

The perception of registered design protection in the South African Jewellery Industry

Nina NEWMAN

Tshwane University of Technology

Abstract

The aim of this paper is to examine the perception and validity of commercial design protection in the South African Jewellery Industry and to convey the general consensus regarding the registration of commercial designs. This exploratory study employs quantitative research and information was collated through a questionnaire that was distributed by the Jewellery Council of South Africa. The questionnaire gauged, inter alia, whether South African jewellers are aware of the Designs Act, the design registration process and which commercial designs are registered.

Over the years, it has become increasingly important for jewellery companies and individual designers to protect their original commercial jewellery designs from being reproduced. A company can create specific commercial designs to represent the image of their company, such as the case of Browns Jewellers' Protea collection and Shimansky's Millennium ring design. The most common practice to protect mass-produced commercial jewellery designs in South Africa is to register a design at the South African Design office. According to the section 1 (1) of the Designs Act No.195 of 1993 (South Africa), a commercial jewellery design can be registered as an "aesthetic design", which mainly refers to the visual protection of the pattern, shape, configuration or ornamentation of the article.

Some local jewellery companies have registered commercial designs according to the Designs Act (South Africa) and over 140 designs are currently recorded in the jewellery domain. Yet, such designs and other protected jewellery designs are still reproduced in South Africa. Conversely, many designers underestimate design protection and do not realize that designs are important intellectual property that is a valuable asset for any business.

The paper discusses the findings of the questionnaire and based on the results, the perception of commercial jewellery design registration in the Jewellery Industry becomes evident. These perceptions would be used as a guideline in the dissemination of information pertaining to design registration and would aid in a greater understanding and awareness of protected designs and the design registration process.

Keywords: commercial jewellery, design registration

Introduction

On a global scale, the product of design industries, such as in the jewellery sector, could compete both with imported goods, as well as enhance export potential, if the proper incentives regarding design protection are in place (Reichman 1992, p. 284). This is confirmed by Schmidt (2005) who notes that design creates an "added value" to the highly competitive jewellery market and enables companies to create brand recognition through unique jewellery designs. In discussing the impact of the global recession and the high cost of precious metals on commercial jewellery designs, Snyder (2013) notes that consumers are leaning towards more unique designs and that jewellery designs need to conform to these consumer demands. In his study on consumer perceptions in the jewellery field, Jokinen (2011, pp. II, 21-23) reaffirms that the main drive in consumer behaviour is design, price and trust, where design outweighs the purchase decision.

With some local jewellery companies focusing on creating original commercial designs, the protection of designs become an increasingly important factor, as the exploitation of such designs, apart from being ethically unsound, can lead to a direct loss of income. However, the reproduction of original commercial jewellery designs is not only a local phenomenon. Weinmann (2011) notes that jewellers in Australia face the same problem as numerous designs are copied and comments on the naivety of jewellery designers regarding the protection of their designs. As a possible solution, Feder (cited in Weinmann 2011) recommends that the best protection for unique commercial jewellery designs would be the registration thereof.

Although design protection is discussed at length in the seminal works of Reichman (1983, 1992), Brown (1987), Magliocca (2003) and many others, the academic discourse on design protection specifically pertaining to South Africa and even the jewellery industry in general, is wanting. Prominent South African jewellery companies often employ intellectual property legal experts to assist them with design protection, but smaller companies and micro businesses, are possibly uninformed or limited in their knowledge or resources to ensure the protection of their unique commercial designs. Currently, there is no dissemination of this information in the Jewellery Industry and there is no indication whether South African jewellers are aware of design registration or what design registration protection entails.

As a means to assess this situation, questionnaires were distributed to the South African Jewellery Industry for two reasons; first, to gauge the perception of the industry regarding design protection and the design registration process, and second, to create awareness of these matters. The anonymity of the questionnaires encouraged an unbiased view from the industry, and as such, resulted in more credible responses from the participants. The findings of the questionnaires are conferred and possible solutions to assist the Jewellery Industry with design protection and design registration, are proposed.

Conceptual and theoretical perspective of intellectual property protection in South Africa

'Intellectual property', defined by Sherwood (cited in Warwick 1999, p.3) as the product of ideas, inventions and creative expressions, is protected through various legalities and Acts. In South Africa, there are four structures that protect intellectual property, namely patents, copyright, trademarks and design registration. Although this paper will focus specifically on the design registration process, Magliocca (2003, pp. 846,867) notes that commercial art, such as jewellery can be also protected through the other three structures, which is briefly outlined.

