

FACULTY OF LAW
POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW
AND PRACTICE 2018-19
Examiners' Report 2019

Part I

A. STATISTICS

(1) Numbers and percentages in each class/category

Category	2019		2018		2017		2016	
	No	%	No	%	No	%	No	%
Distinction	9	13.24	10**	14.29	8	12.12	10	16.13
Merit	21	30.88	n/a***	n/a***	n/a***	n/a***	n/a***	n/a***
Pass	34*	50.00	55****	78.57	57*****	86.36	48	77.42
Partial Fail	4	5.88	5	7.14	1	1.52	2	3.2
Fail	0	0	0		0		2	3.2
Total	68		70		66		62	

*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

(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 2019, a small number of scripts for coursework assessments were double marked to ensure consistency of approach between markers. Overall, 124 out of 324 coursework assessments (38.3%) and 43 out of 128 examination scripts (33.6%) were double marked in 2019.

No scripts were 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 merit award was introduced in 2019. This led to a change in the criteria for second marking, set out in the examination convention, as follows:

“For each paper, a minimum of 6 scripts, or 20% of the scripts, whichever is the greater number, will always be double-marked, as will:

- any script which the first marker found difficult to assess, and
- any script for which the first mark ends in 53, 54, 63, 64, 68, 69, and
- any script for which the first mark is below 50, and
- any written examination script where the candidate has misunderstood the question, and
- any written examination script which has an ‘absent answer’, that is a script which would formerly have been described as of ‘short weight’.”

In the view of the Board, the new merit award worked well. As appears above, 21 out of 68 candidates received a merit award, which was in line with expectations.

C. In light of concerns arising during the marking process in 2019, the Board recommends amending the examination convention to make clear what is, and what is not, good academic practice with respect to compliance with word limits in coursework assessment, and to set out the possible consequences of poor academic practice (including refusal to mark an assessment and/or reference to the Proctors).

The Board also recommends that the possibility of introducing checks to verify that word counts have been accurately reported be investigated.

The Board also recommends that coursework markers be allocated at least 10 scripts, in order to get a feel for the range of answers.

The Board will ask the course director/Diploma Management Committee to consider (a) the order in which the Patents 1 and Patents 2 modules are taught and assessed on the course, and (b) the use of a case list for the written examinations in 2020.

D. The proposed amended form of the examination convention, and a further Notice to Candidates, is attached to this report (Annexe 2).

Part II

A. GENERAL COMMENTS ON THE EXAMINATION

1. Second and third marking

See Part I.A(3) above.

2. Materials in the examination

Candidates are permitted, under strict conditions, to take into the examination room their own copy of the current edition (13th in 2018) 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 an additional document (see Annexe 2 – Notice to Candidates).

The Board will ask the course director/Diploma Management Committee to consider the use of a case list for the written examinations in 2020, as this is now common practice in undergraduate and other postgraduate examinations in the Law Faculty.

3. Legibility

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

4. Word limits in coursework assessments

Following concerns raised by a marker, the Board noted that a significant number of candidates had used devices which had the effect of reducing the word count in coursework assessments. These devices included the omission of spaces following full stops or before brackets, the use of slash (/), hyphen(-) and underscore (_) marks, and compressing case citations into a single word (e.g. *Smith-v-Jones*[2019]EWHC123(QB)). The Board considered such practice to be highly undesirable, but concluded that there was no further action that could be taken in the absence of clear guidance in the examination convention as to what was, and what was not, considered acceptable. The Board recommends amending the examination convention to make clear what is, and what is not good academic practice, with respect to compliance with word limits in coursework assessment, and to state the possible consequences of poor academic practice (including refusal to mark an assessment and/or reference to the Proctors).

The Board also noted that, in some instances, students had under-reported their word count for coursework assessments even if the use of devices was ignored. The Board noted the difficulty of routinely checking whether word counts could be accurately reported, due to the use of PDF format but recommends that the matter be further investigated to see if a technological solution is possible. If not, the Board recommends that random checks be carried out in 2020, and that the under-reporting of word count be treated as academic misconduct (to be dealt with as above).

