

FACULTY OF LAW
POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW
AND PRACTICE 2020-21
Examiners' Report 2021

Part I

A. STATISTICS

(1) Numbers and percentages in each class/category

| | 2021 | | 2020# | | 2019 | | 2018 | |
|--------------|------|-------|---------|-------|------|-------|--------|--------|
| Category | No | % | No | % | No | % | No | % |
| Distinction | 16 | 23.53 | 15 | 21.43 | 9 | 13.24 | 10** | 14.29 |
| Merit | 22 | 32.35 | 15 | 21.43 | 21 | 30.88 | n/a*** | n/a*** |
| Pass | 19 | 27.94 | 35***** | 50 | 34* | 50.00 | 55**** | 78.57 |
| DDPGD***** | | | 1 | 1.43 | 0 | 0 | 0 | 0 |
| Partial Fail | 10 | 14.71 | 4 | 5.71 | 4 | 5.88 | 5 | 7.14 |
| Fail | 1 | 1.47 | 0 | 0 | 0 | 0 | 0 | 0 |
| Total | 68 | | 70 | | 68 | | 70 | |

The assessment regime and criteria were substantially altered in 2020 in response to the Covid-19 pandemic (see Section B below).

*includes one candidate who withdrew from two papers in 2017-18 and completed the Diploma in 2018-19

** includes one candidate who withdrew from three papers in 2016-17 and completed the Diploma in 2017-18

*** the merit award was introduced in 2019, and not available in earlier years

**** includes one candidate who withdrew from three papers in 2016-17 and one candidate who withdrew from two papers in 2016-17 and who both completed the Diploma in 2017-18

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

***** this award was introduced in 2019-20 due to the Covid-19 pandemic.

***** includes one candidate who withdrew from two papers in 2018-19 and completed the Diploma in 2019-20.

(2) Vivas are not used in the IP Diploma.

(3) Marking of scripts

Scripts are double marked according to the criteria in the examination convention. Additionally, in 2021, a number of scripts for coursework assessments were double marked at the request of the Board or the Chair of Examiners to ensure consistency of approach between markers. Overall, 99 out of 325 coursework assessments (30.46%) and 62 out of 62 examination scripts (100%) were double marked in 2020.

One script was third marked.

Further details as to the second marking of scripts can be found in section B below.

NEW EXAMINING METHODS AND PROCEDURES

B. The Covid-19 pandemic continued to affect the delivery of the course and the assessments. In consequence, the following adjustments were made to the assessment regime:

1. The Board implemented the University's 2020-21 Assessment Support Package. This involved, among other things, adopting the enhanced MCE process, and considering and applying the marks safeguard and outcomes safeguard.
2. In accordance with the University's marks safeguard policy, the Board decided to apply a one-mark upwards scaling adjustment to the Patents 2 assignment.
3. Candidates took a single, online, open-book examination, Intellectual Property I and II, with a duration of 8 hours. The paper required candidates to answer 3 questions, comprising 2 compulsory problem questions and 1 of a choice of 3 essay questions. For the first time, the examination was conducted via the University's new open-book exams platform, Inspira.

The Board retained the system of checks, introduced in 2019-20, to verify that word counts have been accurately reported and not artificially suppressed be investigated (see Part II, Section A.4 below). These checks were administered by the Diploma Administrator and the Chair, and penalties applied with reference to a scale agreed by the Board.

C. The University has strongly encouraged departments to utilise online exams in 2021-22 and beyond, where they are felt to be academically appropriate. This is based on a desire to capitalise on the opportunities offered by the Inspira platform, with its associated benefits for flexible and inclusive assessment, the ease of marking typed work, and the significant practical challenges of running a full suite of in-person exams in 2021-22. The view of the Board is that, from both an academic and practical perspective, the online examination has worked well. Given all this, the Board recommends that in 2021-22 the Part II assessment ('Intellectual Property I and II') should once again consist of an 8-hour, open-book, online examination.

At its First Meeting, the Board had sight of the marks for the Patents 1 and Patents 2 coursework assignment. Having reviewed the markers' and candidates' profiles, the Board concluded that decisions as to whether to require any additional marking should not be made solely on the basis of this information and that it would be best to revisit the profiles once the marks for the Trademarks and Passing Off coursework assignment had been received. The Board's view is that some thought should be given to whether steps could be taken to ensure that, in the future, the marks for the first three coursework assignments are received before the First Meeting of the Board. For example, it might be desirable for the First Meeting to take place at a later point in the year, in order to give the relevant markers enough time to complete the marking.

The Board notes that a substantial amount of marking was undertaken by individuals who acted as second markers. One reason for this is that first marking is generally undertaken by at least four or five individuals, who each mark a relatively small number of scripts. This means that there is a greater need for second marking, to ensure consistency of approach between markers. The Board has considered whether there may be a case for dividing the scripts between a smaller number of first markers. While this would reduce the need for second marking, a change of this nature might not be practicable and may discourage some of those who would otherwise agree to act as markers. Consequently, we do not wish to recommend a change to the marking procedures at this stage, but we do recommend that further consideration should be given to this issue.

As explained in Part II.A(4) below, the Board has adopted a policy for imposing penalties for non-compliance with the word count and citation rules. Under the policy that applies to coursework assignments, where a breach of the word count rules is classified as 'minor', the Board has a discretion: it may deduct one mark or it may refuse to make a deduction. We believe it would be better to replace with this discretion with a general rule requiring a deduction of one mark. This would avoid the risk of the discretion not being exercised fairly as between candidates.

