

D&C 2008 Examiners' Comments.

General.

Success in this examination requires detailed or general knowledge of a large number of Sections, Articles and Rules of the various Statutes and Regulation set out in the Syllabus. Those who were thoroughly familiar with them and correctly applied them did well. Those candidates who had not paid the syllabus necessary attention did correspondingly badly.

Too many candidates did not appear to have read the questions and as a result gave irrelevant answers, (which takes up valuable exam time and scores no marks). Another unfortunate tendency is to give illegible or simply unintelligible answers. As to the first, the examiners do what they can to decipher the undecipherable, and read the illegible, but at the end of the day, if it cannot be deciphered or read, it cannot be marked. As to the latter, candidates should remember that a detailed knowledge of Statute means very little unless and until it is correctly applied. Candidates should avoid complex sentence structure, rambling and unclear alternatives, which generally take longer to write so waste the Candidates' examination time and do not score marks. Candidates are encouraged to read precisely what the examiners were looking for, listed below, and consider how much more quickly the paper might have been answered by sticking firmly to the point of the question posed. Mere jargon and complex "legalese" will only confuse the client in "real life" and will not score marks in an examination.

Question 1

The Examiners were looking for:

- i) An order (1 mark) prohibiting the defendant (1 mark) from doing an act which infringes the Community Design registration (1 mark).
- ii) An order to seize (1 mark) infringing articles (1 mark).
- iii) An order to seize any materials or instruments (1 mark) which are used to manufacture (1 mark) such articles if the owner is aware (1 mark) that such items may be reasonably used for such purposes (1 mark)
- iv) The law of the member state in which the infringement occurs (1 mark).

Comment. Very few candidates attempted this question, which required knowledge of Art 89 of the Community Designs Directive. Those who had such knowledge did well.

Question 2

The Examiners were looking for:

Part A

Making (½ mark)

Offering (½ mark)

Putting on the market (½ mark)

Importing (½ mark)

Exporting (½ mark)

A product (½ mark)

Part B

Private (½ mark)

Non Commercial (½ mark)

Experimental (½ mark)

Teaching purposes (½ mark)

Use in ships or aircraft (½ mark)

Spare parts or accessories (½ mark) for repairing ships or aircraft (½ mark)

Carrying out of repairs on ship or aircrafts (½ mark)

Sources acknowledged (1 mark)

Exhaustion of EU rights (1 mark)

Repair of complex product (1 mark)

Comment. Candidates confused exceptions to infringement (Section 7A) with innocent infringement (Section 24B) and consequently lost easy marks. Read The Question!

Many candidates failed to define use (Section 7 (2)). One or two candidates reproduced the requested section almost verbatim and consequently scored very highly.

Question 3

The Examiners were looking for:

Part a

Composed of at least two replaceable (½ mark)

Component parts (½ mark)

Permitting disassembly (1 mark)

And reassembly (1 mark)

Part b

Industrial (1 mark)

Handicraft (1 mark)

Packaging (1 mark)

Get up (1 mark)

Graphic symbols (1 mark)

Typographic type faces (1 mark)

Parts intended to be assembled into a complex product (1 mark)

Comment: A straightforward question which required thorough knowledge of Section 1(3). Most candidates did well on this question.

Question 4

The Examiners were looking for:

Secrecy of certain designs (1 mark) of a class relevant to defence (½ mark) notified by Secretary of State (½ mark)

Less than 14 days (1 mark) from filing (1 mark)

Memos/documents prepared by registrar/patent office (1 mark) for internal use only (1 mark)

Disparaging statements (1 mark)

Offensive/immoral/antisocial behaviour (1 mark)

Confidential Documents (1 mark)

Demonstrate knowledge of Rules 29 (3) and Rule 30 (Applicant must request confidentiality/registrar must agree to treat as confidential) (1 mark)

Comment: The question specified “upon registration” so discussing the pre-registration position gained no marks. Several candidates appear not to have read the question, and confused community Law with UK law and so scored no marks at all. It is clear from the question which jurisdiction was requested. Several candidates confused the applicant’s ability to request deferred publication with the ***statutory exceptions*** to publication again missing easy marks. Generally there was a lack of knowledge and understanding of Rules 28-30 inclusive, so this was on the whole poorly answered.

