

FC4 Design and Copyright Law MS

SECTION A

Question 1

In relation to Section 253B CDPA, state the 'permitted purposes' in a communication concerning a threat of infringement proceedings in respect of design right?

6 marks

Answer 1

Giving notice that design right subsists in a design (**1 mark**), discovering whether design right in a design has been infringed (by a specified act) (**1 mark**) or by whom. (**1 mark**). Giving notice that a person has a right in or under design right in a design (**1 mark**) where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the design right in the design (**1 mark**). Any other purpose if the court considers that it is in the interests of justice to do so (**1 mark**).

That question will not be marked because S253B CDPA is not in the syllabus.

Question 2

Explain the particular requirements for UK design validity of component parts of complex products as set out in Section 1B(8) and Section 1B(9) RDA.

5 marks

Answer 2

A design applied to a component part of a complex product shall only be considered to be new and have individual character if the component part, once it has been incorporated into the complex product (**1 mark**) remains visible during normal use of the complex product (**1 mark**) to the extent that those visible features of the component part are in themselves new (**0.5 mark**) and have individual character (**0.5 mark**). "Normal use" means use by the end user (**0.5 mark**) but does not include any maintenance (**0.5 mark**), servicing (**0.5 mark**) or repair work (**0.5 mark**) in relation to the product.

Question 3

Explain who has the right to object to derogatory treatment and what is meant by 'derogatory treatment' according to Section 80 CDPA.

4 marks

Answer 3

The author of a copyright literary, dramatic, musical or artistic work **(1 mark)** and the director of a copyright film **(0.5 mark)** has the right not to have his work subjected to derogatory treatment. Treatment of a work means any addition to, deletion from or alteration to or adaptation of the work **(0.5 mark)**, other than (i) a translation of a literary or dramatic work **(0.5 mark)**, or (ii) an arrangement or transcription of a musical work involving no more than a change of key or register **(0.5 mark)**; and (b) the treatment of a work is derogatory if it amounts to distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author or director **(1 mark)**.

Question 4

- a) Who may be regarded as an innocent infringer under Section 24B RDA? Under what circumstances is the definition of innocent infringer applicable?

7 marks

- b) What is the effect of a finding that an alleged infringer is indeed an innocent infringer?

2 marks

Total 9 marks

Answer 4

- a) An innocent infringer is a defendant who proves at the date of the infringement he was not aware **(0.5 mark)**, and had no reason for supposing, that the design was registered **(0.5 mark)**. This applies if the product is marked with the word "registered" **(0.5 mark)** or any abbreviation thereof **(0.5 mark)** or any word or words expressing or implying that the design applied to **(0.5 mark)**, or incorporated in **(0.5 mark)**, the product has been registered **(0.5 mark)**, unless the number of the design **(0.5 mark)** or a relevant internet link **(0.5 mark)** accompanied the word or words or the abbreviation in question **(0.5 mark)**. A relevant internet link is a reference to an address of a posting on the internet which is accessible to the public free of charge **(1 mark)** and which clearly associates the product with the number of the design **(1 mark)**.
- b) Although damages may not be awarded **(0.5 mark)**, this does not affect the power of the court to grant an injunction (in any proceedings for infringement of the right in a registered design) in respect of any innocent infringement. **(1 mark)** if it is given by implication **(0.5 mark)**

Question 5

- a) Your client designed a new coat composed of panels of different textures. The design was disclosed first in the UK by the designer in August 2025. Please advise the client what protection is available in the UK for the design of the new coat.

3 marks

- b) Explain what is the duration of the protection.

4 marks

- c) Your client who designed the new coat composed of panels of different textures plans to license the design. Explain what is meant by 'exclusive licence'.

2 marks

Total 9 marks

Answer 5

- a) Supplementary UK unregistered design right- SUDR (CDR as amended - The Designs and International Trade Marks (Amendment etc) (EU Exit) Regulations 2019 Schedule 1, Art. 2) **(1 mark)**, UK registered design (RDA Section 1(2)) **(1 mark)**, Unregistered design right CDPA s. 213- why it is applicable and why it is not applicable **(1 mark)**.
- b) The SUD protects the design for a duration of 3 years from first disclosure (CDR as amended) **(0.5 mark)**, provided that the design must come to the attention of the circles in the UK or a qualifying country **(0.5 mark)**. The UK registered design's initial duration is 5 years from the date of registration **(0.5 mark)**. Registration is renewable for further periods of 5 years **(0.5 mark)** up to a total of 25 years **(0.5 mark)**. For the unregistered design, the maximum term of protection is 15 years from the end of the calendar year in which the design is made **(0.5 mark)**, subject to 10 years from the date of first marketing **(0.5 mark)** and further subject to licences of right in the last 5 years of protection **(0.5 mark)**.
- c) An "exclusive licence" is a licence that authorizes the licensee to the exclusion of all other persons **(1 mark)**, including the person granting the licence to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design **(1 mark)**.

