

The Chartered Institute of Patent Attorneys

Comments on Legal Working Group – Team 7's

Draft Proposal for Rules on the European

Patent Litigation Certificate

and Other Appropriate Qualifications

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<u>CIPA Comments on Legal Working Group – Team 7's Draft Proposal for Rules on the European</u> Patent Litigation Certificate and Other Appropriate Qualifications

CIPA

The Chartered Institute of Patent Attorneys ("CIPA") is the representative body for Chartered Patent Attorneys in the UK. Most fellows (around 1,800 people) of CIPA are Registered Patent Attorneys regulated by the Intellectual Property Regulation Board ("IPReg") (a national Regulatory Authority supervised by the Legal Services Board under the Legal Services Act 2007) and are also qualified European Patent Attorneys (although the three groups do not completely overlap).

CIPA has been following the preparations for the Unified Patent Court (UPC) with much interest and is pleased that the matter of representation before the UPC under Articles 48(1) and 48(2) has been given consideration. It is clear that Team 7 has a good understanding of the relevant issues and much of the proposal is to be welcomed.

With regard to the draft proposals on the European Patent Litigation Certificate (EPLC) and other appropriate qualifications, CIPA attaches, at Appendix A, a mark-up of the draft rules showing proposed changes. The key points are the following:

- Rule 11 should recognise litigation rights awarded in member states as an appropriate qualification
- Rule 12(a) should additionally include the following courses:

Birkbeck College London course leading to the Diploma in Intellectual Property Litigation

Manchester University course "Postgraduate Certificate in Intellectual Property Law

Queen Mary College London, "Diploma in Intellectual Property Law"

Intellectual Property Litigation Skills courses accredited by IPReg

- Rule 12(b) be amended so as not to be limited to infringement actions and sole unassisted representation
- new Rule 12(c) to include a provision for responsibility in a requisite number of EPO oppositions and appeals to be an appropriate qualification
- the EPLC course be open to other suitable provider to deliver and not just universities or non-profit organisations
- the EPLC certificate course providers to be able to recognise learning and examinations already acquired by EPAs.

Cost, Competition, Access to Justice

Before commenting on the current proposals, CIPA wishes first to set out some important economic issues. For the UPC to be a success, it must be cost effective for litigants. With a supra-national court being set up, with new infra-structure, judge training and three or four person panels, there is a danger that the costs of the court system may put it beyond the reach of small to medium size enterprises. Already some national enforcement is beyond the reach of individuals and small businesses. The UPC is due to become the only venue for enforcement of European patents. It is going to take jurisdiction away from other national routes, for example the Intellectual Property Enterprise Court "IPEC" (formerly the Patents County Court) in England and Wales. The court fees are under discussion elsewhere, including how court fees are made affordable for smaller litigants without unduly burdening larger litigants, but there are also issues with the cost of representation.

For the first time, litigants in the UK will not be allowed to represent themselves in patent disputes. This has significant impact on access to justice. Whilst those owning patents will be used to dealing with patent attorneys, at least, those who are accused of infringement may not already have representatives, whether lawyers or patent attorneys. It is important for the pool of suitably qualified representatives to be as wide as possible. It is important for there to be as much competition as possible, in order for that competition to be reflected in the level of fees being charged. Most attorneys will restrict their actions to their fields of expertise. That specialisation should be recognised and they should not be required to demonstrate competence in areas in which they will not practice, even if they have the right to do so. Patent attorney qualifications do not restrict attorneys to particular technical fields. Patent attorneys restrict themselves to the technical field in which they have developed their competencies.

Within the UPC, steps are being taken to ensure that the judges will be of the highest quality and suitably trained. There is no limitation on the lawyers who may take cases before the UPC. Some will be specialists, not just in litigating patents but also in patent law and the technical field of the patent. But others will come before the UPC with no knowledge of patents. Whilst it is important that the patent attorneys appearing are able to deal with the issues in the cases in which they appear, it is also important that any hurdles before the patent attorneys are proportionate, and comparable to those set before any other person who is entitled to be a representative before the UPC. In particular, the knowledge base for patent attorneys (who will already have significant experience of patent matters, including oral advocacy in EPO oppositions) should be balanced against that of lawyers who, whilst knowing about general law concepts and litigation procedures in their home states, may know nothing of patents or the specialist procedures of the UPC, and should not be balanced only against the knowledge and skills of lawyers who specialise in patent litigation.

Rights of UK Patent Attorneys before UK Courts

The rights of UK Patent Attorneys to represent clients in patent infringement and revocation actions is governed by "Rights to Conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules 2012", promulgated by IPReg - the UK regulatory authority for patent attorneys. A copy of those regulations is at Appendix B. The UK profession is regulated and all attorneys are required by the Code of Conduct to act within their competence (Rule 4) and have appropriate professional indemnity insurance (Rule 17). The Code of Conduct is attached at Appendix C. Additionally, those exercising rights as litigators are subject to a supplementary code of conduct, "Special Rules of Professional Conduct applicable to Regulated Persons conducting litigation or exercising a right of audience before the Courts" also promulgated by IPReg. A copy of the litigators code of conduct is at Appendix D.

Most registered patent attorneys in the UK have the right to represent clients in appealing from decisions of the UK Intellectual Property Office to the High Court and have the right to represent clients in the Intellectual Property Enterprise Court, (in both infringement and validity cases). Patent attorneys who have taken such cases have been praised by the judges in their judgments for the way in which those cases have been handled. As with solicitors in England, not everyone who has a right to represent before the court exercises that right. Those that do ensure that they have taken appropriate training and may add others with different skills to their teams when undertaking specific tasks.

In order to start patent infringement cases in the High Court or represent clients in appeals alone to the Court of Appeal or the Supreme Court, UK registered patent attorneys require further qualification. In some cases, barristers may also need to be involved¹, but registered patent attorneys still have the right to manage the litigation. This widening of the pool of potential representatives is particularly important for access to justice.

In the vast majority of cases before the UPC, the key issues will be the construction of patent claims, the discussion of the law of infringement and an analysis of validity. In all such matters, UK registered patent attorneys are taught and examined². This is the corner stone of their skill and experience. Most will specialise in some area of technology. So it is very rare that anyone specialised in computing would venture into biotechnology or vice versa. We will come back to this in relation to the current proposals for course content.

Revocation Proceedings

If the UPC proves to be a success, and particularly if the UPC is able to deal with actions for revocation in a timely and cost effective manner, then there is the possibility that the opposition procedure before the EPO will move to the central division of the UPC. The majority of oppositions

¹ In the UK, there is a traditional split between those who represent and those who act as advocates.

Details of that will be discussed below.

before the EPO are run by patent attorneys. Very few of these cases involve other lawyers. European patent attorneys are the body of people with the skill and expertise to run these actions. When oppositions are being run, it is often to clear a competitor's patent out of the way before launching one's own products. In these cases, there are no infringement issues. Injunctions and damages are not in issue. Complexities of joint tortfeasorship do not arise. There may be no need for discovery and there may be no or only limited need for witness statements.

The rules do not make provision for a separate list for those who only want to take revocation proceedings. But notwithstanding that such revocation proceedings may, in the future, take place in a court and not in a tribunal, the core issues to be presented and decided upon in such cases remain the same as they are when the same matter is decided in the EPO. Patent attorneys, like other lawyers will need to learn the rules of this new forum for dealing with patent revocation. It is important for access to justice that any hurdles put before patent attorneys seeking to represent clients in such cases, are proportionate to the rights which need to be exercised. European patent attorneys are already at an advantage for UPC revocation actions, as Article 65 of the UPC Agreement confirms that the EPC provides the legal basis for decisions on validity and they already have extensive knowledge of the existing EPO case law on this topic and will be closely following any edicts from the UPC which will modify that practice.

APPROPRIATE QUALIFICATIONS

We are seeking to build a new pan-European court. This should not be built only along the lines of one national system, but must reflect and meld the different systems in different member states. The language used to define the type of relevant qualifications reflects some cultures but not others. It is not yet sufficiently inclusive of all European cultures and histories and we hope to see this remedied during this consultation process. In particular, the requirements for qualifications to be awarded by universities or similar higher education authorities, do not take into account cultures where the state authorises independent bodies to issue relevant litigation certificates or where learning takes place in the work place or through lectures organised by other types of organisation. Also, the current draft ignores the historical way in which professions have grown up and is currently likely to discriminate against the older members of the professions who have appropriate knowledge and experience — but who qualified before the relevant courses came into existence, whilst favouring the younger members of the profession who may have the book learning or been granted the opportunity to take a course and pass those examinations, but not yet had time to acquire the wisdom of long years of experience.

CIPA now comments on the Rules as drafted, firstly to deal with the other appropriate qualifications for entry onto the list and then to give our comments on the proposed EPLC.

We warmly welcome the provisions to provide a body of patent attorneys able to represent clients in proceedings before the UPC from the outset. We also welcome the provisions which recognise the wording of Art 48(2) that the European Patent Litigation Certificate is not the only form of

appropriate qualification. These provisions are sensible and well-chosen steps to provide litigants with a wide choice of representatives from the outset, and we urge the Preparatory Committee to keep these routes open. We also urge the Preparatory Committee to improve the draft still further.

The starting point will be to clarify who would belong to the body of patent attorneys who are able to take cases when the court begins. In particular, it should include those patent attorneys authorised to take revocation cases, whether those patent attorneys qualify by reason of Rule 11 or Rule 12.

Registration of Qualifications

All of those seeking entry onto the list by virtue of "other appropriate qualifications" will need to make an application to the Registrar (Rule 14). Currently we have no guidelines as to how this will be implemented – which qualification would be accepted and which would be refused. If the Registrar is going to be able to process such applications quickly, so as not to disadvantage litigants who wish to instruct European Patent Attorneys, the Registrar will need to have a manual of appropriate qualifications from individual member states. This may need updating in time, but it would be beneficial for this to be put together now. That will also provide clarity for those who need to know whether they already qualify or whether they will need to take a further course. That will also help potential EPLC course providers to start gearing up to the full course. Additionally, the list of recognised courses under Rule 12 should be expanded, regardless of whether a course might also qualify under Rule 11, once the transitional provisions have expired.

We therefore start our detailed review with Rule 11 and Rule 12.

Rule 11

This provision is welcome. However, we are not sure what is meant by passing an "equivalent state exam" in law. In the light of the fact that regardless of how the qualification regime has changed over the years, we have a regulator which issues litigation certificates in the UK, we propose that this rule is amended to include the wording "or who have obtained a litigation certificate entitling them to conduct litigation in a court of a Contracting Member State".

UK patent attorneys are required to take examinations which permit them to register as UK patent attorneys and practice patent law in the United Kingdom. Going forward, there will also be a course and examination in litigation skills for all UK patent attorneys, by which they will have rights to conduct litigation in the IPEC. However, so as not to discriminate against others who have qualified at earlier dates, but already been added to the UK qualification list through transitional arrangements, we seek the recognition of the award of the certificate, rather than the passing of an exam.

