

Examiner's
use only**Question 1**

- a) Request deferment when filing community design (at time of filing) ✓0.5c

File a representation suitable for reproduction, or if the design is a 2D design, file a specimen of that design. ✓0.5i

+ pay deferment fee. ✓0.5d (publication fee optional at this stage)

Deferment can be for up to 30 ✓0.5a months from priority date or filing date if no priority is claimed. ✓0.5b

A publication fee ✓0.5g and a representation suitable for reproduction (i) must be filed 3 months before ✓0.5e the end of the 30 month period or 3 months ahead of requested publication if earlier. ✓0.5f

A request for publication must also be filed within this time period

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- b) Deficiency of a publication request is sent if fees + request for publication (and any specimens required) is not made before the end of the 3 month period. Time period for doing these requests is before the end of 30 month ✓0.5h period from priority date. If this deficiency is not done, application will be deemed never to have existed.

4.5

MARKS AWARDED 4.5/6**Question 2**EXEMPTIONS OF INFRINGEMENT

- 1) a private ✓ or non-commercial ✓ use
- 2) experimental purposes ✓1
- 3) teaching ✓ purposes or for the purpose of making citations ✓ provided it is compatible with fair trade practise, ✓
 - does not exploit the design prejudicially and ✓
 - mention is made of the source. ✓

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This relates to, without license, reproducing the design exactly or substantially by

- making an article to that design
- making a design document for the purposes of making an article to that design for the above purposes 1, 2, 3 and without licence.
- importing into the UK
- for sell or hire, offer or expose when they know or have reason to believe UDR exists the design for the purposes in 1), 2) and 3)

Any of these acts not done for 1, 2, 3 would infringe UDR.

It is also not an infringement of any UDR to do anything which would be an infringement of copyright.

→ will not infringe UDR if you have consent for the above acts or if you have a license to do the above acts . for purposes not relating to 1), 2) and 3)

4

MARKS AWARDED 4/5

Question 3

The applicant can restore his rights within 2 months ✓1e from the obstacle preventing completion of the act, provided it is within 1 year ✓0.5h maximum of the missed deadline (6 months from the end of the grace period if renewal) and failure to do the act (ie. pay renewal fee) was in spite of all due care ✓1c

Apply for restitutio → form + restitutio ✓0.5a fee within 2 months with a statement of grounds ✓0.5j and evidence ✓0.5k that failure to pay was in spite of all due care. Also, carry out omitted act ✓0.5l (pay renewal fee ✓0.5n + late fee ✓0.5n) within that 2 month period. Due care relates to actions of the proprietor and of any legal representative. It is quite strict/high threshold.

If the application for restitutio is accepted, design will be treated as if it had never lapsed. However this can be opposed within 2 months.

If refused, the design rights remain lapsed, renewal fee refunded.

If in the period between lapse and application for restitutio:
someone uses the design or makes serious and effective preparations to use
the design and they did so in good faith, they are entitled to continue using
this act but will not be able to license this right.

They will however be able to assign this right with a business.

If the acts were done in the grace period were application fee could still be
paid (i.e. the 6 month grace period) or is a continuation of an earlier infringing
act it is considered to be infringement.

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MARKS AWARDED 5.5/9

Question 4

- a) 1) file a community design registration and a US national design
registration (at same time ✓, or within 6 months ✓ of the other)
- 2) file a International Design Registration (Hague agreement) designating
both the EU and the US ✓
- 3) file a International Design Registration designating EU and
file a national design registration in the US
at the same time, or one 6 months 3 later that the other ✓

Advantages

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- administratively simpler ~BOD
- renewal fees paid in one action
- Only requires one agent if
there are no objections from
national offices.

