

## **Design and Copyright Examiners' Comments 2010**

General:

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

### **Question 1**

This dealt with the question of moral rights in literary or artistic works. Parts a) and b) were well answered on the whole, though some candidates forgot the moral right to object to derogatory treatment. Part c was less well answered, the principle being that moral rights are personal and are not assignable. Transfer can only occur on death.

The examiners looked for the following points:

In Part a)

Right to be identified as author (1) S77 CDPA

Right to object to derogatory treatment (1) S80

Right not to have work falsely attributed (1) S84

Right to privacy in a commissioned (1) private or domestic (1) film or photo (1) S85

In Part b)

Identification (1) S78

In Part c)

By transfer on death (1) including by testamentary disposition, or as part of the estate (1 for either) S95(1) (a),(b). [Exercise by the personal representatives as in S95(1)(c) is not really a transfer but was given credit, no credit was given for mentioning assignment under S94]

### **Question 2**

This dealt with International Registrations, and here the examiners looked for the following:

Part a)

Same as if registered in the register of Community Design Registrations at OHIM.

A106a CDR

Part b)

Same as an application for registration of a Community design. A106d.1

Part c)

Within 6 months of publication of the international registration (1 mark). On the grounds it is not a design (1 mark), or contrary to public policy or morality (1 mark). Article 106e.1

Part d)

Registration of earlier date but unpublished at the filing or priority date of the Community design (1 mark), and having effect in the Community (1 mark), or an application for such a registration (1 mark). A25(1) (d) (iii).

### Question 3.

This presented few problems to the majority of candidates, and where marks were missed it was due to lack of organisation leading to incompleteness. A tabular answer would be perfectly acceptable.

Several candidates wrongly believed that there would be a default to a qualified designer if the owner of an unregistered right was not qualified, and too many apparently believed that there was a requirement for qualification for ownership of registered rights.

### Question 4.

#### Part a)

The languages of the Office are Spanish, German, French, English and Italian (½ each up to 2). This is from Regulation 207/2009, A 119(2). [The Trade Mark Regulation]

#### Part b)

Applications may be filed in any language of the Community (1 mark) BUT a second language must be given, which must be a language of the Office (1 mark). A98.(1),(2) CDR

#### Part c)

Correspondence is in the language of filing (1/2) if that is a language of the Office (1/2), otherwise the second mentioned language (1 mark). A98(3).

#### Part d)

The language of the proceedings is as in Part c) (1 mark). Application for declaration of invalidity must be in language of proceedings (1 mark), but if that is different from language of filing, the right holder can use the latter (1 mark). Parties can agree to use any language of the Office (1 mark). A98(4),(5).

### Question 5

Parts a) and c) are both 6-month terms, but for full marks the answer must show that for UK it is up to the anniversary date, whereas for EU it is up to the end of the month containing the anniversary date. Parts b) and d) contain clues; clearly the Registrar has to do something before cessation but OHIM has to act after. In each case the action is notification but the terms are 6 weeks and 6 months respectively.

An unfortunate number of candidates gave answers based on late payments, getting no marks.

### Question 6.

This question did not pose many difficulties, except for those candidates who were under the impression that there was no protection when a feature is dictated by technical function. This relates to Registration of designs, not to unregistered rights in the UK.

### Question 7.

Here was the first of the “long” questions, and again an unfortunate number of answers were spoiled by lack of organisation. Each subject, either legal or factual, should be dealt

with in turn, going through all the possibilities to be applied to it. For full marks the advice required by the question should also be supplied once the analysis has been laid out.

The points the Examiners were looking for can be summarised as follows:

Edge of blade: No UDR – S213(3)(b) CDPA “must fit”

Copyright exists but only theoretically useful because of uniqueness

DR. no – dictated solely by function (in the case of each individual setting)

Blade Corrugation: No UDR as before

Copyright exists and could be useful

DR no as before

Handle outline: UDR OK – not method of construction

Copyright exists – takes precedence over UDR - S236CDPA

DR OK.

Handle hole: All OK.

Outlook: favourable, at least in theory, for both aims. The handle aspects are stronger.

Question 8.

This question deals with rights of prior use of a Community Registered Design and required the “detailed knowledge” of Article 22 CDR specified by the syllabus.

The examiners were looking for the following points.

Part a)

Not correct(1 mark).

Probably not good faith(1 mark), but anyway “no” because copied(2) – Last phrase of A22(1)CDR,.

Part b)

Correct (1 mark).