Alternatively, patent attorneys can acquire extra knowledge through taking a law degree or LLM or obtain a Graduate Diploma in Law (previously the Common Professional Examination) (CPE/GDL)³. We assume that such a Graduate Diploma in Law would be covered by the "equivalent state exam in law" wording, but it would be helpful to have that clarified. It is for this reason that we recommend compiling appropriate lists now, so that those who might be affected will have certainty about their inclusion on the list even before it is in operation.

As discussed above, most Registered patent attorneys in the UK all have the rights to represent clients in IP legal proceedings in the courts. The main court in which they can exercise those rights is the Intellectual Property Enterprise Court (IPEC), which is a specialist list of the High Court. However, they also have rights to appeal decisions of the UK Patent Office to the High Court.

In these cases, UK Registered patent attorneys run the litigation, and deal with questions of infringement and validity and the other ancillary aspects of litigation. They also have the right of audience before the courts to make oral submissions. The right to undertake these activities is controlled by the litigation certificates administered by IPReg, the regulatory body for UK Registered agents. In these proceedings, therefore, UK Registered patent attorneys are the equivalent to lawyers as discussed elsewhere in the UPC Rules of Procedure.

Patent attorneys who have the rights to bring proceedings in the UK, will have qualified by taking foundation and final examinations or a recognised alternative. Taking a course is not a requirement. The final examinations include examination of the law of infringement and validity (P2) and an examination in patent attorney practice (P6). Copies of the current syllabuses for these papers are at Appendix E1 and E2. The foundation examinations have for many years included a law paper, which will cover litigation, contract and tort law, and more. A copy of the current syllabus for this paper is at Appendix E3. These examinations used to be set under the supervision of the UK IPO. Since 2007, they have been transferred to IPReg. Since 1985, a number of courses have been established which provided exemption from the foundation examinations, and are now a recognised alternative route. These courses are long courses, conducted over a number of months, covering many topics of IP law and ancillary subject-matter, and are examined at the end of the course. The courses provide a thorough academic grounding in the legal matters that is then complemented by the work experience gained by working as a trainee attorney while preparing to take the EQE and the UK finals exams. Some of the courses provided by Queen Mary College London, Brunel University London and Bournemouth University are currently listed under Rule 12(a).

However, these courses have not replaced the foundation examination route to qualification as a UK patent attorney. The foundation-level qualification in the UK is to sit a series of modular exams (including the Law Paper – see Appendix E3), generally over a period of two or more years.

A large proportion of UK patent attorneys have followed the modular exam route (or its predecessor, the Intermediate exam) to foundation-level qualification and from there to full

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This is the route by which those who did not obtain a law degree can still become a solicitor or barrister in England and Wales.

qualification following the advanced-level exams – and with that (for most) the award of litigation rights. Indeed, before the advent of the pioneering Queen Mary College course, there was no alternative. Also, many UK patent attorneys - and indeed current trainees - have been forced onto the modular exam route by their employer's training policy.

There is nothing of significance in the syllabus of the proposed European Patent Litigation Certificate that is absent from the foundation-level exams but is covered by the current Queen Mary College, Brunel University London or Bournemouth University courses.

If the Queen Mary College, Brunel University London or Bournemouth University courses are to be accepted pursuant to the draft Rule 12(a) iv), v) and vi) but without giving an equal opportunity to those who qualified to foundation level by the modular or Intermediate exam route, the effect would be unfairly to discriminate against the latter group. This is despite those who qualified to foundation level by the modular or Intermediate exam route having, on average, greater experience in view of the relatively recent introduction and popularity of the Queen Mary College, Brunel University London and Bournemouth University courses.

Indeed, the effect of the current draft proposals would be unfairly to discriminate against entire firms of patent attorneys who chose, for their own business reasons, to train new entrants to foundation level by the modular exam route or who are located too far from the course providers to make regular use of them. At the time, firms and trainees understood that route to be equivalent in all practical respects to the certificate courses offered by Queen Mary College, Brunel University London or Bournemouth University. It would be unfair to remove that equivalence, retroactively, in a manner that cannot be justified by differences in IP litigation skills acquired via the respective routes.

The result will be to distort the IP litigation market by favouring firms whose attorneys followed the certificate route and conversely by disadvantaging firms whose attorneys followed the modular exam route. In some cases, the choice of qualification route was made more than twenty years ago, with no suggestion of such a profound impact either then or since.

If the UPC is to be a success, then litigation which the UK Government has already permitted UK registered patent attorneys to undertake, will transfer to the UPC and there is no reason why those recognised to take such cases should not also be able to take cases before the UPC. Indeed, preventing such recognised attorneys from taking cases before the UPC would have a negative impact upon the UPC system's formative years. This is because these attorneys are trusted by their clients to represent them, or in-house attorneys that act for their employer, before the UK courts in cases that could in the future be taken before the UPC. Preventing these recognised attorneys from acting therefore would destroy continuity of representation, leading to a need to brief a new representative who would not be familiar with the matter or the business being represented. This leads to an increase in costs and complexity, thus decreasing the chance that the UPC will be considered as the litigation forum of choice.

If our proposal that those with litigation rights awarded by state regulators such as IPReg are eligible to represent clients before the UPC, then the issues discussed above will be avoided. Our members seek certainty from the regulations. These should not be left in a form where there is uncertainty or where matters will only be clarified once the UPC has started.

Rule 12(a)

If Rule 11 is amended to enable all those who state regulators regard as suitable to represent clients in litigation is made, then the only amendments we wish to see made to Rule 12(a) is the addition of further courses which were run previously, but are no longer available. Otherwise, as we have discussed above, some provisions of this draft regulation need amending in order to meld the different cultures across the EU. The reference only to "successfully completing a course" is discriminatory against litigators who qualified before such courses were set up, but who have, nonetheless, satisfied the regulator that they are fit and proper people to take actions before the English courts and have passed relevant examinations, even if there was no structured course. Further, as discussed above, the older members of the profession have more experience of litigation than those with recent book learning but have not been in practice for long. It is wrong to exclude such people from acting before the UPC. So if there is no on-going provision under Rule 11 for those with litigation certificates to represent before the UPC, there should, at the least, be a time for those with such certificates to get on the list, regardless of whether or not there was a course for them to attend.

We are pleased to see the courses provided by Queen Mary College London, Brunel University London and Bournemouth University are all currently listed. However, there are other courses also to add to this list.

Prior to Queen Mary providing a certificate course, there was a diploma in Intellectual Property. This should also be added to the list. A copy of a diploma certificate issued to one of our members is at Appendix F. We have had the opportunity to see the submission which is being made by Queen Mary, and have noted that it includes details of those courses and why it is appropriate for them to be included in the list. We have not seen any submissions for Bournemouth or Brunel. However, those courses are comparable to the Queen Mary course and the Law Paper (Appendix E3) as they are all designed to meet the requirements laid down by IPReg for UK patent attorneys to qualify. Accordingly, all these courses should remain on this list.

For a number of years, a **Postgraduate Certificate in Intellectual Property Law** was taught by Manchester University. This is no longer run, but was also a route to UK patent attorney qualification. Accordingly, by analogy, this should also be added to the list in Rule 12(a). This was a course, offered as both a full time one semester course and as a part time course over 12 months. The course was provided in six modules, covering the following topics: 'Introduction to the General Legal Framework Of Intellectual Property', 'UK Patent Law and Practice', 'UK Trade Mark Law and Practice', 'The Law of Copyright and Design', 'Patent Drafting Skills', and 'Overseas Intellectual Property Law'. A copy of the Handbook for this course is attached to this response at Appendix G.

When patent attorneys were awarded litigation rights in the UK, a course was required. This has gone through a number of iterations. Initially there was a **Diploma in IP Litigation course run by Birkbeck College, University of London in 1995.** This essentially practical course was designed to assist UK patent attorneys to conduct litigation before the Patents County Court, as it then was. It involved sixty hours of lectures from lecturers including solicitors, barristers and judges, and practical exercises such as mock trials and advocacy training. Those sixty hours of contact time at the University were supplemented by hours of preparation, study and revision at home. Additionally, the Diploma course concluded with a three-hour examination. The syllabus of this course is attached as Appendix H1-9. The Preparatory Committee will note that the course is focussed on the conduct of litigation, with involved hands on experience in running a mock case.

The Litigation Course taught by Nottingham Law School was developed out of the Birkbeck course and a further LLM in advanced litigation (see Appendix H9). The course was a Masters in Law when it was started and consequently those taking it qualify under Rule 11 as currently drafted. The course was only changed recently, as the level of that course was in excess of the qualification level required to be a solicitor in England and Wales. **The list set out in Rule 12 therefore should continue to include the Nottingham Law School IP litigation course.** If there are any changes to Rule 11 which mean that those with the previous LLM no longer qualify under Rule 11, then Rule 12a should be amended to include the LLM.

In addition to these courses, the UK has introduced a requirement for a litigation skills training courses for all newly qualified patent attorneys. Courses are being accredited by IPReg. They will teach litigation skills, including handling evidence, ethics and advocacy. At the end of the course, there will be a written and oral assessment. For the transitional period, at least, we wish to add these courses to the list in Rule 12a. The course will comprise a remote learning module and a two day face to face skills training. The intention is to meet the learning outcomes identified in Schedule 1 of the Regulations which are attached as Appendix B – see page 9. The outline for the face to face part of CIPA's basic litigation skills course is attached at Appendix I. This document is still a draft and the application for accreditation from IPReg has not yet been finalised. There are other course providers, so we seek to have all IPReg accredited ligation courses added to the list in Rule 12(a).

The information memorandum suggests that the list in Rule 12 may expand in the next few years, so there should be room to add other suitable courses to the list as providers gear up to teaching the EPLC.

Rule 12(b)

As currently drafted, the wording for Rule 12(b) requires a patent attorney to run a case on their own without the assistance of any other qualified lawyer. The difficulty with this drafting is that it does not recognise the variation in the culture of litigation practice across Europe and so is not sufficiently inclusive. This is not how litigation is run in the UK and suggests an unrealistic view of

how general litigation practice actually works in the UK. It is very rare for any lawyer to run a case entirely alone and without assistance. Litigation in the UK has distinguished between those who run the case (the litigator) and those who speak in court (the advocate). The split between solicitors (the litigator) and barristers (the advocate) means that neither a solicitor nor a barrister will run the case on their own without the assistance of another.

Consequently, this wording has the effect of excluding <u>all</u> patent attorneys who conduct litigation in the UK, regardless of the number of cases in which they represent clients or the number of years over which they have built up that experience, as it would be most unusual to run a case without the assistance of a specialist advocate (barrister) – i.e. the assistance of another lawyer. It would also exclude patent attorneys who co-operate with patent attorney colleagues to manage litigation.

Litigation is often a team exercise. It can require a mix of skills. If a case involved an issue of competition law, then a competition law lawyer might be called upon to assist. If it involved employment law, then an employment law lawyer might be called upon to assist. Likewise, the patent attorney in the UK is likely to call upon a barrister to assist with the advocacy and, particularly, with the handling of evidence and with cross-examination of the other side's witnesses. Therefore to place a requirement on a UK patent attorney to have represented a party without the assistance of another lawyer means that even those patent attorneys regularly running infringement cases before the English courts will not qualify.