5. Patents 1 and Patents 2 Modules

The Board discussed whether the Patents 1 module and assessment imposed a disproportionately large workload on students in comparison with the Patents 2 module, concluding that it was less of a workload issue but more of a question whether it would be preferable for the students to start with Patents 2 rather than

Patents 1. The Board agreed to take this to the Diploma Management Committee for further discussion.

6. External Examiner

Dr. Naomi Hawkins joined the Board as our External Examiner. She was fully involved in every part of the examination process and was very helpful to us; we are very grateful to her. Dr. Hawkins has submitted her examiner's report separately.

7. IPLA Examiner

We are also very grateful to Mr. Robert Anderson of Hogan Lovells who steps down this year after many years of service to the IP Diploma, including as a member of the Board.

8. Assessors

In addition to the examiners, 32 colleagues were assessors. This number is made up of 29 professional colleagues and includes 3 academic colleagues, one of whom was from another university. We are very grateful to them for their commitment to the effective functioning of the IP Diploma.

9. Diploma Administrator

Mrs. Ellen Moilanen is in charge of all aspects of the Diploma and is the first port of call for everyone involved, examiners, assessors and candidates. That the Diploma runs efficiently and smoothly is very largely down to her, and the Board (and, in particular, the Chair of Examiners) are very grateful for all that she does

B. EQUAL OPPORTUNITIES ISSUES AND BREAKDOWN OF RESULTS BY GENDER

Category	2019				2018				2017				2016			
	Male		Female		Male		Female		Male		Female		Male		Female	
	No	%	No	%	No	%	No	%	No.	%	No.	%	No.	%	No.	%
Distinction	3	10.00	6	15.79	5	18.5	5	11.63	4	12.12	4	12.12	3	12.5	7	18.42
Merit	8	26.67	13	34.21	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a	n/a
Pass	19	63.33	15	39.47	19	70.38	36	83.72	29	87.89	28	84.85	18	75	30	78.95
Fail	0	0.00	4	10.53	3	11.11	2	4.65	0	0	1	3.03	3	12.5	1	2.63
Total	30	44.12	38	59.38	27	38.57	43	61.43	33	50.00	33	50.00	24	38.71	38	61.29

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	16	23.19	30	43.48	12	17.39	11	15.94	0	0.00	69
Patents 2	10	15.38	21	32.31	21	32.31	13	20.00	0	0.00	65
Trade Marks and Passing Off	14	21.54	18	27.69	17	26.15	15	23.08	1	1.54	65
Copyright	12	18.46	22	33.85	16	24.62	14	21.54	1	1.54	65
Designs	11	17.19	19	29.69	22	34.38	12	18.75	0	0.00	64
Intellectual Property I	9*	14.06	21	32.81	17	26.56	16	25.00	1	1.56	64
Intellectual Property II	13	20.31	27*	42.19	17	26.56	6	9.38	1	1.56	64

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

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 3.

Professor A. Dickinson
Mr. R. Anderson (IPLA)
Dr. D. Gangjee
Dr. N. Hawkins (External)

Annexe 1 – Reports on individual papers

Annexe 2 - Examination Convention and Notice to Candidates (marked to show proposed changes)

Annexe 3 – 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

Most candidates dealt well and succinctly with the several quite intricate issues arising from the scenario, not just as to the identity of potential defendants, but also as to which items and which acts infringe which claims. The standard of the answers was generally high. A few specific points arising are set out below.