Patenting is usually prescribed to protect an invention or very specific ideas that are innovative or have an industrial application (Raj 2012, p. 7). Patents protect conceptual features and are not often used to protect jewellery designs, unless the design includes an improved or newly developed technical component. In fact, Magliocca (2003, p. 851) explicitly notes that patents are "not suited for regulating [aesthetic] designs and present applicants with a high burden of proof".

Brown (1987, p. 1344) states that copyright protection has been developed through cases, regulations and statutes. Although most copyright Acts, including the South African *Copyright Act no. 98 of 1978*, provides protection for original artistic works and technical drawings, it does not protect the idea, or concept of the piece (Raj 2012, p. 6; Magliocca 2003, p. 854). Unlike patents, trademarks and registered designs, copyright is automatic once the article is created. Under section 1 (1) of the South African Copyright Act, jewellery articles are listed under "artistic works" and must be an original work produced by the author's own creativity and labour. Copyright infringements occur when the core identity of the article remains identifiable, even if the piece is aesthetically altered. The main problem with copyright is that it does not offer much protection for designs and that the originality of the design must be proven. Copyright is also not intended to protect mass-produced artistic works, specifically if articles, such as jewellery, are produced through an industrial process such as casting and stamping.

Trademarks protect a specific brand, unique name or symbol associated with a specific company or product. Jewellery designs can be protected through trademark registration, but the design must extend to the company's brand identification. Most fashion houses, such as Gucci, have trademark protection – as their logos are applied as design motifs in their accessories and jewellery collections. A jewellery company is also allowed to trademark a name or slogan related to a jewellery collection. A case in point is the Guardian Angel collection of the local jewellery company, Browns Jewellers. E Clark (2015, pers. Comm., 15 July), from the Legal Department of Browns Jewellers, elucidates that “before a collection [viz. Guardian Angel] can be trademarked a search in the relevant class must be completed to ensure that the name is available for use”. According to the *Trade Marks Act 194 of 1993* (South Africa) jewellery falls into Class 14 which is defined as “precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; including diamonds, horological and chronometric instruments”.

Design registration from a legal context

For commercial protection, i.e. designs that will be mass-produced by an industrial process (usually over 50 copies of a specific design), the most common practice is to register the design. The registration of designs could either protect the aesthetic or functional aspect of an article. Jewellery designs and articles typically fall under ‘aesthetic design’ category, which refers to the shape, form, appearance, pattern, ornamentation and configuration of an article, or the combination thereof (Designs CIPC IP Online n.d.). According to section 14 (1a) of the Designs Act (South Africa), an aesthetic design can be registered provided it is new and not previously disclosed or used in South Africa, or distinctive, where the design is dissimilar to any design previously published, including the Internet.

Design registration only protects the form and visual appearance of the article from being copied. Section 20 of the Designs Act (South Africa) states that the registration of the design further protects the design from being manufactured or imported into South Africa for the purpose to be sold. A person is also not allowed to sell, hire or otherwise dispose of such an article; use or keep the design or article for the purpose of trade and authorize another person to sell, hire and otherwise dispose of such an article. According to section 22 (1) of the South African Designs Act, the protection of a registered aesthetic design is only fifteen years. Magliocca (2003, p. 847) notes that, compared to other forms of protection, design registration is limited because of this short protection period. However, because South Africa is a member of the Paris Convention, the protection of locally registered designs also extends to the countries which are co-signatories.

In addition, registered designs are grouped into 32 different classes, restricting the registration of the design to the other articles falling in the same class (Designs Act). Alternatively, according to section 15 (4) of the Designs Act (South Africa), a design can be registered in more than one class. Consequently, a registered design is protected in a much narrower and more specific scope than with a patent protection.

In order to register a design, photographs or drawings of the final design must be submitted and various views of the design must show the decorative elements of the design. Browns Jewellers only register their most important, signature collections such as the *Protea* and *Queen of My Heart* engagement rings (Clark, E. 2015, pers. Comm., 15 July). However, it is the responsibility of the applicant to ensure that the design is new and does not infringe existing intellectual property rights.

Once the design is registered, it is advertised in the official journal and open to public inspection. All registered designs are listed electronically on the Companies and Intellectual Property Registration Office (CIPRO) website. However, registered jewellery designs are listed under various titles, which makes the search for a specific design problematic. On investigation, one design is listed under “jewels”, 60 under “adornment”, 67 under “jewellery”, 2 under “juwele”, 9 under “bracelets” and 7 under “necklaces (CIPC - Public design and patent search n.d.).

