

Examiner's  
use only**Question 1**

- a) To protect the same design for which an application for design registration was filed in Canada, must file within 6 months of the date that application was filed (presuming there was no priority claimed – otherwise 6 months from that date). So July + 6 months ≈ January 2018 ✓(i)1
- b) There are no qualification requirements to file a CRD (Community Registered Design) application.
- the designer is entitled to the CRD.
  - In this case that seems to be Anne. ✓(i)1
  - But anyone can file the application (– Anne may bring entitlement proceedings). The designer has a right to be cited as such in the application.
- c) Since there are multiple designs for the same product, type, could file a multiple application ✓(i)½
- ↳ pub/deferment fee & registration fee for each design after the first are reduced.
- Products as indicated in the application must be in the same locarno class ✓(i)½, unless the designs relate to ornamentation. (so multiple applications for bottles, & for bags & ✓(ii)½ for mats).

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MARKS AWARDED 3.5/10

**Question 2**

- a) i) It is infringement to do anything which is an exclusive right of the design right owner.
- Design right owner has exclusive right to reproduce the ✓(i)1 design for commercial purposes by making articles to the design (or by making design doc to enable such articles to be made).
  - Reproducing design by making articles to the design means copying the design so as to make articles exactly or substantially to the design. ✓(ii)½
  - So it depends whether a miniature version of the desk lamp constitutes an article made “exactly or substantially to the design”. ✓(ii)½

- If yes then they infringe by making because they copied the picture of it & made it for selling (i.e. commercial purposes)
- Person can inf. by selling if they know/have reason to believe article is infringing article  
↳ so only infringe by selling if they knew that UK-UD Right subsisted in the design. 2
- ii) Importing into the UK an article which is an infringing article is ✓(iv)½ infringement if it is done for commercial purposes ✓(v)½ (& if the person knew/had reason to believe that article was infringing article).  
↳ importation was done by a family, to put the article in their dining room  
→ NOT commercial purposes, so not infringement. ✓(v)½ 1½
- b) i) Storing a product is covered by “use” of the design, if it is ✓(i)½ stored for the purpose of making, offering, putting on the market, importing, exporting or using a product in which design inc. or to which it is applied, in the EU.  
  
– So if stored for such purpose, then yes, infringement ½
- ii) Holder of UCD can only prevent use of the design if it results from copying. Not copying ✓(vii)½ if it results from an independent work of creation ✓(v)½ by a designer who can reasonably be thought to not have been aware of the design ✓(vi)½ made available to the public – so it depends how common the design is, ✓(viii)½ & so whether the designer of fabric can prove his design was an independent work of creation & that he was not familiar with the design 2

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**MARKS AWARDED 6/10**

#### Question 4

- a) A mark, other than a dramatic or musical work, containing words that are written, spoken, or sung. ✓(i)1
  - Includes:
    - Table or compilation, other than a database ✓(ii)½
    - Computer program ✓(iii)½
    - Preparatory design material for a computer ✓(iv)½ program.
    - Database. ✓(v)½ 3
- b) Dramatic work includes a work of dance or mime ✓(i)1 1
- c) Musical work means any work that includes music, exclusive of any words or actions that are intended to be spoken, sung or performed with the music ✓(i)1 1

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|--|------------------------|
| d) Artistic work means any <ul style="list-style-type: none"> <li>Graphic work, photo, sculpture or collage, irrespective of artistic quality. ✓(i)1</li> <li>Work of architecture, being a building or a model for a building ✓(ii)1</li> <li>Work of artistic craftsmanship ✓(iii)1</li> </ul> | 3                      |
| e) Graphic work means any <ul style="list-style-type: none"> <li>Drawing, painting, diagram, map, chart or plan ✓(i)1</li> <li>engraving, etching, lithograph, woodcut or similar work ✓(ii)1</li> </ul>   | 2                      |

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**MARKS AWARDED 10/10**

### Question 5

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|--|---|
| a) No ✓(i)½ – Acts done for the purpose of research & private study are excluded from infringing acts.   | ½ |
| b) Yes. ✓(ii)½ <ul style="list-style-type: none"> <li>Copying the photos is infringement (artistic work – reproduce the work in any material form = copy ✓(iv)½).</li> <li>And selling the book = issuing copies (of the photos) to the public.</li> </ul>   | 1 |
| c) Yes – publishing = showing the work in public.  | 0 |
| d) Yes ✓(i)½ – Infringement can be direct or indirect ✓(ii)½ (i.e. whether intervening acts are infringement does not matter, since copying the article <u>is</u> .)   | 1 |
| e) Yes ✓(i)½ – Artistic work – copying includes making a 2-D copy of a 3-D work ✓(ii)½ & vice-versa.<br>– Also copying includes reproducing in any material form.  | 1 |
| f) <ul style="list-style-type: none"> <li>Copying includes copying all or a substantial part of the work. ; + issue copies to the public is infringement<br/>↳ but is this a copy or <u>original</u>?</li> <li>– Original → Showing the work/communicating the work to the public is infringement.<br/>But social media site – is that public ✓(iv)½ or just his “friends”?</li> <li>– Probably <u>is</u> infringement ✓(i)½, since it probably does constitute showing the work/communicating it to <u>public</u>.</li> </ul> | 1 |

- g) Lending a video is probably OK, since there were probably terms (express or implied) when he bought video that he could lend it to another person.
- But showing it in public is infringement.
  - Therefore it is infringement to lend it to someone if he knew it was to be used to commit an act of infringement.