1. A claim chart is normally useful when getting engaged in patent litigation; even the act of drawing one up can focus your attention on the integers of the claims. And a claim chart is particularly useful in this case – with a number of potential defendants, two separate infringing systems and a variety of possible infringing acts under Section 60. Some answers could have been improved by using a claim chart.
2. The MMQ system raises a number of issues. It is a pre-existing item adapted for use in a system that might infringe the patent. Simply keeping the MMQ in unfitted form cannot be an infringement. Offering it could arguably fall within Section 60(2) with appropriate “knowledge” on the part of the supplier.
3. The facts support various allegations of common design. Whether it is worth a claimant shouldering the additional burden of proving joint tortfeasorship is a question of tactics and cost/benefit, but the possibility should be mentioned in the answer. There is some overlap between common design and the facts that would support an allegation under s.60(2).
4. Question 2 allows for a range of different approaches and different conclusions. A good answer will identify the fact that there is a variety of possible arguments on infringement. Question 2 specifically leaves validity out of issue. All subsidiary claims are dependent on Claim 1, and answers should make it clear that the infringed claim must have all the features of Claim 1, and any other claims on which it is dependent. The concept of claim dependency is an important one.
5. The angle at which the MMQ would be set raises a number of issues. Reference to the specification is helpful. The claims have to be interpreted in the light of the description and drawings (s.125). In the context of whether the MMQ device infringes, paragraph [007] of the specification could be referred to. There is no absolute right or wrong answer; the candidate should demonstrate an understanding of the problems of construction, and the application of that construction to a particular design of window opening. For example, in the MMQ, the window is tilted in the opposition direction to that shown in the Figures. Thus, assuming that the relevant opening is at the front then the angle is probably around 200°, but certainly more than 60°, in which case there is no infringement of Claim 3.
6. The second design, with the curved baffle in the roof, raises different issues of construction. For example, does the curved baffle have the required “angle”, and does it produce the same result and operate in the same way? A good answer would, as many did, bring in a reference to the recent *Actavis* decision, and should refer to paragraph [008] which arguably extends the definition of “window”.

7. As to the prior art, the MMQ was at a public exhibition in May 2012, before the priority date of 4 June 2012. The magazine, even though it was later, would at least be evidence of that public prior use, even though not a citable item in its own right. Running the MMQ as prior art raises similar issues of construction to those that would arise under infringement. Here though, the current state of play seems to be that the *Actavis* equivalence test would not be applied to prior art cited for lack of novelty. The prior art would simply be looked at purposefully. A car is a moving vehicle so Claims 1 and 2 are arguably anticipated.
8. Most dealt well with the prior outing of the train in June 2011. The main issue is confidentiality – whether the employees were told to keep what they learnt from their trip confidential. If not then at least Claim 1 would be anticipated.
9. Various questions arise on the Boating World article. The actual subject matter is well away from the specific disclosure in the patent, but claim 1 is broad. A boat is a vehicle, and the cooling requirement is not specifically restricted to air; the word “window” could arguably be given a wide interpretation in the light of paragraph 008.
10. Conard is intended to stop smoke coming through the window, so it would not disclose a device “for cooling”. But evidence might show that there was some cooling effect. The word “for” in a patent claim means in most case “suitable for” but Claim 1 contains no limitation as to whether the flap is forward or rear of the window.
11. There is not a lot to go on for an obviousness attack. If lack of inventive step is mentioned it should be dealt with separately from lack of novelty. They are two different concepts.
12. Insufficiency based on the preferred ranges of angles might have some traction, but an embodiment that works badly might still be enough to be sufficient.
13. In answering question 4 on improving the patentee’s position, most candidates focused well on the possibility of amending the claims. It is fundamental that amendments should not introduce matter that is not disclosed in the specification, and should not broaden the scope of protection. If it is thought that Conard anticipates, then amending down to Claim 2 could cure that. If Claim 1 is too broad and covers devices that do not work at all in terms of cooling, then a limitation down to the angles in the range of 20° - 60° could cure that. If Boating World is a problem, then there could be amendments to limit Claim 1 to railway carriages, and to cooling air rather than water, both of which are disclosed in the patent and could feasibly be brought into claim 1 without adding matter.
14. Another point on improving the position which was picked up by many candidates is to advise against suing on the MMQ device at all, to avoid a squeeze on validity. Suing on it could be an own goal.

