

Examiner's  
use only**Question 1**

- a) The application should be filed by July 2018 as this will be the end of the 12 month disclosure ✓(iv)1 grace period, where the earlier design will not be citable against the later application. To claim priority from the Canadian application, any application to register the sports bottle in Europe should be filed 6 months from the filing date of the Canadian application e.g. January 2018. ✓(i)1 Only designs to the design disclosed in the Canadian application can claim priority. 2
- b) Anne is the designer of the sports bottle as she designed the sports bottle independently from Fitcessories Ltd. Therefore, Anne is the person entitled to file ✓(i)1 the Community registered design application for the sports bottle unless she assigns her rights in the priority doc and any application in the Community to Fitcessories ✓(ii)½ Ltd. Assuming Anne is not employed by Fitcessories, the other designs will have joint ownership ✓(iv)1 between Anne and Fitcessories. If Anne is employed by Fitcessories and she designed the other products in execution of her duties or following instruction from her employer, the rights in the design lie with Fitcessories. Anne should assign ✓(iii)1 her rights to Fitcessories so before January 2018 so that all designs can be included in a single application. 3½
- c) Multiple designs ✓(i)½ can be registered in a single application to save costs. Multiple registration and publication fees will need to be paid, but the fees are reduced. The designs need to relate to the same Lacarno ✓(i)½ class. Anne will need to assign her rights to Fitcessories (for the design in the Canadian application) to encompass all designs in a single application. 1

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**MARKS AWARDED 6.5/10****Question 2**

- a) i) Yes. The holder of UDR has the exclusive right to reproduce articles to that design for commercial purposes this includes: ✓(i)½
- making articles to that design, and
  - recording in a design document designs that are to be made into articles
- in which a design right is incorporated in or to be applied to.
- Reproduce means to make articles that are identical or substantially identical.

| Examiner's use only  |    |
|--|----|
| <p>A miniature version of the desk lamp is substantially ✓(ii)1 identical and the infringer is clearly exploiting this article for commercial purposes (he is making + selling), so it is infringing the UDR. Primary infringement. ✓(i)½</p>  | 2  |
| <p>ii) It is secondary infringement ✓(iv)1 of a UDR to import an article, for commercial purposes, into the UK where the article is protected by a UDR.</p> <p>However, 'putting in a dining room' does not constitute ✓(v)1 'commercial purposes' therefore there is <u>no infringement</u>.</p>  | 2  |
| <p>b) i) A CUD gives the rights holder the exclusive right to: make, offer, put on the market, import, export and use a product to which a design is incorporated or to which it is to be applied. Stocking a product for any of these uses is also an infringing act. So if the T-shirts are stocked in the warehouse and are ✓(i)1 intended for any of the above uses, then yes there is infringement, otherwise there is no infringement.</p> | 1  |
| <p>ii) No. It is not an offence to put on the market a product in which the design is incorporated or to which it has been applied to if such a product has already been put on the market in the EEA by, or with the consent of, the design rights holder. Assuming the product is on the market in the EEA, (it is widely used), the design right holder has exhausted their rights and there is no infringement.</p>                          | 0  |
| <p style="text-align: center;">(5) MARKS AWARDED 5/10</p>  |    |
| <b>Question 4</b>  |    |
| <p>a) any work, other than dramatic or musical ✓(i)½ work which is spoken, sung or performed and necessarily includes:</p> <ul style="list-style-type: none"> <li>– any work of writing ✓½(i) or speech excluding a computer programme.</li> <li>– computer programme ✓(iii)½</li> <li>– database ✓(v)½</li> <li>– preparatory arrangements for creating a computer programme. ✓(iv)½</li> </ul>   | 2½ |
| <p>b) any work of dance or mime ✓(i)1</p>  | 1  |
| <p>c) any work of music, exclusive of any words or actions that are to be spoken, sung or performed with such music. ✓(i)1</p>   | 1  |
| <p>d) any graphic work, photograph, collage or sculpture, irrespective of artistic quality ✓(i)1</p> <p>any work of artistic craftsmanship ✓(iii)1</p> <p>any architectural work including a building or a part of a building. ✓(ii)½</p>  | 2½ |

e) any painting, printing, graph, map, or chart, and ✓(i)½

any engraving, etching, lithography or woodcut ✓(ii)1, woodchip, etc.

