

FACULTY OF LAW

POSTGRADUATE DIPLOMA IN INTELLECTUAL PROPERTY LAW AND PRACTICE 2022-23

Examiner's Report 2023

PART I

STATISTICS

A.

- (1) Numbers and percentages in each class/category

Category	Number			Percentage (%)		
	2022/23	2021/22	2020/21*	2022/23	2021/22	2020/21*
Distinction	16	(15)	(16)	20.5	(18.07)	(25.53)
Merit	21	(27)	(22)	26.9	(32.53)	(32.35)
Pass	39	(33)	(19)	60	(39.76)	(27.94)
Partial Fail	2	(5)	(10)	2.5	(6.02)	(14.71)
Fail	0	(2)	(1)	0	(2.41)	(1.47)
Total	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:

Vivas are not used in the IP Diploma

- (3) Marking of scripts

Scripts are doubled marked according to the criteria in the examination conventions. Additionally, in 2023, 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, 150 out of 386 coursework assessments (38.86%) and 22 out of 77 examination scripts (28.57%) were double marked in 2023.

The Board did not consider that any scaling adjustment was necessary.

NEW EXAMINING METHODS AND PROCEDURES

B.

In 2022, the Board of Examiners recommended reconsideration of the existing practice for monitoring compliance with word limits and citation requirements. Under the existing system, a sample of scripts was spot checked for each coursework assignment. Candidates whose scripts were found to have breached the requirements were then flagged and all future submissions from these candidates were checked. The Board recommended adopting one of the following alternatives:

- All scripts to be checked for compliance , or
- All scripts for particular assessment units (e.g. two coursework assignments) would be checked.

The Board, however, recognised that the feasibility of the first option may be dependent on the existence of appropriate technological support. On investigation it was found that all checks must be done manually.

In light of this, the Board's second recommendation was adopted and checks for word count and citations of all scripts were carried out in relation to three coursework assignments. This practice generally worked well. It was, however, administratively difficult and time consuming to implement. A significant practical challenge was that the software used to carry out word count checks (Microsoft Word) included symbols such as bullet points and Roman numerals, whereas candidates may not have included these in their own count. In 2022-23 all such symbols were manually removed during the checks in order to adopt the most generous approach to candidates. However, the Board recognised that this resulted in a very time-consuming and inefficient process.

C.

In recognition of the administrative difficulties incurred in monitoring compliance with word limits described at Part 1.B above, the Board recommended that the Examination Conventions be amended to inform candidates that the word count of submissions will be checked by implementing the submitted text into Microsoft Word, and that the software counts bullet points, Roman numerals, etc.

The Board also recommended amending the Examination Conventions so as to more explicitly highlight to candidates the possibility of breaching the University's plagiarism rules through auto-plagiarism and collusion.

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

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

PART II

A. GENERAL COMMENTS ON THE EXAMINATION

1. Second and third marking

See Part I.A(3) above.

2. Materials in the examination

The examination, Intellectual Property I and II, was conducted on an open book basis.

3. Legibility

All examination scripts were typed.

4. Word limits in coursework assessments and written examination

The Board 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.

5. Scaling Adjustments

The Board did not consider that any scaling adjustment was necessary.

6. External Examiner

Professor Tanya Aplin continued in her role as an External Examiner and was fully involved at all stages of the examination process. Professor Aplin has now completed her term as External Examiner after several years of service. The Chair wishes to express her gratitude for Professor Aplin's commitment and valued guidance both this year and in previous years.

7. Internal Examiners

Professor Ben McFarlane served on the Board for a third year and Brian Cordery served for a fourth. The Chair expresses her gratitude to both for their continued commitment and support during the examination process.

8. Assessors

In addition to the examiners, 34 colleagues acted as assessors. The Board is very grateful for their commitment and timely marking.

9. Diploma Administrator

This year, Marina Amiconi took over as Diploma Administrator. Her support was invaluable in ensuring a highly organised and timely examination process.

B. EQUALITY AND DIVERSITY ISSUES AND BREAKDOWN OF THE RESULTS BY GENDER

	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	

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	17	22.07	17	22.07	22	28.57	20	25.97	1	1.3	77
Patents 2	6	7.69	28	35.9	25	32.05	19	24.36			78
Trade Marks and Passing Off	18	23.07	21	26.92	21	26.92	17	21.79	1	1.28	78
Copyright	22	28.20	25	32.05	18	23.08	13	16.67			78
Designs	13	16.67	23	29.49	21	26.92	19	24.36	2	2.56	78
Intellectual Property I and II	7	8.97	32	41.02	21	26.92	18	23.08			78

D. COMMENTS ON PAPERS AND INDIVIDUAL QUESTIONS

These appear in Annex 1.

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

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. Ben McFarlane (Internal Examiner)
 Prof. Tanya Aplin (External Examiner)

COMMENTS ON PAPERS AND INDIVIDUAL QUESTIONS

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

A. Coursework assessments

Patents I

The problem was based on a patent which described a fitting or fittings for a draining system for an ablution water container which may, at the selection of the user from within the ablution water container, direct the wastewater either into pipes which connect to the standard domestic wastewater system, or into pipes which lead the water from the house into the garden, and into flower beds or plant containers.

This could be achieved in two ways:

- 1) a “two plughole solution” adopted by Tabitha in the bath at Penscombe: drilling a second hole in the bath and connecting a second plughole fitting which directs water to the garden, or
- 2) by a single, bifurcated fitting that Tabitha conceives, and describes in the patent, but has not yet made at the time of the questions.

