

THE JOINT EXAMINATION BOARD

PAPER D & C - 2004 DESIGN AND COPYRIGHT

Examiners' Comments

Q1

In relation to Community Unregistered Design Right:

- a) How does Council Regulation (EC) No. 6/2002 of 12th December 2001 on Community Designs fully define the event which starts the term of protection? (5 marks)
- b) When does this term of protection end? (2 marks)
- c) As at what time is the novelty and individual character of the design to be judged? (1 mark)
- d) On what basis is a judgment on individual character made? (2 marks)

Examiners' comments

Some answers showed confusion between Community and UK unregistered design right.

a. Many candidates said that the term starts when the design "is made available to the public in the EU". This is not strictly correct. The basic test is whether the design has been made available to the public. This is then further defined with reference to the knowledge of interested circles in the EU. The effect is that the actual act of public disclosure may occur anywhere.

b. EU terms do not run to the end of the year.

c. This date is not the date when the design was created; that is (more or less) the UK test. The correct answer is the same as for part a.

Q2

A declaration of invalidity of a UK Registered Design may be applied for on some grounds, such as lack of novelty, by any interested party. Other grounds can only be raised by a party having a particular status. List five other grounds and give the status required in respect of each respectively, in order validly to apply for a declaration of invalidity. (2 marks each)

Examiners' comments

Generally-available grounds are not asked for in the question, and reciting them will waste valuable time without gaining marks. Amongst the specific grounds, answers such as "earlier registered design" also get no marks; on a literal interpretation that includes prior publications. It is necessary to give the full conditions, namely an application for RD of earlier effective date but unpublished at the effective date of the RD in question, to

get marks. There is a bonus for those who point out that CRDs had been added by the RDR 2003.

Q3

Is Registered Design and/or Design Right protection available nationally in the UK for the following, assuming all have novelty and individual character? Give reasons for negative, as well as positive answers. No marks will be awarded for unreasoned answers.

- a) A jigsaw puzzle (in respect of the interlock of the pieces, not the picture represented). (3 marks)
- b) Wallpaper with a multi-coloured repeating decoration. (4 marks)
- c) The 3-D patterns in a hand-knitted sweater. (3 marks)

Examiners' comments

See general comments above. There should be little real difficulty with the facts presented.

- a. Clearly the main issue is "must fit" and equally clearly the modular exception to the exception does not apply. Whatever one may think of the drafting of S1C(3)CDPA, it is precisely not a quality of a jigsaw puzzle that its pieces serve the purpose of "multiple assembly ...of mutually interchangeable products".
- b. It is important to be precise. It is *inter alia* "colours" which may be a registrable feature.
- c. The surface decoration was explicitly 3D and was also a pattern. Though *Mark Wilkinson v Woodcraft* could be mentioned it should have been distinguished. The sweater is a handicraft item and that such things are in the category of "product" for the purposes of the Act should have been pointed out.

Q4

On 14 February 2003 a free-lance designer, a UK national, makes drawings showing a new shape for a product. Confidential arrangements are made for the exploitation of the design, with the result that a publicity campaign starts in the UK on 2 January 2004 with advertisements showing and emphasizing the new shape, and the products are put on sale in numerous shops in the UK on 9 January 2004.

The success is such that on 2 February 2004 a UK Registered Design application is filed relating to the design. The application has been granted. A UK-based manufacturer of the product paid the designer an agreed lump sum to create the design.

- a) On what date do the terms expire of:
 - (i) copyright in the original drawings? (2 marks)
 - (ii) UK unregistered design right? (2 marks)
 - (iii) rights in the UK registered design? (2 marks)

- (iv) the period in which the proprietor may claim priority of the UK application when filing a corresponding application in a Paris Convention country? (2 marks)
- b) Who owns the copyright in the drawings and who owns the rights in the registered design? (2 marks)

Examiners' comments

- a. It is not correct to say that copyright expires in 25 years if there is industrial application. What happens is that certain acts cease to be infringement of copyright, and that is a totally different legal situation. See S52 CDPA.
- b. It is not correct to say that the applicant for registration is the proprietor of the design. This is evidently not so; see Q2 in which it is a correct answer that false proprietorship is a ground of invalidity at the hands of the true proprietor.