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MARKS AWARDED 8.5/10

### Question 5

a) No. ✓(i)½ Fair dealing for the uses of private ✓(ii)½ study does not constitute an infringement. Copying is an offense, but not for the above purpose. MENTION SHOULD Be made to the source.

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b) Yes. ✓(i)½ Copying the photographic arrangement of published editions means making a facsimile copy ✓(ii)½ of the work, this has clearly occurred. Furthermore, selling the book shows commercial purposes and therefore constitutes an infringement.

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c) No. ✓(i)½ Fair dealing ✓(iv)½ in an adaptation for the purposes of caricature, parody or pastiche does not constitute an infringement. ✓(ii)½ The author of the cartoon sketch would own the copyright and have the exclusive right to issue copies of the sketch to the public. Mention should be made to the source, if practicable.

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d) Yes ✓(i)½, making an article for the purposes of producing an article in which copyright subsists and the person making the article knows or has reasonable grounds for supposing that the article to be produced is protected by copyright is an infringing act.

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e) Yes. ✓(i)½ Copying an artistic work involves making a 2D image from a 3D image. The photograph (2D) was created from the sculpture (3D). Thus, infringement has occurred. ✓(ii)½

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f) Infringement of works in a film recording includes producing a photograph of an essential part of the film recording. Therefore, if the few seconds of footage contain an essential part of the sporting event this may constitute an infringement. ✓(iii)½ However, posting something on social media may not be for commercial purposes, unless they are ✓(iv)½ a Sports blogger or something similar. If the posting was done for non-commercial purposes, there can be no infringement.

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g) No. ✓(i)½ There is no infringement in copyright with fairdealing in events that are beneficial for public policy or morality.

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MARKS AWARDED 6.5/10

**Question 6**

- a) The design right will have expired. ✓(ii)1 The maximum term for a registered design is 25 years from the date of registration (i.e. the filing date). The design ✓(i)1 was filed in 1990 and so could only be in force and valid up until 2015. It is an offence to mark products to which a design is incorporated or applied to as ✓(iii)½ 'registered' if the term of registration is invalid, this includes engraving embossing the word 'registered' or any other item to that effect. 2½
- b) Liable to a fine of level 1 on the standard scale. ✓(i)½ ½
- c) The fine would be different – level 3 on ✓(ii)1 the standard scale. It is still an offence to mark products as registered if an application for registration has not been applied for. 1
- d) It is a criminal offence to copy ✓(i)½ a design that is protected by a registered design if the person copying the design knows or has reason to believe that the design is a registered design. ✓(ii)1 Copying the design means to produce products that are identical or differ in immaterial features. 1½
- e) A person found guilty of copying a registered design can be subject to:
- On summary conviction (Magistrates court):
- imprisonment (not more than 6 months)
  - a fine (not exceeding level 5 on the standard scale), or
  - both ✓(ii)1
- On indictment conviction (Crown court):
- imprisonment (not more than 10 years)
  - a fine, or
  - both ✓(i)1

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**MARKS AWARDED 7.5/10****Question 8**

- a) Ownership relates to the person to whom the design right belongs (designer or employer). Joint ownership reflects that there are multiple rights in the design i.e. two or more persons designed the product, to which the design is incorporated or applied to. 0

b) The right to a community design are unitary, i.e. enforced across the entire EEA. However, the rights are enforced in the Member state where the owner:

- has a seat or is domiciled ✓½(v)
- or has an establishment.

For joint owners of Community unregistered designs the Member State where the rights are enforced will be that in which the joint owners have agreed by ✓(vi)½ written communication (for registered designs it is the person who first appears on the list).