Although the patent description described embodiments with a “single fitting” solution, the claims could cover both.

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

There were no priority points raised in this question.

Question 1

Infringement

The first question was confined to the “Showersava” device.

Claim 1 described an “ablution water container”. The patent is written in the context of a bath or sink. A question arose as to whether a shower tray is a “container” (in that because a shower tray has no plug, it does not contain water, merely redirects it.). Some but not all students identified this point.

Claim 1 specified a “plurality of drainage outlets”. Whether this feature was present, and whether at least one outlet could be “blocked” depended on where the “outlet” was. If it is construed as the outlet to the container (the plughole), the Showersava has only one, and it is not blocked. If the “outlet” could be further downstream, a plurality is present, and at least one can be blocked.

Claim 1 stated “such that waste water may be directed to either the usual domestic wastewater disposal system or directed to an external garden watering system”. This gave rise to an argument about whether “or” in the above sentence is an “exclusive or” (i.e., the water must be directed to the garden, or to the sewer, but not both). The Showersava could direct water to the sewer, or to both, but it could not direct water only to the garden. This gave rise to an argument that there was no literal infringement. A similar issue arose in respect of claim 4. Some but not all students identified this point.

In each case above, candidates had to consider the Actavis tests for equivalence. Most students who identified the non-infringement arguments arising from “or” in claims 1 and 4 went on to apply the Actavis questions.

Question 2

Infringement – acts and liability for infringement

There were two main areas of infringement in the fact pattern:

- 1) Supply (and surrounding facts) of the “Showersava” fitting; and
- 2) Supply of parts and instructions for creating the “two plughole solution”.

The facts provided people having different roles in the manufacture, and the import and sale of the Showersava, raising questions of liability for primary infringement under s. 60(1).

Most candidates correctly considered the various grounds in s. 60(1) (making, keeping, importing, use etc). Some candidates also identified issues of joint tortfeasance. The facts also raised issues relating to the supply of “means essential” for making the “two plughole solution”, and liability for infringement under s. 60(2), and the defence of s60(3): staple commercial products (unless made for purposes of inducing person to do an act which infringes).

The main issues were generally correctly spotted and well-handled.

There was also a proprietorship question which affected who the correct claimant was, as Penscombe Plumbing Limited, not Tabitha, is the patent proprietor. Most candidates identified this.

Question 3

Invalidity – novelty

The question provided candidates with a publication (Daily Scorpion article) which was not novelty destroying, and a prior disclosure (the two-plughole bath at Penscombe) which anticipates claims 1 and 4. Most candidates correctly identified these as the relevant pieces of prior art and applied the novelty test from Synthon.

The facts raised a confidentiality issue (the disclosure to Katie) which nearly all candidates discussed, correctly concluding that this disclosure did not form part of the state of the art.

Invalidity – lack of inventive step

The prior art was designed to make the candidates carry out a Windsurfing/Pozzoli analysis in relation to the prior art and all the patent claims. Candidates generally showed their knowledge of the relevant questions, and of the need to provide reasons for their answers to those questions, albeit with different degrees of detail and care. In the setter’s view the dual plughole would not be obvious over the Scorpion article, and the bifurcated plughole would not be obvious over any prior art. The use of standard sizes would be obvious, as would the use of a green plug.

Invalidity: excluded subject matter

Claim 3 (use of a plug coloured green) raised the question of whether this fell within excluded subject matter of the presentation of information. Few candidates identified this as a point.

Invalidity: sufficiency

Candidates generally identified that Claims 1 and 4 may suffer from claim breadth insufficiency, i.e., the description does enable the PSA to make something which falls within the class (the bath embodiment) but doesn’t enable the PSA to make other things falling the class (a shower embodiment).

Some candidates attributed too little knowledge to the skilled person, finding insufficiency where the skilled person would likely have had sufficient knowledge to put the claimed invention into effect.

Question 4

Title, and amendment

Although most candidates dealt with the title point in question 2, not all addressed ways of resolving the problems with title that they had identified.

Few handled the amendment issues well, but there is no single saving amendment:

- Some candidates correctly proposed amendment of claim 1 to restrict to a single fitting. This would overcome the Penscombe bath prior art, which has two separate plugholes. There is support for this in the specification (Line 70). Claim 2 includes this feature, but also includes the bifurcated plughole, which is not present in the Showersava, so amendment of claim 1 would be preferred. This amendment doesn't help with insufficiency, though.
- Restricting the claims to baths and sinks would overcome sufficiency but would not capture infringement.
- Amendment to add the limitation from line 54 "at the selection of the user from within the ablution water container" would help with the Scorpion prior art but not the Penscombe dual plug solution

Patents 2

The question was based on an invention made by an individual to add a member of a defined class of chemicals called "tosins" to paint which would act as a temporary dye so that when the paint was applied, it would show the coverage but when dried would return to the chosen colour.

The question tested understanding of most mainstream areas of patent law and practice including entitlement to priority (substantive and formalistic), novelty (including confidentiality and section 2(4) on the definition of the prior art), inventive step, insufficiency, construction and infringement (both on a normal construction and by equivalents).

For the first time this year, candidates were asked to prepare initial disclosure lists. These are established firmly in the CPR and it was considered important that candidates should get used to drafting them.

The particulars of claim were generally well done.

Most candidates, importantly, explained their decision to include or not include the German manufacturer as a defendant, including consideration of joint tortfeasorship.