We do not understand why the draft rule only recognises experience limited to patent infringement actions. The UPC has jurisdiction to hear cases relating to declarations of non-infringement and revocation, as well as cases relating to infringement. Further, the UPC will hear cases relating to SPCs. All require knowledge as to how to present a case in the court, bring forward evidence and comply with ethical obligations, in exactly the same way as the infringement actions explicitly recited in the Rule.

Also, many cases settle in the UK and do not go to trial. So it is important to ensure that the rule does not limit the attorneys who might find this the right route to qualification only to those who have completed a trial.

From the UK point of view, we propose amending Rule 12(b) to read:

"having responsibility in the conduct of at least three actions primarily concerning one or more matters in a Contracting State which are the equivalent of one or more matters falling within the jurisdiction of the UPC, initiated before a national court of a Contracting Member State within the five years preceding the application for registration."

We recognise that other changes may be required to meet the requirements of other nationalities.

Rule 12 also does not take into consideration the experience of patent attorneys in EPO Opposition and Appeal matters. Article 65 of the UPC Agreement confirms that the EPC is used to decide validity and Rules 30 and 50 of the current RoP confirm that any amendments to a patent have to

satisfy EPC requirements. We propose that Rule 12 also includes a provision for those who have had responsibility for a requisite number of EPO oppositions and appeals within the five years preceding the application for registration to be an appropriate qualification during at least the transitional period.

We propose adding Rule 12(c):

"having represented a party on his own without the assistance of a lawyer in at least five oppositions or appeals before the European Patent Office within the five years preceding the application for registration."

EPLC

We are pleased to see the changes which have already taken place between the initial draft of these rules and the current draft. Further changes are required.

In order to assist you, we provide comments on the rules on a rule by rule basis.

Rule 1 – no comment

Rule 2 – The EPLC should <u>not</u> be awarded based on course attendance, but for demonstrating the required knowledge and skill set to practise before the UPC by passing an assessment, uniformly applied across Europe. Or by demonstrating that carefully designed learning outcomes have been achieved.

CIPA considers that one way in which the system could be significantly simplified is not to award certificates based on the completion of a course, but rather by passing an assessment that is standardised across UPC states. This assessment should involve both written (*i.e.* academic legal knowledge) and oral components (*i.e.* advocacy and negotiation). This approach will ensure consistency in the level of the ability of the holders of the certificate across Europe that is not dependent upon the course that the certificate holder attended.

Further, this will significantly reduce the administrative burden in checking and monitoring courses for accreditation (and so reduce the cost to the UPC, which is charged with the accreditation of the courses). The recognition in the profession of any course that sets out to prepare people to be assessed will be self-fulfilling. If people attending a course successfully obtain the EPLC following assessment, it reflects well on the content of the course. If attendees of a particular course do not pass the assessment, the course will know that something needs to change, and people will not choose to attend the course unless it does change. Furthermore, it will also free up the choices of individuals wishing to obtain the certificate, in that they may then choose the manner in which they study and prepare for the assessment leading to the EPLC, be it self-study, a course provided by a university, a non-profit body, or a profit making entity.

This would place the EPLC in line with the framework currently used in the EQE. Candidates prepare in the way that they choose, be it course-based or otherwise. The candidates then take the exam that is centrally administered by the EPO, and held across Europe. Indeed, it is possible that some of the infrastructure in place for holding the EQE, and certainly the EPO's experience in conducting the assessment, could be employed in the assessment leading to the EPLC.

Additionally, CIPA has a number of comments on the nature of the course and the syllabus, which will make it clearer why the idea of a single course, to be undertaken by European Patent Attorneys has a number of significant limitations, which stop this approach from being the optimal solution.

If the Rule remains in a form similar to that current drafted, then CIPA cannot see why the Course must be delivered by a university or other non-profit making body of higher education. It should be open to any provider to deliver the Course. In the UK, the state allows free competition between profit making and non-profit making bodies. What is important is the quality of the organisation, which is assessed during the accreditation process. The draft rules already make provision for annual reports to be produced and for each institution to reapply on a regular basis. For instance, in the UK, to qualify as a solicitor, a person can take a course delivered by The Kaplan College of Law, which is not a university. To qualify as a barrister, a person can attend the Bar School, which again is not a university. Within the patent profession, there are also commercial organisations which deliver training courses on patent-related matters. CIPA itself delivers training on patent-related matters, and qualification as a UK registered patent attorney is by final exams set by the Patent Examination Board (the "PEB"), a body accredited by IPReg, which is neither a University nor an education body, although both CIPA and the PEB are non-profit making bodies. It cannot be seen why such non-university entities could not combine to deliver a suitable Course and examination. In CIPA's view, the Course could be delivered by any suitable organisation or combination of organisations⁴.

The Training Centre in Budapest is for the training of judges. CIPA considers that it could be advantageous for these facilities to be made available at cost (i.e. avoiding state subsidies) to other training providers, but considers that the Training Centre should focus its efforts on training judges and not divert that to training EPA's.

Rule 3 – It is CIPA's opinion that to approach the grant of a European Litigation Certificate as being the outcome of a single course is too restrictive. In line with our proposal above, rather than setting out the course's required contents, the Rule should instead set out a list of learning outcomes which will then be assessed.

The Preparatory Committee is referred to the way in which IPReg sets out learning outcomes in its Regulation (see Appendix B at pages 9-12) and also to the way in which Manchester University laid

As set out below, we consider that it may not be necessary for any organisation to demonstrate to the Administrative Committee ("AC") that the Course meets certain quality requirements.

out its course requirements (see Appendix G). We believe that this is the approach which should be undertaken here. Rule 3 should be replaced.

The current content for the EPLC in Rule 3 includes many topics which for example UK EPAs will already have learned from their training to become UK Registered patent attorneys and EPAs. The same will be true for many other nationally qualified EPAs. Accordingly, the course proposed in Rule 3 will simply be an inefficient re-treading of old ground for many practising EPAs. This is another reason why focussing on learning outcomes and passing an assessment rather than merely completing a course is a more appropriate means for awarding EPLCs. If an individual has already studied one of the relevant legal topics, it circumvents the need for that individual to be lectured on what they already know.

One particular topic in the list set out in Rule 3 exemplifies this most clearly. All European Patent Attorneys will need to know about European patents with unitary effect, whether they are domiciled in one of the member states ratifying the UPC or not. They will be the persons who will have to advise clients whether to keep the bundle of EP patents or elect for an EP patent with unitary effect. They will need this knowledge whether they plan to litigate or not. We are planning training courses for our current members and expect the syllabus to change for EPAs who qualify once the new system is in force. Therefore we expect the training for EPAs to include advanced knowledge of Regulations 1157/2012(EU) and 1160/2012(EU). It is therefore unnecessary and wasteful for this there to be a requirement as in Rule 3f) for this topic to be taught again to this level on a course for the EPLC and for any organisation planning courses or awarding certificates not to be able to take cognisance of the training undertaken elsewhere. In contrast, lawyers, even those who are patent-experienced, will not have such detailed knowledge of these Regulations.

Another example is item d). Most EPAs will already be familiar with the patent-related case law of the CJEU, particularly where it is relevant to questions of patentability in their technical field. Not all patent-experienced lawyers will know anything about SPCs, whereas most EPAs working in the pharmaceutical and biotechnology fields will. Furthermore, those EPAs who specialise in other technologies (e.g. computing) do not need to know this law as it will be outside their field of practice.

What is more important are practical litigation skills.

If contrary to our view that this should be completely reconsidered, Rule 3 is retained, then we have the following comments. It is CIPA's view that any course should be considerably more vocational and considerably less academic. One of the strengths of a UK EPA is the training received whilst working and/or practising under supervision. CIPA considers this as an invaluable part of any training provided to a patent attorney. This is recognised not only at UK level - where a minimum of two years practice is required before being allowed to enter the Register⁵, and most final

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E.g., see http://www.cipa.org.uk/pages/about-careers

examination are heavily based on practice - but also at European level, where a minimum of three years supervised work experience is required to sit the European examinations⁶.

Accordingly, we recommend at least 50:50, preferably more, should be on the vocational side - at present, the draft suggests that the vocational element is an afterthought. Additionally, this ensures that practitioners provide a considerably part of what is taught/trained and that they work in partnership with any academics who help to deliver the non-vocational parts of any course). So we propose an initial amendment so that Rule 3 begins: "The course shall comprise an academic part and a vocational part." Much of the current list of course content then belongs to the academic part of the course.

Additionally, we consider that the curriculum is too prescriptive and should be re-drafted to include only those topics that every other professional admitted to work with the new UPC should know requiring patent attorneys to learn topics which are not deemed essential for other professionals would put them at in a disadvantageous position which could ultimately affect access to justice. We believe that these core aspects include items (f), (h) and (i) – although, as noted above, we expect (f) to have been already taught elsewhere before an EPA embarks on the litigation couse. All the other items should be considered as desirable. For example, we note that UK EPAs will already have learned some of these desirable items from their training to become UK Registered patent attorneys and EPAs; this may also happen in other jurisdictions. Additionally, there are topics which the majority of lawyers know nothing about, and which only a few of the specialised lawyers with any experience in patent litigation may know. Examples include item (b) knowledge of private law outside of the member state in which the lawyer practices or item (g) a comparative overview of patent infringement proceedings in other member states. Further in relation to item (g), we do not understand why it is important to know about how proceedings are conducted in different member states, as opposed to differences in infringement law. If the representative is practising in the UPC, then that will be the relevant procedure: so we are not clear of the need for knowledge of different court procedures in 20+ other member states. Whilst a course provider may additionally want to teach some of these topics, there is a difference between the "added extras" and what is required for the award of the qualification. Further, by differentiating between the core requirements for the qualification and the further knowledge which it is useful to have, others wishing to practise in the UPC will be able to take the additional learning without having to do the full course.

Further, CIPA understands that in a talk given by Oliver Varhelyi on 4 July 2014 in Paris (Unitary patent and Unified patent court conference) the training needs of technically qualified judges were listed as:

- No need for training in patent law
- Training in civil procedure (principles of procedural law and UPC rules of procedure)
- Language training

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E.g., see http://www.epo.org/learning-events/eqe/admission.html

The talk also mentioned that 90% of the people applying for technically qualified positions are EPAs, and that these applicants were all deemed *eligible*, *i.e.* no further training in patent law is deemed necessary. It follows that the three topics listed above are all that are required to sit as a technical judge in the UPC. It is therefore not proportionate for EPAs to be required to undertake further patent law training, over and above those topics that the judges are required to be familiar with.

Moreover, if CIPA's proposals are followed, then those who have undertaken training as a technical judge will be able to have that training taken into account if they also wish to be qualified to represent clients before the court. Otherwise they would have to undertake a full EPLC course as proposed, even though they have already been trained on part of that syllabus.

Rule 4 - The length of 120 hours seems overly long when considering the degree of training already undertaken by EPAs in taking the EQE. Further, as noted before, it is important that parties have a large pool of legal counsel from which to choose in UPC actions and an overly long course will serve to limit the choice of counsel, particularly where some of the topics set out in Rule 3 relate to background knowledge that is known already or that is not immediately and directly applicable to procedure before the UPC.

