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- 1) Any legal person who is resident in a member state of the Hague agreement can file a design application.

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2) For a design to be registerable in the UK, it must be novel and have individual character^{✓1} over any designs made available to the public before the relevant date. The relevant date is the filing date or if claiming priority, the priority date.

A design is novel if the design is different or differs only in immaterial^{✓1} details to any design made available to the public at the relevant date.

A design has individual character if it the overall impression created by the design is different to the overall impression created by any design made available to the public on the relevant date, as viewed by the informed user.^{✓1}

The informed user has an eye for detail and would compare designs.

There are certain exclusions from protection, including:

- features of a design which are dictated solely by their technical function.^{✓1}
- features of a design that are 'must fit' – i.e. features that are defined in that they must fit with another part.^{✓1}
- features of a complex design which are not visible during use of the product.^{✓1}

MARKS AWARDED: 6/8

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- 3) The country of origin of a copyright work is determined by the Berne convention by which country the author of the copyright is resident in or by which country the work was created in.

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4) acts restricted by copyright:

- making copies of the work ✓¹
- reproducing the work
- performing the work in public ✓¹
- selling copies of the work
- storing copies of the work
- using the work

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5) .

a. A design can qualify by reference to the designer if they are a qualifying person, by reference to an employer of the designer if the employer is a qualifying person, or by reference to the first marketing of the design in a qualifying country.

A qualifying person is a person who is resident in a qualifying country. Australia is not a qualifying country so the designer is not a qualifying person. There is no reference to the employer or first marketing so the design cannot qualify by either of these. This would not meet the qualifying requirements.

b. A design can qualify by reference to the designer if they are a qualifying person, by reference to an employer of the designer if the employer is a qualifying person, or by reference to the first marketing of the design in a qualifying country.

Germany is not a qualifying country so the design does not qualify by reference to the designer.

A body corporate having substantial business in a qualifying country, is a qualifying person. As the business operates in the UK, it appears that it has substantial business in the UK and therefore the design meets the qualification requirements by reference to the employer of the designer being a qualifying person.

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c. A design can qualify by reference to the designer if they are a qualifying person, by reference to an employer of the designer if the employer is a qualifying person, or by reference to the first marketing of the design in a qualifying country.

Italy is not a qualifying country, so the design so not qualify by reference to the designer. The design qualifies by reference to first marketing in a qualifying country, as the UK is a qualifying country, and the design was first marketed in the UK.

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- 6) Any person can bring invalidity action in relation to a UK design, by submitting in writing to the UKIPO a statement with reasons for why the design should be invalidated. *Allow* ✓½

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MARKS AWARDED: 0.5/5

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8)

- a. For an unregistered design right to subsist in the dress, it must be an original work. ^{✓1} The design must also have been recorded, this can either be in a design document or if an article is produced to the design. Marion launched her dress in February 2021 which indicates that she had the dress produced, which could be the first recording of the design. She may also have a design document that shows the dress before this, and could count as the first recording. The dress design appears to be an original work, as it is described as something 'entirely different to the norm' by the fashion press.

✓1

This issue that Marion may face with unregistered design is that it only covers shape and configuration. ^{✓1} Unregistered designs do not protect surface decoration. The spherical shape of the dress will be covered. ^{✓1} The dimples in the material are unlikely to be covered as they appear to be surface decoration which is not covered by unregistered design right.

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- b. Unregistered design right only prevents other parties from copying the design - it must be a slavish copy. Marions has the unregistered design right from February 2021 and Osmund showed his design in September 2021, when Marions unregistered design right subsisted so Osmund could be infringing. From the description given, it does appear that Osmunds design is a slavish copy of

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Marions design, as both are described as a white, spherical in shape dress with dimples in the material. Marion could take action against Osmund for infringement of her unregistered design right.

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- c. Marion may have an unregistered design right in the UK and community unregistered design right in the EU. ✓1

✓1

UK unregistered design right lasts to the end of the calendar year 15 years from the first recordal of the design. If the design is made available for sale or hire during the first 5 years, then the design right lasts until the end of the calendar year 10 years from the date it was made available for sale or hire.

Community unregistered design right lasts for 3 years from the first recordal of the design. ✓½

If Marion wants to file a UK registered design application, she must do so within 12 months of the first disclosure. UK registered designs must be new on the filing date, with some exceptions. One exception is that a disclosure was made in the 12 months prior to the filing date of the design, by the designer. This would apply to Marion, so she would need to file the design by December 2022.

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If Marion wants to file an EU registered design then must also file
the application within 12 months of the disclosure. ✓½

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9)

a. A UK design registration requires a renewal fee to be paid at 5 year intervals from the filing date, to keep the design right in force. The first renewal fee for Sin Free Cakes registration fell on 30 September 2022, which it appears they have missed as they do not have the paperwork for the design. The design is still in force as there is a 6 month window from the missed renewal deadline in which renewal fees can be paid without the design right being lost. Therefore, Sin Free Cakes can pay the renewal fee within 6 months of the missed renewal deadline of 30 September 2022 and keep the design right active. The renewal fee can be paid by filing a form and paying the renewal fee, an additional fee would also be required for late payment.

b. Sin Free Cakes UK registered design may prevent the Halo cake from being sold by Mrs Pickling. A product infringes a UK registered design if it creates the same overall impression to the informed user. While assessing the overall impression, degree of freedom of the designer should be considered.