D. Information concerning the examinations, including the conventions and notices of changes to the conventions, was sent to each candidate by email. The conventions were also made available online.

Part II

A. GENERAL COMMENTS ON THE EXAMINATION

1. Second and third marking

See Part I.A(3) above.

2. Materials in the examination

The written examination, Intellectual Property I and II (see Part I.B above) was conducted on an open-book basis.

3. Legibility

All examination scripts were typed.

4. Word limits in coursework assessments and written examination

The Board adopted a system of checks to implement the requirements in the examination convention concerning word count for coursework assignments (see Part I, Section B above). For each coursework assignment, a sample of scripts was

spot checked for compliance with the requirements concerning (a) number of words, and (b) appropriate citation practice/suppression of word count. Scripts flagged as breaching the requirements in either respect were flagged, and the remaining coursework assignments for these candidates were routinely checked for compliance in the relevant respect. The Board applied penalties for non-compliance with these requirements with reference to an agreed scale.

In the written examination, a word count limit of 1,500 words per answer was applied. Markers were instructed not to mark the sections of questions that exceeded the limit.

5. Scaling Adjustments

Having compared the median mark for each paper with a reference value (achieved by averaging the marks from the previous three pre-pandemic years for the relevant paper), the Board agreed to apply a one-mark upward scaling adjustment to the Patents 2 coursework assignment. The Board did not consider that any other adjustment was necessary.

6. Partial fails

The Board notes that there was a relatively high number of Partial Fails this year. A paper is classified as a 'Fail' if the overall mark is less than 50. Every paper that obtained an overall mark below 50 was double marked (and, if appropriate, third marked) and if, at the end of this process, the mark was still lower than 50, the candidate's profile was carefully considered by the Board.

7. External Examiner

Professor Tanya Aplin joined the Board as an External Examiner. Professor Aplin was fully involved at all stages of the examination process and made an enormous contribution. The Chair wishes to express his gratitude to her.

8. Internal Examiners

Professor Ben McFarlane joined the Board and Brian Cordery served on it for a second year. The Chair expresses his gratitude to them for their immensely valuable support in conducting the assessments in the Diploma this year.

9. Assessors

In addition to the examiners, **32** colleagues were assessors. This number is made up of **31** professional colleagues and includes **1** academic colleagues from another university. We are very grateful to them for their commitment to the effective functioning of the IP Diploma.

10. Diploma Administrator

Ellen Moilanen stepped down from the role of Diploma Administrator in November 2020. We are very grateful to Ellen for her many years of service to the IP Diploma and wish her every success in her new role. Juliet Franks took on the role of Acting Administrator in November 2020. We wish to thank her for keeping the Diploma on an even keel during a difficult period. Lettitia Derrington took over as Diploma Administrator in April 2021. We greatly appreciate everything Lettitia has done to support the examination process and wish to express our sincere thanks to her.

B. EQUAL OPPORTUNITIES ISSUES AND BREAKDOWN OF RESULTS BY GENDER

| | 2020 | | | | 2019 | | | | 2018 | | | | 2017 | | | |
|-------------|------|-------|--------|-------|------|-------|--------|-------|------|-------|--------|-------|------|-------|--------|-------|
| | Male | | Female | | Male | | Female | | Male | | Female | | Male | | Female | |
| Category | No | % | No | % | No | % | No | % | No | % | No | % | No. | % | No. | % |
| Distinction | 9 | 33.33 | 6 | 13.95 | 3 | 10 | 6 | 15.79 | 5 | 18.5 | 5 | 11.63 | 4 | 12.12 | 4 | 12.12 |
| Merit | 5 | 18.52 | 10 | 23.26 | 8 | 26.67 | 13 | 34.21 | n/a | n/a | n/a | n/a | n/a | n/a | n/a | n/a |
| Pass | 11 | 40.74 | 24 | 55.81 | 19 | 63.33 | 15 | 39.47 | 19 | 70.38 | 36 | 83.72 | 29 | 87.89 | 28 | 84.85 |
| Fail | 1 | 3.70 | 3 | 6.98 | 0 | 0 | 4 | 10.53 | 3 | 11.11 | 2 | 4.65 | 0 | 0 | 1 | 3.03 |
| DDPGD | 1 | 3.70 | 0 | 0.00 | 0 | 0 | 0 | 0 | 0 | 0 | 0 | 0 | 0 | 0 | 0 | 0 |
| Total | 27 | 38.57 | 43 | 61.43 | 30 | 44.12 | 38 | 59.38 | 27 | 38.57 | 43 | 61.43 | 33 | 50.00 | 33 | 50.00 |

| | 2021 | | | |
|-------------|------|--------|--------|--------|
| | Male | | Female | |
| Category | No | % | No | % |
| Distinction | 6 | 19.35% | 10 | 27.78% |
| Merit | 14 | 45.16% | 8 | 22.22% |
| Pass | 8 | 25.81% | 11 | 30.56% |
| Fail | 3 | 9.68% | 7 | 19.44% |
| DDPGD | 0 | 0.00% | 0 | 0.00% |
| Total | 31 | 46.27 | 36 | 53.73 |

