

FC4 Design and Copyright Law

FINAL Mark Scheme 2024

Section A

Question 1

a) What exclusive rights are given to the proprietor by registration of a design in the UK?

(4 Marks)

b) What exclusive rights are given to the rightsholder of a copyright in a work in the UK?

(4 marks)

Total: 8 marks

Answer:

- a) 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 of a product in which the design is incorporated **(0.5 mark)** or to which it is applied **(0.5 mark)**, or stocking such a product for those purposes **(0.5 mark)**.
- b) To copy the work **(0.5 mark)**, to issue copies of the work to the public **(0.5 mark)**, to rent **(0.5 mark)** or lend the work to the public **(0.5 mark)**, to perform, show or play the work in public **(0.5 mark)**, to communicate the work to the public **(0.5 mark)**, to make an adaptation of the work or do any of the above in relation to an adaptation **(0.5 mark)**, to authorise others to do any of these actions **(0.5 mark)**.

Question 2

Ahmed is a London-based designer. His UK registered design was filed on 23 January 2019. Ahmed did not renew his design, but he tells you that he forgot to do so because he was busy looking after his ill mother. He wishes to maintain his design right.

Advise Ahmed about the current status of his design right and any necessary steps to maintain his right.

7 marks

Answer:

Upon registration, registered designs are protected for five years from the date of filing **(1 mark)**.

If, within six months immediately following the end of that period an application for extension is made and the prescribed renewal fee and any prescribed additional fee is paid, the right shall be treated as if it had never expired **(1 mark)**.

Within a further six months, an application for the restoration of the right in the design may be made **(1 mark)**.

As it is now 5 years and 10 months after the filing date, Ahmed may still apply for restoration **(1 mark)**.

Ahmed must demonstrate that the lapse was unintentional, possibly a doctor's note from his mother's GP or a statement etc. (any reasonable discussion is acceptable) **(1 mark)**.

Ahmed must also pay a renewal fee **(1 mark)**

and any prescribed additional fee **(1 marks)**.

Question 3

Danielle is a French designer living and working in Paris. She has filed a Hague International Design application designating the UK and the USA. In her application, she has requested a deferment of publication for one year.

Advise Danielle about the results of her request for a deferment of publication, and any additional actions she must take.

7 marks

Answer:

When an applicant requests deferment the design will be registered **(1 mark)**, but not immediately published **(1 mark)**.

The USA does not allow deferment **(1 mark)**.

The UK allows for a deferment of 12 months **(0.5 mark)**.

If one of the designated parties does not allow deferment, then the request is invalid **(1 mark)**.

Thus, Danielle must decide whether to:

Abandon the deferment request **(1 mark)**.

Abandon, within one month **(0.5 mark)** the USA as a designation **(1 mark)**.

If Danielle does not withdraw the US designation within one month, the request for deferment of publication is not taken into consideration and the standard publication period applies **(alternate 1 mark)**.

Question 4

What are the possible circumstances in which prior disclosure of a design does not invalidate the novelty requirement for a UK registered design?

6 Marks

Answer:

It could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the geographical area comprising the United Kingdom and the European Economic Area (note: NOT EU) and specialising in the sector concerned **(1 mark)**;

It was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied) **(1 mark)**;

It was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date **(1 mark)**;

It was made by a person other than the designer, or any successor in title of his, 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 **(1 mark)**;

It was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his **(1 mark)**.

If the later design makes a valid priority claim from an earlier application **(1 mark)**.

Question 5:

- a) Jocelyn is an American designer living in Massachusetts. Tina is a British designer living in Norfolk. In April 2024, they have jointly designed an oil pump.

Explain whether the design of the oil pump would qualify for a UK Unregistered Design Right.

(3 marks)

- b) Róisín who was an Irish author living in Ireland and Aiden who was a British author living in Ireland, co-authored a play published in Ireland in 1958. Róisín died in 1959 and Aiden died in 1962.

When will the copyright in the play expire in the UK?

