

**Question 1**a) PRIORITY

– Original owner is still listed as the owner of the CRDs. While our client has had an assignment (signed a deal) to transfer the CRDs to her name, this needs to be recorded. The assignment must be in writing and signed by the original owner and the new owner.

Priority cannot be claimed from the original CRDs if they are in the names of different applicants. Criteria for claiming priority for Designs; – Must file application claiming priority within 6 months of filing the original designs. ✓1(i) (e.g. file the UK designs with 6 months of the priority date(s) of the original CRDs.

UK can claim priority from a community design as they are both contracting parties (UK & EU) to the Paris convention. Both the original application and priority claiming application must relate to the same subject matter (e.g. the designs in the UK application must be the same as the designs in the Community application).

Both applications must be made by the same applicant.

Therefore, check the deal the client has signed. If this would suffice as an assignment, record this at the UKIPO and the Office (European designs office) as soon as possible. Have the European register updated to show that our client is now the owner of these designs.

The CRDs were registered about 3 months ago. When a CRD is registered, the date of registration is the date the application was filed. (if it does not claim priority).

Therefore the period for claiming priority from each of the CRDs will end in about 3 ✓1(ii) months.

This assignment should also be recorded ASAP.

The assignment must be recorded within 6 months of agreement, or as soon as reasonably practicable thereafter. This stops 3<sup>RD</sup> parties recording another agreement before yours which would over-ride your assignment.

We should record this assignment ASAP (at the UKIPO and the Office) and have the European registered updated to show new ownership. This will allow us to claim priority.

Once the above has been done, we can file the UK design application. We can either submit these designs as single applications, ✓1(iii) each making a priority claim to its respective European counter-part. (File within 6 months of filing date of Community designs).

Alternatively, we could file one application, containing multiple designs. ✓1(iv) There is no classification criteria in the UK, so multiple designs can be filed in one application, even if they relate to different kinds of products. Multiple designs cannot be filed in one application in the UK if the design is ornamental in nature though (can't include designs relating to ornamentation in a multiple application).

Different priorities can be claimed for each design in a multiple application, so this is not a concern. (As it says each CRD was registered on different days → therefore they were filed on different days → making the priority date for each design different).

Submit where the application was filed ✓1(vi), the date of ✓1(v) filing and the application number ✓1(vii) within one month of filing the UK application (to claim priority for each design).

Submit a certified copy of each priority registration /application with 3 months of UK filing. ✓1(viii)

Multiple application will save money.

- b) – Have the European registered updated to show she is now the owner. ✓1(ix) Send the signed assignment document ✓1(x) to the office the have it recoded. She needs to provide us with the original assignment document for us to do this.
- From registration, these designs are now valid for 5 years. They can be extended, 5 years at a time, by paying the renewal fees.
  - Renewal fees must be paid in respect of each design.
  - These are due at the end of the month in which the design was registered (5 years from registration ✓1(xiii)).

- They can be validly paid 6 months before the expiry date, and there is also a 6 month period to pay them 6 months after expiry. (this includes an additional charge though).

These are the actions the client should now take with respect to these CRD's.

11

MARKS AWARDED 11/12

3

## Question 2

### BERNE CONVENTION

- Authors of literary and artistic works are afforded the same protection in countries in which they are not a national or resident ✓1(i) as would be afforded to nationals / residents of that country. ✓1(ii)

Where an author publishes a literary or artistic work in the country in which they are a national or a resident, they will have copyright protection in that country.

When they make their work available in countries in which they are not a resident or a national, they will be afforded the protection available in the country which they have made their work available i.e. the protection that country would grant its nationals.

The authors must be a resident/national of a Berne convention contracting state, or first publish their work in a Berne convention contracting state, → and protection is only available in other Berne convention contracting states.

If there are joint authors, only one of them must be a resident/national of a contracting state.

If the artistic work relates to a film, the headquarters of the studio in which the producers of the film created the film must be within a Berne convention contracting state.