Design infringement is subjective and is decided by the courts, based on statutory provisions and precedent. There is no percentile difference stated between that of a reproduction and the registered design and prosecution can only happen if the copying is substantially identical. In discussing jewellery design infringement, contemporary jewellery designer, Geraldine Fenn (cited in Searle 2010) notes that “another designer can change the colour or material or dimensions without technically infringing the copyright”. This is supported by Magliocca (2003, p. 852) who agrees that design simply involved the rearrangement of elements into a new pattern, making the protection of a design difficult.

Research methodology

In order to gauge the perception of the Jewellery Industry on design registration, the methodology used in this exploratory research was conducted through an online questionnaire. The questionnaire was emailed to the 191 members of the Jewellery Manufacturers Association of South Africa *via* the Jewellery Council of South Africa. The participants remained anonymous and had the opportunity to add additional comments to the questionnaire. The participation was voluntary and they were allowed to withdraw at any stage. Although survey response rates to email questionnaires are of a general concern, the response from the Jewellery Industry participants yielded an acceptable response rate for email surveys (Shih & Fan 2009, pp. 27, 31). This methodology was also applied as email survey was the fastest and most effective method to obtain data from participants all over the country.

The questionnaire was designed in order to establish the participant’s perception of design registration and subsequently structured into four sections. The first section obtained general data from the participants, specifically where their business is situated and how long they have been in the industry. The second section focused on the commercial jewellery design process and approach of the participants and the next section dealt specifically with the participants’ understanding of the design registration process. Proposed recommendations and the awareness of registered designs were gauged in the remainder of the questionnaire.

The data obtained from the questionnaires were translated into percentages, in a graph format, which visually illustrated the results of the various questions. This made the data easier to interpret and aided in the collation of all the information.

Data presentation and analysis

General information

The majority of the participants were based in Gauteng (63%), followed by the Western Cape (21%). The remainder of the participants were from the Limpopo, Mpumalanga, Free State and the North West provinces. This geographical distribution is seen in Figure 1. No questionnaires were received from Kwa-Zulu Natal or from the Eastern Cape and Northern Cape. Although not an ideal participation level, the general distribution of provinces, as well as the high percentage feedback from the Gauteng region, gave a general representation of the South African Jewellery Industry sector on a small scale.

The participants were evenly distributed in terms of their experience in the Jewellery Industry. Although there was no dominant section in this question, the majority of the participants were in the industry for over 20 years (28.2%). This even cross-section of participants’ experience, gave the study a good general consensus regarding the knowledge and perceptions of the industry.

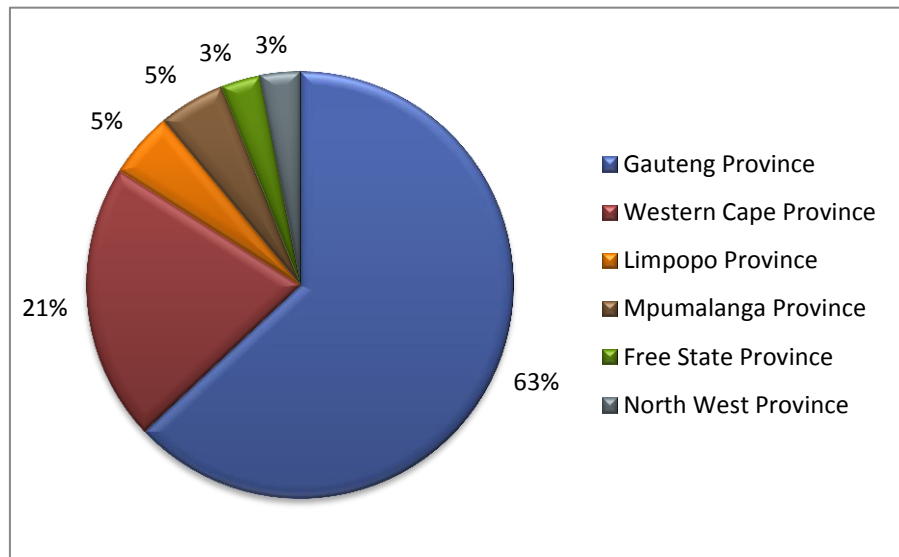


Figure 1: The geographical location of the participants.

Commercial jewellery design process and approach

Before gauging the participants' perception of commercial design registration, it is first necessary to understand the process in which the participants designed for their clients, and how important they viewed unique commercial jewellery designs. Devon and Van de Poel (2004, p. 466) notes that decision-making in design are made by various stakeholders, such as the project leader, the design team, the client, or a combination of people. This was taken into consideration, and, as seen in Figure 2, various approaches to design were asked. Most participants chose more than one method, and one participant noted that the "client brings ideas in pictures, then I design something new based on pictures". This indicates that the client also has an input in the design in some cases.

