

FC4 Design and Copyright Law
FINAL Mark Scheme 2021

SECTION A

Question 1

State the maximum duration of the following rights and from when the duration is calculated:

- | | |
|--|---------|
| a) a Community Registered Design | 1 mark |
| b) a UK Registered Design | 1 mark |
| c) Community Unregistered Design Right | 1 mark |
| d) UK Unregistered Design Right | 2 marks |
| e) Copyright in a work created jointly by two known UK authors | 2 marks |

Total: 7 marks

Answer

- | | |
|--|---------|
| a) Article 12 CDR 25 years (0.5 mark) from the filing date (0.5 mark) | 1 mark |
| b) Section 8 RDA 25 years (0.5 mark) from the registration (filing) date (0.5 mark) | 1 mark |
| c) Article 11 CDR 3 years (0.5 mark) from the date on which the design was first made available to the public within the Community (0.5 mark) | 1 mark |
| d) CDPA 216 15 years (0.5 mark) from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever first occurred (0.5 mark), or, if articles made to the design are made available for sale or hire within 5 years from the end of that calendar year, 10 years (0.5 mark) from the end of the calendar year in which that first occurred (0.5 mark). | 2 marks |
| e) CDPA 12 70 years (0.5 mark) from the end of the calendar year (0.5 mark) in which the last (0.5 mark) author dies (0.5 mark) | 2 marks |

Total: 7 marks

Question 2

Explain how the scope of protection of a UK design registration is determined?

3 marks

Answer

Section 7 RDA The registration of a design under this Act gives the registered proprietor the exclusive right to use the design **(1 mark)** and any design which does not produce on the informed user a different overall impression **(1 mark)**. In determining whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration **(1 mark)**

3 marks

Question 3

Your client wishes to obtain registered design protection in the UK, USA, China and Japan for a new design.

a) **What are the minimum requirements for obtaining a filing date in the UK?**

5 marks

b) **What options are available for filing later applications covering the USA, China and Japan and when should these applications be filed?**

5 marks

Total: 10 marks

Answer

a) **RDR 2006 R4** The minimum requirements for obtaining a filing date in the UK are the filing of an application to register the design/of a request to register the design **(1 mark)** on Form DF2A; identification of the person making the application **(1 mark)**; and either (i) a representation of the design **(1 mark)**; or (ii) a specimen of the design **(1 mark)**; and the prescribed fee **(1 mark)**.

5 marks

b) File a national application **(0.5 mark)** in China **(0.5 mark)** and either i) file national applications **(0.5 mark)** in the USA **(0.5 mark)** and Japan **(0.5 mark)**; or ii) file a Hague International Design application **(0.5 mark)** designating the USA **(0.5 mark)** and Japan **(0.5 mark)**. In each case, a priority claim to the first UK filing **(0.5 mark)** should be made within 6 months of the first UK filing **(0.5 mark)**.

5 marks

Total: 10 marks

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Question 4

- a) How does the CDPA define an 'artistic work'? **3 marks**
- b) In relation to what acts does the author of a textbook about patent law have a right to be identified? **3 marks**

Total: 6 marks

Answer

- a) In accordance with the CDPA s.4(1) an "artistic work" means—
- a) a graphic work **(0.5 mark)**, photograph **(0.5 mark)**, sculpture **(0.5 mark)** or collage **(0.5 mark)**, irrespective of artistic quality,
 - b) a work of architecture **(0.5 mark)** being a building or a model for a building, or
 - c) a work of artistic craftsmanship **(0.5 mark)**.

3 marks

- b) In accordance with the CDPA s.77(2) the author of a literary work has the right to be identified whenever -
- i) the work is published **(0.5 mark)** commercially **(0.5 mark)**, performed in public **(0.5 mark)**; or
 - ii) copies of a film or sound recording **(0.5 mark)** including the work **(0.5 mark)** are issued to the public **(0.5 mark)**.

3 marks

Total: 6 marks

Question 5

Explain whether and why the design of a rocking horse would or would not qualify for UK Unregistered Design Right in the following circumstances. Assume that the rocking horse was designed in 2021:

- a) **it was designed jointly by a UK individual and a US individual resident in their home countries** **3 marks**
- b) **it was designed by an employee of a French company carrying out business in France** **3 marks**
- c) **it was designed by a Swiss resident and was first marketed in the UK by a UK distributor** **3 marks**

Total: 9 marks

Answer CDPA 217-220

- a) A joint design qualifies for design right protection if any of the designers **(0.5 mark)** is a qualifying person **(0.5 mark)**. An individual habitually resident **(0.5 mark)** in a qualifying country is a qualifying person **(0.5 mark)**. A qualifying country includes the UK **(0.5 mark)** so the qualifying requirements are met **(0.5 mark)**.