Disadvantages of filing strategy 2)

- will take longer to register for EU
- cannot defer publication in EU
since (US does not allow for
deferment) + US is designated
- some subject matter not
allowed in US jurisdiction which
is allowed in EU + vice versa.
- Expensive

4

MARKS AWARDED 4/4

Question 5

Design right (UDR) does not subsist

- 1) if not original (i.e. aspects of the article are commonplace in a qualifying country at the time of recordal)

UDR only subsists when recorded either in a design document or an article is made to that design

UDR = unregistered design right

A UDR protects the shape and configuration of the whole or part of any article

→ (either internal or external)

Exclusions → does not subsist

In any

Method or principle of construction ✓0.5a

“Must-fit”, i.e. parts of an article that must be connected to, ✓0.5d placed in, around or ✓0.5e against another article so that either article can perform its function, ✓0.5f

“must-match” ✓0.5 - i.e. part of an article that is dependent on the appearance of ✓0.5 another article which is integral ✓0.5j to the overall design.

– surface decoration (including colour) ✓1k

NO exclusions for technical functions

or non-visible parts of a components

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MARKS AWARDED 4.5/6

Question 6

- a) Not actionable

→ relates to “primary infringement” → the threat alleges to making an article.

threats relating to making or importing articles are non-actionable ✓

- b) NOT actionable if the manufacturer has done or intends to do an act of infringement making or importing. It then covers any other forms of infringement (e.g. selling). ✓

Actionable, otherwise unless the threat was via a permitted communication

→ (i.e. if he was not manufacturing that product)

- c) Actionable as threat is made to someone selling the goods ✓ (not making/importing).

However, may not be actionable if done via a permitted communication.

- d) Not-Actionable
since threats are not actionable if it relates to an allegation of intending to import a product ✓

Which is a form of primary infringement.

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MARKS AWARDED 4/4

Question 7

17 April 2018 was date of filing

- i) 17th April 2023 renewal fee is due +
grace period ends 17th October 2023 ✓✓

first renewal due on 5yr anniversary after filing . can be paid up to
6 months before + can be paid in 6 months afterwards plus late fee.

- ii) renewal fee due
30th April 2018 (the last day of the ✓ month in April)
for a community design

grace period ends 30th October 2018 (6 months from end of the due date)

- b) – uncertainty over Brexit ! ✓
– more representations can be filed at UK office for designs (greater protection), 12 at UKIPO and 7 at EUIPO.
disclaimers can be filed with UK registration but not with a community registration. This may provide greater protection

2.5

MARKS AWARDED 2.5/3

Question 8

An exclusive licensee has the same rights and remedies as if he was the copyright owner/if he had been assigned the copyright (except against the copyright owner) ✓

- The rights of the exclusive licensee are concurrent with that of the copyright ✓ owner.
- The exclusive licensee may avail himself of the same defences as the copyright owner in any action
- ∴ can bring infringement proceedings
seek the same remedies (e.g. damages, account of profits) as the copyright ½ owner

2.5

MARKS AWARDED 2.5/3**Question 9**

a) Jill is an artist

The paintings are a form of artistic work ✓0.5e protected by copyright.

The owner of copyright is anyone who creates the work (the author) unless the works were created in the course of employment. The employer then owns the copyright.

For the paintings done when she worked at a studio → the copyright will belong to her ex-employer without any other agreement to the contrary.

✓1d

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For the paintings done while she is at home (home-created), she will be the owner of the copyright. ✓0.5c

Any copyright subsists 70 years from the end of the year in which Jill dies.

✓1e

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This gives her the right to use her works exclusively. For the following acts ✓1f

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- copy
- issue copies to public
- perform, show, play to public

- communicate to the public
- make adaptations
- rent or lend to the public.

9b) Jill has several options when working with Joe.

Firstly, she could retain all her rights and give Joe consent to commercialise her work.

She could also license ✓0.5h her work to Joe. She can set the terms of the license for what Joe can and cannot do. She would still be able to deal in her own work unless it is an

→ exclusive license. ✓1m ✓1h This would mean Jill would not be able to do the same acts licensed to Joe. However, any license can also be **one unclear word** in duration meaning her rights would be maintained after the duration passes.

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A license has to be made in writing and signed by the licensor.