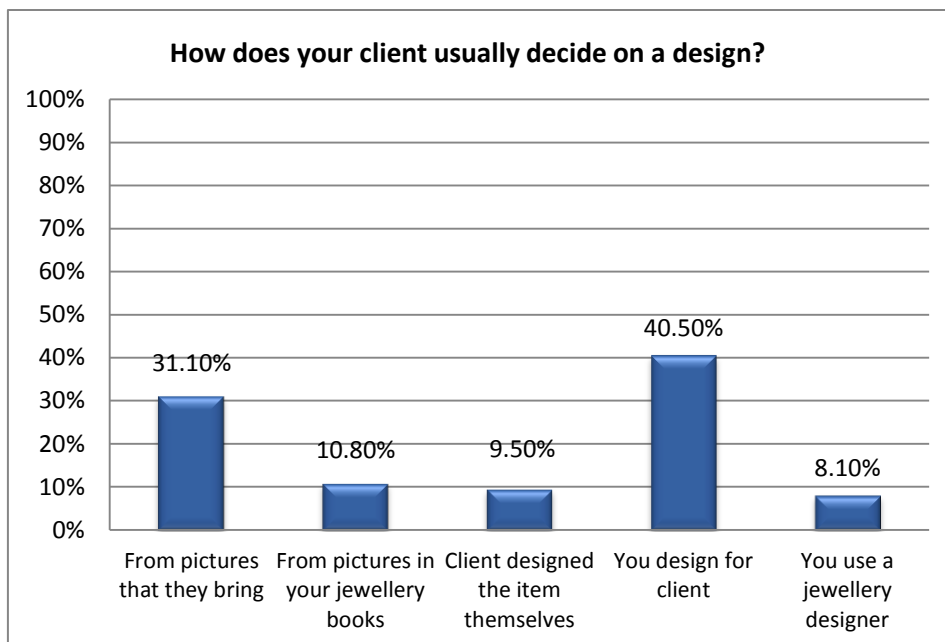


Figure 2: Methods on how clients decide on a jewellery design.

When confronted with an image that a customer presents (31.1% of the time, as seen in Figure 2), nearly half of the clients (47.5%) insist that the image be copied exactly. This is regardless of whether or not the jewellery design is protected through design registration or general copyright law. However, most participants (62.5%) noted that they alter a commercial design when presented with

an image of a jewellery piece, 27.5% indicated that they sometimes do and 10% indicated that they do not alter the design. This demonstrates that the client has some control over the direct copy of the jewellery design, although most industry members try to alter the design.

Figure 2 also indicates that unique jewellery designs are created through the client (9.5%), by the participants themselves (40.5%) and by the employment of a jewellery designer (8.1%). This automatically implies that unique commercial designs are created in nearly 60% of the time. One question asked if clients are interested in unique designs and the results, seen in Figure 3, seem to confirm that most clients do. According to the participants, over half of their clients preferred unique designs and even 12.8% of the participants provided only bespoke designs to their clients.

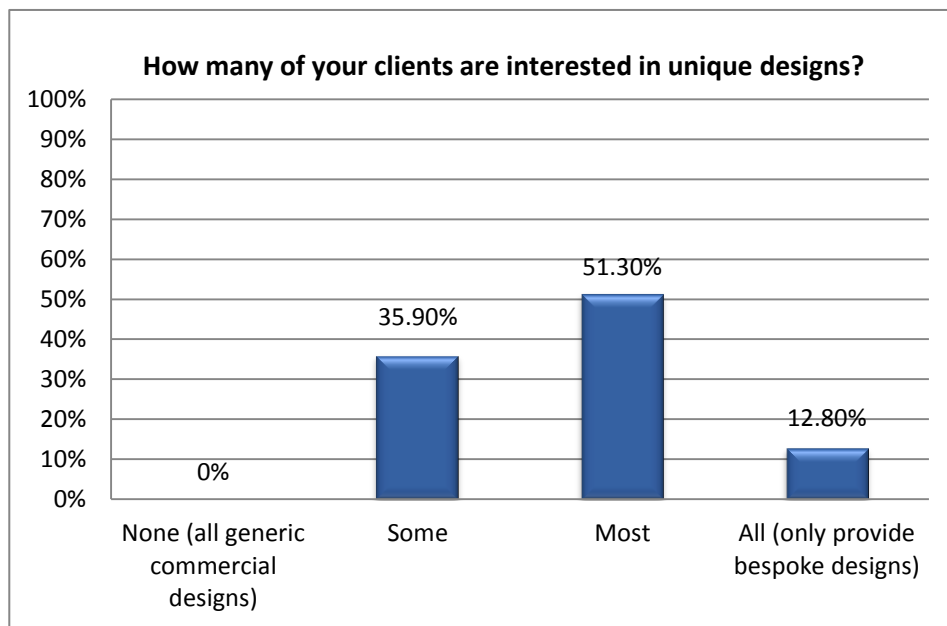


Figure 3: The results from the participants indicating if their clients are interested in unique commercial designs.

