

FC4 (D&C) UK Patent Law
FINAL Mark Scheme 2020

In this mark scheme the following annotations will be used:

- **UDR:** Unregistered design right (UK)
- **CRD:** Community registered design
- **CUD:** Community unregistered design
- **CDR:** Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs
- **CDIR:** Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation EC No. 6/2002 Council Regulation
- **CDPA:** Copyright, Designs and Patents Act 1988
- **RDA:** UK Registered Designs Act 1949
- **EUIPO:** European Union Intellectual Property Office

Knowledge of Section/Article numbers is not required.

SECTION A

Question 1

In relation to CRDs,

- a) Set out the maximum term for deferred publication and from when it is calculated.
2 marks
- b) Explain the two stages required in the process of deferred publication, including what actions must be taken and by when.
5 marks

Total: 7 marks

Answer

- a) 30 months (1 mark) (i) from the filing date or priority date (if claimed) (1 mark) (ii)
2 marks
- b) Stage 1 – request deferred publication (1 mark) (iii) on filing (1 mark) (iv)
Stage 2 – request publication / pay publication fee (1 mark) (v) any time within 30 month period (1 mark) (vi) although request must be filed at least 3 months before the end of the 30 month period (1 mark) (vii)
5 marks

Total: 7 marks

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Question 2

- a) State who is regarded as the author of a literary, dramatic, musical or artistic work which is computer-generated. **1 mark**
- b) In accordance with the CDPA, when is an author regarded as unknown? **1 mark**
- c) Explain what is meant by a work of joint authorship. **2 marks**
- d) Describe a situation in which the author of a work is not considered to be the first owner of any copyright in the work. **3 marks**
- e) Assuming moral rights exist and are asserted, under what circumstances does the author of an artistic work have the right to be identified? **3 marks**

Total: 10 marks

Answer

- a) *The author will be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken (1 mark) (i).* **1 mark**
- b) *An author is regarded as unknown if it not possible for a person to ascertain his identify by reasonable enquiry (1 mark) (ii).* **1 mark**
- c) *A work of joint authorship means a work produced by the collaboration of two or more authors (1 mark) (iii) in which the contribution of each authors is not distinct from that of the other author or authors (1 mark) (iv).* **2 marks**
- d) *Where a literary, dramatic, musical or artistic work, or a film, is made by an employee in the course of employment (1 mark) (v), his employer is the first owner (1 mark) (vi) of any copyright in the work subject to any agreement to the contrary (1 mark) (vii).* **3 marks**
- e) *The author of an artistic work has the right to be identified whenever:*
- a) *The work is published commercially / exhibited in public / a visual image of it is communicated to the public (1 mark) (viii).*
- b) *A film including a visual image of the work is shown in public or copies of such a film are issued to the public (1 mark) (ix).*
- c) *In the case of a work of architecture, a sculpture or a work of artistic craftsmanship, copies of a graphic work representing it, or of a photograph of it, are issued to the public (1 mark) (x).* **3 marks**

Total: 10 marks

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Question 3

With regard to *Article 1C* of the *RDA*, what features of a design will not give rise to a registered design right?

Total: 3 marks

Answer

(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product's technical function (1 mark) (i).

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions (must fit) (1 mark) (ii) so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function (1 mark) (iii).

Total: 3 marks

Question 4

Explain how the term of an unregistered design right is determined in the UK and EU.

Total: 6 marks

Answer

UDR

Design right expires—

(a) fifteen years from the end of the calendar year (0.5 marks) (i) in which the design was first recorded in a design document (0.5 marks) (ii) or an article was first made to the design (0.5 marks) (iii), whichever first occurred, or

(b) if articles made to the design are made available for sale or hire (0.5 marks) (iv) within five years from the end of that calendar year (0.5 marks) (v), ten years from the end of the calendar year in which that first occurred (0.5 marks) (vi).

CUR

CUR last for three years (0.5 marks) (vii) from the date on which the design was first made available to the public (0.5 marks) (viii) within the Community (0.5 marks) (ix).

A design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed (0.5 marks) (x) in such a way that, in the normal course of business, these events could reasonably have become known (0.5 marks) (xi) to the circles specialised in the sector concerned (0.5 marks) (xii), operating within the Community.

