**FACULTY OF LAW**

**POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW AND PRACTICE 2022-23**

**Examiner’s Report 2024**

**PART I**

**STATISTICS**

**A.**   
  
(1) Numbers and percentages in each class/category

|  |  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- | --- |
| Category | Number | | | | Percentage (%) | | | |
|  | 2023/24 | 2022/23 | 2021/22 | 2020/21\* | 2023/24 | 2022/23 | 2021/22 | 2020/21\* |
| Distinction | 23 | 16 | (15) | (16) | 27.7% | 20.5 | (18.07) | (25.53) |
| Merit | 31 | 21 | (27) | (22) | 37.3% | 26.9 | (32.53) | (32.35) |
| Pass | 26 | 39 | (33) | (19) | 31.3% | 60 | (39.76) | (27.94) |
| Partial Fail | 3 | 2 | (5) | (10) | 3.6% | 2.5 | (6.02) | (14.71) |
| Fail |  | 0 | (2) | (1) | 0.0% | 0 | (2.41) | (1.47) |
| Total | 83 | 78 | (83) | (68) |  |  |  |  |

\* The assessment regime and criteria were substantially altered in 2020 and 2021 in response to the Covid-19 pandemic.

(2) If vivas are used:

Please include numerical detail of any vivas which were held, with an indication of the effect of any vivas on classes or results.

|  |
| --- |
| Vivas are not used in the IP Diploma |

(3) Marking of scripts

Please give details of scripts which are not double-marked.

Where scaling has been used, boards should record its use and provide detailed information

about why scaling was necessary and how it was applied. Please state whether qualitative checks were used where scaling has been employed.

|  |
| --- |
| Scripts are doubled marked according to the criteria in the examination conventions. Additionally, in 2023-24, 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, 170 out of 407 coursework assessments (41.77%) and 28 out of 79 examination scripts (35.44%) were double marked in 2023-24.  The Board did not consider that any scaling adjustment was necessary. |

**NEW EXAMINING METHODS AND PROCEDURES**

**B.** Please state here any new methods and procedures that operated for the first time in the 2023/24 academic year with any comment on their operation in the examination and on their effectiveness in measuring the achievement of the stated course objectives.

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| In recognition of the administrative challenges in monitoring compliance with word limits, the Board recommended that the Examination Conventions be amended to inform candidates that the word count of submissions will be checked by inputting the submitted text into Microsoft Word. The software will count bullet points, Roman numerals, and other elements.  However, the conversion of scripts from PDF to Word led to occasional issues in which sections of some scripts were duplicated, artificially inflating the word count. To address this, the Exam Board introduced an additional 10% leeway on the word count and applied penalties for scripts exceeding this new limit |

**C.** Please summarise any **future or further** changes in examining methods, procedures and examination conventions which the examiners would wish the faculty/department and the divisional board to consider. Recommendations may be discussed in further detail under Part II.

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| --- |
| **Submission of Word Scripts:** In recognition of the administrative difficulties in monitoring compliance with word limits, particularly after converting submissions from PDF to Word, it is proposed that scripts be submitted directly as Word documents to avoid such issues (subject to agreement from University bodies).  **Poor Academic Practice/Citations:** Several scripts per coursework were found to reduce their word count by not fully citing sources. It is proposed that the Examination Conventions and/or marker guidance be reviewed to introduce clearer penalties or adjustments in marks for such practices.  **Student Feedback:** The DMC is requested to review coursework guidance based on the following student feedback:   1. Some coursework assignment questions are difficult to navigate due to a lack of clarity. 2. Students raised concerns about the frequency and speed of clarifications and corrections, which, they felt, affected their assignments and led to substantial re-writing. The Board liaised with the markers about the issued raised and were satisfied that it did not impact any students’ performances. However the Exam Board encourages efforts to reduce the need for clarifications and to issue them as quickly as possible when necessary.   **Assignment Submission Time Change:** The submission deadline has been changed from 1 PM to 12 PM. This change is due to the fact that proctors consistently require all extensions to be submitted by 12 PM, leading to confusion among students who expected the deadline to remain the same as the original 1 PM submission time. As a result, automatic 5-point penalties were being applied. |

**D.** Please describe how candidates were made aware of the examination conventions to be followed by the examiners and any other relevant examination information.

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| --- |
| 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**

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| 1. **Second and third marking**   See Part I.A(3) above.   1. **Materials in the examination**   The examination, Intellectual Property I and II, was conducted on an open book basis.   1. **Legibility**   All examination scripts were typed.   1. **Word limits in coursework assessments and written examination**   The Board monitored compliance with the word limits for coursework assignments through the practice described at Part 1.B(1) above. Where a breach of the word limits prescribed in the Examination Conventions was identified, the Board applied the penalty for non-compliance set out in the Conventions.  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.   1. **Scaling Adjustments**   The Board did not consider that any scaling adjustment was necessary.   1. **External Examiner**   This year Professor Peter Harrison started as the External Examiner and was fully involved at all stages of the examination process.   1. **Internal Examiners**   Brian Cordery served for a fifth year and Thomas Krebbs first year as internal examiners. The Chair expresses her gratitude to both for their continued commitment and support during the examination process.   1. **Assessors**   In addition to the examiners, 37 colleagues acted as assessors. The Board is very grateful for their commitment and timely marking.   1. **Diploma Administrator**   This year, Rachael Harper took over as Diploma Administrator. |

**B.** **EQUALITY AND DIVERSITY ISSUES AND Breakdown of the results by gender**

|  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- |
|  | **2023-24** | | | | | | |
| Total | Male | % of Male | % Cohort | Female | % of Female | % Cohort |
| **All grades** |  |  |  |  |  |  |  |
| **Distinction** | 23 | 10 | 30.30 | 11.90 | 13 | 25.49 | 15.48 |
| **Merit** | 31 | 10 | 30.30 | 11.90 | 21 | 41.18 | 25.00 |
| **Pass** | 26 | 10 | 30.30 | 11.90 | 16 | 31.37 | 19.05 |
| **Fail** | 2 | 2 | 6.06 | 2.38 | 0 | 0 |  |
| **Incomplete** | 2 | 1 | 3.03 | 1.19 | 1 | 1.96 | 1.19 |
|  | **2022-23** | | | | | | |
| Total | Male | % of Male | % Cohort | Female | % of Female | % Cohort |
| **All grades** |  |  |  |  |  |  |  |
| **Distinction** | 17 | 8 | 25 |  | 9 | 19.56 |  |
| **Merit** | 19 | 9 | 28.13 |  | 10 | 21.74 |  |
| **Pass** | 38 | 13 | 40.62 |  | 25 | 54.35 |  |
| **Fail** | 2 | 1 | 3.12 |  | 1 | 2.17 |  |
| **Incomplete** | 2 | 1 | 3.12 |  | 1 | 2.17 |  |
|  | **2021-22** | | | | | | |
| Total | Male | % of Male | % Cohort | Female | % of Female | % Cohort |
| **All grades** |  |  |  |  |  |  |  |
| **Distinction** | 15 | 7 | 21.88 |  | 8 | 15.69 |  |
| **Merit** | 26 | 8 | 25 |  | 18 | 35.29 |  |
| **Pass** | 35 | 13 | 40.62 |  | 22 | 43.13 |  |
| **Fail** | 6 | 4 | 12.50 |  | 2 | 3.92 |  |
| **Incomplete** | 1 |  |  |  | 1 | 1.96 |  |
|  | **2020-21** | | | | | | |
| Total | Male | % of Male | % Cohort | Female | % of Female | % Cohort |
| **All grades** |  |  |  |  |  |  |  |
| **Distinction** | 16 | 6 | 19.35 |  | 10 | 27.02 |  |
| **Merit** | 22 | 14 | 45.16 |  | 8 | 21.62 |  |
| **Pass** | 19 | 8 | 25.80 |  | 11 | 29.73 |  |
| **Fail** | 10 | 3 | 9.68 |  | 7 | 18.92 |  |
| **Incomplete** | 1 |  |  |  | 1 | 2.70 |  |

[Chairs of examiners should include in the reports of their boards a commentary on any general issues relating to questions of equality and diversity, and of special educational needs (comments which might identify individual candidates should be confined to section E).

A breakdown of the results by gender for both the current year, and at least the previous 3 years should always be supplied, so that it is possible to track systematically gender differences in examination performance. In small cohorts this breakdown by gender may be omitted to maintain confidentiality. Where there is a noticeable gap in attainment between genders, boards are encouraged to place the breakdown of results by gender in Section E of the report, to avoid the risk that the data reinforces negative stereotypes regarding gender performance, in a context where students are using examiners’ reports as part of their examination preparation.