C. DETAILED NUMBERS ON CANDIDATES' PERFORMANCE IN EACH PART OF THE EXAMINATION

| | 70 plus | | 65-69 | | 60-64 | | 50-59 | | Under 50 | | Total |
|-----------|---------|------|-------|------|-------|------|-------|------|----------|-----|-------|
| | No. | % | | | No. | % | No. | % | No. | % | |
| Patents 1 | 7 | 8.0 | 23 | 26.1 | 21 | 23.9 | 12 | 13.6 | 4 | 4.5 | 67 |
| Patents 2 | 6 | 10.3 | 17 | 29.3 | 21 | 36.2 | 21 | 36.2 | 2 | 3.4 | 67 |

| | | | | | | | | | | | |
|------------------------------|----|-------|----|-------|----|-------|----|-------|---|------|----|
| Trade Marks and Passing Off | 15 | 17.2 | 16 | 18.4 | 11 | 12.6 | 20 | 23.0 | 2 | 2.3 | 64 |
| Copyright | 18 | 27.3 | 22 | 33.3 | 7 | 10.6 | 12 | 18.2 | 3 | 4.5 | 62 |
| Designs | 12 | 23.1 | 19 | 36.5 | 11 | 21.2 | 12 | 23.1 | 8 | 15.4 | 62 |
| Intellectual Property I & II | 12 | 19.35 | 24 | 38.71 | 13 | 20.97 | 11 | 17.74 | 2 | 3.23 | 62 |

*includes one candidate who withdrew from two papers in 2018-19 and completed the Diploma in 2019-20

**includes scaling adjustment (see Section A.5 above).

D. COMMENTS ON PAPERS AND INDIVIDUAL QUESTIONS

These appear in Annexe 1.

E. COMMENTS ON THE PERFORMANCE OF IDENTIFIABLE INDIVIDUALS AND OTHER MATERIAL WHICH WOULD USUALLY BE TREATED AS RESERVED BUSINESS

These appear in Annexe 2.

Dr. Luke Rostill (Chair)
Brian Cordery (IPLA)
Prof. Tanya Aplin (External)
Prof. Ben McFarlane

Annexe 1 – Reports on individual papers

Annexe 2 – Reserved matters

Annexe 1

COMMENTS ON PAPERS AND INDIVIDUAL QUESTIONS

A breakdown of the marks on each paper appears at Part II.C of this report.

A. Coursework assessments

Patents 1

The problem was based on a patent for an improved face-mask. There were no tricky technical issues to ensure that candidates without any technical background were not disadvantaged. The fact pattern was designed to present issues as to scope of claims; infringing acts and liability for infringement; invalidity for lack of novelty; invalidity for lack of inventive step; and issues relating to title, threats and amendment. These are all “mainstream” issues which would enable a good candidate to display her/his knowledge of patent law, but required a degree of attention to the details that a poorer candidate might not display.

Question 1

Infringement – scope of claims

Infringement by equivalents is one of the biggest current issues in patent law and the issue was presented squarely to candidates in claim 1, which required “non-woven” material, the accused infringement being made of woven cotton. This was handled competently by most candidates. Subsidiary claims presented the “numerical range” issue (claim for 3-5 pleats, the accused infringement having 6 pleats), two construction issues (meanings of “additional” and “bonded”) an issue as to the meaning of relative terms (“top” and “downwards”). These required closer reading of the patent and the fact pattern, and enabled us to differentiate between stronger and weaker candidates.

Question 2

Infringement – acts and liability for infringement

The facts provided a number of people having different roles in the design and manufacture of the accused infringing masks, raising questions of liability for primary infringement, and accessory liability and joint tortfeasorship. The facts also raised issues relating to the supply of “means essential” for making the masks, and liability for selling the masks. The main issues were generally correctly spotted and well-handled, although few candidates discussed the more subtle “accessory liability” issues (this could be because of word number constraints). There was also a proprietorship question which affected who was the correct claimant, which most but not all candidates handled well.

Question 3

Invalidity – novelty

The question provided candidates with two prior publications which were clearly relevant as prior art. There were additionally prior disclosures in the fact pattern. This is the sort of thing that (in the setter’s experience) weaker candidates frequently overlook, but nearly all did spot these prior disclosures. The facts raised a confidentiality issue which nearly all candidates discussed in varying degrees of detail.

Invalidity – lack of inventive step

The prior art was designed to make the candidates carry out a *Windsurfing/Pozzoli* analysis in relation to two prior publications and all the patent claims. Candidates generally showed their knowledge of the relevant questions, and of the need to provide reasons for their answers to those questions, albeit with different degrees of detail and care.

Question 4

Title, threats and amendment

Although most candidates dealt with the title point in question 2, not all addressed ways of resolving the problems with title that they had identified. Most candidates dealt with the threats point. Surprisingly few handles the amendment issues with any confidence.

Patents 2

Introduction

The Patents 2 assignment for 2020/21 concerned another pet-related invention, this time a paddling pool for domestic use which did not require inflation and was therefore immune to punctures from e.g. dogs and other pets. The coursework was designed to test candidates on the key issues of construction and infringement especially by equivalence. The problem also required the candidates to consider joint tortfeasance and common design. On the validity side, candidates were required to look at entitlement to priority, novelty and inventive step.

Construction and Infringement

The invention described in the patent in suit contained various elements some of which were included in the priority document and some of which were not. In particular, Claims 3 to 6 were added later. Most candidates were able to pick up on the significance of this, particularly with regard to entitlement to priority and prior use (see below).

