration includes all the features of the design as registered, save for features that are immaterial or ordinary trade variants.¹³

[48] Simply put, one would ask whether the two appearances, each looked at as a whole, are substantially different. Whether the design registration is new is to be judged solely by "the eye" when comparing the design or prior art.¹⁴ The question is whether the shape of the registered design differs from the article or the design of which is claimed to have anticipated the registered design.

[49] In this instance, the Definitive Statement contained in Form D6 for the registered designs, A2016/01137 and F2016/01138 was worded as follows:

"The features of the design which protection is claimed include the pattern and/or shape configuration of the arch deck board substantially as illustrated in the accompanying

¹² Burrells above n 11 at 499 (para 9.72.6).

¹³ Burrells above n 11 at 500-501 (para 9.72.8) set out the three step enquiry namely:

"[F]irst, the scope of the design registration has to be construed with reference to the definitive statement; secondly, the import of the alleged anticipation has to be ascertained; and, thirdly, the design as registered and properly construed with reference to the definitive statement has to be compared with the alleged anticipation.

The general and the main principle is that if the comparison reveals that alleged anticipation and design as registered are subsequently identical, then there is no novelty in the design as registered, but if there is a difference which is more than practically immaterial, then there is novelty.

Whether a design is novel in comparison with a previous design is a matter of fact to be judged by the eye... It is the general impression gathered by the eye that counts and the question for determination is whether the two appearances, each looked as the whole are subsequently different."

¹⁴ Section 1(1) of the Designs Act 195 of 1993.

representations. The length; width; thickness ratios as shown are not claimed and these ratios can vary as required.”¹⁵

[50] The object of having a definitive statement is to call attention to special features forming the kernel of the author's idea. Where a specific feature in the definitive statement is claimed, anyone copying the special feature would be guilty of infringement. However, in many cases, the novelty of the design in fact resides in the appearance of the design as a whole and not in any isolated aspect of the design. Therefore, the pattern and configuration of the design have to be considered as a whole for the purposes of novelty and infringement.¹⁶

[51] It cannot be refuted that the price list described the boards as “infinity arched”, which is consistent with the description in the definitive statements of the registered designs, where reference is also made to the “arched deck board”. This confirms that the prior art and the registered designs refer to the same product. Eva-Last has not demonstrated any material difference between the prior art and the registered designs. I am of the view that this finding renders the registration invalid under section 14 of the Act. Consequently, the novelty of the designs has been destroyed due to the said disclosures.

Revocation in terms of alleged misrepresentation on registration of the design

[52] The second ground, which Zentia relied upon, was that at the registration stage, when the Forms D3 were completed and submitted to the registrar of Designs, Eva-Last deliberately made misrepresentations to the registrar.

[53] Zentia pointed out that Eva-Last failed to acknowledge that the proprietor of the designs was fatal. This non-acknowledgement constitutes a material irregularity as Eva-Last could only have applied for the registration of the designs if it were the proprietor.

¹⁵ Emphasis added.

¹⁶ Burrells above n 11 at 466 (para 9.40).

[54] On my understanding, it is a fundamental requirement in terms of the regulation 12(1)(c) that Form D3 includes a declaration by an applicant that it is the proprietor of the design and if an agent has been appointed, then a power of attorney must be filed.¹⁷ Only a proprietor of a novel design may apply for its registration. The term “proprietor” is defined as:

- “ (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.”¹⁸

[55] An application for registration is prescriptive. The registrar is required to examine applications for registration in terms of section 15 “in a prescribed manner” and consider if the requirements are met. Section 15 of the Act governs the registration of designs and section 15(1) enjoins the registrar of designs to “examine in a prescribed manner” any applications for registration of a design.

[56] Three requirements must be met in order for the registrar to register the design, namely:

56.1. The registrar is required to examine the application.

56.2. The examination of the application must be “in a prescribed manner”.

¹⁷ Designs Regulations, GN R844 GG 20256, 2 July 1999. Regulation 12(1)(c) reads-

“12(1) An application for registration of a design shall be made on Form D1 and shall be accompanied by the following documents:....

(c) Form D3, which shall include a declaration by the applicant that he is the proprietor of the design, and a power of attorney in the case where an agent is appointed.

¹⁸ Section 1 of the Designs Act 195 of 1993.

56.3 The application must comply with the requirements of the Act, as well as the Regulations thereto.

[57] The phrase “in the prescribed manner” in section 15(1) means in the manner prescribed by the Act and Regulations promulgated under the Act. Clearly, the applicant had not complied with regulation 12(1)(c)¹⁹ where the registrar had to ensure that the Form D3 included a declaration by the applicant that it is the proprietor of the designs.