Positively pleading validity is not a good idea, though many candidates did plead it. If there is going to be a claim to relief by publicity, the notes should explain why that is a good idea.

The prayer for relief needs to include a claim for an inquiry or an account, and (which some candidates omitted) a claim for the payment of any sums found due together with interest.

Candidates should include in the pleading, or explain in their notes, how they comply with the requirement for stating compliance with pre-actions protocols.

Pleadings should be carefully proof read to ensure for instance that the patent number is correctly given and that the reference to Defendant or Defendants is consistent throughout.

It is important for the particulars of infringement and the notes accompanying them to consider each product and (if more than one) each defendant, and in the context of the product claim, the acts under section 60(1)(a), in the context of each process claim, the acts under section 60(1)(b) and (c), and for all claims, contributory infringement and section 60(2). The knowledge requirements of sections 60(1)(b) and 60(2) should be referred to and distinguished.

The pleading needs to be clear and logically structured so that, together with the notes, it is clear what has been covered and why. The best answers had a logical and concise structure and made sensible, explained, choices on what to cover.

Equivalence should be considered for claims 3, 4 and 5 and reasons given for including, or excluding, it from the pleading. Equivalence should not have been considered in relation to claims 1, 2 and 6. Where an assertion was made that claims 3, 4 and 5 were infringed on a normal construction, without equivalence, that should have been supported by an explanation in the notes. In general candidates recognized the correct test. It is important to consider what the inventive concept is of the claim rather than the patent (otherwise the first two Actavis questions produce the same answer regardless of claim wording), and that includes consideration of the fact that one is dealing with dependent claims particularly as regards the third Actavis question.

The Defence and Counterclaim was generally well done. Candidates recognized the importance of considering every paragraph of the Particulars of Claim. Some candidates omitted a denial of validity in the Defence, including it only in the Counterclaim.

The Grounds of Invalidity were generally well done. Candidates recognized the potential chain-of title priority issue. Some candidates also recognized a possible issue lack-of-support priority issue for claims 5 and 6, and either pleaded it or explained why they were not pleading it.

A logical structure for the Grounds of Invalidity made clear which prior art was pleaded for novelty and for obviousness against which claims generally or only if priority was lost, with the decisions explained in the notes.

In relation to the Manisha-Jeremy and Jeremy-Ashok conversation, confidentiality and the 6 month grace period should be considered for both interactions, including consideration of the consequence of breach of confidence by Jeremy in making a disclosure to Ashok. In relation to UV Light Paint, better answers considered the meaning of “change” (permanent or not) and “light” (including UV or not). For the Bowler letter, it was important to note that the proposal was to add a tosin to water, not paint. For Manisha’s exhibition appearance, a question arose about whether an intention to show a product is sufficient to amount to making it available to the public. Some inference could be drawn about the extent of disclosure from Ashok’s report of the exhibition. Most candidates recognized the sun cream as a red herring.

The notes should include a discussion of insufficiency at least as to breadth of claim insufficiency in claims 1 and 2, even if unpleaded, and if pleaded, some explanation of the basis should be included. The Initial Disclosure lists were generally well done, with most candidates recognizing that material that is already in the other party’s possession does not need to be included. The inclusion of a letter before action in initial disclosure should be explained in the notes – for instance, some candidates included it to support their pleaded case as to knowledge of the patent in support of s60(1)(b) infringement.

Most points on the notes have been included above. The inclusion of a claim chart in relation to infringement and validity was generally helpful. The infringement claim charts were particularly useful in identifying where the infringement case would be based on equivalence.

Trademarks and Passing Off

Q1.

Analysis of any potential cause(s) of action against CrassWarfare as well as: any risk of counterclaim against the various marks; any points of weakness in the potential claims; and any available defences for CrassWarfare (75 marks)

Infringement analysis

Question 1 was broadly framed but we expected students to consider all trade mark infringement options under ss.10(1)-(3), as well as passing off. Although there likely would be copyright and design issues in a real world scenario, these were expressly excluded.

All students managed the application of each aspect to some degree, but the stronger papers considered all three of s.10(1)-(3) analytically and systematically, whilst some students lost marks by immediately focusing on particular elements only, without adequately explaining why other grounds of infringement might not be available. Although the marks were clearly not identical, the similarity between HOMEQUITY and NOMEQUITY was intended to make students comment on whether such differences would go unnoticed.

A systematic approach would first apply the tests common to all aspects of s.10:

- use of a sign (including the extent of use in the UK, which applied the jurisdictional test of targeting and the potential clues given in political and other references such as currency, shipping etc) as to what acts of infringement (advertisement, application to goods etc),
- in the course of trade (whether a partial donation of profit still qualified as trade),
- without consent (clear on facts).

Most students applied these aspects relatively well.

Similarity of marks should then be applied, considering each of the aural, visual and conceptual similarity of the marks/signs in question, noting, among others, the close similarity between the N and the H on identity and the fact that both the allegedly infringing signs are in the heritage font.

Some papers set this out in a table to consider the different elements of similarity across the various marks/signs at issue (almost like a claims table in patents) which can be an effective use of words and made for easy reading. The strongest element of similarity was conceptual – both the marks and the infringing signs played with the concept of equity in home ownership (with home/no equity being a negative connotation of the original). Given the parodic nature of the Crasswarfare products students were expected to make much of this point in common conceptual similarity (both mark and signs were neologisms) as well as consider if a parodic treatment might actually suggest separate ownership/origin and point away from confusion. Many did not consider this aspect sufficiently when it would likely be a major issue for consumers. Brand owners tend not to parody themselves.