Question 6

State which acts constitute infringement of copyright by 'copying' in accordance with Section 17 CDPA.

7 marks

Answer 6

Reproducing a literary, dramatic, musical or artistic work in any material form (**1 mark**), including storing the work in any medium by electronic means (**1 mark**), Copying an artistic work includes the making of a copy in 3 dimensions of a 2-dimensional work (**1 mark**) and making a copy in 2 dimensions of a 3-dimensional work (**1 mark**). In relation to a film or broadcast, copying includes making a photograph of the whole or any substantial part of any image forming part of the film or broadcast (**1 mark**). In relation to the typographical arrangement of a published edition, copying means making a facsimile copy of the arrangement (**1 mark**). In relation to any description of work, copying includes the making of copies which are transient or are incidental to some other use of the work. (**1 mark**).

SECTION B

Question 7

Sylvie, the CEO of your client, Chaise Ltd, has come to you for advice. Chaise makes items of garden furniture in wood and the CEO has brought you details of a distinctive new design for a handcrafted garden seat that has been designed in-house.

- a) Advise Sylvie on the proprietorship of the design.**

2 marks

A few weeks ago, the seat was demonstrated at a local garden centre to test the reaction of potential purchasers. Several people, including the Managing Director of the garden centre, one of Chaise's employees and one potential purchaser, took photographs of the seat. Sylvie is worried that an image of the new seat has appeared on the garden centre's website offering a very similar design of the seat for sale by a different manufacturer.

Sylvie has approached the Managing Director of the garden centre but has been told that the garden centre has registered the design and that if Chaise itself attempts to sell the design, the garden centre will take action for infringement. Details of the registration have been provided by the garden centre.

- b) Advise Sylvie of the risk of infringement of the garden centre's registered design and what action it can take to mitigate this risk.**

7 marks

- c) Advise Sylvie what action she can take to prevent the garden centre offering the design for sale, and why. Do not discuss copyright or unregistered design right of any form in your answer.**

11 marks

Total 20 marks

Marks are awarded for any reasonable argument and conclusion.

Answer 7

- a) Proprietorship by Chaise**

The design appears to be owned by Chaise Ltd (**1 mark**) because it was designed in-house (**1 mark**).

- b) Infringement risk by Chaise and mitigation**

Chaise Ltd appears to have a prior use right in respect of the garden centre's registered design (**1 mark**) because it made in good faith or made serious and effective preparations to use the design (**1 mark**). To mitigate the risk for infringement, Chaise should collect evidence of ownership and development of the design (**1 mark**), seek a declaration of invalidity in respect of the registration by the garden centre (**1 mark**) on the ground that the design is not new in view of the demonstration at the garden centre (**1 mark**) and on the ground that the garden centre is not the proprietor of the design (**1 mark**). To accomplish

this, Chaise Ltd should additionally gather evidence of the demonstration of the design at the garden centre (**1 mark**).

c) Prevent the garden centre offering the design for sale, and why

The design created by Chaise Ltd appears to be registrable (**1 mark**), because it is new (**1 mark**), in that the disclosure at the garden centre was made by the designer or his successor in title within the 12-month grace period (**1 mark**). In addition, the design appears to satisfy the requirement of individual character (**1 mark**), because 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**). Chaise Ltd should apply to register at the IPO (**1 mark**). Once the design is registered advise the garden centre of the registration (**1 mark**) and send copy to put the garden centre on notice and ensure there is no defence of innocent infringement (**1 mark**). The garden centre's seat does not appear to produce a different overall impression on the informed user and will infringe the registration (**1 mark**). If the garden centre does not cease offering the infringing seat for sale (**1 mark**), Chaise Ltd can take action for infringement. (**1 mark**).

Marks are awarded for any reasonable argument and conclusion.

Question 8

Your client, Smell Ltd, a UK company, manufactures and markets perfumes and is proposing to repackage one of its products in a new shape of bottle designed by one of its employees. Smell Ltd advises you that it wishes to file an application to register a trade mark, but that it is open to alternative suggestions.

- a) **What alternative forms of protection can you suggest may be effective for Smell Ltd in the UK? (In your answer, do not address copyright issues and passing off.)**

3 marks

- b) **Identify the relative advantages and disadvantages of your suggestions.**

Advantages 7 marks

Disadvantages 10 marks

Total 20 marks

Additional marks are awarded for alternative answers.