There were issues of infringement by equivalence to be tackled in particular regarding the use of “rectangular” in claim 2 and with regard to the positioning of the drainage hole and plug.

Most candidates were able to argue the construction and equivalence points really well. Some considered that the patentee intended strict compliance with the positioning of the plug hole “at the lower end of one of the HDPE slabs” Others did not. There was no right or wrong answer as long as the Actavis questions were clearly set out and the appropriate arguments made. Candidates were told at the Patents 2 workshop of the recent trend towards pleading Particulars of Equivalence. They were also provided with a precedent. It was therefore somewhat disappointing that quite a few candidates argued but did not plead equivalence. Since this trend appears to be continuing (see e.g. Voxer), candidates should specifically draft Particulars of Equivalence in order to score highly.

As well as direct infringement by PetsRUs, there was an argument that the plastic supplier Foley Plastics should be included as an additional defendant for indirect infringement pursuant to Section 60(2) Patents Act 1977. There were arguments both ways on this and it did not really matter if Foley Plastics was included or not provided that the legal and commercial arguments were considered. There was the possibility of a staple commercial product defence pursuant to Section 60(3) which most candidates picked up. Many candidates still did not include separate Particulars of Knowledge which really should be provided when considering the mental element of Section 60(2).

Lots of candidates drew up claim charts for their infringement analysis. This appeared to aid clarity of thought for many.

Validity

The main issue on validity was prior use both before the priority date and during the priority year. At the workshop, candidates were taught about the key issues surrounding formalistic and substantive priority. They were asked to plead as to the position if priority was maintained and if it was not.

Surprisingly few candidates set out the position with regard to the situation where priority was maintained and when it was not. Most candidates picked up the main prior uses but surprisingly few referred to the leading Court of Appeal decision on prior public use in Hozelock which was a little disappointing.

Most but not all candidates picked up on the formalistic priority points. The general trend in the law appears to be a softening of the rigid position in Edwards v Cook and more candidates should have picked up.

The other main issue in relation to prior use was mosaicking. Too many candidates pleaded invalidity based on a combination of discrete events which legally could not be combined to form a validity attack.

The factual matrix surrounding the prior user events and the various claims was complex. Some candidates used a chronology as a tool to compare the various claims and the prior user events and this generally worked out well. Claim charts and chronologies are a good way to put a lot of information across to the marker without using a lot of words.

Candidates were provided with a number of prior art citations to consider to plead in relation to the validity of the patent. Most candidates demonstrated an understanding of the need to consider each prior art citation against each claim and to be critical in their analysis. None of the prior art citations provided to the candidates was very strong and candidates could have been forgiven for not pleading any of them in relation to inventive step although understandably most felt obliged to plead one or two citations. Only a few candidates pleaded all the citations which was clearly not appropriate in the circumstances. Overall, most candidates justified their pleadings fairly well. Several candidates pleaded all the prior art citations which was plainly inappropriate in all the circumstances.

Some candidates alleged that the patent was insufficient. This was generally well argued although it should be understood that patents drafted for the purposes of coursework assignments will inevitably somewhat brief in nature.

Trade Marks and Passing Off

The standard of coursework was good this year. The majority of candidates fell within the same range for marks and were of a similar quality. As with previous years, candidates are generally very good at reciting the law, picking out most of the relevant facts and applying those (to varying degrees).

On **question 1**, some candidates did not understand that oppositions are a paper-based comparison, whereas infringement can take into account the real-life context of use. Further, some candidates were not rigorous enough in comparing the specifications.

On **question 2**, candidates seemed reticent to commit on whether the trade mark registration was valid/invalid.

On **question 3**, candidates were good at spotting the relevant litigation tactics that could be used.

There were some exceptional candidates, who provided papers which were extremely well written, compelling and commercial in their approach. These really stood out. In a similar vein, there were unfortunately a handful of candidates who displayed a lack of understanding of the subject matter, and a worrying inability to write in comprehensible English.

Copyright

The paper considers a series of educational books written by Sean Riley and published by Laburnum – the Tail to Tale (T2T) series. Laburnum is in financial difficulty and is negotiating a deal with Mega Publishing, which is keen to acquire Laburnum or its assets. Mega has made Laburnum aware that it has been approached by Holly Enterprises, a literary agent, with a pitch for a rival series, Led by the Tale (LBTT). Mega is threatening to withdraw from the negotiations if LBTT is not stopped.

The person behind the pitch, Ivy Salix, is a former employee of Laburnum and is now with Willow Tree. The pitch appears to be based on the T2T series, and Ivy appears to have taken documents and details of Laburnum's suppliers and customers with her on her departure. Laburnum wants to know what action it can take to stop the launch of LBTT, and in relation to the material Ivy appears to have taken. It also wants advice on the terms that are likely to be negotiated in any deal with Mega in relation to the Tail to Tale series.

Question 1

The question asks for advice on various copyright works on which Laburnum might rely to stop the launch of Led by the Tale.

Overall, the question was well answered, particularly by those candidates who followed the "Sootie" structure, i.e., who dealt with the issues arising in order of Subsistence, Originality, Ownership, Term of copyright, Infringement and Exceptions/Enforcement. Stronger answers applied the law closely to the facts. However, there were some weaker papers.