Fashion accessory in the CRD not limiting (1 mark) but prior right arises “for the purposes

..... for which [the] preparations had been made” (1 mark). A22(2).

Preparations were serious (expense) (1 mark). But purpose was for horse-combs, so no right of prior use (1 mark). (But C would still have the right to exploit in that field.)

Question 9.

The Question deals with the rights which the company may have, it does not call for a discussion of what the products are. Marks were available for noting that UK (1 mark) and Community Registered Design Right subsisted (1 mark) and that each may be filed validly within 12 months from publication (1 mark). Options open to Applicants are: to abandon and refile (1 mark).

Other points that attracted marks were: how likely is it that the designs will be seen in normal use, when were the original designs applied to household appliances (1 mark); when were the modifications applied to motor and aero engines (1 mark); and (iii) in the latter case would such modifications have been taken into account by the purchaser (1 mark)?

Marks were also awarded for discussion of whether parts were modified in a trivial or immaterial way for use in the domestic appliance; and whether parts for motors and aero engines are likely to be dictated solely by technical features.

This question was generally very poorly answered. Too many candidates who can provide almost word perfect answers to factual questions, seem to be totally adrift when attempting the mental jump from 'rote learning' to application of the law to situations that are often encountered in day-to-day practice.

#### Question 10

This question requires a discussion of the rights that are owned by Mr Smith and the actions that are open to him. The examiners were looking for the following.

##### Part (i)

Community Design Right (1 Mark),  
and UK UDR (1 mark)

Note for possible bonus marks: S51 CDPA, provides that while design documents are protected as artistic works [1/2mark],  
copyright in such documents is only infringed by the manufacture of an article to the design if the article manufactured is, itself, an artistic work, or a typeface (section 51(1) CDPA) [1/2 mark]

The making of a two-dimensional copy of the design documents themselves, such as a photocopy, can still infringe copyright [1 mark].

An unmodified statement that copyright subsists in the freehand original drawings does not attract any marks. Such statement must be put into context.

##### Part (ii)

##### Section 215 CDPA - Ownership of design right

1. The designer is the first owner of any design right in a design which is not created in pursuance of a commission or in the course of employment.
2. Where a design is created in pursuance of a commission, the person commissioning the design is the first owner of any design right in it.

Therefore:

Was there any form of contract with Mr Smith (1 mark),  
and was there any consideration paid to Mr Smith (1 mark)  
Possibly invalidate Mr Smith's UKRD

The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting. Here the client can claim to be the proprietor of the design represented in the original drawing, but can Mr Smith claim to be the proprietor of the design represented in his versions of the drawings? (1 Mark)

The registration of a design constituting an unauthorized use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright. (1 Mark)

#### Question 11

Too many candidates failed to note that perhaps something should have been found by the searcher and that this could probably be considered as a cause for complaint against the

search firm. A few spotted the relatively straightforward points: For how long had Alpha been selling the heater? If more than 12 months prior to Beta's priority date the registration might not be valid or if it were valid then there was probably not be infringement.

A few candidates considered whether Alpha could prove that they were not aware of the registration and several candidates mentioned that a mere reference to the words "Registered Design" provided no real rights, unless accompanied by the number. Other marks were available for mentioning false claiming by Beta and that immaterial differences might in fact provide a defence to infringement.

Among the points taken into consideration were the following:

Is the Beta Heater actually covered by the registered design? Falsely claiming it is a registered design is an offence (1 mark)

Are the differences between the Alpha Heater and the registered design 'more than immaterial differences'? If so there is no infringement (1 mark)

For how long has the Alpha Heater been sold? More than 12 months before the priority date of the Registered Design? If so there is no infringement (1 mark)

Discuss how this affects validity of registered design (1 mark)

"Alpha Ltd usually carry out thorough searches"

Did they this time?

Because (1 mark)

(a) Does Alpha have a claim against the search firm? (1 mark)

And (b) Can Alpha prove that they were not aware of the design?

Just "Registered Design" appears (1 mark)

Must be a number (1 mark)

Might there be a defence of innocent infringement? (Discuss) (1 mark)

BUT independent design/arrival at the same design is not a defence (1 mark)

## Question 12

This was a relatively straightforward and popular question. Most candidates who attempted this question passed it, with marks being awarded as much for the reasoning as for getting the correct answer. Main issues:

- a) product?
- b) Colours?
- c) Novelty?
- d) Function/method of construction?
- e) 3D/solely functional?