

Examiners' Comments, Design and Copyright 2012.

General.

Because of an apparent breach in security immediately prior to the examination, the paper had to be rewritten and two questions were included which hindsight showed were strictly outside the scope of the syllabus but which despite that were popular and extremely well answered. These were Question 7 which ninety per cent of candidates attempted (of whom ninety per cent actually passed) and Question 11 which seventy five per cent of Candidates attempted (of whom sixty eight per cent passed).

Generally, Candidates are reminded that conclusions must be supported by reasons.

Recitation of a provision will not get marks unless 1) the provision is relevant to the question and 2) its applicability to the situation being considered is fully explained and argued. See particularly Questions 8 and 9 below.

Question 1.

The question required discussion of requirements for a filing date, not for what is needed to complete formalities such as a designation of articles, language choice, and so on.

A few candidates commented on the fact that a specimen had been filed. This is only valid for a filing date if deferment is requested and the design is 2D.

Most candidates recalled the one-month period after filing during which priority may be claimed, but too many did not make it clear that it is the filing date, not the declaration date, that must be within the priority period. Most candidates appeared to think that there is a 3-month period from a declaration date for filing convention documents. This is not so; see A8(1) CDR – 3 months from filing date.

Question 2.

The question points to a possible difference between expiry date and renewal fee payment. Rights expire on the anniversary; renewal fees may be paid without supplement during a period of 6 months before the end of the month containing the anniversary.

The question asked what happens if only three fees are paid. Too many candidates simply said that the designs to be renewed should be specified, which may be correct in practice but is not the answer to the situation put in the question. For procedure see A 22(5) CDIR – only after unanswered enquiry from OHIM about intentions will the designs be renewed in numerical order.

Question 3.

This very basic question was badly answered.

The question gave the structure for an answer – the general principle of availability, which can broadly be called universal, and then the exceptions, notably; not being known amongst relevant circles in the Community, the 12-month grace period, confidential and abusive disclosures.

There was confusion between the exception for confidential disclosure, which is without limit of time, and the exception which is the grace period for disclosure directly or indirectly by the inventor, and that for abusive disclosure, both of which are limited to 12 months preceding filing.

It was incorrect to refer to convention or exhibition priority since both have the effect of altering the relevant date.

Question 4.

This was intended to draw out the difference in availability and starting points between UKUDR and RD rights.

Clearly the 3-D aspects of the raised pattern have to be discussed in the context of UKUDR – surface decoration or configuration? Either is arguable though the latter is signalled in the question.

Colours (not 'colour') are protectable by UKRD but not by UKUDR.

“Method of manufacture” can be discussed in the context of UKRD, only to be dismissed. The question makes it quite clear that appearance, which is what is to be protected, is independent of the way the articles are made.

In relation to UKRD, there should be a discussion of strategy in view of the numerous colour-schemes and raised patterns that are possible. Multiple-design application(s) should certainly be mentioned, as well as the non-limitative effect of designation of articles.

Question 5.

Surprisingly few Candidates tackled this straightforward question.

- a) Copyright in the original catalogue had, clearly, expired, and because the drawings in the current catalogue are the same they are not original, and one might debate who owns the copyright in the drawings of the ‘hinged lid’ and discuss the fact that the typographical arrangement and texts of the current and 2013 catalogue may be subject to copyright and infringed by competitor if taken.
- b) UKUDR. Nothing original in stools, current or future, if without hinged lids. Appearance of hinged-lid stools OK if not commonplace, but Indian designer not qualified. No exclusivity for client, so not qualified that way. Discussion of whether commissioned – question leads to No. Neither colour nor texture gives rise to UKUDR.
- c) RD. Existing registration invalid for lack of novelty – designation not limiting and design field the same. Appearance of hinged-lid stools, possibly colours and texture, potential subject matter, but ownership is the Indian designer’s. Assignment needed if client is to validly apply.

Question 6.

Although the question did not explicitly state that the registrations were UK, the context made it clear, and candidates dealt with it accordingly.