Most students recognised that on the facts, the term of copyright was not an issue, and that there were no relevant exceptions.

The better papers considered the rights which might be useful to Laburnum and disregarded the rest. The main focus was on the T2T title design, extracts from the original T2T pitch, two photos, and a haiku.

Generally the papers recognised that copyright would subsist in all of these. Most recognised that the pitch expressed the ideas for the T2T series, and so was protectable. Good candidates discussed possible copyright in Tail to Tale as a title, and in the haiku, and did more than merely say that copyright might exist in short works in principle, instead applying that principle to the facts.

The examiners had expected there to be a consideration of the Court of Appeal decision in *Kogan v Martin*, and its comments on copyright in characters, but few papers did that. The examiners therefore decided not to penalise candidates who did not refer to the case on that point, but to credit those who did.

The discussion of possible infringement of the individual works was also good, although there were issues with possible infringement of the Lido photo by the bench photo. The best (only a few) recognised that the photos had been taken from slightly different angles on a snowy day, so had probably been taken on the same occasion, as in *Creation Records*, and that possibly Sean Riley had rights in a second photo, which the bench photo in the LBTT pitch document copied.

Many papers focussed on the possibility of obtaining an interim injunction, noting that Laburnum was in financial difficulty so might not be able to support a cross-undertaking. However, the candidates nearly all focussed on the copyright works individually, and whether they could be used to stop the material in Annex 2. Few stood back to think about whether that would be enough to stop the LBTT launch entirely, or to force Ivy/Willow to change it to such a degree that it ceased to be a worrying competitor. Had they done so they might have said that if the characters, the title and the T2T design and possibly the overall plot had to be changed, that might be the best achievable outcome.

Suggesting that threatening criminal proceedings might be a way forward failed to recognise that that would raise the stakes for the defendants and probably make it harder to settle. Who should be claimant(s) was well considered. Most papers recognised that it would be necessary to ensure that Laburnum had the necessary rights to sue. Those who noted that it would not be necessary to join an owner or exclusive licensor into an application for an interim injunction did not always acknowledge that they would need to be joined later.

As for the possible defendants, nearly all recommended suing Ivy and Willow. Many who suggested also suing Holly did not consider whether they had any liability, if they were merely acting as agent, and some did not point out that for Laburnum, suing a literary agent might well not be wise. Given that Mega had brought the problem to Laburnum's attention, and was in negotiation with Laburnum, suing them would be commercially very dubious.

Question 2

The answers showed a good understanding of copyright and database rights in databases. The better ones were willing to form a view on the likely outcome of claims against Ivy, noting that a database right claim was more likely to succeed than a copyright one. Most papers also considered a breach of contract or common law claim for misuse of confidential information as alternatives, with some also considering the Trade Secrets Directive, which adds little. Some also pointed out that there might be useful restrictive covenants/non-compete clauses. Very good candidates noted, here or in question 1, that suing, or threatening to sue, Ivy and Willow under these rights and for copyright too might be very effective.

Question 3

The question asked for consideration of the terms that might be needed in relation to the T2T series, not generally. It asked for the reasons for suggesting the various terms to be explained "on the facts". Many papers did little more than list general commercial terms which might be

found in any sale agreement. The best considered what Mega would want to acquire, what Laburnum would want to ensure, and worked out from there the terms each would want in the contract. For example, Mega will want to be able to publish the series after the sale. It will want warranties to cover change of control provisions (on a share sale) and licences terminable on sale (on an asset sale). Laburnum will want to ensure that any warranties are limited by disclosures.

It is unlikely that the issue with Ivy will be resolved before completion of any deal. So the best papers also considered what terms might be incorporated into the agreement to cover the conduct of any ongoing or future litigation and where the costs should fall.

Well done to those who found the “Easter Eggs” which add to the inference of copying: Venus (de) Milo; “Heidi” author Johanna Spyri; and Scout and her lawyer father Atticus from *To Kill a Mocking Bird*. And to those who knew that *Salix* is the Latin scientific name for Willow, which might infer that Ivy was behind that company. The examiners didn’t expect candidates to find those, but credited those who did – only a few.

Designs

The coursework consisted of three questions revolving around a pub chain, Carnival, which was thinking of developing a “coffee and chess” theme for its pubs. It was planning to invest in a large-scale chess set for each of its pub gardens, small chess sets for people to play chess, and a coffee pot.

The dates given in the coursework were such that the only three design rights which were relevant were UKUDR, the Supplementary Unregistered Design Right, and registered designs. Discussion of copyright or Continuing Unregistered Community Design Rights was expressly excluded.

The coursework was very well done by a number of candidates, but some papers were less persuasive.

General comments

The three products in issue were the WobbleSet, based on the TweedleSet; a chess set, SetA Carnival was thinking of reproducing, which looked similar to images of traditional sets, and a coffeepot, the FieldingPot which had been alleged to infringe rights in a HigginsPot.

Candidates were expected to consider each of the WobbleSet, SetA and the FieldingPot, to assess whether they might infringe third parties’ valid design rights, to analyse the merits of any claim against Carnival and/or Bob, and to consider what steps Carnival and Bob might take, both to reduce the infringement risk and to strengthen Carnival’s commercial position.

Candidates structured their coursework in one of two ways – by right, and by product. Either worked, but structuring by product probably led to greater cohesion and less need for repetition.