In reference to the demand for unique designs from the clients, when asked whether the participants consider unique commercial designs important to the trade, 82.5% agreed that it was important, 7.5% of the participants were not sure and 10% noted that it was not. This high percentile confirms that the demand for unique commercial designs is high, and that the protection of such designs become increasingly important.

Design registration process

This section of the questionnaire investigated whether the participants think that the protection of unique commercial designs are important, what the registration of designs entail and their knowledge of designs registered currently in South Africa. Figure 4 shows the results when the participants were asked if they think that the registration of designs is important to protect unique commercial designs.

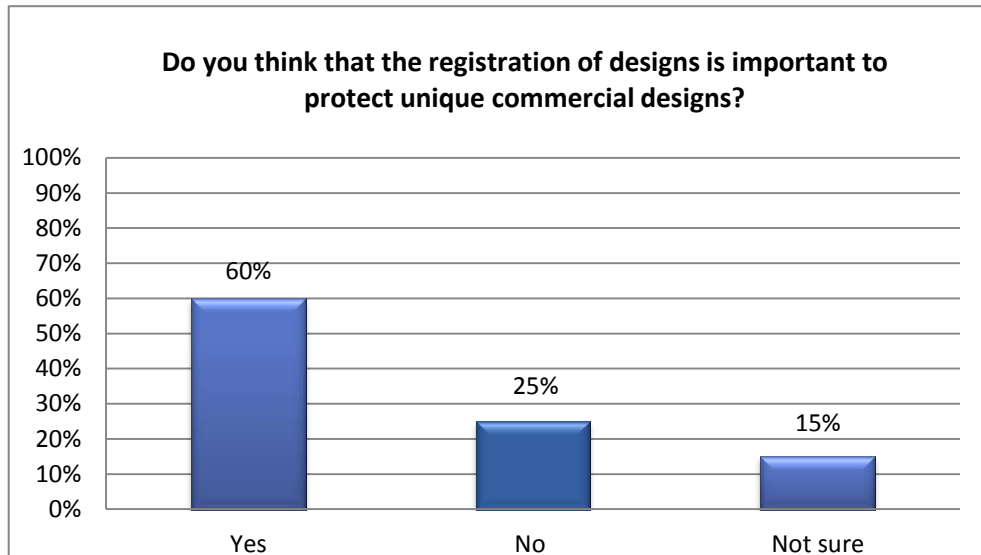


Figure 4: The results showing that most of the participants thought that the registration of designs is important to protect unique commercial designs.

The results show that most of the participants were in agreement that the registration of designs is important, opposed to 25% who did not agree. However, one participant noted that the registration process is “too complex and any part of a design can be changed”. When asked if they knew what the design registration entails, over half of the participants did not know and 20% were not sure (Figure 5). A participant also commented that the registration process is “far too complicated and expensive. We tried to register a design but ended up simply registering its name”. Another participant commented on the uniqueness of current registered designs, noting that “I don’t think it will be fair for a company to patent a classic design, or one that has been in Europe/USA a few years before – just because they are the first to patent it (in SA), doesn’t mean it is their design and therefore they have exclusive rights”. This concern was echoed by another participant, “Another problem is that you will once again have companies registering common designs like tension set rings and three stone rings and then claiming that they came up with the idea, giving it nice names”.