Patents 2

Introduction

This was a relatively straight-forward problem addressing a patent for a new design of coffee cup. It drew inspiration from the celebrated Haberman v Jackal case from the later 1990s. The aim was to enable all candidates to demonstrate a good working knowledge of the basic principles whilst enabling stronger candidates to address some more challenging issues. Certain parts of the chronology, for example the date or dates of supply of stainless steel rings by Monkseaton Metals Limited (“MML”) to Cullercoats Cups Limited (“CCL”), were left imprecise so as to enable candidates to speculate as to whether the date or one of the dates of supply was prior to the publication for the application for the patent (31.10.17). Many candidates picked up these points nicely.

Construction and Infringement

Most candidates identified that there were three product claims and one process claim. Most candidates picked up that “for” in the context of a patent claim will generally mean “suitable for” and thus the purpose would not save the claim if that were all that differentiated it from the prior art.

Some candidates also picked up that the integer “connected metal rings” in Claim 2 is not well explained in the specification of the patent.

Claim 3 which is directed to titanium rings is arguably not infringed by the supply of stainless steel rings. It remains an unresolved area of law in the UK post Actavis whether if the specification mentions as possible options A, B and C but the claim lists e.g. only C, A and B are thereby excluded. Not many candidates argued the issue as well as the setter had hoped.

In terms of the Defendants, clearly CCL was to be a Defendant. The factual matrix pointed towards MML as an indirect infringer although several candidates elected not to include MML – at least at this stage – because of doubts over the timing of the supply and also because of MML’s potential as a supplier to Segedumun Supplies Limited (“SSL”). There was no right or wrong answer to this issue.

Although technically each was undertaking infringing acts, it was not intended that Dec’s Deli or Jane Louise should be named as defendants as SSL wanted to continue to do business with both. There was probably not enough on the facts to include the officers of CCL or MML as defendants individually.

In terms of infringing acts, all candidates recognised that CCL were undertaking infringing acts pursuant to Section 60(1)(a) of the Patents Act. They were offering the process of claim 4 contrary to Section 60(1)(b) and also supplying or offering to supply means essential contrary to Section 60(2). Most candidates identified the differences in knowledge between the two although not many candidates pleaded the particulars of knowledge particularly well.

Most candidates included MML as a second defendant for supplying means essential with the relevant knowledge which was telegraphed in the fact pattern.

Invalidity

The first issue to address was entitlement to priority. A problem was teed up in the fact pattern that the priority document was filed in the name of Dr Mandal and yet the application as filed was in the name of CCL. Since CCL was established as a vehicle for Dr Mandal’s business, it was envisaged that candidates should acknowledge the problem and explore the law of

equitable assignment as set out in e.g. HTC v Gemalto. Not many candidates did this although almost all picked up that priority was an issue.

With entitlement to priority in doubt, the setter had hoped that candidates would plead the challenges to validity in the alternative. Some but not all candidates did this.

If the patent was not entitled to priority, then validity would be assessed at 31.8.17 which would bring into play an exhibition of the patented product at Gosforth Park Hotel. This would almost certainly be novelty destroying even though the single member of the audience did not speak good English (see e.g. Lux v Pike).

Whether or not priority is maintained, Claim 1 of the patent will be anticipated by the Haberman Cup described in prior art reference B because of the meaning of the words "suitable for" in English patent law as described above (see e.g. Adhesive Dry Mounting v Trapp and more modern cases along the same lines). There is a good argument that all claims are in fact obvious over B if prior art C (the IKEA cup) is representative of the common general knowledge. The invention really lies in a combination of B and C but mosaicking for inventive step is generally impermissible absent an express reference or some other pointer towards combining two references. Prior art A was probably not worth pleading in the circumstances.

Another validity plea worth making was the disclosure from Mandal to Porter on 5 August 2016 although query whether this was in confidence.

