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SECTION A

**Question 1**

The owner of the design rights. A design can qualify by reference to the designer or the employer. The designer is the first owner. If the designer was employed and the design was created in the course of employment, then the employer is the first owner of the design. Or their respective successors in title. To qualify they have to be resident in one of the signatory countries, or have substantial business in such countries. <sup>Allow</sup> ✓ ½

**MARKS AWARDED: 0.5/3**

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## Question 2

*Requirements for design to be registrable:*

A design to be registrable has to be novel and have individual character. It must not be excluded by the exclusions below and schedule A (emblems). ✓1

- *Novelty*: a design is considered novel if it is not identical or only differs in insignificant differences to another design which was made available in the UK before the relevant date (priority if claimed, or filing). ✓1
- *Individual character*: A design is considered to have individual character if the overall impression it produces on the informed user is different from the overall impression made by another design which was made available to the public in the UK before the relevant date. To assess the overall impression made by the informed user the degree of freedom of the designer has to be considered (if there were any constraints when manufacturing the product (case law: Airwick spray) ✓1

*Exclusions:*

- *Technical function*: features of the design which are solely dictated by their technical function are not covered by the right ✓1
- *Must fit*: features of the design which must be particularly sized and shaped so that the article in which they are included can fit with/in/near another article to perform its function cannot be protected ✓1
- *Public policy/morality*: Designs which would case a serious threat against public policy and morality in the UK will not be registered. ✓1

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Further Schedule A excludes emblems such as the Union Jack flag,  
figuring the Queen, the Olympic symbol, and others ✓1

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**Question 3**

The country of origin is the country in which the work was first made available to the public. <sup>✓1</sup> Protection is independent from the country of origin.

Made available to the public means:

Literary, artistic, musical, dramatic work: published, performed, exhibited, exposed, played, or communicated in any other way to the public.

Sound recording, film, broadcast: when first issued to the public, performed to the public, recorded to the public.

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**MARKS AWARDED: 1/9**

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#### Question 4

- <sup>✓1</sup> *Copy the work*: copying means reproducing for literary, dramatic, artistic work. For artistic work it also means taking a photograph of a film including the work. For musical and sung words it also means making a sound recording of a film including the work.
- <sup>✓1</sup> *Issue copies of the work*: Issuing copies of the work in public includes <sup>✓1</sup> exhibiting, communicating, <sup>✓1</sup> publication of the work, <sup>✓1</sup> performing. An exclusion to this is when the author has exhausted their rights regarding that work (has already issued copies of the work in UK or EEA)
- <sup>✓½</sup> *Making adaptations of the work*: this includes translations and transcriptions, for example from 2D to 3D and vice versa, from written words to drawings (and vice versa). It also includes making translation of a computer program from one code language to another.

4½

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**Question 5**

- a) No because qualification by designer requires the designer to be a qualifying person, who would have to be resident in a qualifying country. <sup>✓1</sup>  
Australia is not a qualifying country since it is not the UK and it is not a territory with a reciprocal agreement. <sup>✓1</sup> 2
- b) Yes, the design would qualify by reference to the employer. <sup>✓1</sup> The employer qualify as the business was formed under the law of a qualifying country (Hong Kong is one of the territories with reciprocal agreement) <sup>✓1</sup> and it sounds like a substantial part of the business is done in the UK (qualifying country). <sup>✓1</sup> 3
- c) Yes the design would qualify by reference to first marketing. <sup>✓1</sup> To qualify this way a design must be first marketed in a qualifying country by a qualifying person. In this case both the country and the qualifying person (the company) are in the UK, so the design would meet the requirements. <sup>✓1</sup> Italy is no longer a qualifying country after Brexit so the design cannot qualify by reference to the designer. 2

**MARKS AWARDED: 7/9**

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### Question 6

Any person can bring an invalidity action against a UK registered design, after registration. ✓ $\frac{1}{2}$

The only exception is if an invalidity action is raised with regard to the entitlement (ownership) of the design, only the person actually entitled to the design can bring such action. ✓ $1$

Invalidity actions can be brought for:

- Design does not fulfil the requirements of the act
- It does not fit in the definition of design
- It is not novel or does not have individual character
- It is against public policy/ morality
- It contains features of must fit
- It is determined by its technical function
- It contains excluded emblems

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1 $\frac{1}{2}$

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## SECTION B

### Question 7

- ✓1
- a) The pieces are protected as they are an original artistic work falling in the category of graphic work (paintings) . The duration of the right is 70 years from the end of the calendar year of death of the author (David) and therefore the protection is still in force. Copyright is an automatic right in the UK and therefore no registration is required. In general, it protects from copying, specifically copyright protection covers against copying and issuing copy and making adaptations of the work. For artistic works copying means reproducing the work. ✓1
- b) Depending on the agreement between David and the studio, ownership changes. If David was an employee of the studio then the paintings would be considered to be done during the course of employment and therefore would be owned by the employer (the studio). However if the studio commissioned the work to David or David was not employed by the studio but only had an agreement regarding exposing the work (e.g. a licence for the studio) , then David would still be the owner as the right of ownership of the commissioner was removed from the act, and obtaining a licence does not transfer the ownership. ✓1
- c) The first option would be to assign the rights to Stubbs Ltd, this would allow the retailer to do any act which is the right of the owner. Alternatively David could give Stubbs Ltd a licence agreement for producing and selling prints of the work only. This way David would maintain his ownership of the design and therefore maintain his rights to them. Lastly, David could

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agree with Stubbs an exclusive licence agreement. This way Stubbs would have exclusive right to the production and selling of the prints (excluding David from such acts too). An exclusive licence gives rights to the other party to bring proceedings without the consent of the owner (David) for example, but not bring action against the owner. ✓1

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d) If David is the owner of those paintings, he will be able to sue the retailer for selling adaptation of his protected work. However we have no information on who the manufacturer of such postcards is and probably the retailer is not the manufacturer, the retailer could be an innocent infringer and not know or have reason to believe that the postcards were copied. Selling is a secondary infringement and therefore both knowledge and copying need to be shown. ✓1

David could request the retailer who is the manufacturer of said products and bring proceedings directly to the manufacturer, for primary infringement. ✓½

David would be entitled to damages, account of profits, delivery up, and injunction and any other damage available to property right owners. ✓1 ✓1 ✓1

7½

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### Question 9

- a) The design was registered 30 September 2017, which means 5 years <sup>✓½</sup> have passed and the first renewal fee was due the 30 of September 2022. <sup>✓1</sup>

This means that there are currently no rights subsisting in the work.

However, we are still in the grace period time and therefore Sin Free

Cakes can still pay the fee to renew the registration. If this is done before <sup>✓1</sup> the 30<sup>th</sup> of October 2022 (it is a Sunday so it would be the next working day) no surcharge will be needed. If the fee is paid later the surcharge will increase. <sup>✓1</sup> There is no indication if the register has sent a notification of miss-payment, which should be sent within 6 weeks of the renewal date. If the fee is paid before the notification is sent, the notification will not be sent.

If the fees are not paid before the end of the grace period, the owner can apply for restoration within 12 months of failure to meet the renewal date.

To successfully file for restoration, the proprietor has to prove that the deadline was missed unintentionally (on top of paying the missing fee and the surcharge).

- b) Registered design rights: Mrs Pickling might be infringing the registered design rights of Sin Free Cakes. The client says that the cakes are very similar and it is infringement to making a product to the design (if without a licence in the UK). However, the competitor's cake includes the halo as well as the angel wings and therefore the design might not be found to infringe. Further there is no indication of when the acts by Mrs Pickling have started and because there are no rights currently standing Sin Free

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Cakes cannot pursue any infringement action before renewing the design registration. Once the design is renewed, because we are still in the grace period, any act which would have constituted infringement if the design was valid will be considered infringement after late payment of the renewal fee, as if the registration had never expired.

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- c) The photograph in question suggests that Mrs Pickling created the design of the “Halo” cakes before Sin Free Cakes registered their design.

