

Question 1

a) Using a portrait of the Queen and a Union Jack flag is not a grounds for refusal of registration, however using specially protected emblems and symbols is a grounds for invalidity. Therefore, a design registration using images of the Queen and the Union Jack will not be valid, because the Queen and Union Jack fall under the exclusions of Schedule A1 for specially protected emblems and symbols.

b) Copyright subsists in artistic work. Artistic work includes photographs, irrespective of artistic quality. A photograph is a recording of light on a medium, therefore an x-ray image is a photograph, and is protectable by copyright.

c) The following is excluded from unregistered UK design protection: features of an article which depend upon the features of another article, which the article is intended by the designer to form an integral part. This is the 'must match' exclusion. Therefore features of the car door design which depend on the appearance of the car are not protectable, however other features of the car door may be protectable. Additionally, 'must-fit' features are not protectable, i.e. features of the article which are required for the article to be connected to or placed in, around or against another article for either to function. Therefore features for connecting the door to a car will not be protectable. Surface decoration of the car door will not be protectable.

d) A design is excluded from unregistered community design right protection if it is contrary to public policy or accepted principles of morality. Very offensive language is likely to be contrary to accepted principles of morality. Therefore the design will not be protectable.

MARKS AWARDED 6.5/10**Question 2**

a) Priority may be claimed from the date the design is made available to the public at a specially recognised exhibition. This means that other designs made available to the public after the date of exhibition priority, will not be relevant to the novelty or individual character of the design in question.

b) The application for registration of the community design must be filed within 6 months of the date that the design was exhibited at the exhibition. The applicant must claim priority within 1 month of filing the application, providing proof that the design was exhibited at the specially recognised international exhibition.

d) i) The EUIPO will notify the applicant that the design does not meet the requirements, and set a deadline for response. The deadline is 2 months from the date of the notification.

ii) The applicant has one opportunity to submit observations in response. The applicant may amend the application as long as the identity of the design is maintained and the application meets the requirements for registration. The applicant may amend the application by limiting the scope of protection of the design, or disclaiming features that do not form part of the design.

iii) The application will be published and registered, if the applicant's observations or amendments overcome the EUIPO's objections. If the application is not amended, or if the applicant does not submit observations, before the deadline set by the EUIPO, the application will be refused. If the application has not been published it will be deemed never filed. Some fees may be refunded (e.g. publication fee).

MARKS AWARDED 7.5/10

Question 3

a) For a design to meet the qualification requirements, the designer must be a qualifying person. A qualifying person is a person habitually resident in a qualifying country, or a body corporate or other legal personality formed under law of a qualifying country, and having a place of business in a qualifying country where a substantial amount of business is carried on. The US is not a qualifying country, so a person living in the UK is not a qualifying person, and so the design would not meet qualification requirements. However if the design was created jointly and the other designer is a qualifying person, then the design will meet the requirements for qualification. In this case, only the qualifying person will be entitled to rights in the design.

b) Italy is a qualifying country (all EU countries are qualifying, and Italy is in the EU). A design created in the normal course of employment or under instructions from an employer belongs to the employer. A design qualifies if the employer qualifies. The employer company qualifies if it was formed under the law of a qualifying country and has a place of business in a qualifying country where a substantial amount of business is carried on. The company was formed under law of a qualifying country but the design will only qualify if the company also has a place of business in a qualifying country where a substantial amount of business is carried on.

c) Japan is not a qualifying country so the designer is not a qualifying person. However, a design meets the qualification requirements if its first marketing in the UK or EU is by a qualifying person. Its first marketing is in Spain, an EU country, therefore the design meets the qualification requirements if the person carrying out the marketing is a qualifying person. Only that person will be entitled to the rights in the design.

MARKS AWARDED 7/10

Question 4

- a) The design is not a design under the definition of a design (the appearance or whole or part of an article resulting from the features of, in particular lines, shapes, colours, contours, texture or materials of a product or its ornamentation).
- b) The design is not novel or lacks individual character.
- c) The design is excluded – contrary to public policy or morality, dictated solely by technical function, ‘must-fit’.
- d) The design is in conflict with an earlier design (an unpublished application for a registered design).
- e) The design is excluded due to protection of a copyright work.
- f) The design incorporates a specially protected badge, emblem, symbol or escutcheon.
- g) The design incorporates a protected sign.

