

**FACULTY OF LAW**  
**POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW**  
**AND PRACTICE 2016-17**

**Examiners' Report 2017**

**PART ONE**

**A. Statistics**

**1. Numbers and percentages in each category**

The number of candidates taking the examinations was 66 (including one candidate who re-took two papers, and three reinstated candidates (suspended in 2015-16) who took two papers).

	2017		2016		2015		2014	
Category	No	%	No	%	No	%	No	%
Distinction	8	12.12	10	16.13	7	12.5	8	12.90
Pass	57**	86.36	48	77.42	41***	73.21	49	79.03
Partial Fail*	1	1.52	2	3.2	8	14.29	5	8.06
Fail	0		2	3.2	0		0	
Total	66		62		56		62	

\* candidates who failed one or more papers and are eligible to re-take those in the next academic year

\*\* includes three candidates who withdrew from two papers in 2015-16 and completed the Diploma in 2016-17

\*\*\* includes a candidate who withdrew from two papers in 2013-14 and completed the Diploma in 2014-15

**2. Vivas**

Vivas are not used in this Diploma.

**3. Marking of scripts**

Double marking of scripts is not routinely operated. 155 out of 455 (34.07%) scripts (43.67% in 2016; 39.2% in 2015; 45.23% in 2014) were second marked. Third marking may be used in exceptional cases and three scripts (0.66%) were third marked this year. Further details about second marking are given in Part Two (A.1.).

## **B. New examining methods and procedures**

The Diploma is jointly taught and examined by senior law practitioners (solicitors) who are members of the Intellectual Property Law Association (IPLA) and by members of the Faculty of Law. Teaching commences with a two-week residential programme in Oxford in August/September followed by nine workshops (two of which are revision workshops) spaced over the academic year. The candidates are all newly qualified or trainee solicitors or barristers. The Diploma examination is divided into Part I and Part II. Part I focuses on the practice of intellectual property (IP) law and consists of five coursework assignments (two in Michaelmas, two in Hilary and one in Trinity Term). Each coursework assignment is preceded by a one-day workshop on the relevant IP topic(s). Part II consists of two unseen two-hour examination papers covering the range of IP law, and are written at the end of Trinity Term.

In each paper (coursework assignment or examination paper) a proportion of scripts chosen at random were second marked as a check to ensure that markers were adopting similar standards. Where any significant discrepancy was found, scripts were second marked and markers adjusted their marks (for all scripts) if they were out of line with other marker(s). In addition, all scripts with borderline marks (ie. 47, 48, 49, 67, 68, 69, also 53 and 54 as a sub-55 mark bars a Distinction), all failing marks (49 or below), and any problem scripts were second marked.

Compulsory electronic submission by candidates of their coursework assignments was introduced this year. This was much appreciated by candidates (almost all of whom are outside Oxford) and was accomplished without any difficulties.

## **C. Possible changes to examining methods, procedures and conventions**

1. Setting and checking the question paper for each coursework assignment (Part I) and examination paper (Part II) and the marking of candidates' scripts are the responsibility of a team of two (or more) members. The leader of the team has a considerable additional responsibility to ensure that procedures are carried out and deadlines met.
2. The examiners applied the marking and results conventions as agreed by the Teaching Audit Committee of the Board of the Social Sciences Division and notified to candidates. For the award of the Diploma a candidate must have no mark below 50 in any of the seven papers (five coursework assignments plus two examination papers). A mark below 50 may not be compensated by good performance elsewhere.
3. A Distinction was awarded to four candidates who did not qualify under the final outcome rules (in the same examination year 3 marks of 70 or above, including 70 or above in at least one of the two examination papers, and no mark below 55). All of these candidates had two marks of 70 or above (in one case three marks of 70 or above) supported by one or more very good marks (high 60's).
4. The introduction of a Merit award was raised by the Board of Examiners, in particular by the external examiner, in 2010-11 and has been repeated each year since. In 2014-15 the Education

Committee carried out a formal consultation process on a specific proposal for the introduction of a Merit outcome for graduate courses on an institution-wide basis. There was support for a Merit outcome in the majority of departments and very strong support from students. However, the Committee's Graduate Panel decided not to take further steps to introduce a Merit outcome in the immediate future; instead the Panel decided to concentrate on standardisation of the marking scales in use for graduate courses in the University, and in particular to engage with the Arts & Humanities Division which operates a pass mark of 60 (not 50) for some of its courses. At the same time the Graduate Panel stated that introduction of a Merit outcome remained on its list of priorities. Two academic years have passed since that decision, and no progress has been reported. Even if the Humanities Division comes into line and adopts 50 as the pass mark for all its courses, there is likely to be yet further delay while the Panel attempts to work out and standardise the rules for a Merit outcome.

The University's continued inability to come to grips with this issue is extremely disappointing and very difficult to defend. The Examiners doubt whether it will be possible to devise a standard set of rules which will easily fit the University's wide variety of graduate courses. The formal outcome of a course must be influenced by its educational purpose (academic research, vocational, practical) and the quality and career path of the students for which it is designed. This is a Diploma in Intellectual Property Law and Practice; both an academic and professional development programme for newly qualified or trainee barristers and solicitors. As such it resembles the University's second BM, part of the career path for medical practitioners, for which there is already a Pass with Merit. It also resembles the Diploma in Legal Practice, the vocational course for trainee solicitors (now transferred to Oxford Brookes University) which had a Commendation (equivalent to Merit). This Diploma functions very much as a professional qualification so to permit a Pass with Merit in this case is not likely to create a further precedent for other PGT courses in the University.

#### **D. Examination Convention**

The Examination Convention (known as the Examiners' Edict) and an additional Notice to Candidates are attached (see Appendix 2).

### **PART TWO**

#### **A. General Comments**

##### **1. Second and third marking**

The procedures for second marking were identified in Part One, B., above. First and second markers were required to discuss their marks and, wherever possible, agree the mark. This worked well with all second marked scripts receiving an agreed mark. Three scripts were third marked.

##### **2. Medical certificates, dyslexia/dyspraxia and special cases**

For the two written examination papers special arrangements were required for two candidates. In the Examination Schools three candidates were granted extra time for those

two papers, two of whom were also granted the use of a computer. Information in respect of two other candidates was forwarded to the Examiners under Part 13.2 and 13.3. of the *Examination Regulations*.

**3. Materials in the examination**

Candidates are permitted, under strict conditions, to take into the examination room their own copy of the current edition (12<sup>th</sup> in 2017) of Butterworths Intellectual Property Law Handbook. Their copy has to be absolutely clean and unmarked, and all copies are inspected before the start of the examination. All candidates supplied themselves with the Handbook, and no problems were encountered. In addition, candidates were provided in the examination room with a set of loose documents (see Appendix 2 – Notice to Candidates). All candidates remembered to bring with them their University card (which has to be displayed on their desk to enable their identity to be checked).

**4. Legibility**

No candidate was required to have either of their examination paper scripts typed.

