

Examiner's
use only**Question 1.**

- a) Publication of a Community Registered Design can be deferred by requesting a deferred publication at the time of filling the application. ✓0.5e
- This must include the payment of the fee for requesting deferred publication, which can ✓0.5d be paid on filing but may also be paid up to 2 months after notification from EUIPO that the fees must be paid. The fee is paid together with the registration fee. If paid late, a surcharge will also be due.
 - Publication can be deferred for up to 30 ✓0.5 months from the filing date (= registration date).
 - The publication must be requested and the publication fee paid at least 3 months before the date of requested publication. ✓0.5e
 - If the full 30 month term is being used ✓0.5f, publication must be requested and the fee ✓0.5g paid 3 months before the expiry of the 30 month period. The applicant can request publication earlier than this date, but must pay the publication fee 3 months before the date of requested publication.
- b) If there are any deficiencies in a publication request, the EUIPO will notify ✓0.5k the applicant of the deficiencies, setting a specified period of time for response/2 months from the date of notification)
- The applicant must remedy the deficiencies within the specified period. Otherwise, the registration is deemed never to have had an effect. ✓0.5

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3.5

MARKS AWARDED 3.5/6**Question 2.**

UDR is not infringed by:

- acts done privately ✓0.5a and for non-commercial ✓0.5b purposes
- acts done for experimental purposes ✓1c

- acts done for the purpose of making citations ✓0.5e, provided acknowledgement is made of the source ✓1g, that the act is compatible with fair trade practices ✓0.5f and does not unduly prejudice the normal exploitation of the design. ✓0.5g

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UDR is not infringed by any acts which are done with the consent of the proprietor.

UDR is also not infringed if the act does not constitute reproduction of the design by making articles to the design or by recording the design in a design document. That it, in order for an act to infringe it must be shown that the design was copied so as to produce articles exactly or substantially to the design. If the act is not deemed to constitute copying (reproduction), there is no infringement.

4.5

MARKS AWARDED 4.5/5**Question 3.**

Any person who is party to proceedings before the EUIPO (including the proprietor of a community registered design) who, in spite ✓1e of all due care required in the circumstances ✓1d having been taken, fails to meet a time limit vis-a-vis the EUIPO, may apply to have his rights re-established where the obstacle to his meeting the time limit has the direct consequence of the loss of rights or other means of redress.

This includes failure to pay a renewal fee before the due date, or within the 6 month ✓0.5a grace period (with surcharge), with the effect that the registered design lapses. ✓0.5b

The proprietor must apply to have his rights re-established within 2 months of the ✓1e removal of the cause of his failure to meet ✓0.5p the time limit, and in any case before the expiry of the 12 month period immediately ✓0.5h following the missed deadline. In this case, the 6 month grace period for payment of the renewal fee is deducted from the period, and ✓0.5i thus the 12 month period is from the original missed renewal deadline. ✓0.5l

The omitted act (i-e. payment of the renewal fee ✓0.5m+ the late payment fee) must also be completed ✓0.5n within this deadline. The fee for re-establishment of rights must also be paid. ✓0.5o

The application must include a statement explaining the reasons for the missed deadline, and include evidence that the failure to pay ✓0.5k the renewal fee occurred in spite of all due care in the circumstances being taken. If the EUIPO is satisfied, it will reinstate the Community Registered Design.

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MARKS AWARDED 8/9**Question 4.**

- a) i) File separate applications for design registration in the EU and the US (i.e individual community and us applications). This can be carried out simultaneously, or one application can be filed first, with the other being filed within the 6 month period immediately following and claiming priority from the first. The latter application will then be given a priority date of the filing date of the first application, meaning that the scope of protection in each territory is equivalent. ✓
- ii) An application for international registration could be filed, designating the European Community and the US, through the Hague system. Both the European Community and the US are party to the Hague Agreement (Geneva Act). Provided no objections are raised in either territory, equivalent protection will be enjoyed in each. ✓
- iii) First file in one territory (e.g European Community) and within 6 months file an international application designating the other (e.g the US), claiming priority from the earlier application. ✓
- b) Strategy ii) International application designating EU and US) has the advantage that only a single application is required, easing the administrative burden of filing in multiple territories. ✓

A disadvantage of this strategy is that additional designation fees are due for each designated state, on top of the basic fee (application fee) and publication / deferment fees.

4

MARKS AWARDED 4/6

Question 5.

Design right does not subsist in:

- methods or principles of construction ✓
- surface decoration ✓
- “must-fit features”: features of appearance which enable the article to be connected to ✓, or placed in, around or ✓ against another article to enable either article to perform its function ✓
- “must-match features” ✓0.5: features of appearance which are dependant upon the appearance ✓ of another article which the article is intended ✓ to be an integral part (or in which the article is intended to be incorporated), or with which the article is intended to be used.

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MARKS AWARDED 5/6**Question 6.**

- a) No – threats made in relation to manufacture of products are not actionable. ✓
- b) Yes – a threat made in relation to selling a product may be actionable (assuming the receiving party is aggrieved), regardless of whether the person selling the product is the manufacturer.
- c) Yes – threats made in reaction to selling a product are actionable ✓
- d) No – threats made in relation to the importation of products are not actionable. ✓ This is regardless of whether or not the importation is actual or proposed.