Furthermore, even if 120 hours is deemed to be the appropriate amount of time required to complete the entire course set out in Rule 3, some degree of dispensation should be given for certain topics, if those topics have been covered in national exams leading up to the qualification of the EPA, either as an EPA, or as a national patent attorney. In this regard, for example, the finals papers P2 and P6 taken in qualifying as a UK Registered patent attorney include significant elements on determining infringement and validity and various aspects of EU law, which be taken into consideration. One simple way to administer this proposal would be to give people who have passed the appropriate UK exams exemptions from specific sections (e.g. a)-f)) from those set out in Rule 3 and consequently shorten the further hours of required study.

Accordingly we propose amending this to enable cognisance to be taken of other courses which equip EPAs with the relevant knowledge and skills.

In requiring there to be both written and oral examinations, we have presumed that the oral examination may be set to test skills of advocacy or negotiation, rather than requiring this to be an oral examination of knowledge. If it is the former, then we have no objection to it, although oral examinations can be hard to mark in a consistent manner. If it is the latter, then it should be recalled that education culture varies across Europe and this new law is not about trying to harmonise that culture.

Rule 5 – CIPA welcomes the idea that e-learning is encouraged and can form part of the course delivery. EPAs are busy individuals with practices to run. They are scattered over a wide area. Whereas e-learning is easier to accommodate, face to face learning needs more planning. It is

necessary to learn litigation skills. However, this needs to be managed to ensure that undue hurdles are not placed in the way of those seeking to study. As will be seen from the plan for CIPA's own Basic Litigation Skills course, there are 3 days' worth of distance learning prior to 2 days of face to face tuition and assessment.

Rule 6 – The point made above about universities and other non-profit making body of higher education applies here. There is no need to limit course providers in this way. We have added professional institutions to this list. Again, it is important that there should be a certificate of appropriate standing, but there is no need for all learning and skills to be acquired on a single course.

From **Rules 7 to 10**, it appears that the Administrative Committee will accredit the course providers. This could place a large burden on the Administrative Committee in that there could be at least one provider in each member state. Accreditation is a costly and time-consuming business and could add to the costs of the system. CIPA considers that this should be avoided. Further the criteria for applications are unnecessarily prescriptive. The Preparatory Committee is referred to the manner in which IPReg currently accredits courses – see Appendix B, page 13. This issue is how the learning outcomes are to be delivered, not necessarily how the hours break down within a particular course. Where practitioners are to be used to provide tuition, then course providers need flexibility to indicate the nature of the practitioner and how they will be trained to deliver the course. They may not be permanent staff. We have made some suggestions for improvement of this part.

Rule 7, 8 and 9 – These would be redundant if there were no need for accreditation.

Rule 10 – As mentioned above, we have no issue with the facilities of the Training Centre being used, but feel it should concentrate on training judges.

Rules 13 and 14 – CIPA considers that Rules 13 and 14 will need to be amended to reflect the changes we suggest to Rules 11 and 12. Currently, Rule 14 indicates that Rules 11 and 12 will provide an exhaustive list of "Other Appropriate Qualifications". So it is important to us that our members are clearly covered by each of those rules and not left to seek exemption on an individual basis, although we feel that it is right to leave open that other qualifications may be acceptable in future.

Rule 15 – no comment.

Rule 16 – We are concerned that litigants will attempt to challenge the legitimacy of registration of a representative during litigation. Such tactics will be disruptive, add to the cost of litigation and adversely affect competition between European Patent Attorneys and other lawyers, and hence

adversely affect consumer choice. To make it entirely clear that such challenges are not allowed, we suggest adding: Decisions of the Administrative Committee or Registrar (as the case may be) referred to in Rules 8, 14 and 15 may not be challenged by an opposing party in proceedings before the UPC, nor by any other third party.

Rules 17 to 22 – no comment.

CIPA should be happy to assist the Preparatory Committee or provide any further information. If we can be of assistance, please contact CIPA's Chief Executive, Lee Davies - lee@cipa.org.uk.

APPENDICES

- A PROPOSED AMENDMENTS TO THE DRAFT RULES ON EPLC AND OTHER APPROPRIATE QUALIFICATIONS
- **B-RIGHTS OF UK PATENT ATTORNEYS TO CONDUCT LITIGATION AND ADVOCACY**
- C UK PATENT ATTORNEY CODE OF CONDUCT
- **D UK PATENT ATTORNEY LITIGATOR CODE OF CONDUCT**
- **E1-E2 SYLLABUS FOR UK PATENT FINALS EXAMINATIONS**
- E3 SYLLABUS FOR UK PATENT FOUNDATION EXAMINATIONS
- F COPY OF QUEEN MARY DIPLOMA IN INTELLECTUAL PROPERTY LAW
- G COURSE MATERIALS RELATING TO MANCHESTER POSTGRADUATE CERTIFICATE IN INTELLECTUAL PROPERTY LAW
- H1-9 COURSE MATERIALS RELATING TO BIRKBECK DIPLOMA IN INTELLECTUAL PROPERTY LITIGATION
- I DRAFT OUTLINE FOR THE FACE TO FACE PART OF CIPA'S BASIC LITIGATION SKILLS COURSE

DECISION OF THE ADMINISTRATIVE COMMITTEE

RULES ON THE EUROPEAN PATENT LITIGATION CERTIFICATE AND OTHER APPROPRIATE QUALIFICATIONS PURSUANT TO ARTICLE 48 (2) OF THE AGREEMENT ON A UNIFIED PATENT COURT

THE ADMINISTRATIVE COMMITTEE OF THE UNIFIED PATENT COURT,
HAS DECIDED AS FOLLOWS:

Part I – European Patent Litigation Certificate

Rule 1

European Patent Litigation Certificate

The European Patent Litigation Certificate (hereinafter referred to as Certificate) may be acquired in accordance with the provisions laid down in this Part.

Rule 2

European Patent Litigation Course

The Certificate may be issued by universities and other non-profit educational bodies of higher education and professional institutions in -a Contracting Member State [as well as by using the facilities of the Unified Patent Court's Training Centre in Budapest (hereinafter referred to as Training Centre)] to European Patent Attorneys entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the European Patent Convention (hereinafter referred to as Euro-pean Patent Attorneys) who have successfully demonstrated competence in completed a course on European patent litiga-tion. Such competence may be acquired through courses accredited pursuant to Rules 6 to 8 (hereinafter referred to as Course).

Rule 3

Content of the Course

THIS RULE SHOULD BE REPLACED WITH A SET OF LEARNING OUTCOMES. THIS MEANS THAT COURSE PROVIDERS CAN ENSURE THAT ATTENDEES HAVE THE RELEVANT KNOWLEDGE AND CAN FILL IN GAPS, BUT WITHOUT HAVING TO RE-TEACH TOPICS WHICH HAVE BEEN LEARNED ELSEWHERE OR COMPETENCIES WHICH HAVE ALREADY BEEN DEMONSTRATED.

(1) The course shall comprise an academic part and a vocational part. The competencies to

- a) a general introduction into law, including main aspects of European law;
- b) basic knowledge of private law, including contract law, company law and tort law, in both common and continental law;
- c) basic knowledge of international private law;
- d) the role, organisation and patent-related case law of the Court of Justice of the European Union, including case law on supplementary protection certificates;
- e) enforcement of patents, providing knowledge of Directive 2004/48 (EC) (or any replacement directive) on the enforcement of intellectual property rights and relevant case law of the Court of Jus- tice of the European Union;
- f) THIS WILL BE TAUGHT TO ALL EPA's and should be deleted from this list unitary patent protection, providing advanced knowledge of Regulations 1157/2012 (EU) implementing enhanced cooperation in the area of the creation of unitary patent protection and 1160/2012 (EU) implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements as well as the Rules relating to unitary patent protection;
- g) a comparative overview on patent infringement <u>law and defencesproceedings</u> and revocation of pat—ents in Contracting Member States;
- h) the operation of the Unified Patent Court, providing advanced knowledge of the Agreement on the Unified Patent Court and the Unified Patent Court's Statute;
- i) litigation before the Unified Patent Court, providing advanced knowledge of procedures, practice and case management before the Unified Patent Court, with special regard to the Rules of Procedure of the Unified Patent Court.
- (2) The <u>competences to be demonstrated Course</u> shall focus in particular on the contents mentioned in points (f)-(i) of para- graph (1) and include practical exercises on litigation and negotiation.

Rule 4

Duration of the Course and examination requirements

- (1) The minimum duration of <u>study prior to being awarded a European Patent Litigation</u> <u>Certificate</u>the Course shall be 120 hours.
- (2) The Course shall be concluded by both a written and oral examination.

Rule 5

Course languages and e-learning

(1) The Course may be provided in any official language of a Contracting Member State.

(2) E-learning facilities are encouraged as an integral part of the Course. However, practical training sessions will always requires personal participation.

Rule 6

Accreditation requirement

Universities and other non-profit educational bodies of higher education and professional institutions of a Contracting Member State may offer issue certificates and offer appropriate the Courses subject to accreditation by the Administrative Committee.

Rule 7

Request for accreditation

The request for accreditation of the Course shall be filed with the Unified Patent Court in one of the official languages of the European Patent Office and shall contain:

- a) the <u>curriculum learning outcomes</u> of the Course envisaged <u>and how these will be delivered;</u>
- b) information concerning the requirements under Rules 4 and 5;
- c) information concerning the requestor's status;
- d) information concerning the number of hours for each topic of the Course;
- e) names and titles of the <u>course leader and indications as to how other teachers</u> may be selected-teachers and trained;
- f) draft scheme of examination, defining the objectives and the method of examination, including the number and duration of written and oral exams.

Rule 8

Examination of the request and decision

- (1) The request for accreditation shall be decided upon by the Administrative Committee on the basis of an opinion of the Advisory Committee.
- (2) If the requirements under Rules 3 6 are met and the request for accreditation complies with Rule 7, the Advisory Committee shall give an opinion in favour of accreditation to the Administrative Committee.
- (3) If the requirements under Rules 3 6 are not met or if the request for

accreditation fails to comply with Rule 7, the Advisory Committee shall give a negative opinion on the request.

In this event, the Administrative Committee shall communicate the Advisory Commit- tee's opinion to the requestor and invite him, according to the nature of the objection, to correct the deficiencies noted or to submit comments within a non-extendable period of two months. If the deficiencies are not corrected in due time, the Administrative Committee shall refuse the request. If the requestor corrects the deficiencies or submits comments, the Administrative Committee shall consult the Advisory Committee once again and decide on the request on the basis of the second opinion of the Advisory Committee.

(4) Accreditation is granted for five academic years following the date of the notification of the decision on accreditation. The request for the prolongation of the accreditation for another five years may be filed one year before the expiry of the five-year period at the earliest.

Rule 9

Reports

Participating educational bodies are required to report every year to the Unified Patent Court on the curriculum, results and statistics of the accredited Course. The Administrative Committee takes note of this report.