Similarity of goods, mapping the Crasswarfare offering to the specification of the Toddington marks as registered was another opportunity to differentiate on quality of analysis, comparing an App and web browser games with computer software (*per se*) for example. The analysis of a board game vs toys and playthings and other elements, channels of trade were all relevant, as was the changing

nature of entertainment and games over time (and convergence on smartphones of real world and virtual games). Most students covered the basics well.

The application of a likelihood of confusion was generally correctly done, applying a multi-factorial assessment of all relevant factors, including all the above. The best papers also took into account the “context of use” which offered mitigating factors as to whether confusion was more or less likely in a parodic context, given Crasswarfare seemed to be making a wider point about capitalism and home ownership which would be less likely to be confused with the origin of the original HOMEQUITY games and software. Many papers correctly identified that confusion may not yet have arisen as the infringing product was due to drop soon but had not yet launched.

The application of s.10(3) enabled students to consider the test for reputation and how it might be evidenced. Given it is not a particularly high standard to establish reputation, it was clearly met here, and most students identified this as a stronger cause of action. The best papers identified that s.10(3) gave a good route for infringement specifically because confusion might not have been as likely in a parodic offering. Crasswarfare appeared to want to sail close to the wind but were aiming at ironic and parodic, not deceptive as to origin. There were multiple factual references to support reputation, extent of sales, longevity, top seller-stats, permeation of the product name into popular culture etc. More importantly, unfair advantage, tarnishment as well as dilution could all be argued on the facts. Tarnishment in particular is rarely available but Crasswarfare were making a wider point about the negative aspects of obsession about home ownership, which was potentially harmful for the brand and reputation of Toddingtons given the divorce count attributed already.

Passing Off

Students were expected to apply the usual passing off analysis, under the classic trinity of *Jif*. Again, this was universally applied.

Most students recognised that goodwill could be established, using the same analysis as reputation. Goodwill must subsist in the UK, but there were plenty of facts to establish this. Additional marks were awarded to students who explained *why* passing off was important here, given that some of the marks suffered from either revocation risk or validity/bad faith challenges (see below). Passing off/ goodwill may well still have been generated in the older boards which are still likely to be in many UK households but long past the 5 year use period for trade marks.

Defences and Counterclaims

Most students correctly analysed whether the mark HOMEQUITY was inherently distinctive (likely yes as a neologism) and whether it was wholly descriptive of the concept of the game (probably not entirely). The marginal stylisation was also relevant here. Again, most students recognised that even if it was originally descriptive it should have acquired distinctiveness given longstanding use and notoriety.

The reference to the dictionary definition may suggest a long term risk of genericism/customary in trade, but query if consumers still perceived it as an indication of origin despite its inclusion. Analysis was mixed here.

The '123 mark was liable for revocation given no actual sales of the game has been made in that form for more than 5 years. Would use of the later mark count (or was that mark sufficiently different)? Note also the spec was for toys only. Most students recognised the non-use risk but some analysis was rather superficial whereas stronger papers explained why there is an effective defence for marks on which use cannot be shown and are as such unenforceable for that aspect. Extra marks were on offer for any student that identified that the non use could potentially be "cured" by licensing any of the third party use and seeking retrospective effect.

The '456 mark fared better in risk, but also seemed liable to revocation across a range of class 9 goods and note the web-based version ceased use but the smartphone version might still constitute use for computer software.

Some (but by no means all) students recognised that the '789 mark might be vulnerable to a *SkyKick* breadth/intention challenge as computer software *per se* but rather too many papers dismissed this immediately following the Court of Appeal decision without considering whether situation was wholly analogous to Skykick. Note unlike Sky, Toddington are not a software company and had to outsource the development of their App so it was hard to see how they had a genuine intention to use the whole computer software spec. There was rather more risk here than many recognised.

The pending application is still under examination, but note if registered it may be vulnerable to a Monopoly/Tesco evergreening challenge also given the repetition of marks and spec which might be seen as an attempt to circumvent non-use rules. The same considerations applied to the computer software element of '789 which was an "evergreen" of that element of '456. Only the strongest papers picked up that element, which was rather buried in the detail.

Do Crass Warfare have any other kind of defence beyond counterclaim? Descriptive use? Is a defence of parody available? Is the mark being used to indicate origin? Does the not for profit claim help? Likely no on all scenarios but marks were available for considering all those issues. Many students picked up on those aspects but few all or most.

Q2.

Consideration of strategy, including as to: which forum might be most appropriate for resolution of the dispute; the remedies Toddingtons might seek; any steps which could be taken to strengthen Toddington's position; and any other strategies the client might consider, with an explanation of the advantages and disadvantages of any strategies proposed. (25 marks).

Question 2 was intended to get students to apply the potential causes of action and relevant facts for maximum strategic benefit. Most students did fairly well on this aspect (some in fact comparatively rather better than in the Q1 analysis). The best papers again applied this fairly systematically and by theme, but broadly speaking we were looking for:

Where an action could be brought. Most students correctly identified the good facts (charities, Jeremy Hunt reference) and missing information (currency, shipping etc) for the UK courts to have jurisdiction. But a trap purchase would likely fix all that anyway if fulfilled. Having got jurisdiction, most papers included consideration of the pros and cons of IPEC vs the High Court and additional marks were also provided for consideration of the Shorter Trial Scheme.