The better candidates considered the design of the whole of each of the TweedleSet, the traditional chess sets and the HigginsPot (the Whole Design) and analysed whether the Whole Design might be protected by one or more valid design rights. They considered whether any valid design right might be infringed by the WobbleSet, SetA and the FieldingPot. The result of those two analyses enabled them to advise as to how likely it was

that Carnival/Bob might infringe a valid right, and from there, advise as to the next steps Carnival/Bob should take. They recognised that rights might also be claimed in parts, but that that would not be the stronger case.

It was very important throughout the coursework to be precise about dates, as those affected both the subsistence and validity of the rights and their infringement. Good candidates recognised that clarifying unclear dates would be critical to deciding the strength of the rights.

The best candidates paid close attention to the facts. For example, the TweedleSet was “rather unusual”. Bob had “never seen anything like it”. It had “generated quite some interest”. That all pointed to a design which was not commonplace (UKUDR). The traditional chess sets, in contrast, “frankly all look the same”. The indication was that the TweedleSet might be protected, whereas the traditional sets might not.

The coursework also raised a number of issues about whether a right could subsist at all (e.g. by qualification, by date) and if it did, who might own it. There were points to consider about what the infringing acts might be, who had done/might do them, and who might be liable for them.

Registered rights

There were no specific registered designs in the question, so beyond saying that better searches should be done to make sure that no relevant third-party rights were registered (and might be infringed), there was little more to say about such rights. On the other hand, there was scope for discussion of a possible registration of the WobbleSet, or part of it.

The approach to registered designs varied considerably between candidates. The examiners considered each approach and gave credit if the analysis showed a good understanding of UK registered design law as it applies after IP Completion Day.

UKUDR and Supplementary Unregistered Design Rights

Some specific points arose in relation to UKUDR and Supplementary Unregistered Design Right. As a general point, it is unlikely that a design can be commonplace and yet have individual character.

UKUDR

The best candidates considered each chess set as “an article” and explained why.

Good candidates looked at how the right might arise, and noted the need for more information about Etherreal and where the TweedleSet had been sold, in particular whether it had first been marketed in the UK. The dates given in relation to the TweedleSet suggested any UKUDR might be in the licence of right period.

A number of candidates missed that to infringe, Carnival's acts in relation to the WobbleSet would have to be for a commercial purpose as defined in the CDPA. Good candidates indicated that if the WobbleSet was hired out to customers, that might suffice. They also spotted that Carnival/Bob might be liable for authorising, e.g. if they requested Fielding to sell the FieldingPot to them.

The best analysis of the coffee pots noted that whilst the HigginsPot might have some UKUDR protection, the FieldingPot was not the same, and probably not substantially the

same as it, making infringement unlikely. The best candidates showed that they had read the cases on what did and did not constitute surface decoration and applied them well.

SUDR

The best candidates noted the squeeze here. If Pot1 was a relevant prior design, HigginsPot would have to create a different overall impression from it for there to be a valid SUDR, but could not then be infringed by FieldingPot, which created a similar impression to Pot1.

Commercial issues

The best candidates showed an excellent sense of the commercial realities. For example, they were prepared to say that whilst the legal risk might be tolerable e.g. in relation to the traditional chess sets and the HigginsPot, Carnival could eliminate that risk, and the time and expense of litigation, by choosing a different design altogether, or by buying the items from the source - the SetA manufacturer and Higgins.

B. Intellectual Property I & II (Examination)

Question 1

The majority of the legal issues were identified by the majority of candidates. The best answers were able to clearly identify the relevant issues, identify the relevant law/principles/case law and apply it to the facts in a succinct yet well-reasoned manner, wasting little if any words on irrelevant issues. The weaker candidates often missed elements of the question; failed to cite the relevant statutory provision and/or case law; used up words on irrelevant issues; were contradictory in their analysis – e.g. finding that an invention had been anticipated, yet also non-obvious; did not apply the law to the facts presented; or did not demonstrate a clear understanding of the relevant legal principles.

- a) In answering this question, most candidates considered some or all of the following issues. However, as will be highlighted, some of these issues are quite obvious from the facts and needed only a brief mention, if at all. Many candidates used up too many words on these types of issues.
- Patentable subject matter –
 - Software exclusion - surprisingly many candidates addressed this point (probably because it mentions use of computer software) under s1(2) non-inventions and, after applying Aerotel, came to the conclusion that this was not software as such. This was one of those issues that probably didn't need to be covered.
 - A few candidates also addressed the exception to patentability for inventions contrary to public policy and morality. Better answers engaged with the limited scope of this exclusion and probably rightly concluded that the invention wouldn't be excluded on this basis.
 - A smaller number of weaker candidates even suggested that this invention may be excluded as a method of medical treatment. However, this necessitated a discussion of what type of patent/invention this was – product or process. Only one of these candidates directly engaged with this point, but many did reach the conclusion that this invention must be a 'substance or composition for use in' a method of medical treatment and thus not excluded on this basis.