Q5

Are the following people infringers in the UK of a UK Registered Design and/or of UK unregistered design right validly subsisting in the designs concerned?

- a) The innocent importer of identical articles from Taiwan. There is no licence for their importation. (2 marks)
- b) A shopkeeper innocently selling identical articles which come from an unauthorized source. (2 marks)
- c) A wholesaler innocently stocking identical articles which come from an unauthorized source. (2 marks)
- d) A manufacturer innocently making articles from drawings which are direct copies of an original design and which come from an unauthorized source. (4 marks)

Examiners' comments

Innocence is not a defence to infringement; positive knowledge of the existence of a registered right is not necessary before there is infringement. Innocence can however relieve the infringer of some possible sanctions. It is only in respect of unregistered rights that there is mention of a royalty basis (S232(2)CDPA) and there is nothing similar in the RDA.

There is no point in voicing doubts as to whether the protagonists were really innocent (see above). The question said they were, so they were.

Q6

Your UK client is owner of validly subsisting copyright in certain drawings and UK unregistered design right in the corresponding design. Articles made by your client in accordance with the drawings and the design were put on sale and very soon copies started to appear in the UK.

Investigation shows that a draftsman unconnected with your client had measured off the articles to produce in the UK manufacturing drawings which he then purported to license to UK manufacturers competing with your client.

Your client wants to sue all of these people under both copyright and UK unregistered design right. Make notes on how you would advise your client as to who he can and cannot sue under these rights, in respect of which activities, giving reasons in each case. (10 marks)

Examiners' comments

It is not correct to say that the draftsman does not infringe copyright because he had copied indirectly. But because there **is** infringement of copyright there is no infringement of Design Right in making a design document for enabling articles to be made (S236 CDPA). However that authorising infringement is itself infringement (S226(3) CDPA). By virtue of S51(1) CDPA the manufacturer is not an infringer of copyright, but of course infringes design right by manufacture and (if with knowledge) by possession for commercial purposes. A lengthy discussion of S.52 CDPA and duration of rights, is clearly not particularly relevant to the question. (“...and very soon copies started to appear...”).

Q7

How does the CDPA 1988 define the following in relation to copyright:?

- a) works of joint authorship (1½ marks)
- b) works of unknown authorship (1½ marks)
- c) derogatory treatment (3 marks)
- d) artistic work. (4 marks)

Examiners' comments

This memory question was well answered by most, the weakest section being part c. The rather peculiar exclusion of translations and transcriptions was quite often missed, and there were too many irrelevant essays on the nature of moral rights, wasting time and getting no marks.

Q8

Provide outline information on the substance of two leading cases; one relating to a United Kingdom Registered Design and the other to a United Kingdom Unregistered Design Right. (5 marks each)

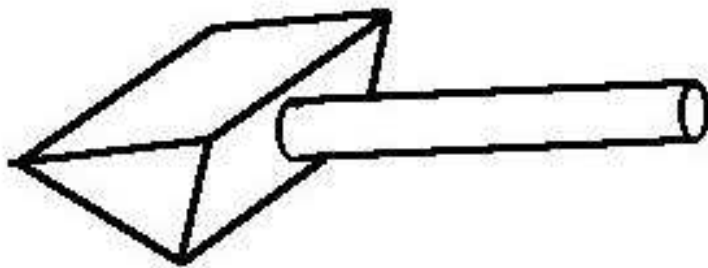
Examiners' comments

Many candidates chose to avoid this question, although there were quotations from case law in support of answers to other questions. The recent *Lambretta v Teddy Smith* case was a popular choice for UK unregistered design right. There appeared to be some

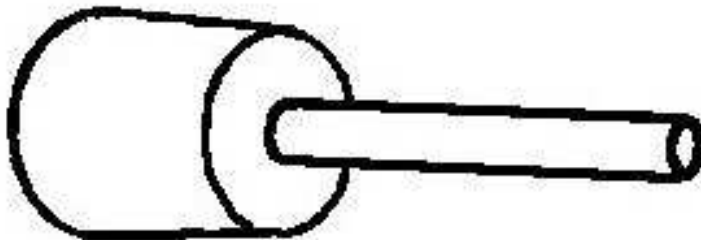
difficulty in referring to registered design cases that are still good law. Marks were nevertheless awarded for correct discussion of registered design cases that have been superseded by the Registered Designs Regulations 2001, provided that it was apparent that the candidate realised this.

