

FC4 Design and Copyright Law
FINAL Mark Scheme 2022

- Half marks may be awarded where candidates have not been precise.
- Article and section numbers are not required.

SECTION A

Question 1

Who is entitled to file a design application using the Hague System? (Assume the latest 1999 'Geneva Act', revision applies.)

3 marks

Answer:

Art 3 Hague Agreement (Geneva 1999): Any person that is a

- **national of a State that is a Contracting Party** or of a State member of an intergovernmental organization that is a Contracting Party (1 mark) , or
- that has a **domicile**, (1 mark) or
- **a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party** (0.5 marks each),

shall be entitled to file an international application.

3 marks

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Question 2

Your client wishes to obtain registered design protection. Advise your client on the requirements for a design to be registrable in the UK and outline any exclusions from protection.

8 marks

Answer:

Up to 8 marks for any of the following points:

RDA s.1B:

- A design shall be protected by a right in a registered design to the extent that the design is **new and has individual character** (1 mark).
- 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 filing date/priority date (or “relevant date”) (1 mark).
- A design has 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 filing date/priority date (or “relevant date”) (1 mark).
- 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).

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

- if the **component part**, once it has been incorporated into the complex product, **remains visible during normal use of the complex product**; (1 mark) and
- to the **extent that those visible features of the component part are in themselves new and have individual character** (1 mark).

RDA s.1C:

- A right in a registered design shall not subsist in features of appearance of a product that are solely **dictated by the product’s technical function** (1 mark).
- A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as 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. **Mark available for a discussion around this “must fit” provision** (1 mark).
- Contrary to **public policy or morality** (1 mark).
- Contains **emblems** not allowed as per Schedule 1A (1 mark).

8 marks

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Question 3

Outline how the country of origin of a copyright work is determined by the Berne Convention.

9 marks

Answer:

(a) Berne Convention Article 5 (4) :

The country of origin shall be considered to be

a) in the case of works

- **first published in a country of the Union, that country (1 mark) ;**
- in the case of works published **simultaneously in several countries of the Union** which grant different terms of protection **(1 mark)**,
 - the country whose legislation grants the **shortest term of protection** **(1 mark)**

(b) in the case of works published **simultaneously** in a **country outside the Union and in a country of the Union, the latter** country **(1 mark)**;

(c) in the case of **unpublished works** **(1 mark)** or of **works first published** in a country **outside** the Union **(1 mark)**, **without simultaneous** publication **in a country of the Union** **(1 mark)**,

- the country of the Union of which the author is a **national** **(1 mark)**,

provided that:

(i) when these are **cinematographic works** the maker of which has his **headquarters or his habitual residence in a country of the Union**, the country of origin shall be that country **(1 mark)**, and

(ii) when these are works of **architecture erected in a country of the Union** or other artistic works incorporated in a building or other structure located in a country of the Union, the country of origin shall be **that country** **(1 mark)**

9 marks

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Question 4

List the acts restricted by copyright in a work. (Do not discuss ‘secondary infringement’, i.e. acts involving infringing copies of a work.)

6 marks

Answer:

CDPA s16:

(1)The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom—

- to **copy** the work **(1 mark)**
- to **issue copies** of the work to the public **(1 mark)**
- to **rent or lend** the work to the public **(1 mark)**
- to **perform, show or play** the work in public **(1 mark)**
- to **communicate the work** to the public **(1 mark)**
- to **make an adaptation of the work** or do any of the above in relation to an adaptation **(1 mark)**

6 marks

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Question 5

In relation to UK unregistered design right in a design created on 10 January 2021, explain whether the following would meet the qualification requirements:

- a) A designer who is an individual who lives in Australia. **3 marks**
- b) A company that employs a German designer, the company being formed in accordance with Hong Kong law and operating in the UK. **3 marks**
- c) A designer, resident in Italy, of a product embodying a qualifying design, the product having been first marketed in the UK by a UK company. **3 marks**
- Total: 9 marks**

Answer:

- a) Section 218 CDPA – **qualifies if designer is a qualifying person** (1 mark)
Section 217 CDPA - an individual must be **habitually resident in a qualifying country**/ the UK or a country afforded reciprocal protection (1 mark)
Australia is not a qualifying country so no design right applies (1 mark) **3 marks**
- b) Section 219 CDPA – qualifies if design created in **course of employment with a qualifying person** (1 mark).
Section 217 CDPA - a company would be a **body corporate** or other body having legal personality as mentioned under Section 217(b) CDPA, which, for there to be UDR, **must be formed under the law of a part of the UK/other qualifying country and carry out substantial business activity** (1 mark).
Hong Kong is a qualifying country and they appear to have business activity in the UK so Unregistered design right would appear to subsist (1 mark) **3 marks**
- c) For the first marketing provisions to apply the design **cannot qualify for protection by reference to designer** (Section 218) **or employer** (Section 219) (1 mark).
Qualifies if the **first marketing is by a qualifying person and first marketing takes place in the UK** (1 mark).
Italy isn't a qualifying country but the **first marketer would qualify** (1 mark) **3 marks**
- Total: 9 marks**

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Question 6

Explain who has the right (also called ‘standing’) to bring an invalidity action in relation to a UK registered design.

5 marks

Answer:

Section 11ZA RDA

If the grounds are that:

- it does not fall within definition of a “design”, or **doesn’t fulfil requirements** of Section 1B to 1D – **Anyone** (1 mark).
- it is not new or does not possess individual character over an **earlier registered design** made available to the public after the relevant date of the later design – **The registered proprietor of the earlier design** (1 mark).
- The registered proprietor is **not the proper proprietor** – The **proper proprietor** (1 mark)
- the design involves use of an **earlier distinctive sign**, the use of which is prohibited in the UK – the **holder of the right** to prohibit the use of the sign (1 mark)
- the design registration constitutes unauthorised use of **copyright protected work** – The **copyright owner**. (1 mark)

5 marks

SECTION A TOTAL: 40 marks

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SECTION B

Question 7

David is a Manchester-based artist who creates paintings of seaside landscapes. His most celebrated pieces are a series of paintings of Brighton Beach in southern England, which he produced in 1998.

- a) **Advise David whether copyright law protects his Brighton Beach pieces, and if so, what protection is provided (but do not list the restricted acts).**

4 marks

Due to the success of the Brighton Beach pieces, he was recently invited to work with Lands End Collective, a studio in St Ives in south-west England. While doing so, he created a series of paintings of St Ives. The paintings are on display in the studio's gallery.

- b) **Advise David on any ownership issues that need to be considered in respect of copyright in the new series of paintings.**

4 marks

Because they have been so well received, a large retailer, Stubbs Ltd, has approached David to enter into discussions about the production of prints of his seaside paintings, to be sold in its shops nationwide.

- c) **Advise David on the possible legal options that will enable Stubbs to produce these prints commercially.**

4 marks

The discussions with Stubbs are ongoing and David visits London for a meeting. He decides to do some shopping for gifts for his family and is astonished to see another large retailer, Turner's plc, selling postcards bearing his Brighton Beach series of paintings.

- d) **Advise David on what legal action he could take, including the remedies available to him.**

8 marks

Total: 20 marks

Answer:

(a)

- Copyright subsists in **original artistic works** and this would include a painting (1 mark)
- **David is the creator** of the painting so he **owns the copyright** (1 mark)
- It lasts **for David's life plus 70 years** (1 mark)
- Copyright owner has **exclusive right to do restricted acts** (1 mark).

4 marks

(b) **In what capacity was he working** with the Studio (1 mark)?

- If he was **employed** by them then **they** may own the copyright (1 mark).

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- If he was commissioned by them, without any agreement to the contrary, he would own the copyright (1 mark).
- In the absence of any arrangement, then he would be owner as author of the works (1 mark)

4 marks

(c) David could assign the rights in the Brighton paintings to the retailer. If he does this, he will transfer all of the copyright in the Brighton paintings to the retailer (1 mark).

- David could license the rights to the retailer. This would see him license the retailer to do any or all of the acts restricted by copyright including the production and sale of prints of the Brighton paintings (1 mark).
- If David grants the retailer an exclusive licence then he would not be able to do any or all of the restricted acts himself until the licence had expired (1 mark).
- A non-exclusive licence would allow him to licence the works to third parties/sole license would allow him to do any or all of the restricted acts himself but not license the work elsewhere (1 mark for either).
- A joint ownership agreement can also potentially be put in place allowing use by both David and the retailer (alternative 1 mark).