**5. External Examiner**

We have been very fortunate to have the help and advice of Dr. Sivaramjani Thambisetty as External Examiner for four years. She has been very fully involved at all stages of the examination process, and last year undertook additional marking at short notice when an assessor was taken ill. She has been always a most helpful and reliable colleague and we are very grateful to her.

**6. IPLA Examiner**

We are also very grateful to Mr. Robert Anderson of Hogan Lovells who, as coursework co-ordinator, organised and supervised the teams of practitioners involved in the teaching and examining of the coursework assignments. It is not an easy task to bring together for the Diploma colleagues who also have demanding professional lives, and we very much appreciate his commitment and care. He was also fully involved in every part of the examination process.

**7. Additional Examiner and Assessors**

2016-17 has been a difficult year for the Diploma. Due to ill health and a tragic death we had to seek help at very short notice from additional academic and practitioner colleagues. Their help was essential to ensure that the Board had full information on the performance of candidates. Dr. Dev Gangjee also joined the Board in July as a replacement examiner. We could not have completed the examination of the Diploma this year without their vital and very generous help, and they deserve our special gratitude.

In all, in addition to the examiners, 31 colleagues were assessors, and we owe our thanks to them all.

**8. Diploma Administrator**

Throughout the year Mrs. Ellen Moilanen has been in charge of all aspects of the Diploma and is the first port of call for everyone involved, examiners, assessors and

candidates. We confidently rely on her to ensure that the Diploma runs efficiently and smoothly. We know how fortunate we are to be in her hands, and we are very grateful.

### B. Equal Opportunities issues and breakdown of results by gender

Category	2017				2016				2015				2014			
	Male		Female		Male		Female		Male		Female		Male		Female	
	No.	%	No.	%	No.	%	No.	%	No.	%	No.	%	No.	%	No.	%
Distinction	4	12.12	4	12.12	3	12.5	7	18.42	4	16.67	3	9.38	4	13.33	4	12.90
Pass	29	87.89	28	84.85	18	75	30	78.95	18	75	23	71.88	24	80	25	80.65
Fail	0	0	1	3.03	3	12.5	1	2.63	2	8.33	6	18.75	2	6.67	2	6.45
Total	33		33		24		38		24		32		30		31	

The examiners were not asked to produce an ethnicity analysis of the results.

### C. Percentage distribution of marks by paper

	70 plus		60-69		50-59		Under 50		Total
	No.	%	No.	%	No.	%	No.	%	
<b>Part I</b>									
Patents 1	11	17%	41	63%	13	20%	0	0	65
Patents 2	6	9%	46	71%	13	20%	0	0	65
Trade Marks and Passing Off	6	9%	36	55%	23	35%	0	0	65
Copyright	18	27%	36	55%	11	17%	1	2	66*
	70 plus		60-69		50-59		Under 50		Total
Design	15	23%	40	63%	9	14%	0	0	
<b>Part II</b>									
Intellectual Property I	6	9%	52	80%	7	11%	0	0	65**
Intellectual Property II	12	18%	45	69%	7	11%	1	2	65**

- \* includes 1 candidate who re-took the paper
- \*\* includes 3 candidates who took the paper having suspended in 2015-16

NB The figures above include 2 candidate who took four papers in Part I but then withdrew from Designs and from both papers in Part II, and 1 candidate who took all papers in Part I and then withdrew from both papers in Part II.

#### **D. Comments on individual papers**

These appear in Appendix 3.

Mr. R. Anderson (IPLA)  
Professor G. Dinwoodie  
Dr. D. Gangjee  
Ms A.S. Kennedy (Chair)  
Dr. S. Thambisetty (External)

Appendix 1 – External Examiner’s Report – to follow  
Appendix 2 – Examination Convention and Notice to Candidates  
Appendix 3 – Reports on individual papers

## Appendix 1 – External Examiner’s Report

### FACULTY OF LAW

#### POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW AND PRACTICE 2016-2017

#### EXTERNAL EXAMINER’S REPORT 2017

This is my final and fourth year as External Examiner on the Postgraduate Diploma in Intellectual Property Law and Practice. I am happy to report that assessment processes appear to have been conducted fairly and in accordance with institutional regulations and the academic standards of the Diploma are appropriate. I attended the final Examiner’s meeting on the 12<sup>th</sup> of July 2017 where all the classifications were closely scrutinized before being finalized. We also identified the top performers in all the coursework and Examinations so that a special mention could be made informally to mark exceptional performances. Through the year I regularly contributed to reviewing coursework and Examinations, as well as marking schemes. It was a further pleasure to work closely with Prof Dinwoodie as Director of the course this year.

#### **Coursework and Examinations**

The Diploma does a very good job of examining students on the key principles, controversies, and debates relevant to intellectual property rights. In the assignments candidates are expected to apply their knowledge and legal reasoning skills to realistic and challenging factual scenarios. In the Examinations candidates engage with a small number of the wider policy debates occurring in the intellectual property field, in part because they are expected to answer one essay question as well as one problem question during the exams. This year some questions were raised as to clarity of instructions provided to the candidates in Intellectual Property 2. Several scripts were reviewed again during the final Examiner’s meeting to ensure that marks given were appropriate.

#### **Assessment**

This year we had the occasion to review the range of marks given by individual markers in an attempt to ensure that all markers were applying marking schemes in standardized ways across the course. The pool of markers is itself quite large, necessitated by the professional workloads of those who teach on the Diploma. A significant problem associated with a large number of markers is that many markers only review a small number of scripts, while others review a large number. We discussed the possibility of curtailing numbers and/or ensuring that each marker commits to an even proportion of scripts so that it is easier to monitor the quality of marking procedures. We also discussed maintaining a roster of professionals who could step in to take over from individual markers who cannot meet their commitments, but this is contrary to the ambition of this course to use only the most senior professionals as teachers and markers. The data provided on markers was useful and is a commendable step towards ensuring even more rigorous standards on this course.

#### **Administration of the Course**

The Diploma has several moving parts and tight timelines which depend on an extraordinary degree of coordination and management. There are multiple relationships between different categories of staff and practitioners that coalesce at multiple points through the year. Ellen Moilanen does an excellent job in providing consistency and institutional memory year on year. I am particularly pleased to note that pastoral care arrangements are being taken up and medical or other exceptional circumstances are continually monitored.

#### **Merit Classification**

I understand that there has been some further progress within the Arts and Humanities Division and the work of the Education Committee which suggests that a resolution may be possible in the near future. I commend the Examiners and course management for persisting with this long drawn issue. It is in the clear interests of

students to allow a Merit classification. While I am disappointed that we could not provide this during my tenure as External Examiner there are indications that success may be just round the corner. Until then a small percentage of students are notified informally that they are in a small category of top scorers. In addition, the practice of informing students when they have achieved the top mark in a particular paper is also to be welcomed. These mechanisms reward outstanding students and incentivize everyone else to do better.

I have thoroughly enjoyed the last four years as External Examiner. The IP Diploma is one of a kind, characterized by rigorous standards, analytical depth and professional excellence. It has been a particular pleasure to work with a small group of very committed teachers, Examiners and markers. I have no doubt that the Diploma will go continue to go from strength to strength.