Total: 6 marks

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Question 5

What acts, in accordance with Article 7A(2) of the RDA, would not infringe the right in a UK registered design?

Total: 6 marks

Answer

- (a) An act which is done privately and for purposes which are not commercial; (1 mark) (i)*
- (b) An act which is done for experimental purposes; (1 mark) (ii)*
- (c) An act of reproduction for teaching purposes or for the purpose of making citations; (1 mark) (iii)*
- (d) The use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom; (1 mark) (iv)*
- (e) The importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; (1 mark) (v) or*
- (f) The carrying out of repairs on such ships or aircraft (1 mark) (vi).*

Total: 6 marks

Question 6

- a) Explain the meaning of “infringing article” as defined in relation to UDR. **4 marks**
- b) Explain what is meant by exhaustion of rights in relation to a CUD. **4 marks**

Total: 8 marks

Answer

- a) *An article is an infringing article if its making to a design was an infringement of design right in the design (1 mark) (i).*
An article is also an infringing article if—
 - (a) it has been or is proposed to be imported into the United Kingdom (1 mark) (ii), and*
 - (b) its making to that design in the United Kingdom would have been an infringement of design right in the design (1 mark) (iii) or a breach of an exclusive licence agreement relating to the design (1 mark) (iv).*

4 marks
- b) *The rights conferred by a Community design shall not extend to acts relating to a product (1 mark) (v) in which a design included within the scope of protection of the Community design is incorporated or to which it is applied (1 mark) (vi), when the product has been put on the market in the Community (1 mark) (vii) by the holder of the Community design or with his consent (1 mark) (viii).*

4 marks

Total: 8 marks

SECTION A Total: 40 marks

SECTION B

Question 7

In 2017, Woosie developed its first baby seat (seat 1) and registered CRD1 on 1 May 2017 to protect the design. Seat 1 was first sold in June 2017. Woosie continued to develop the baby seat and registered CRD2 to protect the design of its second baby seat (seat 2) on 2 November 2019. Seat 2 was first sold in January 2020.

CRD1 was filed with Computer Aided Design (CAD) drawings which depict seat 1 in grey. However, seat 1 was only sold in white. CRD2 was filed with black and white line drawings and included no shading or colour. Seat 2 was sold in grey and white.

Seat 1 and seat 2 included some common features and some differences. The common features included the shape of the base of the seat, the height of the back of the seat, the angle of the arms of the seat and a rim forming a handle around the edge of the seat. The main differences were the shape of the back of the seat, which was more rounded in seat 2, and the style of the arms of the seat, which were thicker in seat 2.

In March 2020, TotsRUs launched their new baby seat (TotSeat) which has a narrower and taller back than either of seat 1 or seat 2, a different shape of base than seat 1 or seat 2 and a slot forming a handle instead of a rim. The TotSeat was only sold in white.

- a) **Woosie has approached you for advice on enforcing their CRDs against TotsRUs. Write notes outlining points you need to discuss with Woosie. Include considerations of validity and scope of protection as well as infringement.**

14 marks

- b) **Consider whether any parts of seat 1 or seat 2 might give rise to UDR and what criteria would be required for the TotSeat to infringe such UDR. Assume that Woosie meets the qualification requirements for UDR.**

6 marks

Total: 20 marks

Answer

- a) *CRD1*

Up to 3 marks for a reasonable discussion. For example,

Registered 1 May 2017 – initial term is 5 years (0.5 marks) (i) so at least in force until 1 May 2022 (0.5 marks) (ii).

No mention of prior art so assume design is new (0.5 marks) (iii) and has individual character (0.5 marks) (iv).

Filed with grey CAD drawings so protection may be limited by colour grey (0.5 marks) (v).

As seat 1 is only sold in white it is arguable that seat 1 is not covered by CRD1 (0.5 marks) (vi).

However, on the basis of the information available, CRD1 appears valid (0.5 marks) (vii).

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CRD2

Up to 8 marks for a reasonable discussion. For example,

Registered 2 November 2019 – initial term is 5 years so at least in force until 2 November 2024 **(0.5 marks) (viii)**.

CRD2 was filed with black and white line drawings so should cover any colour of seat **(0.5 marks) (ix)**.

