

Recap of Designs for FD1

1. Slides
2. Designs table
3. FD1 Design Questions
4. FD1 Designs mark scheme and comments
5. FD1 Designs sample answers

Appleyard Lees[®]



2024 Informals Advanced Lecture

Recap of design rights for FD1, David Clark - Appleyard Lees IP LLP

Innovation | Branding | Strategy | Solutions

1

Introduction

At the start, you want something predictable to settle the nerves...

Appleyard Lees[®]

Innovation | Branding | Strategy | Solutions

2



About me, and designs

Passed FD1(/P2) in 2002 - interesting times for design law in the UK!

Did a lot of contentious designs work in the early days of the new law

Worked for a multinational with high demand for:
design clearance work, and
wide international filing strategy

Frequently involved in FC4 tutorials, did this lecture last year

Two ingredients



Two ingredients:

Know the relevant information

Apply the information to the scenario

- FEED THE EXAMINER AN ANSWER THAT LOOKS LIKE IT WAS WRITTEN BY A PATENT ATTORNEY

Know the relevant information

FD1 Syllabus

Know the relevant information

	Content	Learning Outcomes	Legislation	Rules
1	Available forms of intellectual property	a) Assess the limitations of available forms of intellectual property: <ul style="list-style-type: none"> • Patents • Designs • Trade Marks • Copyright • Confidential Information • Know How 	Parts I and III of the <u>Copyright, Designs and Patents Act 1988 (CDPA)</u> The <u>Patents Act 1977 (PA)</u> The <u>Registered Designs Act 1949 (RDA)</u> The <u>Trade Marks Act 1994</u> <u>Hague Agreement Concerning the International Registration of Industrial Designs (Geneva Act 1999)</u> Articles 2 to 18 Council Regulation (EC) No. 6/2002 as amended CDPA 51 to 53	The Community Design Regulations 2005 as amended

Know the relevant information

	Content	Learning Outcomes	Legislation	Rules
16	The law and practice relating to UK and International registered designs, UK design right and UK copyright	Analyse a scenario and provide reasoned advice taking into account the following factors: <ul style="list-style-type: none"> • What can be protected • Who qualifies for rights • Entitlement and Ownership • Duration • Licences of right • Rights granted by registration • Infringement • Grace periods and Prior disclosures • Renewal and restoration • Multiple designs 	Please refer to the syllabus for FC4	Please refer to Syllabus for FC4



Know the relevant information

FC4 Section 2. The Syllabus

“To be successful in this examination, you will need to:

Demonstrate an understanding and appreciation of the Design and Copyright topics set out in Schedule A of the IPReg Accreditation Handbook. You will thus need to demonstrate knowledge of the main provisions of International and UK law relating to design and copyright.

You will also need to demonstrate knowledge of the relevant procedures and formalities required to obtain the protection for UK designs.

You will also need to demonstrate knowledge of the relevant principles relating to subsistence and enforcement of UK copyright.



Know the relevant information

Schedule A, IPReg Accreditation Handbook (November 2016)

...

c) Design and Copyright law: laws and procedures (UK and European Union Intellectual Property Office (EUIPO)) relating to the protection of industrial design through registered and unregistered design laws - qualifying for protection, ownership, infringement, defences, invalidity and overlap with copyright and trade marks, strategic creation and management of industrial design portfolios, registering and maintaining a design in the UK and internationally, copyright law (UK and international) - rationale and subsistence, subject matter (literary, artistic, musical and dramatic works), ownership, licensing, moral rights, economic rights, infringement, permitted acts.

...



Know the relevant information

That sounds like a lot...

What do they actually ask questions about?



Know the relevant information

Analyse a scenario and provide reasoned advice taking into account the following factors:

- What can be protected
- Who qualifies for rights
- Entitlement and Ownership
- Duration
- Licences of right
- Rights granted by registration
- Infringement
- Grace periods and Prior disclosures
- Renewal and restoration
- Multiple designs





Know the relevant information

Make a table!



Candidate X 2019	Copyright	UK Unregistered Design	UK Registered Design	Commonly Registered and Unregistered Designs
<p>(a) ORIGINAL literary, dramatic, musical or artistic works (b) sound recordings, films or videorecordings (c) the typographical arrangement of published editions</p> <p>Does NOT extend to literary, dramatic or musical work unless it is recorded in writing</p> <p>LITERARY any work other than a dramatic or musical work</p> <p>ARTISTIC (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality (b) a work of architecture, being a building or a model for a building (c) a work of sculpture</p> <p>Copyright takes precedence over UNLAWFUL</p>	<p>shape or configuration (whether internal or external) of the whole or part of an article</p> <p>Registration</p> <p>NO physical arrangement of parts</p> <p>any design incorporated in or applied to a component part of a complex product if the component part carries visible during normal use</p>	<p>any individual or herd/stock item other than a complex product, packaging, process, graphic symbols and logos</p> <p>designs incorporating, when applied to a complex product, packaging, process, graphic symbols and logos</p> <p>parts intended to be assembled into a complex product</p> <p>COMPLEX PRODUCT: a product which is composed of at least two parts pertaining to the product</p> <p>design incorporated in or applied to a component part of a complex product if the component part carries visible during normal use and have individual character</p>	<p>Appearance of the shape or of a part of a product resulting from the features of, in particular, the lines, contours, colours, shapes, textures and materials of the product itself and/or its packaging</p> <p>any individual or herd/stock item other than a complex product, packaging, process, graphic symbols and logos</p> <p>any individual or herd/stock item other than a complex product, packaging, process, graphic symbols and logos</p> <p>parts intended to be assembled into a complex product</p> <p>COMPLEX PRODUCT: a product which is composed of at least two parts pertaining to the product</p> <p>design incorporated in or applied to a component part of a complex product if the component part carries visible during normal use and have individual character</p>	
<p>Requires (What can be protected):</p>	<p>(1) Design right is a property right which subsists in an ORIGINAL DESIGN (1) NEW - no identical design or no design whose features differ only in immaterial (1) NEW - no identical design has been made available to the public before the date the design was made available to the public before the relevant date (date of filing of the application or date of priority. Design shall be deemed to be identical if their features differ only in immaterial details</p> <p>(2) A design is not ORIGINAL if it is COMMONPLACE in the design field in question at the time of its creation</p>	<p>(1) DESIGN CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p>	<p>(1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p>	<p>(1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p>
<p>Includes (What can be protected):</p>	<p>(a) a method or principle of construction (1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION</p> <p>(2) ANY DESIGN WHICH IS APPLIED TO A COMPONENT PART OF A COMPLEX PRODUCT IF THE COMPONENT PART CARRIES VISIBLE DURING NORMAL USE AND HAS INDIVIDUAL CHARACTER (2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) SURFACE DECORATION (NB surface decoration is a matter for aesthetic protection)</p>	<p>(1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION</p> <p>(2) ANY DESIGN WHICH IS APPLIED TO A COMPONENT PART OF A COMPLEX PRODUCT IF THE COMPONENT PART CARRIES VISIBLE DURING NORMAL USE AND HAS INDIVIDUAL CHARACTER (2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) SURFACE DECORATION (NB surface decoration is a matter for aesthetic protection)</p>	<p>(1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION</p> <p>(2) ANY DESIGN WHICH IS APPLIED TO A COMPONENT PART OF A COMPLEX PRODUCT IF THE COMPONENT PART CARRIES VISIBLE DURING NORMAL USE AND HAS INDIVIDUAL CHARACTER (2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) SURFACE DECORATION (NB surface decoration is a matter for aesthetic protection)</p>	<p>(1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION</p> <p>(2) ANY DESIGN WHICH IS APPLIED TO A COMPONENT PART OF A COMPLEX PRODUCT IF THE COMPONENT PART CARRIES VISIBLE DURING NORMAL USE AND HAS INDIVIDUAL CHARACTER (2) INDIVIDUAL CHARACTER: the overall impression produced on the informed user (1) INDIVIDUAL CHARACTER: the overall impression produced on the informed user</p> <p>(3) SURFACE DECORATION (NB surface decoration is a matter for aesthetic protection)</p>