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1<sup>st</sup> September 2017.



## Appendix 2 – Examination Convention and additional Notice to Candidates

## Appendix 3 – Reports on individual papers

### Trade Marks

#### General Note for Students

The objective of this question was to present you with a fairly real life scenario and for you to weigh up the various options for the claimant in this situation. The facts of the case were not ideal for the claimant, so you may have needed to give him some unpalatable advice. In looking at the facts and applying the law to them, you should have been led to consider the relative merits of the action for passing off compared to the action for trade mark infringement, and also some of the pitfalls arising from the way the claimant has used its marks.

The question brought in the aspect of unjustified threats, something which in practice will always need to be considered when writing a letter before action, and what the response might be when a potential defendant raises this issue. It also touched on potential non-use, as well as a possible challenge to the defendant's application based on relative grounds and bad faith.

There was therefore quite a lot to get your teeth into. A pass mark required some appreciation of the complexity of the scenario, and an identification of the various issues it presented. There was plenty of scope for better candidates to shine in advising the client on its strategy, and whether in fact it would have to live with some elements of this new situation.

Because it was trying to look like a real scenario as far as possible, there was no single "right answer" to the question, so the best marks were available for candidates who recognised the difficulties, discussed the options, and advised the client on its best strategy.

#### Question 1

*On the facts as stated, advise Ralph on the prospects of a passing off action by Nickleby's Stores Limited against Hawk Enterprises relating to the use of the name NICKLEBY'S in relation to the Oxford venue. Indicate any further information you would need in order to complete your advice. (20 marks)*

You were expected to set out the law on passing off and the basic ingredients of misrepresentation, goodwill and damage or likelihood of damage, and marks were awarded for that, but the real point of the question was to apply the law to the facts.

The closest case on the facts would probably be *Harrods v. Harrodian School* and you would have got a mark for mentioning that case. However, it can be distinguished on the facts because some aspects of the defendant's business are much more closely related to the business of the claimant than in the *Harrods* case, in particular the sale of some clothing and food and drink, and the operation of a restaurant.

Clearly the claimant has goodwill arising out of the operation of the London store which would apply to a wide range of goods, including probably all the goods being sold by the defendant, as well as in the operation of a retail store and a restaurant. Better candidates thought about whether this goodwill attached to the NICKLEBY'S name where the goods are concerned, given that these would seem to be sold under well known brand names or under the SAINT NICHOLAS brand, and not under NICKLEBY'S (the inspiration for this was the way Marks & Spencer used to operate with the ST MICHAEL brand). The defendant is however operating a "store within a store" which incorporates the NICKLEBY'S name ("THE STORE AT NICKLEBY'S"), and the restaurant is operating within the club which also incorporates the name. The defendant is also selling online.

All in all, most candidates should have come to the conclusion that this would probably be a difficult case to bring in passing off. Marks were available for recognising that additional information will always be required in a case like this. In any event you would be expected to say that evidence of actual confusion would be required and the prospects would be slim without it. Evidence might be obtained from customers of the Oxford venue, tourists who had visited both London and Oxford, and students who might have experience of both localities. Also any online shoppers who would admit to having been confused or even to have bought the wrong T-shirts by mistake.

## **Question 2**

*Likewise, advise on the prospects of an action for trade mark infringement against Hawk. (20 marks)*

The main point of this part of the question was to see whether whether you could identify aspects of the problem where the claimant's trade mark registrations put it in a better position than if it could rely only on its goodwill. The claimant had registrations covering various of the goods sold by the defendants, in particular posters, T-shirts and bottled water. The "other memorabilia" could include various things which may or may not be covered by the specifications indicated. You might have commented on that, but were not be expected to dwell on those points.

The fact that the goods are sold under other brand names or under the SAINT NICHOLAS brand, and that the restaurant operates under a different name, would be relevant to validity and possible liability for revocation, which are to be discussed later. Here you were expected to recognise that the registrations do cover the relevant goods and the the question therefore revolves around the similarity of the trade marks. Marks were therefore be given for setting out the ECJ/CJEU case law and applying the "global appreciation" and "average consumer" tests to the similarities and therefore the likelihood of confusion between the registered trade mark NICKLEBY'S and "THE ZONE AT NICKLEBY'S" in relation to the T shirts and the restaurant services, and "THE STORE AT NICKLEBY'S" in relation to the other goods, and the retail services, including the provision of the shopping bags, and the online sales.

You should also have discussed the possibility of an action under section 10(3) assuming that NICKLEBY'S to be a mark with a reputation. The use of the mark in connection with a night club might be asserted to be generally detrimental to the repute of the trade mark but especially having regard to the bad press about the drugs. Unfair advantage was perhaps less strong. Better candidates recognised that "without due cause" might be an issue relied on by the defendant if they assert that the use of the NICKLEBY'S name is justified by reference to the building or the locality in Oxford where the venue is based.

No hard and fast conclusion was appropriate here, but you might have felt that the case was better in relation to "THE STORE AT NICKLEBY'S", perhaps in relation to the online sales of T shirts in particular, and have thought about whether the use and registration of THE ZONE by the defendant would be relevant to the likelihood of confusion arising from the use of "THE ZONE AT NICKLEBY'S". The historical and geographical significance of NICKLEBY'S in Oxford was also a relevant consideration.

## **Question 3**

*Explain to Ralph the significance of the reference in the letter to groundless threats. (10 marks)*

This question gave relatively easy marks for candidates who had looked at section 21. Marks were awarded for recognising that the section is primarily intended to discourage threats being made to secondary infringers

such as distributors, and does not include threats of proceedings for infringement of a registered trade mark alleged to consist of the application of the mark to goods or their packaging, importation of goods, and the supply of services under the mark. (It was reasonable to assume from the wording of the question that the letter before action went beyond a “mere notification” of the existence of the registrations, but that could be noted as another possible exception).

You did not have the benefit of knowing what the letter before action said, but assuming it was directed to Hawk Enterprises referring to its alleged use of the registered mark on or in relation to the T shirts and other goods and to the provision of retail services and restaurant services, then Nickleby’s could rely on the exclusions from the operation of the section. However Hawk could seek to commence proceedings forcing Nickleby’s to justify their allegations of trade mark infringement (bearing in mind the differences which the defendant might assert between the registered mark and the marks as used) which could put the claimant at a tactical disadvantage. Some candidates noted that, under the current state of the law, there is the possibility that the legal adviser could be joined in any action for groundless threats.

#### **Question 4**

*Advise Ralph on the significance of Hawk's trade mark application in context and on the merits of filing an opposition against this application when published and on what grounds. (15 marks)*

You should have realised that the filing of the trade mark application by the defendant had no significance in the context of the claimant’s potential actions for passing off or trade mark infringement and could not improve the defendant’s position. The application is only recently filed and is so far assumed to be unexamined and unpublished.