The disclosure from Porter to Pearce later in August 2016 is also worth pleading and the stronger candidates noted that Section 2(4) which provides a grace period appears to be directed to the filing date of a patent application and not the priority date. Thus, it would not apply to the facts at hand.

Some candidates raised various grounds of insufficiency which was not surprising given the rather cursory and vague description in the specification.

Trade Marks and Passing Off

Overview

The coursework was based on a premium brands business encountering various trade mark problems.

Students were generally compliant in focusing their answers on trade mark law and litigation strategy, and indicating in their answers what further advice and information might be needed.

Papers were generally well-structured and easy to follow, although some were not. The better papers showed a strong application of the law to the facts, and gave concise strategic answers.

Question 1

This question had the most marks and nearly all candidates quite rightly focused their efforts on answering it fully. Candidates generally set out the *Interflora* conditions and then applied those to the facts. Candidates picked up on the fact that the mark covering spirits etc was likely to have a reputation but the better candidates queried whether that would be supportable in light of the restricted distribution and sales. Very good candidates queried whether DD's use was in relation to retail services, as opposed to the alcoholic products themselves, and then considered similarity of goods/services.

Most candidates fairly covered possible trade mark defences and passing off, including picking up the potential price differential between the two parties and citing the *Moroccanoil* case.

Strategy was generally well covered, including a possible interim injunction application. On irreparable harm, better candidates mentioned the potential loss of a contract with Nola and whether the association of the brand with a cheap outlet would irreparably damage the brand's carefully cultivated luxury aura. There was little mention of the ability to give a cross-undertaking in damages, which is an important factor to take into account when advising clients.

Most candidates were able to set out the pros and cons of High Court versus IPEC, but not all gave an opinion on which forum would suit the parties/facts best. Good candidates also covered off the WIPO UDRP procedure and set out the pros and cons of that route.

Question 2

Most candidates easily covered off the law in this area and the major cases on false endorsement. Some candidates recognised the difficulties posed in proving goodwill in the name of a social media influencer and that further information would be needed. Better candidates picked up on the fact that each sentence of BBL's proposed advert is true – so queried whether this would amount to a misrepresentation.

Question 3

Most candidates were quick to find that the marks were similar, although this was an issue worthy of deeper consideration. Generally candidates did not query whether use of the trade mark on 'hats, gloves and scarves' would be sufficient to maintain a specification of 'clothing' and simply assumed it would. That meant they did not address whether the narrowed specification would be regarded as similar to footwear. Good candidates questioned whether there was enough information to determine whether the EUTM had a reputation, but in any event queried whether the relevant types of injury (unfair advantage, tarnishment, dilution) would really occur in this scenario.

Question 4

Some candidates skipped straight to exhaustion of rights without first stating that this was a case of identical marks used on identical goods, so prima facie infringement. Most candidates cited the *BMS conditions* and applied those to the facts. Few candidates queried whether the *BMS conditions* would apply to a non-pharma case. Some candidates picked up on the fact that arguably BBL operate a selective distribution arrangement and mentioned the applicability of the *Copad v Christian Dior* case.

Copyright

Overview

The coursework was based on two photos and the shadow puppets depicted in them, and an art book containing instructions on how to make other shadow puppets.

Students were told to focus their answers on the Copyright Designs and Patents Act 1988, and to indicate in their answers what further advice and information might be needed. Students took this instruction in different ways, with some pointing in general terms to what further advice and information would need to be sought, and other students looking in depth at points outside the CDPA itself.

Students were not penalised for indicating where need arose for further information and advice outside the CDPA, without more. Nor were they penalised if their own research outside the CDPA had led to errors or misunderstandings.

Students were however expected to consider the rights which might arise in the puppets depicted in the photographs, which might need to be taken into account by WorldArt when doing more than merely exhibiting those puppets.

Papers were generally well-structured and easy to follow. The better papers showed a strong application of the law to the facts, and kept a strong commercial eye on how WorldArt might achieve its aims.