Innovation | Branding | Strategy | Solutions

<p>Qualification/Ownership (Who qualifies for rights, Entitlement and Ownership)</p> <p>Author = PERSON WHO CREATED IT Sound recording → the producer Broadcast → person making the broadcast Typographical arrangement of a published edition Computer generated → person who arranged it JOINT OWNERSHIP = produced by the collaboration of two or more authors in which the contribution of each author is not distinct from the other. A firm shall be treated as a work of joint ownership if, at the end of the calendar year in which the author dies.</p>	<p>Designer (person who creates it) is the FIRST OWNER unless the design is created during the course of employment. FIRST OWNER (e.g. designer, employer) must be qualifying person for design to get LADRS. Can also get LADRS if FIRST MARKETED in qualifying country by qualifying person. FIRST MARKETED is then the owner. Qualifying person = individually, naturally, resident in a qualifying country or body corporate formed under law of qualifying country with a place of business at which substantial business activity is carried out in any qualifying country. 10 yrs from the end of the calendar year in which the design was first created in a design document OR an article was first made to the design, whichever first occurred. if articles made to the design are made available for sale or first anywhere within end of first 5 yrs, then 10 yrs from the end of the calendar year in which that first occurred.</p>	<p>Author shall be treated as the designer if the proprietor: AUTHOR = PERSON WHO CREATED IT Employer shall be treated as the original proprietor, where a design is created by an employee in the course of his employment. Not if a design is generated by a computer, the author is the person who made the necessary arrangements. 5 x 5 yrs from date of registration. Renewal fees may be up to date.</p>	<p>The right to the Community design shall vest in the designer or his successor in the: Two or more persons who have jointly developed a design, the right to the Community design shall vest in them jointly. Where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law. Designer shall have the same right as the applicant or the holder of the registered design to be cited as such. 5 x 5 yrs from date of filing (CDDR). 3 yrs from the date on which the design was first made available to the public within the Community (CDRR) (i.e. shall NOT have protection if not made available within the Community)</p>
<p>Duration</p> <p>Unknown authorship → 70 years from the end of the calendar year in which the work was made. If the work of unknown authorship was made public during that period → 70 years from the end of the calendar year in which the work was first made public.</p>	<p>Any person 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. PRIMARY INFRINGEMENT (1) Without permission of proprietor reproduces the design for commercial purposes, to that design (2) by making a design document recording the design for the purpose of making such articles to be made. NE MAKING ARTICLES TO THE DESIGN means copying the design so as to produce articles exactly or substantially to that design. In other words, it is only infringement if the design is NOT an independent work of creation by a designer unfamiliar with the design. A different rule has no bearing on it whether or not there is infringement. (2) Design right is infringed by a person who without the licence of the design right law firm, or business another to do, anything which by virtue of this section is the exclusive right of the design right owner. SECONDARY INFRINGEMENT (1) Infringes this law. (2) has in his possession (3) uses, for hire, or offers or exposes for sale or hire. Who can bring infringement proceedings. (1) The design right owner. (2) Exclusive licensee. Remedies. Damages, injunctions, accounts of profit, delivery up, destruction.</p>	<p>Without consent of proprietor uses the design and any design which does not produce on the informed user a different overall impression (only depend on the degree of freedom of the designer). Like includes making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied or sticking such a product for those purposes. INFRINGED ARTICLE (1) has been prepared to be imported into the UK (2) as relating to that design in UK or had been first infringed in the UK. Right to Prior Use A person who, before the application date, used a registered design in good faith or made serious and effective preparations to do so may continue to use the design for the purposes for which, before that date, the person had undertaken to use it. Does NOT include: (a) if was copied from the design which was subsequently registered (b) in right to license the design (c) right to design or transmit the design UNLESS (i) the design was used in the course of business; (ii) the design is design right owned by the part of the business in which the design was used. Who can bring infringement proceedings. (1) The design right owner. (2) Exclusive licensee. Remedies Injunction, Damages for financial infringement – not aware or had no reasonable grounds for supposing that the design was registered; injunction, accounts of profit, delivery up, destruction.</p>	<p>The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression. Excludes if without consent of proprietor uses the design, use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied or sticking such a product for those purposes. UNREGISTERED DESIGN - only if the content used results from copying the protected design. Right to Prior Use - only if the content used results from copying the protected design. Right to Prior Use - only if the content used results from copying the protected design. EXCLUDES: (a) private/commercial acts; (b) reproduction for teaching purposes; (c) reproduction for the purpose of making citations or of teaching; (d) Planes/ships temporary in EU registered in a 3rd country; (e) carrying out of repairs/repairing spaces for such ships/aircraft. Exhaustion of Rights Rights conferred by CDR shall not extend to acts relating to a product put on the market in the Community by the holder of the CDR or with his consent. Right to Prior Use – same as UK Remedies (1) injunction (2) seizure (3) seizure of materials used in the manufacture if it is known or obvious that they are intended for use. (4) sanctions appropriate in the circumstances provided by the law of the member state where the infringement occurred.</p>
<p>Infringement/Exclusions/Remedies (Rights granted by registration, infringement)</p> <p>Without consent of proprietor: (a) copy the work (reproducing, storing in electronic form, making 3D copy of 2D work and making 2D copy of work, using a photograph of a three-dimensional, making a facsimile copy of a work, etc.) (b) make copies of the work to the public (putting into circulation in EEA, if not already, or outside EEA, NOT subsequent distribution or importation) (c) rent or lend the work to the public (d) perform, show or play the work in public (e) substantial part must be infringed, substantial does not necessarily refer to length, but rather to their part. (f) make an adaptation of the work (a translation, a version of a dramatic work converted into a non-dramatic work, a version of a book, etc.) (g) make a copy of or imitate it with the same or a similar effect (h) for computer programs - translations include converting a computer program into a different code language - a NOT fair dealing to cover a computer program from a lower level language to a higher level language. SECONDARY INFRINGEMENT (a) Without knowing importing into the UK, otherwise than for private and domestic use, an article which he knows or has reason to believe is an infringing copy. (b) Without knowing procuring or causing with an article he knows... (possess in the course of business, sell, let for hire, offer or expose for sale or hire, exhibit in public or distribute in the course of business, distribute other than in the course of business, or otherwise) affecting the sale or the copyright. (c) without a licence providing an article specially designed/adapted for making copies of an article he knows create, import into UK, possess in the course of business, sell, let for hire, offer or expose for sale or hire). EXCLUDES: (a) making temporary copies (b) Research and private study (c) Critical review and news reporting (d) Caricature, parody and pastiche (e) Copying and use of extracts of works by educational establishments (CDR). - The above must be for non-commercial use and must be 'fair dealing'.</p>	<p>Who can bring infringement proceedings. (1) The design right owner. (2) Exclusive licensee. Remedies. Damages, injunctions, accounts of profit, delivery up, destruction.</p>	<p>Who can bring infringement proceedings. (1) The design right owner. (2) Exclusive licensee. Remedies Injunction, Damages for financial infringement – not aware or had no reasonable grounds for supposing that the design was registered; injunction, accounts of profit, delivery up, destruction.</p>	<p>Who can bring infringement proceedings. (1) The design right owner. (2) Exclusive licensee. Remedies Injunction, Damages for financial infringement – not aware or had no reasonable grounds for supposing that the design was registered; injunction, accounts of profit, delivery up, destruction.</p>

Appleyard Lees

Innovation | Branding | Strategy | Solutions

<p>Grace Period/Priority (Grace periods and prior art disclosures)</p> <p>Renewal and restoration</p> <p>Multiple Designs</p>	<p>6 month priority period (i.e. 6m to claim priority from an earlier convention application). PRIORITY CLAIM REQUIREMENTS: (a) date of each convention application (b) country in which each convention application was made (c) 3m from date of filing of later application shall provide representation of design of earlier application. Not disclosed if: (a) could not reasonably have become known in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned. (b) it was made to a person other than the designer/successor of his, under conditions of confidentiality whether expressed or implied. (c) it was made by the designer/successor of his, during the period of 12 months immediately preceding the relevant date. (d) it was made by another person, during the period of 12 months immediately preceding the relevant date in consequence of info provided/action taken by the designer/successor of his. Restoration Application for restoration may be made by: (1) registered proprietor (2) any other person who would have been entitled had the right not expired (3) one or more of joint applicants UNINTENTIONAL → restoration of right on payment of renewal fee + additional fee. Must state grounds. PERIOD FOR REQUESTING RESTORATION – 12m Examiner must notify applicant within 6 weeks of expiry. Restoration Several designs may be combined into one application. Fees are due for each multiple application/registration. Multiple designs are independent of surface decoration.</p>	<p>6 month priority period. PRIORITY CLAIM REQUIREMENTS: (a) declaration of priority (<1m) (b) copy of previous application A design is not disclosed if such events could not be reasonably become known in the normal course of business to the circles specialised in the sectors concerned in the Community. Not counted as disclosure if it has been made available to the public: (a) by the designer/successor or a third person as a result of information provided or action taken by the designer/his successor; and Restitutio in Integrum Application must be filed <2m of cause of non-compliance 12m time limit for submitting application Lapse must be in spite of ALL DUE CARE REQUIRED BY THE CIRCUMSTANCES Must state grounds. Several designs may be combined into one application, BUT designs must be applied to/incorporated in products of the same LOCARNO CLASS. Fees are due for each multiple application/registration. Multiple designs are independent of surface decoration. Locarno class additional fees must be paid within 3m of filing.</p>	<p>6 month priority period. PRIORITY CLAIM REQUIREMENTS: (a) declaration of priority (<1m) (b) copy of previous application A design is not disclosed if such events could not be reasonably become known in the normal course of business to the circles specialised in the sectors concerned in the Community. Not counted as disclosure if it has been made available to the public: (a) by the designer/successor or a third person as a result of information provided or action taken by the designer/his successor; and Restitutio in Integrum Application must be filed <2m of cause of non-compliance 12m time limit for submitting application Lapse must be in spite of ALL DUE CARE REQUIRED BY THE CIRCUMSTANCES Must state grounds. Several designs may be combined into one application, BUT designs must be applied to/incorporated in products of the same LOCARNO CLASS. Fees are due for each multiple application/registration. Multiple designs are independent of surface decoration. Locarno class additional fees must be paid within 3m of filing.</p>
--	---	--	--

Appleyard Lees



Know the relevant information

Make a table!

A useful start point here:

[Designs for Life: Different types of protection | Gowling WLG](https://gowlingwlg.com/en/insights-resources/articles/2022/designs-for-life-different-types-of-protection/) (2022)

<https://gowlingwlg.com/en/insights-resources/articles/2022/designs-for-life-different-types-of-protection/>

Email me for the spreadsheet to use as a start point



Question spotting?

Email me for a compilation of the last 10 years of design questions, examiner's comments and sample scripts

Even distribution of questions on obtaining of rights, enforcement of rights, validity of rights

Even distribution of questions about the different types of rights in designs
(apart from copyright)



Question spotting?

UK government and EU consulting on revisions to statute – too early in the processes for practice-based questions this year?

EUUDR / UKSUDR – an obvious area to examine post Brexit transition period, but too soon to go again?

Sources of new case law, and hot topics

<https://www.marques.org/blogs/class99/>

...called it as “visible in normal use” last year

UK IPO Registered Designs Examination Practice guide? [Updates here](#)

Apply the information to the scenario



Apply the information to the scenario

FD1 Section 1. Guidance for Candidates

The Final Diploma examinations test candidates' ability to:

- see the overall picture;
- assimilate and make use of data, information, themes and ideas provided;
- extract and identify key issues and consider how best to present these in the context of the situation provided;
- write in a logical, cohesive and clear manner; and
- provide outcomes and proposals that:
 - i. reflect the client's needs and priorities;
 - ii. are based on analysis of information available and, where appropriate, risks and costs;
 - iii. are practicable and achievable; and
 - iv. meet the requirements of relevant law and represent good practice with an appreciation of commercial realities of the situation presented.



Apply the information to the scenario

- see the overall picture;
- assimilate and make use of data, information, themes and ideas provided;
- extract and identify key issues and consider how best to present these in the context of the situation provided;

It is reasonable to assume that every phrase in a question is there for a purpose. Many candidates clearly fail to answer a question in its entirety, failing to make points which are obvious to the Examiners. It is recommended candidates should take steps during the examination to identify those parts of a question which they have used to highlight those they have not.



Apply the information to the scenario

FD1 Section 1. Guidance for Candidates

- write in a logical, cohesive and clear manner; and

In this paper candidates are presented with a number of different situations which they are expected to assess and respond to by giving advice to their client. What is required is clear, cogent advice, not rambling statements of the law without applying the law to the specific situation.

Despite the clear statement in the paper that there are no marks for discussing copyright or design right some candidates still felt it necessary to do so.



Apply the information to the scenario

FD1 Section 1. Guidance for Candidates

- provide outcomes and proposals that:
 - reflect the client's needs and priorities;

What are the client's needs and priorities?

Put yourself in the client's position – what would you want?



Apply the information to the scenario

FD1 Section 1. Guidance for Candidates

- provide outcomes and proposals that:
 - i. reflect the client's needs and priorities;

To protect something of commercial value, such as the investment in creating a new design for a product

Identify and secure rights

Be confident about ownership

Identify infringing activity

Evaluate potential validity concerns

- What can be protected
- Who qualifies for rights
- Entitlement and Ownership
- Duration
- Licences of right
- Rights granted by registration
- Infringement



Apply the information to the scenario

FD1 Section 1. Guidance for Candidates

- provide outcomes and proposals that:

...

are based on analysis of information available and, where appropriate, risks and costs;

A is relevant to B because [reasoning]

X should do Y because [reasoning]

Write an answer like a patent attorney would



What do we know about patent attorneys?