Rule 10

Training Centre

(1) The Training Centre, by offering the necessary infrastructural and organizational assets, shall assist the educational bodies that wish to provide a Course at the seat of the Training Centre as well. It may also facilitate e-learning options.

[(2) The Training Centre may also offer the Course in compliance with Rules 3 – 5. In this case, Rule 9 applies to the Training Centre as well.]

Part II – Other appropriate qualifications

Rule 11

Law diplomas

European Patent Attorneys holding a bachelor or master degree in law according to relevant educational standards in a Member State or who have passed an equivalent state exam in law of a Member State of the European Union or who have obtained a litigation certificate entitling them to conduct litigation in a court of a Contracting Member State shall be deemed to have appropriate qualifications pursuant to Article 48(2) of the Agreement on a Unified Patent Court and may apply for registration on the list of entitled representatives.

Rule 12

Other qualifications during a transitional period

During a period of three years from the entry into force of the Agreement on a Unified Patent Court, any of the following shall also be deemed as appropriate qualifications for a European Patent Attorney pursuant to Article 48(2) of the Agreement on a Unified Patent Court:

- (a) the successful completion of one of the following courses:
 - i) Centre d'Études Internationales de la Propriété Intellectuelle, courses leading to the Diploma on Patent litigation in Europe or to the Diploma of international studies in industrial property (specialized in patents);
 - ii) FernUniversität in Hagen, course "Law for Patent Attorneys";
 - iii) Nottingham Law School, course "Intellectual Property Litigation and Advocacy";
 - iv) IPREG accredited intellectual property litigation skills courses;
 - v) Birkbeck College London, course "Diploma in Intellectual Property Litigation";
 - viiv) Queen Mary College London, courses "Certificate in Intellectual Property Law" or "MSc Management of Intellectual Property" or "Diploma in Intellectual Property Law";
 - vii) Brunel University London, course "Intellectual Property Law Postgraduate Certificate"
 - viii) Bournemouth University, course "Intellectual Property Postgraduate Certificate";
 - ix) Manchester University course "Postgraduate Certificate in Intellectual Property Law"

[...]

or

(b) having responsibility in the conduct of represented a party on his own without the assistance of a lawyer admitted to the relevant court in at least three patent infringement actions primarily concerning one or more matters falling within the jurisdiction of the UPC, initiated before a national court of a Contracting Member State within the five years preceding the application for registration:

or

(c) having represented a party on his own without the assistance of a lawyer in at least five oppositions or appeals before the European Patent Office within the five years preceding the application for registration.

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Part III - Registration

Rule 13

Entry on the list of representatives based on a Certificate

The European Patent Attorney wishing to represent parties before the Unified Patent Court shall lodge the Certificate at the Registrar. He shall thereafter be registered on the list of entitled representatives under Article 48(3) of the Agreement on a Unified Patent Court (hereinafter referred to as List).

Rule 14

Request for recognition of other appropriate qualifications

- (1) Requests for recognition of other appropriate qualifications shall be filed with the Unified Patent Court in one of the official languages of the European Patent Office.
- (2) In case of requests filed pursuant to Rule 11 or 12(a), the request for recognition of other appropriate qualifications shall contain a copy of the respective diploma.
- (3) In case of requests filed pursuant to Rule 12(b), the request shall include all

details necessary to identify the infringement actions the European Patent Attorney intends to rely on such as

- a) name of the parties,
- b) court seized with the action,
- c) date of commencement of the proceedings.

Reasonably available evidence to support the request, such as a copy of the power of attorney shall be submitted.

Rule 15

Examination of and decision on the request for recognition of other appropriate qualifications

- (1) The request for recognition of other appropriate qualifications shall be examined by the Registrar. The Registrar may, if he deems it necessary, consult the Advisory Committee for an opinion.
- (2) If the requirements contained in Rules 11 or 12 are met and the request for recognition of other appropriate qualifications complies with Rule 14, the Registrar shall enter the requestor on the List.
- (3) If the request for recognition of other appropriate qualifications complies with Rule 14, but the requirements under Rules 11 or 12 are not met, the Registrar shall reject the request.
- (4) If the request for accreditation fails to comply with the requirements of Rule 14, the Registrar shall invite the requestor to correct the deficiencies noted within a non- extendable period of two months. If the deficiencies are not corrected in due time, the Registrar shall reject the request.

Rule 16

Effect of entries

- (1) Subject to paragraph 2 and 3 of this Rule, registrations of European Patent Attorneys on the List shall be permanent, including registrations under the transitional provisions pursuant to Rule 12.
- (2) Registration on the List shall cease to have effect in the event that the registered representative ceases to be a registered European Patent Attorney in the list of

European Patent Attorneys maintained by the European Patent Office. The Registrar will strike the name off the List, upon request or ex-officio. In case the European Patent Attorney is re-entered on the list maintained by the European Patent Office, he shall, upon his request, be re-entered by the Registrar on the List.

- (3) The registrar will strike the name of an entitled representative from the List, upon his request to this effect.
- (4) Decisions of the Administrative Committee or Registrar referred to in Rules 8, 14 and 15 may not be challenged by an opposing party in proceedings before the UPC, nor by any other third party.

Part IV - Review

Rule 17

Decisions subject to review

Decisions of the Registrar referred to in Rules 15 and 16 may be challenged in accordance with the following provisions.

Rule 18

Formalities of the petition for review

The petition for review shall be filed in writing with the Registrar in one of the official languages of the European Patent Office, within one month of notification of the challenged decision. It shall indicate the reasons for setting aside the decision of the Registrar.

Rule 19

Revision by the Registrar

- (1) If the Registrar considers the petition for review to be admissible and well founded, he shall rectify his decision.
- (2) If the Registrar does not rectify his decision within one month of receipt of the petition for review, he shall forward it to the President of the Court of Appeal who

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shall decide on the petition for review.

Rule 20

Decision by the President of the Court of Appeal

If the petition for review is admissible, the President of the Court of Appeal shall examine whether the appeal is allowable. If the petition for review is allowable, he shall alter the Registrar's decision. If the petition for review is not allowable, he shall reject it.

Part V – Notification and Entry into force

Rule 21

Notification

Decisions of the Administrative Committee, the Registrar and the President of the Court of Appeal shall be notified.

Rule 22

Entry into force

This Decision shall enter into force on [...].

Done at [...] on [...]

For the Administrative Committee

The Chairman



RIGHTS TO CONDUCT LITIGATION AND RIGHTS OF AUDIENCE AND OTHER RESERVED LEGAL ACTIVITIES CERTIFICATION RULES 2012

1 DEFINITIONS

- 1.1 In these Rules, except where otherwise indicated:
 - "Accreditation Guidelines" means the guidelines set out in Schedule 2 to these Regulations;
 - "Administrative Appeals Regulations" means the appeals regulations for reviewing decisions of IPReg;
 - "Advanced Litigation Skills Course" means an advanced litigation skills course accredited for the purposes of these Rules by IPReg;
 - "Advocacy or Litigation Certificate" means: Intellectual Property Litigation Certificate; Higher Courts Litigation Certificate; or Higher Courts Advocacy Certificate, issued under these Rules;
 - "Advocacy Skills Course" means an advocacy skills course accredited for the purposes of these Rules by IPReg;
 - "Advocacy Assessment" means an advocacy assessment approved by an Approved Regulator for the purposes of awarding a grant of a right of audience in the High Court, Court of Appeal and/or the Supreme Court;
 - "Appointed Person" means a person appointed to hear appeals under section 76 of the Trade Marks Act 1994;
 - "Attorney in Good Standing" means a Registered Patent Attorney or Registered Trade Mark Attorney in respect of whose conduct there is no complaint outstanding and against whom there is no disciplinary record which in the view of the PRB or TRB affects their suitability to be a litigator or advocate;
 - "Approved Regulator" means a body entitled to award a right to conduct litigation or a right of audience under the Legal Services Act 2007;
 - "Basic Litigation Skills Course" means a basic litigation skills course accredited for the purposes of these Rules by IPReg;
 - "CIPA" means the Chartered Institute of Patent Attorneys;
 - "Codes of Conduct" means the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated persons and Special Rules of Professional Conduct applicable to Regulated Persons conducting litigation or exercising a right of audience before the Courts adopted from time to time by IPReg;
 - "Disciplinary Procedure" means the disciplinary procedure for enforcing the Codes of Conduct;



"Higher Courts Advocacy Certificate" means an advocacy certificate conferring the rights set out in Rule 2.2 (c);

"Higher Courts Litigation Certificate" means a litigation certificate conferring the rights set out in Rule 2.2 (b);

"Intellectual Property Litigation Certificate" means a litigation certificate conferring the rights set out in Rule 2.2 (a);

"IPReg" means the PRB and the TRB acting individually or together as the Intellectual Property Regulation Board, as the context requires;

"ITMA" means the Institute of Trade Mark Attorneys;

"LCAP" means a Litigation Course Accreditation Panel established under Rule 6;

"Manager" in relation to a body, has the same meaning as in the Legal Services Act 2007;

"Patent Attorney Body" means a body (corporate or unincorporate) whose name is entered in the Patent Attorney Register;

"Patent Attorney Register" means the register kept under section 275 of the Copyright Designs and Patents Act 1988 as amended;

"PRB" means the Patent Regulation Board of CIPA;

"Registered Patent Attorney" means an individual whose name is entered in the Patent Attorney Register;

"Registered Trade Mark Attorney" means an individual whose name is entered in the Trade Mark Attorney Register;

"Regulatory Objectives" shall have the meaning set out in Section 1 of the Legal Services Act 2007:

"Reserved Legal Activities" shall have the meaning set out in Section 12 of the Legal Services Act 2007;

"Trade Mark Attorney Body" means a body (corporate or unincorporate) whose name is entered in the Trade Mark Attorney Register;

"Trade Mark Attorney Register" means the register kept under section 83 of the Trade Marks Act 1994 as amended;

"TRB" means the Trade Mark Regulation Board of ITMA;

1.2 Responsibility for this qualification scheme is delegated by CIPA to PRB and by ITMA to TRB.



2 THE RIGHTS TO CONDUCT LITIGATION AND RIGHTS OF AUDIENCE CERTIFICATES

- A Registered Patent Attorney may apply to the PRB and a Registered Trade Mark Attorney may apply to the TRB to be granted any of the following Certificates:
 - (a) Intellectual Property Litigation Certificate;
 - (b) Higher Courts Litigation Certificate;
 - (c) Higher Courts Advocacy Certificate.
- 2.2 The rights to conduct litigation and rights of audience exercisable by attorneys holding Litigation and Advocacy Certificates are set out below:

(a) Intellectual Property Litigation Certificate

- i) A right to conduct appeals from and/or apply for judicial review in the High Court of decisions of:
 - a) the Comptroller General of Patents,
 - b) an Appointed Person, or
 - c) any other body or tribunal in England and Wales making decisions relating to the subsistence, scope, grant, enforcement, exploitation or ownership of intellectual property rights such as may be constituted from time to time;
- ii) A right to conduct litigation in (including the right to conduct appeals of interim decisions of):
 - a) the Intellectual Property Enterprise Court; and
 - b) the County Court when the court is hearing a matter where Part 63 of the Civil Procedure Rules apply or any matters ancillary thereto;
- iii) A right of audience to appear before:
 - a) the Intellectual Property Enterprise Court;
 - b) the High Court in appeals proceedings mentioned in paragraph (i) but not applications for judicial review; and
 - c) the appeal tribunal constituted by the Registered Designs Act 1949 (as amended from time to time);
- iv) A right to conduct appeals from decisions in proceedings mentioned in paragraphs (i)-(iii) above to the Court of Appeal and the Supreme Court.