4 marks

(d) **Up to 8 marks for any of the following:**

CDPA 16:

Unauthorised copying of the work (0.5 mark) and issuing copies to the public is restricted (0.5 mark).

CDPA 23: Dealing with infringing copies is secondary infringement;

- (a) possesses in the course of a business, (1 mark)
- (b) sells or lets for hire (1 mark),
- or offers or exposes for sale or hire, (1 mark)

We are not sure if shop has produced them but there are infringements in the circumstances set out above either via production and sale or just sale (1 mark).

CDPA 96: copyright infringement is actionable by the copyright owner (1 mark)

so David could take action to prevent this infringement, as he is the owner. In an action for infringement of copyright all such relief by way of

- damages (1 mark),
- injunctions (1 mark),
- accounts (1 mark)
- or otherwise (1 mark. Allow any example such as delivery-up).

8 Marks

Total: 20 marks

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Question 8

Your client, Marion Eastwood, is a UK fashion designer who creates extremely flamboyant and artistic items of clothing. At a fashion show held in Edinburgh in February 2021, Marion launched her Golf Ball Dress, the dress being described as something 'entirely different to the norm' by the fashion press. The dress is white, spherical in shape, and has dimples in its material.

In September 2021, Marion attended a fashion show in London and one of her competitors, Osmund Bowtie, showed a new, white, spherical dress with dimples in the material. Marion is considering taking action and has asked for your assistance.

- a) Make notes for a meeting with Marion in which you will advise her on any unregistered design rights she owns in the dress. Do not discuss copyright.**

8 marks

Marion asks you to advise her on whether she can prevent any activities of Osmund relating to the design she saw at the London Fashion Show.

- b) Set out your advice to Marion.**

6 marks

Marion tells you that she has also been selling another of her creations, the Sunflower Dress, in France and Germany, since it was exclusively launched at the Paris Fashion show in December 2021.

- c) Advise Marion on unregistered design rights she may own in the Sunflower Dress in the UK and EU, and their duration, and any issues that need to be considered if she wants to file UK and Community design applications for the Sunflower Dress.**

6 marks

Total: 20 Marks

Answer:

- a) Up to 8 marks for any of the following points:

UDR

- The design must be **original** (1 mark).
 - A design is **not "original" if it is commonplace** in the design field in question at the time of creation (1 mark).
 - Marion's dress is described as flamboyant and the press described the dress as **entirely different to the norm, so likely to be original and not commonplace** (1 mark).
- Protects **shape or configuration** (whether internal or external) of the whole or part of an article (1 mark).
- Does **not subsist in the colour** (1 mark).
- UDR may subsist in the dress/**aspects** of the shape of the dress and (likely) its **dimpled**

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design (1 mark).

Supplementary Unregistered Design

- The dress was exclusively launched in **the UK** in February 2021 **so SUD will apply** to the dress **(1 mark)**
 - and it extends to the **dimpled effect** **(1 mark)**
 - and **colour** **(1 mark).**

8 marks

b) The owner of design right in a design has the exclusive right to reproduce the design for commercial purposes by making articles to that design

- Reproduction of a design by making articles to the design means copying the design so as to produce articles **exactly or substantially to that design** **(1 mark)**

Design right is **infringed by** a person who **without the licence** of the design right owner does, or authorises another to do, anything which is the exclusive right of the design right owner **(1 mark)**

- There is a **prima facie case** for primary infringement based upon the facts available to us **(1 mark).**
- Osmund is using his design for **commercial purposes** **(1 mark)**
- and it appears to be an article produced exactly or **substantially** to that design **(1 mark)**
- However, we would need to consider whether the designer has **copied** the dress as that is a key requirement to proving infringement **(1 mark).**

6 marks

c)