- Novelty – again this is one of those issues that needed little attention if at all. The tutors on the diploma have constantly emphasised that an invention will only be anticipated if a single piece of prior art discloses every integer of the claimed invention. The claimed invention is to a system that captures, stores and redelivers memory signals. It is clear that no single piece of prior art covers all three integers (some candidates did break the various integers down further). The best answers were those that came to this conclusion in a clear well-reasoned and succinct manner. Weaker answers were confused by what the invention was trying to achieve and thus often concluded that the invention had been anticipated.
- Inventive Step – In light of the prior art, this was a much more relevant consideration. Most of the candidates identified the appropriate test (*Windsurfing/Pozzoli*) and, with varying degrees of success, applied it to the facts presented. Many also rightly considered whether, in light of the prior art, there was an argument that this was ‘obvious to try’, assessing whether any of the prior art created a ‘reasonable prospect of success’. As always with obviousness, the fact-based nature of the assessment makes it difficult to apply considering the limited information provided. However, I did expect the candidates to make a reasonable attempt at applying the principles to the facts. The majority concluded that while the prior art probably disclosed the first two integers of the claim – collection and storage – the third integer ‘redelivery’ had not been disclosed and that it would require inventive activity to make this leap. Better answers recognised the prior art cannot be mosaicked unless the prior art is expressly or implied linked, and tended to focus on the US patent as the ‘closest’ prior art on which to base the analysis. These answers often also considered the possibility that the two articles could form part of the CGK and thus factored into the analysis in this way.
- Sufficiency – This was one of the key issues in this part of the question. Weaker answers only addressed this issue briefly. The examiners were expecting a discussion of Biogen sufficiency (given that the claim is to all ‘means’ of achieving the effect) and plausibility (as there was no experimental data included to demonstrate it would work). Better answers often based their reasoning on the Supreme court decision in *Regeneron v Kymab* and *Warner-Lambert v Mylan/Generics*. Many answers also considered classic insufficiency and either ignored reference to the fact that the specification describes and illustrates a preferred embodiment or concluded that it wasn’t enough to satisfy s14(3). The examiners were hoping that some of the best candidates would make use of the prior art to argue that it might suggest a plausible theoretical reasoning that the invention might work, thus satisfying the plausibility threshold; or that as BCIs already exist (i.e. part of the CGK) it was sufficient to just state ‘means to’ detect and receive. However, only a couple of answers did this.

b) This section was generally covered well, but some lacked the necessary attention to detail which often resulted in a confused response.

- Patentable subject matter – it was in this section that the examiners expected to see discussion of s1(2) non-inventions. Most candidates did cover this issue and applied the Aerotel test to confirm that this was not a computer program ‘as such’. However, very few considered the final stage of the test – i.e. does it fall into any of the other excluded categories? The question was drafted to suggest that, while not software per se, the software was actually facilitating the presentation of information by ‘generating projection modelling images’ and thus possibly excluded on that basis. Maybe this point was just too obscure!
- Novelty –

- Nov 2020 disclosure. The issue can be split into two - i) was the invention disclosed and enabled? The relevance of Kyle's lack of understanding was covered by many candidates who rightly referred to the decision in *Folding Attic Stairs*. But candidates had to be careful not to confuse Kyle's characteristics with the objective PSA (weaker answers made this mistake). Better answers also engaged with whether Kyle's inspection would actually 'enable' the invention to the PSA. ii) Was Kyle 'free in law and equity to use the information'? If not there was no disclosure as not 'made available to the public'. Issues of confidence arise. Candidates either a) considered whether Williams were under an express or implied obligation of confidence which either extended to Kyle as an employee; b) or, if not and Williams were in breach by letting Kyle enter, then the patent was saved by s2(4)(b) as filing was within 6-months of this breach. In the alternative, many considered if Kyle would also be under an implied obligation of confidence and thus any disclosure to him would not be anticipatory. Weaker answers failed to demonstrate a clear understanding that s2(4)(b) is only relevant where a disclosure in breach of confidence has actually been made.
 - May 2020- Similar issues to above but more clear-cut. Hacking into a system to access information is illegal and thus not 'free in law and equity to use the information'. Many also considered that it was irrelevant that they didn't access any proprietary information. However, this is not strictly relevant, as was s2(4)(b) that was considered by many. The examiners were hoping that candidates would also focus on enablement and thus conclude that as this was not the final amended version there could be no enablement. Very few addressed this point, and, in light of the illegal activity, it is probably a side issue anyway.
 - September 2020 – This issue is slightly more complex and nuanced.
 - Lauren has accessed Jeff's computer – Has the invention been disclosed and enabled? Possibly, but will depend on whether the original unamended version is the invention and Lauren's amendments are merely minor un inventive steps. Few addressed this point.
 - Most focussed purely on the issue of confidence. i) Jeff is under an obligation of confidence to his employers and he has breached this obligation by giving the computer to Lauren. But this public disclosure would be saved by s2(4)(b) as within the 6-month filing window. ii) And/or Lauren was under an implied obligation of confidence and thus not free in law and equity to use the information, thus no 'public' disclosure.
 - Entitlement – Most candidates considered whether Lauren could be entitled to a claim as the inventor/joint-inventor. Better answers looked in more detail at what amounts to an inventive contribution and the implications for Aircode if Lauren was a joint-inventor.
- c) The FRAND issues was identified by almost all candidates. However, the quality of the answers varied depending on the level of knowledge and detail provided. The examiners were especially looking for reference to the following:
- A discussion on the nature of the FRAND obligation and how it arises
 - The impact seeking an injunction may have for Trullan. Many focussed on the implications for Trullan under competition law. However, strictly speaking, this is not the basis for the FRAND approach in the UK. Better answers engaged with the decision of the UK courts in the *Unwired Planet v Huawei*, especially how the UK

courts have constrained the relevance of the CJEU's 'process of negotiation' set out in *Huawei v ZTE* to favour the patentee.