Detail, particularly in terminology is important!

Be clear and consistent as between:

The product (which embodies a design)

The rights in the design

Particular features of a product, or of a design

- Those that stated they could file a design did not say what they were filing for. It is important to be specific when giving information; saying 'file a design' is not good enough.

If you just say "design right", which right are you talking about?

For registered designs, are you are talking about an application or rights in a registered design?



What do we know about patent attorneys?

Detail, particularly in terminology is important!

Stick the wording of the statute – probably more important than citing the relevant Section

Care needed with “must fit” and “must match” shorthand

Do not let patent-specific language creep in
inventive step v **individual character**
skilled person v **informed user**



What do we know about patent attorneys?

Detail, particularly in terminology is important!

Stick the wording of the statute – probably more important than citing the relevant Section

Care needed with “must fit” and “must match” shorthand

Do not let patent-specific language creep in
inventive step v **individual character**
skilled person v **informed user**

Questions?

Appleyard Lees[®]

Innovation | Branding | Strategy | Solutions

Innovation | Branding | Strategy | Solutions



Our offices | CONTACT US

Manchester

The Lexicon
Mount Street
Manchester, M2 5NT
United Kingdom

T: +44 (0)161 835 9655
F: +44 (0)161 835 9654

Leeds

1 East Parade
Leeds, LS1 2AD
United Kingdom

T: +44 (0)113 246 5353
F: +44 (0)113 246 5472

Halifax

15 Clare Road
Halifax, HX1 2HY
United Kingdom

T: +44 (0)1422 330 110
F: +44 (0)1422 330 090

Cambridge

Godwin House
Castle Park
Cambridge, CB3 0RA
United Kingdom

T: +44 (0)1223 675 283
F: +44 (0)1223 675 288

BioHub at Alderley Park

Mereside
Alderley Park
Alderley Edge, SK10 4TG
United Kingdom

T: +44 (0)1625 881 089
F: +44 (0)1625 881 117

Appleyard Lees[®]

Candidate X 2019	Copyright	UK Unregistered Designs	UK Registered Designs	Community Registered and Unregistered Designs
<p>Covers What/ Definitions (What can be protected)</p>	<p>(a) ORIGINAL literary, dramatic, musical or artistic works (b) sound recordings, films or broadcasts (c) the typographical arrangement of published editions</p> <p>Does NOT exist in literary, dramatic or musical work before it is recorded in writing.</p> <p>LITERARY works Any work other than a dramatic or musical work, which is written spoken or sung, and includes: (a) a table or a compilation other than a database (b) a computer program (c) preparatory design material for a computer program (d) a database</p> <p>ARTISTIC works (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality (b) a work of architecture being a building or a model for a building (c) a work of artistic craftsmanship</p> <p>"Building" includes any fixed structure, and a part of a building or fixed structure. "Graphic work" includes painting, drawing, diagram, map, chart or plan, engraving, etching, lithograph, woodcut or similar. "Sculpture" includes a cast or model made for purposes of sculpture.</p> <p>["Dramatic work" includes a work of dance or mime. "Musical work" means a work consisting of music, exclusive of any words or action intended to be sung, spoken or performed with the music.]</p>	<p>Design - shape or configuration (whether internal or external) of the whole or part of an article.</p> <p>NB: Shape - physical geometry Configuration - relative arrangement of parts/elements "Parts of parts" are not protectable</p> <p>Unlike for an Unregistered CDR, in the UK one cannot protect COLOUR.</p> <p>The definition of a design only covers 3D products (i.e. surface decoration is excluded – see "exclusions" below).</p>	<p>Appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.</p> <p>PRODUCT: any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type- faces and parts intended to be assembled into a complex product.</p> <p>COMPLEX PRODUCT: a product which is composed of at least two parts permitting disassembly and reassembly of the product.</p> <p>A design incorporated in or applied to a component part of a complex product is only new and have individual character if the component part remains visible during normal use.</p> <p>"NORMAL USE" means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.</p> <p>MADE AVAILABLE TO THE PUBLIC - published following registration, exhibited, used in trade or otherwise disclosed before the relevant date, except where these events could not reasonably become known in the normal course of business to the circles specialised in the sector concerned.</p>	<p>Appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.</p> <p>PRODUCT: any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.</p> <p>COMPLEX PRODUCT: a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product</p> <p>If design applied to or incorporated in a product which is a component part of a complex product shall only be considered to be new and to have individual character: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use (b) visible features of the component have novelty and individual character.</p> <p>"NORMAL USE" means use by the end user, excluding maintenance, servicing or repair work.</p>
<p>Requires (What can be protected)</p>	<p>NB: Copyright takes precedence over UUKDR.</p>	<p>(1) Design right is a property right which subsists in an ORIGINAL DESIGN. (2) A design is not ORIGINAL if it is COMMONPLACE in the design field in question at the time of its creation.</p>	<p>(1) NEW - no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date. (2) INDIVIDUAL CHARACTER - 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. 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</p>	<p>(1) NEW - no identical design has been made available to the public before the date of filing of the application or date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details. (2) INDIVIDUAL CHARACTER – 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 date of filing of the application or the date of priority.</p>
<p>Excludes (What can be protected)</p>		<p>(a) a method or principle of construction</p> <p>(b) features of shape or configuration of an article which: (i) enable the article to be connected to, or placed in, around or against, another article (MUST FIT), or (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part (MUST MATCH),</p> <p>(c) surface decoration (NB: surface decoration is a matter for <u>copyright</u> protection).</p>	<p>(1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (2) MUST FIT - features of appearance of a product which must necessarily be reproduced 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. (3) Contrary to public policy or to accepted principles of morality. <u>Schedule A1 grounds for exclusion</u>: royal arms/crown not allowed; flags not allowed if their use is misleading or offensive; permission is required to use an image of the Queen.</p>	<p>(1) FEATURES SOLELY DICTATED BY THE PRODUCT'S TECHNICAL FUNCTION (2) MUST FIT - features of appearance of a product which must necessarily be reproduced in its 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. NB: Does not prevent a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system. (3) Contrary to public policy or to accepted principles of morality.</p>
<p>Qualification/ Ownership (Who qualifies for rights, Entitlement and Ownership)</p>	<p>AUTHOR = PERSON WHO CREATES IT Sound recording → the producer Broadcast → person making the broadcast Typographical arrangement of a published edition → publisher Computer generated → person who arranged it</p> <p>JOINT OWNERSHIP = produced by the collaboration of two or more authors in which the contribution of each author is not distinct from the other. A film shall be treated as a work of joint ownership UNLESS the producer and the principal director are</p>	<p>Designer (person who creates it) is the FIRST OWNER unless the design is created during the course of employment.</p> <p>FIRST OWNER (e.g. designer, employer) must be qualifying person for design to get UUKDR</p> <p>Can also get UUKDR if FIRST MARKETED in qualifying country by qualifying person. FIRST MARKETER is then the owner.</p> <p>QUALIFYING PERSON – individually habitually resident in a qualifying country, or body corporate formed under law of qualifying country with a place of business at which substantial business activity is carried out in any qualifying country.</p>	<p>Author shall be treated as the original proprietor. AUTHOR = PERSON WHO CREATES IT</p> <p>Employer shall be treated as the original proprietor, where a design is created by an employee in the course of his employment.</p> <p>NB: If a design is generated by a computer, the author is the person who made the necessary arrangements.</p>	<p>The right to the Community design shall vest in the designer or his successor in title.</p> <p>If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.</p> <p>Where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.</p> <p>Designer shall have the same right as the applicant or the holder of the registered design to be cited as such.</p>