(4 marks)

7 marks

Answer:

- a) A joint design qualifies for UK UDR protection if any of the designers is a qualifying person **(1 mark)**.

An individual habitually resident in a qualifying country is a qualifying person **(1 mark)**.

The UK is a qualifying country and Tina is a qualifying person, so the qualifying requirements are met **(1 mark)**.

- b) Copyright expires at the end of the period of 70 years from the end of the calendar year in which the author dies. **(1 mark)**

In the case of a work of joint authorship if the identity of the authors is known reference is to the last of them to die. **(1 mark)**

Where the country of origin of the work is not the UK, and the author of the work is not a national of the UK, the duration of copyright is that to which the work is entitled in the country of origin, provided that does not exceed 70 years. But this is joint authorship wherein an author, Aiden, was British. **(1 mark)**

Aiden died in 1962, SO the copyright will expire on 31 December 2032 (answers stating no copyright from 1 January 2033 are acceptable) **(1 mark)**

Question 6:

Your client, Chen, who is a British national living in Kent, recently created a new decoration for the surface of a toaster. He already has a UK registered design right for the toaster.

Explain to Chen whether he has or can obtain any of the following:

- a) A UK UDR in the decoration.
- b) A UK registered design right in the decoration.
- c) Copyright in the decoration.

5 marks

Answer:

- a) Surface decoration is excluded from design (s. 51 / 213, no need to mention the section) **(1 mark)**.

Therefore, it cannot obtain a UK UDR **(1 mark)**.

- b) He can apply for a UK registered design (Section 1(2), no need to mention section) **(1 mark)**.

- c) Surface decoration may be an artistic work **(1 mark)**.

Thus, it may be protected by copyright **(1 mark)**.

Section A Total: 40 Marks.

Section B:

Question 7:

Donatella is a British designer, who is employed by Wheelie, a bicycle wheel manufacturing company based in London. Last month, at the request of Wheelie, Donatella designed a brake pad for a bicycle wheel. Donatella designed the brake pad to fit exactly on the rim of the bike's wheel to allow cyclists to brake immediately. She also decided to add criss-crossed luminescent reflective strips on the brake pads which make them more visible during the night as well as more appealing to consumers.

As Donatella was designing the brake pads, it occurred to her that the bicycle wheel would benefit from additional improvements. Therefore, Donatella designed a uniquely shaped spring which is fitted inside of the bike's wheel. The spring is visible when air is pumped into the wheel, but not afterwards. Donatella designed the spring in her own time but used Wheelie's warehouse and the tools that were provided to her by Wheelie to design the brake pads.

Donatella wishes to register herself as the owner of both designs in the UK. Wheelie learns about Donatella's intentions and insists that they should be registered as the owners of both designs.

a) Discuss whether the brake pad can be registered.

(11 marks)

b) Discuss whether the spring can be registered.

(2 marks)

c) Assuming that both designs can be registered, who would be entitled to the designs in the brake pad and in the spring?

(7 marks)

Total: 20 marks

Answer:

a) The brake pad:

Is this a complex product (e.g., are these plural replaceable component parts, any reasonable discussion is acceptable) **(1 mark)**

Candidates should discuss whether this is an exact fit (question mentions that it's designed to "fit exactly on the rim of the bike's wheel" any reasonable discussion is acceptable) **(1 mark)**

Discuss whether the brake pad is dictated by function **(1 mark)**

and apply at least one of the different tests (e.g., perception by average consumer, artistic value, expert reports, etc., any reasonable discussion is acceptable) **(1 mark)**

If not technical, does it have new **(0.5 mark)** and individual character? **(0.5 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 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 relevant date **(1 mark)**.

