

**D&C – Design and Copyright
Mark Scheme 2014**

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

Answer

*Indicates half marks may be awarded where candidates have not been precise.

RDA s8: registration initially lasts 5 years (**0.5 marks**) from registration/filing date. Last payment dates were 12/1/14 (**0.5 marks**) and 6/9/14 (**0.5 marks**), which have passed, so both registrations have expired (**0.5 marks**).

A: 2 marks

Can extend for further 5 years (**0.5 marks**) – apply and pay fee within 6 months before expiry date (**0.5 marks**).

B: 1 mark

6-month grace period available, ending 12/7/14 (**0.5 marks**) and 6/3/15 (**0.5 marks**). The first date has passed; second registration can still be renewed. Apply and pay fee + additional fee (if paid after 6/10/14) (**1 mark***). If renewed, the registration is deemed never to have expired.

C: 2 marks

For first registration, can apply for restoration within prescribed period.

D: 1 mark*

Will be restored if failure to pay was unintentional (**0.5 marks**) and if pay unpaid renewal fee + additional fee (**0.5 marks**).

E: 1 mark

Client no longer needs the second design of the multiple application, but it's possible to renew just the first and third designs – just pay 2 fees specifying first & third designs are to be renewed (Or: Renewal fees are not high so could keep the second in case it turns out to be important later).

F: 1 mark*

Brief comment on whether lapse was unintentional (**1 mark***). Client indicates he wasn't aware and has no paperwork. Ask client how registrations were handled e.g. did he have a representative? UKIPO send a reminder 6 months in advance, so who has been receiving the reminders? (**1 mark***)

G: 2 marks

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

Answer

*Indicates half marks may be awarded where candidates have not been precise.

- a) Request for registration **A: 1 mark**

Information identifying the applicant **1 mark**

Representation suitable for reproduction or a specimen **1 mark***

- b) File multiple application or two separate applications (more costly)

B: 1 mark*

For reflective yarn design: file a specimen of the fabric. Deferred publication is compulsory; need to submit a representation of the design when requesting publication.

NB. Another, alternative, option would be to file better photos but the question indicates that "despite best efforts" it has not been possible to capture the detail in photos, so this would suggest filing a specimen instead.

1 mark*

- c) Registration fee for each design is due on filing. Publication/deferment fee is due on filing.

C: 1 mark*

For at least second design, deferred publication fee due 3 months before end of 30 month deferment period, or earlier if required.

1 mark*

There's no need to defer publication of first design, so higher fee for publication would then be payable on filing.

1 mark*

- d) CUD: yes - ornamentation is protectable, and lasts for 3 years from publication. (**1 mark***) There's no indication that the fabrics have been sold yet, and ABC are still developing their marketing strategy, so the date of first publication is key for CUD subsistence. (**1 mark***)

D: 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

Answer

Maximum of 10 marks to be awarded overall.

Half marks may be awarded where candidates have not been precise.

Validity: CUD: For colour, shape etc. if new and has individual character and within 3 year limit.

A: 1 mark

CRD: protects appearance e.g. shape, colour, ornamentation. If new and creates different overall impression, CRD will be registrable.

B: 1 mark

There's a 12-month grace period and design is 'recent' so presumably there's still time to register.

C: 1 mark

Black and white line drawings give greater protection than colour/photos etc. [discussed e.g. in AirWick]. **(1 mark)** If include colour in the registration, protection is limited to those colours. **(1 mark)** Could include a black & white line drawing version and a colour contrast version [Trunki]. **(1 mark)** The latter may be useful if the broader version as found to be invalid.

D: 3 marks

Needs to have been copying – did the competitor see the client's design when they met recently?

E: 1 mark

CRD: May be infringement of the shape since a briefcase may be similar in shape, and possibly the ornamentation if similar enough. If register black & white line drawing version, competitor may fall within scope **(1 mark)** but may not infringe 'contrast' version. **(1 mark)**

F: 2 marks

Can only take action for infringement once registered so apply ASAP.

G: 1 mark

If candidate answers Infringement of CUD: As CRD, award **2 marks** – but note maximum of 10 marks available for Question 3.

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

Answer

Half marks may be awarded where candidates have not been precise.

- a) The US is not a qualifying country

A: 1 mark

Circumstances for qualification:

- i. if design doesn't qualify under s.218,219 (designer, employer, commission)

B: 1 mark

- ii. qualifying person is exclusively authorized to market in the UK

C: 1 mark

- iii. marketing takes place in the UK, or countries to which the section extends, or other EU countries

D: 1 mark

- b) design qualifies if any one person meets requirements (**0.5 marks**), but only persons meeting the requirements are entitled to UDR (**0.5 marks**).

E: 1 mark

- c)

- i. No – no UDR in 2-D or surface decoration

F: 1 mark

- ii. No UDR in connectors as these are features of shape or configuration which enable an article to be connected to another article so that either article may

perform its function (**1 mark**); may be UDR in other aspects of the fence (**1 mark**)

G: 2 marks

- iii. Yes – no restriction for UDR for components not visible in normal use

H: 1 mark

- iv. Yes – no exclusion of computer generated designs (they're mentioned in s214) (**0.5 marks**); the 2-D computer generation is a design document for an article (the furniture pod) (**0.5 marks**)

I: 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 | |

Answer

Knowledge of the Article number is not required.