Q9

Your UK client owns Community Design Registration No. 000111111-0001, for a sun cream applicator, of which the representation is shown below.



The validity of your client's registration has been challenged on the basis of an earlier published Spanish utility model registration for a skin sterilizing solution applicator, a drawing of which is shown below.



In each case, the applicator consists of a foamed plastics applicator sponge, attached to a plastics handle.

a) OHIM have found your client's design to be valid over the prior art sterilizing solution applicator. Give reasons why this may have been so. (4 marks)

Your client is aware of a Dutch manufacturer who owns Community Design Registration NO. 000222222-0002 for a similar (and potentially infringing) sun cream applicator registered and marketed after the date of registration of your client's design

- b) Give details of four main acts of infringement as defined by the European Designs Directive 98/71/EC. (4 marks)
- c) Where would an infringement action have to be brought against the Dutch manufacturer? (2 marks)

Examiners' comments.

- a. The central point here is the obvious one of different impression; but there is a necessity to determine who the informed user might be, the user of cosmetics or the user of medicaments – or are they the same? The nature of the articles is per se irrelevant. However, it might be that the interested circles are different so that the earlier design is not relevant prior art at all. Design freedom is another issue that needs to be discussed.
- c. The Court has to be a Community Design Court, and then it is the country of domicile of the defendant that is critical, not the site of infringement.

Q10

State, with reasons, whether you consider that the designs of the following products would be registrable under the Registered Designs Act 1949 (as currently amended). Assume in each case that the product is new.

- a) A blue and yellow quartered squash ball.
- b) A tyre tread.
- c) A mobile telephone display logo which only appears when the telephone is switched on.
- d) A building.
- e) An exact scale model of a vintage car.

(2 marks each)

Examiners' comments

Each of the parts of this concerns a different possible cause of non-registrability. Part a – are colours a valid feature (yes); b – functionality/ degree of choice/visibility in use; c – non-permanent features (yes); d – is a building a ‘product’; e – novelty (no). The quality of discussion is more important than the conclusion reached – but it is necessary to reach a conclusion (see above).

Q11

Your client, Abacus Limited (a UK company) is the owner of an original design for a new self-propelled shopping trolley. Relying on the ‘grace period’, the new design was registered in the UK two months ago, ten months after first marketing.

Abacus has now discovered a rival manufacturer, Bonanza Limited, selling an identical shopping trolley. On checking the Patent Office website, you find that Bonanza have registered their design two months before Abacus's registration. The representations of the Bonanza registration are identical to the Abacus design.

What actions (if any) can be taken by either party against the other under:

- (i) the Registered Designs Act 1949 (as currently amended) and
- (ii) the design right provisions of the Copyright, Designs and Patents Act 1988? *(10 marks)*

Examiners' comments

This appears to be the most difficult question on the paper but in fact is one which yields easily to non-panicky analysis. Either B copied A or they did not. (That both copied a common source, is ruled out by the question; A's design is stated to be original). What are the consequences in each case?

If B copied, note the effect of S 1B(6)(d) RDA; A's registration remains valid in spite of the earlier registration by B; A can invalidate B's registration by either or both of the grounds of earlier disclosure by marketing and improper proprietorship; B has no design right because of lack of originality.

If no copying (but in view of identity the onus will shift to B) then neither has a valid registration because B's is invalid in view of A's earlier marketing and A's is invalid because of B's registration, even though the latter is invalid. Both have design right, but there has been no copying.

Q12

What acts as to infringement of a UK design registration are specifically excluded from the Registered Designs Act 1949 (as currently amended)? *(10 marks)*

Examiners' comments

Another memory question and on the whole well answered. The commonest omissions were of the exhaustion and repair provisions of S7A(4) and (5).