Not clear when CRD1 was first published **(0.5 marks) (x)** but seat 1 was first sold in June 2017 so seat 1 in public domain at least since then **(0.5 marks) (xi)**.

CRD2 filed more than 12 months after publication of seat 1 in June 2017 **(0.5 marks) (xii)** so outside grace period from first disclosure **(0.5 marks) (xiii)**. Therefore seat 1 is prior art against CRD2 **(0.5 marks) (xiv)**.

To be valid, CRD2 must be new and have individual character at least over seat 1 **(0.5 marks) (xv)**.

Seat 2 has some differences (more rounded back and thicker arms) over seat 1 so not identical to seat 1 **(0.5 marks) (xvi)**. If differences are not immaterial, seat 2 is new with respect to seat 1 **(0.5 marks) (xvii)**.

For individual character, seat 2 must create a different overall impression **(0.5 marks) (xviii)** on an informed user **(0.5 marks) (xix)**. The informed user is generally framed as having a level of knowledge about the product in question which is in between an ordinary user and an expert **(0.5 marks) (xx)**.

Weighing up the similarities and differences between seat 2 and seat 1, discuss a possible outcome **(0.5 marks) (xxi)**. For example, it may be hard to convince a judge that seat 2 has individual character over seat 1 / seat 2 may be distinguished enough from seat 1 to have individual character **(0.5 marks) (xxii)**.

Accordingly, CRD2 may be invalid / valid **(0.5 marks) (xxiii)**.

Infringement

Up to 3 marks for a reasonable discussion. For example,

The scope of protection of a CRD includes any design which does not produce a different overall impression on the informed user **(0.5 marks) (xxiv)**.

In assessing the individual character, the degree of freedom of the designer is taken into consideration **(0.5 marks) (xxv)**.

The TotSeat has a different back, base and handle to CRD1 and CRD2. These features may/may not be enough to produce a different overall impression **(0.5 marks) (xxvi)** so that the TotSeat may/may not infringe either of CRD1 or CRD2 (if valid) **(0.5 marks) (xxvii)**.

In addition, the TotSeat is white and CRD1 is in grey **(0.5 marks) (xxviii)**. This would further differentiate the overall impression and therefore it seems unlikely that the TotSeat would infringe CRD1 **(0.5 marks) (xxix)**.

14 marks

b) **Up to 6 marks for a reasonable discussion. For example,**

Any original features **(0.5 marks) (xxx)** of the shape or configuration **(0.5 marks) (xxxi)** of the whole or part **(0.5 marks) (xxxii)** of seat 1 or seat 2, which are not commonplace **(0.5 marks) (xxxiii)**, may give rise to UDR.

The colour of seat 1 or seat 2 would not result in UDR **(0.5 marks) (xxxiv)** as surface decoration is excluded from UDR protection **(0.5 marks) (xxxv)**.

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In seat 1, UDR may subsist in at least (0.5 marks) (xxxvi) the shape of the base of the seat, the height of the back of the seat, the angle of the arms of the seat and the rim forming a handle around the edge of the seat (0.5 marks) (xxxvii).

In view of seat 1, the only potentially original features (0.5 marks) (xxxviii) in which UDR may subsist in seat 2 are the shape of the back of the seat (0.5 marks) (xxxix), which was more rounded in seat 2, and the style of the arms of the seat (0.5 marks) (xxxx), which were thicker in seat 2.

If TotsRUs copied any of the features having UDR exactly or substantially it would infringe (0.5 marks) (xxxxi).

6 marks

Total: 20 marks

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Question 8

Your client, Skool-Me, has created a new educational application “App” for home-schooling, which is accessible via a smartphone, tablet or computer. The App was launched in January 2020 and contains purpose-made content in the form of pictures, photographs, stories and worksheets for a range of different class subjects (e.g. Literary, Numeracy, Art, History, etc.). The App is bright and colourful and full of digital images to engage a child of primary school age. There is also a consistent screen layout throughout such that for each class subject there is an area for text, an area for pictures and an area for worksheets. Each area is presented within a distinctive cloud-shape. The worksheets are available as interactive online pages and can also be printed for completion offline. Navigation within the App is by way of a gently curved rainbow-coloured ribbon along the top of the screen, and each colour in the rainbow is labelled for access to a different class subject. When a subject is selected, the cloud-shapes turn the colour corresponding to that subject in the rainbow-coloured ribbon and the content is provided on the coloured cloud-shaped backgrounds. The layout and the class subjects remain constant, but the content is refreshed every week.