Half marks may be awarded where candidates have not been precise when reciting the content of the Article.

- a) Art 3: "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".
A: 2 marks
- b) Art 5: "A design shall be considered to be new if no identical design has been made available to the public before the date the design was first made available to the public (CUD) or before the filing/priority date (CRD). A design is considered identical if features differ only in immaterial details".
B: 2 marks
- Art 6: "A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date the design was first made available to the public (CUD) or before the filing/priority date (CRD). In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration."
C: 2 marks
- c) Art 8: designs solely dictated by technical function
D: 1 mark
- features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order 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, although design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system is not excluded.
E: 2 marks
- Art 9: designs contrary to public policy or morality.
F: 1 mark
- 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

Answer

* Indicates half marks may be awarded where candidates have not been precise.

- a) Germany is in EU (**0.5 marks**), and “trade fair” would indicate the exhibition was open to members of the trade which would count as public disclosure (**0.5 marks**)

1 mark

UK RDR: assuming the July disclosure (**0.5 marks**) was the first public disclosure, file by equivalent date in July 2015, using 12-month grace period (**0.5 marks**).

A: 1 mark

CUD comes into being after being made available to public (**1 mark**). UDR comes into being after being recorded in a design document or model (**1 mark***).

B: 2 marks

Finials were sold (it does not matter where) (**0.5 marks**) within first 5 years (**0.5 marks**) from end of calendar year in which design was first recorded, so UK UDR expires 10 years from the end of the calendar year in which marketing first occurred, i.e. 31 December 2024 (**0.5 marks**). Licences of right will be available in the last 5 years of UDR protection (**0.5 marks**)

C: 2 marks

For CRD/RDR, need to file an application (**0.5 marks**) to register the design at OHIM/UKIPO and would last for 5 years (**0.5 marks**), renewable every 5 years (**0.5 marks**) up to max 25 years (**0.5 marks**)

D: 2 marks

- b) No (**0.5 marks**) - test for disclosure is whether events could reasonably have become known (**0.5 marks**) in the normal course of business to the circles specialised in the sector concerned (**0.5 marks**), operating within the Community. A website is likely to be publicly accessible worldwide and thus meet the requirements of disclosure. (**0.5 marks**)

E: 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

Answer

*Indicates half marks may be awarded where candidates have not been precise.

First design filed in August 2014, so still within 6-month priority period (**1 mark***). In principle can file CRD claiming the US priority within 6 months from filing date, i.e. by the equivalent date in February 2015 (**1 mark***).

A: 2 marks

She mentions initial marketing in December 2013, which implies this was when first public disclosure occurred (**1 mark***). You're told there is a 12-month grace period in the US, and there is also a 12-month grace period in Europe, which will expire in December 2014 (**1 mark***). So any further applications need to be filed by December 2014 and not February 2015 (**1 mark***). It is not permissible to add the grace period to the priority period (**1 mark***).

B: 4 marks

The second design was first sold last month, September 2014, so we're within the grace period for filing a new community application for that design.

C: 1 mark*

Filing a multiple application including both designs will keep costs down (likely to be same Locarno classification (**0.5 marks**)). Or could file an EU application for first design only by December 2014 to ensure priority deadline is met, and then file a further application by September 2015 to delay some costs (**0.5 marks**).

D: 1 mark

Can only claim priority for first design – can't add matter, but we can file one design with a priority claim and one without in the same application.

E: 1 mark*

Second design includes an additional feature, so presume is different enough to qualify for CRD, but should check.

F: 1 mark*

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

Answer

*Indicates half marks may be awarded where candidates have not been precise.

- a) copy the work (**0.5 marks**), issue copies of the work to the public (**0.5 marks**), rent or lend the work to the public (**0.5 marks**), perform, show or play the work in public (**0.5 marks**), communicate the work to the public (**0.5 marks**), make an adaptation of the work or do any of the above in relation to an adaptation (**0.5 marks**).
A: 3 marks
- b) Recite 4 instances of secondary infringement from the following sections of the CDPA: s22, 23, 24, 25, 26.
B: 4 marks*
- c) An article is an infringing copy if its making constituted an infringement of the copyright in the work in question. An article is also an infringing copy if it has been or is proposed to be imported into the United Kingdom, and its making in the United Kingdom would have constituted an infringement of the copyright in the work in question, or a breach of an exclusive licence agreement relating to that work.
C: 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 | |

Answer

*Indicates half marks may be awarded where candidate have not been precise.