Question 1

The question was generally reasonably handled. Students recognised the rights which might arise, the author/owner of them, the need to consider how UK copyright might arise in relation to works by non-UK authors, and how WorldArt might infringe if unauthorised copies, or partial copies, were made. Good suggestions were made as to how to acquire the necessary rights to use the works as WorldArt wished.

Some issues raised by the question required information and advice beyond the CDPA. Where students sought to tackle these, common areas of difficulty arose, particularly as to how, if at all, the works might qualify for UK copyright, and the duration of copyright in works created before the CDPA came into force. As noted, students were not penalised if they got these issues wrong.

Question 2

Again, this was generally well handled. Students generally recognised that if WorldArt were to reproduce the instructions themselves, or part of them, they would need consent from the author. There were good discussions as to originality, substantial part, and the possibility of re-writing to avoid infringement.

There were also good discussions as to whether or not using (very simple and broad-brush) 2D instructions by making either new shadow puppets or a (different) stage would infringe, s51, and the idea/expression debate. Students spotted the possible defences which might be available, and how WorldArt might benefit from them.

Question 3

The question covered a number of different works, authors and activities and again was generally well-handled. Students were particularly asked to consider rights in the moves the

shadow puppets made, and the shadows they threw. This led to some well-argued thoughts, particularly as to whether the shadows might themselves be “works” or whether they might be protected as part of a larger dramatic work.

There was some confusion as to the distinction between a script as a literary work, and its more probably status as a recording of a dramatic work. And some students seemed not to have understood that a film, if a dramatic work per se, is capable of performance by being shown.

Question 4

A number of students handled this question very briefly, sometime in only a couple of paragraphs, perhaps for word count reasons. However, some missed a number of the rights concerned altogether, and lost marks as a consequence.

Good answers considered the rights which might arise in the photos, written descriptions, object details, catalogue layout and the catalogue’s status (or not) as a database. Ownership of those rights, particularly difficulties arising from the involvement of an unpaid intern, were well-handled. As stated above, marks were not deducted if students indicated that database rights might arise, though not under the CDPA.

Designs

To be added

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 noticeable increase in number of candidates achieving a mark of 70% or above (Distinction), from 10% in 2017/18 to 14% in 2018/19. This year saw the introduction of a Merit Award for marks between 65-69%, with 33% of candidates falling into this category. The average mark achieved in Part A = 64% and in Part B = 63%.

As per previous reports, there is a general tendency for candidates to either fail to state the relevant legal authority or only mentioning it in passing without demonstrating knowledge of the legal principle/s arising from the case. Surprisingly, this year there was also a number of scripts that referred to the 'EU' rather than the 'EPO'. This error had a negative impact on the marks awarded.

Part A

The 'essay' section of the paper saw the vast majority of candidates opt to answer question 2 (51) over question 1 (13). The average mark for question 1 was slightly lower (63%) than the average mark for question 2 (64%).

General observations:

- a) Once again, it was pleasing to see candidates engage with the academic materials provided on the reading list. It was also clear that many had conducted research (or had experience of issues) beyond that required by the reading.
- b) Scripts that achieved a merit or above in Part A were those that critically engaged with the question being asked. Unfortunately, too many responses merely provided a descriptive account of the relevant case law with little if any attempt to link the material back to what was actually being asked. As will be discussed below, this was more of a problem for Question 2 than Question 1.

Question 1

This question provided an opportunity for candidates to examine the current legal position on intention as a requisite for establishing infringement, and the normative bases, if any, for such a requirement. As expected, most essays highlighted that an intention is not a relevant factor in most instances of infringement. Many responses also took into account the possible distinction between *knowledge* and *intent* when considering infringement under s60(1)(b) and s60(2). Several candidates also examined purpose-limited claims, thereby bringing discussion of e.g. *Mobil* and the recent decision in *Warner-Lambert*. The essays marked at the higher end of the scale fully engaged with the proposition advanced in the question to argue whether or not patent infringement *should* be an intentional tort. Arguments related to accidental infringement or the more practical problems highlighted in the *Warner-Lambert* litigation were often advanced, as were links to the disclosure or notice requirement of the patent system.