The obvious ground of opposition is to the application for restaurant services where the claimant has the identical mark registered for the identical services, so an opposition under section 5(1) ought to be successful subject to the need for the claimant to prove use of its mark. This raised the issue (which needed to be discussed in Question 6 also) of whether the claimant actually uses NICKLEBY’S as a mark for restaurant services, given that it operates the restaurant within the store under the name of WACKFORD’S. Candidates should realise that given that their registrations are more than five years old, Nickleby’s would be required to state in their Notice of Opposition the goods or services on which the mark has been used in the five years before the publication of the defendant’s mark. The defendant will be likely to put the opponent to proof of use of the mark, which would require some evidence of use of NICKLEBY’S in connection with the restaurant. You were expected to recognise this as an issue but not to reach a firm conclusion given the lack of detail in the question.

In relation to the entertainment and night club services, an opposition could be based on section 5(3) in reliance on NICKLEBY’S as a mark with a reputation for retail services and the use of the mark being “without due cause” and liable to be detrimental etc. especially with reference to any bad reputation which the club may have attracted or might attract in future. There was also the possibility of asserting unfair advantage although this would probably be less strong on the facts. Again, the question of “without due cause” may be an issue relied on by the defendant in its defence, but this would seem less strong in the context of the opposition where the defendant is seeking to register NICKLEBY’S and not the marks it actually uses. You might have noted that the fact that the defendant has filed such an application would be inconsistent with any argument by them that the name NICKLEBY’S is being used only with reference to a building or to a geographical area. They are in effect attempting to claim that NICKLEBY’S is itself distinctive for the relevant services not just in context of the trade marks they are actually using. Although "HAVE A BREAK ..." might suggest that they could claim distinctiveness in part of a slogan, they are not really in a position at this stage to argue on the basis of acquired distinctiveness, having started use only three weeks ago.

Hawk's application would appear to have been made as a reaction to the letter before action. That should have led you to consider whether the application might have been made in bad faith. A pointer to that would also be the fact that the mark applied for is NICKLEBY'S, which is not a mark which the defendant uses as such, and they are fully aware of the claimant's registered trade marks and its business having received the letter before action. There was room for discussion of the law relating to bad faith and whether the facts would reach the required threshold. The advice should probably have been that bad faith would be a ground worth including having regard to the particular circumstances.

### **Question 5**

*Advise Ralph on the significance of the references to invalidity and revocation in Hawk's letter. (15 marks)*

Are there any grounds of invalidity? Not that we could be aware of on these facts. Nickleby is a surname so you might have mentioned the NICHOLS case but should not have spent much time on invalidity.

Revocation for non-use is more interesting on these facts. NICKELBY'S is used as the name of a department store, and we can assume that it is used in the usual ways - name on the shop, on receipts, tickets and shopping bags etc, and also probably online (the problem does not specifically say so, but the claimant does have a relevant registration in Class 35). It is not applied to goods as such (with the exception of the T shirts) because SAINT NICHOLAS or other brand names are used. Taking the classes in turn: Class 16 - there is evidence that the mark appears on various printed matter but will that suffice as evidence of use on goods in that class? Class 25 - the mark is used on T shirts but is that trade mark use or just promotion of the brand? The fact that the problem says that the mark is used "discreetly" may be helpful in that regard. In relation to other clothing and food and drink in Classes 29-33 the mark is not used per se but these items will be sold in the store and probably placed in bags with the store's name on them. Is that sufficient for trade mark use? Class 35 - the mark is clearly used for retail services and may also be used online (you might have recognised the need to confirm that but it was probably also safe to assume it). Class 43 - there are the same issues as above with the name of the restaurant and whether there will be sufficient evidence of use if NICKLEBY'S in respect of restaurant services. You should have been able to recognise the issues but were not expected to reach firm conclusions.

### **Question 6**

*Advise Ralph generally on the strategy you would recommend to be taken at this point, including any action which Nickleby's can or should take in response to Hawk's solicitors' letter and/or its trade mark application, and on the relative merits of pursuing actions for passing off and trade mark applications based on these facts. (20 marks)*

The recommended action in response to the reference to threats might have included discussion of the possibility of commencing action for infringement immediately if the case was felt to be strong enough, to avoid pre-emptive action by the defendant, although that might have been an over-reaction at this stage. Otherwise perhaps the reference to section 21 should have been seen as posturing by a defendant who is adopting an aggressive approach and which should not over-influence the claimant's strategy.

Best marks were available for strategies which took account of the weaknesses of the claimant's position but sought to make the best of it. This might have included:

1. Recommending negotiations with Hawk to de-emphasise or phase out the use of "NICKLEBY'S in the name of the Oxford club. Hawk's main interest would seem to be in the "ZONE" name, and once the venue

becomes established in Oxford it would probably lose little by dropping the reference to Nickleby's. This may allow a face saving compromise to be put forward for a phase out over the next 6-12 months.

2. Hawk to cease selling T shirts with THE ZONE AT NICKLEBY'S subject perhaps allowing run off of existing stocks.
3. Hawk to cease use of THE STORE AT NICKELBY'S in the Oxford club (use of THE STORE online would not be objectionable once the references to NICKLEBY'S had been removed as above).
4. Withdrawal of the trade mark applications (these should never have been filed so no compromise on that was really appropriate).

If the above meets with no constructive response then the opposition should be pursued in due course and serious consideration should be given to commencing an action for trade mark infringement at least in relation to the operation of a retail store under the name THE STORE AT NICKLEBY'S and the sale of T shirts bearing the slogan THE ZONE AT NICKLEBY'S both at the Oxford venue and online. If the evidence of use of NICKLEBY'S in relation to other goods and the operation of the restaurant is favourable, then actions in that regard can be considered also. Commencement of action may be conducive to bringing Hawk to the negotiating table but should only be recommended if the client has the will and resources to follow it through. Given that operations by Hawk commenced only three weeks ago you might have discussed the possibility of a preliminary injunction.

Overall, the conclusion probably ought to have been that the claimant has potentially a better case in trade mark infringement than in passing off, subject to the questions of validity and potential revocation. As regards the trade mark application, you should have recommended that the register be watched for the publication of the application so that an opposition could be filed in due course. There would be no point in filing any observations with the IPO or taking any other action at this stage, although a letter can of course be written inviting Hawk to withdraw the application.

As regards action in response to the reference to non-use, you should have noted that it would not be possible to rely on any use commenced now or within 3 months of the letter from the defendant's solicitors so changing the branding of the restaurant or the goods at this point would not assist. The advice should have recognised that Nickleby's registrations were potentially vulnerable in relation to the goods and the restaurant services but that the outcome will depend on the actual facts and the evidence of use which Nickleby's can show. The registration for the retail services would not seem to be vulnerable.

As a longer term strategy, consideration should have been given to increasing the prominence of the NICKLEBY'S name in relation to the sale of goods and the restaurant operation. This will not assist the client with his immediate issues, but some longer term recommendations for the client would have been appropriate.