[58] Section 31(1)(a) of the Act states that the registration of a design may be revoked on the grounds that the application for the registration of the design was not made by a person entitled thereto under section 14. Section 31(1)(e) states that the registration of a design may be revoked if such registration of the design should have been refused in terms of section 16.

[59] Eva-Last however, argued that the deletion was a mere administrative/clerical error. It went on to explain that when the representative of Eva-Last signed the Form D3, he assumed that the form was correctly completed. Furthermore, the legal representative of Eva-Last, as well as the registrar, could have advised him of the irregularity. The mistake in the completion of the Form D3 was only realised when the amendment of the design certificates was pursued in respect of the release date. Eva-Last also contended that it did not pursue to correct the proprietorship issue when it applied to have the release date altered.

[60] Eva-Last also pointed out that the registrar accepted the documents and allowed for the registration of the respective designs. When the issue with the Form D3's was in fact raised with the registrar during the virtual meeting, the registrar failed to draw Eva-Last's attention to the irregularity. Eva-Last submitted that it is, in any

¹⁹ Zondo J (as he then was) outlined the concept “in the prescribed manner” in *MCG Industries Pty Ltd v Chespak Pty Ltd* [2011] ZAGPPHC 222; BIP 284 (GNP) at paragraph 13-16. This case was confirmed on appeal in *Chespak (Pty) Ltd v MCG Industries (Pty) Ltd* [2014] ZAGPPHC 646; 2014 BIP 465 (GP).

event, the proprietor of the respective designs as contemplated in the Act, and this fact has not been challenged by Zentia.

[61] In my view, even if I were to accept Eva-Last's explanation that it was a clerical error, the law is specific, namely, the designs could only be registered by the proprietor. This is what regulation 12(1)(c) prescribes. The fact that it could have been an oversight on the part of the registrar; does not assist Eva-Last. The declaration was material to effect registration. I therefore conclude that the registration of the designs was impermissible. The registrar should have refused the application in terms of section 16.

[62] The effect of the registration of a design is to grant to the registered proprietor the right to exclude others from making, importing, using, or disposing of any article in the class in which the design is registered and embodying the registered design or design not substantially different from the registered design.²⁰ Consequently, the designs are further revoked in terms of section 31(1)(a) and section 31(1)(e) of the Act.

The counter-application

[63] In the counter-application, Eva-Last sought relief in the form of damages based on infringement proceedings. It claimed that Zentia was publicly selling its products (boards), which are copies of its designs. Eva-Last explained that the infringement application was necessary but could not be instituted due to the delay in the pending appeal in respect of Wille J's judgment. In light of my findings, the counter-application cannot be sustained as the novelty of the designs has been destroyed. In the premises, the counter-application is dismissed with costs.

Costs

[64] During argument, both parties accepted that the general principle, namely, that the costs follow the result, should be applied. The applicant sought costs on scale C

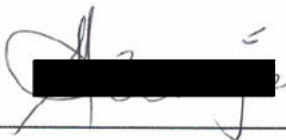
²⁰ Section 20(1) of the Designs Act 195 of 1993, see also *Clipsal Australia Pty Ltd v Trust Electrical Wholesalers and Another* [2007] ZASCA 24; 2009 (3) SA 292 (SCA); [2007] 4 All SA 1082 (SCA) at para 4.

and the respondent on scale B. In exercising my judicial discretion, I find that this matter warrants costs on scale C. The applicant, as the successful party, is entitled to its costs on scale C. With the dismissal of the counter-application, the applicant is further entitled to such costs on scale C as well.

Order

[65] The following order is made:

1. The registration of the following designs is revoked in accordance with section 31(1)(a), (c) and (e) of the Designs Act 195 of 1993 and the Registrar of Designs is ordered to remove the following designs from the Design Register:
 - a. A2016/01137;
 - b. F2016/01138;
 - c. A2016/01139;
 - d. F2016/01140;
 - e. A2016/01141;
 - f. F2016/01142;
 - g. A2016/01143;
 - h. F2016/01144;
 - i. A2016/01145;
 - j. F2016/01146;
 - k. A2016/01147;
 - l. F2016/01148;
 - m. A2016/01149;
 - n. F2016/01150;
 - o. A2016/01151 and
 - p. F2016/1152.
2. The first respondent is ordered to pay the costs of this application on scale C.
3. The counter-application is dismissed with costs on scale C.


H. KOOVERJIE
JUDGE OF THE HIGH COURT
GAUTENG DIVISION, PRETORIA

Appearances:

Counsel for the applicant:

Instructed by:

Adv. R Michau SC

De Chalains Attorneys

Pretoria

Counsel for the first respondent:

Instructed by:

Adv. CL Markram-Jooste

Bredenkamp Attorneys Inc

Pretoria

Date heard:

13 February 2026

Date of Judgment:

16 March 2026