Question 2

Given the number of cases listed, this question allowed candidates plenty of choice on how to respond. Weaker answers merely demonstrated an understanding of the case law and provided a limited discussion of the impact on the applicable aspect of UK patent law. Better responses went further to provide a more detailed critique of the respective rulings. However, it was noticeable that a significant number of answers failed to fully engage with the whole question. Greater marks were, thus, awarded to candidates that directly addressed the second sentence of the quote. All credible and supported arguments for and against the proposition were accepted. Some responses simply highlighted the distinction between the pro-patentee and pro-user decisions. Better responses engaged more deeply with this distinction to analyse whether or not it did in fact evidence a lack of policy direction by the House of Lords/Supreme Court.

Part B

The 'problem' section of the paper saw the majority of candidates opt to answer question 3 (42) over question 4 (22). The average mark achieved on both questions was the same - 63%.

General observations:

As was mentioned in last year's Report, it was noticeable that knowledge of, what may be seen by candidates as, the more peripheral aspects of the Residential Programme was often weak. As will be discussed below, few responses provided a convincing account of the law of Breach of Confidence or patent amendment.

Question 3

Approximately two-thirds chose to answer this question, which required candidates to explore the law in several areas - infringement (direct and indirect), sufficiency/AgrEvo Obviousness, methods of medical treatment, amendment. The question set out two claims – a product and a process. However, many answers failed to separate the claims where required which resulted in some confusing analysis and missed marks. The question was divided into two parts – (a) and (b)

- (a) The discussion of infringement by Titus and DWW was generally dealt with well. Candidates demonstrated a sound knowledge of the law of construction. While indirect liability under s60(2) was also applied well, supporting case law was not always adequately presented.

The validity of the patent required examination. The first issue presented was the potential inability of claim 1 to achieve its stated technical effect – enhancing performance. Most candidates recognised this problem and addressed the issue as one of either insufficiency or AgrEvo obviousness (plausibility). The response to this issue were generally of a good standard with many demonstrating a detailed understanding of some of the complexities/uncertainties in this area. However, few answers separately considered the potential impact of Titus' trial on claim 2, i.e. is claim 2 actually excluded as a method of medical treatment (thus linking to part (b) of the question?). Many candidates correctly challenged the validity of claim 1 by analogy with the facts in *Actavis v ICOS*, i.e. that the combination of known ingredients lacked an inventive step as being 'obvious to try'. Several candidates also considered whether the experimental use defence in s60(5)(b) was available to Titus.

- (b) This section was covered less well. Most candidates identified that it may be advisable to amend the claim to avoid revocation as being a method of medical treatment. However, most answers failed to provide a detailed understanding of the law relating to amendments and disclaimers. There was also a noticeable lack of legal authorities in the answers to this element of the question.

Question 4

This question focussed on the patentability of two computer-implemented inventions, inventorship, entitlement, and the law of confidence. Candidates were asked to advise *all* relevant parties.

The question of whether both inventions related to excluded subject matter was addressed by most candidates. Again, a good understanding of the relevant case law was demonstrated.

The issue of novelty was a relevant consideration for the patentability of both inventions. Again, this element of the question was covered well with virtually all candidates discussing the exception to absolute novelty provided by s2(4)(a) – disregarding disclosures in breach of confidence. However, few candidates explored the law of confidence to determine whether or not Amy’s disclosure was actually in breach. Many responses merely made a passing reference to *Coco v Clark* without exploring the necessary elements set out in the case. In questioning the novelty of Ethan’s invention, it was necessary to determine if it fell within the scope of the Reba/Lori invention. Many answers correctly noted that the doctrine of equivalents is not applicable when assessing novelty.