This section of the report should also include comments on the effect of different methods of assessment (e.g. problem questions, extended essays, essay papers) on any observed differences.]

**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 | % | No | % |  | | Patents 1 | 38 | 46.34 | 27 | 32.93 | 10 | 28.57 | 5 | 12.12 | 2 | 2.44 | 82 | | Patents 2 | 5 | 6.17 | 28 | 34.57 | 20 | 24.70 | 28 | 34.57 |  |  | 81 | | Trade Marks and Passing Off | 20 | 24.70 | 22 | 27.16 | 20 | 24.70 | 18 | 22.22 | 1 | 1.22 | 81 | | Copyright | 19 | 23.75 | 19 | 23.75 | 34 | 42.50 | 7 | 8.75 | 1 | 1.25 | 80 | | Designs | 16 | 19.28 | 18 | 21.69 | 24 | 28.92 | 16 | 19.28 | 2\*\* | 2.41 | 83 | | Intellectual Property I and II | 10 | 12.66 | 30 | 37.97 | 28 | 35.44 | 11 | 13.92 |  |  | 79\*\*\* |   *\*All data points have been taken post application of any academic penalties*  *\*\*MCE under consideration – result may change*  *\*\*\* 2 students didn’t sit exam* |

**D. Comments on papers and individual questions**

|  |
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| These appear in Annex 1. |

**E. comments on the performance of identifiable individuals and other material which would usually be treated as reserved business**

[This part must be physically separate, and must be detached from the version of the report sent to JCCs and to college and departmental libraries. It should be retained for **one year** only after the final exam board.

Include in this section the total number of mitigating circumstances notices to examiners received and the number of candidates for whom the notice had a material impact on their results and/or classification. The total number of candidates who received a ‘Declared to Deserve Honours/ Masters’ degree should also be included.]

|  |
| --- |
| These appear in Annex 2. |

**F. NAMES OF MEMBERS OF THE BOARD OF EXAMINERS**

|  |
| --- |
| Dr Joanna Bell (Chair of Examiners)  Brian Cordery (IPLA) (Internal Examiner)  Prof. Thomas Krebs (Internal Examiner)  Prof. Peter Harrison (External Examiner) |

**Annexe 1**

**COMMENTS ON PAPERS AND INDIVIDUAL QUESTIONS**

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

1. **Coursework assessments**

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## Patents 1

1. *Infringement (30 marks)*
   1. *Outline the law of infringement, including literal[[1]](#footnote-1) infringement and infringement by equivalence (5 marks).*

Examiners were looking for:

* Normal interpretation (literal, purposive) through eyes of PSA, and
* Actavis/modified Improver questions
  + Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, ie the inventive concept revealed by the patent?
  + Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?
  + Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?
* Characteristics and qualification of PSA: uninventive, works in the area, has the knowledge of the common contemporaneous technology.
  1. *Does the ePhone 15 infringe each claim of GB 2334455B (the Poldark patent) under either a literal or equivalence approach? Draw up a claim chart for each claim of the patent, dividing each claim into integers, and use this to explain the reasons for your answer. Assume for this question that every claim of the patent is valid as granted (5 marks per claim).*

Most candidates used a claim chart, which was a sensible approach. Claims 2, 4, 5 are likely infringed. 1 and 3 are not. Note that all of this is arguable: candidates who demonstrate an understanding of the tests and the technology, but reach a different conclusion, were given marks.

| Claim | Element | Normal | Equivalence |
| --- | --- | --- | --- |
| 1 | **Mobile communication terminal**  **comprising a USB port and USB lead capable of connecting to the USB port of a laptop computer,**  **the USB port providing both power and connectivity,**  **the mobile communication terminal capable of being used both for communication**  **and as a wired computer mouse**  **with functional mouse buttons.** | We don’t know whether the ePhone could be used as a wired computer mouse.  So, we cannot say infringed on normal basis.  (strictly, we also don’t know whether the ePhone15 has a USB port) | Probably not. Actavis questions.  The ePhone 15 is probably not achieving “substantially the same result” because it utilises only one of the two benefits of the ”wired mouse” invention: it is not receiving power.  The third question: strict compliance…. Possibly yes (as Claim 2 addresses the wireless solution, so claim 1 is intentionally limited to the wired invention) |
| 2 | **Mobile communication terminal**  **comprising Bluetooth connectivity capable of connecting to a Bluetooth-compatible laptop computer,**  **the mobile communication terminal capable of being used both for communication and as a wireless computer mouse**  **with functional mouse buttons.** | Yes (easy 5 marks).  Candidates may question whether the ePhone 15 is capable of being used both for communication and as a wireless computer mouse because it does not expressly say that. The fact pattern describes everyone using their phones as hotspots, and it would be a retrograde step if the ePhone 15 could not do both. | N/A |
| 3 | **Mobile communication terminal according to claim 1 or 2,**  **characterized in that the mobile communication terminal can utilise its camera application using the downwards facing camera and LED light,**  **or upwards facing camera,**  **or both in combination,**  **so as to detect movement of the mobile communication terminal when used as an optical computer mouse.** | The patent attorney puts tape over the cameras of the ePhone 15 and it still functions, so we know that they are not being used .  (Some candidates suggested that cameras could still be being used in the alternative when not taped over, i.e. the device is switching between cameras and the accelerometer. This is theoretically possible, and if so would fall within the claim, but we have no evidence to assert that)  Note that this claim is “or”. There is a claim construction argument about whether the claim requires the device to be capable of all three options (downwards, upwards, both), or whether a device which does just one of those things falls within the claim. | Actavis questions  If it is using accelerometers, that is probably not equivalent.   1. Not substantially the same way 2. Not obvious to the PSA 3. Accelerometers are described in the spec but not included in the claim: suggestive that compliance intended. |
| 4 | **Mobile communication terminal according to one of the preceding claims, characterized in that the mouse functionalities, in particular the mouse buttons, are provided on the touch screen of the mobile communication terminal.** | Yes  (What are the “mouse functionalities”? they appear in line 203 and 214, and physical mouse buttons are an example. A scroll wheel might be a third example of a “mouse functionality”, but doesn’t appear in the case study ) | N/A |
| 5 | **Mobile communication terminal according to one of the preceding claims,**  **characterized in that when the terminal is connected to the laptop computer via a Bluetooth radio link, the mouse buttons on the touch screen display appear in a blue colour** | No (they go from greyed out to white when connected via Bluetooth). This is not normal infringement. | Actavis questions: likely to be equivalent.  The best argument against equivalence is that the ephone buttons changing from greyed out to white indicate that the phone mouse function is active and connected. The patent is slightly different in that it indicates one form of connectivity is in use rather than another.  Strict compliance required by the patentee? Probably not. |

1. *Acts of patent infringement (25 marks)*
   1. *Outline what acts may constitute patent infringement, and the relevant statutory provisions (7 marks).*

This is a general question: would expect a list of s. 60 (1) acts and short explanation:

“Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say

(a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;

(b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;

(c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.”

And 60(2)

A person (other than the proprietor of the patent) also infringes a patent for an Invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

noting the exception at 60(3):

staple commercial products (unless made for purposes of inducing person to do an act which infringes

Joint tortfeasance by common design.

* 1. *What acts of patent infringement, if any, have been committed by ePhone (UK) Ltd? (5 marks).*

The relevant facts in the scenario are as follows:

“**Some local company is buying them in California and bringing them back round Cape Horn on a frigate, and selling them on the Truro market, and I must say they’re going like hotcakes.”**

**On the back it says “Imported and distributed in the UK by ePhone (UK) Limited, 14 Pirate Cove, St Ives, Cornwall.** www.ePhone.co.uk**.”**

These are product claims (they all start “Mobile communication terminal…”). Some candidates thought that the claims described a process, presumably because it describes steps carried out within the product. This caused errors.

S60(1)(a) :

* Importing
* Disposes of
* Offers to dispose of
* Keeps (more than mere warehousing)
* (we don’t know about “uses”)

Common design with Sir George (next question) because they seem to reference his website on the product. Many candidates identified common design for George, but not for the company.