3

MARKS AWARDED 3/4**Question 7.**

- a) 17 April 2018 – Community + UIT
 - i) The first renewal fee is due five years from the date of registration (which is the same as the date of filing). Thus, the first renewal is due on 17 April 2023. ✓

The renewal fee can be paid late (with a surcharge) in the period immediately following the due date. This expires on 17 October 2023.

- ii) The first renewal fee for the Community registration is due on the last day of the calendar month in which the period of registration expires (5 years from registration/filing).

This is due on 30 April 2023. ✓ The grace period is 6 months from this date, and the fee must be paid by the end of the calendar month in which the grace period expires ie. By 31 October 2023. ✓

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MARKS AWARDED 2/3

Question 8.

An exclusive licensee has the right, to the exclusion of all other persons including the copyright owner, to do any of the things (acts) which it is the exclusive right of the copyright owner to do. 0.5

An exclusive licensee can bring infringement proceedings in respect of an infringement of copyright, by any party other than the copyright owner (this should instead be pursued as an action for breach of contract). 0.5 The copyright owner must be made party to proceedings. 0.5 However, owner is not liable for any costs if he does not take part in proceedings. 0.5

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MARKS AWARDED 2/3

Question 10.

- a) It is the exclusive right of the proprietor of a UK registered design (UKRD) to use the design in the UK, or any other design which does not produce on the informed user a different overall impression, taking into account the degree of freedom of the designer. This right is infringed by any person who uses the design in the UK without the consent of the proprietor. It is not necessary to show copying in order for there to have been an infringement. Use includes making, offering, putting on the market, importing, exporting or using a product to which the design is applied or in which the design is incorporated.

It is therefore possible that Tara has infringed Nicky's UKRD by using the design. Thus, depending on whether or not Tara's display creates a different overall impression of the user, ✓1c it is likely there has been an infringement.

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- b) Any person who, before the filing or priority date of a UKRD uses the registered design, or makes serious and effective preparations to use the design, may continue to use that design for the purposes for which its use was commenced or the preparations made.

Thus, if Tara started using the design (or made serious and effective preparations to do so) before Nicky's filing/priority date, she will have a right to continue to use the display for the same purpose.

This right cannot be licenced and it can only be transferred if used in the course of a business (which it was) and it is transferred together with that part of the business in the course of which it was used.

This is provided the design was not copied from the design eventually registered.

- c) Tara's best defence is to argue that Nicky's UKRD is not novel or does not have individual character over Abigail's display. This requires that Abigail's display was made available to the public before Nicky's UKRD filing or priority ✓1g date. We are told that Abigail kept it secret, so this is uncertain. Need to find out the relevant date i.e. the filing or priority date of Nicky's UKRD, and the date Abigail's display was first disclosed.

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Possible defence for innocent infringement ✓0.5o is Tara could not have reasonably been aware that ✓1n Nicky's design was registered. Did Nicky mark his display?

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- This only limits the remedies available to Nicky and does not provide a complete defence. If innocent, no damages will be awarded but an injunction could still be granted.

- d) Use of a registered design could be a criminal offense, but only if it is shown (beyond reasonable doubt) that the design was copied. Having in possession for commercial purposes would be a criminal offence, if Tara was aware that the design was copied. Use of the display boosts her sales, so this could be considered commercial purposes. However, Tara was completely unaware of Nicky's design so cannot have known it was copied (which in fact, it was not anyway). The risk of there being a criminal offence is very small. ✓1v

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- e) Potential action for groundless threats, as Tara is aggrieved. The threat ✓ does not ✓ relate to manufacturing or importing, so ✓ is actionable.

Could claim declaration of unjustifiable threat, damages, injunction against continued threats. Nicky's letter is not for the permitted purpose, so is actionable.

6.5

MARKS AWARDED 6.5/20

Question 11.

- a) Roisin's failure to file appropriate representations has resulted in the EUIPO notifying her of the deficiency. In order for an application for Community Design Registration to be accorded a filing date, suitable ✓1a representations must be filed. Roisin must correct this deficiency within 2 months ✓ of the notification by filing suitable representations, ✓ otherwise the application will be treated as never having been filed. ✓1 Once replacement representations have been filed, the application will be accorded a filing date of the date on which the deficiencies were remedied live. ✓d The date on which the representations are filed). 1

The appropriate fees must also be paid within ✓✓✓ 2 months of the notification, with a surcharge for late payment. This will not influence the filing date, but if a filing date is accorded ✓e and the proper fees not paid within the deadline, the second and third designs will be deemed to have been abandoned. 6

- b) For a community registered design application, priority can either be claimed on filing or within one month of the filing date. ✓1 The EUIPO does not conduct any checks for corresponding applications in other territories, and thus without filing a claim to priority, the CRD will not be given the priority date of the Irish application.

The later application must be filed within 6 months of the earlier ✓1 application in order for priority to be claimed. Ireland is a member of the Paris Convention, so priority can be validly claimed from this application.