(b) Higher Courts Litigation Certificate

- i) All rights given under an Intellectual Property Litigation Certificate;
- A right of audience to appear before the County Court when the court is hearing a matter where Part 63 of the Civil Procedure Rules apply or any matters ancillary thereto;



- iii) A right to conduct litigation and a right of audience to appear in case management conferences and in interim proceedings before:
 - a) the Patents Court; and
 - b) in any other Court of the High Court when the court is hearing a matter where Part 63 of the Civil Procedure Rules apply or any matters ancillary thereto; and
- iv) A right to conduct appeals from decisions in proceedings mentioned in paragraph (iii) to the Court of Appeal and the Supreme Court.

(c) Higher Courts Advocacy Certificate

A right of audience before the High Court, the Court of Appeal and the Supreme Court in proceedings which may be conducted by an attorney holding a Higher Courts Litigation Certificate.

3 PASSPORTING OF EXISTING RIGHTS

- 3.1 Intellectual Property Litigation Certificates for 2012 shall be issued to Attorneys in Good Standing on the date when these regulations come into force unless an Attorney holds a Patent Attorney Litigation Certificate pursuant to the CIPA Higher Courts Qualification Regulations 2007 or a Trade Mark Advocate certificate pursuant to the ITMA Trade Mark Litigator and Trade Mark Advocate Certificate Regulations 2009.
- 3.2 Higher Courts Litigation Certificates for 2012 shall be issued to Attorneys in Good Standing who on the date when these regulations come into force hold either a Patent Attorney Litigation Certificate pursuant to the CIPA Higher Courts Qualification Regulations 2007 or a Trade Mark Advocate Certificate pursuant to the ITMA Trade Mark Litigator and Trade Mark Advocate Certificate Regulations 2009.

4 CONDITIONS FOR GRANT OF CERTIFICATES

- 4.1 Applications for the grant of an Advocacy or Litigation Certificate shall be made in writing to IPReg in the form prescribed from time to time.
- 4.2 Intellectual Property Litigation Certificates will, unless refused for reasons given in writing, be granted to Attorneys in Good Standing who can certify that:
 - a) they have completed a Basic Litigation Skills Course; or
 - b) they have previously held an Intellectual Property Litigation Certificate.
- 4.3 Higher Courts Litigation Certificates will, unless refused for reasons given in writing, be granted to Attorneys in Good Standing who can certify that:



- a) they have completed an Advanced Litigation Skills Course; or
- b) they have previously held a Higher Courts Litigation Certificate; or
- c) they have the qualifications required by any other Approved Regulator to conduct civil litigation in the Higher Courts.
- 4.4 Higher Courts Advocacy Certificates will, unless refused for reasons given in writing, be granted to Attorneys in Good Standing who can certify that:
 - a) they have previously held a Higher Courts Litigation Certificate and have completed an Advocacy Skills Course or an Advocacy Assessment; or
 - b) they have previously held a Higher Courts Advocacy Certificate; or
 - c) they have the qualifications required by any other Approved Regulator to conduct civil litigation and have a right of audience in the Higher Courts.
- 4.5 IPReg shall determine in consultation with CIPA and ITMA and with the approval of the Legal Services Board such fees as may be payable in connection with the issuance of Litigation and Advocacy Certificates and shall publish a list of these at regular intervals.

5 MAINTENANCE AND REVOCATION OF CERTIFICATES

- 5.1 Unless revoked in accordance with a decision made under the Disciplinary Procedure or for any reason as set out below, all Litigation and Advocacy Certificates shall be renewed annually with the annual renewal of the entry on the relevant Register.
- 5.2 If a Higher Courts Litigation Certificate is issued to the holder of an Intellectual Property Litigation Certificate, the holder's Intellectual Property Litigation Certificate will lapse when the Higher Courts Litigation Certificate is issued.
- 5.3 Any certificate shall be revoked automatically in the event that:
 - a) the holder of a Litigation or Advocacy certificate ceases to be a Registered Patent Attorney or a Registered Trade Mark Attorney; or
 - b) the holder requests that the Certificate is revoked.

6 LITIGATION COURSE ACCREDITATION PANEL

- 6.1 IPReg shall be empowered to establish a Litigation Course Accreditation Panel (LCAP) to:
 - a) handle applications from course providers;



- b) accredit courses and course providers;
- c) consider and, if deemed necessary, alter the outcomes; and
- d) consider whether an accreditation to a course or course provider should be withdrawn and decide accordingly.
- 6.2 Any established LCAP shall primarily accredit courses. However, where an LCAP accredits a course, it may also accredit the course provider in relation to that course. The LCAP shall set out the extent to which an accredited course provider may adapt its course without having to reapply to IPReg or an LCAP for approval. Where an applicant for accreditation of a new course is already an accredited course provider, then the LCAP will take that accreditation into account when considering the subsequent application.
- 6.3 All decisions made by a LCAP shall be in writing and shall state the reasons for any decision.
- 6.4 The members of a LCAP shall be appointed by IPReg and removed by IPReg in accordance with such procedure as IPReg decides and for such term as IPReg decides.
- 6.5 Any LCAP which is established shall include:
 - in the case of courses accredited or being accredited on behalf of the PRB one or more Registered Patent Attorneys who are not members of CIPA Council and who have not served as a members of CIPA Council during any of the 12 month period immediately preceding their appointment;
 - b) in the case of courses accredited or being accredited on behalf of the TRB one or more Registered Trade Mark Attorney who are not members of ITMA Council and who have not served as a members of ITMA Council during any of the 12 month period immediately preceding their appointment; and
 - c) an academic with experience of running professional skills courses.

Any LCAP may additionally include up to 3 in total of:

- d) at least one practising solicitor or barrister; and
- e) at least one lay person with knowledge or experience of industrial or consumer matters.

At least one member of the LCAP shall be a member of IPReg and this member shall act as the chairman of the LCAP.



7 OUTCOMES AND THE ACCREDITATION OF LITIGATION AND ADVOCACY COURSES

- 7.1 IPReg shall require that accredited Litigation and Advocacy Skills Courses enable attendees to achieve outcomes as set out in Schedule 1, and IPReg may prescribe syllabuses for such courses or may publish exemplary syllabuses.
- 7.2 Institutions or bodies wishing to teach any course accredited by IPReg shall submit, or may be invited to submit applications to IPReg. Such applications may be subject to an application fee set by IPReg from time to time, the application fee being set at a level not to exceed the administrative costs involved in reviewing and accrediting courses.
- 7.3 IPReg shall investigate whether the institution or body is fit to teach the relevant course, i.e. whether it can impart the necessary legal knowledge and practical skills so that those who have completed the course can act effectively within the scope of the Certificate for which teaching is given. IPReg shall have regard to the Regulatory Objectives and the Accreditation Guidelines set out in Schedule 2 to these Regulations.
- 7.4 IPReg shall give a decision in writing as to whether or not the relevant course or course provider has been accredited.
- 7.5 At such times as IPReg considers appropriate, IPReg shall require an institution teaching an accredited course to provide reports concerning the operation of the course in sufficient detail to show that the required standards are being met. IPReg shall have power on reasonable notice to withdraw its accreditation in the event of any serious shortcomings which are not remedied to its satisfaction or in the event that the course provider fails to provide the information requested in a timely manner or at all.
- 7.6 IPReg may delegate any duties and powers under this rule to an LCAP established under Rule 6.

8 APPEALS

- 8.1 Any person who is aggrieved by a decision of an LCAP or IPReg under these regulations may:
 - a) within one month of receiving notification of the decision ask for the decision to be reviewed; and the LCAP or IPReg shall review the decision as soon as reasonably practicable and shall notify the person of the outcome; and
 - b) within one month of receiving notification of the outcome of a review, if still not satisfied, file an appeal to have the decision reviewed in accordance with the Administrative Appeals Regulations.



9 OTHER RESERVED LEGAL ACTIVITIES

- 9.1 All Registered Patent Attorneys and all Registered Trade Mark Attorneys are authorised to carry on reserved instrument activity as set out in paragraph 5 of Schedule 2 Legal Services Act 2007 where such instruments relate to intellectual property rights.
- 9.2 All Registered Patent Attorneys and all Registered Trade Mark Attorneys are authorised to administer oaths as set out in paragraph 8 of Schedule 2 Legal Services Act 2007 and to use the title "Commissioner for Oaths" under section 183 Legal Services Act 2007.
- 9.3 Any rights granted to an individual under paragraphs 9.1 and 9.2 shall be revoked automatically in the event that individual ceases to be a Registered Patent Attorney or a Registered Trade Mark Attorney.

10 RIGHTS OF PATENT ATTORNEY AND TRADE MARK ATTORNEY BODIES

- 10.1 Any Patent Attorney Body or Trade Mark Attorney Body is authorised to carry on Reserved Legal Activities which any Manager or employee of the body is authorised to carry on whether by virtue of these Rules or by virtue of any grant of rights by any other Approved Regulator provided that such activities are conducted under the supervision of a person who is authorised to carry on those activities.
- 10.2 If a Patent Attorney Body or Trade Mark Attorney Body has been acting in respect of a matter and the sole Manager or employee authorised to act in respect of that matter ceases to be a Manager or employee, the Patent Attorney Body or Trade Mark Attorney Body shall for a period of up to one month remain authorised to undertake such actions in respect of that matter as may be necessary to transfer the matter to someone authorised to undertake the litigation or any other actions as may be permitted on application to the Court.

11 COMMENCEMENT DATE AND REPEAL

These Rules shall come into effect on 31st December 2012 and the CIPA Higher Courts Qualification Regulations 2007 and ITMA Trade Mark Litigator and Trade Mark advocate Certificate Regulations 2009 shall cease to be effective as of that date.



SCHEDULE 1

Basic Litigation Skills Course Outcomes

A basic litigation skills course is intended to enable a practitioner to be licensed to conduct litigation and appear before the courts in matters within the scope of an Intellectual Property Litigation Certificate.

At the end of the course attorneys should, in the context of intellectual property litigation, be able to:

- understand the importance of preparation and the best way to undertake it;
- understand the importance of litigation ethics and the obligations and duties litigators and advocates have towards a court, clients and other parties;
- understand the *basic skills* in the presentation of cases before courts and tribunals in particular the skills necessary for the presentation of cases before the Intellectual Property Enterprise Court;
- understand the procedures for swearing oaths and the circumstances when a Commissioner for Oaths may not administer an oath;
- understand the procedural rules, including the time limits, for a judicial review, and the circumstances when judicial review of the decisions of intellectual property tribunals will be granted;
- understand court structures and civil litigation procedure and how they apply to intellectual property litigation;
- be able to formulate and present a coherent submission based upon facts, general principles and legal authority in a structured, concise and persuasive manner.