- a) **Explain how each of the various different parts of the App might qualify as a copyright work.** **6 marks**
- b) **State the duration of copyright protection in each case and how this is affected if the author is unknown or if the work is computer-generated.** **4 marks**

Total: 10 marks

A competitor, EdYOUcation, launched a very similar educational website in April 2020. Both Skool-Me and EdYOUcation are aimed at UK school curriculums.

- c) **Advise Skool-Me on the points that would need to be considered for infringement of their copyright and what remedies would be available.** **7 marks**

Skool-Me are considering applying for some registered design protection in the UK and EU to supplement their copyright protection. However, they have a limited budget for this.

- d) **Advise Skool-Me on a benefit that registered design protection could offer over copyright protection and outline which parts of the App you would advise Skool-Me to consider registering and why.** **3 marks**

Total: 20 marks

Answer

- a) ***Up to 6 marks for a reasonable discussion on the different parts of the App. For example,***

App Code – this may qualify for copyright protection as a literary work (0.5 marks) (i)

Pictures/Digital Images – these may qualify for copyright protection as forms of artistic/graphic works (0.5 marks) (ii)

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Photographs – these may qualify for copyright protection as forms of artistic works (0.5 marks) (iii)

Stories - these may qualify for copyright protection as forms of literary works (0.5 marks) (iv) e.g. if they are written (0.5 marks) (v)

Text/content - may qualify for copyright protection as forms of literary works (0.5 marks) (vi) e.g. which are written (0.5 marks) (vii)

Worksheets (interactive online pages or printed) – depending on the content of the worksheets, these may qualify for copyright protection as artistic/graphic work (0.5 marks) (viii) and/or literary works/typographical arrangements (0.5 marks) (ix)

Screen layout inc. separate areas for text, pictures and worksheets - this may qualify for copyright protection as an artistic/graphic work or typographical arrangement (0.5 marks) (x)

Distinctive cloud-shapes (inc. colours) - these may qualify for copyright protection as an artistic/graphic work (0.5 marks) (xi)

Gently curved rainbow-coloured ribbon with each colour in the rainbow labelled for access to a different class subject - this may qualify for copyright protection as an artistic/graphic work (0.5 marks) (xii)

6 marks

b) Up to 4 marks for a reasonable discussion on duration. For example,

Copyright in literary and artistic works expires at the end of the period of 70 years (0.5 marks) (xiii) from the end of the calendar year in which the author dies (0.5 marks) (xiv).

If the author is unknown copyright expires—

(a) at the end of the period of 70 years (0.5 marks) (xv) from the end of the calendar year in which the work was made (0.5 marks) (xvi), or

(b) if during that period the work is made available to the public (0.5 marks) (xvii), at the end of the period of 70 years from the end of the calendar year in which it is first so made available (0.5 marks) (xviii),

If the work is computer-generated the above provisions do not apply and copyright expires at the end of the period of 50 years (0.5 marks) (xix) from the end of the calendar year in which the work was made (0.5 marks) (xx).

4 marks

c) Up to 5 marks for a reasonable discussion on infringement. For example,

The owner (0.5 marks) (xxi) of the copyright in a work has the exclusive right (0.5 marks) (xxii) to do the following acts in the United Kingdom—

(a) to copy the work (0.5 marks) (xxiii)

(b) to issue copies of the work to the public (0.5 marks) (xxiv)

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We need to check if Skool-Me was the actual owner (0.5 marks) (xxv) of the copyright in each work. This seems likely for at least the content (0.5 marks) (xxvi) as we are told that the content is purpose-made. However, we would need to check whether a website designer, for example, owns the copyright in the code/screen layout (0.5 marks) (xxvii).

We also need to consider whether any of the copyright works have been copied (0.5 marks) (xxviii) - as a whole or any substantial part of it (0.5 marks) (xxix).

