

Examiners' Remarks D & C 2007

General:

Q1. Part a) caused no difficulty. In Part b) too many answers suggested that the restoration fee was paid immediately; in fact it is payable after the Registrar has decided to allow the application (R41(6) RDR).

In Part c)i), most answers recognised that the right had effectively never lapsed, but many answers to Part c)ii) lacked precision; in particular the need to recognize that the period includes that of c)i) (S8B(3) RDA), but more importantly that a first infringer thereafter was exempt only if infringement began before the advertisement of the application to restore (S8B(4) RDA).

Q2. Surprisingly few candidates tackled this relatively easy question, the whole answer to which is in S24B RDA. Many answers lacked essential detail. For the mandatory exclusion of an award of damages or an account of profits defendants must show they were not aware nor had any reasonable grounds for assuming that the registration existed. Marking is not deemed to make a defendant aware unless the registration number is also given. An injunction could nevertheless be granted.

Q3. There appears to have been a large amount of guesswork in the answers to Part a). Under A47 CDR OHIM has no power to refuse an application on comparative grounds; at this stage it can only act if the subject of the application is not a design, or if the design is contrary to public policy or morality. Good candidates emphasized this.

Marks were also given to answers which stated that failure to observe formalities was a ground, provided that those answers made clear that in fact it is the failure to rectify after a notification of the original failure that is the immediate cause, and despite A10(4) CDIR using the term "reject" rather than "refuse".

Part b) was well answered by most, though too many thought that "must match" was one of the grounds, and very few stated that false proprietorship as a ground can only be based on the decision of a national Court.

Q4 was very popular, and well answered by most; failings were the realisation that all of the name, address and nationality of the applicant are obligatory, and that the date and country of the priority application are also obligatory (not necessarily its number). See A1 CDIR.

Q5. For such a fundamental question, there was an alarming variation in the quality of answers. Many answers overlooked the most obvious case, where the later application claimed convention priority. It is essential to distinguish between the time-limited exclusion of an abusive disclosure and the unlimited exclusion of a confidential one. There was also too much vagueness about the requirement that a disclosure could not reasonably have been known to interested circles in the EEA if it were not to be deemed made available to the public. The exact wording of S1B(6)(a) RDA (and the equivalent A7(1) CDR) should be kept in mind.

Q6. Part a) of this question required a precision which was lacking in a number of answers – all of “multiple”, “replaced”, “disassembly” and “reassembly” are required by A3(c) CDR.

Both Part b) and Part c) required the special conditions attaching to complex products; lengthy answers detailing normal validity and infringement were irrelevant. For Part b) see A4(2) and (3) CDR; the relevant component must be visible in normal use, which does not include servicing maintenance or repair, and its visible portion must fulfil the requirements for novelty and individual character.

The answer to Part c) can be found in A110 CDR – there is no monopoly over use for repair of a complex product to restore its appearance.

Q7.

Part a)

According to Ss. 1 and 4 CDPA, each picture in the cartoon strips is a graphic work, and the series of pictures in each strip when taken together is a graphic work.

Part b)

The Examiners were looking for a discussion of the various issues that this part of the question presented. For example, if a competitor uses the general appearance of the cartoon character but does not copy the exact pose/detail of the character (i.e. the reproduction is not the same, even though the character may be recognisable) is there any copyright infringement? Is there copyright in all possible pictures of the character even though the client has created pictures in only a discrete number of poses? What would happen if a competitor copied the general theme of the comic strips and the facial appearance of the character but otherwise the competitor's comic strips were different?

Part c)

According to S. 17(3), a 3-D copy of a 2-D work is protected. S.51 does not apply as the cartoon character is an artistic work. However, under

S.52 there is no infringement by producing 3-D copies after 25 years from first marketing.

Q8

- i) Art. 4(3) of the Regulation applies i.e the engine must be visible in normal use of a car. The bonnet is usually closed in normal use of a car. Normal use is defined as use by the end user excluding maintenance servicing and repair.
- ii) According to Art. 3(a) colours can be a feature of design.
- iii) Art. 8(2) – the part of the adapter with a European style plug would be excluded from the assessment of novelty and individual character, as would the shape of the socket for a UK style plug. The rest of the design would be registrable.
- iv) The term “permanent conservatory extension” required discussion. Is the extension a building or a product?
- v) Under the Regulation, a design is not new if the design has previously been “made available to the public”, regardless of whether the design was applied to a different product.

Q9

- i) Artistic copyright subsists irrespective of artistic quality S.4(1)(a)
- ii) Copyright would subsist in the typographical arrangement provided it does not merely reproduce a previous arrangement (see S.8(2) CDPA)
- iii) Copyright does not subsist unless a work is recorded – the debate may be televised (sound recording) and would be recorded in Hansard.
- iv) Is there any skill or effort involved in creating a chronological list?
- v) A true copy of the Mona Lisa would not be original, even though considerable skill and effort is required in its production.

Q10

(i) According to S. 11 the first owner of copyright is author of a commissioned work. However, under S.91(1) future copyright can be assigned. The commission should therefore include an assignment of copyright. Under S.77 the author of a literary work has the moral right to be identified as author of a work when it is published commercially. However, S.78 specifies that such a moral right must be asserted by the author and under S. 87(2) the moral right can be waived by instrument in writing.

(ii) Under S. 80 the author of an artistic work has the right not to have his work subjected to derogatory treatment. The client's use of the painting may be considered derogatory treatment which is defined as distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author. The client's offer would have no effect on the author's rights – S.77 and 84 cover references to the author but such a reference (or lack of it) is not relevant under S.80.

Q11

This question is based on the decision of the Court of Appeal in *Landor & Hawa v Azure Designs*. The court confirmed that design protection is available for purely functional designs provided that the function in question can be achieved by designs with different shape or configuration. The answers to (a) and (b) are largely the same provided the candidate appreciates that the effect of the two legislations is the same, even though the wording is slightly different.

(a) S.213(3)(a) of the CDPA specifies that design right does not subsist in a "method or principle of construction". The exclusion ensures that designers cannot create an effective monopoly [under UDR] over articles made in a particular way. The client indicated that there are several other ways to achieve the desired function, and the method of manufacture is based on economic considerations. Therefore, the design may not be excluded from protection.

(b) Article 8(1) of the Regulation specifies that a community design shall not subsist in features of appearance of a product which are "solely dictated by its technical function." Is the shape of the design solely dictated (i.e. driven without option) by the technical function? The answer on the facts presented is "No" since the client has indicated that there are other designs which perform a similar function.

Q12

This aspect of the law still needs judicial clarification and the Examiners were looking for a sensible discussion, whatever the conclusion reached.

On one analysis, if, in the normal course of business the design sold in the US could reasonably have become known to the circles specialised in the sector concerned operating within the community, then design protection would commence from December 2005. A discussion of how this might arise would be appropriate. If this is not the case, then design protection

would commence from March 2006. In this latter case, the design would be deemed new as the US disclosure would not be considered for the purposes of Art. 5. The date of June 2005 is not relevant to CUDR.

Full marks were also available to those candidates who adopted and showed an understanding of the reasoning of the Regional Court of Frankfurt (in Thane International Group's Application), that CUDR would not be acquired when first publication was outside of the community.