- Marion owns **Community Design Right** because her **disclosure was in France** in December 2020 **(1 mark)** (but no Supplementary Design Right in the UK).
- She also owns **Unregistered Design Right in the UK** **(1 mark)**
- CDR will last until **December 2024** and the UDR until **2031** **(1 mark)**
- Marion could consider filing a **Registered Community Design Application and a UK Registered Design Application** **(1 mark)**
- The launch at **Paris Fashion week** would have become known to those specialising in the sector concerned in the EU and EEA so is a **disclosure** **(1 mark).**
- However, there is a 12 month grace period within which designs can be disclosed before Community Design and UK applications are filed and she is **still within the grace period** until December 2022 **(1 mark).**

6 marks

Total: 20 Marks

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Question 9

You receive an email query from a new client Sin Free Cakes.

Sin Free Cakes manufacture a low-calorie cake product called 'Angel's Share'. The cakes are shaped like angel's wings. There are no other cakes on the market that use an identical or similar shape and the Sin Free Cakes are hugely successful.

Sin Free Cakes tell you that they filed a UK design registration, using a line drawing of the shape of the Angel's Share cake and that it was registered on 30 September 2017, but they are not sure where their paper work for the design is.

Sin Free Cakes alerts you to the website of a major retailer that is selling a very similar cake that has been manufactured by a large well-known cake manufacturer, Mrs Pickling. Mrs Pickling has recently launched a new health-conscious cake called 'Halo', which is a sponge cake shaped like a halo and wings.

Sin Free Cakes has received a large number of emails and social media communications querying whether the Halo cake is produced by them, and they want some advice on whether they can object to the continued sale of the Halo cakes.

- a) Advise Sin Free Cakes on the status of their UK design registration and steps they may need to take.**

4 marks

- b) Advise Sin Free Cakes on their position with respect to the acts of Mrs Pickling.**

6 marks

After your meeting you find a Twitter post from Mrs Pickling's account from 2014. It contains a photograph of the Mrs Pickling sales team at a cake manufacturers' conference in London in 2014. The sales stand includes promotional materials relating to a Halo cake and photographs of a cake with an extremely similar design to that used in the Halo cake that your client has taken issue with.

- c) Make notes to use during a call with Sin Free Cakes to advise them on the impact of the Twitter post on their position.**

6 marks

- d) Advise Sin Free Cakes on the risk that the Halo design poses to their activities.**

4 marks

Total: 20 Marks

Answer:

- a) A UK registration last for **25 years** and is renewable every five years **(1 mark)**.

- So the **first renewal** dated was 30 September 2022 **(1 mark. Allow 'five years from filing')**.
- It appears that **the renewal was missed** but there is a six month grace period from the renewal date **(1 mark)**.
- Any renewal would incur **late fees** **(1 mark)**

4 marks

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- b) Sin Free Cakes own a UK design registration that is earlier than the launch of the Mrs Pickling Halo Cake as it was only **recently launched** (1 mark) so
- **there doesn't appear to be a prior use defence** under Section 7B (1 mark).
 - Sin Free Cakes have received a **large number of emails** and social media communications so at least that is an indication that it has the **same overall impression** on the informed user (1 mark)
 - and **copying is not a requirement** to prove registered design infringement (1 mark)
 - Infringement action could be taken in relation to:
 - the **manufacture** of the Halo cake by Mrs Pickling (1 mark) and
 - the **sale** of the cakes by the major retailer (1 mark).

6 marks

c)

- This **could impact upon the validity** of the Sin Free Cakes design as it is from 2014 and pre-dates it so is a **prior disclosure** (1 mark).
- Given that it was disclosed as a trade conference it would constitute a disclosure that is likely to have become known before filing date of the Sin Free Cakes Design in the **normal course of business to persons** carrying on business in the European Economic Area and specialising in the sector concerned (1 mark)
- Given that the Halo cake is likely to have the same overall impression there is a strong argument that the Sin Free Cakes design was lacking in **individual character at** the filing date (1 mark).
- The Sin Free Cake is **vulnerable to invalidity** accordingly (1 mark).
- If we pursue Mrs Pickling and the retailer relating to their actions then they are **likely to threaten to invalidate the registration** or file an invalidity action (1 mark).
- This significantly weakens Sin Free Cakes' position as their design is on the face of it invalid and thus we may **not be in a position to proceed with any objection** (1 mark).