* 1. *What acts of patent infringement, if any, have been committed by Sir George? (5 marks).*

The relevant facts in the scenario are as follows:

**“The ePhone.co.uk website allows users to purchase and download software for older models of the ePhone to enable the functionality found on the ePhone 15. For older models without Bluetooth, it also sells a cable that allows the ePhone to mimic a USB device when connected to the laptop USB port. A “Whois” search shows that the ePhone.co.uk website is owned by Sir George Warleggan.”**

* Common design with ePhone (UK) Limited (George owns the website that’s on the back of the phone, so they are probably acting together)
* S60(1): uses, keeps (at least he did until Demelza stole it)
* S60(2)

The software to convert an older ePhone does not directly infringe (all claims are to a “mobile communication terminal) but is “means, relating to an essential element…” for Claim 2 (and dependent claims 4 and 5), and probably satisfies the double territoriality (.co.uk address).

The software and lead are “means, relating to an essential element” for Claim 1 (and 4 and 5) and probably satisfies the double territoriality (.co.uk address).

Some candidates noted that ownership of domain name doesn’t necessarily entail direct responsibility for acts undertaken via the website, although it is suggestive.

Under s. 60(3) the software is not a staple commercial product. The lead may be if it is an ordinary USB lead, but it is being supplied for an infringing purpose.

* 1. *What acts of patent infringement, if any, have been committed by Steve? (5 marks).*

None, unless he is part of the common design. No evidence. The point of this question is to remind the students of the territoriality of patents.

* 1. *What are the statutory defences to patent infringement, and do any apply? (3 marks).*

s. 60(5).

*(5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if –*

*(a) it is done privately and for purposes which are not commercial;*

*(b) it is done for experimental purposes relating to the subject-matter of the invention;*

*(c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;*

*(d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom;*

*(e) it consists of the use of a product or process in the body or operation of a relevant aircraft…*

Probably only 5(a) applies to George in respect of his own ePhone 15. If candidates mention the ship defence, they should conclude its not relevant.

Some candidates included s60(3) in here rather than question 2.3, which was ok.

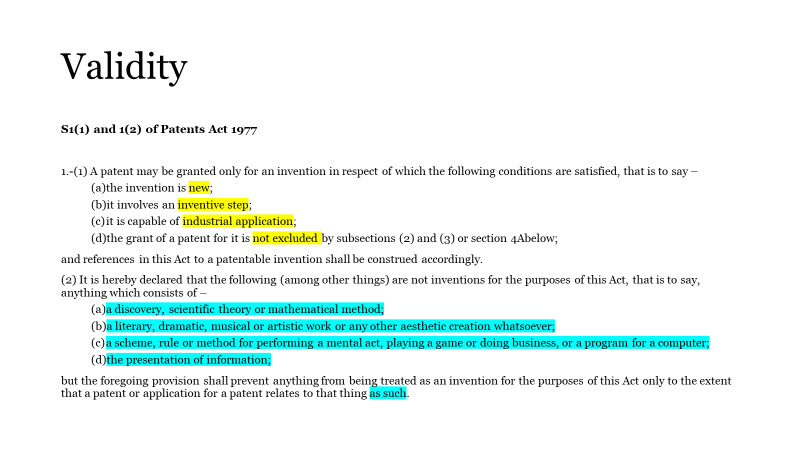
1. *Patent Validity (30 marks)*
   1. *What is the relevant date for assessment of patent validity, and why? (1 mark).*

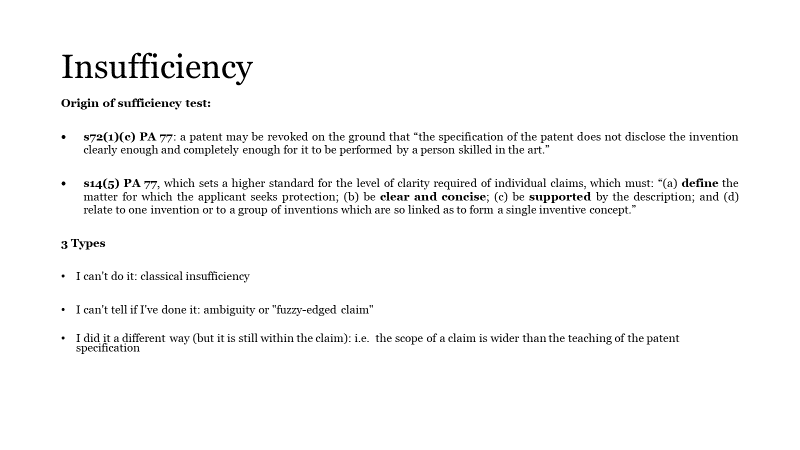
Priority date = filing date = 03.12.1807. Candidates should reference s.2 Patents Act 1977 when explaining why this is the relevant date.

Some candidates explained why the filing date was relevant, but then failed to write down what the date was…

* 1. *On what grounds may a patent be invalid? Identify the key statutory and case law provisions (4 marks).*

Examiners were looking for concise summary. The slides that candidates were shown are below:





The notes from the residential course say**:**

**Novelty test**(Synthon v Smithkline [2006] RPC 10)

* Disclosure

“the matter relied upon as prior art must disclose subject-matter which, if performed, would necessarily result in an infringement of the patent.”,

* Enablement

Enablement means that the ordinary skilled person would have been able to perform the invention which satisfies the requirement of disclosure”.

**Inventive Step test**:

Course notes (p9) teach the approach to obviousness as follows:

* + 1. Take each cited piece of prior art separately unless there is a reason to read them together
    2. Carry out Windsurfing/Pozzoli analysis

(1) Identify the notional "person skilled in the art" and his common general knowledge;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

(Nb: Does candidate demonstrate proper understanding of low threshold of last step? )

* + 1. Ask following questions:
       1. Faced with this piece of prior art and the problem the skilled person is trying to solve, would the invention come to mind? If it would, would the skilled person be able to foresee that it would indeed solve the problem?
       2. Why would invention be obvious? Why not? What would the skilled person need to appreciate if (s)he is to foresee that it’s worth doing? Why would this be (or not be) something he would appreciate?
       3. What motivation is there to solve this particular problem – how hard will the skilled person be looking for a solution? What other possibilities are there?

**Mosaicking**. Can’t mosaic two pieces of prior art, but it is possible to combine one piece of prior art with CGK. So, it is necessary to decide of each piece of prior art: is it CGK? Examples of CGK in this case study probably include:

The use of touchscreens as a user interface

Bluetooth connectivity for a mouse

The Communicator 9000 and use as a mouse is unlikely to be CGK: its unlikely to be in textbooks and a PSA would not be expected to know about it unless she/he had used one.

* 1. *For each claim of the Poldark patent, please explain: (5 marks per claim)*
     1. *whether it is novel and inventive over the 9000 Communicator prior art; and*
     2. *whether any other grounds of invalidity identified in your answer to 3.2 may apply.*

(Note that 3.3.2 includes excluded subject matter and insufficiency, which are relevant. Most candidates used a claim chart. See next landscape page for model answer)