The informed user in our case is likely a cyclist (any reasonable conclusion is acceptable) **(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)**

Also, if the pads themselves are not registrable can the reflective stripes be nevertheless registered **(1 mark)**

The question mentions that the reflective strips have a functional element, but possibly also design choices (any reasonable conclusion is acceptable) **(1 mark)**

She can also register the pads, but only the stripes will be protected, the must-fit / functional aspects will be excluded (any reasonable discussion is acceptable) **(alternate 1 mark)**.

b) The spring:

For a design of a component part to be registrable it must remain visible **(1 mark)**.

The question is whether pumping air is 'normal use' or 'maintenance, servicing and repair work,' (any reasonable discussion and conclusion is acceptable) **(1 mark)**.

c) The author of a design 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 her employment **(1 mark)**,**

Then, her employer shall be treated as the original proprietor of the design **(1 mark)**.

The brake pads were designed by Donatella on instruction from her employer so this would count as in the course of employment **(1 mark)** and Wheelie would be entitled to the rights in the brake pads **(1 mark)**.

The spring was designed by Donatella in her own time. This could suggest that it was not created in the course of his employment **(1 mark)**.

However, as they were designed in the warehouse with Wheelie's tools and as part of the wheel design, it might be seen as course of employment **(1 mark)**.

(Marks are awarded for any reasonable argument and conclusion.)

Question 8:

Asnee is a Scottish interior designer from Dundee. Asnee is well-known for his imaginative designs of plant pots and home décor. In November 2011 Asnee designed a new plant pot and made a document for his design. The plant pot is made of clay, it has five openings where different plants can be planted, its surface has ridges and folds, and it comes in the colour purple.

Asnee has not registered his design. On 6 December 2021, he launched the plant pot in a public event in his Dundee shop. A day after the event, James, head of Dundee's Gardening Society, walks into Asnee's shop and mentions how beautiful and unique he found the plant pot, and purchases three such pots.

- a) Prepare notes for a meeting with Asnee in which you will advise him on any UK unregistered design rights he owns in the plant pot (Do not discuss Copyright or Supplementary Unregistered Designs).**

(5 marks)

Orly, a designer from Dundee, attends the launch at Asnee's shop. Orly takes photos of the plant pots with her phone, because she wants to use these photos to make a similar design. Back at her own shop, based on the photos, Orly makes ten such plant pots. Orly asks her business partner and shop co-owner, Nelly, to display the plant pots at the shop window and sell them to customers. Nelly places the plant pots in the shop window, but no one buys any of the pots.

- b) Advise Asnee whether Orly's actions are an infringement of his UK unregistered design rights.**

(5 marks)

- c) Advise Asnee whether Nelly's actions are an infringement of his UK unregistered design rights.**

(4 marks)

Tara, another designer from Dundee also attends the launch at Asnee's shop. Tara loves the plant pots and wishes to produce them to sell in her shop. She asks Asnee for permission to produce the plant pots, but he explicitly tells her he is not willing to license her to do so.

- d) Explain whether Tara may still be allowed to produce copies of Asnee's plant pot, and if so, how?**

(6 marks)

Total 20 marks

Answer

a) Unregistered Design Right:

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)**.

James described the plant pot as “unique”, indicating it is different to the norm, so likely to be original and not commonplace **(1 mark)**.

An UDR protects shape or configuration of the whole or part of an article **(1 mark)**.

But it does not subsist in the colour **(1 mark)**.

b) Asnee, as 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 **(1 mark)**

The photos could be considered “design documents” so the making would infringe under s226(1)(b (no need to mention the section; any reasoned argument is acceptable) **(1 mark)**.

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

By making the pots Orly is copying the design so as to produce articles exactly or substantially to that design **(1 mark)**

Orly is asking Nelly to display the pots which is authorisation, but displaying the pots is secondary infringement so Orly is not liable **(1 mark)**.

c) Nelly offers / exposes the plant pots for sale, in the course of a business **(1 mark).**

Thus, she may be a secondary infringer **(1 mark)**

The question is, does she know or has reason to believe that the pots Orly produced are an infringing article **(1 mark)**.