→ that is a partial license, for all acts that Jill has exclusive rights for, or only some of ✓1l the acts (e.g. putting on the market)

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She could also assign ✓0.5p her rights to Joe. This can be a partial assignment for some but not all the rights Joe is allowed to do. She could retain some rights, for example, showing in public.

Alternatively, she could assign all her rights in the copyright to Joe.

All assignments have to be in writing and signed by the assigner.

Regardless of the rights in copyright ,that is,

- copy
- issue copies to the public
- rent or lend to the public
- perform, show, play in public
- communicate in public
- make an adaptation

Which she may consent Joe to do,
license to Joe or
assign to Joe

Jill still will have moral rights in her work, that is the right:

- to be identified (if asserted) and
- to object to derogatory treatment of the work.

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9c) Jill as the copyright owner has an exclusive right to

✓1f

- copy
 - issue copies
 - rent or lend
 - communicate
 - perform, show or play
 - adaptation of works
- } ← if asserted

She also has the right to be identified and object to derogatory treatment of the work

Copying the work means reproducing the work in any material form as long as it is all the work or a substantial part, directly or indirectly.

In this case, It depends to what extent the artistic work was copied. If it is indeed a copy of Jill's work, there is infringement.

A painting into a landscape print is a copy (→ any since material form)

If the work has been copied, The work us being issued and shown to the public. Which is an infringing act.

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→ However it may be an original work done by her ex-employee or owned by her employer in which she does not own the copyright

In this case she has no rights.

This also depends on any acts Joe was allowed to do by agreement.

If Joe is allowed, no infringement of those acts

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unauthorised acts ∴ include person who copied work

and shop issuing copies/showing work to public if they knew or had reason to believe it was an infringing copy. If no agreement with Joe, can bring infringement proceedings for those acts. ✓0.5o

Jill also has the moral rights to be identified and object to derogatory treatment on any works for which she was author. This includes when artistic work is published commercially, issued or communicated to the public or exhibited. The identification should be clear + reasonably prominent.

If this is a copy of her work (see discussions above) her rights are infringed as the painting is said to be by her ex-employee can therefore bring action against ex-employee since her rights are being infringed.

She also has rights to object to derogatory treatment, but no evidence of this taking place in this scenario.

unless the work has been added to, deleted from, altered or adapted in a way that is prejudicial to the honor and repute of Jill's work.

If so, her rights are also infringed by this work being shown/communicated in public.

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MARKS AWARDED 8.5/20**Question 10**

a) Nicky may have a cause of action against Tara if

- the UK registered design is in force ✓1b
- she has done an infringing act in the UK, i.e., using articles made to the design without the proprietor's (Nicky) consent in Tara's shops

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only if Tara's scoreboard has the same overall impression on the informed user ✓1c as Nicky's design.

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This takes into account the degree of freedom in the design and any partial disclaimers in Nicky's registered design (for example, the texts on the display). e.g. top-ten chart

The fact that Nicky's UK reg. design is for different purpose (may be in a different class of goods) is irrelevant as class is not limiting.

However the informed user may be different for each shop's customers.

- b) Tara has prior user rights for acts done for a particular purpose, or serious and effective preparations for any acts, were done by Tara before the priority date of the registration in question. This means that Tara can continue to do these acts, provided they were not copied from the registered design in question.

Tara may only have the rights to continue the use of scoreboards as she was before the priority date and this may not include any expansion (e.g. use in her latest store + publication) unless serious + effective preparations were made ahead of the priority date

She cannot license this right but she can assign the right with the business.

- c) Tara may have a defence to infringement ∴ innocent infringement if she had no knowledge or reason to believe ✓0.05m that a design right existed.
✓0.5l

mere marking on a product is not sufficient for awareness, unless she can show that the marking included a registration number or a relevant internet link where

- i) the link is free of charge and
- ii) clearly associates product with registration number.

If Tara can demonstrate innocent ✓0.5o infringement, she is not liable to pay damages

→ she also has a prior use defence.