3 marks

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- b) A design qualifies for design right protection if it is created in the course of employment **(0.5 mark)** with a qualifying person **(0.5 mark)**. A body corporate which is formed under the law of a qualifying country **(0.5 mark)** and has a place of business at which substantial business activity is carried on in a qualifying country **(0.5 mark)** is a qualifying person. A qualifying country does not include countries in the EU **(0.5 mark)** so the qualifying requirements are not met **(0.5 mark)**.

3 marks

- c) Switzerland is not a qualifying country **(0.5 mark)** so the Swiss resident does not qualify for UK UDR **(0.5 mark)**. However, a design can qualify for UK UDR if the first marketing of the design **(0.5 mark)** is by a qualifying person in the UK **(0.5 mark)**. The UK distributor would be a qualifying person **(0.5 mark)** so the qualifying requirements are met **(0.5 mark)**.

3 marks

Total: 9 marks

Question 6

List five circumstances in which a disclosure of a design does not destroy the novelty of a later filed UK registered design.

5 marks

Answer

Any five from the following list:

In accordance with RDA s.1B, a disclosure will be disregarded if:

a) It could not reasonably have become known before the relevant date **(0.5 mark)** in the normal course of business to persons carrying on business in the Geographical Area Comprising the United Kingdom and European Economic Area and specialising in the sector concerned **(0.5 mark)**;

b) It was made to a person other than the designer, or any successor in title of his, **(0.5 mark)** under conditions of confidentiality (whether express or implied) **(0.5 mark)**;

c) It was made by the designer, or any successor in title of his, **(0.5 mark)** during the period of 12 months immediately preceding the relevant date **(0.5 mark)**;

d) It was made by a person other than the designer, or any successor in title of his, **(0.5 mark)** during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his **(0.5 mark)**;

or

e) It was made during the period of 12 months immediately preceding the relevant date **(0.5 mark)** as a consequence of an abuse in relation to the designer or any successor in title of his **(0.5 mark)**.

If the later filed design claims priority from an earlier application and the priority claim is valid **(0.5 mark)**

(The precise wording of the act is not required to obtain marks but if candidate says EU they will not receive a mark as it is EEA. Maximum of five marks available)

5 marks

SECTION A TOTAL: 40 marks

SECTION B

Question 7

You are approached by Rose Smith, who designed a range of 6 vases in September 2021 but is yet to disclose them. Each vase is an unusual shape, different from all the others and anything Rose has seen before. In addition, each vase is decorated with the same interesting pattern, which repeats several times on each vase.

Rose is also considering using the same pattern on other home furnishing products like cushions and lampshades although she has not yet finalised these designs.

- a) **Advise Rose of the features of designs that in general are defined as being suitable for registration in the UK and the two main requirements for a design to be registrable in the UK. Discuss whether her vases and pattern may meet these requirements.**
10 marks
- b) **Advise Rose of routes for obtaining registered design protection in the UK, France and Germany for her current range of vases.**
2 marks
- c) **Advise Rose of any protection she may have or may obtain now for future products that incorporate the same pattern**
4 marks

Rose decides to delay the launch of her vases until she is ready to launch her entire range of home furnishing products. She anticipates that this may take another 12 months. However, she recently attended a trade show and overheard a competitor, Rob, discussing his own new range of unusually shaped vases that he plans to launch next week. Rob told his colleague that he plans to see how the vases perform on the market before applying for registered design protection only for the vases that perform the best.

Rose is worried that Rob's vases may have similar shapes to her vases.