## Patents 1

The standard of the scripts was generally good although a few students seemed to lack a complete understanding of some aspects of the law. Some recurrent issues were:

1. Assuming that the person named on the patent was the proprietor and not suggesting that the Register should be checked
2. Failure to identify all possible infringers.
3. A significant number of students failed to spot that there may be a right to continue prior use under s.64 or failed to discuss this defence in sufficient detail.
4. The experimental use defence was dismissed because the use was for commercial purposes. (The test is not whether the use is commercial but whether the use was predominantly experimental in the sense of seeking to find out new information.)
5. Failure to analyse claims, claim by claim and integer by integer in relation to infringement/validity. Students had been encouraged (although not required) to use claim charts. Some did not. This meant that a number missed points on infringement and/or invalidity.
6. Failure to spend enough time in determining the meaning of words in the specification. (The words in a patent mean what the patent says they mean, not necessarily what they many mean in general usage. What is a “bead”?)
7. Failing to consider lack of novelty and obviousness separately. This sometimes led to the wrong result.
8. Each item of prior art was not dealt with separately for the purposes of assessing novelty.
9. Applying hindsight in determining what the skilled man would have done to resolve the problem in question rather than considering what he actually would have done before the priority date.
10. Not appreciating that amending claims by adding features not disclosed in the patent specification is impermissible (“added matter”). Similarly it was not always appreciated that deleting features from the specification can also add matter.
11. Failure to realise that amending the specification but not the claims will usually be ineffective as a cure for invalidity.

## Patents 2

### Summary

This year's question addressed construction, infringement and validity issues in the context of second medical use patents. This is currently a hot topic in the English Patents Courts, especially in light of the litigation concerning Lyrica® (pregabalin). On the whole, the questions were well answered by candidates. Most students demonstrated a thorough knowledge of the relevant principles. The best candidates had thought deeply about issues such as the appropriate relief to be granted where the same medicine can legally be sold for one medical indication but should not be sold for another.

### Question 1 – Infringement

Candidates were asked to prepare Particulars of Claim and Particulars of Infringement in the High Court (Patents Court). All candidates identified Quadrangle plc as the only claimant. The vast majority of candidates named the UK company Zebedee Pharma Limited as a Defendant for committing acts of direct infringement of the relevant patent and the German company Schneider GmbH for indirect infringement of the patent. There was probably insufficient evidence to join any of the officers of either company to the proceedings individually. In relation to Zebedee, the candidates almost universally identified that the patent contained a claim in the so-called Swiss form which, according to the English Courts' interpretation, is a purpose-limited process claim and also a claim in EPC 2000 format which is a purpose-limited product claim. Virtually all candidates recognised this distinction and framed their allegations of infringement accordingly. The best candidates picked up that the chronology of the scenario had been prepared at a time when the UK IPO was still granting claims in both formats.

Ultimately, the key question, in accordance with the law as summarised by Floyd LJ. in Warner Lambert v Actavis ([13 October 2016] EWCA Civ 1006) is whether Zebedee had taken all reasonable steps within its power to ensure that its carved-out cameronicide medicine was not used to treat the patented indication, head-lice. On the facts presented, Zebedee had clearly taken insufficient steps and most candidates recognised that this – pointing to the large volume of sales and the CEO, Dr. Martyn's specific knowledge that her company's product was being used to treat head-lice. It was hoped that candidates would suggest steps that Zebedee should take to negate the intention that its product was being used for infringing purposes. Some candidates did so, and a few even went so far as to draft letters which Zebedee might write to stakeholders in the healthcare system to point out that their product should only be used for athlete's foot. However, more candidates should have considered framing the prayer for relief to the facts of the case.

As regards Schneider GmbH, the key question was whether the company supplied the active pharmaceutical ingredient in the UK to be incorporated knowing, or it being obvious to the reasonable person, that it would be intentionally used for an infringing purpose in the UK (see Grimme v Scott [2011] FSR 7). Most candidates were aware of the double territorial requirement of Section 60(2) and addressed this in their answers. The fact pattern had been devised to make it arguable that Schneider owned the cameronicide in the UK because it had not paid for the goods at the relevant time. Most candidates spotted this and some even considered that this was not enough to satisfy the legal requirements.



### Question 3 – Defence and Grounds of Invalidity

In the Defence, most candidates adhered fairly rigidly to the precedents supplied during the residential course which was sensible.

The potential challenges to the validity of the relevant patent were not particularly numerous but they were rather detailed. Perhaps most importantly, the fact pattern set up a challenge to entitlement to priority since the patent application used to establish priority was filed in the names of the two inventors, Dr. Dalton and Dr. Colaco, whereas the patent application leading to the patent was filed by Quadrangle plc. The law around formalistic entitlement to priority has been under the spotlight of the English Court since Edwards v Cook ([2009] EWHC 1443). The employment/consultancy status of the inventors was tailored to enable candidates to argue that the relevant formalities had not been completed. Most candidates picked this up and argued the points well. The facts also teed up a potential challenge to substantive priority due to the addition of further data in the application leading to the patent which was not in the priority document. Candidates picked this up as well.

However, many candidates seemed not to appreciate the significance of the loss of entitlement to priority. A loss of priority would mean that the date at which the validity would be assessed was 10 April 2010 (as opposed to 13 April 2009 if priority was maintained). Importantly, a loss of entitlement to priority would potentially bring into play the clinical studies conducted at the University of Central Chorley in autumn 2009. An elegant way in which to set out the Grounds of Invalidity would have been to set out details for the validity challenge if priority was not maintained, and separate details for the situation where priority was maintained. Hardly any candidates did this.

Most candidates recognised that the accidental circumstances by which cameronicide came to be discovered to be useful to treat head-lice could arguably be used to challenge the validity to the patent although confidentiality and plausibility would likely be contested. Many candidates did not seem to be up to speed on the relevant law on clinical trials and the fact that the existence of clinical trials does not usually anticipate the outcome of those trials (Hospira v Genentech [2015] EWHC 1796).

### Question 3 – Explanations

Most candidates addressed the points noted above succinctly. Again, the most disappointing aspect of the majority of the answers was the failure to distinguish clearly between the situation if entitlement to priority was maintained and the situation if it was not.

## Copyright

### 1. Overview

The overall performance of candidates was good, with a number of distinction marks. There was only one fail.

As in previous years, many candidates managed to consider all the relevant material in the assignment with well-structured answers which dealt with the matters raised in a coherent and logical manner. The best candidates were able not only to discuss the less clear issues, but also to reach a view as to how they might be resolved. They gained marks by applying the law to the facts before them, making good use of those facts to support their conclusions. Overall, the performances showed a good understanding of copyright law, although the more difficult areas, such as rights in films and CGI-created effects proved challenging for some. References to other possible causes of action such as malicious falsehood seemed to have been made without much consideration as to the strengths of the arguments.

### 2. Comments on Question 1 (50 marks)

This was generally well-answered. Dwayne's rights were dealt with comprehensively. Most candidates raised the UK/EU originality tests and applied both, with the best discussing what, if any, difference there might be between them, with reference to the cases. Subsistence was well-handled, as was the likelihood that Jane had followed the book so closely that she had taken a substantial part of it.

Most recognised that RFR's rights in Dwayne's book were unclear and would need to be established, giving Jane a possible escape from a case by them against her. Most also realised that whilst Dwayne might have moral rights and might use them to object to her "unflattering treatment", RFR could not, unless Dwayne had left his moral rights to them on death, for which there was no evidence on the facts. Few picked up that it was not clear that RFR was a legal entity with capacity to sue, despite the deliberate vagueness in the question as to what it might be.