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| Claim |  | Novelty | Inventive Step | Other |
| 1 | **Mobile communication terminal**  **comprising a USB port**  **and USB lead capable of connecting to the USB port of a laptop computer,**  **the USB port providing both power and connectivity,**  **the mobile communication terminal capable of being used both for communication**  **and as a wired computer mouse with functional mouse buttons.** | All elements likely to be anticipated by the 9000 Communicator  One issue is whether the Communicator can also be used “as a communication device” and whether that wording requires simultaneous use whilst being used as a mouse. |  | Some candidates thought that “Mobile Communication Terminal was too broad when the patent teaches only a mobile phone, and therefore an insufficiency argument arose.  If the PSA could apply the teaching of the patent to another form of terminal (eg a pager or a tablet) then it would not be insufficient. |
| 2 | **Mobile communication terminal comprising Bluetooth connectivity**  **capable of connecting to a Bluetooth-compatible laptop computer,**  **the mobile communication terminal capable of being used both for communication and as a wireless computer mouse with functional mouse buttons.** | Not anticipated by 9000 Communicator (not Bluetooth connectable).  Not anticipated by Bluetooth mouse as not a mobile communication terminal as that term is used in the spec (eg line 9). | Probably not inventive.  Person skilled in the art: engineer working in mobile phone industry. Engineering/electronics graduate.  Bluetooth is within his CGK at priority date as a means of carrying “mouse” type information to the laptop (spec eg line 50).  Inventive concept: use of the mobile communication terminal as a mouse.  Prior art: doing the above using a USB cable to carry the “mouse”- type data.  Use of Bluetooth instead: probably not inventive. |  |
| 3 | **Mobile communication terminal according to claim 1 or 2, characterized in that the mobile communication terminal can utilise its camera application using the downwards facing camera and LED light, or upwards facing camera, or both in combination, so as to detect movement of the mobile communication terminal when used as an optical computer mouse.** | The 9000 communicator uses the downward facing camera.  There is a claim construction argument about whether the claim requires the device to be capable of all three options (downwards, upwards, both), or whether a piece of prior art which does just one of those things falls within the claim.  To the extent that this claim covers a device which just uses the downward facing camera, it is anticipated.  If it has to be able to do all three things (downward, upward, and both in combination) then it is not anticipated, but… see insufficiency | It is either anticipated or insufficient so don’t need to think about inventive step.  The principle of using the upward facing camera is the same as using the downward facing camera. There are significant disadvantages in using the upward facing camera (the ceiling it is looking at is a long way away so it would be less sensitive to small movement). The advantage is that there is no need to use an LED to light the ceiling. If students analyse this, they may conclude inventive. | The claim is insufficient to the extent that it claims use of both the upwards facing camera and downwards facing camera in combination. But the specification line 83 says that “*The video camera application on the mobile communication terminal may select between one or the other of such cameras, but may use only one camera at a time.* “ |
| 4 | **Mobile communication terminal according to one of the preceding claims, characterized in that the mouse functionalities, in particular the mouse buttons, are provided on the touch screen of the mobile communication terminal.** | The 9000 communicator probably isn’t a touchscreen device  (“*The 1 button on the keypad is the left mouse button and the 3 button is the right mouse button*”). So not anticipated | The spec and drawings both describe a touchscreen-type mobile phone as being common, so they are CGK at the priority date.  Probably not inventive at priority date to use the touchscreen instead of physical buttons. |  |
| 5 | **Mobile communication terminal according to one of the preceding claims, characterized in that when the terminal is connected to the laptop computer via a Bluetooth radio link, the mouse buttons on the touch screen display appear in a blue colour** | Not anticipated. | Candidates should identify that an inventive step cannot lie in excluded subject matter. | Excluded subject matter: any invention in this claim lies purely in the presentation of information (that the device has established a Bluetooth connection). |

1. *Patent Amendment (10 marks)*
   1. *What amendments may be made to a patent after grant? (4 marks).*

Examiners were looking for candidates to explain that an amendment cannot broaden the claim, or “add matter” (teach something that wasn’t previously taught by the patent).

* 1. *Is there a claim amendment that Demelza can make that would preserve the validity of the Poldark patent? Which claim should she amend and why? Will it still capture the infringing acts? (6 marks).*

Amend Claim 2 to add an integer claiming the use of accelerometer to detect motion, preferably by taking language from line 242 onwards from the specification.

Demelza could amend claim 3 to limit it to use of the upward facing camera: this might save claim 3 from anticipation by the 9000 Communicator and from insufficiency, but it won’t capture infringement.

Some candidates who thought “Mobile communication terminal” was insufficient and replaced it with “mobile phone”. That would be ok.

A common mistake made by candidates was to start with a claim that is not infringed and add a feature from the specification to it as an alternative feature, in an attempt to make the claim capture the infringement. For example, they would add the accelerometer to claim 3. If the claim was not infringed before the amendment, and it is infringed after the amendment, then it must have been broadened (because it captures something now that it did not previously).

1. *Litigation (5 marks)*
   1. *Who should be the claimant in a claim for patent infringement? Are there any steps that need to be taken in respect of title before a claim may be brought? (2 marks).*

The proprietor is Wheal Grace Mining Company Ltd, and it should be the Claimant.

We would want to ensure that Demelza has assigned her rights in the invention to the Company (although if she’s a director not just a shareholder there would be an argument that the patent belongs to the Company).

Because this isn’t a PCT application we don’t need to worry about assignments of the right to claim priority.

* 1. *What remedies might the claimant seek? (3 marks).*
* Injunction
* damages back to the date of publication, or account of profits
* delivery up and destruction of ePhones kept in the UK
* publication and dissemination of the judgment

## Patents 2

This year’s question related to a patent for biodegradable chewing gum, the invention being the brainchild of a young woman who steps in some discarded gum on her way to a disastrous job interview.

As always, the invention in question was simple to understand, the aim being to test students’ knowledge of the law rather than their technical prowess. Further the question was designed to examine students’ understanding of the core areas of patent law such as construction, infringement, novelty and inventive step. There were however opportunities for students to score highly in terms of pointing out squeezes and recognising more esoteric issues such as novelty only citations and possible Gillette defences.

Overall, the question was reasonably well done. As always there was one core Defendant (Crawleys Gum) and as assortment of other actors – both corporate and individual people – for whom there were arguments for and against including them in the proceedings. There is no right or wrong answer in respect of these actors as long as the arguments are persuasive.

Most candidates argued that claims 1, 4 and 5 of the patent in suit were infringed by the Good Gum product made by Crawleys and some argued for 2 and 3 too. Again, there was no right or wrong answer as long as the arguments were sound. Equivalence was generally well done. The very best answers tended to use claim charts which are useful to set out a lot of information clearly.

Overall, the question relating to validity was less well done. Candidates tended to slavishly copy the sample answers given to them which are consciously not stated to be model answers but rather to provide guidance. For instance the sample answer does not plead common general knowledge to be considered with the inventive step prior art and yet it should be included. Hardly any candidates added CGK to their pleading. It is important to think and not just copy.

Many candidates did not recognise the novelty only patent application and of those that did, several pleaded it incorrectly. Disappointingly few candidates recognised the attack on the substantive priority of the patent which could be really important because there were a lot of further attacks to the patent which emerged in the priority year including, as some candidates spotted, the sale of Good Gum.

Most candidates picked up on the potential challenge to the patent arising from the conversation in the pub prior to the priority date between the inventor and her friend. Most were able to cite the conventional law on breach of confidence. Only a few looked at the individual claims and applied the information imparted by the inventor to each claim.

Many candidates raised insufficiency challenges and were right to do so. Several raised added matter but this was really a challenge to substantive priority.

## Trademarks and Passing Off

**Q1 - Advise Sheila and Brooke on the registrability of the New Marks identified in Table 2. As part of your advice, please identify any supporting evidence as well as any comments as to how the pending marks are used that may improve the chances of achieving a registration. \*Students should note that the description of the disco ball shape is used in lieu of an image. As part of your answer, consider the options and best strategy for protection of the disco ball keyring shape as a trade mark. This will be the mark that matures to registration in Q2.**

|  |
| --- |
| The shape of a silver disco ball on a keychain with the letter D etched in silver on each of the mirrored glitter panels\* |
| LADLE OUT THE DISCOUNTS |

In answering this question, please assume you have been instructed by Sheila and Brooke to reuse the specifications from the existing Ladle ‘456 registration so you do not need to consider additional classes.

Students will note a time gap between questions 1 and 2. This is merely to allow the relevant facts to develop between questions.

**30 Marks**

Students were expected to consider the absolute grounds for registrability of the two marks. Relative grounds could be mentioned for completeness but were not the focus of the question.

Most papers correctly identified the relevant statutory tests and applied these to the facts available.

Both marks were to be considered under s.1(1) TMA and then under s.3(1) in the usual distinctiveness and descriptiveness criteria. The shape mark (if that was the recommendation) should also have been considered under s.3(2) to see if any of the shape exclusions applied to the *entirety* of the mark sought to be registered (unlikely on the facts). For the shape mark, the potential for the letter element (D) on the panels may well overcome inherent registrability concerns, provided it was legible, although some students suggested alternative lettering. Most students correctly identified that the shape mark description as set out in the paper was fairly hopeless as to clarity and consistency and should be replaced with an image, either in 2D or 3D depending on the recommendation together perhaps with a specific silver colour (if claimed).

For the slogan mark, many students commented on the general difficulty with registering slogans as not being perceived as an indication of origin. However, here the clear original reference to LADLE makes that less of an issue given it was a well established brand name, as well as the fact that a ladle can dish out soup, but not discounts, so there was a dual meaning. Clearly the discount element would be descriptive as far as promotional activity was concerned.

It was important to demonstrate that registrability, descriptiveness and distinctiveness were to be considered both generally but also through the lens of the average consumer for the goods/services applied for. Some aspects of the mark were more descriptive for spoons and promotional activity and vice versa and of course disco balls are a fairly common keyring shape so the textual element was particularly important in that respect, but disco balls for promotional services would be less common. The instruction to reuse the spec was simply to avoid too much analysis on selecting the goods/services.