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MARKS AWARDED 4.5/10

**Question 6**

- a) It is a criminal defence to falsely represent that a design (that has been applied to a product / incorporated ✓(iii)½ into a product – i.e. the chair) is falsely registered.

This includes marking such a product (i.e. the chair) with the word “registered” or an abbreviation thereof, or any other word or words expressing or implying design is registered.

Marking the chairs (if that is what he put the number on) with the design number would constitute something that expresses or implies the design is registered.

- Sam’s design is not registered – UKRD lasts, at the most, for 25 years from the application date. ✓(i)1

Application date was in 1990, so UKRD would have expired, ✓(ii)1 at the latest, in 2015, which has passed.

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- b) Sam could be sentenced to imprisonment & a fine ✓(i)½, or both.

(m = months)

Summary conviction → prison ≤ 6m; fine ≤ level 3 on standard scale	]	½
Conviction on indictment → prison ≤ 12m; fine ≤ level 5 on standard scale		

- c) Yes – prison term, fine or both – both more severe ✓(i)½

Summary conviction → prison < 2y ; fine ≤ level 5 on standard scale.	]	½
Conviction on indictment → prison ≤ 5y ; fine ≤ statutory Maximum		

- d) Yes, if they do so intentionally, in the course of business, without consent ✓(iii)1 of the proprietor, when they know or have reason to believe that the design is registered ✓(ii)1, and they do so to make a product exactly to the design or with features that differ only in immaterial details from the design. ✓(i)½

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## e) Fine and/or imprisonment

Summary conviction =

- prison ✓(ii)1 ≤ 6 months &/or
- fine ≤ £10,000

} England (/Wales).

or

- prison ≤ 12 months &/or
- fine ≤ £10,000.

} Scotland

Conviction on indictment:

Prison ≤ 5 years ✓(i)½ &/or fine ≤ statutory maximum

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MARKS AWARDED 7.5/10

## Question 7

i) Unregistered Design Right (UDR).

- Protect shape & configuration. (not surface decoration)
  - Last for 10–15 years. ✓(ii)½
  - Ownership of UDR depends on how design qualified for protection – presumably by reference to employer (Splash Ltd) which is a company formed under UK law, with place of business at which substantial business activity is carried on.
- Splash Ltd owns UDR ✓(i)½, not Fountain Ltd → There is no presumption of ownership for commissioners.  
(Anyway, Splash made pumps according to Fountain's designs? → So Splash's design belongs to Splash.)
- Copyright → in drawings for any pump designs ✓(iii)1; provided UKUDR does not subsist in these features. (Not in pump – not artistic.)

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ii) UKUDR:

- Infringement to do, or to authorise any other person to do, an act which is an exclusive right of the owner.
- Exclusive right of owner – to reproduce the design for commercial purposes, by making article to design, **one unclear word** .....
- So Fountain infringe Splash's (S) UK UDR by authorising Sprinkle to make an article to the design (for commercial purposes).

- Sprinkle will infringe if they make articles to ✓(i)1 the design for commercial purposes (but, if they did not know UKUDR subsisted in design & had no reasonable grounds for supposing, Splash will not be able to get damages from them).  
↳ Also infringe if they sell articles made to design (but if innocent, Splash can only get damages not exceeding a reasonable royalty (+ injunction & other remedies).

Copyright:

Copyright does not subsist in the work as far as UKUDR subsists in the work (it is a design document).

- j) UKUDR – not protect surface decoration.
  - therefore copyright would subsist in design document & could be infringed as far as those features not protected by UKUDR go.
  - Also copyright in Surface dec of pump itself.

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MARKS AWARDED 3/10

**Question 8**

- a) The owner of an Unregistered Community Design (UCD) has the exclusive right to use the design & prevent third parties not having his consent from using the design. In the case of joint ownership – both have the exclusive right as mentioned above.

In terms of what each owner is entitled to do with the right, it depends on the MS the owner(s) are in. Presumably could not be assigned by one co-owner without consent from the other(s).

- b) Community designs as a form of property are dealt with as national design rights of the member state ✓(v)½ in which:
  - a) • The holder is domiciled
  - b) • If holder is not domiciled in a member state, then the member state (MS) in which he has an establishment. ✓(v)½
    - If neither of the above (a or b) apply, the MS in which the office (EUIPO) has its seat – i.e. Spain. ✓(vii)1
- c) • Acts done privately & for non-commercial purposes ✓1
  - Acts done for experimental purposes ✓1

- Acts of reproduction for the purpose of teaching or of making citations, provided such use is compatible with fair trade practices, & provided mention is made of the source. ✓1
- Acts in relation to ships or aircraft which are registered in a third country and which temporarily enter the territorial waters of the EU. ✓1

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MARKS AWARDED 6/10

### Question 9

- a) No registered rights – those must be applied for.