What else? Some impressive alternate strategies were also analysed, recognising that a trial may be great for Innocent and the law firm, but less of a goal for the Taddingtons business. Could the website be challenged? Could it be taken down through e-commerce exemption/notice & takedown? What about the Appstores? Could the route to market be cut off? What about unjustified threats? A customs watch at borders? A UDRP? Many students identified a number of viable alternate enforcement routes which could be quite effective.

Against whom? Many papers correctly identified the need for court permission to serve out on a German based entity, but also recognised the ability to put individual UK based directors at risk through allegations of controlling mind and joint tortfeasorship.

Mitigating strategies? What new marks might be filed? Could any of the historic or unlicensed use be legitimised to reduce validity or revocation risk? Both these were relevant considerations. Finally, a number of papers should be commended for identifying the PR/reputational risk for the various enforcement options, taking on an entity such as CrassWarfare who were deliberately targeting the products to make a wider socio-political point, as well as “doing good” by donating profits to charity.

Copyright

The fact pattern

The candidates were asked to advise Earlydays, which invested in works of art and used them to create commercially attractive works for sale. It had a five-year plan to increase its business and was negotiating a loan with a Bank to invest in better communication tools and more physical premises. The Bank had indicated to Jenny, Earlydays’ CEO, that it would want a secured loan.

The coursework focussed on a painting, Abdidot, and two crops from it, Crop1 and Crop2, reproduced below. The painting had been painted by Abdi, from Somalia but living in Milton Keynes at the time he did the painting. He had attended some art classes, run by Bram, at the TitianCC art centre, and signed up for their termly draw using a form on the back of the poster advertising the art classes and the draw. The theme for the term was The Red Dot. Abdi’s painting won the draw, even though the red dot on his painting had got there by accident. Abdidot was added to TitianCC’s collection. The Crops of Abdidot were done by Anna, from TitianCC’s marketing department. Both Crops included Abdi’s red dot. TitianCC was using various merchandise incorporating Abdidot or the Crops, including mugs, one of which had been given to Abdi.

Abdi had become aware that copies of Abdidot were being used on poor-quality third-party products and that TitianCC had not been monitoring those uses. An example was that an exact copy of Crop2 was being used by an online seller, Giftart, on wrapping paper it used to send its gifts to customers.

Abdidot had complained to TitianCC, indicating that he was unhappy that the work was not being used for TitianCC's benefit as he had thought it would be, in ways he found upsetting.

Earlydays was interested in acquiring Abdidot, Jenny having seen it in the 50th anniversary of the competition. It had become aware of the problems, as had the Bank. Both the Bank and Earlydays were concerned to know that these and similar problems, both present and future, could be resolved.

The questions

Candidates were asked to write a briefing note for their partner, Sam, to advise Earlydays as to the wider points it should consider when acquiring art and when dealing with the Bank, bearing in mind that Sam planned to use the briefing note when meeting the Bank's inhouse IP lawyer.

Earlydays wanted to use the circumstances surrounding Abdidot as a guide.

The questions

There were three questions. There was also detailed guidance as to what to cover. The best papers took that guidance into account when answering. They structured the papers well, making it clear to any reader what the points in issue were, what the relevant law was, and then applying that to the facts and reaching a conclusion. Examples are below.

Overview of the coursework answers

Overall, the examiners were pleased to see that generally the candidates had understood the law and were able to apply it to the facts, the best doing so very persuasively. Most papers were in much the same range, with good handling of the points. Some were less good, some were excellent. There was some use of note form, some considerable. The Examiners generally found that style less persuasive and drew it to the attention of the Exam Board where it seemed excessive.

The good papers assumed that the reader did not know the underlying law, or would benefit from a reminder of it, so explained it and how it applied to the facts. Weaker papers assumed that knowledge on the part of the reader, which made those papers harder to follow and less persuasive, bearing in mind how Sam wished to use the memo. For example, some said that Abdidot was original, without setting out why that mattered.

Candidates relied occasionally on the wrong authorities (e.g. on Hardacre [1905–1910] Mac.C.C.1 rather than the CDPA as authority for the fact that exclusive licensees have the right to sue, and on the InfoSoc Directive rather than the CDPA for the acts of infringement). One relied on an unreported case without indicating how its asserted findings could be verified.

It was noticeable that some candidates relied considerably on secondary authorities such as textbooks, rather than the underlying law. This was less persuasive than those who relied on the primary authorities.

Of the authorities, *Designers Guild* and what it says about the taking of a substantial part was the least well handled. The best candidates said that the test looked at whether the part taken reflected the author's skill and labour, reflecting Lord Scott, and fitting well with the EU test as to whether the author's own intellectual creation has been taken. The examiners felt that they should not penalise too heavily for the less persuasive arguments here.

Question 1 was generally soundly answered. Questions 2 and 3 varied, with a trend towards good answers to Question 2 accompanied by a less strong answer to Question 3, and vice versa.

Question 1 Abdidot

This was in three parts. The first asked what copyright there might be in Abdidot and the Crops and how strong it was. The second asked where that copyright might lie, and what rights Earlydays might acquire, both maximum and minimum, to exploit those works and stop third parties infringing. The third asked what factual investigations Earlydays should carry out in relation to its other art, and how it might avoid future problems.