<p>Duration</p>	<p>70 years from the end of the calendar year in which the author dies.</p> <p>Unknown authorship → 70 years from the end of the calendar year in which the work was made.</p> <p>If the work of unknown authorship was made public during that period → 70 years from the end of the calendar year in which the work was first made available.</p>	<p>15 yrs from the end of the calendar year in which the design was first recorded in a design document OR an article was first made to the design, whichever first occurred.</p> <p>If articles made to the design are made available for sale or hire anywhere within end of first 5 yrs, then 10 yrs from the end of the calendar year in which that first occurred.</p>	<p>5 x 5 yrs from date of registration. Renewal fees may be up to 6m late.</p>	<p>5 x 5yrs from date of filing (CRDR).</p> <p>3 yrs from the date on which the design was first made available to the public within the Community (CURDR) (i.e. shall NOT have protection if not made available within the Community)</p>
<p>Licences as of right</p>		<p>Any person 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.</p>		
<p>Infringement/Exclusions/Remedies (Rights granted by registration, Infringement)</p>	<p>Without consent of the proprietor:</p> <p>(a) copy the work (reproducing, storing in electronic form, making 3D copy of 2D work and making 2D copy of 3D work, taking a photograph of a film/broadcast, making a facsimile copy of a typographical arrangement)</p> <p>(b) issue copies of the work to the public (putting into circulation in EEA, if not already, or outside EEA, NOT subsequent distribution or importation)</p> <p>(ba) rent or lend the work to the public</p> <p>(c) perform, show or play the work in public (a substantial part must be infringed; substantial does not necessarily refer to length, but rather a key part)</p> <p>(d) communicate the work to the public</p> <p>(e) make an adaptation of the work (a translation, a version of a dramatic work converted into a non-dramatic work, a version of a book, newspaper or magazine in which the story is mainly conveyed by pictures, an altered version of a computer program, an arrangement or an altered version of a database, an arrangement or transcription of a musical work)</p> <p>NB: For computer programs: - translations include converting a computer program into a different code/language - it is NOT fair dealing to covert a computer program from a lower level language to a higher level language</p> <p>SECONDARY INFRINGEMENT</p> <p>(a) Without licence importing into the UK, otherwise than for private and domestic use, an article he knows/has reason to believe is an infringing copy.</p> <p>(b) Without licence possessing or dealing with an article he knows... (possess in the course of business; sell, let for hire, offer or expose for sale or hire; exhibit in public or distribute in the course of business; distribute other than in the course of business prejudicially affecting the owner of the copyright)</p>	<p>PRIMARY INFRINGEMENT</p> <p>(1) Without permission of proprietor reproduces the design for commercial purposes-</p> <p>(a) by making articles to that design</p> <p>(b) by making a design document recording the design for the purpose of enabling such articles to be made.</p> <p>NB: MAKING ARTICLES TO THE DESIGN means copying the design so as to produce articles exactly or substantially to that design.</p> <p>In other words, it is only infringement if the design is NOT an independent work of creation by a designer unfamiliar with the design. A different size has no bearing on whether or not there is infringement.</p> <p>(2) 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.</p> <p>SECONDARY INFRINGEMENT</p> <p>(a) imports into UK</p> <p>(b) has in his possession</p> <p>(c) sells, lets for hire, or offers or exposes for sale or hire, for commercial purposes, an article which he knows/has reason to believe is an infringing article (excludes the original article).</p> <p>EXCLUDES:</p> <p>INNOCENT INFRINGEMENT</p> <p>Primary Infringement – defendant did not know, and had no reason to believe, that design right subsisted in the design → claimant not entitled to damages.</p> <p>Secondary Infringement – infringing article was innocently acquired → only remedy is damages not exceeding a reasonable royalty.</p> <p>Who can bring infringement proceedings</p> <p>(1) The design right owner</p>	<p>Without consent of proprietor uses the design and any design which does not produce on the informed user a different overall impression (may depend on the degree of freedom of the designer).</p> <p>Use includes making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied or stocking such a product for those purposes.</p> <p>INFRINGING ARTICLE :</p> <p>(a) It has been/proposed to be imported into the UK</p> <p>(b) Its making to that design in UK would have been infringement of the right in a registered design right or an exclusive licence for that RUKDR.</p> <p>EXCLUDES:</p> <p>(a) private/not commercial act;</p> <p>(b) experimental act;</p> <p>(c) reproduction for teaching purposes;</p> <p>(d) Planes/Ships temporarily in UK registered in a 3rd country;</p> <p>(e) carrying out of repairs/importing spares for such ships/aircraft.</p> <p>Right to Prior Use</p> <p>A person who, before the application date, used a registered design in good faith or made serious and effective preparations to do so may continue to use the design for the purposes for which, before that date, the person had used/prepared to use it.</p> <p>Does NOT include:</p> <p>(a) if was copied from the design which was subsequently registered</p> <p>(b) a right to license the design</p> <p>(c) right to assign or transmit the design UNLESS (i) the design was used in the course of business; (ii) the design is assigned/transmitted with the part of the business in which the design was used.</p> <p>Who can bring infringement proceedings</p> <p>(1) The design right owner</p> <p>(2) Exclusive licensee</p>	<p>The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.</p> <p>Infringes if: without consent of proprietor uses the design. use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.</p> <p>UNREGISTERED DESIGN - only if the contested use results from copying the protected design.</p> <p>NB: criteria for infringement of an unregistered design right is the same as for a registered design right with the caveat of COPYING.</p> <p>EXCLUDES:</p> <p>(a) private/non-commercial acts;</p> <p>(b) experimental acts;</p> <p>(c) reproduction for the purposes of making citations or of teaching;</p> <p>(d) Planes/Ships temporarily in EU registered in a 3rd country;</p> <p>(e) carrying out of repairs/importing spares for such ships/aircraft.</p> <p>Exhaustion of Rights</p> <p>Rights conferred by CDR shall not extend to acts relating to a product put on the market in the Community by the holder of the CDR or with his consent.</p> <p>Right to Prior Use – same as UK</p> <p>Remedies</p> <p>(1) injunction</p>

<p>Grace Period/Priority (Grace periods and prior art disclosures)</p>			<p>6 month priority period (i.e. 6m to claim priority from an earlier convention application).</p> <p>PRIORITY CLAIM REQUIREMENTS: (a) date of each convention application (b) country in which each convention application was made (c) 3m from date of filing of later application shall provide representation of design of earlier application.</p> <p>Not disclosed if: (a) It could not reasonably have become known in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned. (b) It was made to a person other than the designer/successor of his, under conditions of confidentiality whether expressed or implied. (c) It was made by the designer/successor of his, during the period of 12 months immediately preceding the relevant date. (d) It was made by another person, during the period of 12 months immediately preceding the relevant date in consequence of information provided/action taken by the designer/successor of his. (e) It was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the</p>	<p>6 month priority period.</p> <p>PRIORITY CLAIM REQUIREMENTS: (a) declaration of priority (<1m) (b) copy of previous application</p> <p>A design is not disclosed if such events could not be reasonably become known in the normal course of business to the circles specialised in the sectors concerned in the Community.</p> <p>Not counted as disclosure if it has been made available to the public: (a) by the designer/his successor or a third person as a result of information provided or action taken by the designer/his successor; and (b) during the 12-month period preceding the date of filing of the application or the date of priority.</p> <p>Also not disclosure if the design has been made available to the public</p>
<p>Renewal and restoration</p>			<p>Restoration Application for restoration may be made by: (1) registered proprietor (2) any other person who would have been entitled had the right not expired (3) one or more of joint applicants</p> <p>UNINTENTIONAL → restoration of right on payment of renewal fee + additional fee. Must state grounds. PERIOD FOR REQUESTING RESTORATION = 12m</p> <p>Examiner must notify applicant within 6 weeks of expiry.</p> <p>Renewal 6m before the end of the registration period</p>	<p>Restitutio in Integrum Application must be filed <2m of cause of non-compliance 12m time limit for submitting application</p> <p>Lapse must be in spite of ALL DUE CARE REQUIRED BY THE CIRCUMSTANCES Must state grounds.</p> <p>Examiner must notify applicant within 6 weeks of expiry.</p>
<p>Multiple Designs</p>			<p>Several designs may be combined into one application.</p> <p>Fees are due for each multiple application/registration.</p> <p>Multiple designs are independent of surface decoration.</p>	<p>Several designs may be combined into one application, BUT designs must be applied to/incorporated in products of the same LOCARNO CLASS.</p> <p>Fees are due for each multiple application/registration.</p> <p>Multiple designs are independent of surface decoration.</p> <p>Locarno class additional fees must be paid within 2m of filing.</p>

Sample Answers

2022

2)

UKUDR

In the UK, unregistered design rights will automatically subsist in the **original** design from the date that it was first recorded, which appears to have already happened.

The client is based in the UK so is a qualifying person for UKUDR protection.

This protection will last up to 15 years from the first recording or up to 10 years from first sale if this happens in the first 5 years of protection term.

Hence, this protection will readily cover the length of time required.

However, this protection does not cover surface decoration so, if any aspect of the design relies on surface decoration, this will not be protected.

This protection is also limited to the UK.

Supplemental UKUDR & Community UDR

If the design is novel and has individual character (providing a different overall impression to the informed user over the state of the art) then supplemental UKUDR will subsist in the design automatically from the date that the design is first disclosed in the UK or EU. Similarly, Community UDR will subsist in the design automatically from the date that the design is first disclosed in the EU.

The launch event, which is being streamed to retail customers in **both** the UK and EU will trigger this automatic protection in both jurisdictions, provided no earlier disclosure is made.

✓203

✓204 206

✓205

This protection will last for 3 years from the launch event and should therefore **just** cover the client's intended use of the design.

The two unregistered rights will, in combination, cover both the UK and EU, as the client requires. Surface decoration is also protected by these rights.

However, copying of the design is required for infringement.

Registered UK/Community rights

If the design is novel and has individual character (explained above), it can also be registered for broader protection not limited to protecting against direct copies.

✓210

Although there is a cost associated, the initial term lasts 5 years, so **safely** covers the client's intended use of the design. After the first 5 years, the registrations can then be allowed to lapse to avoid further costs.

Also, broader protection can be obtained by filing the applications for registered designs in both the UK and EU by using line drawings. This will provide protection for the shape, irrespective of colours, etc.

✓202

If advantageous, it is further possible to cover different aspects of the design individually and cost effectively using a multiple application in each of the UK and EU.

Surface decoration will also be protected.

Further, direct copying of the design is not required for infringement.

If possible, I recommend this approach as it provides the most robust protection and will definitely cover the intended use of the design (where as unregistered protection particularly in the EU is cutting it fine).

The applications should be filed before the launch event to reduce likelihood of a competitor accruing prior use rights, but a 12 m grace period is available after first disclosing the designs to validly file the applications.

MARKS AWARDED: 7/10

✓207

2021

Question 2:

UK unregistered design:

- UK unregistered design right subsists from when an article is first made to the design or recorded in a design document. No public disclosure is required for this design right to subsist. The dated drawings by Senior would count as a design document and therefore Senior have UK unregistered design protection for their design.
- Senior are UK manufacturer and therefore are a qualifying person in a qualifying country.
- The design must be original in the sense that it is not commonplace in the relevant technical area in a qualifying country. This would appear to be the case as the design is distinctive.
- UK unregistered design right subsists for 15 years from the end of the calendar year in which the design was recorded in the design document. Senior have not made available an article made to the design for sale or hire as they maintained the design as confidential information, and therefore this would be the appropriate term. Check the date on the drawings to ascertain when UK unregistered design protection would have started, in order to ascertain whether the design is still covered and whether a licence of right would be available (which is available in the last 5 years of the design right term).

- In order to enforce the UK unregistered design, Senior would have to show that the design had been copied. This does not appear to be the case as Ms Alten is surprised by the fact that Senior have the design. Therefore, Senior cannot enforce the design against Ms Alten. ✓205
- Prepare evidence that Ms Alten did not copy the design, for example, her own documents detailing the design. ✓204
- Ms Alten also has UK unregistered design right protection dating from when she first made an article to her design or recorded her design in a design document. The design is original because Senior's design is not commonplace in the technical area concerned in a qualifying country, because they kept the design confidential. However, she would also have to show copying to enforce it, which Senior did not do. ✓201 ✓203

Registered design

- The design is distinctive and therefore the design meets the requirements of novelty and individual character (i.e. it creates a different overall impression on the informed user)
- Senior's drawings do not invalidate the design because the details of the design were not made available to the public and were kept confidential. Disclosures are only novelty-destroying if they become known in the circles specialising in the sector concerned in the UK or EEA, which is not the case here. ✓207
- The demonstration to Senior does not invalidate the design because the UK design application had already been filed.

- Senior would have prior user rights if they had made serious and effective preparations in good faith to make or sell articles made to the design. However, for prior user rights to apply, they would need to have continued their preparations, whereas Senior in fact did not pursue the design. Therefore, Senior do not have prior user rights based on the information available. Check whether Senior continued work on the design at any point prior to the filing of the UK design application. ✓209
- Ms Alten's registered design protects designs which do not create a different overall impression on the informed user. As Senior's design only differs in immaterial details, the UK registered design will cover Senior's design. ✓210
- Therefore, based on the information available, Senior in fact do need to obtain a license from Ms Alten in order to make or sell walking frames to their design.
- Ms Alten does not need to take a licence from Senior for their unregistered UK rights in order to make or sell walking frames made to her design because she did not copy the design.
- As Ms Alten is expecting the design to be popular, consider filing overseas registered designs claiming priority from her UK design application, within 6 months of the filing date. (7/10)

201 202 203 204 205 206 207 208 209 210
 ✓ X ✓ ✓ ✓ X ✓ X ✓ ✓

MARKS AWARDED: 7/10

2020

Question 2

Entitlement

You should check to see whether L did in fact copy the design from W. Their design and first disclosure were after the date of first sale by W, so this seems likely. If so, W are the original designers, and are entitled to any registered design rights for the pattern.