Thus, the deadline for priority is 9 October 2018 ✓a, and the Community application must be given a filing date before this deadline expires. The priority claim should preferably be made by this time, though can be made up to one month after the filing date (with a late payment fee).

The priority claim must include the country and ✓ date of the earlier filing (Ireland; 9 April 2018) ✓ and the file number if available ✓. Within 3 months of making the priority claim, it will be necessary to file a certified copy of the priority application. Assuming the Irish application is in English, no translations will be required. Note that the priority claim is only valid for the original design. ✓ It is also necessary to indicate which of the designs in the multiple application the priority claim relates to. The other designs will not be given the same priority date. ✓ 5

- c) A multiple application may only be filed if the indicated products to which the design is intended to be applied or in which the design is intended to be incorporated are within a single Locarno ✓ class. Thus the multiple application ✓ will need to be divided out if Roisin wishes to indicate products in different classifications ✓. This would be more expensive than pursuing a multiple application.

Alternatively, Roisin could amend the application such that the indicated products are within a single ✓ Locarno class. 2

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MARKS AWARDED 13/20

Question 12.

- a) Taylor,
- Copyright subsists in any original work, being a literary, dramatic, musical, artistic work, film, broadcast, sound recording or typographical arrangement of a published edition.
 - Thus, copyright may subsist in:
 - i) the publications as literary works.
 - ii) The illustrations of the stickman and the speech bubbles, both individually ✓f and in combination, as artistic works.
 - iii) The typographical arrangement of the published editors i.e the typographical arrangement of her publications, provided these are original.
 - Copyright will only protect the specific works, thus it is not useful for obtaining broad protection over the concept of buzz words in speech bubbles

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- Copyright subsists automatically from the date on which the works is recorded.
- Taylor owns the copyright in all of the above (assuming she was the author of the drawings)
 - ⇒ The first owner of a literary or artistic work is the author, so assuming Taylor is the author of both, she also owns the copyright in the literary and artistic works.
 - ⇒ The first owner of copyright in the typographical arrangement of published editions is the publisher, which is Taylor.

b) Unregistered design right subsists in the design of the shape or configuration (whether internal or external) of the whole or part of an article. Design right does not subsist in surface decoration, and there is therefore ✓h no design right in her drawings/illustrators.

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However, Community unregistered design rights may subsist, as the CDR defines a design as the appearance of whole or part of a product arising from features of, in particular, the ✓i lines, colours, contours, shape, texture and/or materials of a product or its ornamentation. More, a product is any industrial or handicraft item, including (amongst others) packaging, get-up, graphical symbols and typographical type faces. (CUD)

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Thus, Community unregistered design right way subsist in:

- the packaging of the publications
- the get-up of the publications
- the graphic symbols included in the publications (including the stick man and the speech bubbles)
- any typographical typefaces used in the publications, especially in relation to the buzzwords.

To qualify for CUD rights, the designs must be novel and have individual character over any ✓1 other design made available to the public before ✓1 the date on which Taylor's designs were first made available.

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CUD subsists for three years from the ✓1 date first made available to the public (presumably the date they were first published. When was this done?

CUD extends to the UK. Assuming Taylor created the design herself and not in the course of employment she is the owner.

- c) As discussed above, the scope of protection conferred by copyright is limited. The stickman figure has not been copied, and thus there is no infringement by copying. However, copyright is infringed by making an adaptation of a work and by dealing with such an adaptation by (inter alia) copying, issuing copies to the public or communicating the work to the public. ✓m

An arrangement of an artistic work includes an altered version of it. Thus, if the stickwoman is sufficiently close to Taylor's stickman that it would be considered to be an adaptation, Kate has infringed by making the adaptation, copying the ✓0½ adaptation, issuing copies to the public. There is also secondary infringement through possessing in the course of business, selling and offering for sale and distributing in the course of business infringing copies. This qualifies as she knows or has reason to believe that the bookmarks are infringing copies.

Taylor's CUD would also be infringed by any design which does not produce on the informed user a different overall impression, taking into account the degree of freedom of the designer. The question here is whether the stickwoman creates a different overall impression on the informed user.

CUD is infringed by any person who, without the consent of the owner, does any of:

- making offering, putting on the market, importing, exporting or using products to which the design is applied (or in which the design is incorporated) or stocking such products for those purposes. The "design" is applied to the bookmarks, so Kate would infringe by carrying out any of the above acts in relation to the bookmarks.

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Examiner's
use only

For CUD to be infringed, the design must have ✓✓ been copied. That is, CUD is not infringed if the infringing design is the result of an independent work of creation by a designer who can reasonably be thought not to be familiar with the design made available to the public.

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Kate is clearly familiar with the design, as she based her own design on Taylor's. Kate's best defence would be to demonstrate that Taylor's stickman was not new or did not have individual character over the stickmen ✓u drawings at the time it was first made available to the public.

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Alternatively, Kate could argue that her own Stickwoman would produce on the informed user a different overall impression to Taylor's stickman. ✓w

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9.5

MARKS AWARDED 9.5/20