- The examiners expected candidates to consider the non-discrimination limb of FRAND given that Techpill were refusing to license on the same terms as mobile phone producers. A good number of candidates did this and many also factored in the policy implications that come into play with these type of healthcare devices.

Question 2

This question produced a broad spread of marks (48-73). It is difficult to generalise as to where candidates fell down as all of the issues in the question tripped up some people. Nevertheless, most candidates were able to do the following:

- (i) Provide a reasonable analysis of the global appreciation test for trade mark law (but see v, below).
- (ii) Discuss with confidence the question of whether copyright subsisted in the design of the wand (impact of *Lucasfilm*, whether this case could be distinguished, etc) and were not distracted by the originality red herring (wand based on description in novels).
- (iii) Note the impact of s 51 CDPA as regards copyright in the drawing.
- (iv) Provide a general discussion of the test for passing off and the reasons why the problem at hand is different from a case like *Fenty*.

The issues that tended to produce the spread of marks were as follows:

- (v) As regards registered trade marks: noting that there is no question of the products being identical since we are dealing with a goods / services case.
- (vi) As regards registered trade marks: noting the possibility of partial revocation and using the facts given in the problem carefully (nature of the use and use with additional material). The very best answers considered how partial revocation would feedback into the similarity of products enquiry.
- (vii) As regards copyright: being clear about the nature of the potentially infringing act (there is no evidence that the defendant made the wands and common sense ought to have suggested that they were not the likely manufacturer).
- (viii) Passing off: thinking carefully about how WB would have to frame their case. It is obvious that they cannot claim goodwill in Radcliffe's likeness per se. They would have to pitch their case in terms of goodwill in the HP universe (cf. *Duff Beer*, *Pub Squash*) and claim that there was a misrepresentation in all the circumstances.

Question 3

This question was generally addressed well, with several distinctions being awarded. Most answers identified the historical problems purpose limited patents create for the novelty principle and strict liability infringement. Many answers purely focussed on second-medical use patents and thus incorporated reference to the clash with methods of medical treatment; the introduced of swiss-form and EPC 2000 claims; and the litigation in *Warner-Lambert v Generics/Mylan*. However, better answers went much further and looked at the 'narrowing' implication of other recent Supreme Court decisions on obviousness, equivalents and sufficiency. Some also looked at other relevant subject matter such a biotechnology.

As always, weaker responses were often very descriptive, made little direct reference to the question being asked, and lacked a clear structure. Better answers directly engaged with the question throughout the essay.

Question 4

This essay question required candidates to critically evaluate whether the ‘overall impression on the informed user’ test provides adequate protection for registered designs, with reference to the rationale for design protection. Most candidates began by outlining the test and its symmetry with the validity assessment for registered designs. The informed user who assesses infringement is the same hypothetical person assessing whether a design deserves to qualify for protection by possessing sufficient individual character. Expanding the scope of the infringement analysis would invariably raise the bar for qualifying as a protected design – too close for one would be too close for the other. Therefore, several candidates suggested that any inadequacy of protection had more to do with the application of the test as opposed to its legal elements or criteria. Middling answers merely described the UK Court of Appeal judgments which adopted an ‘over-informed user’ perspective, finding the designs in question to be valid but not infringed. The weakest candidates merely disagreed with the outcomes in these cases. Better candidates (i) engaged meaningfully with the competing rationales underpinning design protection, (ii) explained why the specifics of appellate litigation might drive judges towards this ‘expert’ perspective, or (iii) flagged up the significance of how best to interpret registered design representations as the starting point of the comparison, (iv) or else identified internal contradictions within the informed user construct, situated somewhere between the subjects of patent and trade mark law. The best candidates proposed achievable reform options within the existing legal framework. On the whole, this was well answered.

Question 5

This essay question required candidates to assess whether an open-ended defence is required for either copyright or trademark law. It was heartening to see several candidates attempted this question, which drew forth a range of views and perspectives including some very thoughtful answers. Most candidates argued against the introduction of an open-textured ‘US fair use’ style defence. For **copyright**, some candidates astutely pointed to the limited room for manoeuvre, by way of the (legacy) constraints in the Infosoc Directive and the TRIPS three step test. One candidate took a courageously contrarian view, arguing that human rights law may force a reconsideration of these outer limits. Some of the better answers looked to expand the scope within the home grown ‘public interest’ defence, the quotation defence and the flexibility afforded by the suite of ‘fair dealing’ defences more generally. By contrast, weaker answers overemphasised the causes precipitating the need for new defences (new social and commercial reuses of existing works in the digital context; the lowering of subsistence thresholds; broad rights such as communication to the public). For **trade marks**, there were a range of equally creative responses. Some set out the existing defences (i.e. there was a sufficient ‘defences’ component to the answer) before turning to assess the potential to balance interests by modulating the scope of infringement – for example, by not presuming harm to trade mark functions too readily. Other good answers looked to the lessons that might be drawn from the new referential use defence, the need to reinterpret the ‘honest practices’ proviso, or drew inspiration from ‘due cause’ in the dilution context. One of the best answers considered both sets of defences horizontally, arguing that there was no point in having more generous defences in copyright if trade mark law could be used to prevent a parodic use. The candidate suggested ways in which both regimes may be encouraged to march in synch.