Copyright in a work is infringed by a person who without the licence of the copyright owner (0.5 marks) (xxx) does, or authorises another to do, any of the acts restricted (0.5 marks) (xxxi) by the copyright.

Up to 2 marks for a reasonable discussion on remedies. For example,

In an action for infringement of copyright all such relief by way of damages (0.5 marks) (xxxii), injunctions (0.5 marks) (xxxiii), accounts (0.5 marks) (xxxiv) or otherwise is available to the plaintiff as is available in respect of the infringement of any other property right (0.5 marks) (xxxv).

7 marks

d) *Up to 3 marks for a reasonable discussion. For example,*

No need to prove copying (0.5 marks) (xxxvi) for infringement of registered designs.

To be most cost-effective, Skool-Me should consider registering the unchanging features (0.5 marks) (xxxvii) of the App as opposed to the content. This includes the screen layout (0.5 marks) (xxxviii); the distinctive cloud-shapes (0.5 marks) (xxxix) and the gently curved ribbon (0.5 marks) (xxxx).

The broadest protection will be obtained by filing black and white line drawings (0.5 marks) (xxxxi) although colours could be included to add distinctiveness (0.5 marks) (xxxxii).

They may also register the animation whereby the rainbow is used to change the colour of the cloud-shapes (0.5 marks) (xxxxiii).

3 marks

Total: 20 marks

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Question 9

You hold an initial meeting with a new UK client, KoffiKup, about a new coffee machine design which was first marketed by them in the UK in 2018. The coffee machine was designed by an Israeli company specifically for the UK market and KoffiKup have an exclusive licence to sell the coffee machine in the UK. However, a competitor, HotShot has just launched a similar coffee machine in the UK and KoffiKup suspect that HotShot have copied their coffee machine design.

The KoffiKup coffee machine has a distinctive bubble-like body and every element of the machine, including all the buttons, have a bubble-shape. In addition, the body of the coffee machine has a bubble design printed on its outer surface.

No registered design rights have been applied for in relation to KoffiKup's coffee machine.

- a) **Explain the qualification requirements for UDR and discuss whether KoffiKup's coffee machine may meet these requirements.**
12 marks
- b) **Define the requirements that design features must meet for UDR and CUD to subsist and discuss whether any UDR and CUD may subsist in any aspects of the design of KoffiKup's coffee machine.**
6 marks
- c) **Identify which acts, if performed by HotShot, would constitute primary infringement of UDR.**
2 marks

Total: 20 marks

Answer

- a) **Up to 12 marks for a reasonable discussion. For example,**

A design will qualify for UDR if:

- i) the designer (0.5 marks) (i) is a qualifying person (0.5 marks) (ii); or*
- ii) it is created in the course of employment (0.5 marks) (iii) with a qualifying person (0.5 marks) (iv).*

A qualifying person is defined as:

- a) An individual habitually resident (0.5 marks) (v) in a qualifying country (0.5 marks) (vi); or*
- b) A body corporate (0.5 marks) (vii) or other body having legal personality which –*
 - (i) is formed under the law of a part of the United Kingdom or another qualifying country (0.5 marks) (viii), and*
 - (ii) has in any qualifying country a place of business at which substantial business activity is carried on (0.5 marks) (ix).*

A qualifying country is—

- (a) the United Kingdom (0.5 marks) (x),*
- (b) a country by virtue of an Order under section 255 (0.5 marks) (xi),*
- (c) a member State of the EU (0.5 marks) (xii), or*

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(d) to the extent that an Order under section 256 so provides, a country designated under that section as enjoying reciprocal protection (0.5 marks) (xiii).

If neither of the above applies, a design may qualify for UDR if the first marketing of articles made to the design (0.5 marks) (xiv) is by a qualifying person (0.5 marks) (xv) and takes place in the UK, EU or other country by a relevant Order (0.5 marks) (xvi).

In this case, the coffee machine was designed by an Israeli company. However, Israel is not a qualifying country (0.5 marks) (xvii) so it cannot qualify on the basis of the employer (0.5 marks) (xviii).

We do not know whether the designer is a qualifying person (0.5 marks) (xix) but as the designer appears to have been employed by the Israeli company (0.5 marks) (xx) the design does not qualify for UDR by reference to the designer (0.5 marks) (xxi).