The reference in the question to “supporting evidence” and “comments as to how the pending marks are used that may improve the chances of achieving a registration” was intended to be a prompt to consider evidence of acquired distinctiveness and what may be required from the client to demonstrate this if an inherent distinctiveness challenge was received on either mark. Given both marks have been used for a period of time there was a good story on acquired distinctiveness, the slogan mark had arguably not been “used” for a very long time but remained in popular consciousness nevertheless. The disco ball shape had not been in use long but had been distributed in quite staggering numbers and brand perception reinforced in downloads. The strongest papers also considered “use as a trade mark” vs purely promotional use.

Finally, the best papers reinforced the need for an intention for genuine use of the mark, and a registration solely for defensive purposes to prevent counterfeits would risk invalidity on that basis, so a recommendation for further items to be produced was sensible.

**Q2. Advise Sheila and Brooke in relation to the action(s) that Ladle may have in relation to the various activities of the Lendle chain. You should also deal briefly with litigation strategy and the pros and cons of different options.**

**In answering this question, you should discuss any potential defences Lendle might raise, and any weaknesses or vulnerabilities in the action(s) you identify and advise Sheila and Brooke accordingly.**

**You may cross-reference any registrability or validity concerns raised in Question 1. \*Students should assume the shape mark was ultimately registered in the form they recommended at question 1.**

**70 marks**

There was a *lot* going on with this question and a lot of variables, but students were marked on how they applied the relevant law to the facts, rather than there being a “model” answer as such. Reasonable minds often differ as to the ultimate conclusion of infringement.

The best papers considered the infringement scenarios in order of commercial significance, starting with the LENDLE/LADLE similarity for the supermarkets themselves. Whilst there were detailed examples of particularly egregious behaviour in some of the blatantly copied promotional campaigns (as below), students were expected to consider the LADLE/LENDLE element in the most detail.

Many students started with the opposition and identified the difference between the “paper” test in the UK IPO for oppositions and the “real world” analysis for trade mark infringement through the courts. However, some papers were at risk of missing the “big picture” by not fully analysing whether Ladle should separately/in addition consider an infringement claim against the Lendle chain for the name of the supermarket itself.

Students were expected to consider the core dispute of infringement of the LADLE marks through the use of LENDLE for identical/similar retail and related services and consider each of s.10(1)-(3) and apply the usual tests for each of those. The best papers broke these tests into constituent elements as set out in the usual caselaw to demonstrate understanding and application to the facts.

The marks were clearly not identical, but the goods/services were identical or highly similar. It is also likely that LADLE is a mark with a reputation but there may be questions as to the regionality of that reputation and/or whether reputation extends beyond those who actually purchase due to geography (see below). The global assessment for infringement allowed many factors to be include.

As well as the core LADLE/LENDLE dispute there were a number of other potential infringements, as below. Given the available space and word count we did not expect a full analysis of each in all the same level of detail, but many students used a table as a way of presenting the most relevant analysis and not repeating each element every time.

*(a) Lendle Deep Cut Discounts online shopping offering (and any basis to challenge)*

*(b) Dish out the Discounts vs Ladle out the Discounts TM registration*

*(c) Friday Night Ladle Discount Disco vs Friday Night Deep Cuts Discount Ball (both as to the event/promotion type and the name)*

*(d) Lendle’s disco key ring and associated smart phone app vs the Ladle TM registrations*

Although the name of the two supermarkets was the key commercial issue, as well as outraging the Ladle family, the above factors all helped to indicate a deliberate intention to free ride/sail close to the wind which rather cuts across any defence/claim that the similarity in supermarket names arises solely from the private equity lead.

Associated with the analysis and question 1, there was a real difference between how some of the above terms/promotional practices might be interpreted by consumers and hence protected/permitted by the law. Use of the term discount and advertised promotional events on a Friday evening for example cannot be monopolised by a single trader. But the use of a disco ball and dancing, which prior to Ladle’s promotion arguably was not closely associated with supermarket shopping, is much more likely to create confusion, a misrepresentation/deception in passing off or support a free riding claim under s.10(3) for trade mark infringement. Many students focused a little too narrowly on the disco ball being a keyring (and that aspect being narrowly protected), but the keyring was merely a “vehicle” for the promotional scheme, which was highly distinctive as a discount disco.

Passing off was also relevant on each aspect but students were only expected to set out the Jif lemon test once in detail, identifying goodwill (in what), misrepresentation (how/why) and damage, to consider whether passing off deception was realistic in all the circumstances. It could also plug a gap in the marks or be a backup on validity risk so was a useful addition.

Passing off could likely have been deployed in respect of all complaints but was most relevant to the Deep Cuts Discount Ball. Goodwill can in theory relate not just to the name but also the trading style and promotion of a business. The key would be whether misrepresentation or deception would occur solely as a result of the similarity in concept and name between the (Lendle) Deep Cuts Discount Ball and the (Ladle) Discount Disco. Buried within some fairly generic imagery and keyrings was a highly innovative and distinctive promotional concept, emulated by Lendle who would likely then seek to argue that terms like disco, balls and discounts could not be monopolised.

The location of each set of supermarkets is relevant given most grocery shopping is still quite local (even if most chains are national), but online shopping does feature in the question. Regionality of renown and goodwill was therefore a potential limit, particularly on the scope of protection for “event” based promotion in particular, although many papers identified that students tend to be more transient and may have grown up in the south but attend university in the north (or vice versa).

There were no obvious defences but there were potential bad faith challenges to some of the Ladle marks (*Skykick*, software *per se*) as well as at least some potential *Hasbro/Lidl v Tesco* “evergreening” to consider. There were also the potential validity challenges such as a lack of distinctive character and the potential shape grounds (shape of goods as such) which could be cross referred to question 1.

The Lendle chains are named after the entrepreneur fronting the private equity consortium. Although the precise details of the entity trading as Lendle is unknown, there is no suggestion it is Trevor Lendle in his personal capacity, so the “own name” defence would not apply to a corporate entity (many papers indicated that it would). It would be a stretch to claim use of Lendle as due cause.

This question also had available marks for strategy (venue e.g. IPEC, STS, High Court), consideration of interim injunction and the usual test to be applied, requirement for cross undertaking, status quo on the market etc. Most students identified the infringement options of IPEC, the High Court and the in-between option of the shorter trial scheme, considering the pros and cons of each. The best papers also considered strategic options such as complementary venues, a takedown request via App stores for the App, or a complaint to the ASA. A lower cost option would have been to let the TM opposition play out first and then use that as leverage if successful. Students might note the reluctance of Lendle to spend money and consider litigation of this nature isn’t likely in the family “DNA”.

Relatively few students considered an interim injunction application. It may not have been granted, given the status quo of the Lendle brand already being established on the market. In addition, the cross undertaking in damages would have been very significant and would be a substantial risk for Ladle. Advancing age or not, Eric would likely never have supported it.

## Copyright

1. **The paper**

The focus of the paper was Acacius, which had acquired software from Stephanos, which in turn had obtained software from Plaka Inc, its parent company. Stephanos had been wound up after the sale to Acacius. Acacius was now looking to expand its business beyond the museum work it had previously been doing, for example into medical devices and building. Acacius wanted to know what rights it had, what rights it needed, and how it might deal with its future customers.

There were clear statements in the original coursework that when working with Plaka, Edwin was an employee and Jessica was an independent contractor. A concern was raised that the clarifications meant that significant further work had to be done, revolving around the status of the various individuals at differed stages.

The markers have indicated that all the papers dealt with the different legal issues arising from whether someone is an employee or an independent contractor, and that all the papers had understood those differences. The markers did not see any difficulty in the papers arising from the clarifications.

Overall, most papers handled the coursework competently, with some doing very well. The main distinguishing factor in stronger papers was the ability of students to use their understanding of the legal framework, to offer considered practical advice on how Acacius should deal with the issues facing it, and its future dealings with customers.

**General comments**

Some papers did not use the Exam Convention rules, s 4.2, when giving citations. These have been referred to the Exam Board for consideration.

Some papers used very old cases, of limited persuasion. It is more persuasive, where possible, to find more recent ones, for a more up-to-date view. Similarly, it is more persuasive to cite from the legal cases setting out the principles, rather than the text books reflecting those principles.

The better papers formed a view on the facts given, but made it clear that more investigation would have to be made to form a conclusive view, particularly given how many contracts there seemed to be in place, which had not been seen.

1. **Question 1**

**The rights**

There were three things which could benefit from copyright protection. The software in the 3Dtech, the software in the Enhanced 3Dtech, and the 3Dprints.

**Subsistence**

Virtually all papers recognised that software can be protected as a literary work. How the 3Dprints might be protected was less clear. Most papers recognised that they might be protected as sculptures or works of artistic craftsmanship, and discussed how that might be, some more persuasively than others.

