

Question 1

a) A design is the appearance of the whole or part of a product result from: in particular the lines, contours, colours, shapes, textures, materials of the product itself or its ornamentation.

- A design may be found invalid for incorporating protected signs, badges, emblems, and escutcheons. These include those signs listed in Schedule A1 of the Registered Designs Act 1949.
- Portraits of the Queen and national flags of the UK are both not registrable as UK designs.

b) Copyright exists in literary, dramatic, musical or artistic works.

- Artistic works include graphic works, photographs, sculpture and collage irrespective of artistic quality.
- Photograph is recorded of light or other radiation on any medium.
- A x-ray would have copyright as a photograph (or artistic work).

c) Car door must match the overall shape and configuration of the car. Features of the design that are dependent on the appearance of another article, on which the article is intended by the designer to form an integral part are excluded from registration. – Car door falls into this category therefore excluded. UDR registration.

d) Designs that are contrary to public policy or principles of morality in one EU member state to be excluded.

- Does not include distasteful designs
- Only needs to be contrary to public policy or principles of morality on ne member state to be excluded.
 - Likely to be excluded if very offensive.

MARKS AWARDED 4.5/10**Question 3**

a) To qualify as an individual the individual must be habitually resident in a qualifying country.

Qualifying countries include:

- The UK

- Other EU member states
- Reciprocal arrangement countries (e.g. New Zealand)

US is not a qualifying country therefore individual habitually resident in US would not qualify for UK UDR.

b) Subject to agreement to the contrary, the Italian company will own any design created during the course of the designer's employment.

To qualify by reference to employment, the employer must be a qualifying person. For an employer to be qualifying person, they must have been formed in accordance with UK law or have a place of business in the UK where effective business activities take place.

The Italian company may qualify but only if they have conducted significant business activity in the UK.

c) To qualify by first to market, the design does not qualify either by reference to designer or employer. In this case designer is not qualifying person as resident in Japan. The first marketing of the design anywhere in the world must take place in the EEA by a qualifying person.

Spain is in the EEA, but more information is needed concerning the person who put the product on the market to determine if the design qualifies with reference to first to market.

MARKS AWARDED 6.5/10

Question 4

a) The design is not a 'design' as defined by S.1 (RDA).

b)

- The design lacks novelty and/or individual character.
- The design is a component part of a complex product and is not visible during normal use.
- The design is solely dictated by its technical function.
- The design is excluded by 'must fit', (i.e. must be in the necessary exact form and dimensions so as to permit the product to which the design is incorporated or to which it is applied to be mechanically connected to, placed in, around or against another product so either product may perform its function. (With the exception of modular products).
- The design is contrary to public policy or morality.

c) The designer is not entitled to the right in the design.

d) The design is in conflict with an earlier design. The earlier design having been filed for registration before the filing/application date (or priority date if claimed) of the design in question but published afterwards.

e) The design incorporates a distinctive sign, where the rights holder of the distinctive sign may prohibit use in the UK.

f) The design incorporates an unauthorised use of a copyright work. The owner of the copyright work may raise objection.

(g) The design incorporates a protected badge, coat of arms, emblem or flag as set out in Schedule A1 (RDA).

- Only the rightfully entitled rights holder may object on grounds of (c)
- Only the rights holder of the conflicting or earlier rights may object on grounds (d) (e) and (f).
- Only an interested party may object on grounds of (g).

MARKS AWARDED 10/10

Question 6

a) A community design court is a designated court (i.e. designated by each member state of the EU) to have international (i.e. pan-European) jurisdiction in relation to community design cases.

The designated community design court in the UK is the High Court and IPEC.

Community design courts have jurisdiction over:

- Actions for infringement of community designs.
- Actions for invalidity of community designs.
- Declarations of non-infringement.
- Declarations of invalidity.

b) The infringement action would be heard:

- i. In the EU country in which the defendant is domiciled, is established or has a seat.
- ii. If not (i) then in the EU country in which the claimant/plaintiff is domiciled or established business.
- iii. If not (ii) then the seat of the office. That is, Spain – the office of the EUIPO.

- The case may be heard in a different country if both parties agree or if the defendant makes an appearance at a different court.
- For parties solely based in US and Canada respectively, the case will be heard in Spain subject to any other agreement/arrangement.