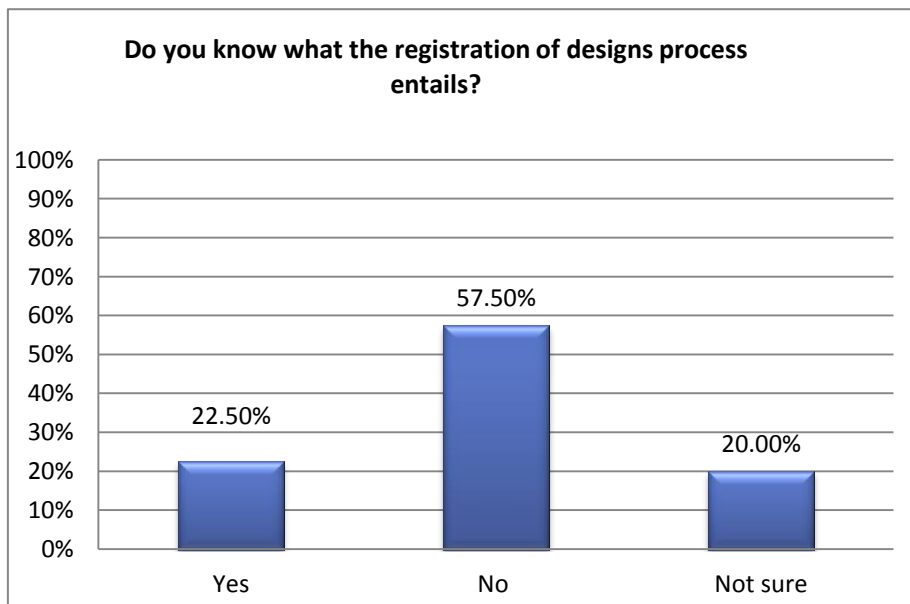


Figure 5: The results of whether the participants are familiar with the design registration process.

Other questions in this section shed light on jewellery designs that are registered and the awareness of the industry regarding these designs. Of the participants, only 5.1% currently have commercial designs registered with the South African Design Office. Fewer than half of the participants were familiar with any registered designs and 12.5% of the participants were not sure. However, when asked if the participant would copy a design if they knew it was registered, 87.5% stated “no” with the other 12.5% noting that they were not sure. No participants answered “yes” to this question. One participant commented that “I may be influenced by them”, indicating a reluctance to reproduce an existing registered design. This, together with the high number of participants that specified that they do not replicate a registered design, indicates a high level of professional ethics from the participants.

Participant proposed recommendations

This section mainly gauged the participants’ perception regarding proposed measures that can be put in place as to make the industry, as well as the public, more aware of registered designs. The first questions dealt with the current knowledge of the design registration process. When asked if they would like to know more about the design registration process and design protection, the majority of the participants agreed and 72.5% of the participants further showed interest in having their unique commercial designs registered.

When referring to Figure 6, it is evident that nearly all of the participants agreed that the Jewellery Industry should be made more aware of registered designs. One participant commented on the importance of this awareness: “They have to be [made aware] otherwise who will know. I have seen numerous ring designs of our protea, all very similar”. Nearly the same response was echoed when the participants were asked whether the Public should also be made more aware of jewellery designs that are protected, although a participant commented that “it is a very complex issue because of marginal differences”. Another participant noted that “We should find a way to educate the public and especially the industry so that they would not want to make someone else’s designs, but rather take pride in doing their own designs”. The high demand could relate to the predicament jewellers face when a client insists on the reproduction of a registered design (in reference to the 47.5% of clients that insist that a design be copied exactly as the original). Fenn (cited in Searle 2010) agrees with this sentiment and states that “I think ultimately the public needs to be educated enough that they can spot a copied piece of design and care enough about originality not to buy it”. Fenn adds that the media should also play a role in educating the public about local original design which should help reduce the need to copy existing designs.

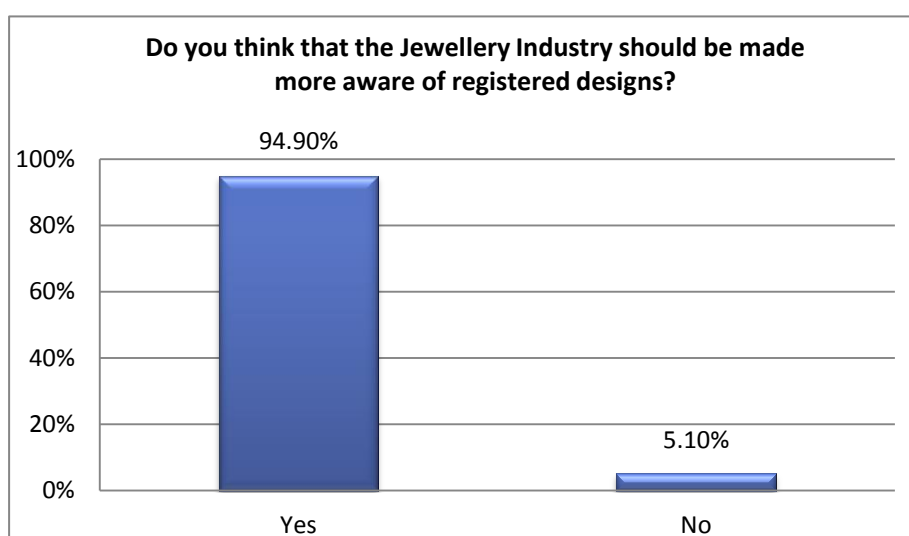


Figure 6: The graph shows that nearly all the participants agree that the Jewellery Industry should be made more aware of registered designs that are protected by the Designs Act.