Most candidates understood that the relevant provisions on copyright could be found in the CDPA and that for copyright to subsist, there had to be a work, which had to be original, and had to qualify for protection in the UK. The best set out what the CDPA provisions said and where they could be found. The less strong papers tended to assume that the reader knew, or relied on footnote references to the relevant sections of the CDPA without setting out what they say.

The best papers picked up that Abdidot might have been painted before the CDPA came into force and said that that should be checked, but proceeded on the basis that the CDPA applied. They pointed out the two tests for originality and applied both to Abdidot and the Crops, recognising that although no UK court had yet determined which test to apply, most had now proceeded on the basis that if the European test could be met, the UK test would be too.

Most candidates had little difficulty in concluding that Abdidot was an original artistic work, particularly, a painting. They argued persuasively that Abdi's decision to keep the accidental red dot was a creative choice. They picked up that as Abdi was from Somalia, Abdidot would only qualify for UK copyright protection if Abdi was resident or domiciled in the UK when he painted it or if it was first published in a qualifying country. Some papers however assumed that Abdi was resident or domiciled in the UK at the time he painted Abdidot, which was not evident on the facts given. As throughout when faced with uncertainty, the better papers explained the consequences: they said that whilst there might be a route to qualification, it would need to be checked, and if it turned out not to be the case, Abdidot might not qualify at all.

Candidates found the Crops more difficult, particularly given the absence of information as to how Anna had created them. Better papers explained what kind of artistic work they might be and why, indicated that proving originality might be a problem but was probably superable, and indicated that as derivative works with not much change, the originality was likely to be limited at best. Some assumed without more that the Crops qualified.

Most candidates were confident to say that if copyright subsisted in Abdidot, it would be strong, and that even if copyright subsisted in the Crops, it would be quite weak.

Most candidates recognised that there were problems in showing the Abdi had assigned his copyright to TitianCC, referring to the vagueness of the wording of the poster and to the greater likelihood that Abdi had granted a licence, the scope of which was unclear. The better ones said that for Earlydays to acquire copyright, it would have to get it from the right owner, most probably TitianCC or Abdi rather than Bram, and that given the uncertainty, it would be best to get comfort from both, e.g. via a confirmatory assignment from Abdi to TitianCC on suitable terms, and a subsequent assignment from

TitianCC to Earlydays, with relevant terms such as warranties. The best looked at how Abdi might feel and how to persuade him to make the assignment. They recognised that Abdi would also have unassignable moral rights and dealt with those. They also recognised that TitianCC's current use of the works would have to be sorted out – e.g. by TitianCC undertaking to stop that use, or by Earlydays giving it a licence back, perhaps for a payment. The minimum rights Earlydays would want were well explained, with most saying that an exclusive rather than a non-exclusive licence would be better.

Most papers looked at whether Anna had or had not created the Crops in the course of her employment, and that it was key to check, with the best starting by checking her contract. Candidates did not always explain or deal with the position if she had done them outside the course of that employment.

Many candidates listed a set of terms Earlydays should seek, with better papers explaining why they were desirable on the facts. Some of the best showed a strong understanding of commercial law, suggesting provisions such as a requirement for TitianCC to obtain warranty and indemnity insurance cover in light of its probable inability to satisfy any significant claims against it.

The best papers also suggested that Earlydays should audit at least a sample of its most commercially valuable works, to see the position and take steps to strengthen it where necessary, and suggested future steps, including a checklist for those acquiring new works to work to.

Question 2: Giftartpaper

The question asked candidates to look at what Earlydays could do about Giftartpaper, assuming it had all the relevant rights in place. The question was best answered by those who specified the possible acts of infringement, both primary and secondary, and then considered whether those were infringed by Giftartpaper and the dealings in it. They looked at whether Giftartpaper had been derived from and was similar to each of the Crops or a substantial part of them. They were confident to say that it was highly likely that that these were copies, given that Giftartpaper contained a replica of part of Abdidot, which was itself unique.

The next step led to some confusion. The best papers confidently said that Crop2 had been had probably been copied, given that it appeared on TitianCC merchandising and had been reproduced in its entirety. They said that there was less certainty over Crop1, which could probably be ignored, as the case on Crop2 and particularly on Abdidot was stronger. Many concluded that a substantial part of Abdidot had been taken, perhaps indirectly, although the reasoning was not always strong. Some recognised that although the only originality there might be in Crop2 lay in the way it had been cropped, not in what was depicted in it, so an infringement action based on it would be weak.

The infringing acts were generally handled well, although the issuing of copies to the public by Giftart was sometimes misunderstood, with candidates saying that there was no infringement as TitianCC had itself issued other copies.

The possible defences were generally confidently dismissed, with good discussions on quotation and pastiche. This was not a question about s51, as the copy on the wrapping paper was clearly surface decoration and thus s51 could not apply.

It was apparent that candidates understood what various steps Earlydays could take and what remedies it could recover. The best picked from the range and suggested specific ways forward in view of the facts and Earlydays' commercial needs.

Question 3: The Bank

There were some good answers here, and some which did not do much more than describe generally what banks can do, without applying that to the facts. Few started from the basis that Bank's primary concern would be to be able to realise sufficient funds from the security given to it by Earlydays, if Earlydays defaulted on the loan. Many however recognised that the problems with the IP might make the Bank reluctant to lend, or lend much, on the back of it. Particularly strong answers recognised that the Bank had better security open to it, such as over Earlydays' existing properties and website. Many candidates discussed the different pros and cons of mortgages and legal charges. Not many said that security could be taken over any royalty streams. The good answers here stood out.

