

Examiners' Comments D & C 2006

General.

The "memory" questions such as 1 – 4 tended to be answered well while those such as 5 and 6, which called for analysis of a situation, caused obvious difficulties. Once again discipline is needed; a dispassionate and calm dissection will yield results which make the answer self-evident, but spraying random remarks and possibilities around certainly will not.

"Quiet, calm deliberation disentangles every knot" – W.S. Gilbert

Questions.

1. All of the fees in a) to c) are payable on application. They may be paid later in response to a notification of deficiency, but that is not the date on which they were payable.

There is only one term in d) – 30 months. That it may be cut short later by early payment of the publication fee is not strictly relevant in the context of this question.

A proper answer to f) should follow through to all the consequences including finally the application being void *ab initio*.

2. Usually well answered; the divisional procedure should be explained fully, and it should be pointed out that deletion is a possibility, and that failure to deal with the objection involves loss of the whole application.
3. All the answers are to be found in S 253 CDPA1988, and many people knew them well. Those few who wrongly thought the question was about remedies for infringement did very badly.
4. Parts a) and b) caused no problems. In part c), however, many candidates while correctly spotting that qualification may arise due to the presence of an otherwise non-qualifying entity within the EU, thought that a "place of business" would suffice. What is required by S217 (1) (b) CDPA is a "substantial business activity". See also S217 (5). The correct answer is probably that there is no qualification here, but that is less important than a discussion of the issues.

In Part d) for "first marketing" qualification there must be an exclusive right. It was transparently clear from the question that there was none.

5. This was the first of the analytical questions, and it gave rise to a lot of difficulty amongst those who ignored the structure of the question itself, which lays out one rational approach. In part a) we are concerned with either copyright or unregistered design right. Which of these has Mrs A in respect of what? Likewise Mrs B? What has Mr C done? Which of his actions might offend against either or both rights in whose hands? Assembling the facts in tabular form would enable the writing of an organized and almost certainly correct answer.

Most factual failures arose from not dealing with Mr C's indirect copying onto computer, and from a very common misapprehension about Mrs B's position. To be author by virtue of making "arrangements necessary for the creation of the work" the work in question must be computer-generated. Here, the work was "generated" by Mrs A, and as far as a design document is concerned the designs are not original in Mrs. B's hands. Several candidates also made Mrs B owner of copyright in the program, despite the question clearly stating that it was commercially available!

Part b) was clearly looking mainly for a discussion of registrability and the best mode of proceeding. A full answer needed some discussion of (i) whether a design for a flower arrangement is registrable at all - probably yes as for a handicraft product/item - (ii) whether there is lack of novelty - no, because it is in the grace period - and (iii) where, UK or CRD. Because there were "a dozen or so" designs to protect the question (at the time it was set) was leading to use of the Community system. Who should register is a subsidiary issue, but in any case there should be a regularisation of the situation in writing, by Mrs A and Mrs B.

6. Critical here is a realisation that there is exhaustion of rights in respect of the physical machines sold, and their manuals. Thus company A has done nothing wrong in relation to the client, and B does nothing wrong in having or using the machines. It is also critical that mere information is not susceptible of protection. Thus the possibilities for infringement are reduced to the activities involved in producing the new manual - "some drawings" were taken from the client's manual, and it is possible that textual matter may have been taken as well.

7. There was much confusion from those who failed to read the question and did not realise that the support was identical to the prior art.

The core issues for discussion revolve around (i) who is the "informed user", (ii) who is this in the present case, and (iii) does the word "user" imply that the assessment of individual character is carried out in use? If it does, is it likely that differences in detail that are visible when the fitting is inspected carefully be important when the fitting is 5m above the ground?

Anyway it is clear that registration should be (i) of the fitting or (ii) of the fitting plus support with the latter disclaimed (though the effect of the latter when an assessment is made on overall effect of the design as then represented is unclear), coupled with a discussion as indicated above. It is, incidentally, not possible for OHIM to refuse registration on grounds of lack of novelty or of distinctive character, as many candidates appeared to believe

8. The main question here is, what is prior art to a Community Design? So the questions to be asked of the client should demonstrate to the examiner that the candidate is aware of this. On the one hand, was the trade show in Singapore visited by many people from the EU and/or was there evidence that what was shown there could have become known in

the EU by other means e.g. on the internet. On the other hand, even if there had been knowledge within the EU, would it be relevant? Are the “circles” of jewellers and watchmakers distinct? If they are then any disclosure to one such is not prior art at all in relation to the other. (But the fact that your client was at the show suggests that the “circles” are not distinct.)

A possible problem for registration by the client is ownership, since he is proposing to adopt, not adapt, the design. If he buys the design he must also buy the right to registered proprietorship in EU (and, outside the question, copyright); alternatively, agree terms with the jewellery designer so that the latter should apply.

9. Several candidates got no marks for their answer to this question because they delivered a general treatise on registrability of designs and did not apply themselves at all to the facts; the question asks how to assess registrability of the design, namely that of a boat hull with the given characteristics. The issues are kit-of-parts, visibility in use, functionality, and design freedom. All need discussion.
10. Very few candidates tackled this question and unfortunately some of those misdirected themselves since they dealt with the amendment of an application. The question relates to the weirdly-numbered S 11ZD RDA 1949 as amended. If the Registrar proposes to invalidate a UK Design Registration on certain grounds, the Proprietor is given a chance to save the right by “modification”; however, the essential character of the design must not be changed and the modified registration must appear to be valid. The effect is as from grant.
11. Well answered by almost everyone, except that there is still apparently widespread ignorance of the fact that UK unregistered rights – design and copyright – expire at the end of the relevant year.

A tabular presentation of the answer was helpful both to the candidates and to those doing the marking.

12.
 - a) Producer and principal director, as joint owners.
 - b) It is irrelevant for the purposes of ownership that the commissioner being a Japanese company, is apparently unqualified. But unless there is qualification there is no design right at all. Here, however, are the conditions for qualification by first marketing; exclusive right to an EU person, and first sales in the UK. So the right exists and the Japanese company is the owner.
 - c) Much confusion in the answers to this, arising from an imperfect recollection of the working of the statute. In the case of a computer-generated work the designer is “the person by whom the arrangements for the creation of the design are undertaken”. *Per se* this has nothing to do with employment, commissioning or the like. After you have decided who the “designer” is, you can think

about ownership. That is the discussion here, and it seems probable that the University “made the arrangements....”.