The possible grounds for a claim against Jane were generally well-explained, as were the remedies available. The better answers recognised that an interim injunction was unlikely in the circumstances, that a permanent injunction did not seem to be what RFR was seeking, and that therefore a settlement on monetary terms might be acceptable to RFR, if they had the capacity and right to sue.

A number of candidates suggested that Jane might/should seek a settlement with Dwayne if RFR did not have the rights it asserted, but not all considered what might be done if RFR did not have standing and Dwayne still could not be contacted.

The best candidates recommended that RFR be put to proof of their title before any settlement discussions with them were started. They also recommended that if RFR had no standing and Dwayne could not be traced, Jane might try to acquire an orphan works licence, recognising that she had not yet done enough to entitle her to one, and that it would have limitations.

A number of candidates suggested that Jane should start an action/bring a counterclaim against RFR for malicious falsehood, abuse of process and/or unlawful interference with trade, without further analysis. None of these was likely to succeed on the facts, and the listing of these as possible ways forward was unconvincing.

In relation to the TV series, the best candidates made it clear that the TV Series was at risk of indirectly infringing *Out of the Frying Pan*, which Jane would need to take into account if agreeing terms with RFR/Dwayne.

Most candidates gave good consideration to the other copyright works which might be contained within *Over the Seven Seas* and which might be reproduced in the TV Series, and pointed out that therefore Jane would need to have ownership or exclusive rights in those works to license them to the TV Company. Rights in the musical score were generally well considered, with candidates picking up the differences between musical works, sound recordings, and the treatment of sound tracks.

Whilst candidates dealt well with Jane's negotiating position in relation to her consultancy and contribution to the script-writing of the TV Series, the best also focussed on Jane's copyright rights in *Over the Seven Seas* itself, and how she might protect them in her dealings with the TV Company. The very best recommended that she should license those rights to the TV Company for a fee/royalty payment, but on restricted terms which would enable her e.g. to recover those rights and/or license them to others, should the TV Company fail to perform, or other opportunities arise.

### **3. Comments on Question 2 (25 marks)**

Candidates recognised that the key focus of this question related to the improv performers' rights and the rights in the CGI-created effects.

The improv performers' copyright and performers' rights were very well considered. Nearly all candidates recognised that dramatic work copyright would arise when Jane filmed the performances, and that the performers, and possibly recording entities, would have rights. Jane's need to acquire relevant reproduction rights was discussed well, with only a few suggesting (unpersuasively) that Jane could ignore them. A few candidates confused rights in the performances with rights in Jane's recordings of them.

The best candidates recommended that if Jane could not get consent from the performers, she should omit the relevant clips from *It's a Shook Up World*, as she would be unlikely to be able to limit her reproduction of any particular performance to an insubstantial part of it, even if the clip was very short.

The candidates' answers in relation to the CGI-created effects was mixed. The question was targeted at areas of copyright which might not fit comfortably with modern technology.

The question deliberately lacked detail as to what the effects were, and this was an opportunity to consider what copyright works might be involved, given the limited works listed in the CDPA. There were some thoughtful answers as to what the works might be e.g. graphic works. There were quite a few references to how the effects might be computer-generated works, which they might well be, but that is relevant to authorship of the work, not to its nature (literary, artistic, etc.)

Suggestions that the effects might themselves be computer software/literary works, rather than just generated by the use of computer software, were interesting but perhaps unlikely.

Few if any candidates suggested that the effects might not be copyright-protected at all. Candidates generally found this part of the question difficult or treated it only superficially, but there were some good answers. Nearly all said that whatever the position, Jane should ensure that she, not the person producing the effects, had the rights in them – a practical answer.

#### 4. **Comments on question 3 (25 marks)**

Most candidates recognised that this question expected them to discuss both *Norowzian v Arks* and the idea/expression dichotomy to the degree they had not already done so in question 2. As the question focussed on infringement rather than on subsistence (it being assumed that Jane had the rights she needed), the answers worked best when the candidates discussed what rights Jane might rely on, and how strong her case might be in relation to each. Candidates gained marks if they considered both the strengths and the weaknesses of Jane's position, rather than (over-)stressing the weaknesses.

Candidates understood the idea/expression dichotomy well, and the answers in that respect were good. However, the lack of copyright protection for editing styles and techniques could have been better related to the lack of copyright protection for ideas.

Candidates generally understood that *It's a Shook Up World* would probably be protected by copyright both as a film, and as a dramatic work. There could have been more discussion as to the wider scope of the latter, and the ability it gives to rely on more than literal reproduction of the work, although many candidates covered this well.

Few candidates pointed out that whatever the status of the film, the question assumed that Jane also had relevant rights in the underlying improv performances. As many candidates recognised, even Jane's short clips were likely to be a substantial part of each performance. They could have stated that therefore copying those clips via another performance/film might also infringe copyright in that performance, which Jane could stop. Some candidates however assumed that *It's a Shook Up World* would not be a recording of a performable dramatic work, basing that on statements in *Norowzian*, but the facts there were distinguishable.

### **Designs**

The aim of the question was to get student to think systematically about the different rights which might arise, the scope and validity of each right, and their subsistence and ownership, and whether or not they were infringed, and if they were, the remedies that might be available. Students were also specifically asked to consider what further information might be needed, and to advise on strategy and tactics, in the light of the information already available.

Students were told not to consider copyright, and there was no UK registered design to discuss.

#### **Overview**

There were a considerable number of designs to compare and contrast. Some students included pictures of the items they were considering at each stage, which greatly assisted clarity and the marking.

Structure was an issue which the students needed to have considered carefully before writing their answers.

Given that the answer was in the form of a note to a partner, and was intended to enable the partner to understand the issues and discuss the matter with a client (*NoveltyGifts*), it was very helpful to have, somewhere, an overview of the merits of each claim on the facts as known, the additional information to be sought, and the tactics to be adopted. The better students put these together in one place, at either

the beginning or the end, which worked better than dotting the thoughts on further information and strategy throughout the paper.

The question required the students to consider a Community Registered Design (CRD), Community Unregistered Community Design Rights (CUDR) and UK unregistered design right (UKUDR). They had a number of articles to which they had to apply these rights and students needed to avoid unnecessary repetition. Those that did so best dealt with each right in its entirety in turn, setting out the legal issues relating to each and then applying them to the facts. A few students tackled one bit of all three rights, e.g. validity, and applied that to the facts, before moving on to do the same with another bit, e.g. infringement. This made reading the paper very difficult to read and follow, and we would caution against such an approach.

The students needed to read the paper carefully to note which facts were known and which were not. These included dates, the identity of those commissioned to do the designs and whether, and if so how, one or other of the companies making allegations against the client (GardenBitz) had acquired title to the designs and the rights in them. The better answers did this well. The better answers also paid close attention to the fact pattern to strengthen their legal arguments.