There is a 12 month grace period for disclosures resulting from the designer. As the pattern was first disclosed in April 2020, W are within the grace period (up to April 2021), so can still file their own registered design.

✓203

They should file a (UK or community) registered design to the pattern itself:

✓204

Given the pattern is "striking" and consumers have "never seen anything like it".

The design to the pattern should be registerable, as it is new (differ in more than immaterial differences) and shows individual character (creates a different overall impression on the informed user) over known designs. However, it will need to be new and individual over prior filed designs, and designs which could reasonably be known in the EEA in the sector concerned, and over prior filed design rights .e.g. L's design. However, this appears to have been copied from W. Thus, this design can be discounted as a disclosure resulting from the actual designers (W) within the grace period.

✓201

✓202

Burden of proof to show that the design was copied by L will lie with W.

They can file in UK (registered design) to the pattern itself, but as they are very successful designs commercially, and they are selling online, may be preferable to file a community registered design to get protection across EP. Do this asap, to avoid any other conflicting registrations, e.g. due to independent creation.

They could also file a design to the pattern applied to decorative tableware to cover their specific products, and give further protection. File as part of a multiple design registration to save costs.

Could then file a priority claim within 6 months in any other states of interest abroad if of interest, e.g. US. Though, they should do this within 1 year of first disclosure (by April 2021) to take advantage of the grace period.

Their design right (UK or community) will cover the pattern no matter what it is applied to, so they should be able to stop the competitor L selling all of their products with the design applied in the UK (and abroad in EU if a community registered design is applied for).

✓205

Assuming L copied, W are entitled to the design. They should apply for their own design asap as set out above, relying on the grace period.

Currently L have an in force registered design right, so could bring infringement action against W. However, W could counterclaim for entitlement, due to copying.

W should pre-empt this, by applying to have L's design revoked either due to non entitlement, or due to lack of novelty/individual character in view of the prior disclosures of W (tableware sold in April). This was sold at craft fairs in the UK, which although small, would attract relevant people in the sector, so designs

✓207

✓206

could reasonably be known in European economic area in the sector concerned (sector of the prior art).

W may instead be able to obtain ownership of L's design if they can show that they are entitled.

If L did not in fact copy the design, then they are entitled to their design right. However, you can apply to have it revoked due to lack of novelty/individual character in view of W's sale in April. Should provide evidence of such disclosure and sale.

If L did not copy, and their designs to the curtains/seat covers etc. are new and individual in their own right, e.g. due to their shape, these designs could be valid (though no indication that anything beyond the pattern is new and individual.

Monitor for further designs submitted by L.

Communication from L merely draws attention to design - so is therefore a permitted communication and not an actionable threat.

Registered designs provide monopoly protection for 25 years from registration, renewal in 5 year tranches, so are a strong right for W.

No need to show copying for infringement.

MARKS AWARDED: 7/10

7

2019

Question 2

Registered design

Registered design gives best scope of protection because it permits the holder to prohibit use of the design, or any design not producing on the informed user a different overall impression, and does not require proof of copying.

✓ 210

Registered design protects the appearance of the whole or part of a product resulting from the features of lines, contours, colours, shape, texture and/or materials of the product or its ornamentation. Hence, the overall appearance of the ship (shape, colour, contours etc.) would be covered. The model ship is a handicraft product for which a design may be registered.

File a Community Registered Design (CRD) application because this will give protection in both UK and the Netherlands via one application, thus saving money and effort. File the application before the exhibition date; although there is a grace period of 12 months available, this does not prevent others from arriving independently at the design themselves and filing their own application, so better not to rely on the grace period.

✓ 205

✓ 206

Registered design will enable holder to prevent others from using the design; using the design = making, offering for sale, putting on the market, importing, exporting, or using an article made to the design, or storing such an article.

A CRD must be new and have individual character. The ship model is likely to be new because it is not an exact replica of the Mayflower. Individual character will depend whether it creates a different overall impression than any article made available to the public before the priority date; arguably it does compared to the wooden beam remnants, in terms of outward appearance of the ship model (the beams are presumably internal).

✓ 203

✓ 204

CRD lasts 25 years (renewable every 5 years).

File in black and white line drawings for best protection. If colour important, file separate CDR application with colour drawings.

✓ 208

Unregistered designs

Community Unregistered Design (CUD) protects the same as a CRD but only if can prove copying of the design. CRD lasts 3 years from date the design is first made available to the public in the Community, which will be date of exhibition in a few weeks. Arises automatically.

✓209

UK Design Right (UKDR) protects an original design, ie. one not being commonplace in a qualifying country (UK, EU, reciprocal countries) in design field in question at time of its creation. Protects shape and configuration, , whether internal or external, of the whole or part of an article but not surface decoration. Hence, unlike CDR and CUD, would not protect colour of the model.

Lasts 15 years from end of calendar year in which the design was first recorded in a design document or by making articles to the design, or if shorter, 10 years from end of calendar year in which articles made to the design first made available to the public by sale or hire. Unless the researcher made the design in 2014 or earlier, UKDR will expire end of 2029, subsisting due to exhibition sales in a few weeks.

UKDR only protects against copying the design, which requires proof of copying.

Is the researcher a qualifying person (habitual resident of a qualifying person)? If yes, they would own the UKDR. If not, the UK museum would be a qualifying person (UK company with substantial business activity in UK, as they presumably sell goods/services in the museum) and would qualify for UDR by first marketing in UK/EU, ie. at the exhibition.

7

MARKS AWARDED 7/10

Question 2

Any registered designs registered in UK will provide absolute monopoly with no need to prove copying.

Registered design lasts 25 years from filing subject to 5 yearly renewals.

First owner of designs is the designer (i.e. the design agency) unless this has been altered by agreement so check the contract to see who owns – if no terms alter default position then SS aren't entitled to file & need to have the rights transferred before filing in their name or can file in design agency's name & assign subsequently

✓206

✓207

Designer employed by design agency won't own the designs himself/herself as will have been created in the course of employment duties.

"Private" testing won't be **one unclear word** as prior art against the designs as long as the testing was under duty of confidence – need to check this. If it was confidential then no prior art ("assuming features are registrable") prevents registration of the novel aspects of the design that have individual character considering design freedom.

There is a 12 mth grace period so the exhibition in bath won't be novelty destroying for any design filed in 12 mths of exhibition but best not to rely on grace period as any independent 3rd party disclosures would be **one unclear word** & 3rd parties could obtain prior user rights so advise to file ASAP & definitely before the exhibition.

✓209

✓210

✓208

SS in all likelihood own designs so displaying at the exhibition won't be a breach of applicant's confidence.

Turning to the designs themselves – all aspects relate to showers so can file probably an EU design in one Locarno classification but no restriction on classifications in UK – so advise to file an EU or UK design (depending on markets of interest) in a single application to save fees.

Protectable aspects are shape of tray and surface pattern on base. These should be protected as separate designs.

✓201

Surface decoration is part of a product & hence is registrable (c.f. UK unregistered rights).

Shape is also a registrable part of a product.

Both aspects have aesthetic qualities ("new & distinctive") so aren't solely dictated by technical function & so aren't excluded.

The shape should be protected by black line drawings rather than solid coloured drawings to broaden the scope of protection (c.f. Trunki case) as the colour would be limiting if filed & so not in client's interest.

✓202

Same applies to surface pattern – should only depict the shape that produces the "distinctive" pattern using black lines unless the colour is necessary to provide the requisite distinctive character.

✓203

If filed in black lines then subsequent infringements would only have to give the same overall impression as the shape depicted & any coloured infringements could be prevented.

NB EU designs are substantively similar to UK & better value.

Question 2

He has taken no steps → priority claim is not an option.

In general, community and UK registered designs are very similar. File CRDs because he has interests in Europe, and UKRDs as a brexit-based precaution.

For both UKRD & CRD, there is a 12 month grace period for designer disclosures made public in the EEA. As the US launch may have become known, recommend filing within 1 year from first disclosure. However, recommend filing ASAP to protect from risk of independent creation.

201

Bracelet, necklace and ring are likely to all fall within the same top level locarno class, and so recommend filing one app to the three designs. This will save money, and the designs will protect against anything which does not produce a substantially different overall impression on the informed user. Right will last upto 25 years, renewals due every 5 years.

209

Validity of registration

The designs appear to be novel and possess individual character → “particularly distinctive appearance”. The only other issue is for the ring, is its design solely dictated by technical function? Did you have design freedom, i.e. is there any other way of making that mechanism? If no, patents would have been your only option, but not now in view of US disclosure. If yes, then registration for ring likely to be valid.

203

Mr Rough

Any potential infringement/3rd party disclosure in the grace period could only be caught/discarded if one could prove copying. This seems likely as the articles are “replicas”. Therefore, any design rights of Mr Smooth’s could be enforced, once registered, to stop Mr Rough (i.e. through an injunction). Remedies being: damages or account of profits, delivery-up/destruction of goods, injunctive relief, declaration of infringement.

206

Ring

If registrable, it seems the design for the ring is infringed as, irrespective of the lack of functionality, it produces the same overall impression on the informed user.

207

Bracelet

The bracelet appears identical, and the design should be registrable and so Rough could be stopped from (or sued for) MUDOIKE the bracelet.

Necklace

Rough doesn’t make Necklaces. So no infringement here.

Earring

Smooth will have no registration for earrings (any attempt would not be novel), but if the earring does not create a different impression to the ring (“includes appearance of mechanism”) and ring mechanism appearance is registrable, MUDOIKE the earrings could also be stopped from or sued for MUDOIKE the earrings.

210

Therefore, once designs are registered, apply for injunction, or bring proceedings in court.

2022

Question 2

Your UK client X is a well-known manufacturer of hairdryers which are sold in the UK and widely throughout the EU. The client has sent you details of a new design, created in-house, for a hairdryer which it will sell only for the next three years, after which it will be replaced by a future design. Launch is scheduled to be in London in November with live streaming to retail customers based in the UK and the EU and who operate throughout the UK and EU.

Prepare notes for a discussion with your client as to the forms of design protection that may be available during the intended period of sale and what might be done to maximise design protection throughout the UK and the EU.

10 marks

2021

Question 2

You have recently filed a UK design application for your UK client, Ms Alten (A), for registration of a distinctive new design for a walking frame for elderly and disabled people. Subsequently, Ms Alten made a prototype, which she demonstrated to a UK manufacturer, Senior Ltd (S), who she had never dealt with before, to discuss large-scale production of the walking frame.