- d) **Ignoring any prior users' rights, advise Rose what steps she can take to obtain an earlier UK filing date than Rob without making her design available to the public before her own product launch.**

4 marks
Total: 20 marks

Answer

- a) A "design" is defined as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation (**1 mark**). RDA Section 1

Novelty

A design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date (**1 mark**). RDA Section 1 B

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Individual Character

A design has individual character if the overall impression it produces on the informed user **(1 mark)** differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date **(1 mark)**. RDA Section 1 B

In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration **(1 mark)**. RDA Section 1 B

Vases

Each vase is an unusual shape, different from all the others and anything Rose has seen before. The shape of a vase would meet the definition of a design **(0.5 mark)**. The degree of freedom in creating a shape of vase is only limited in that it must function to hold something and have a space to hold something **(0.5 mark)**. Consideration should be given to the potential implications of this with regard to the degree of difference over the prior art that will be required to produce a different overall impression **(0.5 mark)**. As the designs are all different to any known designs, this implies that the shape of each vase is new and produces a different overall impression on Rose, who is a vase designer. Consideration should be given as to who the informed user will likely be (e.g. someone not as knowledgeable as Rose but someone who buys and uses vases regularly) **(0.5 mark)**. Any reasonable conclusion based on the information provided (e.g. the vase shapes are likely to qualify for registered design protection) **(0.5 mark)**.

Pattern

The pattern constitutes ornamentation and thus meets the definition of a design **(0.5 mark)**. The degree of freedom in creating a pattern is large so a relatively large difference over the prior art will be required to produce a different overall impression **(0.5 mark)**. The fact that the pattern is described as interesting implies that it may be new and have individual character **(0.5 mark)** although this is not entirely clear and Rose should be consulted to confirm this **(0.5 mark)**. Thus, it appears that the pattern may qualify for registered design protection **(0.5 mark)**.

10 marks

- b) Rose could file a UK registered design application and an EU registered design application or she could file a Hague application designating the UK and EU/or FR and DE nationally instead of EU as a whole **(1 mark)**.

All 6 vase designs (with and without the pattern applied) can be included in multiple application **(0.5 mark)** for further cost-savings as they are all in the same Locarno class / same type of product **(0.5 mark)**.

2 marks

- c) She cannot apply to register her future products as she has not finalised the designs yet **(1 mark)**. However, she could apply for protection of the pattern as ornamentation **(0.5 mark)**, which would protect against use of the same pattern on any product. Half a mark for discussion of multiple application and issues associated with Locarno classification in UK/EU/Hague **(0.5 mark)**.

In addition, copyright may subsist in the pattern **(1 mark)** if it is an original work **(1 mark)**

Maximum of 4 marks available but 1 mark also available if candidate refers to disclosure of pattern in UK to obtain Supplementary UDR

4 marks

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- d) Rose can file a design applications in the UK (**1 mark**), requesting deferred publication to keep the designs secret for the time-being (**1 mark**).
In the UK, publication can be deferred for up to 12 months (**1 month**) from the filing date (**1 mark**)

4 marks

Total: 20 marks

Question 8

Ignore Unregistered Design Rights when answering this question.

Your client, Chin, has a UK Registered Design for a jacket, registered on 1 April 2019 and launched later that month although sales so far have been slow. He has since been informed by a colleague that an individual, Jacques, has used a similar design in the UK but at this stage the nature of Jacques's use is unclear.

Bearing in mind the nature of the design in question, write notes for a meeting with Chin in which you advise him of:

- a) the possible activities of Jacques that he can seek to prevent based upon his UK Design registration**

4 marks

- b) the possible activities of Jacques that he cannot seek to prevent based upon his UK Design Registration**

3 marks

In further investigations, you discover that Jacques has a UK Registered Design for his jacket design, which was registered on 12 March 2016. There has been no communication with the UKIPO since then.

- c) Advise Chin of the status of Jacques' UK Design Registration including what steps Jacques could have taken and by when to ensure his registration was renewed or maintained**

8 marks

- d) If Jacques successfully maintains his UK Design Registration, advise Chin on the implications for his UK Design Registration and any implications in relation to his sales to date.**

5 marks

Total: 20 marks

Answer

- a) Section 7(2) RDA:

(i) the making **(0.5 mark)** offering **(0.5 mark)** putting on the market **(0.5 mark)** importing **(0.5 mark)** exporting **(0.5 mark)** or using **(0.5 mark)** of a product in which the design is incorporated or to which it is applied **(0.5 mark)**; or

(ii) stocking such a product for those purposes **(0.5 mark)**

4 marks

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Marks up to a maximum of three

b) Section 7A(2):

The right in a registered design is not infringed by—

(a) an act which is done privately and for purposes which are not commercial; **(1 mark)**

(b) an act which is done for experimental purposes; **(1 mark)**

(c) an act of reproduction for teaching purposes or for the purpose of making citations **(1 mark)**, which is compatible with fair trade practice and doesn't unduly prejudice the normal exploitation of the design and mention is made of the source **(0.5 mark)**

Section 7A(6) No proceedings shall be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration of the design under this Act is granted. **(1 mark)**