Some students spent a long time going into the minutiae of the differences between the right claimed and the alleged infringement (eg: counting the decorative dots on the products). An approach which worked better was to indicate that there were a number of similarities and differences, highlight the most significant, and form a view. This left more wordcount for wider discussion of the legal issues.

### **Registered community design**

The validity or otherwise of the CRD might depend on its scope, as the scope might affect both novelty and individual character. Students did not always address scope first, although the test set out in *Trunki* as to whether or not an unornamented design was wide enough to cover surface decoration was generally well understood. The better answers spotted that the date of publication of the GardenBitz design was not known, and needed to be checked. They also discussed and formed a view as to whether or not disclosure near a Tour de France route might make the design available to the public, or was too obscure.

Many, but by no means all, students noted that whilst Garden Bitz S.A was named as the proprietor of the CRD, the design had been commissioned and there was no evidence as to chain of title to it from the commissioned party and that this needed to be dealt with.

Infringement of the CRD was generally considered well, with most students quickly eliminating the NG BirdBoot from the discussion, and forming a view in relation to the NG Wellies.

### **Unregistered Community Design Right**

One key issue here was when any UCDR right subsisted at all. That was not clear from the documents. Similarly, it was not clear from the facts who owned any UCDR subsisting. It was important to consider the facts to establish whether any right existed, and if so, who could enforce it. Some answers identified what further information was needed, but others either failed to consider the issues at all, or made broad statements without further discussion.

Most students handled the issues of infringement well. They recognised that GardenBitz could rely on either the whole or part of their design to assert infringement, in contrast with the CRD. The best answers made choices as to which parts they would expect GardenBitz to rely on, and the very best recognised that GardenBitz would need to be cautious in its choices to avoid relying on a part which could be held to be invalid. Some students recognised that parts could be relied on, but then only referred to the whole in their discussion of invalidity. A few failed to discuss infringement of a part at all, thus missing a key difference between the rights arising from CRDs and UCDRs.

## **UKUDR**

Many students, but not all, included a good discussion as to whether or not UKUDR subsisted, given that it was unclear who had created the designs, when the designer had been commissioned (before or after the changes brought in by the Intellectual Property Act 2014), or where the products were first marketed. One student included a flow diagram, which was helpful.

Most students recognised that like the UCDR, UKUDR is flexible and enables a claimant to decide what rights to claim with the alleged infringement(s) in front of them. The better students indicated and discussed which rights might be claimed, to best catch the alleged infringements. Some students however, either gave little consideration to which parts might be relied on, or considered only the product as a whole, thus missing the benefit of the flexibility of the right. Nearly all students recognised the need to show copying; only some discussed it.

## **Notice**

A number of students assumed that the QuickReg letter put notice of a claim to UCDR and UKUDR, without considering whether or not that was indeed the case.

## **Remedies**

These were generally well-handled.

## **Tactics**

It was a little surprising how many students advised starting proceedings when there were major gaps in the information available. A disappointing number of students were ready to concede points without even considering asking GardenBitz to be more specific about what rights they relied on and whether they owned them. A few students spotted the possibility of an 'Alicante torpedo' but didn't really consider all the implications of doing that. Similarly, whilst most students spotted the threats points, a surprising number advised bringing a threats action without considering the likelihood of a counterclaim for infringement, and how successful any such counterclaim might be. Few students' analyses of the tactics considered the commercial issues in addition to the legal ones. Only a few students considered what the client might do to placate GardenCentres4U

Overall, the question was well-tackled and students showed a good understanding of the issues. The best answers also put the legal issues into the commercial context.

## Intellectual Property I

### General Comments:

Intellectual Property 1 was taken by 64 Candidates. The answers provided were of a high standard over all. There was a slight decrease in the number of candidates achieving a mark of 70% or above, from 12.5% in 2015/16 to 9% in 2016/17. However, this was offset by a large increase in the number of candidates achieving a pass mark of 60% or above, from 77% in 2015/16 to 91% in 2016/17. The average mark achieved in Part A = 64% and in Part B = 63%.

On a general note, it was pleasing to see candidates mostly avoid practices previously highlighted as negatively impacting on the marks awarded. Most candidates stated the correct statutory provisions and made appropriate use of the case law to demonstrate understanding and application of the law in question.

However, this year it was noticeable that the answer to the second question was often rushed and, in a few cases, unfinished. Candidates must allow sufficient time to provide an adequate answer to two questions if they wish to demonstrate their potential across both question formats.

### Part A

The 'essay' section of the paper saw the vast majority of candidates opt to answer question 1 (55) over question 2 (9). The average mark for questions 1 and 2 was the same = 63.5%.

### General observations:

- a) Across both questions, those that achieved highly demonstrated knowledge of the law and policy in question, and applied that knowledge to the question being asked. As observed in last year's Report, to achieve at the highest level care must be taken to ensure the answer addresses the various elements in the question, and does so through a process of 'critical evaluation'.
- b) It was pleasing to see candidates utilising the academic commentary provided on the Reading List and in the seminars. There was also significant evidence of candidates' engagement with a wide variety of legal and academic materials beyond the mandatory reading.

### Question 1

This was the most popular essay question, attracting 86% of candidates. The quotation from Floyd LJ on the purpose of plausibility allowed candidates to approach the issue from various perspectives (given the current uncertainty). Weaker responses merely provided an overview of plausibility and its application at various stages in the patenting process – e.g. sufficiency, industrial application, inventive step and priority. Some delved deeper into the origins of the concept and whether its EPO roots should refine its application in the UK context. Better responses analysed in detail the application of plausibility (including the appropriate standard) and assessed to what extent, if at all, it fairly operated to prohibit speculative claiming, and whether that was its sole objective.

## Question 2

This question was more focussed in its application – the law on patent entitlement in the UK. The question premised that inventors do not generally own or benefit from their inventions, which thereby hindered one of the prime objectives of the patent system – to foster innovation. It was pleasing to see most candidates include a discussion of the incentive rationale within their answers and to refer to some of the academic writings they encountered in their studies. Better responses discussed the full range of provisions covering patent ownership and inventorship, including sections 7, 13 and the provisions on employee inventions. Weaker responses tended to focus on the latter and prioritised s39 ‘Right to employee Inventions’ or s40-41 ‘Compensation for Employees’. This approach did not adequately provide insight into all provisions concerning employee inventions s39-42 and their operation in light of the question’s premise.

## **Part B**

The ‘problem’ section of the paper saw the majority of candidates opt to answer question 4 (45) over question 3 (19). The average mark for question 3 was slightly higher (64.5%) than for question 4 (62.5%).

### General observations:

- a) Candidates must be mindful of the artificial nature of the examination format. Little more than an A4 page of facts is provided which will mean that not all ‘real world’ information is available to inform the candidates’ response. It was noted that several candidates did not adequately apply the law to the facts because they lacked ‘expert evidence’. It is appropriate to highlight to the examiner what further information may be required to provide a full and informed decision, but always attempt to apply the law to the facts in the question.
- b) It was interesting that majority of candidates chose to answer the essay question on ‘plausibility’, but, in the majority of cases, failed to consider its practical application in the problem questions.