The question was well answered by most, the main difficulty coming in lack of precision over the period during restoration in which infringement or good faith preparations give rise to third-party rights. It is from expiry (not from the end of the 6-month period in which renewal might be made belatedly) until the advertisement of the application for restoration. Too many failed to specify the ground for restoration; lapse has to be unintentional, clearly satisfied here – would clients deliberately forego their main source of income?

Some candidates wrongly thought that if payment were made within a month of lapse no surcharge is payable.

Question 7.

The 'Official languages' of the Office are Spanish, German, French, Italian and English. Applications may be filed in any language of the Community, but a second language must be given, which must be an Official Language. Single Party proceedings are conducted in the language of filing if that is an Official Language otherwise the nominated second language (which must be an Official Language) is used. Invalidity may be filed in any Official Language, which if it is the language in which the application was filed (provided this was an Official Language) or the second (Official Language) becomes the language of proceedings, failing which the applicant for invalidity must provide a translation.

Question 8.

There was too much parroting of the conditions for protection of complex products and of "must fit" and too little application of those provisions to the facts proposed. Indeed, many candidates appeared not to have noticed that the question is directed only to the situation regarding domestic appliance parts.

The registrations for motor and aero-engine parts are of interest insofar as there may have been significant relevant modification of those parts or their visibility, so that earlier presumed registrations may either render invalid new ones for the domestic appliance parts, or already cover them. In the former aspect, note that if it were that motor or aero-engine parts are in a different field, so as not reasonably to have become known in domestic-appliance-part circles, neither registrations nor availability will affect the novelty of any registrations in the latter field,

despite the monopoly of the earlier registrations being unrestricted by designations!

Question 9.

Although many candidates recognized the possibility of invalidating Smith's registration, there was lack of clarity over the grounds which could be pleaded.

Client can allege proprietorship of:

The design

Unregistered design right

Copyright

in seeking invalidation at the Registry.

There is no specific provision enabling the Registrar to order transfer of ownership or proprietorship. The expected answer was that the client must contemporaneously apply for registration in his own name and seek invalidation of Smith's. However, a candidate who sought to rely on the fact that the court has a general discretion to rectify the register in S20 (which is not in the syllabus) would have been given due credit.

Many candidates asserted that Smith had copyright in his "graphics" despite being told in the question that they were an exact copy of client's sketches.

There was too much recitation of the rights and remedies theoretically available to client under UDR or copyright without any argumentation about how they might be applicable to the situation of the question.

And nobody asked where the original sketches had gone!

Question 10.

A fundamental problem, not discussed by many candidates, is the extent to which Midnight Blaster does in fact give the same impression as the representation in the Registered Design. Too few questioned whether Acme No 9 had actually been available before 9 May 2009; the Registration would be invalid if it had been, at least to the extent it might have been infringed. Astonishingly, some candidates thought that

there was a grace period in respect of disclosures from any source. It was also crucial to discuss whether Acme No 9 was materially different from Acme No 8 which was certainly available before that date; if there was little or no difference, once more the Registration would be ineffective against Acme No 9.

There were possible issues about unjustified threats and/or falsely claiming registration; if there was infringement was it innocent (this is not a defence) in view of the apparent absence of a number from the actual Midnight Blaster; and whether the former attorney could and should have found the registration in his search – very much a matter of timing, rather than evident negligence. These were not discussed in a well-organized way.

Question 11.

The Applicant, holder or any other party to proceedings before OHIM may apply for re-establishment of rights; and must show that i) in spite of due care in the circumstances ii) non-observance of a term resulted directly in loss of rights or means of redress. The time limits are within 2 months from removal of cause, 12 months overall. For renewal fees the 6-month extension is not counted. The application must contain the Grounds relied upon, and facts, in writing.

Question 12.

This simple memory question was carelessly answered by many, who omitted the all-important territorial element and/or forgot that it is anyone with the proprietor's consent who may use the design. On the other hand the lists of what constitute "in particular" that use were usually complete.

The section on exhaustion also showed many careless errors, including statements that there is exhaustion when the articles are put on the market, without geographical limitation or limitation regarding who did it!