Therefore, they might be eligible for prior user rights. It is probable that because they had promotional material they were already manufacturing the cakes or made serious preparation to manufacture said cakes, and therefore they might have right to continue producing said cakes without infringing the registered design. This right is not a licence per se which means they cannot transfer this right or sub-licence. However, because it is a right acquired for a business the right can be passed on to other partners and the successor in title.

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- d) Mrs Pickling might have unregistered design rights with regard to that cake shape since the photographs of the cake can be considered design documents, which would cover the shape and configuration of the cake. In which case Sin Free cakes might be sued for infringement as making an article to the design is an exclusive right of the desing owner. However, Sin Free Cake might be able to defend themselves by proving innocent infringement if they were not aware or had reason to believe the existence of the design right and that the design was not copied.

✓1

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Further, because the Halo cake design was made available to the public before the relevant date for the Sin Free cake design registration, the registered design might be invalidated on the base of novelty and individual character, particularly if the “Angel’s Share” cake is found to only differ in immaterial details to the “Halo” cake and/or if the overall impression made on the informed user is found to be the same. The degree of freedom in this case are vast because there is little restriction on the possible cake shapes and therefore the two cakes are likely to be found to be very similar; moreover, it is said that there is no cake in the market that looks like it. Further as mentioned before the twitter messages sent to Sin Free Cake suggest that the users get the same impression from the cake.

Lastly, there might be copyright subsisting in the photographs of the Halo cake, which could be considered to be infringed by making a design document to the cake in the photo (it could be considered an adaptation of the work).

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### Question 10

*Multiple designs in one application:* ✓1

- International application: yes (up to 100) but they have to be in the same Locarno class
- EU application: yes but they have to be in the same Locarno class ✓1
- UK: yes, no limit to Locarno class ✓1
- US: no multiple applications allowed

*Possible routes:*

- International application:

All the countries of interest are signatories to the Hague agreement and therefore the designs can be filed internationally and designate the four countries, or designate EU + UK + USA. International applications can include multiple designs in the same application as long as they are in the same Locarno class. However when designating the states each country has their rules. Therefore, Marvin would have to file 3 international applications designating all:

- i. 1 for the kettle and toaster, however when entering the US phase this will become two separate applications
- ii. 1 for the bread bin
- iii. One for the pattern

This leads to a total of 4 applications.

- UK + EU + US:

Another option is to file in the separate jurisdictions. In the UK all four designs can be filed in the same application. In the EU they would have to

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be in the same Locarno class and therefore they would need to file one application for the kettle and toaster, and two more for the pattern and the bread bin. In the US they would have to file 4 separate applications. Therefore this would be a total of 8 applications.

- Other routes:
- File 4 separate international applications designating all 4 countries
- File one UK application with all the designs, 3 international applications designating EU and US of which one includes the kettle and toaster, one includes the pattern and the other the bread bin. ✓<sup>1</sup>
- Filing in all the states separately would be another possible route.

With regard to cost saving I would suggest the first option of filing 3 separate international applications. However international applications include 3 fees of which one is a designation fee.

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b) Marvin could proceed in showing the toaster as all countries mentioned have a 12-month grace period that protects the owner from self-disclosure. The applications would then need to be filed within 12 months of said disclosure to be considered novel. ✓<sup>1</sup>

1

c) The design right is in force since only 3 years have passed from registration.

The owner has exclusive right to make, offer, expose in business, import, export and use the design for the purpose of making an article to the design. Any of these acts done by a third party in the UK after the priority date would be an infringement. Therefore selling an identical fridge in the UK consists in an act of infringement (if the act was started after the priority date).

✓<sup>1/2</sup> ✓<sup>1/2</sup> ✓<sup>1/2</sup> ✓<sup>1/2</sup> ✓<sup>1/2</sup>

✓<sup>1/2</sup> ✓<sup>1/2</sup>

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d) Marvin would have to assign the design right to the company. The assignment has to be in writing and signed by the assignor. When registering the assignment a form and a fee have to be filed and requesting the registration of the assignment. This is important because the assignment would be binding to any successor in title only if they are aware of the assignment and if the design was further assigned later, but before recording the assignment, the new assignee would own the rights (if it was recorded).

**MARKS AWARDED: 14.5/20**

14½

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