If the first marketing of the coffee cup by KoffiKup in the UK was the first marketing of articles made to the design (0.5 marks) (xxii), the design would qualify for UDR (0.5 marks) (xxiii) with reference to KoffiKup which is a UK company and therefore a qualifying person (0.5 marks) (xxiv).

12 marks

b) UDR

Up to 4 marks for a reasonable discussion. For example,

UDR subsists in original designs (0.5 marks) (xxv).

A design is defined as the shape or configuration (0.5 marks) (xxvi) (whether internal or external) of the whole or part of an article (0.5 marks) (xxvii).

UDR does not subsist in—

(a) a method or principle of construction,

(b) features of shape or configuration of an article which—

(i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function (must fit) (0.5 marks) (xxviii), or

(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part (must match) (0.5 marks) (xxix), or

(c) surface decoration (0.5 marks) (xxx).

A design is not “original” if it is commonplace in the design field in question at the time of its creation (0.5 marks) (xxxi).

Thus, UDR may subsist in aspects of the shape of the coffee machine (including the buttons) but not its surface design (0.5 marks) (xxxii).

CUD

Up to 2 marks for a reasonable discussion. For example,

CUD may subsist in the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation (0.5 marks) (xxxiii).

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A design shall be protected by a Community design to the extent that it is new (0.5 marks) (xxxiv) and has individual character (0.5 marks) (xxxv).

Thus, CUD may subsist in aspects of the shape (including the buttons) and surface decoration of the coffee machine (0.5 marks) (xxxvi).

6 marks

c) Up to 2 marks for a reasonable discussion. For example,

The owner of UDR has the exclusive right to reproduce the design for commercial purposes—

(a) by making articles to that design (0.5 marks) (xxxvii), or

(b) by making a design document recording the design for the purpose of enabling such articles to be made (0.5 marks) (xxxviii).

Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design (0.5 marks) (xxxix).

Design right is infringed by a person (e.g. HotShot) who without the licence of the design right owner does, or authorises another to do, anything which by virtue of this section is the exclusive right of the design right owner (0.5 marks) (xxxx).

2 marks

Total: 20 marks

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Question 10

Your client, Ava, has designed a wooden spoon with a distinctive decorative pattern etched into the handle. She intends to apply the same pattern to a number of spoons in a sterling silver cutlery set, for example, a teaspoon, soup spoon and tablespoon. Each spoon will have a different shape but all will incorporate the distinctive decorative pattern on the handle (these are referred to collectively as the spoon designs). She would like protection for the spoon designs in the UK, France, Germany, USA, China and Japan, minimising the initial cost as she is awaiting funding which is expected in the next 3 months.

- a) **Explain the options for seeking protection in the countries of interest and the pros and cons associated with each option. Bear in mind the number of designs that may need to be filed to provide maximum protection.**

12 marks

- b) **Ava has heard that some countries have a grace period for filing a design application after the design is disclosed. Advise Ava on whether she is safe to rely on the grace period in view of her ambitions for her designs.**

2 marks

Ava is employed by Designeroo in the UK as a graphic designer and first created the wooden spoon design when Designeroo asked her to do so. As Designeroo have never been interested in making sterling silver cutlery, Ava decided to create the rest of the spoon designs in her own time and has filed an initial CRD application including all of the spoon designs, in her own name.

- c) **Advise Ava on the ownership of the spoon designs and whether any of the CRDs may be invalidated on this basis.**

3 marks

Ava's funding has fallen through and she decides to sell all of the spoon designs and associated rights to Designeroo to take them forward.

- d) **Explain what is required to transfer the spoon designs to Designeroo and update the Register of Community Designs.**

1 marks

Designeroo would like to use the distinctive decorative pattern, created by Ava, on other products for sale in the UK and several other countries. However, they do not wish to file any more registered design applications.

- e) **What rights might Designeroo have in the distinctive decorative pattern in the UK and overseas?**

2 marks

Total: 20 marks

Answer

- a) **Up to 9.5 marks for a reasonable discussion of the options. For example,**

Priority

To minimise initial costs file in e.g. UK first (0.5 marks) (i) then file Paris convention applications e.g. in each of France, Germany, USA, China and Japan (0.5 marks) (ii),

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claiming priority from the first application, within 6 months from the first filing date (0.5 marks) (iii).