Any reasonable discussion on Nelly’s constructive or actual knowledge is acceptable **(1 Mark)**.

d) Tara is entitled as of right to a licence to do in the last five years of the design right term anything which would otherwise infringe the design right **(1 mark).**

UKUDR term is the shorter of ten years from the end of the year of first sale **(1 mark)** OR 15 years from first recordal **(1 mark)**.

In our case, we are 13 years after the year of recordal, so within the final five years of the design right term **(1 mark)**.

Making copies of the plant pot would otherwise be an infringement **(0.5 mark)**.

As Asnee is not willing to license it, Tara can approach the IPO for a license **(0.5 mark)**.
The IPO will determine the terms of the license **(1 mark)**.

Question 9:

Maude works for a local bookshop in Aldringham, UK. Clive, the bookshop owner knows that Maude adores Bonnie who is a famous novelist. Last month, Clive instructed Maude to go to the Aldringham library, as Bonnie was delivering a live speech there. Bonnie delivers a moving 30-minute ad-libbed speech. No recording devices of any kind are allowed in the library, but Maude utilises her typist expertise to secretly transcribe Bonnie's lecture verbatim on her laptop. She transcribes it without Bonnie's or Clive's knowledge.

- a) Explain whether Maude, Bonnie, or Clive might own the copyright to the speech.**

(8 marks)

A few days after the speech, Maude prints the document containing Bonnie's speech using the bookshop's printer. She accidentally forgets to collect the printed document. Her colleague, Toby, finds the document. Toby has no idea who the author of the document is, but thinks the closing paragraph of the speech is especially noteworthy and takes a photo of it. He sends the photo to some of his peers.

- b) Bonnie approaches you asking whether Maude or Toby's actions infringed her copyright. Advise Bonnie.**

(8 marks)

Bonnie is upset that her work is being disseminated without her permission, as she sees special value in personally delivering her speeches directly to her fans.

- c) Advise Bonnie on the possible actions available to her against Maude or Toby, and which of those courses of action is best suited for her.**

(4 marks)

Answer:

- a) A transcript is a literary work, thus the subject matter of copyright (1 mark).**

The transcript must be original, as it is made by Bonnie and reflects her personality / labour, skill and judgement, it meets the originality requirement **(1 mark)**.

The speech is ad-libbed, however, due to Maude's typing it has been recorded in material form / fixed **(1 mark)**.

It doesn't matter whether it is recorded by or with the permission or knowledge of the author or not **(1 mark)**.

Bonnie is the author of the speech **(1 mark)**.

Thus, Bonnie will enjoy a copyright in the speech and be its first owner **(1 mark)**.

As it is a verbatim transcription, Maude is not the author / co-author / joint-author of the work **(1 mark)**.

Since Maude is not the author, the question of whether or not she transcribed the speech in the course of her employment or not becomes irrelevant and Clive also has no copyright **(1 mark)**.

- b) Bonnie has the exclusive right to reproduce the speech (1 mark).**

Copyright in a work is infringed by a person who without the licence of the copyright owner does any of the restricted acts **(1 mark)**.

This includes reproducing the speech, which is a literary work, work in any material form, **(1 mark)**.

This includes storing the work in any medium by electronic means **(1 mark)**.

This is strict. It does not matter that Maude accidentally forgot the document **(1 mark)** or that Toby does not know who the author/owner is **(1 mark)**.

Infringement is in the whole work or any substantial part of it **(1 mark)**.

Maude uses the whole document, but Toby only copies the closing paragraph, so the question is whether this is a substantial part (any reasoned conclusion is acceptable) **(1 mark)**.

- c) An infringement of copyright is actionable by the copyright owner, who is Bonnie (1 mark).**
Possible relief includes damages **(0.5 mark)**, injunctions **(0.5 mark)**, accounts **(0.5 mark)** or otherwise **(0.5 mark)**.
Bonnie sees special value in “personally delivering her speeches directly to her fans”, so the best course of action is likely an injunction (any reasoned conclusion is acceptable) **(1 mark)**.