**Originality**

As most students knew, *THJ v Sheridan* in the Court of Appeal puts it beyond doubt that the test for originality for LDMA works is whether the author has invested their own intellectual creation in that work. There is therefore no need to discuss the old “skill labour and judgement” test.

There were two key issues here. Was the Enhanced3Dtech, a derivative of the 3d tech software, original enough to give it standalone copyright. Were the 3Dprints capable of copyright protection, given that to some degree at least, they were replicas of earlier works.

Generally, the discussions here were good. Many papers were comfortable to say that as the Enhanced3Dtech was “dramatically” better than what had gone before, it might well be original. Similarly, Jessica seemed to have done enough to mean that her work gave originality to the 3Dprints she had worked on.

There was some good discussion as to how the use of 3D printing might, or might not, give rise to originality. Many concluded that it might well not. The best however said that it was unclear how the software and the robot were used in the making of the 3Dprints, (for example, what was done to produce each bespoke print, and who by) and that further enquiries should be made, as there might be relevant human input.

**Computer generated works**

Many papers discussed this, although the facts were not clear. The best referred to the definition of such a work in s178 of the CDPA and went from there:

“computer-generated”, in relation to a work, means that the work is generated by computer in circumstances such that there is no human author of the work “.

Those papers emphasised that without knowing the circumstances, no view could be formed, but went on to discuss the consequences if the work was indeed computer-generated.

**Qualification**

Given that Plaka Inc was plainly not a UK company, issues arose here as to how the works might qualify for protection, as it seemed that they might have been created with no UK connection. There was some confusion, though the better papers looked at the wording of s159 for assistance. It is not just by first publication that foreign works are protected.

**Duration** was not in issue, so needed very little mention.

**The author and owner**

Most papers knew that the first author or authors had to be identified to be able to work out where ownership lay, and did so well.

**Joint authors**

There was some good discussion here, with most clearly understanding the test. Some implied, and the better papers said, that the consent of all joint authors, or their successors in title, would be needed for Acacius to expand as it wished. A few indicated that there might be an issue as to whether there could be joint authorship of a computer-generated work.

**Ownership**

The papers understood the difference between first ownership of copyright in works created by an employee in the course of their employment, and in a work created by an independent contractor.

Most also recognised that that ownership might be transferred, including at a very early stage, by assignment of that copyright, including by assignment of any future copyright.

**Licences**

The papers mostly set out what infringing acts Acacius might be liable for if it expanded as it planned, although little detail was expected. There were no current allegations of copyright infringement against Acacius in the fact pattern. That suggested that Acacius’ acts to date were acceptable to the other parties, whether because there had been an assignment, or because there was a sufficient licence of the rights, express or implied. The only indication that there might be an issue was Jessica’s wish to be identified as an author.

Most papers set out the possible contractual arrangements that there might be in place between the various parties, tracking through the various stages given. Some did this better than others. Strong papers here indicated that if there was a licence, it might not be wide enough to cover Acacius’s expansion plans. For example, any independent contractor licences might be of concern. They also indicated that a good, and important, task would be to consider the documents relating to the Stephanos/Acacius deal, which Acacius should still have.

**Liquidation**

Nothing was said on the facts beyond that Stephanos had been wound up after the Acacius deal. Some papers assumed that the liquidation was on insolvency, which was probably unlikely. A number assumed that if Stephanos assets had not transferred to Acacius, they had become bona vacantia, which might not have been the case. The detail of what happens on liquidation (solvent or insolvent) was not taught on the course and students were told they were not expected to know it. Where students tried to go beyond the course teaching, errors crept in. Given the importance in practice of seeking specialist advice in practice, in areas of law outside one’s expertise, credit was given to papers which said that such advice should be sought.

However the markers were generally lenient here.

**Moral rights**

As most paper recognised, the attribution right does not apply in relation to computer programs (software). Nor does it apply to anything done by or with the authority of the copyright owner, where copyright in the work originally vested in the author’s employer by virtue of section 11(2). So the issue here related narrowly to Jessica’s claim in relation to the 3Dprint she had made, and similar potential claims by others. Most papers knew that Jessica’s claim had to be asserted. The best said that the simplest way to avoid an issue would be to stop use of her image and in future to choose an image where the rights had been waived.

1. **Question 2**

The strongest papers focussed on the steps Acacius wished to take to expand its business, worked out what rights it needed to be able do that, then referred back to the facts they had considered in Question 1 and applied them. Given that this question accounted for 30% of the marks, there was scope to look at this in some detail, and the best did exactly that.

Two of the key issues were whether the rights which Acacius had were wide enough for its future plans, and the difficulty of tracing all the authors and owners if more was needed from them. Good papers commented on the need to understand what rights Acacius had to the 3Dtech software, as the Enhanced3Dtech seemed to be a derivative work, so could infringe it. They also recognised that Acacius was not in a position to demand an assignment from any third parties, and would not be able to obtain any rights that Stephanos had had without great effort, so might need to seek narrower rights or other ways of achieving what it needed. The strong papers here thought not only about what Acacius might want, but also about how the other parties might respond, and so thought through what compromises Acacius might be able to live with. Few were confident enough to say that Acacius might not be able to get all that it needed, so would have to decide whether going ahead as planned was a viable option.

1. **Question 3**

Here, the best papers considered how the customers in each sector might interact with each other, and be affected by what was happening in the other sectors. From that they considered how best Acacius might deal with each of them, to avoid conflict and maximise the benefit to Acacius itself. The method of payment was also well discussed in the best papers, which recognised that there might be no copyright in the 3Dprints in the new sectors, but that they might be used as a basis for royalty payments for use of the software. Less strong papers listed general contract terms that might be included in any similar deal, but with little discussion as to how those were relevant here. Some answers were very short, which made it difficult for the examiners to give many marks.

## Designs

**The Paper - Overall**

The coursework was generally soundly done with some very good papers. The key distinguishing features of the better papers was their strong application of the law to the facts as known, from which they formed confident views as to the merits, whilst recognising that more information was needed. They then gave strategic advice in the light of the views they had formed, which was generally strong.

Overall, although there were some errors, the papers showed a good understanding of design law and how it is applied in practice.

**The fact pattern**

The coursework focussed on Kidfun, an independent design agency, which designed, first, its own toys for exploitation by its toy company licensees, and second, toys made to commission from specific toy companies, who expected to have all the rights in those toys.

There were four toys for consideration.

The first two were **Buttonlorry**, a toy lorry designed by Anna during her school Design and Technology classes, and a project proposal from Anna, now working with Kidfun. Anna’s proposal was that Kidfun should design a small toy lorry, **Kidfunlorry**, that Kidfun could license out. The Kidfunlorry would be based on the Buttonlorry, but no further details were given as to its design.

The third toy was the **Kidfuncar**, commissioned from Kidfun and sold by Shed Toys plc (Shedtoys). Kidfun had received a message on its Kidfun.eu website from Mytoys Inc, alleging that the Kidfuncar infringed its rights in a fourth toy, **Myridecar**. The message told Kidfun to take the Kidfuncar off the market immediately, or its customers would by sued.

**The question**

The question asked for a full briefing note to Samia, that she might pass to counsel, about the design rights involved, their validity, and how Kidfun might achieve the best possible legal outcome in relation to both the Buttonlorry/Kidfunlorry and the Myridecar/Kidfuncar matters. There was a strong steer that Kidfun needed to know how to respond to Mytoys and mollify Shedtoys, which not all candidates picked up on.

The best papers bore Samia’s wishes in mind, and set out their advice accordingly. They took the strengths and weaknesses of Kidfun’s position into consideration and tailored their advice accordingly. Weaker papers focussed on the law, and to a greater or lesser degree how it might apply to the facts, but were less strong on addressing Kidfun’s specific requests for assistance.

The paper was marked out of 100.

**Buttonlorry**

The relevant design law here was generally soundly explained, and thoughts given as to what might be protected. Good candidates picked up that Buttonlorry was not going to be commercially exploited. They noted that it was unlikely that there was a registration for Buttonlorry, (which should be checked) and that there was little commercial point in applying for one: indeed, applying for one might be commercially unhelpful.

Some particular points recurred.