Advanced Litigation Skills Course Outcomes

An advanced litigation skills course is intended to enable a practitioner to be licensed to conduct litigation and appear before the courts in matters within the scope of a Higher Courts Litigation Certificate.

At the end of the course attorneys should, in the context of intellectual property litigation, be able to:

- display an understanding of knowledge, and an awareness of current problems and/or new insights, in the field of advocacy and court procedure in the High Court and the County Court;
- demonstrate competence in advocacy skills across a range of contexts within the area of intellectual property litigation;
- demonstrate an appreciation of the importance of organisational skills in obtaining evidence, carrying out a disclosure exercise and working with fact witnesses and experts in preparing witness statements and expert reports, in a timely and efficient manner, and demonstrate an understanding of how to exercise such skills;
- bring their own perspective to bear upon an unfamiliar problem in the context of intellectual property litigation in the High Court and propose effective solutions to problems;
- conduct advocacy effectively in Judge's room hearings in the High Court and the County Court;
- apply relevant rules of evidence across a range of contexts in High Court and the County Court



litigation;

- analyse facts and evidence in a High Court case including the drafting of trial strategy plans and drafting or review of witness statements;
- draft a coherent, clear and persuasive skeleton argument in a relevant case before the High Court;
- analyse and advise on risk and prospects of success in a trade mark/patent case before the High Court;
- accept accountability and perform independently with responsibility;
- advise on and comply with, relevant rules of ethics and courtroom etiquette;
- work productively with colleagues, clients, the judge and opponent.

Advocacy Skills Course Outcomes

An advocacy skills course is intended to enable a practitioner to be licensed to appear before the courts in matters within the scope of a Higher Courts Advocacy Certificate.

At the end of the course attorneys should, in the context of intellectual property litigation, be able to:

- apply the rules of evidence and determine when evidence is relevant and therefore potentially admissible and be able to demonstrate their understanding of:
 - i) burden and standards of proof,
 - ii) disclosure, including issues relating to confidentiality, privilege and public interest immunity,
 - iii) hearsay evidence including being able to identify hearsay evidence, recognise when it may be admissible, how it may be admitted and its evidential value when adduced,
 - iv) documentary hearsay including laying the evidence for documentary hearsay, any formal requirements and time limits,
 - v) similar fact and evidence including being able to recognise when similar fact evidence is appropriate as evidence,
 - vi) opinion and expert evidence including when and to what extent opinion and expert evidence is admissible,
 - vii) improperly obtained evidence including being aware of how evidence has been obtained, the evidential constraints and effects of adducing improperly obtained evidence;
- understand the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated Persons and the Special Rules of Professional Conduct applicable to Regulated Persons conducting litigation or exercising a right of audience before the Courts;
- advise the client on suitable representation at court including the possibility of instructing a barrister or a higher court advocate not from his/her own firm or practice;
- resolve issues arising from unintentional or inadvertent disclosure of confidential or privileged information,
- resolve potential and actual conflicts including conflicts arising between the advocate's duty owed to the client and the advocate's duty to the Court;



- advise on potential conflicts between acting as an advocate for a client and becoming a
 potential witness for that client,
- recognise when an advocate may become professionally embarrassed and have to withdraw from a case:
- advise the client of the advocate's need to maintain professional independence and the associated need to draw any unfavourable law of which the advocate is aware to the attention of the court;
- comply with courtroom etiquette;
- prepare coherent skeleton arguments and necessary supporting documents and supply the court with copies of the relevant law;
- present legal argument to the court accurately citing only relevant and material law where necessary;
- respond to interventions by the court and develop legal argument;
- respond to the opponent's legal arguments and develop appropriate legal argument in the light of these;
- be prepared to present the case in detail as required by the court and be able to respond to any application as well as interventions by the court;
- understand the importance of and be able to draft and present clear trial strategies and plans;
- use a trial strategy and plan to outline the facts and evidence, in terminology and detail as appropriate to the type of case;
- present an effective and coherent opening speech;
- conduct an examination in chief, if required, by:
 - i) asking relevant non-leading questions which promote the client's case,
 - ii) identify and place before the court relevant documentation produced by the witness after establishing the necessary evidential foundation;
- in cross examination
 - i) know on what matters in dispute a witness can be cross examined,
 - ii) be able to control the direction and pace of the evidence,
 - iii) appropriately challenge the witness' evidence in accordance with the client's instructions,
 - iv) ensure that all relevant disputed matters are put to the witness,
 - v) identify and appropriately cross-examine on any previous inconsistent statements;
- identify situations when re-examination is required to put the client's case and to repair damage done to the witness in cross examination or to clarify or amplify matters raised in cross-examination;
- identify and use effectively expert evidence, challenge expert evidence, and where necessary confirm or question the expert's qualifications and expertise;
- in a closing speech be able to:
 - i) identify and appropriately present the key issues in the client's case and the positive and negative evidence elicited from witnesses;
 - ii) anticipate and appropriately address arguments likely to be advanced by the opposing advocate,



- iii) effectively deal with interventions by the court and respond appropriately to them;
- have an awareness that much civil advocacy depends on the quality of written documentation
 put before the court in addition to the quality of the oral advocacy at trial;
- comply with the Civil Procedure Rules throughout the trial process;
- recognise the costs implications faced at all stages of preparation and during the trial;
- apply pre-action protocols where relevant;
- appropriately advise the client on alternative dispute resolution remedies;
- draft a Statement of Case and other trial documents and be able to identify deficiencies in the drafting of such documents;
- prepare a coherent and effective trial strategy and/or produce a trial plan based on Statements of Case, Witness Statements, and other disclosed documents put before the court;
- exercise sound judgement in the making of appropriate interim applications;
- understand the effect of interim orders;
- identify any costs implications resulting from interim orders;
- draft coherent skeleton arguments to assist the court;
- understand the implications and requirements of current Practice Directions as to what needs to be included in the trial bundle to ensure that the bundle complies with court requirements;
- understand the importance of alternative dispute resolution and when it is appropriate and advise their client appropriately;
- understand and have an awareness of equality and diversity issues and the need to act as role models for others in handling issues of diversity and difference, and confront discrimination and prejudice when observed in others.



SCHEDULE 1

Litigation and Advocacy Course Accreditation Guidelines

- 1. IPReg may visit the institution and liaise with the staff concerned as often as necessary. In particular IPReg shall investigate:
 - (a) whether those intending to teach the course understand the reasons why the course has been set up and the objectives that it is required to achieve;
 - (b) whether the proposed course is adapted to the needs of the students;
 - (c) whether there is a sufficient team of suitably qualified people available to teach the courses;
 - (d) whether the institution has the physical and other resources necessary for the course to be taught;
 - (e) how the course is to be run, what will be the expected size of the student groups, and how exercises aimed at developing practical skill are to be carried out to sufficiently rigorous standards and under adequate supervision;
 - (f) what theoretical syllabus will be covered and what practical skills will be taught;
 - (g) what specimen exercises and specimen examination papers are available for consideration; and
 - (h) that the candidate's written work and examinations will be appropriately supervised.
- 2. IPReg shall liaise with each institution teaching an accredited course to ensure that:
 - (a) the syllabus and practical exercises are up to date and continue to meet the training requirements of Patent/Trade Mark Attorney Litigators or Advocates;
 - (b) the examination and test conducted by the institution are of an appropriate standard; and
 - (c) the administration and management of the course is effective.
- 3. The overall aim of an accredited course is that by the end a participant should be able to achieve the outcomes set out in schedule 1 for that level of course.



Memorandum

With effect from 1st October 2013 the Certification Rules have been amended to substitute references to the Intellectual Property Enterprise Court for the Patent County Court and to refer to the County Court (singular)



RULES OF CONDUCT FOR PATENT ATTORNEYS, TRADE MARK ATTORNEYS AND OTHER REGULATED PERSONS

The Patent Regulation Board of the Chartered Institute of Patent Attorneys and the Trade Mark Regulation Board of the Institute of Trade Mark Attorneys working jointly together as the IP Regulation Board (IPReg) now make the following provisions under Section 275A of the Copyright Designs and Patents Act 1988 and under Section 83A of the Trade Marks Act 1994, respectively, pursuant to Sections 185 and 184 of the Legal Services Act 2007.

Rule 1 - Interpretation

In these Rules, unless context otherwise requires:

"patent attorney register" means the register kept under Section 275 of the Copyright Designs and Patents Act 1988 as amended;

"trade mark attorney register" means the register kept under Section 83 of the Trade Marks Act 1994 as amended;

"registered person" means:

- i) a registered patent attorney;
- ii) a registered trade mark attorney; or
- iii) a body (corporate or unincorporated) registered in the patent attorney register or the trade mark attorney register;

"regulated person" means a registered person, an employee of a registered person, or a manager of a body which is a registered person;

"manager", in relation to a body, has the same meaning as in the Legal Services Act 2007;

"professional work" means any services provided by a regulated person in the course of business providing legal services;

"corporate work" means professional work undertaken by an employed regulated person acting solely as an agent on behalf of :

- (a) their employer;
- (b) a company or organisation controlled by their employer or in which their employer has a substantial measure of control;
- (c) a company in the same group as their employer;
- (d) a company which controls their employer;



- (e) an employee (including a director or a company secretary) of a company or organisation under (a) to (d) above, where the matter relates or arises out of the work of that company or organisation; or
- (f) another person with whom a person under (a) to (e) above has a common interest;

"in private practice" means undertaking professional work which is not solely corporate work:

"client" means principal on whose behalf a regulated person acts as agent and includes any person for whom the regulated person is address for service for any right regardless of the nature of any current relationship. In the case of foreign originating work, for the purposes of these Rules the "client" remains the principal for whom the work is ultimately being done, although the instructions may come from an intermediary foreign patent or trade mark attorney, to whom the regulated person will also owe a duty of professional care. Where a regulated person is instructed via such an intermediary any obligation to provide information to a client under these rules may be discharged by providing such information to that intermediary.

Rule 2 - Scope

These Rules set out the standards of professional conduct and practice expected of regulated persons undertaking professional work. Registered persons are responsible under these Rules not only for their own acts and omissions, but also for those sanctioned, expressly or otherwise, by them.

Not every shortcoming on the part of a regulated person, nor failure to comply with these Rules, will necessarily give rise to disciplinary proceedings. The guidance shown in *italics* accompanying these Rules is not mandatory and does not form part of the Rules. Nevertheless, any alleged breach of the Rules will be considered with reference to the guidance.