MARKS AWARDED 5.5/10

Question 7

a) UK unregistered design right (UDR) subsists in an original design. A design is the shape and configuration (whether internal or external) of the whole or part of an article.

UDR does not subsist in:

- i. Methods or principles of construction – i.e. the appearance of features of an article determined by the manner in which it was made (e.g. knitted quilt).
- ii. ‘Must fit’ – the shape and configuration of features of an article embodying the design, which permit the mechanical connection to, placed in, around or against another article so that either article may perform its function.
- iii. ‘Must match’ – The shape and configuration of features of the design that are dependent on the appearance of another article, in which the article is intended by the designer to form an integral part.
- iv. Surface decoration.
 - The overall shape of the ‘stackable condiment set’ may have UDR if the overall shape is original (i.e. not commonplace in the EEA in the design field at the time of manufacture).
 - The star-shaped base in the pepper shaker would fall under ‘must fit’ exclusion – therefore excluded from UDR. The base must be the correct shape to receive the salt shaker.
 - The star-shaped main body of the salt shaker is also excluded under ‘must fit’ for the reasons above.
 - The ‘half-star’ shapes (T) would be excluded under the must match exclusion. Their appearance is dependent on the appearance of the other half of the shaker.

MARKS AWARDED 4.5/10

Question 8

a) Remedies available for a successful infringement action include:

- i. Damages or an account of profits (these are mutually exclusive).
- ii. Grant of an injunction – i.e. a court order that orders a person to do an act or stop doing an act.
- iii. Seizure of goods.
- iv. Delivery up or destruction of infringing goods. – a request for delivery up must be made within 6 years of the decision.
- v. Declaration of validity.
 - If innocent infringement (i.e. the infringer had no knowledge of the infringing activity) – damages will not be an available remedy.

b) A community design gives the rights holder the exclusive right to use a product to which the design is incorporated and to prevent a third party without the proprietor's consent from using such a product.

Use means:

- Making
- Offering
- Putting on the market
- Importing or
- Exporting

a product in which the design is incorporated or stocking any such product for any such use within the community.

MARKS AWARDED 4/10

Question 9

a)

- The client can authorise a large company to use his registered design.
- The rights may be fully assigned to the large company via an assignment – but the client would lose all his rights, which is not in the client's current interests.
- Alternatively can licence this use of the design to the large company. – May be an exclusive or non-exclusive licence.
- Exclusive licence would be a single licence to the company which would prevent any other person (including the proprietor) from using the design.

- Non-exclusive licence could allow further licences to be granted (may not be preferred by large company).
- Client could grant sole-licence meaning large company would be the only licensee but would maintain rights for the proprietor to use.
- Licences are dependent on the terms of the licence.

b)

- The client should prepare a licensing agreement containing details of the proposed licence. (May suggest to consult an IP solicitor to draft the licence agreement).
- Licence should be made in writing and signed by licensor (i.e. client).
- The licence should be registered at UKIPO – must be made in writing and signed by licensor to be entered and registered.

c)

- If an exclusive licence was granted, the proprietor (i.e. the client) would also be prevented from using the design. – This may not be a problem if designer is discontinuing his business but would be a disadvantage if restarting his business and the licence is still in force.
- If an exclusive licence was granted, the licensee would be able to start an infringement action without the consent of the licensor/proprietor. (However the licensor must still be notified and this only applies if the licensor has not commenced his own infringement action). – Proprietor should also be made party to the proceedings (even if only as a nominal defendant). – Proprietor would not be liable for costs if does not actively take part.
- Licensee is entitled to certain damages in the event of an infringement action started by the proprietor if they have suffered a loss during infringement.
- If a non-exclusive licence – licensee must seek permission from proprietor before starting infringement action.
- If licence, the client/proprietor would be entitled to a royalty (amount dependent on terms of licence).
- If assign the rights the proprietor would lose all rights to the design.
- If licenced, (depending on terms of agreement) the licensee may sub-licence the design.