3 marks

c) Steps Jacques must take and by when to ensure his UK registration is enforceable or maintained

RDA 8

RDR 12

RDA 8A, 8B – Restoration

RDR 13

The renewal date for Jacques' UK registration is 12 March 2021 **(0.5 mark)** i.e. 5 years from the registration date. **(0.5 mark)** However, the renewal was missed and renewal fees can be validly paid up to 6 months from the renewal date **(0.5 mark)** so he should have renewed and paid late fees **(0.5 mark)** by 12 September 2021 **(0.5 mark)**. If he renewed before 12 April 2021 there would be no additional fees **(0.5 mark)** but any renewal filed after 12 April would result in late fees **(0.5 mark)**

Assuming Jacques has not renewed by 12 September 2021, he may still be able to apply to restore the design **(0.5 mark)** up to 12 months from the renewal date **(1 mark)** i.e. by 12 March 2022 **(0.5 mark)**

The Registrar must be satisfied that a failure to pay the fee was unintentional **(1 mark)**

An application for the restoration of the right in a design must be made on Form DF29 **(0.5 mark)** and supported by evidence of the reasons for the missed renewal that are listed in the application **(1 mark)**.

8 marks

d) Implications for Chin's UK Registration

Chin's UK registration may be invalid if it lacks novelty or individual character over Jacques earlier UK design **(1 mark)**. Jacques may apply for revocation of Chin's UK registration on this basis **(1 mark)**.

Implications in relation to Chin's sales to date

RDA 8 B Anything done during the period between expiry and restoration, which would have constituted infringement if the right had not expired, shall be treated as an infringement-**(1 mark)**

(a) if done at a time when it was possible for an application for extension to be made under section 8(4)

or

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- (b) if it was a continuation or repetition of an earlier infringing act.
(1 mark)

Chin's sales to date may constitute infringement of Jacques UK design registration at least for the period of use between April 2019 and September 2021. However, as the sales were slow in this period, damages may not be significant **(1 mark for a reasonable conclusion of this nature including comments on innocent infringement and damages implications)**

**5 marks
Total: 20 marks**

Question 9

Noah has designed a new range of tables and chairs in the last year for which he owns a UK Design Registration in his own name. Noah has been employed as a designer by a furniture company, Aykera, for the past five years.

He was tasked with designing the chairs by his boss at Aykera, but he also designed complementary tables in his own time.

Aykera has recently discovered Noah's registered designs and has asked him to transfer the rights in all of the designs to Aykera.

- a) **Discuss whether it is Noah or Aykera who is entitled to the registered designs in the tables and chairs.**
8 marks
- b) **If Noah agrees to transfer the design registration for the tables and chairs to Aykera, describe the requirements for effecting the transfer and recording it on the register, including any consequences of non-registration.**
5 marks
- c) **If Noah refuses to transfer the design registration to Aykera, explain the options available to Aykera.**
3 marks
- d) **If Noah was deemed to be the valid owner of the design registration, explain the rights Aykera would have if Noah offered them an exclusive licence the use the designs subject of the registration**
4 marks
- Total: 20 marks**

Answer

CDPA 215

- a) The author of a design (**1 mark**) shall be treated as the original proprietor (**1 mark**) of the design except that where a design is created by an employee in the course of his employment (**1 mark**), his employer shall be treated as the original proprietor of the design (**1 mark**).

The chairs were designed by Noah on instruction from his boss so this would count as in the course of employment (**1 mark**) and Aykera would be entitled to the rights in the chairs (**1 mark**).

The tables were designed by Noah in his own time. This implies that they were not created in the course of his employment (**1 mark**). However, as they were designed to complement the chairs, and Noah would be aware that Aykera would likely wish to sell the chairs and tables in their furniture range, it could be argued that Noah created the tables to supplement the chairs in the course of employment (**1 mark**). (Marks are awarded for any reasonable argument and conclusion.)

8 marks

RDA 15B
RDA 19

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RDA 24 A

- b) An assignment of a registered design is not effective unless it is in writing **(1 mark)** signed by or on behalf of the assignor **(1 mark)** or, as the case may be, a personal representative.

The assignment should be recorded on the designs register **(1 mark)** by applying to the registrar and providing evidence of the transfer **(1 mark)**.

Only the registered proprietor (or an exclusive licensee) may take action for infringement **(1 mark)**.

