

D&C – Design and Copyright

**Wednesday 1 October 2014
2.00 p.m. – 5.00 p.m.**

Time allowed – THREE hours

INSTRUCTIONS TO CANDIDATES

1. You should attempt **ten** of the twelve questions in this paper.
2. Each question carries **10** marks.
3. If more than ten questions are answered, only the first ten presented will be marked.
4. Start each question (but not each part of each question) on a fresh sheet of paper.
5. Enter the question paper reference number (D&C), the question number, and your candidate number in the appropriate boxes at the top of each sheet of paper.
6. The scripts are photocopied for marking purposes.
 - a. Use **black ink**.
 - b. Write on one side of the paper only.
 - c. Write within the printed margins.
 - d. Do not use highlighter pens on your answer script.
7. Do not state your name anywhere in the answers.
8. Write clearly: examiners cannot award marks to scripts that cannot be read.
9. Reasoning should always be given where appropriate.

INFORMATION FOR CANDIDATES

1. The total number of marks for this paper is 100.
2. At the end of the examination the invigilator will instruct you to:
 - a. count the number of pages you have used;
 - b. use the boxes on each page of the answer script to number pages in the format “1 of 25, 2 of 25 etc”;
 - c. place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3.
 - a. Do not staple the pages, or use sellotape or treasury tags.
 - b. You may take the examination paper with you.
4. This question paper consists of 7 pages in total, including this page.

Question 1

You receive the following email from a potential new client:

'I filed two UK Registered Design applications a few years ago, both of which were subsequently registered. The first was an application for a single design filed on 12 January 2009 and the second contained three designs and was filed on 6 September 2009. I'm not sure if I needed to do anything this year, and I can't find any paperwork to suggest I need to. These designs – apart from the second design of the multiple application – are important to my business and so I am contacting you for advice on what to do.'

Make notes that could form the basis of advice on the current situation, describing what action (if any) the new client needs to take, and by when, and identify any further information you need from the client.

Total: 10 marks

Question 2

ABC Limited, a UK textiles manufacturer, informs you that it has, very recently, designed a fabric with a new pattern that it is keen to protect, although it does not wish to alert its competitors to the existence of the design until it has further considered its marketing strategy. It also has a version where some of the yarns used are metallic and reflective although it says that, despite its best efforts, this is not apparent in the photographs it has taken.

- a) If ABC Limited decides to file a Community Registered Design application, what are the minimum requirements for a filing date to be granted?

3 marks

- b) What action would you recommend ABC Limited takes to protect all features of its designs at OHIM?

2 marks

- c) What fees will be payable for the application and when? (You do not need to indicate amounts.)

3 marks

- d) ABC Limited also enquires whether it has any Community unregistered design rights in the fabric.

Make brief notes on how you would advise them.

2 marks

Total: 10 marks

Question 3

You receive the following email from a potential new UK client:

'Our company designs and manufactures pencil cases. Our recent design is for a pencil case in the shape of a briefcase, and shows a city skyline silhouette. It has a black foreground against a white background, and is proving very popular – we think people like the striking difference in colour. Yesterday we were chatting to one of our competitors, who mentioned he is thinking of designing a suitcase bearing a skyline scene, although his ranges typically only use pale, pastel colours. He normally produces suitcases that can be pulled along on wheels, but this one will probably just have a handle. Please advise what Community-wide protection we have or can obtain, and whether we can take action against our competitor.'

Draft a reply, ignoring any issues relating to patents, trade marks, copyright and passing off.

Total: 10 marks

Question 4

- a) *Section 220 'Qualification by reference to first marketing'* of the UK Copyright Designs and Patents Act 1988 (CDPA) specifies the requirements for qualification by reference to first marketing.

In what circumstances will a design that originates from the US qualify under this section?

4 marks

- b) According to *Section 218 'Qualification by reference to designer'* of the CDPA, what is the requirement for qualification if a design is jointly owned by two or more persons?

1 mark

- c) Assuming the requirements for originality and qualification are met, state whether UK unregistered design right would subsist in the following and explain why:

- i. a tablecloth depicting novel Halloween characters;

1 mark

- ii. a fencing system the ends of which each comprise a male and female connector that join together to link adjacent panels;

2 marks

- iii. a cooling fan in a laptop;

1 mark

- iv. a computer generated design for an office furniture pod.

1 mark

Total: 10 marks

Question 5

- a) What is the definition of a 'Design' according to the Community Design Regulation?
2 marks
- b) How are 'Novelty' and 'Individual Character' defined in the Community Design Regulation?
4 marks
- c) What is excluded from protection for a Community Registered Design according to the Community Design Regulation? Specify any exceptions to these exclusions.
4 marks

Total: 10 marks

Question 6

- a) A local client comes to you asking for advice on protecting a new design for decorative finials for attaching to the ends of curtain poles. She explains that she exhibited her product at a trade fair in Germany in July and has since started selling it. She wants to know what protection is available in the UK, how long it will last, and any steps she now needs to take.