## Question 3

Broadly speaking, this question required candidates to address issues related to patent/SPC infringement and defences. 30% chose to answer this question. Given that the question was divided into three elements, most answers were provided in that format. Although, much fluidity between sections was noted in the answers.

- a) This section raised the possible infringement of the 121 patent. Candidates were required to i) identify the existence of an SPC, ii) the term extension conferred, and iii) the protection afforded by the SPC. Reference to the relevant statutory provisions was expected. Some candidates then considered any applicable defences.
- b) This section again focussed primarily on infringement of the 121 patent. Students were expected to consider whether i) the SPC covered the combination medicament, and ii) would Gencotec’s use infringe the SPC. Again, reference to the relevant statutory provisions expected and applicable case law.



- c) Most candidates focussed upon infringement of the 999 patent. However, few questioned the scope of protection afforded to the 999 patent – for ‘localised’ treatment. The challenge to the validity of the patent on the grounds of lack of novelty and inventive step was generally addressed well. The best answers discussed the application of ‘obvious to try’, and some considered the application of plausibility in this context. Most answers progressed to consider other possible defences including the ‘Bolar’ exemption, experimental use defence and the right to work in s64 PA. Those achieving at the highest level demonstrated a detailed knowledge of the application of these defences in light of the relevant judicial interpretations. Given that Gencotec was using Pellisase to treat greying hair, it was disappointing that very few answers went on to consider whether this use infringed the 121 patent/SPC as well as the 999 patent.

#### Question 4

Again, this question required the application of patent law in the infringement context, but different issues were raised. Better answers made a clear distinction between the nature of the technological advance in question – product or process – and structured their answers accordingly.

*Parties to the infringement* – Most candidates made a good attempt to determine who was liable for the importation into the UK of the cattle. Issues such as title transfer and common design were considered in detail.

*Infringement of Claim 6 – s60(1)(a) Importing a patent product.* This issue was dealt with reasonably well. Most candidates identified that the yearlings appeared to fall within the scope of the claim and focussed on challenging the validity of the patent. The relevant grounds included i) modifying the genetic identity of animals-causing them suffering – without any substantial medical benefit to man...; ii) Lack of sufficient disclosure for claiming more than has been taught in the description (post-grant evidence following BIAS study); iii) Technical feasibility being confined to a particular animal variety; and iv) possible lack of inventive step. Most of these issues were generally addressed well with often detailed reference to the applicable case law. However, the link between points ii) and iii) was rarely made. While most candidates discussed sufficiency and animal varieties, they often focussed on the wording of the claim and did not consider the evidence provided by the BIAS study. This suggested that the technical feasibility was, in fact, confined to the Red Poll variety.

*Infringement of Claim 1 – s60(1)(b) BIAS use of patented process.* This act of infringement was often omitted from the analysis. Defences considered included experimental use, insufficiency (BIAS establish that the process is not applicable to all bovines, but do establish that it works in other ‘mammalian livestock’), inventive step, and whether this process can be considered ‘essentially biological’ for the production of animal or plants. Again, the best answers were those that engaged with the relevant case law to demonstrate a full understanding of the judicial interpretation given to these provisions.

*Infringement of Claim 1 – s60(1)(c) imports a product obtained directly by means of a patented process.* Most answers addressed this issue and considered to what extent the yearlings could be seen

to be ‘obtained directly’ from the protected process. Better answers made reference to applicable case law. Relevant challenges to the validity of the patent were those considered above.

## **Intellectual Property II**

There were four questions for this paper, of which candidates were required to answer two: one essay and one problem question. The essay questions drew upon trade mark law and design law respectively. This year, while both questions were attempted, candidates tended to favour the design essay. One problem question was on trade mark while the other raised issues of copyright, with trade marks being the preferred problem. The quality of answers to all questions was generally good, with a systematic approach to problem questions in evidence. However a surprising number of candidates who attempted the question failed entirely to engage with Q.2(b), resulting in disappointingly low marks.

**Q1.** This question asked whether the excessive scope associated with (i) blurring and (ii) free riding under the ‘dilution’ head of trade mark infringement could be offset by the defendant establishing ‘due cause’ for their use. Better answers began by outlining the rationale for these two types of infringement and the difficulties associated with establishing a convincing harm-based account for (i) and (ii). The harm for blurring has proven conceptually slippery (harm to selling power? uniqueness? distinctiveness as a term of art?) and difficult to empirically prove (how is a change in economic behaviour causally established?). Meanwhile free riding controversially isn’t concerned with the establishment of any harm at all and the extent to which any positive benefit arising from mental associations is illegal is debatable. At this point some answers deviated into an imagined essay question on trade mark functions. While the expanded universe of trade mark functions is relevant for this essay, it is only to the extent that the dilution provisions assess harm to these functions. Due cause appeared to be an afterthought for some candidates. Better candidates identified the debate at the core of the defence (strict necessity or some form of reasonableness) and the manner in which recent court decisions had expanded or restricted its application.

**Q2.** This question had two parts. Part A was aimed at students demonstrating the distinctions between the Community Unregistered Design Right and the UKUDR (in combination with copyright). Most students were able to outline the key differences between the two parallel systems of rights, and the best answers also considered how the limitations on protection of the UKUDR related to the ability to protect some designs through copyright, though a substantial minority did not address this. Part B asked students to discuss whether eliminating the CUDR in the UK would be a “welcome simplification”. The Part B discussion was necessarily dependent on the discussion in Part A and so many students wrote less on Part B, which was fine, provided they took a position and answered the question with a coherent normative argument. A few answers omitted Part B entirely, however.

**Q3.** The approach to the copyright problem was generally systematic. It was rare to find an issue which had been missed entirely, although some issues were considered superficially. Copyright subsistence in the flower display and the Tripod photograph were generally well developed (category of work, originality, fixation, points of jurisdictional contact), as were questions of authorship (co-authorship; in the course of employment). Some infringement issues were developed in detail but others - the scope of the Tripod photograph’s protection, given its modest originality

quotient and the possible ‘inversion’ of *Temple Island* reasoning – were relatively neglected. Communication to the public was developed by focussing more on *Svensson*’s ‘new public’ requirement, while issues arising under *GS Media* (the subsequent withdrawal of access by the hotel and its implications) were missed by many. Some defences were also underplayed (quotation; the factors used to establish fair dealing as a general preface).

**Q4.** Most of the answers to this question were organized systematically by possible defendant, then addressing potential claims against House Proud. Others began by discussing the registered marks on which House Proud could rely and whether the validity of those marks could be challenged. Quite a few answers neglected to discuss the issue of what was the “sign” that Natasha was using and whether it was identical or similar, but most analysed possible grounds for infringement of House Proud as a mark with a reputation. Most of the answers on the slogan issue were good and comprehensive. Nearly all answers considered whether the F&M image might be passing off, but weaker answers simply put down the classic *Jif Lemon* trinity of passing off without application of the law to the facts of the hypothetical. The weakest part of most answers on this question was in addressing the possible infringing use of IBS—many answers dealt with this minimally and without reference to relevant case law, which may have been due to time constraints.