5 marks

- c) RDA 11ZA

Aykera may consider applying for a declaration of invalidity **(1 mark)** of the design on the ground that the registered proprietor (Noah) is not the true proprietor of the design **(1 mark)** and Aykera may object on the basis that they are the true proprietor **(1 mark)**.

Maximum of 3 marks for this question but possible bonus marks available for additional comments about possibility of applying to the Court for rectification of the register to transfer the designs to them on the basis that they are the true proprietor **(1 mark)**.

3 marks

- d) RDA 15C

An exclusive licence authorises the licensee to the exclusion of all other persons, including the person granting the licence **(1 mark)**, to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design **(1 mark)**.

The licensee under an exclusive licence has the same rights against any successor in title that is bound by the licence as he has against the person granting the licence **(1 mark)**.

In relation to a registered design, an exclusive licensee has, except against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment **(1 mark)**.

4 marks

Total: 20 marks

Question 10

Your UK client designed a new beach towel in July 2020, which has an unusual shape allowing it to be easily folded into a beach bag. The towel is printed with an image of a unicorn, which the client designed herself. No registered design rights have been applied for.

- a) **Discuss what unregistered rights may subsist in the UK in the beach towel and unicorn image. (Do not discuss qualification requirements and do not discuss continuing unregistered design right.)**

8 marks

Your client's product recently gained high-profile publicity when it was endorsed by a celebrity who was using it on holiday. As a result, a competitor has launched an almost identical beach towel that copied your client's design.

- b) **Write notes on the acts which may constitute infringement of each of the unregistered rights discussed above.**

8 marks

- c) **Your client mentions that they have heard that some rights that applied prior to Brexit could still be relevant to this product. Advise your client on what is required for continuing unregistered design right to subsist in the UK and explain how the term of that right is determined.**

4 marks

Total: 20 marks

Answer

- a) UK UDR Section 213 CDPA

UK UDR protects original designs of the shape or configuration (whether internal or external) of the whole or part of an article. **(1 mark)**

On the face of it, UK UDR may subsist in the shape or configuration of the towel as it is referred to as "unusual" i.e. it appears to be original **(1 mark)**.

Surface decoration excluded **(1 mark)** so no UDR in unicorn image **(1 mark)**.

Copyright

The unicorn would qualify as an artistic work **(1 mark)** so copyright would subsist in the unicorn image **(1 mark)**.

The beach towel would be unlikely to qualify as an artistic work **(1 mark)** so no copyright in the towel itself **(1 mark)**.

2 marks also available if candidate discusses Cofemel and impact on functional designs i.e. if they offer some discussion around possibility that copyright could now extend to the beach towel itself

8 marks

- b) UK UDR

Primary infringement – Section 226 CDPA: UDR owner has exclusive right to reproduce (i.e. copy) for commercial purposes, and infringement occurs if another person, without licence of UDR owner **(0.5 mark)**, does or authorises the making of an article to that design **(0.5 mark)**, i.e. copying the design to produce articles exactly or substantially to that design **(0.5 mark)**,

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or the making of a design document recording the design for the purpose of enabling such articles to be made **(0.5 mark)**.

Secondary infringement – Section 227 CDPA: UDR is also infringed by a person who, without licence of the UDR holder, imports into UK for commercial purposes **(0.5 mark)**, has in possession for commercial purposes **(0.5 mark)**, or sells **(0.5 mark)**, lets for hire **(0.5 mark)**, or offers **(0.5 mark)** or exposes for sale or hire **(0.5 mark)**, in the course of a business, an article which is, and which he knows or has reason to believe is **(0.5 mark)**, an infringing article.

Copyright CDPA Section 16

Copyright in a work is infringed by a person who without the licence of the copyright owner **(0.5 mark)** does, or authorises another to do **(0.5 mark)**, any of: copy the work **(0.5 mark)**; issue copies of the work to the public **(0.5 mark)**; rent or lend the work to the public **(0.5 mark)**.

8 marks

c) Continuing UK unregistered design right

Marks for reference to the following points in the syllabus:

Novelty Article 5 CDR

A design shall be considered to be new if no identical design has been made available to the public **(1 mark)**

Individual Character Article 6 CDR

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 **(1 mark)**

Term

<https://www.gov.uk/guidance/changes-to-unregistered-designs#continuing-unregistered-design>

Designs protected in the UK as a UCD before January 2021 are protected as a UK continuing unregistered design **(1 mark)**

It will continue to be protected in the UK for the remainder of the three year term attached to it. **(1 mark)**

4 marks

Total: 20 marks