#### Unregistered Community Design (UCD):

- Protects appearance of the whole or part of a product, resulting from features of, in particular, ... textures, materials, colours ... of product itself &/or its ornamentation. (i.e. surface dec. not excluded).
- Sarah (S) & Marie (M) may have UCD.
- UCD may subsist in the appearance of the blankets/wall hangings (s) or rugs/mats (M) resulting from the texture and materials of the products.
- UCD subsists in a design if the design has been made available to the public (in the EU).
- Since S's blankets & wall hangings & M's rugs/mats have been sold ✓(ii)½, they have been made available to the public (presumably in EU).
- UCD expires 3 years after it was first made available to the public ✓(i)½, so S's UCD has probably expired (she sold 3 years ago). ✓(vi)1 But M's likely still subsists (started selling recently). ✓(xiii)1

#### UK Unregistered Designs (UKUD)

- Presuming both M & S are qualifying persons ...
- UKUDR subsists in features of shape or configuration:
  - Not surface decoration. ✓(v)1
- The "texture" of the articles could be protected since this has shape/configuration & is not mere surface decoration. ✓(viii)½ + "interesting" texture – so could be original.

- UK UDR subsists when it is first recorded in design document /articles first made to design, (whichever first). UKUDR expires 15 years ✓(iv)½ after the end of calendar year in which design first recorded / articles first made to it.

↳ But if articles made to the design were made available for sales within 5 years from the end of that calendar year, then UKUDR expires 10 years from the end of the calendar year in which that first occurred.

- So Sarah: articles made to design sold 3 years ago, so UKUDR still subsists. ✓(vii)½

Marie: articles made to design sold recently.

If < 5 years after end of calendar year in which design first recorded; then UKUDR expires about 10y.

Otherwise UKUDR expires 15 y after end of that. So either way, UKUDR subsists. ✓(xii)½

b) Yes maybe.

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MARKS AWARDED 6/10

### Question 10

- Each design of the multiple registration can be dealt with separately ...
- For designs he has registered: Michaela (M) can bring
  - entitlement proceedings against Peter (P), in respect of the designs she designed on her own ✓(i)½ & the designs they designed together (joint designer). ✓(ii)½
    - Must bring within 3 years ✓(v)½ of filing date of CDR application (unless P registered design in bad faith – then any time). ✓(vii)1
    - M could get designs assigned by order of EUIPO to her ✓(i)½, or her & P jointly ✓(ii)½ (where appropriate).
 

↳ This also applies to the keyrings he has sold made to M's design – he will hold UCD ✓(iii)½ since he disclosed the design to EU first, but since design is M's, she can bring entitlement proc. ✓(iv)½
    - M does not own any UCD, since she has not made any designs available to the public in the EU.

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MARKS AWARDED 4.5/10

## Question 11

Unregistered Community Design – UCD

Registered Community Design – RCD.

- RCD & UCD protect the appearance of the whole or a part of a product, resulting from feature of, in particular, the lines, contours, colours, shape, texture &/or materials of the product itself &/or its ornamentation.
- where product is industrial or handicraft item
  - ↳ Car
 ... including, inter alia, parts to be assembled into a complex product ...
- Complex product is a product containing multiple component parts which are replaceable, permitting disassembly & re-assembly of the complex product.
- A vehicle is a complex product. ✓(xiii)½
- Spark plugs & bumpers (& other spare parts) are component parts of a vehicle. (i.e. replaceable permitting disassembly + re-assembly of car)
- So far – protectable
- But – RCD & UCD only protects component part if (& to extent that) the component part, as incorporated into the complex product is visible during normal use. ✓(x)1
- (– These visible features must fulfill the requirements for protection (be novel & have individual character ✓(xi)1)).
- Normal use means normal use by the end user, excluding servicing, maintenance & repair. ✓(xii)1
- In this case, end user would be a driver of the vehicle.
- So spare parts will be protectable provided they would be visible during normal use by a driver of the vehicle (i.e. – during the driving of the car)
- So spark plugs would be excluded from protection ✓(xiv)½ by UCD & RCD since it would not be visible during normal use. (normal use excludes servicing, maintenance & repairs)
  - ↳ As would most parts that are “under the hood” (engine, etc.)

- Bumper is on the outside, & would be visible during normal use (by end user), so is not excluded by virtue of this provision.
  - ↳ As would other parts that are visible during normal use (e.g. wing mirror, etc...)
- But there is a “must-fit” exclusion
  - ↳ Cannot protect features of appearance which must necessarily be reproduced in their exact form and dimensions ✓(iv)½ to enable the product 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 So, for example, petrol cap not protectable (as far as its shape goes).
- There is no “must-match” exclusion in UCD & RCD.
  - ↳ So no need to worry about e.g. car door needing to “look” the same as car.
- There is an exclusion of features which solely perform technical function. ✓(i)½
- Designs would have to fulfill requirements of novelty & individual character to be protectable.

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**MARKS AWARDED 6/10**