Option 1

File national applications in each country of interest (0.5 marks) (iv)

Pros: Can tailor applications to suit requirements in each country (0.5 marks) (v);

Cons: Most expensive option (0.5 marks) (vi); need local representation in each country (0.5 marks) (vii); time-consuming/hassle to manage multiple applications (0.5 marks) (viii)

Option 2

Similar to option 1 but file EU application to cover UK, France and Germany (plus other EU states) (0.5 marks) (ix).

Pros: Can tailor applications to suit requirements in EU, USA, China and Japan (0.5 marks); EU more cost effective than multiple individual EU countries (0.5 marks) (x) and provides unitary right so easier to manage (0.5 marks) (xi);

Cons: EU is a unitary right so can be invalidated centrally (0.5 marks) (xii)

Option 3

File a Hague international application (0.5 marks) (xiii) and designate EU (or UK, France and Germany separately), USA and Japan (0.5 marks) (xiv).

Still need to file separately in China as China is not a member of the Hague Agreement (0.5 marks) (xv).

Pros: Hague more cost effective than multiple individual applications (0.5 marks) (xvi) and can be managed centrally (0.5 marks) (xvii);

Cons: Difficult to tailor Hague application for best protection in each of EU, USA and Japan (0.5 marks) (xviii); need local representation for China and also local representation if a Hague designation issues a refusal (0.5 marks) (xix)

Up to 2.5 marks for a reasonable discussion on the number of designs. For example,

Multiple designs can be included in a single application in some countries (e.g. UK/EU/Hague) (0.5 marks) (xx).

EU/Hague allow multiple designs in a single application as long as they are in the same Locarno classification (0.5 marks) (xxi) so all spoon designs could be included in a single application (0.5 marks) (xxii).

In some countries separate applications may be required for each design (0.5 marks) (xxiii) or to protect the distinctive decorative pattern independently of the spoon designs (0.5 marks) (xxiv).

12 marks

b) Up to 2 marks for a reasonable discussion. For example,

Although some countries like UK, EU and USA at least have a 12 month grace period (0.5 marks) (xxv) in which a designer may disclose a design before filing a registered design application (0.5 marks) (xxvi), some countries like China do not (0.5 marks) (xxvii). The safest approach is therefore not to rely on the grace period (0.5 marks) (xxviii).

2 marks

c) Up to 3 marks for a reasonable discussion. For example,

As Ava created the wooden spoon design as part of her employment (0.5 marks) (xxix), it is likely that her employer Designeroo is the first owner (0.5 marks) (xxx) of the wooden spoon design, subject to any agreement to the contrary.

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Discussion of silver spoon designs, e.g. as Ava created the sterling silver spoon designs in her own time it is likely that she is the first owner of these spoon designs / unless silver spoon shapes distinct themselves, application of the pattern on the silver spoons designs may belong to Designeroo (0.5 marks) (xxxii).

A CRD may be invalidated (0.5 marks) (xxxii) if, by virtue of a court decision, the right holder is not entitled to the Community design (0.5 marks) (xxxiii). Accordingly, (at least) the wooden spoon CRD is vulnerable to invalidity (0.5 marks) (xxxiv).

3 marks

- d) **Up to 1 mark for a reasonable discussion. For example,**
An assignment, in writing, should be executed (0.5 marks) (xxxv) to transfer the rights in the spoon designs to Designeroo. A request should be made to the EUIPO to record the transfer on the register (0.5 marks) (xxxvi).

1 mark

- e) **Up to 2 marks for a reasonable discussion. For example,**
If the distinctive decorative pattern is an original work (0.5 marks) (xxxii), UK copyright may subsist in it as an artistic work (0.5 marks) (xxxiii). Under the Berne Convention, other signatory countries would grant the same rights as they allow their own nationals (0.5 marks) (xxxix) so copyright may also subsist in those other countries (0.5 marks) (xxxx).

CUD may also subsist in the distinctive decorative pattern as surface decoration is provided such protection (0.5 marks) (xxxxi).

2 marks

Total: 20 marks