Any person may bring an action for declaration of invalidity under grounds a), b), or c). Only the owner of the conflicting design may bring an action for ground d). Only the owner may bring an action on grounds e) (the owner of the copyright).

For g), the sign may be a registered trademark, and only the owner of the rights in the sign may bring the invalidity action.

MARKS AWARDED 9/10

Question 5

- a) Fair dealing in a copyright work for private study is an act permitted in relation to copyright, therefore the student photocopying the book will not be an infringement of copyright. However, it is not fair dealing if it results in copies being issued to several people for substantially the same purpose at substantially the same time, of substantially the same thing. Copying and using extracts of work by educational establishments is also a permitted act, so if the book is copied through an educational establishment, it may be permitted.
- b) Communicating a copyright work to the public, or performing, showing or playing the work to the public are restricted acts in relation to copyright. It therefore depends if the social group is private or public. If private, it is not an infringement. If public, it will constitute an infringement.
- c) Issuing copies of work to the public is an act constituting infringement of copyright. However the copies are being re-issued in the EEA when they have already been distributed

in the EEA with the owner's consent, and therefore this is not an infringing act. (UK and France are both in the EEA).

d) Importing an infringing copy into the UK, other than for private or domestic use is an infringing act (secondary infringement), where the person knows, or has reason to believe the copy is an infringing copy. Offering or exposing for sale or hire a work in the course of business which is, and which the person knows or has reason to believe is an infringing copy, is an infringing act, as is possessing an infringing copy in the course of business. If the copies are poor quality, it is likely that the person doing the infringing acts will know, or have reason to believe the copies are infringing act.

e) Making an adaptation of a work is an act restricted by copyright. Converting software from one programming language to another programming language is making an adaptation of software. Therefore this act is an infringing act under primary infringement.

MARKS AWARDED 7/10

Question 6

A community design court is a court of a member state that has been selected for issuing pan-EU judgements in relation to community designs. Each member state must nominate a court of first instance and a court of second instance, as community design courts.

A community design court has exclusive jurisdiction over:

- i) Proceedings for infringement and, if permitted by national law of the member state, threatened infringement.
- ii) Declarations of non-infringement (if permitted by national law of the member state).
- iii) Declarations of invalidity of unregistered community designs.
- iv) Counterclaims for invalidity of registered community designs.

The action would normally be brought in the member state of the seat of the EUIPO, i.e. Spain. However, the action may be brought in the court of a different member state of the EU if both parties agree, or alternatively the EU member state in which the infringement is alleged to take place, unless the defendant has already entered an appearance in a court of an EU member state. This is because neither the defendant nor the claimant are domiciled in a member state of the EU or have an establishment in a member state of the EU.

The 'cascade principle' is that the action takes place in the member state in which the defendant is domiciled, or if he is not domiciled in the member state, then the member state in which he has an establishment. If the defendant is neither domiciled nor has an

establishment in an EU member state then the action takes place in the EU member state in which the claimant is domiciled, or if he is not domiciled in an EU state, the member state in which he has an establishment.

If neither the claimant nor the defendant is domiciled nor has an establishment in an EU member state, then the action is heard in the EU member state in which the EUIPO is seated, which is the situation in this scenario.

MARKS AWARDED 9.5/10

Question 7

S&P

Unregistered UK design rights subsist in the shape or configuration of the whole or part of an article. There may be unregistered design rights in the overall shapes of the salt and pepper shakers. However, there are exclusions from protection: 'must-fit' and 'must-match'. The features of a design which must be reproduced in an exact form for the article incorporating the design to be placed in, around or against or connected to another article for either to function are not protectable. This is the 'must-fit' exclusion. The must-match exclusion excludes features that depend on the appearance of another article, which the article is intended by the designer to form an integral part. The star-shaped base of P and the star-shaped main body of S are not required for either S&P to function individually, but are required for S&P to interfit. It therefore appears that these features will not be protectable. The must-match exclusion also applies, to the general cylindrical shape of S and P.

T

UK unregistered design rights may not subsist in surface decoration. T is surface decoration which does not form part of the shape or configuration of the design, therefore design right protection will not subsist for T.