→ she can also seek to invalidate Nicky's design if her design was made available to the public in Tara's shop before the priority date of the design ✓1p in question since Nicky's design would lack novelty and individual character over Tara's design.

Made available to public = published, exhibited, used in trade or otherwise disclosed.

→ Tara already used this design in trade.

Also is dependent on design reasonably being known in the normal course of business in specialist circles within the EEA.

If used in shops nationwide, since both users work in retail.

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- d) Tara will have committed a criminal act ✓0.5t if she copied intentionally Nicky's design ✓0.5r exactly or differing only in immaterial details + used, exported, imported, put on the market, Offered made or stocked for those purposes

This is unlikely as the displays were provided by Abigail. However, She did use - and stock the design. ✓1r

If she was aware:

She will be liable to either a conviction on indictment → up to 10 years, a fine or both or

a - summary conviction up to 3 months, a fine, or both.

- e) can bring proceedings for an actionable ✓0.5t threat if she is aggrieved by the threat ✓0.5x and the threat was not a permitted communication - since Tara is not making or importing the ✓01y design. (acts which are non-actionable)

Not actionable if for permitted purpose i.e.

→ a design right exists

→ trying to find out information about primary infringement

→ she has rights under the design

Actionable if:

→ she requests any undertaking

→ requests Tara to stop use

→ requests here to deliver up or destroy the design.

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MARKS AWARDED 8.5/20

Question 11

- a) In order to register a European design the application requires the following for filing date to be accorded
- information identifying applicant
 - request for a community design
 - a representation capable of reproduction or if 2D, a specimen for that design.

In order to be registered the following things are also required

- an indication of product
- a registration fee and either a
- publication fee or a deferment fee.

and further publication/registration fees for any additional designs.

In this case, new representations should be filed as soon as possible. Only when these are received will a filing date be accorded. ✓ (Which will be the date of receipt). This must be done at the latest by the date specified on the notification, otherwise application will be refused.

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Roisin also needs to pay the appropriate fees. ✓ These are due 2 months' from the notification and a late fee must also be filed.

:1

If this is not done, she will be unable to register the designs for which the funds were insufficient (∴ the 2nd + 3rd designs)

- b) priority for a community design application can be claimed up to 6 months ✓ from an earlier application ✓ in a convention country provided the application is the same proprietor or successor in title, and relates to the same design & provided the earlier application is the first application relating to this design.

Republic of Ireland is a convention country.

Roisin is the same proprietor and she intends to register the same designs. She filed the earlier application less than 6 months ago, therefore priority can be claimed if she is accorded a date of filing in her European application by 9th October 2018. ✓ She therefore is advised to file new representations of her designs ahead of this date.

Priority can be claimed within 1 month ✓ of filing the community design ✓ application. This requires her to file the date of the earlier application (9th April 2018) and the country (ROI)

A certified copy of the priority application ✓ must be filed within 3 months of filing ✓ or 3 months of the declaration if the declaration was late (Article 8)

The earlier application was filed in Ireland, therefore no translation will be required if the application is in English (or Spanish, French, Italian, German) but will receive a notification for a translation to be filed if the earlier application is not in any of these languages

Failure to accord of filing date within 6 months, to claim priority 1 month after filing or file the certified copy in time will lead to a loss of priority rights.

The effect of a priority claim, if successful, is that the application is treated as having been filed on the 9th April 2018 for the purposes of novelty and individual character. 0

- c) Roisin should be aware that the Locarno classification for designs is only used for administrative purposes (searching) and provides no limitation on protection.

Roisin will not retain a broader scope of protection if she registers the designs in a different classification.

A multiple application (and the reduced fees that come with it) are only available for products which relate to the same ✓ product class. This would be more expensive, and this is probably why she received a notification that ✓ the 2nd and 3rd fees were insufficient.

Can apply to alter the product class at the time of filing the representations. ✓

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MARKS AWARDED 8.5/20