Question 10:

Andrew is a successful Cardiff-based musician who, in 2019, composed the score to a musical work called “Black Cement.” In November 2020, Andrew gave ‘Ara Studios,’ a Glasgow-based company an exclusive license to “Black Cement” for 35 years. Shanika is a Professor of Musicology at the University of West Suffolk who studies how people react to different types of music. In January of 2021, she played “Black Cement” to a random group of 45 people in a local parking lot, documenting how they react to it. Shanika did not obtain a license to play the work, but Andrew does not want to pursue action against Shanika.

- a) Ara Studios approach you asking whether they can pursue copyright action against Shanika, and whether there is any defence Shanika can rely upon?**

(10 marks)

A few months later, Andrew decides he wishes to retire, so, in March 2022, he assigns the copyright in all of his works, including “Black Cement,” as a gift to his good friend and fellow musician Roman. Roman becomes Andrew’s successor in title to “Black Cement.” Ara studios are very concerned about this, as Roman is known to ban any licensing of copyright works which he owns.

- b) Ara Studios ask you whether the assignment affects their license. What will you tell them?**

(4 marks)

Earlier this year, Cleo, a successful filmmaker from London, produces a hit film called “A Day at the Dog Park” which is played in cinemas across the UK. The film’s soundtrack includes “Black Cement,” for which Cleo obtained a license from Roman. The film’s scores mention “Black Cement, copyright of Roman.” Andrew is very upset by this but thinks there is nothing he can do as he assigned his copyright to Roman.

- c) Advise Andrew as to any action he might have against Cleo.**

(6 marks)

Answer:

a) Up to 10 marks for discussion of the following:

“Black Cement” is a musical work, thus subject to copyright **(1 mark)**.

The owner of the copyright has the exclusive right to any of the restricted acts, including playing it in public **(1 mark)**.

Ara Studios are an exclusive licensee, and as such they have (except against the copyright owner) 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)**.

The license to Ara Studios has been granted before Shanika's actions **(1 mark)**.

Ara Studios' rights and remedies are concurrent with those of Andrew, the copyright owner **(1 mark)**.

So, it doesn't matter that Andrew doesn't want to pursue action against Shanika, but should be joined **(1 mark)**.

Fair dealing with work for the purposes of research for a non-commercial purpose does not infringe any copyright in the work provided that it is accompanied by a sufficient acknowledgement **(1 mark)**

It seems that her actions would qualify as “research” as she is testing how people react to the work (any reasonable discussion is acceptable) **(1 mark)**

There is no indication that Shanika credited Andrew **(1 mark)**.

Nevertheless, it could be argued that it is impossible to credit him when the work is played to random people in a parking lot **(1 mark)**

b)

Copyright is assignable **(1 mark)**

A licence granted by a copyright owner is binding on every successor in title to his interest in the copyright **(0.5 marks)**, except a purchaser in good faith for valuable consideration and without notice (actual or constructive) of the licence or a person deriving title from such a purchaser **(0.5 marks)**.

As this is a gift, there is no valuable consideration so the question of knowledge is not crucial (any reasonable discussion is acceptable) **(1 mark)**.

Ara Studios are a licensee under an exclusive licence, thus they have the same rights against a successor in title who is bound by the licence as they had against the person granting the licence and Roman cannot cancel the licence **(1 mark)**.

c)

The author of a copyright musical or work has the right to be identified as the author **(1 mark)**

The author of a musical work has the right to be identified whenever a film of which the sound-track includes the work is shown in public **(1 mark)**.

But the right is not infringed unless it has been asserted **(1 mark)**

“Black Cement” was featured in the sound-track of “A day at the Dog Park” which is shown in public **(1 Mark)**.

Despite no longer being the owner, Andrew remains the author of “Black Cement” **(1 mark)**.

We do not know whether he asserted his right – so it will depend on whether or not he did so (any reasonable discussion is acceptable) **(1 mark)**.

Part B total: 60 Marks