6 marks

d)

- The Halo Cake **won't enjoy any Community Unregistered Design** rights or CUD because it was disclosed **more than 3 years ago** (1 mark).
- However, it may enjoy **UK UDR in** relation to the shape of the cake (1 mark).
- We don't know when it was created but maximum length of protection is 15 years from date of creation as put on sale more than **five years after the 2014 tweet** (1 mark).
- Risk of claim for infringement but there is an argument that **copying didn't take place** and that the Sin Free Cake **wasn't made exactly or substantially to that design** (1 mark)

4 marks

Total: 20 Marks

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Question 10

Your client, Marvin, has designed a toaster that bears a distinctive pattern on its front and back panels. In addition to the toasters, Marvin believes that there is potential for the pattern to be used across a range of kitchen appliances and containers, and he has already started to design a kettle and a bread bin that incorporate the same pattern.

Marvin would like some advice on how he can go about protecting his toaster, kettle and bread bin designs, all with the pattern applied to them, and also the pattern on its own. He knows that his largest markets are likely to be the UK, France, Germany and the USA.

After speaking to Marvin, you looked up the following Locarno classification numbers:

Toasters – 07-02;
Kettles – 07-02;
Bread bins – 07-07;
2D graphic designs – 32-00.

- a) Explain to Marvin his possible routes to secure protection in these four jurisdictions, for all four of the designs of interest to him, and advise on methods for reducing the cost.**

10 marks

You are yet to file any applications for Marvin as he is still considering the cost. He calls you and tells you that he is thinking about showing the toaster design at a trade show tomorrow.

- b) Advise Marvin on whether he should proceed.**

2 marks

Marvin tells you that he owns a UK design registration for an earlier product that he designed, a fridge, that was registered in 2019. He has seen a company selling what he believes to be an identical fridge in the UK.

- c) Advise Marvin on the types of activities by a third party that would constitute infringement of his UK design registration.**

4 marks

Marvin tells you that he has set up a company, Starvin Marvin Appliances Ltd, and he asks whether he can transfer his UK design registration to the new company.

- d) Explain what is required to transfer the registration, and why these actions are important.**

4 marks

Total: 20 marks

Answer:

- a) If he files in the UK first then he can file **priority applications within six months** in the various additional territories of interest to him so he can stagger the cost that way **(1 mark)**

There are various filing options:

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1 – **National applications** in each territory of interest and tailor each filing to meet the local requirements **(1 mark)**;

- will be most **expensive option** because there is a need to file via agents in each territory other than the UK **(1 mark)**

2- File UK application, **Community Design Application** to cover France and Germany, file national applications in the **USA** **(1 mark)**.

- The EU route is **more cost effective** **(1 mark)**.

3- File a **Hague international application** and designate EU (or France and Germany individually) **(1 mark if option is included)** the UK **(0.5 mark)** and USA, **(0.5 mark)**.

To further reduce costs:

- **Multiple designs can be included in a single application** in a number of territories **(1 mark)**
- **EU/Hague** allow multiple designs in a single application as long as they are in the **same Locarno classification** so would need to file for surface decoration separately **(1 mark)**
- **UK allows for multiple application regardless of** Locarno so could claim all in the priority filing if take that route **(1 mark)**

10 marks

b)

- The **EU, UK and USA have a grace period** of 12 months in which designs may be disclosed prior to filing an application **(1 mark)**.
- However, **some territories** to which he might later extend the design, **do not have the grace period**. Therefore, the advice to Marvin is that he **should not disclose** until he has filed an application and secured a priority date if there is a possibility that he wishes to protect in other jurisdictions **(1 mark)**.

2 marks

c) Section 7 (2) RDA provides:

(a)the making (**.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 stocking such a product for those purposes **(0.5 mark)**

4 marks

d)

- 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)**.
- The assignment should be recorded on the designs register **by applying to the registrar and providing proof of the transfer** **(1 mark)**.
- **The company will not be able to exercise the rights of the proprietor** (e.g. to bring infringement proceedings) until the right is assigned and registered **(1 mark)**.

4 marks

Total: 20 marks