In conjunction with the aforementioned results, the creation of a registered jewellery design database was proposed. Once again, nearly all of the participants agreed that this database would be beneficial to the Jewellery Industry (Figure 7). A total of 89.7% of the participants also agreed that this proposed database should display images of registered designs. The creation of a database is supported by Magliocca (2003, p. 886) who notes that the benefit of have a dedicated registry of intellectual works is that other peers can note what has been done, and so avoid duplication. However, one participant cautioned that “I think that it should be irrelevant whether or not a design is registered, it is protected by copyright. It becomes a problem, when something is not on the design database, many might think that it is okay to copy the design because it is not registered, forgetting about copyright”.

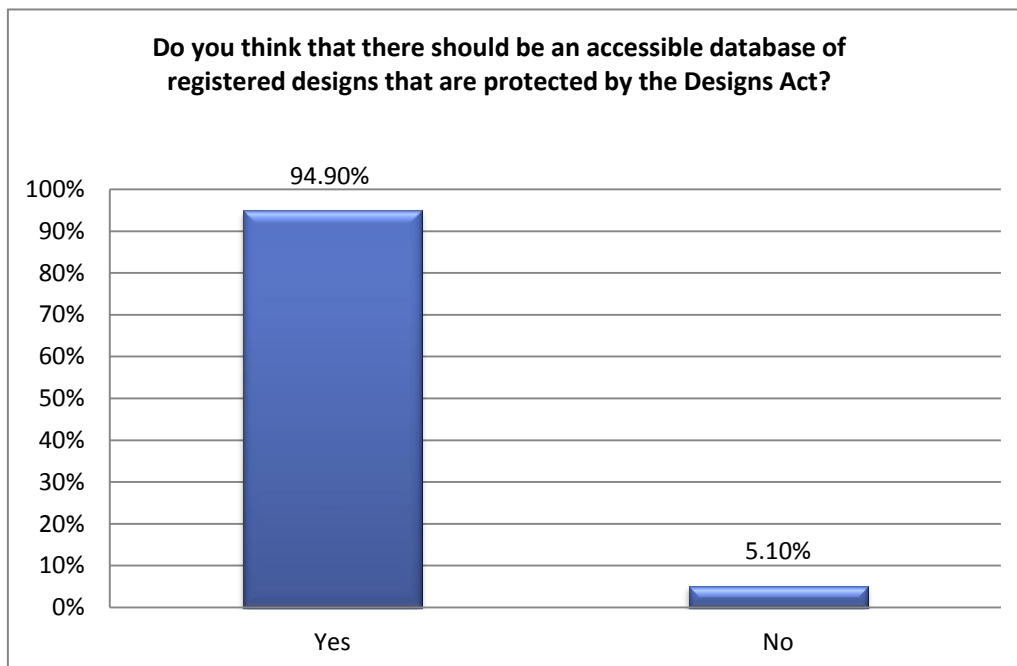


Figure 7: The majority of the participants agree that there should be an accessible database of registered designs that are protected by the Designs Act.

Conclusion

Design registration offers protection to the industry as a whole and should be considered vital in the growth of the industry, as it was developed to support the increase of new products, create competition and to stimulate economic development. Although other forms of intellectual property protection exists, this paper mainly focused on design registration, as it is mainly applied in the protection of mass-produced commercial designs. The main aim of the paper was to gauge the perception of design registration in the Jewellery Industry, as an attempt to raise awareness on the process and on the companies and individuals who have registered designs according to the Designs Act (South Africa).

Although the low response rate can be seen as a limitation of the study, the questionnaires did give a clear indication of the Jewellery Industry's perception regarding design registration. The comments added by some participants also indicated that there was a need for a platform to voice opinions on the matter.

The results of the questionnaire show that various approaches to design are applied in the Jewellery Industry. One of these approaches includes the client presenting an images of a commercial design to an industry member. This creates an ethical dilemma as in some instances, a direct representation is demanded from the client, thus creating potential design infringement by the industry member. Nonetheless, the participants noted that unique designs were regularly created for their clients and

the overall perception showed that unique commercial designs were considered important by the participants, as well as the majority of their clients.