To Ms Alten's surprise, immediately following the demonstration, Senior revealed dated drawings made by their development department some years previously and showing an almost identical design, differing only in immaterial details. Senior explained that, although they believed the walking frame would eventually be a popular product, they felt at that time the market was not ready for such a distinctive design and had not pursued it, with all details of the design remaining in-house as confidential information.

Ms Alten has subsequently received a letter from Senior advising that they own the rights in the design and do not need any licence from Ms Alten to make or sell walking frames made to their design. In addition, any registration by Ms Alten resulting from the application will be invalid and she cannot make or sell walking frames made to her design without infringing Senior's rights.

Prepare notes for a meeting with your client regarding UK Unregistered and Registered rights only.

10 marks

2020

Question 2

New clients, Mr and Mrs Ware (W), come to you with a problem. They make hand-decorated ceramic tableware (tea sets and dinner sets) which they sell at craft fairs in the UK. They developed a new decorative pattern which they have applied to the tableware since April 2020 and which is fast becoming their top-selling line. Visitors to their stall say they have never seen anything like it and observe how striking the new pattern is. To capitalise on the pattern, Mr and Mrs Ware have, in July 2020, set up a website for online sales and, more recently, have started developing new products using the pattern, especially on table coverings and serviettes.

They have just received a letter from a well-established UK retailer, Lately Ltd (L), advising that Lately Ltd registered a design to the same pattern and also, particularly, when it is applied to curtains, seat covers, ceramic napkin rings and candle holders. The letter merely draws attention to their registered design. Mr and Mrs Ware have invested a significant sum to develop products incorporating the pattern and to set up their sales business.

You check and find the designs were registered in the UK by Lately Ltd in June 2020 but you have searched and cannot identify any evidence of a prior disclosure or sales by Lately. Mr and Mrs Ware inform you that Lately Ltd is well known for copying popular designs.

Advise your clients on the situation regarding UK registered designs only.

10 marks

2019

Question 2

You are contacted by the curator of a UK nautical museum. The curator advises you that an independent researcher has contacted them, in confidence, with a small model of what the researcher believes is the famous ship, Mayflower, that was used to transport the Pilgrim Fathers to Virginia, USA in 1620. There is no existing record of the design of the Mayflower. A number of original wooden beams purported to be from the remnants of the Mayflower provided the inspiration for the researcher's design, although the design is unlikely to be an exact replica.

The curator advises you that the museum is planning, at considerable expense, to commission an initial batch of 100 hand-crafted wooden reproductions of the design, which are to be marketed in conjunction with the opening of a new exhibition in a few weeks. There is likely to be interest in the models from the UK and the Netherlands during the exhibition.

Advise the curator on how best to protect the design for the benefit of the museum ignoring issues of copyright.

10 marks

2018

Question 2

Your UK client, ShowerSafe Limited (SS), manufactures shower trays and shower enclosures for users who lack mobility. SS has sent you an email with solid-coloured drawings of a shower tray which it says has new and distinctive shape features and a new and distinctive surface pattern on the base of the tray.

The design was created by an external design agency.

Prototypes of the design have been tested in private, but SS has committed to displaying the tray at the 'ShowerAid' exhibition in Bath, which takes place in two weeks.

Provide SS with advice on how best to protect all the new features of the shower tray by *registered design protection only* in the UK and whether the drawings they have provided are suitable for filing. Prepare notes for your client assuming the new features are registrable.

10 marks

2017

Question 2

Your US client, Mr Smooth, comes to you with his new ring which has an adjustment mechanism allowing the ring to be resized for different fingers. The adjustment mechanism gives the ring a particularly distinctive appearance, and so he has replicated its appearance (but not the mechanism itself) in a matching bracelet and necklace. Mr Smooth tells you that he launched his jewellery range in the US around nine months ago, and will shortly be launching in Europe.

Mr Rough, a competitor of Mr Smooth, has a business making low-cost replica jewellery. Three months ago, Mr Rough launched, in the UK, a matching ring, bracelet and earrings, which can be sold individually or together as a gift set. The ring is not actually adjustable, but includes the appearance of Mr Smooth's mechanism. The bracelet appears identical to Mr Smooth's. The earrings include the appearance of the mechanism.

Mr Smooth asks for your help in stopping Mr Rough. He has not yet taken any steps to protect his products.

Make notes, relating to registered designs only, in preparation for a meeting with your client.

10 marks

2016

Question 2

You are contacted by KitchenBitZ Ltd (KBZ), who have been developing a new toaster having an unusual appearance. The toaster has been in development since the beginning of 2015 and was first offered for sale through KBZ's website in August 2015.

KBZ has received a letter from a major appliance manufacturer, Deutsch GmbH (D), drawing attention to its GB registered design GB-RD1, which clearly shows a toaster that is essentially the same. GB-RD1 was filed in July 2015 without any claim to priority.

KBZ asks what they should do as their toaster clearly infringes GB-RD1, but have made a significant investment in the design of the toaster. Moreover, the appearance of the toaster can be carried over into other small kitchen appliances and this could be a very profitable extension to KBZ's business, although no work has been carried out so far.

KBZ tells you their new toaster design has been noticed by another UK company, which has expressed interest in either taking a licence or purchasing the rights to the design.

Make notes, relating to registered designs only, in preparation for a meeting with your client.

10 marks

2015

Question 2

Your US client Lighting US Inc. (L) sent you an email late last night with various attachments and asks you to obtain registered protection in Europe.

You open the attachments to the email and find three separate US 'design patent' applications. There are a total of five different looking designs in the applications. Two of the designs are for torches, two are for lanterns, and one is for a floodlight. The application for torches has a filing date of 12 April 2015, and the other two have filing dates of 13 April 2015. The US inventors are different for each application but your client has sent a copy of the signed assignments from the inventors to Lighting US Inc.

Your client explains that today and tomorrow are national holidays in the US and he will be unavailable, so asks you to take whatever action is necessary to protect his interests in Europe at the minimum expense because he plans to launch his products late next year.

He apologises for the late instructions but says that even if it is too late to obtain registered protection he has heard that there is an automatic protection for designs in both the UK and elsewhere in Europe so it won't matter too much.

Ignoring patent law and copyright, prepare notes for a follow-up call with your client on what actions you have taken and why.

10 marks

2014

2. Your UK client, ACCEZORIES (A), designs and manufactures spoilers for cars which are purely aesthetic in nature.

In 2010, after a short development period, ACCEZORIES started selling the new spoilers at a motor show. The spoilers are an interesting and unusual shape. However, they must be able to fit to the relevant part of the vehicle to which they are secured.

ACCEZORIES calls you today because a high street auto centre CAR BITZ (C) has recently started selling (in the UK and France) cheap replicas of their spoiler.

ACCEZORIES want to know if they can stop these replicas being sold. They have no registered protection for their products.

Write notes for a meeting with your client considering UK and Community Unregistered Design Rights only - do not consider other forms of protection.

10 Marks

2013

2. You are contacted by your client who manufactures and sells crockery. Four months ago the client introduced a new range in the UK. The crockery was based on well known shapes, but with new eye-catching decoration produced by an employee. The new range is proving to be very popular and the client is exploring the possibility of export to other EU countries.

Your client has in the last two weeks discovered that another UK company is about to launch a range of soft furnishings incorporating a design which is rumoured to be identical to your client's new decoration and considers this is likely to have an adverse impact on your clients' products.

Write notes for a meeting with your client considering UK and Community Registered Design Rights only - do not consider other forms of protection.

10 Marks

Year	Question	Answers	Examiner's report
2022	2	<p style="text-align: center;"><u>Forms of UK and EU design rights available</u></p> <p>201 Client is owner of all UK/EU design rights because this is an in-house design (i.e. created by an employee in the course of employment)</p> <p>202 UKRDR and UKURD are forms of design right available to the client</p> <p>203 UKSUDR is available from date of launch because it will be a first disclosure and in the UK</p> <p>204 EURDR is available to the client</p> <p>205 EUUDR is available from first disclosure to the public within the EU (unless the design has previously been disclosed in such a way that, in the normal course of business, the design could reasonably have become known to circles specialised in the sector concerned, operating within the EU)</p> <p>206 Both UKSUDR and EUUDR should be available because first disclosure in the UK and EU will be simultaneous (retail customers from the UK and EU who operate throughout the UK and EU).</p> <p>207 Registered design applications can be filed within 12 months of first disclosure (disclosure at the launch would establish a date of first disclosure)</p> <p>208 Care should be taken, for the registered design, to ensure that the design does not publish before the launch</p> <p>209 One of UK or EU RDR can claim priority from the other within 6 months of filing</p> <p>210 Advise J that although registered rights incur a cost, they have the advantage of no requirement to prove copying</p>	<p>This question was generally well answered. However, many candidates recited details that were clearly not required. The question concerned forms of design protection that were available and could be used to maximise the client's protection, not whether the design met any conditions for registrability. Despite being guided towards the various types of design right, many candidates were unable to resist discussing the validity of the design, which was awarded no marks.</p> <p>While a good proportion of candidates correctly stated the law for EUUDR and UKSUDR, recognising the need for the first disclosure to be within the particular territory, relatively few recognised the practical issue that a disclosure in one territory could preclude protection in the other and a potential solution was simultaneous disclosure.</p> <p>One of the key pieces of information was the simultaneous launch and this was overlooked by many as to its impact.</p> <p>The fact that the publication of the design application could prejudice the various UDRs was rarely considered.</p> <p>Some candidates interpreted the "in house" aspect of the scenario to relate to the novelty of the design, rather than ownership</p>

Year	Question	Answers	Examiner's report
2021	2	<p style="text-align: center;"><u>UKUDR</u></p> <p>201 Both A and S have original distinctive designs entitled to UKUDR (because there was no prior contact between them)</p> <p>202 A has supplementary UKUDR (The Designs and International Trade Marks (Amendment etc) (EU Exit) Regulations 2019)</p> <p>203 Your client cannot stop S from making and selling their design under UKUDR</p> <p>204 S cannot stop your client from making and selling her own design under UKUDR</p> <p>205 Because there would be no copying UK Registered Design</p> <p>206 A is rightful owner of her Registered Design (reason required - because she is the author/designer)</p> <p>207 A's design is registrable because there has been no prior publication so the design is novel</p> <p>208 and "distinctive" design implies individual character</p> <p>209 S has no third party rights because no continuous serious and effective preparations</p> <p>210 S will infringe, because the designs are not materially different (or would not produce a different overall impression), if it should make or sell walking frames (according to either design)</p>	<p>The average mark achieved for this question was 5 out of 10.</p> <p>Whilst discussion of registered designs was generally well handled, the complexities around unregistered rights were often not fully recognised. Most candidates noted that Senior has UDR in its frame, but very few noted that Alten also has UDR in addition to her application for a registered design. In fact, both parties independently created their designs and are, therefore, both entitled to UDR. However, in the absence of copying, they cannot stop each other via such unregistered rights.</p> <p>The question states "You have recently filed ..." and "Subsequently... made a prototype which she demonstrated ...". However, a significant number of candidates were concerned about public disclosure by Alten to Senior and the need to rely on a grace period.</p> <p>Few candidates seemed to identify that Alten had supplementary UKUDR, which is surprising given the recent changes in the law (and the FD1 Syllabus) relating to Brexit.</p> <p>Several candidates wasted time on irrelevant points such as detailing the length of registered design protection which, as the design application was recently filed, was not yet relevant to the client.</p> <p>Overall, however, this question was answered well by many candidates.</p>