NB: Abdidot was in fact painted by a primary school pupil. Thank you to them for allowing it to be used.

Abdidot:



Crop 1:



Crop 2:



Designs

1. The fact pattern

The candidates were asked to assume they were an associate in a law firm, who had been requested to prepare a memo to assist their partner in advising Jamesplc, at a forthcoming meeting. Jamesplc had two divisions, one, Jhome, making middle of the range furniture, the other, Jaspire, making higher standard furniture. Jaspire was very profitable; Jhome, which Jamesplc was preparing to sell, less so. Two problems had arisen. The first concerned a rocking chair, Jaspirechair, sold by Jaspire. A competing chair, Endo1, appeared to have been put on the market by a company, HomeGallery, which had been set up by a former employee of Jamesplc, Dirk Bogart, shortly before he left. Jamesplc thought it might be a copy of the prototype of its Jaspirechair, JaspireMark1, and or the Jaspirechair actually sold, JaspireMark2. JaspireMark2 had sold very well. Casablanca Ltd, a retailer of Endo1, had been undercutting JaspireMark2 but had taken the Endo1 off its website after receiving a letter from Jamesplc. Jamesplc wanted to know what could be done about Endo1.

The second problem related to a rocking chair, Jhomechair, sold for a number of years by Jhome, and a staple in many first homes. Jamesplc had received an email from Lavinplc claiming that Jhomechair was plainly meant to be its Dunjachair and asking it to stop sales. Jamesplc did not want to remove Jhomechair from the market. But nor did it wish to become involved in a dispute, given the potential sale of the Jhome division.

As well as images of JaspireMark1, JaspireMark2, Endo1 and Jhomechair, the candidates were provided with images of other rocking chairs (Otherchairs) on the market, although the dates when OtherChairs were first made available were not given. Candidates were also provided with a registered design for the Dunjachair, Lavinreg, which depicted a single colour photo, showing a rocking chair with a brown frame and a green seat.

2. The question

There was one question, in three parts. Candidates were asked to prepare a memo setting out

- 1 what UK design rights Jamesplc might be able to assert against Casablanca, Homegallery and/or Dirk in relation to the Endo1
- 2 Whether Jhomechair might infringe rights in Dunjachair and
- 3 The specific legal steps Jamesplc might take to strengthen its position.

Further instructions were given as to the nature of the advice to be given, including consideration of strengths and weaknesses of Jamesplc's position, and what strategic steps it might take, in relation to the problems described and generally in dealing with its designs.

3. Overview of the coursework answers

The question was generally soundly answered, with candidates showing a good understanding of the issues arising in designs law and its application. There were some weaker papers, and some which were pleasingly strong.

Most candidates dealt first with the Jaspirechairs, discussing UK unregistered design right (UKUDR) and the supplementary unregistered design (SUD) together with the possibility of obtaining, now, a registration for the Jaspirechair design(s). Some missed the possibility that there might be SUD protection. Some missed the possibility of a new registration.

Candidates then discussed the Dunjachair and Jhomechair, covering the LavinReg first and then the possible UKUDR rights, recognising that SUD could not subsist. That structure worked well, as did tackling the Dunjachair/Jhomechair first. Papers which discussed the issues by right (e.g. UKUDR then SUD then registration), rather than by chair, were less easy to follow.

The question asked candidates not to consider copyright or the continuing unregistered design. A few picked up that there might have been a relevant community unregistered design in relation to Dunjachair and discussed that. The examiners did not penalise those who did not.

The strongest papers made it clear what the issues were, set out the relevant law and then applied that to the facts before reaching a firm conclusion. They showed a strong awareness of the commercial issues facing Jamesplc and gave persuasive advice as to how those might be tackled. The less strong papers generally explained the law less well, gave less focussed advice, or gave advice which did not appear to take into account the legal and commercial position Jamesplc found itself in.

There were some consistent points which arose, set out in more detail below.

4. Dates of Otherchairs and first marketing of JhomeChair

The best candidates said that it was relevant to know the dates the Otherchairs had been put on the market, as the strength of Jamesplc position would be greatly impacted by that.

5. Jaspirechairs/Endo1

UKUDR

Most candidates recognised that Endo1 could infringe either, or part of either, but on appearance, probably not the whole, of JaspireMark1 and JaspireMark2. The best candidates picked the designs which were most likely to be original and infringed and focussed on those. Some weaker papers looked only at the whole of the chairs, without explaining why they were not considering parts. Most confidently said that the exclusions either would not apply or could be avoided by judicious choice of design.

The originality test was generally well discussed, recognising the need for the designer to have done more than merely avoided slavish copying. The need for a lack of commonplaceness was well recognised, and candidates mostly said that the other designs shown did not suggest there was commonplaceness here.

A considerable number of papers asserted that Jamesplc/ Chairace were themselves the designers, rather than the individual(s) who had in fact designed the chairs. The best traced ownership through those individual designers, recognising the need to look at relevant contracts. Some wrongly said that a commissioner could be the first owner.

Good candidates said that the circumstances in which JaspireMark1 was shown to the customers in Brighton would need to be checked, as e.g., if that had been done confidentially, that design might well not have been made available to the public, and so might not be a prior disclosure against JaspireMark1, and vice versa.

Candidates were good on the possible primary infringing acts. Most had little trouble saying that Dirk had probably acted knowingly in setting up his company and had probably authorised the launch of Endo1. A good number however did not appear to understand that Casablanca might not be liable for secondary infringement under s227(1) at all, because its sales would have ceased before it would have been deemed to have knowledge.