Central themes emerged in the answers of the participants with regard to the protection of unique designs and the design registration process. Although pragmatic considerations must be given before a design can be registered, the responses indicated that most participants agreed that the registration of unique designs were important in the Jewellery Industry. Although concerns were raised regarding the uniqueness of certain registered designs, the overwhelming majority of the participants stated that they would not copy a registered design.

It also became clear that more information regarding design registration was found wanting by the participants. This leads to the suggestion to develop of a database, which could be accessible to members of the Jewellery Industry. Because designs form part of the public domain, the protection thereof is often overlooked. Also, accountability rests on the public, the majority of the participants agreed that the database should also be accessible to the Public.

It is important to ensure that the South African Jewellery Industry is informed on design registration, and this responsibility lies with various role-players within the industry. The perceptions of the Jewellery Industry regarding design registration indicated that the protection of designs is an important ethical obligation and is the responsibility of both the industry, as well as the public to uphold.

References

Brown, RS 1987, 'Design protection: an overview', *Yale Law School*, vol. 34, pp. 1341-1404, viewed 20 March 2015,

<http://digitalcommons.law.yale.edu/cgi/viewcontent.cgi?article=3704&context=fss_papers>.

CIPC –Public Design & Patent Search n.d., Companies and intellectual properties commission, South Africa, viewed 20 March 2015, <<http://patentsearch.cipc.co.za/designs/designresult.aspx>>.

Designs CIPC IP online n.d., Companies and intellectual properties commission, South Africa, viewed 27 March 2015, <<http://patentsearch.cipc.co.za/designs/designresult.aspx>>.

Devon, R & van de Poel, I 2004, 'Design ethics: the social ethics paradigm', *International Journal of Engineering Education*, vol. 20, no. 3, pp. 461-469, viewed 30 March 2015, <<http://www.ijee.ie/articles/Vol20-3/IJEE2514.pdf>>.

Jokinen, H 2011, 'Consumer perceptions and behaviour in respect to ethical, social, and environmental matters in jewellery business', Master's thesis, Aalto University, Finland.

Magliocca, GN 2003, 'Ornamental design and incremental innovation', *Marquette Law Review*, vol. 86, no. 5, pp. 845-894, viewed 20 March 2015,

<<http://scholarship.law.marquette.edu/cgi/viewcontent.cgi?article=1296&context=mul>>.

Raj, P 2012, *Copyright basics*, Social Science Resource Network, viewed 4 March 2015, <http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2020311>.

Reichman, JH 1983, 'Design protection in domestic and foreign copyright law: from the Berne Revision of 1948 to the Copyright Act of 1976', *Duke Law Journal*, vol. 1983, no. 6 (Dec), pp. 1143-1264, viewed 14 March 2015,

<<http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=2862&context=dlj>>.

Reichman, JH 1992, 'Design protection and the legislative agenda', *Duke Law Journal*, vol. 55, no. 2, pp. 281-296, viewed 28 March 2015,

<<http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=4149&context=lcp>>.

Schmidt, B 2005, 'Design briefing- a ticket to successful jewelry collections', *GZ Art and Design*, issue 1, February, viewed 4 March 2015, < <http://www.ganoksin.com/borisat/nenam/design-briefing.htm>>.

Searle, J 2010, *Can designers protect themselves against copying?*, 14 December, iFashion, South Africa, viewed 15 July 2015, <http://www.ifashion.co.za/index.php?option=com_content&view=article&id=3208&catid=78&Itemid=114>.

Shih, T & Fan, X 2009, 'Comparing response rates in e-mail and paper surveys: a meta-analysis', *Educational Research Review*, vol. 4, no. 1, pp. 26-40, viewed 22 June 2015, <<http://www.sciencedirect.com/science/article/pii/S1747938X08000055>>.

Snyder, TW 2013, 'Why the line between fine and fashion jewelry is disappearing', *MJSA Journal*, viewed 4 March 2015, <www.ganoksin.com/borisat/nenam/fine-vs-fashion-jewelry.htm>.

Warwick, S 1999, 'Is copyright ethical? An examination of the theories, laws and practices regarding the private ownership of intellectual work in the United States', June 4 – 5, viewed 20 May 2015, <<http://www.bc.edkkjdkfjdkfj>>.

Weinmann, A 2011, 'Legal fight wake-up call for jewellers', *Jeweller Magazine: Jewellery News and Trends*, November 22, viewed 9 February, <<http://www.jewellermagazine.com/Article.aspx?id=2022>>.

Legislation

Copyright Act No. 98 of 1978 (South Africa).

Designs Act No. 195 of 1993 (South Africa).

Trade Marks Act 194 of 1993 (South Africa).