Make notes in preparation for advising your client, ignoring any issues relating to patents, trade marks, copyright and passing off.

8 marks

- b) Would your answer be different if, instead of exhibiting at a trade fair, your client had advertised the finials on the internet, and why?

2 marks

Total: 10 marks

Question 7

Your client contacts you about a design that she started selling in December 2013, for which she has enjoyed a reasonably successful marketing campaign over the last few months. In view of her success, she validly filed a US design patent application for her design in August 2014 as that was where she thought most of her customers would reside. The application was filed within the 12-month grace period that is available in the US. Whilst that first design remains popular, she received feedback from some customers and just last month started selling products made to a second design that includes a new feature. She also now thinks there will be interest in Europe and she asks you what her options are for obtaining Registered Design protection from OHIM for both designs. She would like to wait until Spring 2015, to benefit from additional funds generated from increased sales over Christmas 2014.

Make notes that will form the basis of your advice, setting out her options.

Total: 10 marks

Question 8

A London-based client has written a children's book and is keen to publish and market it himself, although he is worried about other people infringing his rights. With reference to the UK Copyright Designs and Patents Act 1988 (CDPA):

- a) What six acts is he exclusively entitled to do as the owner of copyright in the book?
3 marks
- b) Identify four instances in which there would be secondary infringement of copyright.
4 marks
- c) What is the definition of an 'Infringing Copy' (*section 27 'Meaning of infringing copy'*)?
3 marks

Total: 10 marks

Question 9

- a) What requirements must the applicant of a Community Registered Design application meet in order to substantiate a claim to priority from an earlier application, and what action must an applicant take to claim the priority of an earlier application after a Community Registered Design application has been filed? Include any relevant time limits in your answer.
6 marks
- b) When can a 'partial disclaimer' be used in a UK Registered Design application according to the UK Registered Designs Act 1949?
2 marks
- c) Give an example of how disclaimed subject matter can be indicated in a UK Registered Design application.
1 mark
- d) How is a 'complex product' defined in the UK Registered Designs Act 1949?
1 mark

Total: 10 marks

Question 10

You receive the following email:

'I am a sole trader and I make and sell my own jewellery on my market stall. I was shocked when, one Saturday morning, someone approached my stall and insinuated that I was selling an identical copy of one of their bracelets for which they have a UK Registered Design. He gave me a copy of the registered design which I have checked and found it is currently in force. My bracelet involves an intricate design of fine, woven strands of metal that I can assure you I painstakingly designed and developed myself in my workshop some time ago. Can you please advise whether there is any possibility I could be infringing his rights, and whether he could take legal action against me? In fact, I am so annoyed by the manner in which he approached me during trading hours, is there any action I can take against him?'

Make notes that will form the basis of your advice. Limit your discussions to UK registered design rights; do not discuss UK unregistered design rights or any other intellectual property rights.

Total: 10 marks

Question 11

- a) Your client Jane Smith is a designer who started working for Deezyne Ltd about a year ago, and she has come to you for some advice. She was offered her current job after she prepared some drawings of a product for a friend who worked at Deezyne Ltd and was impressed with her talents. Her previous employer, Conceptform Ltd, whose business is in the same field, found a Community Registered Design relating to that product whilst conducting a routine search of OHIM's database, and saw Jane Smith listed as the sole designer. Because the design relates to a product similar to their own, they are claiming that their company is entitled to the Community Registered Design.

Make notes for points to discuss with your client, and questions to ask.

6 marks

- b) Make further notes on what you would need to discuss with your client if the design was instead registered in a UK National Design Registration.

4 marks

For parts a) and b), restrict your answer to considerations of Registered Designs.

Total: 10 marks

Question 12

Your client, Kitplane Ltd, has a Community Registered Design for a model aeroplane based on the Wright brothers' first flying machine from the early 1900s. There are some differences between the two, mainly due to the vastly different sizes of the two designs. Whilst at an exhibition recently, your client noticed a stall for a company Castplane plc who were selling die cast ornaments which he said looked very similar to his model planes. He spoke to the person manning the stall at the exhibition to express annoyance and intimated he would seek advice on taking action for infringement of his rights. The Castplane representative told him he would be unsuccessful as they had simply copied the Wright brothers' plane, and not the Kitplane model, and asserted Kitplane's registration is not valid. Kitplane dismisses this and considers the Castplane ornament to be more like their design than the full scale aeroplane.

Make notes for discussion, and indicate what further information you need, on:

- a) the validity of Kitplane's registration;
- b) possible infringement of the registration.

Total: 10 marks