Question 5

The Examiners were looking for:

a) Any person (½ mark) is entitled to a Licence of Right during the final (½ mark) period of 5 years (½ mark) of protection (½ mark).

b) Terms are settled by agreement (½ mark) between the parties (½ mark) and in default by the Registrar/Comptroller (1 mark)

c) Licensee may not, without consent of the UDR holder, (½ mark) apply a trade description (½ mark) to any goods marketed by him under the licence (½ mark) to the effect that he is marketing goods from the UDR owner (½ mark) or use such trade description (½ mark) in connection with advertising of such goods (½ mark)

d) Secretary of State may declare that licences are not available (½ mark) to fulfil an international obligation (½ mark) or to maintain a reciprocal agreement with another country (½ mark) that acknowledges UDR (½ mark)

The mechanism is declared by a Statutory Instrument (½ mark) laid before Parliament (½ mark).

Comment. Parts a) and b) were answered very well, whereas parts c) and d) were poorly answered. Part c) provides the specific situation where a licensee's rights are restricted and part d) the specific exception in section 237(4) CDPA 1988.

Question 6

The Examiners were looking for:

Designer or successor in title (1 mark)

Joint designer (1 mark)

Employee (1 mark)

Owner (1 mark)

Joint Owner (1 mark)

Preceding to entitlement (1 mark)

Outcome registered in register (1 mark)

Licence terminates on complete change (1 mark)

Licensee entitled to non exclusive licence (1 mark)

Unless in bad faith (1 mark)

Comment: Failure to distinguish between rights afforded by a registration and requirements of registrability was a common fault. However, on the whole this question was well answered.

Question 7

The Examiners were looking for:

Non Dramatic (1 mark)

Not musical (1 mark)

Written (1 mark)

Spoken (1 mark)

Song (1 mark)

Table (1 mark)

Compilation (1 mark)

Computer programme (1 mark)

By recording (1 mark) and when recorded (1 mark)

Comment: This question required knowledge of section 3 of the Copyright Designs and Patents Act. Again, those who had a thorough knowledge scored highly and those who did not, did not!

Question 8

The Examiners were looking for:

Was the commissioning in the form of a written contract? (1 mark)

What safeguards are there to ensure there is no breach of confidence? (1 mark)

Was a Design Application made in the name of the designer or company? (1 mark)

If in the Designer's name need to register the transfer. (1 mark)

One year grace period to register a Design under the 'CDPA' 1988. (1 mark)

November 1985 + 25 years gives maximum term Nov 2010 (1 mark)

Were any searches carried out for existing rights? (1 mark)

Check that product sold by rival is not protected by registered rights (1 mark)

There are different terms of UDR in UK and EU. (1 mark)

Spare parts may not be registerable and cannot be used to prevent repair (1 mark)

Comment. Many candidates quoted cases and law, but seemed unable to provide advice specific to the facts in the question and generally as to what happens in the 'real world'. What tends to happen is that companies (the new business) pay designers money as part of a contract (referred to as a commission) to design (the new boat and spares) and therefore in equity, or preferably as a result of the contract (which is ideally written down), usually own the Design Rights and Copyright arising from the commission. A written contract therefore should act to transfer those rights (or if not a separate Assignment should be prepared). It is advisable to refer to the contract/Assignment if/when applying to register any new Designs (in the boat and possibly the spares). It is also sensible to advise the client to undertake searches in order to determine whether any relevant existing rights (of the previous employer as well as third parties), are in force and could be infringed. Marks were also awarded for advice, when commissioning a design, stating that a clear 'paper trail' of a design specification to the designer reduces the risk of an allegation of copying. This is probably even more

important in the light of the circumstances in the question, in order to ‘ring fence’ any confidential information that the boat builder may have (and that may still belong to her ex-employer), so as not to ‘unjustly enrich’ the designer she is commissioning. Also it is possible that the previous employers UK Registered Design could be in force (until 2010) and consequently could still be infringed.

Candidates seemed to struggle with this question, failing to point out what are essentially ‘common sense’ facts and the sort of straightforward advice that is often discussed with a client and reported following an initial meeting.