MARKS AWARDED 6/10

Question 10

a) A design right initially lasts for 5 years from the date of filing of the application. This can be extended by further periods of 5 years, up to 25 years in total. To extend the right, it must be renewed. The renewal date is the expiry date of the registration and the renewal fee should be paid within 6 month period ending on the last day of the month in which the renewal date falls. This would be 31 January 2016, which has passed. There is a 6 month

grace period for paying the renewal fee, which runs from the end of the month in which the renewal date falls. This expired on 31 July 2016. Both the normal period for paying the renewal fee and the 6 month grace period have passed, therefore the registration has lapsed.

b) To get the registration back, you will need to apply for 'Restitutio in Integrum'. The deadline for doing so is 2 months from the removal of the cause of non-compliance with the time limit. The renewal of the cause of non-compliance will be when you looked on the register last week and saw the deadline had been missed. The latest the request can be submitted is 6 months from the end of the grace period (i.e. 1 year from the date by which the renewal fee should have been paid without an additional fee) i.e. 31 January 2017. You must apply in writing, pay the restitution fee and complete the omitted act (i.e. request renewal and pay the renewal fee). You will be required to show that all due care required by the circumstances was taken to comply with the time limit, provide a reasoned statement and evidence in this regard. The fact that your wife had been ill may not be sufficient. Did you not receive a communication from the EUIPO at least 6 months prior to the expiry date informing you that renewal would be required? Did you have an appointed representative? I would request restitutio ASAP because third parties may acquire intervening rights if they use your design in the period between the end of the 6 month grace period and publication of your application for restitutio. Third parties may also oppose your application for restitutio.

MARKS AWARDED 8/10

Question 11

a) In the guidebook, copyright might subsist in the words literary copyright, the photographs artistic copyright, and in the typographical arrangement. Any other graphics may also have artistic copyright. For the CD or MP3, there may be literary copyright in words spoken or sung, and musical copyright in any music. There may also be copyright in the sound recording. For the DVD or MP4, copyright might subsist in the film, and in any sound recording accompanying the film, as well as literary copyright in any words spoken or sung, or any musical copyright in any music.

The first owner of copyright in the literary works of the guidebook, CD or MP3 or DVD or MP4 will be the creator of the work, the author. The first owner of copyright in the artistic works in the guidebook (photographs or graphic images) will be the creator of the work. Similarly, the first owner of musical works in the CD, MP3, DVD or MP4 is the author.

The first owner of the typographical arrangement of the published edition is the publisher.

The first owner of the sound recording in the CD, MP3, DVD or MP4 is the producer.

The first owners of the film in the MP4 or DVD are the producer and director.

Note that photography landmarks may be an infringement if the landmarks are sculptures or buildings in which copyright subsists (unlikely if they are historical).

A work is a work of joint authorship if it is created by two or more people. For example, a film is a work of joint ownership if the producer and the principle director are not the same person.

MARKS AWARDED 5/10

Question 12

a) A design is the appearance of the whole or part of a product, resulting from features, in particular lines, colours, contours, textures, materials of the product itself or its ornamentation. A product is defined as an industrial or handicraft item, including get up, packaging, typographical typefaces, component parts of a complex product, and graphics. A complex product is a product comprising multiple component parts which may be replaced permitting disassembly and re-assembly of the complex product. Your products appear to fall under the definition of a design, because it is possible the shape, texture, colours of the bars define the appearance of the bar. However, it is unlikely that the bars would fall under the definition of a product, because a snack bar is not an industrial or handicraft item.

Furthermore, although your snack bars are formed of multiple component parts, i.e. the hard exterior and soft interior, these parts are not 'replaceable to permit disassembly and re-assembly of a complex product' and therefore do not fall under the definition of a complex product.

For complex products, only features of the product that are visible during normal use are protectable. There is case law related to cookies with soft gooey centres which suggests that the gooey centre is not visible during normal use. Overall, it appears your snack bars do not meet the requirements for registration.

b) There might be literary copyright in your recipe, which may prevent others copying the words of the recipe. However, this will not prevent others from using the recipe to make the bars. I would therefore suggest keeping the secret ingredient as a trade secret.

MARKS AWARDED 5/10