- a) Article 8 CDIR: Application should indicate the file number **(0.5 marks)** and country **(0.5 marks)** of the previous application; file a certified copy of representations **(1 mark*)** from earlier application within 3 months of the filing date **(1 mark*)**.
- A: 3 marks**
- Submit a declaration of priority within 1 month of the filing date.
- B: 1 mark***
- Declaration must state the date on which and the country in which the application was made.
- C: 1 mark***
- Need to attend to the requirements of (a) within 3 months of receipt of the declaration of priority.
- D: 1 mark***
- b) Rule 6 UK Registered Design Rules: (i) to limit scope or extent of protection being applied for in relation to the design, or (ii) to indicate that the application for registration related to a design that forms only a part of the appearance of a product.
- E: 2 marks***
- c) E.g. dotted lines, coloured portion + description on application form.
- F: 1 mark***
- d) Section 1(3) RDA: A product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product.
- G: 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

Answer

There are 11 statements which attract marks but a maximum of 10 marks awarded from those available below.

*Indicates half marks may be awarded where candidate have not been precise.

Section 24B – exemption of innocent infringer from liability (**1 mark***): Third party could initiate proceedings against sole trader but, in infringement proceedings, no damages shall be awarded (**1 mark***) /no account of profits can be ordered against the sole trader if they can prove that, at the date of infringement, they were not aware/had no reasonable ground to suppose design was registered (**1 mark***). [NB. there is no provision for prior user rights in UK act]. Discussion on the validity of registration (**1 mark***).

A: 4 marks

Product needs to be marked with the registration number for public to be deemed to be aware of the registration.

B: 1 mark*

For the item in question, it might not be possible to mark on fine strands of metal, but they could mark packaging, website, brochures etc. – need to check.

C: 1 mark*

Court could grant an injunction (**1 mark***) if deemed appropriate and other remedies may be available to proprietor (**1 mark***): order for delivery up, order for disposal of infringing articles.

D: 2 marks

The sole trader mentions her design dates back to “some time ago”, so there is a possibility that her design/bracelet pre-dates the registration – need to check.

E: 1 mark*

Section 26 – groundless threats (**0.5 marks**): Sole trader could be considered to be a person aggrieved (**0.5 marks**), but they are the manufacturer of the bracelet (**0.5 marks**). As such, the sole trader will not be able to pursue a groundless threats action because proceedings may not be brought for an infringement alleged to consist of making/importing. (**0.5 marks**)

F: 2 marks

Total: 11 marks but maximum of 10 marks awarded

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

Answer

Half marks may be awarded to candidates who have not been precise.

- a) Rights vest in designer at first instance; Jane Smith is the creator of the design (**1 mark**), created when previously employed by Conceptform Ltd. Design could belong to Jane Smith, or ex-employer Conceptform Ltd. No provision for commissions in EU (**1 mark**).

A: 2 marks

Need to check in whose name the application was filed (**1 mark**). Art. 14: An employer has right to a community design if design is developed by employee in execution of duties/following instructions (**1 mark**). Assuming the product design in question was created separately from Jane Smith's work duties, her ex-employer Conceptform Ltd will not own the rights, but double check since their business is similar to Deezyne (**1 mark**). Otherwise it appears Jane Smith had the right to file the application.

3 marks

If application was filed in the name of Deezyne, there may be a problem if Jane Smith didn't assign the rights to Deezyne – the registration could be invalid. Find out if there was an assignment.

C: 1 mark

- b) In UK, a commissioner owns rights for design (**1 mark**) created in commission for money/money's worth, so Deezyne could be rightful proprietor. Was Jane Smith paid? (**1 mark**) In UK, s2(1B) RDA is broader than Art 15 CDR specifying that employer owns rights for design created by an employee in "course of his employment" (**1 mark**) but, if design created outside of work, ex-employer not entitled (**1 mark**), and s2(1A) has precedence over s2(1B).

D: 4 marks

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

Answer

Half marks may be awarded to candidates who have not been precise.

Validity of design: Kitplane design "based on" 1900s design. Only valid rights if Kitplane changed design to confer novelty/individual character. Make a comparison.

A: 1 mark

Castplane will only infringe if it post-dates Kitplane's design, and if lacks novelty and individual character. How significant are the differences? They, at least in part, arise from reproduction on a smaller scale. What was degree of freedom of designer?

B: 2 marks

Grounds for invalidity include novelty and individual character, so if full-size plane predates model registration, and registration lacks novelty/individual character over real plane, registration could be invalid.

C: 1 mark

Individual character exists if the overall impression produced on an informed user is not the same. Who is informed user? User of kit model aeroplanes (e.g. children and parents, not serious aeroplane enthusiasts). Would such an informed user consider there to be differences? If so, the Kitplane design registration could be valid.

D: 2 marks

Infringement: Castplane asserts it copied the Wright Bros plane. Check for differences – i.e. is there novelty and individual character? Are differences attributable to size reproduction?

E: 1 mark

If registration is valid, Castplane may infringe if no different overall impression.

F: 1 mark

Informed user of model kit aeroplanes and diecast models could be the same – they are both on same scale and don't actually function, compared actual aeroplanes.

G: 1 mark

Check dates of Castplane & Kitplane designs – who was first? And check if Castplane has a design registration.

H: 1 mark

Total: 10 marks