SUD

Where this was discussed, the discussion was generally good. Most candidates suggested possible designs to rely on that were not subject to an exclusion. They considered the need to confirm that the designs qualified for SUD. The Cantel test was well applied.

Candidates recognised that there would be no SUD in JaspireMark1 if it had not been made available to the public. They were confident to say that there had probably been copying.

Registration of Jaspirechair

Candidates suggested helpfully that Jamesplc might still be able to obtain registrations for the Jaspirechair or parts of it, given that the priority period was still running. Whilst they acknowledged that the JaspireMark1 (even if not kept confidential) and JaspireMark2 would not invalidate any such registration, not all looked at the impact of the Endo1 on those registrations. The best on this point said that if the Endo1 was asserted against the registration, that would not be a problem if its disclosure by or through Dirk was abusive.

6.Dunjachair/Jhomechair

Lavinreg

Given that the registration was a photo of a brown and green chair, and the Jhomechair was shown in brown and white, it was notable that not all candidates commented on that, or were confident to say that they would create different overall impressions. The best though did pick up that Jamesplc might have sold a chair in the same colourways as the registration, which should be checked.

Many candidates noted that it was possible that the Jhomechair predated the Lavinreg/Dunjachair, which might strengthen Jamesplc's position, and make infringement by the Jhomechair impossible. They also noted the defence under s7B of the Registered Designs Act (right of prior use), whilst recognising that that would probably not help Jamesplc in its contractual discussions with Handyhome, unless Handyhome bought the whole Jhomes business.

UKUDR

Here there were two main additional points to those considered in relation to the Jaspirechairs. The first was that Dunja Lumpar did not come from a qualifying country (Montenegro), so the Dunjachair might not enjoy UKUDR at all, although it seemed probable that it might have been first marketed by Lavinplc and so qualify that way. The second was that the other designs given had notable similarities to both the Dunjachair and the Jhomechair, which might either render the Dunjachair commonplace (and therefore not qualify for UKUDR) or so narrow the scope of the Dunjachair UKUDR that there was no infringement by the Jhomechair (the squeeze).

NB if the Brighton meeting was not confidential, Jaspiremark1 may not have been made available for sale or hire at it for the purposes of UKUDR, but could have been made available to the public for the purposes of SUD.

7. Threats

Candidates generally considered these and understood that both Jamesplc's message to Casablanca and Lavinplc's message to Jamesplc could be threats.

8. Remedies and strategy

Although candidates knew the remedies available, there was some confusion between an absence of infringement for want of knowledge, and a limit to the remedies obtainable in relation to innocently acquired goods. Some advised that Lavinplc might seek an interim injunction, which seemed unlikely on the facts. Some suggested that Jamesplc might seek a licence of right, which was not yet available. Some suggested assertive litigation against Endo1 whilst simultaneously recommending seeking settlement with Lavinplc, a rather contradictory approach which might not be in Jamesplc's commercial interests.

Next steps

The best candidates paid attention to the list of points to consider here, set out in the coursework under "note to students". The best answers here contributed noticeably to the candidate's overall performance.

Good candidates recognised that the best outcome for Jamesplc would be to get the Endo1 off the market, and to dissuade Lavinplc from bringing action. That would mean that the JaspireMark1 would no longer be undercut, keeping the Jaspire division profitable, and the popular Jhomechair would continue to sell, keeping Jhome attractive to buyers.

Recognising that Dirk was the fount of the problems with Endo1, they discussed various ways of tackling him and Homegallery robustly. They also recognised however that Casablanca was probably best left alone, or only asked not to sell in future in return for all possible action against it being dropped, particularly in light of the possible threats counterclaim Casablanca might otherwise bring, and its position as a potential customer of Jamesplc.

As for Lavinplc, they clearly advised that more information would be needed before a full strategy could be formed, but that a confident rebuttal of the assertions made seemed like a positive first step. More generally, they advised Jamesplc to be aware of the need to record the chain of title of its designs, to ensure they were deliberately rather than inadvertently disclosed, and that they were only made available after ensuring that all possible relevant rights could be claimed in them. They advised that all relevant contracts and contract provisions were put in place and checked. They also suggested that when new designs were being launched, appropriate checks were made to ensure that there were no third-party rights that might be raised against them.

Intellectual Property I & II examination

The final examination consisted of three questions. Questions 1 and 2 were compulsory problem questions. Question 3 provided candidates with a choice of 4 essays. Candidates generally performed well in the examination. There are, however, two points that are worthy of further comment.

The first is that a surprising number of candidates missed the breach of confidence point entirely in Question 2. This was a matter of some surprise since (i) the application of the law of confidence to plot ideas was covered during both the Residential Programme and the Second Revision Workshop; and (ii) candidates had been told that they should expect the second problem question to cover more than one intellectual property regime. In light of these factors and in light of the fact that many candidates did spot the breach of confidence issue and dealt with it well, the examiners concluded that there were no real lessons to be drawn.

The other issue that is worthy of note is that a small number of students seemed to struggle with essay writing technique. This is an issue that has been on our radar for some time, with students from science and engineering backgrounds sometimes expressing the concern that they have little experience writing essays, particularly in exam conditions. In light of this feedback, we introduced a session on exam writing technique into the Second Revision Workshop this year, but this year's exam performance suggests that more consideration needs to be given to how to address this skills gap.