Question 9

The Examiners were looking for:

Consider applying to register new configurations, initially in the UK (1 mark)

If existing three Design Applications are less than 6 months old file a Community Design and/or an Application to register in Greece and claim priority (1 mark)

If existing three designs were disclosed less than 12 months ago either apply to register them either as a UK Design or direct as a Community/Greek Design (1 mark)

If time periods permit, file a Community/Greek Design and claim priority from existing three - as well as any further new- UK design applications. (1 mark)

Community Design Application permits more than one design, in same Locarno class, therefore reduces costs (1 mark)

Greek manufacturer should be offered a licence (1 mark)

Licence should include the Community Design, UK & Community Unregistered Design Rights, Copyright and Know-How (1 mark)

Licence should be recorded (1 mark)

Must fit/place around to perform function, typically in a spare part, is probably excluded (1 mark)

Components not normally seen in use may also be excluded (1 mark)

Comment. Many candidates knew the law and most recited it in detail but failed to provide any specific advice as to how this affected the client in the particular circumstances or what the client should do (steps that need to be taken) or at least a consideration of the relevance of timeframes of filing and disclosure of the designs.

Candidates were expected to read carefully the information in the question and to work out that there were three design Applications filed by the client for ‘updated versions’ and a number of configurations that they had not registered, but which may have been disclosed. So they were expected to ask if they had been disclosed and if so say how this affected the client’s options. Comment was expected on the relative timeframes of filing dates of existing, as well as any new, Design Applications and any disclosures. A discussion of different permutations of UK and/or Community protection was expected; and comments on whether it would be better to file Community Applications directly, eg as several designs can be combined, as single Locarno class to save costs. Many candidates did not spot the licensing opportunity to the Greek company or if they did, they

failed to put this in their answer. Very few candidates realised that there were other rights to license beyond just the Design – eg copyright, UK and ‘EU’ Design Right and Know-How.

Question 10

The Examiners were looking for:

Who made the design? (½ mark)

And when? During or after employment (½ mark)

So previous Employers rights of ownership need considering (½ mark)

Highlight risk of possible breach of contract (½ mark)

Issues of potential infringement of previous employer’s rights (½ mark)

Similarity to existing third party rights – so do a search (½ mark)

In whose name are Design Applications to be filed - his or the Company? (½ mark)

If filed in his name consider a transfer to the Company (½ mark)

Include assignment of Copyright in the transfer (½ mark)

Relevance of the catalogue, if published more than one year ago? (½ mark)

Similarity to published images in the catalogue – commonplace? (½ mark)

Client’s Designs are original if not commonplace (½ mark)

Unregistered Design Right probably exists (½ mark)

Spare Parts may not be registerable (½ mark)

Implied ‘right to repair’ is an exception to infringement (½ mark)

Pump is probably a complex product (½ mark)

If products are purely functional, design may not be registerable (½ mark)

Is product visible during normal use, if not probably excluded (½ mark)

Normal ‘use’ excludes maintenance/right to repair (½ mark)

Exclusion on complex product must fit and must match (½ mark)

Comment. This question was not considered to be too complex but raised many issues. It too required a practical, common sense and logical approach to the sort of issues that arise almost daily in practice. A list of key bullet points would have scored highly, as a few candidates managed. Many others got bogged down with complex points and went into great detail on only a few points, with the result they wasted time and sacrificed many easy marks.

Question 11

The Examiners were looking for:

Renewal fee is only one month overdue (½ mark)

So do nothing before Mar/Apr 2009 (½ mark)

As a result of the 6 months grace period (½ mark)

As specified in section 8(4) (½ mark)

Once a Registration lapses the Proprietor has 6 months to restore (½ mark)

Client can thereafter commence to make/use/import (½ mark)

As provided for in Section 8B (1 mark)

Provided this is done in good faith (½ mark)

But between Mar/Apr 2009 and Sep/Oct 2009 a decision to restore is discretionary (½ mark)

Subject to the Design being filed after 01 August 1989 (1 mark)

Which must be the case as the third renewal fee is due (½ mark)

And therefore as a result of section 8A/Rule 13 (1 mark)

The Proprietor can restore rights by filing a Form (DF29) and paying a fee (1 mark)

And supply evidence as to the reason(s) for failure to renew (½ mark)

And any party commencing in good faith in the interval Mar/Apr 2009 and Sep/Oct 2009 has the right to continue (½ mark)

Beyond Sep/Oct 2009 Registration lapses irretrievably (½ mark)

Comment. Many candidates wasted time simply reproducing information from the question, without any comment or input, so scored poorly. Again candidates seemed unable to assimilate information, apply basic knowledge of the Design and Copyright Acts and advise a client in respect of options and timeframes. Some Candidates wrote detailed commentaries on wholly unrelated and irrelevant points, rather than address the issues raised! Candidates should remember that their detailed knowledge on Statute means very little to the layperson, who is usually befuddled with jargon and complex “legalese”. Candidates should also avoid complex sentence structure, rambling and unclear alternatives