2

MARKS AWARDED 2/5

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**Question 3**

## a) Reproduction of a design

A reproduction is a copy ✓1(i) of an existing design, wherein the design right has been established by either recording it in a design document, or making the design available to the public (i.e. putting it up for sale on the market).

A reproduction of a design results from copying of the design covered by the unregistered design right, or anything that may only differ in immaterial ways ✓0.5(iv) to the design as covered by the unregistered design right.

A reproduction results from direct copying of the design covered by the unregistered design right.

Only the design right owner is allowed to reproduce articles to the design ✓1(ii) as covered by the design right for commercial purposes.

2.5

## b) Exclusive Rights of a design right owner.

- Make articles to the design ✓1(vi) as recorded in the design document or as per the article first made available to the public (i.e. by way of sale). In the UK
- Offer for sale or hire designs as covered by the design right. In the UK
- Putting on the market designs as covered by the design right. In the UK
- Import articles as covered by the design right (in to the UK).
- Export articles as covered by the design right (from the UK).
- Use articles as covered by the design right. In the UK.
- Stock articles which incorporate the design or to which the design has been applied for any of the above acts. Stocking these articles/products in the UK.

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- c) These acts may be infringed by someone who, without consent or license ✓0.5(vii) of the design right owner performs any of the acts as listed above in the UK, while the design right is in force. (Making ✓0.5(xi), offering ✓0.5(xvi) for sale or hire, possessing ✓0.5(xiii) for sale or hire, importing ✓0.5(xii) or exporting articles covered by the design right, using

articles covered by the design right, or stocking articles with the design incorporated or applied for any of the other acts).

Infringement of a design right can only occur by direct copying though, so it must be shown that direct copying has occurred. If it cannot be shown that direct copying has occurred (i.e. the work of the alleged infringer was a work of independent creation, then there can be no infringement of a design right. Additionally, unregistered design rights can also be infringed by supplying another a means of making articles covered by the design right when it is known or obvious that a design right exists.

- Supplying goods for sale ✓0.5(xiv) or hire ✓0.5(xv), which are covered by the Unregistered design right.
- Possessing articles as covered by the design right to be offered for sale or hire.
- Inducing someone to infringe an unregistered design right by supplying them with a means of making design covered by the unregistered design right.

The last 4 examples would be secondary infringement of an unregistered design right.

7

MARKS AWARDED 7/11

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#### Question 4

##### INTENTIONALLY COPYING IN THE COURSE OF BUSINESS

##### Defences

- You thought the registered design was invalid ✓1(i) (i.e. it had expired / lapsed by renewals not being paid, or was invalid by the owner not being entitled, the registered design not meeting the requirements of a design (definition of design, not new, lacking individual character) → or was invalid by some other means → design dictated by technical function, design must be reproduced in its exact form and dimensions so that the product to which the design is applied may be mechanically connected to, placed in, around or against another product, so that either product may perform their function.

- The person believes they were authorised to do so (must show why they believed they were authorised to do so). → i.e. they believed the proprietor had granted them consent.
- The person was unaware that the design was a registered design. Therefore they believed they were free to copy the design.

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MARKS AWARDED 1/3

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**Question 5**

- a) GRAPHIC WORK.

A graphic work is an artistic work, which if it is original this provides the author with copyright protection.

A graphic work is an artistic work in the form of a painting ✓0.5(i), chart ✓0.5(v), map ✓0.5(iv) or plan ✓0.5(vi), or an etching ✓0.5(viii), woodcutting ✓0.5(x), engraving ✓0.5(vii), lithograph ✓0.5(ix) or similar ✓0.5(xi).

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- b) A photograph is a recording of light or other form of radiation ✓1(xii) or a medium ✓1(xiii) suitable for recording light or other form of radiation to produce an image. ✓1(xiv)

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MARKS AWARDED 7.5/9

**Question 6**

- a) WHOLESOME CHOCOLATE'S CURRENT POSITION.

They have a CRD, registered 1 April 2014. A CRD lasts for 5 years from registration ✓0.5(vi). This may be extended every 5 years, for a total life duration of the design up to 25 years.