Year	Question	Answers	Examiner's report
2020	2	<p style="text-align: center;"><u>Registrability</u></p> <p>201 Appears to be novel (first sold April 2020)</p> <p>202 Has individual character because striking pattern</p> <p>203 Can rely on 12 month grace period to secure registration (providing Lately design derived from Wares design)</p> <p>204 File application for UK Registered design for the pattern. Potential infringement by Wares</p> <p>205 Registration extends to products beyond those specified so will include those sold by Wares</p> <p>206 Registration is invalid – because lack of novelty over sales by Wares</p> <p>207 Can take action...any one of.... have design revoked/declaration of invalidity/entitlement action etc</p> <p>208 do Wares have a prior user right ?</p> <p>209 discussion point – an appreciation prior user rights would not apply to all products at all time points needed – eg in respect of the ceramic products but not for the later products?</p> <p>210 Cannot take action until the design is registered or until the outcome of entitlement proceedings are concluded.</p>	<p>The average mark for this question was 6 (10 marks available).</p> <p>The designs question this year was better answered than in previous years and this is a positive trend. This year the question was concerned solely with aspects of registered designs.</p> <p>An important consideration is whether the clients can secure registration for their design which is a new decorative pattern, initially applied to ceramic tableware and more recently extended to further products. Tableware bearing the new pattern has only been available since April 2020 so is novel. It is said to be “striking” and therefore satisfies the requirement for individual character (see S1B RDA). In order to gain the marks for registrability it is important that candidates do not just state the law but also link it to the facts provided in the question. Although Lately has a publication of the pattern with its registration which is after April but before any application the clients may file, the clients can take advantage of the 12 month grace period provided that Lately’s design has been derived from the clients’ design (copied) (see S1B RDA). An application for a UK registered design should therefore be filed for the pattern. A common error made by candidates related to incorrectly stating that the grace period was 6 months rather than 12 months.</p> <p>It should be noted that while an application for registration must specify one or more products (Rule 5(2)) it is the design, not the product, that is protected (S7(1) RDA). Many candidates missed this important distinction. Nevertheless, the clients are at present still at risk of an infringement action from Lately. As explained above, it is the design that is registered not the product, so the scope of any design registration extends beyond the product(s) specified in the application. Consequently, Lately’s design registration covers all the products sold, or to be sold, by the clients.</p> <p>However, Lately’s registration is invalid because it lacks novelty due to the sales by the clients before Lately’s application was filed. The clients actually have several options here, including declaration of invalidity (on the grounds of lack of novelty or entitlement) (S11ZA RDA) or rectification (on the same grounds) (S20 RDA). In any event, the clients have a prior user right (S7B RDA) although this only applies to the initial tableware products and not to the new products (S7B(1) RDA).</p> <p>The clients’ application will result in a registered design which they can enforce against Lately, but no action can be taken until the design is registered (S7 RDA).</p>

Year	Question	Answers	Examiner's report
2019	2	<p style="text-align: center;"><u>Ownership</u></p> <p>201 Design was from an independent researcher, who is therefore the owner</p> <p>202 Client will need an agreement in place if they want to control the situation – licence or assignment Registrability</p> <p>203 New – design appears to be new becauserationale...</p> <p>204 Individual character – discuss, e.g. details not previously known, design freedom etc.</p> <p>205 Register the design eitherUK/NL or EU</p> <p>206 Is advisable to register before the conference but may use grace period</p> <p>207 Term discussion – Either a) seems design may have been short lived benefit therefore no need for long term/term of 5 years may be enough; or b) the significant interest/expense may warrant requiring a longer duration</p> <p>208 Need line drawings to best protect the design. UDR</p> <p>209 UDR (UK and EU) could automatically exist but....</p> <p>210 ...still recommend RDR because...requires UDR proof of ownership and copying, (one reason is enough)</p>	<p>The average mark achieved for this question was 6 out of 10. It was good to see a much stronger set of marks being achieved in the designs question than has been achieved in previous years.</p> <p>It is clear from the question that the independent researcher is the owner of the design. Consequently, the museum will require an agreement (an assignment or a licence) to be in place if it wishes to control marketing of the models. This was dealt with well by most candidates. The design appears to be new, for example because the question states that there is no existing record of the design of the Mayflower, and possesses individual character because the limited number of wooden beams cannot convey many aspects of the design, leaving the researcher considerable freedom when completing the design. The design should be registered either as a Community registered design or in both UK and the Netherlands in order to cover the client's needs and can best be protected with line drawings. It is advisable to seek registration before the opening of the exhibition, but if this is not possible then the grace period may be used, although this does not protect against independent third-party designs. This has been covered a few times now in FD1 and is generally well answered.</p> <p>The question states that there is likely to be interest in the design during the exhibition, so the commercial value of the design may be short-lived and the initial registration period of 5 years may be sufficient. However, some candidates felt that the "considerable interest" may suggest a need for a longer duration of protection. Candidates were awarded the mark for justifying why term was relevant to their advice regardless of which way they went. Answers that mentioned the term for a registered design but failed to give advice on tailoring it to the needs of the client did not attract the mark. Unregistered design rights will, or will in due course, exist automatically in UK and EU but registration may be preferable because, for example, unregistered design right requires proof of ownership or proof of copying to enforce. A justified reason was required for the mark.</p>

Year	Question	Answers	Examiner's report
2018	2	<p style="text-align: center;"><u>UKRDR</u></p> <p>201 File multiple UK design applications, one for the shape and one for the pattern (or one application that is later divided)</p> <p>202. Need line drawings to best protect the shape of the tray</p> <p>203. discussion required regarding practicality of use of solid drawings for the surface pattern.</p> <p>204. Cannot have both line drawings and tonally shaded solid drawings in the same application (but can in separate designs of a multiple design application)</p> <p>205 Best to include a disclaimer (verbal/visual) in the shape application to exclude pattern – protection is sought for the shape and contours alone - For the above see Designs Practice Note DPN 1/16</p> <p>206 The first owner of the design is the designer not SS (S2 RDA 1949)</p> <p>207 Need to ensure a contract or assignment is in place transferring ownership to SS (S2 RDA 1949)</p> <p>208 Best to file the applications before the exhibition starts (S1B RDA 1949)</p> <p>209 But can file up to 1 year after first disclosure (S1B RDA 1949)</p> <p>210 However, does not protect against independent third party designs (S1B RDA 1949)</p>	<p>The average mark achieved for this question was 6 out of 10. Generally this question was well answered but incomplete analysis meant available marks could not be awarded.</p> <p>The designs question covered a number of aspects of designs law and practice including application procedure, representations and ownership. Candidates were expected to advise their client that two UK designs applications should be filed, one to the shape and one to the pattern. The design was created by an external design agency and candidates were expected to explain that the first owner is the designer and not the client. Although most candidates scored well on the ownership part of the question there were still some who referred to ownership by commission, which is not current law and changed in 2014.</p> <p>The separate needs of the shower tray (shape) and the surface pattern (decoration) were often blurred together and not recognised. When filing strategy for both was discussed very few mentioned the possibility of later dividing a single application.</p> <p>Although candidates often recognised the benefit of line drawings for optimal protection of the tray, discussion often did not extend to the related point of appropriate drawings for the pattern and the incompatibility of both drawing types in a single application. The available mark for discussing the use of a disclaimer was infrequently awarded.</p> <p>The client had provided solid CAD drawings and candidates were expected to appreciate these might not be ideal. According to Designs Practice Note 1/16 line drawings are required to best protect the shape, but this is not necessarily the case with the pattern and some discussion of the practicality of using the solid drawings was expected. However, it is not permitted to mix simple outline drawings with tonally shaded CAD drawings in the same application. The practice note also explains that for shapes it is best to include a disclaimer to pattern, for example along the lines of “protection is sought for the shape and contours alone”.</p> <p>Finally, although many appreciated the existence of a grace period, many still did not advise to act quickly and that reliance on the grace period is inadvisable since it does not protect against independently derived disclosures: this is a way of mitigating risk for your client.</p>

Year	Question	Answers	Examiner's report
2017	2	<p style="text-align: center;"><u>Registrability</u></p> <p>201 Registered design protection can still be sought in the UK/Europe because less than 12 months has lapsed since your clients disclosure (grace period).</p> <p>202 Grace period does not protect against 3rd party disclosures however, Mr Rough copied from Mr Smooth</p> <p>203 The mechanism appearance may not be solely dictated by function, so it is likely that registered design protection would be available for these items as a whole.</p> <p>204 Recommend filing a single or multiple Community design registration covering the mechanism per se</p> <p>205 Recommend filing on the appearance of the mechanism, when applied to each jewellery item.</p> <p style="text-align: center;"><u>Infringement</u></p> <p>206 From registration – it will be possible for Mr Smooth to enforce his reg design right.</p> <p>207 For infringement the mechanism must confer on the user the same overall impression which is likely due to being replicas (conclusion required)</p> <p>208 The bracelet at least is identical therefore if Mr Rough has copied then this was not in good faith and prior user rights will not apply.</p> <p>209 Because the design was copied before the registration no criminal sanctions will apply to Mr Rough.</p> <p>210 The earrings/ and giftsets containing them would be covered by the appearance of the mechanism RDR as design is not limited to the article to which it is applied</p>	<p>The average mark achieved for this question was 4 out of 10. It is important for question 2 to bear in mind that it is the design of the adjustment mechanism that is under consideration, even if that design may be applied to different products, such as a ring, bracelet, necklace or earrings. Candidates are told the adjustment mechanism has a particularly distinctive appearance and what is more it is found on items which are not themselves adjustable. This should indicate the design is unlikely to be solely dictated by its function and is likely to be registrable.</p> <p>The client has disclosed the design as part of the ring, bracelet and necklace around nine months ago. Registered design protection can still be sought in the UK or Europe due to the grace period. Although the grace period does not protect against third party disclosures, the question makes it clear that the competitor is known for making replica jewellery and launched his products after the client's launch in USA. To the extent that the competitor copied the design from the client (which seems very likely) the disclosure can be discounted.</p> <p>Since the design does not appear to be solely dictated by function, both the mechanism itself and all the products sold by the client should be registrable. Given the client's intended launch in Europe, a Community registered design is indicated and registration should be sought at least for the mechanism itself and ideally also for each of the products (ring, bracelet and necklace) sold by the client. This can be accomplished by filing several independent applications or preferably by filing a single multiple application to save costs.</p> <p>It is then necessary to consider how the applications can be used to carry out the client's wish to stop the competitor. This is only possible after registration and to prove infringement the competitor's designs must confer on the user the same overall impression. This seems likely to be satisfied because of the replica nature of the competitor's products.</p> <p>The competitor's bracelet at least, is the same as the client's product and to the extent the competitor has copied the client's design the bracelet was not sold in good faith and prior user rights will not apply. Because the design was copied by the competitor before registration, no criminal sanctions will apply.</p> <p>The earrings and giftsets are covered by the proposed registered designs in a number of ways. A design is not limited to the article to which it is applied so a registration of the appearance of</p>