Answer 8

- a) **Alternative forms of protection**

A registered design is one alternative (**1 mark**). Unregistered design right is another alternative (**1 mark**). Supplementary unregistered design right is a third alternative. (**1 mark**).

[Note: Copyright is not included here because it will not be an effective form of protection. There may be copyright in original design drawings, but in practice these are unlikely to be copied. While the bottle may be artistic, it will not be a work of artistic craftsmanship as it will in practice need to be manufactured rather than hand crafted.]

- b) **Advantages of your suggestions**

Registered designs

Registration requirements for a design do not require use of the design (**0.5 mark**). The costs for the design registration are low (**0.5 mark**). There is no substantive examination for a design registration (**0.5 mark**) and that's why the design registration is quicker (**0.5 mark**). The initial duration for protection is 5 years and can be renewed up to 25 years (**0.5 mark**).

Additional advantages: Protection is available for a wider range of features (**0.5 mark**)

Unregistered design right

UDR exists as of right (**0.5 mark**). A proof of ownership of the design is required. (**0.5 mark**), no fees to pay (**0.5 mark**). fewer requirements than registered design (**0.5 mark**).

Supplementary unregistered design right

SUDR exists as of right (**0.5 mark**). A proof of ownership of the design is required. (**0.5 mark**).

Additional advantages: broad protection (**0.5 mark**), no renewal fees or maintenance fees (**0.5mark**)

Disadvantages of your suggestions

Registered designs

The maximum duration of a registered design is limited to 25 years (**0.5 mark**). An application for design registration must be filed within a grace period of 12months from first disclosure (**0.5 mark**).

Additional disadvantages: More complicated procedure for registration (**0.5 mark**) and more expensive (**0.5 mark**).

Unregistered design right

The maximum term of protection is 15 years from the end of the calendar year in which the design is made (**0.5 mark**). Subject to 10 years from the date of first marketing (**0.5 mark**) and further subject to licences of right in the last 5 years of protection (**0.5 mark**). UDR is not a monopoly right so it is necessary to prove copying to establish infringement (**0.5 mark**). The point of first marketing of the design along with information as to who, when and how the design was made are required (**1 mark**).

Additional disadvantages: Limited scope of protection (**0.5 mark**) , less appealing to investors (**0.5 mark**), more difficult to enforce (**0.5 mark**), infringers are less deterred by unregistered design (**0.5 mark**).

Supplementary design right

Duration is 3 years from first disclosure (**0.5 mark**). SUDR is not a monopoly right so it is necessary to prove copying to establish infringement (**0.5 mark**). The point of first marketing of the design along with information as to who, when and how the design was made are required (**1 mark**).

Additional disadvantages: requires disclosure to the public in the UK (**0.5 mark**) and earlier disclosure in the EU will destroy the novelty requirement (**0.5 mark**).

Question 9

A new client, Haircraft, a UK company, has produced a design for curling tongs, which it began selling in the UK some eight months ago. The curling tongs have sold extremely well and Haircraft wants to know what it can now do to protect the design in the UK.

- a) **Advise Haircraft on the potential registrability of the curling tongs design in the UK.**

4 marks

Moreover, Haircraft is now receiving enquiries from other countries, France, Germany, China and the USA, and is interested to learn what can be done to protect the curling tongs in those countries before it pursues the enquiries.

- b) **Advise Haircraft on what can be done to register the curling tongs design in France, Germany, China and the USA.**

5 marks

Haircraft informs you that it is working on a design for new curling tongs and has recently received initial design documents from an external consultant of Dutch nationality based in the UK. The design documents are creating considerable excitement within the company. The Marketing Director of Haircraft wants to advertise the new curling tongs tomorrow and asks you to explain briefly how best to protect the design in the UK, France, Germany, China and the USA in this situation.

- c) **Give guidance on what is required to ensure Haircraft is the owner of the curling tongs design.**

5 marks

- d) **Advise briefly how you would propose to best protect the new curling tongs design in the UK, France, Germany, China and the USA.**

6 marks

Total 20 marks

Marks are awarded for any reasonable argument and conclusion.

Answer 9

Curling tongs in the UK

The design must be new and have individual character (**1 mark**). Novelty is not destroyed in the UK by a disclosure within 12 months of filing (**1 mark**) provided it originates directly or indirectly from the designer (**1 mark**). Advise filing a UK application for registration as soon as possible to minimise the risk of further disclosures (**1 mark**).