Renewals are due on the last day of the month in which the design was registered, every 5 years. From initial registration, the first renewal would have been due on 30<sup>th</sup> April 2019 ✓0.5(v). This has been missed as the client has had no other correspondence with the EUIPO since registration.

There is a grace period of 6 ✓0.5(vii) months for paying renewals. This grace period ends on 30<sup>th</sup> October 2019.

The renewal must be paid in this time, with a surcharge for using the grace period.

THE CLIENT SHOULD INITIALLY RENEW THEIR DESIGN REGISTRATION FOR ANOTHER 5 YEARS TO ENSURE THEY STILL HAVE PROTECTION. ✓0.5(iv)

#### COVERAGE OF PROTECTION OF CRD

- Design subsists in the appearance of whole or part of a product, arising from the Lines, colours, contours, shape, texture and/or materials of a product or its ornamentation.
- A colour photograph was submitted with the request for registration. It would have been better if a black and white line drawing had been submitted, as this colour photo limits the design protection of the chocolate bar. Is this important though? If they are only making white chocolate bars (and they are clouds), they may only need white to be covered.

The cloud shape will also be protected by the design, as it has been found to be new and distinctive character over what is already available on the market. Their protection covers all designs that only differ in immaterial ways to the registered design, and designs which do not produce a different impression on the informed user from their registered design.

#### FLUFFED UP

The texture of the design is different from WC's design, with this texture not being covered by WC's design, flat chocolate bar vs foamy texture. Is this texture internal or external though? The shape neither appears to be new or offer a different overall impression on informed users than WC's bar does ✓0.5(ix). Is the textured surface also an immaterial detail?

WC's registered community design covers EU member states, of which Ireland is one ✓0.5(xviii). Therefore their protection extends to Ireland.

If WG's are making in Ireland to this design, they are likely infringing WC's CRD. ✓0.5(xvi)

The CRD could be used against WG in terms of the shape of the bar, and the colour (both white chocolate), but not for the texture of WG's bars.

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- b) The design (CRD) was registered in April 2014. This is also the date of filing of the CRD.

If anything has been made available to the public before the date of registration ✓0.5(xxiii) which only differs from the design of the CRD in immaterial ways ✓0.5(xxxiii), then it is prejudicial to the novelty ✓(xxxii) of the CRD.

WC made the design of a chocolate bar available in 2012. This bar appears to, at most, only differ from the design registration in immaterial ways. Therefore the CRD lacks novelty ✓0.5(xxxi) and is unlikely invalid. ✓0.5(xxix)

There is a period of 12 months ✓0.5(xxii) from first disclosure by the author from which a design can then be filed by the author (grace period available in the EU and UK). This would have also been missed. ✓0.5(xxiv)  
The blog entry bar has been viewed by many people. At the time of making available to the Public, it appears to be new and have individual character (radical design, registration of same design being found to be new and have individual character).

While the CRD may be invalid because of this disclosure. Unregistered rights may still exist.

Community unregistered design right → 3 years from first being made available to the public → expired 2015.

UK design right (if WC a UK national /resident or national/resident of a contracting state), 15 years from (the end of the month of) first recordal, or if sold /made available for sale, 10 years from the end of the month it was first made available for sale.

If they only have a UK UDR, this is no enforceable in Ireland. They may wish to come to a cross-licensing agreement with WG.

7

MARKS AWARDED 7/20

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**Question 8**

- a) Goldface has been made available to the public for purchase in the UK. This would give rise to a UK unregistered design right if the design is original and it is not excluded. This design right would last for 10 years from the end of the calendar month it was first made available to the public.

There is likely no design right in the shape of the dial → it is described as generic, so it is a common place ✓0.5(ii) design.

Unregistered UK design rights do not subsist in surface decoration. Therefore the distinctive surface print of the watch would not be covered by a UK UDR ✓0.5(iii) either.

As it was created in the UK (an EU member state) there may be an unregistered community design right that belongs to WatchIt. The dial is generic ✓0.5(vi), so it is not new nor does it have distinctive character. ✓0.5(vii) Surface decoration is covered by an unregistered community design ✓0.5(iv) though → so a CUD may subsist in the dial design /surface decoration ✓0.5(v) if it is new and has distinctive character.