MARKS AWARDED 7.5/10

Question 10

a) The term of a Community Registered Design (CRD) is initially 5 years from the filing date (which is the registration date), but the term can be renewed for further periods of 5 years

up to a maximum of 25 years subject to paying renewal/maintenance fees. The renewal fees are due 5 years from the date of filing and are due on the last day of the month. Bob's application was filed on 07/01/2011. The first renewal was due 31/01/2016. (The renewal could still have been paid in the 6 months immediately following this date (i.e. by 31/01/2016) with payment of a late surcharge/fee).

b) As explained above, it is too late to pay the renewal fee during the 6 month grace period with a surcharge. Bob must therefore file an application for restitutio in Integrum. The application must be filed no later than 2 months after the removal of non-compliance and also no later than within 1 year from the date of the lapse (whichever earlier).

The removal of non-compliance was last week when Bob became aware of the lapsed design – sets the 2 month window. Should therefore be done as soon as possible. Application should be made in writing and must give reasons (and preferably evidence) as to failure to observe the time limit despite all due care having been taken. This is not a guaranteed remedy but is discretionary.

Bob should also be aware that any third party who started using the design in good faith after the date of the end of the grace period may acquire intervening rights in the design. – Those rights would allow them to continue their business activity using the design even after the right has been restored.

MARKS AWARDED 5.5/10

Question 11

a) Copyright subsists in original:

- Literary, dramatic, musical or artistic works;
- Sound recordings, films or broadcasts;
- Typographical typefaces of published editions.

i. **GUIDEBOOK**

- Has literary copyright in the words of the book. The first owner is the author of the book (i.e. the person who wrote the words).
- May also have artistic copyright which would subsist in any drawings or photographs contained in the books. The first owner would be the author/creator of the drawings or photographer of any photographs.
- Will also have copyright in the edition as a whole as a typographical typeface of a published edition. The first owner would be the publisher.

ii. **CD/MP3**

- There will be copyright in the sound recording on the CD/MP3 – First owner is the producer of the sound recording.

- There may be musical copyright in any musical on the CD/MP3 (e.g. background/introductory music). – First owner would be the composer of the music.
- There would be literary copyright in spoken words on the recording. – First owner would be the author of the words.

iii. DVD/MP4

- There may be copyright in the sound recording on the DVD/MP4 – First owner is the producer.
- There will be copyright in the film on the DVD/MP4 – First owner is the producer and director of the film.
- There will be literary copyright in any words spoken on the DVD/MP4 – First author is the author of the words.
- There may be dramatic copyright if the film includes actors , this includes dance or mime. – First owner would be the actors.
- There will be musical copyright in any music on the DVD/MP4 or accompanying the film (e.g. background music). - First owner is the composer of the music.

b) The works created where the specific contribution of each author cannot be distinguished. Works which were created by two or more persons.

MARKS AWARDED 5.5/10

Question 12

a)

DESIGN is defined as the appearance of the whole or part of a product resulting from the features of: lines, contours, colour, shape, texture, materials of the product itself and/or its ornamentation.

PRODUCT is defined as any industrial or handcraft item including:

- Component parts intended to be assembled into a complex product.
- Packaging.
- Get-up.
- Graphic symbols.
- Typographical typefaces.

But specifically NOT computer games.

COMPLEX PRODUCT is a product composed of multiple component parts which can be replaced permitting the disassembly and reassembly of the product.

- The snack bars would fall under the definition of design. We are told they 'a variety of interesting shapes' and is also a product (see below).
- The snack bar is a product since it may be considered a handicraft item (the list of possibilities is not exhaustive and generally covers human created items).
- The snack bar would not be a complex product since it is not composed of parts which can be replaced permitting disassembly and reassembly.
- The overall shape of the snack bar would be registrable.
- For component parts of a complex product – only those features that are visible during normal use are protectable. However, since the snack bar is unlikely to be considered a complex product (as explained above) this exclusion does not apply.
- Other exclusions include 'must fit' and contrary to public policy and principles of accepted morality – but the snack bar does not fall under these provisions.

Overall, the snack bar seems inherently registrable under the requirements set out in Article 4 CDR.

b) Client will have copyright protection as a literary work provided that the recipe has been recorded in writing or otherwise.

Copyright will only subsist from this time.

MARKS AWARDED 5.5/10