Curling tongs in France, Germany, China and USA

There is a 12-month grace period in France and Germany so it is still possible to file separate national applications in these countries (**1 mark**), but it would be more cost-effective to file a single EU design application (**1 mark**). It is no longer possible to get valid protection in China because the design has been disclosed (**1 mark**). Valid protection is possible in USA because

there is a 12-month grace period (**1 mark**). A further option is to file an application for an International registration under the Hague Agreement covering, France, Germany of the EU and USA (**1 mark**).

Ownership of curling tongs design

Depending on the clauses in the consultancy contract, the original proprietor of the design might be the consultant, because the consultant might not be an employee of the company (**1 mark**). This applies also to design right (**1 mark**), where the designer is a qualifying person for both forms of design right due to residence (**1 mark**) and to supplementary design right CDR Art 14(1) (**1 mark**). Advise the client to ensure there is a written assignment in place transferring ownership to Haircraft (**1 mark**).

How best to protect the curling tongs design

The curling tongs design is said to be marketable for many years so there is a need to maximise the duration of protection. (This is not in your hands as regards design right,) but an initial application to register the design should be filed (in the UK) to establish a priority right e.g., RDA s3 (**1 mark**). This should be filed today or tomorrow after ownership is resolved to prevent third parties gaining rights to designs having the same overall impression (**1 mark**). Advise the client to seek protection in other countries within 6 months of the initial application (**1 mark**) and claim priority from the initial application to maximise duration of the protection (**1 mark**). Depending on the where the first place of marketing of the product is this can be accomplished by filing one or more of individual national applications, regional applications (**1 mark**) or an application under the Hague Agreement by virtue of nationality or residence (**1 mark**).

Marks are awarded for any reasonable argument and conclusion.

Question 10

Your client, Bricks plc, has designed and constructed an innovative hotel in Japan in 2021. A Bricks' employee constructed a scale model of the hotel as part of the bidding process. The scale model was first shown to the hotel owner in London and was subsequently given to the hotel owner for display purposes. Your client's detailed architectural drawings were also given to the hotel owner in London.

The hotel owner has made copies of the architectural drawings and sent the copies to UK, Germany and China construction companies without any reference to Bricks plc.

- a) **Advise Bricks as to the nature of any rights that may have arisen from the construction of the hotel in Japan and what action may be taken. Consider each of Japan, the UK, Germany and China. For your answer, address copyright issues only.**

10 marks

- b) **Advise Bricks as to the nature of any rights that may have arisen from the scale model. Again, consider each of Japan, the UK, Germany and China. For your answer, address copyright issues only.**

5 marks

- c) **Advise Bricks as to the nature of any rights that may have arisen from the drawings given to the hotel owner. Again, consider each of Japan, the UK, Germany and China. For your answer, address copyright issues only.**

5 marks

Total 20 marks

Marks are awarded for any reasonable argument and conclusion.

Answer 10

The hotel itself

Copyright will subsist in Japan in the building itself (**1 mark**). This will have originated in Japan under the Berne Convention Art 5(4)(c)(ii) (see also CDPA S 15A) (**1 mark**) because Japan (**1 mark**) and the UK are signatories to the Berne Convention (Berne Convention Art 1) (**1 mark**). The owner of the copyright is Bricks as employer of the workforce effecting the design and construction of the hotel (**1 mark**). Bricks will have the same rights in Japan as a Japanese national in accordance with Berne Convention Art 3 (**1 mark**). Copyright will extend to the UK, Germany and China under the Berne Convention Art 5(1) (**1 mark**) because Germany and China are also signatories to the Berne Convention (**1 mark**). Action for copyright infringement may be commenced in any one or more of the UK, Germany and China under national law (**1 mark**) because that is where the hotels have been constructed (**1 mark**).

The scale model

Bricks will have copyright in the UK in the scale model as an artistic work (**1 mark**) because the model was constructed by an employee (**1 mark**). Copyright will extend to Japan, Germany

and China under the Berne Convention Art 5(1) (**1 mark**). By displaying the scale model, there is no copyright infringement in the UK (**1 mark**). Depending on the availability of exhibition rights, an action for copyright infringement may be commenced in any one or more of the Japan, Germany and China under national law (**1 mark**).

The drawings

Bricks will own copyright in the UK in the drawings as a graphic work under s. 4 (1) (a) CDPA (**1 mark**). S.51 does not apply since the “article” depicted in the drawings as design documents is itself an artistic work under s.4 CDPA (**1 mark**). Again, this protection will extend to Japan, Germany and China under the Berne Convention Art 5(1) (**1 mark**). Given the architectural drawings have been copied, an action for copyright infringement may be commenced (**1 mark**). The action for copyright infringement depends on where the copying of the drawings took place (**1 mark**).

Marks are awarded for any reasonable argument and conclusion.