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- c) 1. Acts done for private, non-commercial purposes ✓1
2. Acts done for experimental purposes. ✓1
3. Acts done on ships or aircrafts carrying infringing goods that are temporarily in the community. ✓½
4. Importing infringing products for the purposes of repairing ships + aircrafts in temporary waters in the community. ✓1

3½

(4½)

MARKS AWARDED 4.5/10

### Question 9

Assuming that no applications for registration have been filed Sarah and Marie may have unregistered UK and Community rights. Cannot apply for registered rights as it is more than 12 months since the design was disclosed.

#### Unregistered Community design (UCD) right

UCD begins when the design is first made available to the public and exists for 3 years ✓(i)½ from this date. Made available to the public means:

- published
- exhibited
- used in trade, ✓(ii)½ or
- otherwise disclosed in such a way that these events can reasonably become known in the course of business to the sectors concerned, operating within the community.

As Sarah and Marie graduated about five years ago, these rights will have expired and they may also not be deemed to be made 'in the course of business' as they were at Art College.

Unregistered UK Design Right (UDR)

A person must qualify for UDR. To be a qualifying person you must:

- be a habitual resident in a qualifying country, or
- a body corporate which:
  - > was formed under UK law or law of another qualifying country, and
  - > has in a qualifying country, institutions that have substantial business activity.

A qualifying country is:

- the UK
- any country to which this part extends by virtue of Section 255
- a Member State of the EU
- a country that has reciprocal protection under Section 256.

Assuming Sarah and Marie are qualifying individuals they will have UDR for the products they made. ✓(vii)½ ✓(xii)½ UDR only exists if the design was recorded in a design document or articles to the design were made available. Presumably, both Sarah and Marie kept several design documents when at Art College disclosing these designs and made the articles to these designs. A UDR term is 15 years from the end of the calendar year in which the design was recorded in a design document or an article to that design was made, whichever occurred later, or if articles to the design were made available for sale or hire 5 years from the end of the calendar year, 10 years from the end of the calendar year in which that occurred. ✓(iv)½ UDR will thus be in force. We will need to find out if the designs were recorded in a design document or articles made whilst at Art College to calculate the full term of protection. Licences as of right are available during the last 5 years of a UDR term. If Sarah started selling products to which the design was incorporated about 3 years ago, and both Sarah and Marie graduated 5 years ago the articles may have been made available for sale or hire in the first five years of the UDR term. Therefore, Sarah will have approximately 7 years worth of UDR protection. Marie will also have this protection as they are both qualifying individuals i.e. joint owners.

UDR subsists for the design of the shape or configuration (whether internal or external) of an article. Exemptions to UDR protection are:

- principles or methods of construction
- Must-fit features
- Must-match features
- Surface decoration. ✓(v)1

Therefore, the texture + appearance of the fabric ✓(viii)½ is not Protected, as it is surface decoration. Also, the parts of the wall hangings that 'must-fit' with the features of the wall to be hung are not protectable. The method/principle of making the articles is also excluded from UDR protection.

- b) Sarah and Marie are joint owners any action for infringement brought by one joint owner will mean the other will need to be joined as claimant or named as a defendant as they have concurrent rights.

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MARKS AWARDED 4/10

### Question 10

Michaela can do two things: apply for declaration of invalidity or apply to be the registered rights holder.

#### 1. Declaration of invalidity

Michaela can apply for a declaration ✓(xi)1 of invalidity to the EU-IPO stating that Peter is not entitled to the rights in the Community design registration. Only Michaela, the entitled person, can apply for this declaration of invalidity.

Michaela must apply to the EU-IPO in writing giving her reasons and providing evidence that she is the entitled person. The fee for applying for a declaration of invalidity must be paid. ✓xiv

#### 2. Entitlement proceedings

Michaela can apply to the EU-IPO to show that, at the time of filing the registered community design, Peter was not the person entitled to file the application. ½

The deadline to bring entitlement proceedings is 3 years from:

- publication from the application for registered community designs ✓(v)1
- the date the design was made available to the public for unregistered community design rights ✓(vi)1

However, if Michaela can show that Peter was acting in bad faith at the time of filing the application then entitlement proceedings can be brought at any time. ✓(vii)1

The EU-IPO will publish:

- that entitlement proceedings have been brought ✓
- the outcome of any such proceedings
- any change in ownership occurring from those ✓ proceedings.