**Registered design in Buttonlorry** One important issue was whether the Buttonlorry might count as a prior disclosure to any Buttonlorry registered design, or more importantly, to the design of the proposed Kidfunlorry. Candidates tackled the obscure disclosure provisions well, and the best applied them thoughtfully to the facts, particularly through consideration of the similar, but different, facts in *Trunki*. A few considered how “in the normal course of business” might affect the arguments. The strongest said that it would be prudent to assume that the Buttonlorry design might not be obscure. They advised that care should be taken to ensure it would not invalidate any rights in the Kidfunlorry design.

**SUDs** A notable number of candidates wrongly said that as the Buttonlorry design had been created before 2021, no SUDs could subsist. It is the date the design is made available, not the date of its creation, that is relevant to subsistence. Other candidates recognised that no SUD could subsist if the display in the school lab was not an excluded disclosure.

**UKUDR** This was generally well considered. Candidates noted that surface decoration was not protected, and gave thought to whether the buttons were surface decoration and therefore excluded, in the light of either *Dyson v Qualtex* or *Neptune v Devol*. The examiners gave credit for sound reasoning (rather than a particular view).

On qualification, some candidates assumed that Anna would be a qualifying person, which was not known on the facts, although as others pointed out, it seemed likely.

Good candidates noted that any UKUDR might now have expired, or be in its final 5 years, such that licences of right were available.

Many candidates recommended that Kidfun should acquire the rights in the Buttonlorry and its associated material from Anna if it could. The best recognised that Anna might well be willing to sell, and that if any UKUDR was indeed in its last few years, the price might not be too high.

**Kidfunlorry**

The fact pattern indicated that the final design of the Kidfunlorry would differ from the Buttonlorry, and that Kidfun wanted to know what it should do to protect the Kidfunlorry design as strongly as possible. As the design process had not yet begun, it was within Kidfun’s power to produce a design which avoided invalidity issues.

The only other designs given were the Buttonlorry and the toy Jeep® off road car. Not all candidates advised that a search should be done for other relevant designs.

Generally the papers were sound on what rights there might be in the Kidfunlorry. The better ones considered how Kidfun could ensure its rights were as strong as possible, on the facts and in the light of the law. For example, they said that Kidfun should ensure that the Kidfunlorry design should be original and not commonplace over earlier designs, having explained those terms.

**Registered design** This wasgenerally well considered, with good advice to ensure the registrations were in place before the design was disclosed.

**SUD** The discussions of what might be protected were generally good.

The main question here related to subsistence. Candidates were aware of the ambiguity in Article 11 of Regulation 6/2002 as it applies to SUDs and advised Kidfun to ensure that it first made the design available in the UK, as the safest way to ensure SUD protection. Some also mentioned that that might lead to difficulty with the Community Unregistered Design right and advised simultaneous publication as the strongest option.

**UKUDR** Again, the protectable designs were generally well considered. Good candidates picked up that the designs needed to qualify, which they could do via Anna if she were the designer and self-employed, through Kidfun if it was a qualifying entity and Anna’s employer, or through the first marketer if that was a qualifying entity and the first marketing was in a qualifying country. None of the facts here was known, so good candidates said Kidfun needed to be careful to get this right. Some candidates wrongly said that qualification could be via commissioning.

**Exceptions in relation to all rights** These were generally well done, here and in relation to the Myridecar, with most candidates showing a clear understanding that the exceptions apply to the whole of a claimed design, not a part of it.

**Licensing** The discussion as to the licences Kidfun might want in place was often well done. The examiners were expecting to see candidates advising at least that any licences for the Kidfunlorry should be limited to the relevant market (e.g. toys only, not TV shows or online games), with any necessary warranties and indemnities it had to give backed up by a right to control any litigation, particularly any brought against it or customers by third parties. The other documents Kidfun might want, such as design records, clear contracts with designers, and confidentiality provisions with potential customers, were also often well stated. However, some candidates’ advice here was lacking in detail.

**Myridecar**

There were two key issues here which would significantly affect the strength of Kidfun’s position. What if any registered designs did Mytoys have for its Myridecar? And did Harry copy when he designed the Kidfuncar? A search for any relevant registered designs, and a discussion with Harry, were therefore priorities for Kidfun.

**Validity of any claimed Myridecar design right** No dates were given for the designs in the Annex. Better candidates considered the position if they pre-dated the Myridecar but noted the need to check those dates, and do a wider search for other designs.

The examiners gave credit for well-argued comparisons, which applied the Cantel test and recognised that it was the informed user’s view, not the candidate’s, that would matter, the informed user being particularly observant and showing a relatively high level of attention. There was considerable disparity of views here as to which designs might and might not create the same overall impression, with the best candidates advising that Kidfun could not be certain to invalidate any claimed Myridecar design rights.

**Possible Myridecar registered design** No registered design was given in the question. The strongest papers focussed on which possible registrations would give Kidfun the greatest problem, noting that a registration of a line drawing of the body shape of the Myridecar would be a concern, because of the similarities between that shape and the shape of the Kidfuncar.

**SUDs** Some candidates dismissed the possibility of SUD protection on the ground that the Myridecar had first been disclosed in New York. However, that was not known for certain. There could for example have been simultaneous disclosure elsewhere.

**UKUDR** The papers here were generally sound, recognising that Mytoys US might not have UKUDR rights, given that the USA does not enjoy reciprocity. They noted the distinction between Mytoys Inc and Mytoys UK and that there might be rights in Mytoys UK.

**Primary infringement** Some papers said that Kidfun could not be an infringer as Shedtoys had made and sold the articles. That ignored s226(1)(b), under which Kidfun could be liable for having made the design document recording the design for the Kidfuncar. Shedtoys could also be liable for infringement, as the Kidfuncar it made and sold was a 3D copy of the design document for the Kidfuncar, which in turn might be a reproduction of the Myridecar design.

**Remedies for infringement of UKUDR: secondary and innocent infringement** Some papers showed misunderstanding of s233 here. Secondary infringement requires the alleged infringer to be on notice of the UKUDR claimed. Without notice, there can be no secondary infringement. Innocent infringement occurs as set out in s233, which also sets out the available remedies. Those remedies apply only in relation to innocently acquired articles, not to all infringing articles dealt with by the infringer.

**Threats** There were some errors as to the threats provisions, though most candidates showed a good understanding of them. The examiners did not find suggestions that Kidfun should immediately start proceedings for threats persuasive, given the lack of information available and the virtual guarantee that any such action would lead to a counterclaim for infringement.

**Other relevant points** The best candidates considered Kidfun’s weakest case, but also its potential strengths, and advised accordingly. They formed views, but also anticipated that their views might not be right, and suggested strategies to deal with different situations.

Good papers picked up that it was plausible that the Kidfuncar had been independently designed, given that the time frame for development was 2 years, and that whilst Harry had extensive knowledge of the market, he had thought (at some unspecified point) that the Kidfuncar was distinctive. They advised that if there was no copying, there could be no infringement of the unregistered rights.

Most candidates recognised that the prior use defence only goes so far.

**Strategy** One key issue was that the Mytoys message was very vague as to the rights claimed. Kidfun did not know what rights would actually be asserted, or how strong those rights might be. The best papers looked at Mytoys’ best and worst position against both Kidfun and Shedtoys, and how Kidfun might proceed in the light of those, in particular as to what Kidfun’s first response to Mytoys might look like.

Better papers also noted the importance of reviewing the Kidfun/Shedtoys contract, to see what terms it might contain., and use that to suggest how Kidfun might approach Shedtoys. Less strong papers said little about how Kidfun should handle that relationship.

The immediate urgent issue was the possibility of an interim injunction, which candidates were specifically asked to address. Yet many candidates skirted the interim injunction issue or did not apply the American Cyanamid principles in any detail.

To buy time and build better understanding of Mytoys claim, good candidates suggested that Mytoys should be asked for detailed further information, using the obligations under paragraph 6 of the Pre-Action Protocol, whilst simultaneously IPTech looked for Mytoys registered designs and any other prior disclosures, asked Harry for his design story, and asked Kidfun more about the impact an interim injunction might have, in order to advise more precisely. Suggesting that Kidfun should concede and ask Shedtoys to pull the Kidfuncar off the market immediately, or should immediately start proceedings against Mytoys, both lacked persuasion.

## Intellectual Property I & II examination

**Q1. Patents Problem Question** - While this question is clearly structured as a patent/trade secret question, some candidates did explore copyright and even UDR. In the past, where software is included in the facts, we have expressly told students not to consider copyright. This was not done this year. Therefore, I did mark any copyright responses. However, too many words spent on copyright reduced their ability to adequately address the patent/trade secret issues. Overall, where copyright was addressed, it was brief and without any real detriment to the mark awarded. This was not the case for a small number of responses, and these have been flagged for second marking.