In this case, the Halo cake sounds similar to the Angel's share cake, as they are both described as being shapes like wings. There are no other cakes on the market that use an identical or similar shape, which indicates that the wing shape is very different to

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anything on the market. As wing shaped cakes are not known before the Angel's share cake, other cake designers have less degree of freedom when designing a cake as any cake with wings will appear similar to the Angel's share cake to the informed user. The emails and social media communications also indicate that the Halo cake creates the same overall impression as the Angel's share cakes, as customers seem to think that the Halo cake is produced by Sin Free Cakes. ✓¹

Therefore, Sin Free Cakes could prevent the Halo cake being sold using their registered design right, as Mrs Pickling is currently infringing that right by selling the Halo cake, as it creates the same overall impression to the informed user. ✓¹

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- c. The twitter post contains evidence of a cake that is extremely similar to the Halo cake, before the registration date of their registered design. If the registered design creates the same overall impression as the cake in the twitter photo, then the registered design may be invalid. ✓¹ The twitter post itself may be excluded as a disclosure as it might be viewed that the informed user would not see that post, especially depending on whether the post was public at the time of the design registration, however the photo is evidence that the cake was disclosed at a cake manufacturers conference, which would likely be considered a public disclosure. ✓^{1/2}

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Mrs Pickling may also have unregistered design rights in the cake from the twitter photo, as the cake was an article made to the design.

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- d. Although the registered design may be invalidated, this will not prevent Sin Free Cakes from selling their cake. Mrs Pickling does not have a registered design for the cake. If the registered design is invalidated, this does not stop Sin Free Cakes from selling the Angel's Share cake. ^{✓1} The only right Mrs Pickling may have is an unregistered design right. However, even if Mrs Pickling does have an unregistered design right, then it seems unlikely that the Angel's share cake would infringe this right, as it is not a slavish copy of the ^{✓1} design, which is a requirement to infringe an unregistered design right.

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10).

a. There are a few options for obtaining protection in these countries:

- i. File an application in one of the country's first, for example the UK. Within 6 months of the filing date of the UK application, he could file applications in France, Germany and the USA claiming priority to the UK application. ✓1
- ii. File an UK design application, and then within 6 months of the filing date of the UK application, file a community design application, which would cover Germany and France, and a separate USA application, both claiming priority to the UK application. ✓1
- iii. File a UK design application, and then within 6 months of the filing date of the UK application, file a Hague international design application claiming priority to the UK application. ✓1 ✓1

UK applications can include multiple designs, and the Locarno class not matter, so Marvin could file the toaster, kettle, bread bin and pattern all within the same application. For the Germany, France, USA, community and Hague international applications, each application must only include designs from a single Locarno classification. So, if option ii or iii is used, the toaster and kettle can be filed in one application, and then the bread bin and pattern would have to be filed as separate applications. These multiple filings could get expensive. Multiple filings would also create other issues so as it being difficult to keep track of all the different designs and renewals etc.

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Filing separate designs may be advantageous because it means each application can offer slightly different protection. Another advantage is that if the design is invalid in one country, it may still be valid in other countries. In contrast, if an EU or Hague design is applied for, and then found to be invalid at a later date, this would invalidate it in all member states.

To reduce costs, it would seem the best option would be to file a UK design application first, especially as the UK has relatively cheap filing fees, and then file a Hague International application designating the USA, France and Germany, claiming priority to the UK application within 6 months of the filing date of the UK application. Three international applications would be required:

- For the toaster and Kettle
- For the bread bins
- For the Pattern

Although there would then be 4 applications including the UK application, this is simpler than filing separate applications in each country or by filing a community design, where there could be up to 3 applications in each country.

- b. He can proceed and disclose the toaster, as all four of the countries he would like to file in have grace periods for disclosures by the designer, however he must then file the design within 12 months of the disclosure at the trade show.

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c. As the fridge is identical it would be an infringing article. The following acts would constitute infringement:

- selling of the fridge ^{✓½} ✓½
- keeping of the fridge
- making of the fridge to the registered design ✓½
- importing the fridge ✓½
- exporting the fridge ✓½
- using the fridge ✓½

d. To transfer the registration an assignment must be completed.

The assignment must be in writing ^{✓1} and be signed by the assignor ^{✓1} (Marvin). The assignment must be registered at the UKIPO as ^{✓1} soon as possible and definitely within 6 months, by filing a form at the UKIPO and paying a fee. Evidence must be provided of the assignment, which would be the assignment document itself.

These actions are important because if infringement proceedings occur, only the proprietor of the design can bring proceedings and receive any remedy from those proceedings. ^{✓1} The proceedings would take into account losses suffered by the proprietor. For example if the design is still registered to Marvin, but all the sales are via Starvin Marvin Appliances Ltd, then Marvin may not be awarded the damages occurred by any infringement, as the

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damages would be based on Marvins sales (which would be zero),
not the sales of the company.

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