Thus, if Michaela wants to invalidate the registration she should apply for a declaration of invalidity, which can be applied at anytime. Or if she wishes to be the owner, she should initiate entitlement proceedings by the deadline (if there is one).

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MARKS AWARDED 7.5/10

**Question 11**

Community design rights subsist for designs. A design is defined as:  
the appearance of the whole or part of a product resulting from its features,  
in particular the:  
lines  
contours  
colours  
texture  
materials (and shape)  
of the product and/or its ornamentation.

A product is defined as any industrial or handicraft item including inter alia:

- component parts intended to be assembled into a complex product,
  - get-up
  - graphics
  - typographical typefaces
- excluding computer programmes

A complex product is a product composed of 2 or more component parts which permit disassembly and re-assembly of the product.

The spare parts are component parts ✓(xiii)½ of a complex product (the complex product being the vehicle). To qualify for registration a component part of a complex product must:

- be visible during normal use ✓(x)½ (normal use means use by the end user, excluding any service, maintenance or repair work). ✓(xii)1
- not be dictated solely by functional features ✓(i)½
- not relate to features that must necessarily be produced in their exact form and dimension ✓½(iv) so as to produce a product in which the design is to be incorporated in or applied to which is to be mechanically connected to or placed in, around or against another product ✓(vi)½ so that either product may perform its function ✓(vii)½ (MUST-FIT)
- be novel + have individual character ✓(xi)½
- not be contrary to public policy or morality.



Spark plugs would be inside the vehicle and thus not visible. Therefore, this component part of a complex product is not registrable. ✓(xiv)½

Bumpers would be visible during normal use and are thus registrable. However, the features that permit attachment to the vehicle would not be registrable due to the 'MUST-FIT' ✓(viii)½ exclusion.

Both registered + unregistered design rights will subsist as above.

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MARKS AWARDED 5.5/10

## Question 12

- a) The scope of protection offered by Mary's registered UK design is the exclusive right to use the product and all other products that do not form a different overall impression on the informed user. The degree of freedom of the designer will be taken into account when assessing individual character.

Use means: making, offering, putting on the market, importing, exporting and using a product to which the design is incorporated in or to which it is applied. Stocking such a product for these uses is an ✓(v)1 infringement as is any of the above uses, without a licence from the registered design right holder. If George's product does not form a different overall ✓(xii)½ impression on the informed user, then George is infringing Mary's registered design right. Mary can sue for infringement ✓(iii)½ as George is selling (putting on the market) infringing products. Mary can seek:

Damages

Injunction

Accounts or otherwise (delivery-up, destruction + declaration of infringement).

George states that similar products have been around for at least 30 years. These may be novelty and individual character-destroying for Mary's registered design right and George can counter-claim for invalidity. ✓(ix)1

If George's statement is true, and he is aggrieved ✓(vii)½ by Mary telling him to stop selling his product, he can seek remedy by way of groundless threats.

George can seek:

- an injunction to prevent further threats ✓(viii)½
- damages which have resulted from the threats
- a declaration that the threats were not valid.

However, George cannot claim this if the threats were justified e.g. they were relating to an infringement or a potential infringement. Mary can also not threaten George for acts of making or importing an infringing product, but the threat for selling is valid. ✓(viii)½ George was clearly aggrieved as he got angry.

Firstly, George should check the UK register to see if the design right is in force. ✓½(i) If not, George may be able to continue selling or have third party rights.

- b) The automobile accessories may form part of a complex product i.e. they may be a component ✓(xiv)1 part. If they are not visible during normal use (use by the end user) the registration will be invalid. Each component part must also be novel and have individual character.

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**MARKS AWARDED 6/10**

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