As usual, many answers wasted valuable words on issues that, while not incorrect, were peripheral to the facts presented.

**Q2 -** *Set out below is the model answer for the 2nd problem question. In marking this question examiners were told to have a notional 75/25 division in mind between the trade mark and design components respectively. There were a small number of scripts where the designs element was not attempted at all or was dealt with only briefly. There were also two scripts where the trade mark element had been done poorly, but the designs element was excellent. In both sets of cases the notional division was particularly important.*

**(i) Advise Joshing in relation to its exposure to liability for registered trade mark infringement and passing off should it proceed with its planned launch of Get Pisterine. In providing this advice, you should also include and evaluate the arguments Joshing may raise in response to any such claims. You should NOT give advice on the regulatory requirements governing how spirits are named and sold**.

This answer will start with the 1976 Mark. This mark has recently expired, however, it is still within the grace period for renewal: s.43(3).

The sign used by Joshing is GET PISTERINE. There is no identity of marks, but at most similarity. This raises the possibility of claims under s.10(2) and s.10(3).

There is a threshold level of similarity that must be shown for s.10(2): *Specsavers*. Kenvue might argue that the word PISTERINE contains one letter different from LISTERINE, and that the addition of the word GET does not change the conclusion that the threshold for similarity is met. However, Kenvue might have difficulty is making out similarity of goods. There is clearly not identity – a spirit drink is not an example of mouth wash or mouth rinse. What about similarity? There are a number of reasons why the *British Sugar* test might suggest there is no similarity: one product is swallowed and the other spat out; the products do not substitute for one another; and they are found in different parts of the supermarket. Even if Kenvue could establish similarity of goods, application of the global assessment in *Specsavers* [52] may favour the conclusion that there is no infringement. Joshing would argue that the parodic nature of the product supports this, as it creates distance from the targeted product: *Specsavers* (context of use can be relevant). That is, no consumer would be confused into thinking that Kenvue had opened a side-business selling spirit drinks that parody its own product, or that it was economically linked with such an undertaking.

Kenvue’s claim in relation to s. 10(3) is stronger. Certain points are straightforward: LISTERINE has a reputation (*General Motors v Yplon*) (Listerine is ‘well known’; level of UK sales; advertising campaigns). There will clearly be ‘use’ by Joshing as the name will feature on the product: s. 10(4)(a). This use will take place ‘in the course of trade’, as the product will be sold commercially: *Arsenal v Reed*. It is not necessary that Joshing’s sign be used in relation to identical or similar goods. The requirement in s. 10(3) is that consumers make a ‘link’ between the marks: *Intel*, *Specsavers* [120]. Kenvue will argue that the parody unquestionably leads to such a link, this being the whole point of Joshing’s parody.

The two most obvious harms are unfair advantage and tarnishment (although it is likely that Kendue would also include a claim for blurring). Product parodies are by their nature a free ride: the joke of Joshing’s product relies on the familiarity of consumers with Listerine. Kendue might therefore argue that the product ‘rides on the coattails’ of Listerine and leverages off the investment of Kendue in Listerine: *L’Oreal v Bellure*. For unfair advantage, the focus is on the benefit to the defendant, such that it is unnecessary to show any diminution in sales of the claimant: *L’Oréal v Bellure*. That said, Joshing might argue that most (successful) cases involving unfair advantage have involved identical or highly similar goods or services, and a successful claim under ss.10(1),(2): *L’Oreal* (perfumes), *Pink v Victoria’s Secret* (clothing); *Specsavers* (optometry services); *Hasbro Inc v 123 Nahrmittel* (modelling clay). Might this case lack the same type of sharp practice seen in cases like *Specsavers* and *Hasbro*? A lot will turn on the degree to which the court is open to arguments that the free ride of a parody is a qualitatively different type of free ride. As for tarnishment, the arguments that Kendue might make relate to the dissonance between the goods, in terms of the method of use (e.g., its product is not drunk) and the health dimensions (e.g., the Joshing product could be said to promote an unhealthy lifestyle and be associated with antisocial behaviour). Kendue will argue that this will cause a change in the economic behaviour of consumers: *Pink*.

The challenge for Joshing is that these conclusions are often merely asserted rather than resting on any evidence. This is seen in *Pink*, where Birss J accepted that the use of PINK by Victoria’s Secret would mean consumers would not see Thomas Pink’s marks in the same way again. There are unlikely to be any defences from s. 11 that Joshing would want to run, and nor are there any viable arguments for the 1976 Mark to be removed or revoked. If Kendue can show a dilution harm, it is hard to see Joshing being saved by a ‘due cause’ argument: compare *Red Bull* (long-standing trader). That is, the strongest arguments for s. 10(3) relate to (1) the lack of similarity in the sign used by Joshing and (2) there is no actionable harm.

Many of the arguments, above, are the same for the Shape Mark. One question relates to the similarity of the shapes, bearing in mind that the registration is the shape with the word ‘LISTERINE’ included. If the sign GET PISTERINE is similar to LISTERINE, this may strengthen the argument that there is similarity with the Shape Mark. In contrast, if there is no similarity in the words, and a court were to accept that the word LISTERINE confers much of the distinctiveness on the Shape Mark, this might weaken Kendue’s for infringement of the shape mark.

(As an aside, the inclusion of the word LISTERINE on the shape may make it harder to argue that the Shape Mark should be removed for lack of distinctiveness. Shapes typically require acquired distinctiveness: *Windsurfing Chiemsée*, *Nestlé v Cadbury*. It is now common for brands to register shapes with words overprinted to help protect against such attacks. That said, in this case, the use of the shape since the late 1990s may mean that acquired distinctiveness is present.)

Another difference for infringement of the Shape Mark relates to the specifications, which include beer. Kendue would say that spirits are similar to beer. If accepted this would strengthen a s.10(2) claim, as courts assume notional use across all specification when assessing infringement: *Maier v ASOS*. Joshing could respond to this by arguing that the Shape Mark should be removed in whole or in part under s.47 as it has been registered for goods where no use could conceivably be intended (javelins, computers software and beer), meaning that the registration was applied for in bad faith: *Sky v SkyKick*.

Overall, the chances of infringement of s.10(3) in relation to the 1976 and Shape Marks is higher than the s.10(2) claim. Would a passing off action also succeed? It would be impossible for Joshing to deny that there is goodwill in the name LISTERINE and the product get up. Much would turn on whether there is an actionable misrepresentation. Joshing might argue that applying *Glee* at [158], and for similar reasons given above, if the parody is successful, it would not cause ‘a significant number of consumers to believe that the business behind [Get Pisterine] was the same as or connected to the business behind [Listerine].’ For Kendue to succeed, the court would need to accept a *very* relaxed interpretation of misrepresentation. Indications from cases such as *Fenty v Arcadia* are that British judges claim that they are holding firm on the need for misrepresentation – i.e., Rihanna succeeded not because of appropriation of her image but because of specific facts that would cause the public to believe wrongly that she authorised the t-shirts. The challenge is that this is based on the conclusion (which is not necessarily evidenced empirically) that members of the public would assume a commercial association. There is a risk that a judge might say that consumers would believe that this sort of parody has been authorised. If that is the case, misrepresentation would be made out, and some sort of harm would likely follow.

**(ii) Advise Joshing on the likelihood of it being able to register its internal spirit measure under the Registered Designs Act 1994**.

For Joshing to register its internal spirit measure, the design must be new and have individual character: s.1B(1). More information would be required, however, there are indications that novelty would be made out. This is because Joshing has not found any similar spirit measures in the UK and US, which would seem to suggest that there is ‘no identical design’ and ‘no design whose features differ only in immaterial details’: s.1B(2). The lack of similar designs may also suggest that there is individual character as defined in s. 1B(3). The main issue for Joshing comes from exclusions in s.1C. Two are problematic. First, the fact that the measure is inserted in the neck of the bottle may mean that the external shape is excluded from protection by s.1C(2). Second, if the entire shape is solely dictated by technical function, then it will not be possible to obtain a registration: s.1C(1). This test is strict; as seen in *DOCERAM*, any non-technical considerations (even if minor) will exclude the operation of this provision. If Joshing wishes to obtain design protection, it may need to be able to point to some aesthetic consideration to oust s.1C. In contrast, it may be more difficult to ‘design around’ s. 1B, given the function of the product.

1. Although “literal” is the word used in Actavis to describe the old approach, the word in this question was clarified by email to the students to mean “normal” or “literal/purposive”. [↑](#footnote-ref-1)