			<p>the mechanism itself will prevent sales of both the earrings and the giftsets, (as arguably would registrations of any of the client's individual products), while the giftsets also include the ring and bracelet as specific products and either registration would prevent sales of these.</p> <p>It is evident that candidates continue to find the design question challenging. Fewer candidates attempted a 'data dump' of everything they knew about registered designs and the majority attempted to tailor their advice to the situation at hand which is very encouraging. Some candidates felt the disclosure by the third party in the grace period was a disclosure that meant the designs were not registerable and as a result lost a few marks for not appreciating they had been copied and was a disclosure that could be ignored. Those that stated they could file a design did not say what they were filing for. It is important to be specific when giving information; saying 'file a design' is not good enough. You need to show you have an understanding for what is registerable (and what might not be) as this may well be important later in discussion about what rights you can enforce.</p>
--	--	--	---

Year	Question	Answers	Examiner's report
2016	2	<p style="text-align: center;"><u>UKRDR</u></p> <p>201. Was there a prior disclosure which would invalidate D's registered design</p> <p>202. KBZ may have prior user rights because development started well before filing of GBRD1.</p> <p>203. Need to show KBZ has made serious and effective preparations to use the design prior to the filing of GB-RD1.</p> <p>204. This is likely to be the case – reason needed - (e.g. given that there was 6 months of development prior to GB-RD1 filing and only 1 month afterwards till sale or because of the significant investment).</p> <p>205. If copied there is infringement and KBZ must stop making and selling the toaster.</p> <p>206. (If not copied)... write to D to explain existence of prior user rights.</p> <p>207. Cannot extend the prior user right to use of the design to other small kitchen appliances (no preparations for such purposes).</p> <p>208. Cannot licence the prior user right to a third party.</p> <p>209. Can assign the prior user right but only if assigned with the relevant part of the business</p> <p>210. No protection is available for the other kitchen appliances.</p>	<p>The average mark on this question was 4 out of 10. Those candidates who approach the designs questions in the same manner they approach the patents questions with sensible analysis generally score better than those who simply regurgitate information.</p> <p>Most candidates identified the possibility that prior art may exist to invalidate the design or identified potential for prior user rights to have been generated. A disappointingly small number contemplated that your client may in fact have deliberately copied in which case there would have been infringement.</p> <p>A number of candidates discussed in great detail the registerability of the kitchen appliances and the possible term they could attract whilst not appreciating that prior user rights only protect against continued preparations and not extrapolation to the other appliances. Additionally many candidates appeared not to appreciate that, although a registered design application is required to specify a product, the resulting registration is not limited to that product. Such a registration will therefore be part of the prior art for a later application for the same design for a related product, which is the situation set out in the question. As nothing could be registered no discussion of Locarno classes or term was required.</p> <p>Candidates should ensure they are up-to-date with developments in the law. Prior user rights for designs became available as from 1 October 2014.</p>

Year	Question	Answers	Examiner's report
2015	2	<p>Priority, CRD, UKURDR, CURDR</p> <p>201 File today (at least on the torches)</p> <p>202 because the 6 months priority period expires today</p> <p>203 File a CRD for a series of 5 designs or file different applications - max 3 (providing this is due to a discussion regarding the Locarno class - see below)</p> <p>204 Different designs relate to articles in the same Locarno class, i.e. all lighting devices ormay not be considered same class - discussion required.</p> <p>205 each design must claim priority from the relevant US design patent on which it was based</p> <p>206 Assignment documents appear to be sufficient</p> <p>207 term would last 25 years from registration</p> <p>As your client has specifically discussed UDR.....</p> <p>208 UK UDR would not apply because there is no qualifying person</p> <p>209 CUDR is only 3 years (expire October 2018)</p> <p>210 Copying would need to be shown for infringement</p>	<p>The average mark on this question was 7 out of 10. Compared to the average mark achieved in designs questions from previous years this was generally well answered.</p> <p>While many candidates identified deadlines of relevance e.g. 6 month priority period, a proportion failed to advise that specific action should therefore be taken today. One candidate suggested that US closed days would allow UK filing deadlines to be extended.</p> <p>Most understood the principle that designs in the same Locarno class could be combined to save costs, however, a smaller proportion applied the facts of the question to reach a conclusion on whether to file a single or multiple applications – a mark was available for consideration of the facts regardless of candidate's detailed knowledge of the Locarno system. It was however, necessary to come to a conclusion on whether they can be combined because they are all lighting related, or they need to be filed separately because they are different products.</p> <p>Again specificity with terminology let some candidates down in this question – many appreciated that priority needed to be claimed but it is important to appreciate that each design is only entitled to claim priority from the relevant US design on which it is based and for which there is different dates. Candidates who simply state 'claim priority' are not giving specific enough advice.</p> <p>Some candidates suggested requesting a copy of the assignment for review – the question says it has been provided - careful reading of what the question does and does not say is important. Few commented on the sufficiency of the assignment documents.</p> <p>Some candidates recognised that the client was not a qualifying person but did not comment on the designer. Qualification can be through a number of routes. It is advisable to explain your reasoning stating 'there is no qualifying person' is correct but stating that 'there is no qualifying person because the client is US based' is better and shows the understanding of the legal point and facts. Some candidates appreciated that protection would last 25 years but stated it would run from registration of the design not application of the design.</p>

Year	Question	Answers	Examiner's report
2014	2	<p style="text-align: center;"><u>UKUDR and CUDR</u></p> <p>i. ACCEZORIES is based in the UK and therefore is a qualifying person in respect of UDR</p> <p>ii. UDR lasts the earliest of either... 1 mark</p> <p>iii. 15 years from the end of the calendar year in which articles first made or recorded... or 1 mark</p> <p>iv. 10 years from the end of the calendar year in which the articles first sold (31 Dec 2020) (if in the first 5 years). 1 mark</p> <p>v. Licences of right are available in the last 5 years i.e. by 1st Jan 2016/in 15 months. 1 mark</p> <p>vi. CUDR will exist and last for 3 years from the first disclosure - which has passed so no protection remains. 1 mark</p> <p>vii. therefore no action can be taken in France. 1 mark</p> <p>viii. The criteria of original designs (not commonplace) is met because the spoiler is said to be an "interesting and unusual shape". 1 mark</p> <p>ix. The part which must-fit the vehicle/spoiler (attaches) is not protectable due to the must-fit exclusion. 1 mark</p> <p>x. It is necessary to prove copying, which is likely to be possible because the shapes are replicas.</p>	<p>The average mark on this question was 6 out of 10. This year's design question related to unregistered designs only (and was clearly indicated as such in the instructions to candidates) yet again some candidates felt it necessary to discuss registered protection which simply wastes time and shows a lack of attention to instructions.</p> <p>This year's design question was well answered in comparison to previous years. However, too many candidates are making basic errors such as listing two possible deadlines but not advising their client which of the two dates is the one that applies – especially in cases such as this one where the earlier date is the critical date. Other candidates merely mentioned the shorter date without explaining why they felt this date was the relevant one in this situation – your client needs clear information. Also many candidates stated the correct time periods of 10 or 15 years but without explaining they ran from the end of the calendar year – this can have potentially a 12 month difference in exclusivity period for your client and is vital information to convey. Only a handful of candidates discussed the possibility of licences of right applying in the last 5 years: even fewer calculated this date correctly and appreciated that within a short time frame this was likely. This question was very simple in respect of Community Unregistered Design – the rights had expired. More candidates could have realised this earlier in their answers and saved significant amounts of time.</p> <p>The word 'replica' was used deliberately to imply copying but few candidates drew any conclusions in this respect.</p> <p>Finally, some candidates misunderstood the must-fit exclusion thinking that it excluded the whole spoiler rather than just the part which fits to the vehicle.</p>

Year	Question	Answers/Examiner's Report
2013	2	<p>Examiners report and mark scheme combined in 2013:</p> <p>The average mark on this question was 5 out of 10. Every year there is a design question and yet often this is a poorly answered question. P2 is a practice paper and marks are awarded for applying the law to the facts and not simply for stating the law. Candidates who have pre-prepared a script covering various aspects of designs law and which they reproduced in the exam generally score badly.</p> <p>This year's design question related to registered designs only yet some candidates still wrote about UDR. Candidates would also do better to structure their answers using headings where necessary.</p> <p><u>UKRDR and CRD</u></p> <p>A discussion was expected regarding the design being owned by the employer and regarding the location of the employer. (1). Surface decoration can be protected (1) but the design must be new and have individual character. Many candidates stated this part of the law but did not then go onto say whether or not this applied. To gain the mark candidates need to apply the law to the facts given such as "this appears to be the case as the design is stated to be new and is eye-catching in design". (1) The design itself will be protected therefore it will not be limited to the item to which it is added (Design is therefore not limited to crockery) (1) A 12 month grace period applies to the clients designs (1) but no grace period would apply if the competitor conceived the design themselves.(1) No need to prove competitor copied the design for enforcement/monopoly right (1) Candidates were often unclear as to the extent of the grace period, e.g. stating that it does not protect from third party registrations. The position is much more serious, in that it does not protect against independently derived disclosures at all, including the upcoming launch if their design was independently conceived rather than copied.</p> <p><u>CRD</u></p> <p>CRD would be useful to cover the exported goods (1). A discussion regarding prior user rights was expected (1) Prior user rights would exist for the community registered design (providing the design was not copied). However, this would not be the case for the UK RDR. Few candidates realised that UK RDR does not have a prior user right exception and therefore it is advisable in the event the third party design was not copied and they are a bona fide prior user Advice File registered community and UK designs (1). Those candidates which had not considered prior user rights generally failed to gain this mark as they believed filing a CRD covered the UK adequately.</p>