

THE JOINT EXAMINATION BOARD

PAPER - Design & Copyright

Examiners Comments - 2005

General.

Answers or parts of answers which are illegible or otherwise incomprehensible get no marks.

Specifically:

Q1. Generally well answered, though it must be borne in mind that things such as not signing the documents are not per se reasons for refusal. It is the lack of response to an objection by the Registrar that may lead to a deemed withdrawal (not strictly a refusal) under R 29(1). The ground found in S 3A(2)RDA is “Not in accordance with rules”; that answer was of course acceptable.

Quite a number of candidates mentioned that not being the true proprietor is a ground. Nor is this quite accurate; the refusal by the Registrar will arise if the applicant does not claim to be the proprietor, the substantive question being dealt with after registration under S 11ZA(2).

The provision about complex products in S 1B(8) is merely defining novelty for a special situation and is not a separate ground.

The “intervening publication” ground in S 1A(2) must be carefully given; it is not a question of there being an earlier application or earlier design but of there being a UK or EC application for registration dated before the relevant date and published after that date.

Q2. Considerable difficulties were had in part c); good candidates gave the answer that there is no provision in the CD Regulation about commissioned works and that therefore the free-lance designer is the first owner (A 14(1) CDR).

In connection with assignment, that UK unregistered rights could only be assigned to a qualified person. This is wrong; once rights have been established by qualification they may be assigned to anybody.

Q3. Good answers were from candidates who recognised that the question had a particular direction and suggested an appropriate particular answer.

Here, for example, the question is clearly signalling that because the journal is well-respected (and also because its place of publication is not mentioned) the criterion of availability in the EU is fulfilled, and because it has been much admired for its “striking” space-age looks the design has individual character/ is not commonplace. To quibble about these things is time-wasting and to deny them, plain foolish.

a). For full marks show that CDR existed but will have expired, now being more than 3 years after availability.

b). Too late unless already applied for (“potential” includes applications).

c). No, not qualified, unless by first marketing.

d). Again this year S51 CDPA caused difficulty even in good answers. Copyright exists and continues to exist for its usual term. However since there is a design document (which does not need qualification in

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the design right sense) it is not an infringement of that copyright to make an article of this character.

- Q4. Many candidates failed to observe the “without penalty” in a) and gave the 6-month grace period rather than the correct 3 months up to and including the anniversary date, and in d) did not see that the application was “already filed” so gave the 6 month priority period rather than the correct 1 month after filing. In c) an answer saying “12 months from expiry” is not precise enough; it is necessary to show that this does not include the grace period.
- Q5. These formalities are, however regrettably, an important part of successful practice. Part d) showed some confusion, seen also in answers to question 8, between multiple designs and multiple views making up the “representation” of the or each design. Here it is A 4(2) CDIR which is needed; no more than 7 views. Note that unlike UK practice no wording may be attached to the views.
- Q6. The only part causing trouble to more than a few was e). R 15(2) provides that the disclaimer shall be on the front sheet only of each “representation or specimen” unless impracticable. It appears that this latter will actually apply only when specimens are filed.
- Q7. The disparity between terms and expiry dates of UK and EU rights now seems to be well understood, as are also the complex provisions governing the expiry of UK UDR.. Astonishingly, however, some candidates ignored the calendar that they had been given and replied that the latest date in part a) was 3 July, a Sunday. If material like that is given it is because it is needed!
Part a) could be seen from the mark allotment to have more content than the others, and to get all 3 marks candidates had to note the possible problem of collision between the priority period and the grace period, and resolve it. These periods are clearly cumulative, see AA 43 and 7(2) CDR. So if the priority application was filed within the grace period, as here, all is well.
- Q8. As in question 3 candidates must allow themselves to be “led” by the clear intention of the question and give appropriate answers. Here, for example, despite the clear instruction in the question that a Community Registered Design was to be applied for, too many answers were on the lines that UK national would be cheaper and/or that enquiry should be made as to which countries were of interest. As a result the question, which wanted a demonstration of knowledge about multiple applications and deferment, was not answered.
Some candidates argued that despite the slight difference in proportions between the three sizes, the slightness of the variation meant that adequate protection would be obtained by registration of only one, saving money. Provided that they showed that they realised that multiple application was also a possibility and the case was well argued, this was acceptable even though the scope of the resulting registration would be narrower overall than that of a

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multiple, and would not permit separate dealing with rights arising from the different reproductions.

There was much confusion in part b). Rights are only enforceable “upon registration” (A 12 CDR) and not, strictly, publication except when there has been deferment (A 19(3) CDR). They date from application.

In part c), which was clearly directed to deferment, it was sensible to discuss whether it would be acceptable simply to delay application (no) and whether, for example, a UK national could be filed now and used as a priority basis for a later CRD. This last is practicable only if the UK is immediately withdrawn because otherwise there would be objections that more than one design was shown if “multiple”, or premature publication if single. If, as is preferable, deferment is discussed a good answer should point out the flexibility of timing that is possible; it is not obligatory to take the full 30 months.

Q9. In questions of this type it is essential to go systematically through each of the types of right that may be relevant, determine whether each really is (saying why not if it isn't), and then say how each affects each of the elements in the given situation. Those who did not do this got poor marks. A tabular analysis would probably help in preparing an answer.

Copyright? Almost certainly exists in drawings. Does it matter? No, because the drawings of shape would be design documents and S 51 CDPA applies. If copyright in the colours, not being copied.

CDR? Yes. The question is pointing in this direction, since the discovery of the goods was recent. Change of size relevant? No. Change of colour relevant? Could be, if the overall impression is changed, but unlikely since we are told that it is the shape that is so distinctive. Infringed by client? Yes, if he sells, stocks, etc, since there has been copying. Infringed by manufacturer? Yes, for the same reason.

UKUDR? Yes, qualified. Change of colour irrelevant since this is not a subject for UKUDR. Infringed by client? Yes, because of copying and knowledge. Infringed by manufacturer? Yes, no knowledge required.

Registered rights? The question is pointing away from this, but it is relevant to remark that we are almost certainly still within the grace period.

Advice? Don't do it, or use the Spanish proprietor to manufacture, or get a licence.

It is not helpful advice to tell your client that he may be free to exploit the idea in about 25 years' time.

Q10. In a) there continues to be confusion about the effect of S52 CDPA. This does not terminate copyright. All it does is to declare that in the circumstances laid out, certain acts will not infringe. If copyright had ceased, there could be no question of infringement.

In b) the preferred answer was “true”, since copying may be indirect (S 16(3)(b) CDPA) and this is the general principle. However those who clearly showed an understanding of the effects and limitations of S 51(1) CDPA could justifiably answer “false”.

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- Q11. All that was needed was regurgitation of S90 CDPA and for full marks the essentials of SS91 and 92 also. Reference to S176(1) was not expected in the answer.
- Q12. This related to unregistered rights; most people got high marks. Note however that “dictated solely by function” is not a reason for lack of protection, and that merely saying “must match” and/or “must fit” is not a sufficient answer; the examiners want to know that the candidate knows what those terms mean.