Inventive step was also considered by many candidates and was of particular relevance to Ethan’s application. The majority of those that considered this issue correctly noted that the Reba/Lori application was not prior art for the purpose of assessing obviousness. However, the disclosure of the Reba/Lori invention to Amy and her friends may well have been. The Windsurfing/Pozzoli principles were stated and applied by the vast majority of those that addressed this point.

The issue of who is the ‘inventor’ of the respective inventions was a point that was often omitted from the analysis. The question of entitlement was more widely considered, but the scope of this analysis (i.e. who may be entitled to claim ownership) depended on firstly identifying who the actual inventor was. Again, while most candidates demonstrated a broad understanding of the relevant principles, few made adequate use of the case law in their analysis.

Intellectual Property II

This year 64 candidates attempted the IP II paper. Following the established rubric, there were four questions for this paper, of which candidates were required to answer two: one essay and one problem question. Essay questions can be primarily focused on any of the three core areas for IP II: copyright, trade marks and passing off or designs. This year, the essay questions related to design law and copyright law respectively. While both questions were attempted, the majority of candidates (53) favoured the design essay. One problem question involved copyright issues while the other raised questions of trade mark law. Trade marks was the preferred problem question. The quality of answers to all questions was generally good. It

was pleasing to observe that, having gained experience with course-work problems over the year, candidates adopted a systematic approach to problem questions.

Q1. The design essay provoked candidates to consider whether the UK Unregistered Design Right (UKUDR) was still relevant, given the several other layers of registered as well as unregistered protection available within design law. This was the most popular question in the paper, with candidates almost universally arguing in favour of its retention and justifying this with both substantive as well as pragmatic reasons. Examples of the attractive breadth of the UKUDR included qualifying subject matter (any aspect of shape or configuration, whether internal or external), excluded subject matter (method or principle of construction), its duration and scope of protection. Better answers revisited its origins and underlying policy basis, to evaluate whether these objectives had been met in the intervening years. Several answers also referred to case law where UKUDR claims succeeded despite rights in registered designs found to not have been infringed.

Q2. The copyright essay proved less popular but those who attempted it tended to be successful. More perceptive answers reviewed the doctrinal broadening of the requirements for copyright infringement by communication to the public. Criteria that were explored included 'an act of communication of a work' which transitioned from a transmission of a work to almost any deliberate intervention, as well as the 'new public' requirement. Better essays investigated whether this amounted to constructing a harmonised European regime for (primary) intermediary liability since secondary or accessory liability for intermediaries remains unharmonized across EU member states.

Q3. Those who attempted the copyright problem question identified most of the major issues in each of the scenarios. In the first scenario, one of the conceptually difficult issues was whether a photographer could 'infringe' their own previous photograph by selling the original to someone else and subsequently taking a similar photo. More astute candidates addressed this via the idea/expression distinction or whether the reproduction included a substantial part. No one addressed whether s 64 of the CDPA 1988 applied. Better answers also considered whether s 23 applied. For the second scenario, most candidates appropriately invoked *Infopaq* and *Levola* when considering whether the 'look' of a dish could be protectable and also considered whether a 2D reproduction of a 3D dish would be infringing. However the defences analysis was often perfunctory.

Q4. The trade mark problem required candidates to conduct infringement analysis, considering whether double identity, likelihood of confusion or (potentially) dilution applied. The test for composite or complex marks was relatively underdeveloped, as was the potential for arguing that the senior mark Smart was weakly distinctive (or that both marks overlapped in an element which was weakly distinctive). As regards dilution, only one candidate astutely argued that while Daimler was clearly indicated to be reputed, there was nothing to indicate that the prior mark Smart had a reputation. The dissimilarity of products was expected to be addressed in the case of AAA, while the defences were adequately addressed, including – for AAA – the recent shrinkage of the own name defence to just personal names. The three dimensional mark scenario called for an assessment of both distinctiveness – including the vexed question of whether mere longstanding association would qualify as acquired distinctiveness (*Kit Kat*) and whether the essential characteristics or features of the shape

were necessary to produce a technical result (or fell within any of the other two policy exclusions).