This right last for 3 years ✓0.5(x) from when the design is first made available to the public in the Community ✓0.5(ix) (EU). This will last for 2 years 2 months more. ✓0.5(xi)

To enforce this right, WatchIt must be able to show that an alleged infringer directly copied their design. They (they being the infringer) are selling /offering to sell to the UK (in the EU). This is infringement of the CUD if direct copying can be proved.

Find out where the alleged infringer is based. Is this inside /outside of the EU. 3 weeks delivery time suggests it is outside of the EU.

- b) WatchIt can still register the design ✓1(xxii). A 12 month grace period is available in both the UK and the Community (EU) for registering designs which have been disclosed by the designer. ✓1(xxi) (so WatchIt has 2 months of the grace period left) ✓1(xxiii). Register by mid December 2019.

Must be new and have individual character to be registered though. The infringer disclosure is likely after the applicant disclosure (as it sounds like this has arisen from direct copying).

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The surface decoration / surface print is registerable in the Community (EU) and the UK, but it sounds like the dial shape is not, as it is 'generic'.

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- c) This appears harmful to WatchIt's product.

They are offering ✓0.5(xxxii) a watch of WatchIt's design in the UK. (Even if the actual product is not to WatchIt's design ✓0.5(xxiv)).

WatchIt should register the design in the UK. This means they can get an injunction against the outlet for offering a watch to WatchIt's design in the UK, when design rights exists.

If they can show direct copying, the sale /offer for sale in the community would infringe the CUD ✓0.5(xxxi). They are offering a direct copy. (even though what is sold is not a direct copy).

Get an injunction to stop their offer of sale.

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MARKS AWARDED 9/20

### Question 9

- a) UK unregistered designs last for 15 years (from the end of the calendar month in which the design was first recorded.)

If an article made to this design is made available for sale /made available to the public in the first 5 years of this period, the life of the UK UDR is 10 years from the end of the calendar month in which it was first made available for sale /made available to the public.

Licences of right are also available in the last 5 years of a UK UDR.

A Community unregistered design lasts for 3 years from first recordal or being made available to the public.

A UK RDR and CDR can last for up to 25 years from registration.

So a much longer life. ✓1(i)

Licences are only available if you decide → no compulsory obligation to offer licences of right. ✓1(xiii)

UK RDR and CDRs are infringed by any designs that only differ in immaterial details to the design registration. They are also infringed

by designs which do not produce a different overall impression on the informed user to the overall impression given by the registration.

You do not need to show copying has occurred to enforce your UK RDR or your CDR. ✓1(ii)

To enforce your UK UDR or your CUD, you must show that direct copying has taken place by the alleged infringer in them creating their product.

i.e. much lower threshold to enforce your rights.

- b) An interim injunction can be sought to stop the alleged infringer carrying out their infringing act. ✓1(ix)

The infringing articles can be delivered up ✓1(x) to the claimant.

The infringing articles can be destroyed if it is deemed appropriate to do so.

Any other remedy available ✓1(xiv) in accordance with national law ✓1(xv) as to where the alleged infringement took place.

- c) interim injunctions ✓1(xviii) can be sought to stop the alleged infringer committing the infringing act.

The infringing articles may be delivered up ✓1(xxi) to the claimant (infringing articles in the possession or made by the defendant.

The infringing articles may be destroyed ✓1(xxii) if it is deemed a more appropriate solution.

The claimant may make a damages ✓1(xvii) claim for the damage to the claimant's business caused by the defendant. A damages claim is not available against someone who was unknowingly infringing (i.e. an innocent infringer).

An account for profits ✓1(xix) against the defendant for the loss caused to the claimant caused by the defendant's infringing action.

You cannot have a damages claim and an account for profits claim together. You cannot make an account for profits claim against an innocent infringer → someone who did not know they were performing an infringing act.

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MARKS AWARDED 12/20