- 2.1 Rules 1 and 2 define the scope of the Code of Conduct. Individuals, firms and companies registered in the patent attorney register or trade mark attorney register, their managers and employees are subject to the code if they act in the course of a business which undertakes relevant professional work.
- 2.2 Rules 12 (Complaints handling) and 17 (Professional Indemnity Insurance) are only applicable to registered persons "in private practice" and attorneys employed within industrial departments are not required to comply with these Rules provided that such attorneys limit their professional activities to "corporate work". In general, this means only undertaking work on behalf of their employer and individuals or companies associated with their employer.
- 2.3 Attorneys undertaking "corporate work" may, however, act on behalf of third parties unrelated to their employer where their employer or an associated individual or company has a "common interest" in such work. Typical examples of permitted actions on behalf of third parties would include: maintaining or enforcing patents on behalf of third parties where the



patents are licensed to an employer; prosecuting patent applications owned jointly by an employer and a third party; the appointment of an attorney as a joint representative on behalf of an employer and others in revocation or opposition proceedings; and time limited activities arising due to the transfer of assets to or from an employer such as the on-going maintenance of a portfolio of rights whilst a formal transfer was being finalised.

Rule 3 – Service of Documents

Any notice or other document required by or for the purposes of these Rules to be given or sent to a regulated person may be given to them personally or sent by mail to their last known address with proof of such postage.

Rule 4 - Competence

Regulated persons shall carry out their professional work with due skill, care and diligence and with proper regard for the technical standards expected of them.

A regulated person should only undertake work within his expertise or competence.

Guidance

- 4.1 A regulated person should always consider whether, having regard to:
 - a) the circumstances (including in particular the gravity, complexity and likely cost) of the work;
 - b) the nature of the regulated person's practice;
 - c) the regulated person's ability, experience and seniority; and
 - d) the regulated person's relationship with the client,

in the interests of the client would be served by the regulated person or some other person providing professional services in fulfilment of the client's instructions.

- 4.2 This should be considered as soon as practicable after receiving instructions and from time-to-time thereafter, particularly when circumstances change. If the regulated person considers that the interests of the client would be served by some other person acting, he must advise his client accordingly.
- 4.3 Particular care should be taken when undertaking advocacy and litigation work before the Courts. A regulated person must only undertake advocacy and litigation work which is within their expertise and competence. Normally, this will mean that registered persons only undertake litigation and advocacy in matters where the primary issues at stake relate to intellectual property rights. It will be appreciated that some cases raise a mix of issues. Where a case raises issues which are not within a registered person's competence (e.g. complex issues of employment law in an IP entitlement case), if a registered person is to continue to act they must supplement their team with other legal advisers who have relevant specialist knowledge of such matters. Undertaking advocacy or litigation is cases unrelated to intellectual property rights will be considered prima facie a breach of Rule 4.



- 4.4 The conduct of litigation may only be undertaken either by a person authorised to undertake it or under their supervision. If a firm is acting in respect of a matter and the only person entitled to act in respect of that matter provides notice of their intention to leave the firm or leaves the firm unexpectedly, the firm must immediately take steps to appoint another authorized person to act. The firm must transfer the matter and cease to act if no suitable person can be appointed within a month of the authorised person's departure. Continuing to act after that date would place the firm in breach of the criminal provisions of the Legal Services Act.
- 4.5 In appropriate exercise of litigation and/or advocacy rights is a matter which is taken very seriously by IPReg. If a registered person is found to have used rights inappropriately this can result in sever disciplinary sanctions including removal of rights to conduct litigation and/or advocacy and removal of a registered person's name from the register of patent attorneys and/or trade mark attorneys.

Rule 5 – Integrity

Regulated persons shall at all times act with integrity putting their clients' interest foremost subject to the law and any overriding duty to any Court or Tribunal.

Guidance

- 5.1 A regulated person should in all professional activities:
 - a) practise competently, promptly, conscientiously, courteously, honestly and objectively, avoiding unnecessary expense to the client;
 - b) act so as to promote confidence in the intellectual property system;
 - c) subject to the law and the regulated person's duty to any Court or Tribunal, put clients' interests foremost and keep clients' affairs confidential.
- 5.2 A regulated person should not do anything that might compromise:
 - a) his independence;
 - b) the dignity and good standing of the regulated person, or of the patent or trade mark professions;
 - c) the freedom of clients to instruct any person or firm to carry out their work or to change their representation.

Rule 6 - Client Care and Service

Regulated persons shall carry out their professional work in a timely manner and with proper regard for standards of professional service and client care.



- Written terms of business should be given to clients at the outset of a relationship and as often as necessary thereafter. Any variations should be communicated to clients as soon as they apply to the client. Regulated persons should ensure that clients receive as often as necessary an explanation, appropriate to the client's reasonably apparent or expected level of understanding, as to the issues in a matter, the progress of the matter and the likely timescale and an update periodically on expenditure incurred or to be incurred. The level of reporting depends on the client relationship and the experience of the client or the person responsible within the client's organisation. For example, lay clients may require more care than in-house counsel. Extra care should be taken when dealing with potentially vulnerable clients such as private individuals and in particular where there may be risk factors related to a person's circumstances (e.g. bereavement, illness or disability, etc.) which increase the likelihood of the client being at a disadvantage or suffering detriment.
- 6.2 When instructions are received orally, it is sensible practice, for the avoidance of future disputes as to the precise instructions given, for a regulated person to provide to the client a written note confirming the instructions received.
- 6.3 When unwilling or unable to provide services to an existing client, or withdrawing from giving services, a regulated person should make reasonable efforts to enable the client to make other arrangements and bear in mind their obligations to put clients' interests foremost. A regulated person should co-operate with a client and any new representative of the client to ensure the client's interests are protected on any change of responsibility.
- 6.4 Even where there is no on-going client relationship, absent a formal termination including clear and reasonable notice to the former client that communications will not be forwarded, regulated persons should take timely steps to draw a former client's attention to correspondence or communications received relating to the former client and their rights. A regulated person may seek a fees undertaking where the client relationship has been terminated for the costs involved in forwarding correspondence.
- 6.5 Every regulated person should have a written file retention/destruction policy which should be made available to the client on request.
- 6.6 If a regulated person gives an indication (such as an estimate) of the likely cost of work and that indication is not intended to be fixed, the regulated person is responsible for making it clear that the indication is not fixed, and for ensuring that the client is informed in advance whenever reasonably possible if it appears the indication will be materially exceeded.
- 6.7 Unless otherwise agreed with the client a regulated person should not require as a condition precedent from a sender of correspondence or a communication intended for or relevant to the client, an undertaking to meet the regulated person's fees for forwarding the sender's correspondence or communication to the client or for giving the client advice on the matter.
- 6.8 This applies typically to requests for consent, licence and so on. There have been instances where regulated persons have refused even to pass on correspondence without comment until their fees are met. Absent the client's agreement, this is a breach of Rules 5, 6 & 7 since the regulated person is putting his own interest in fees before the interest of the



client which is in being informed promptly. This does not prevent the regulated person asking the sender for an agreement to meet reasonable costs, but the forwarding of the communication must not be dependent on it. It is up to the regulated person, having regard to his relationship with the client, to determine how matters of this kind should be drawn to the attention of the client and in the absence of any other arrangement, if the regulated person is unwilling to forward the communication "on risk as to costs" the communication should either be returned to the sender (provided that the client is not prejudiced by the resulting delay) or be forwarded without comment or offering assistance on appropriate terms.

6.9 Note that the sender is not liable for any costs until agreement is reached but that any agreement will impose liability regardless of whether the sender receives the benefit or co-operation sought.

Rule 7 - Conflicts

A regulated person must not act where his interests conflict with those of a client or of a former client, or where he knows or has reasonable grounds for suspecting that the interests of any partner or regulated person or staff of his firm, conflict with those of a client or of a former client.

Provided in all the circumstances it is reasonable to do so, a regulated person may act for two or more clients, or for a client as against a former client, in relation to the same or a related matter in a situation of conflict, or possible conflict but only is all of the parties have given their informed consent in writing. Regardless of consent a regulated person must, however, refuse to act on behalf of conflicting or potentially conflicting parties in contentious matters, in circumstances where the regulated person's actions would not be seen to be neutral or where accepting instructions from both parties would risk a breach of Rule 5 or if Rule 8 cannot be observed.

- 7.1 If a regulated person acquires or has acquired relevant knowledge concerning a current or a former client in the course of acting for that client in any capacity, the regulated person should not accept instructions to act against that client or should henceforth cease to act against that client. The term "relevant knowledge" should mean knowledge of the client or the client's affairs that is not widely disseminated to the public and that is, or is likely to become, relevant to the action concerned against the client.
- 7.2 A regulated person must not allow any person to perform work under his supervision when the regulated person knows or has reasonable grounds for suspecting that such a person has a conflict of interest in respect of the work.
- 7.3 A conflict may not arise simply because the regulated person acts for two or more parties in the same general field of business or technology although on the facts it may do so. More typically a conflict arises by reference to the specific subject matter of a case. However, acting for two or more parties in the same general field of business or technology may give rise to issues of confidentiality under Rule 8.



- 7.4 Confidentiality safeguards within firms or between branches may be sufficient to "cure" conflict, provided informed written consent is obtained from all parties and suitable arrangements to ensure the confidentiality of information applying to each client are in place. Safeguards within firms or between branches cannot, however, "cure" conflicts to enable the same regulated person to act on behalf of opposing parties in a contentious matter.
- 7.5 All regulated persons should undertake a "conflict check" before taking on a new client. This may take whatever form is considered appropriate in all of the circumstances. The minimum expected is a check with all other relevant persons that acceptance of a named client is not likely to compromise the interests of a client already on the books.
- 7.6 Unless otherwise agreed, informed consent requires that the parties whose interests do or may conflict are notified in writing of the name(s) of the other party(ies).
- 7.7 Where there is conflict between the interests of a regulated person, and those of a client, neither informed consent, nor any other arrangement, will enable him to act for that client.
- 7.8 Nothing in these Rules prevents a regulated person from acting as a mediator between parties to a dispute provided the appropriate codes of practice which deal with conflict when acting as a mediator are observed.

Rule 8 - Confidentiality and Disclosure

Regulated persons must keep the affairs of clients and former clients confidential except where disclosure is required and permitted by law or by the client or former client.

Subject to this duty of client confidentiality and any circumstance where disclosure of information is prohibited by law, unless a client expressly agrees that no duty to disclose arises or a different standard of disclosure applies, a regulated person should disclose all relevant information of which he is aware to a client.

Regulated persons must not put any clients' confidential information at risk by acting, or continuing to act for another client where that information may be material, unless both clients provide informed consent and in all of the circumstances it is reasonable to do so.

- 8.1 Confidentiality of clients' information is paramount and central to, though distinct from, the issue of conflict of interests.
- 8.2 A regulated person's duty of confidentiality arises irrespective of the source of information and continues until the client permits disclosure, waives the confidentiality or the information in question is made public and ceases to be confidential.
- 8.3 Where a regulated person takes on a client where there is already a client on the books in the same area of business or technology, but where the matters for which they have been engaged are not related, they should still ensure that the confidential information associated with one is not allowed to be made available to the other or to any regulated person acting for the other client.



- 8.4 Regulated persons have a duty to disclose all relevant information, of which they are aware, to their client in respect of the matter in hand. Information of which they are not aware, but is known to others in the same firm, for example, would be exempted, as would information disclosure of which would breach the duty of confidentiality to another client.
- 8.5 If information is obtained in relation to a prospective client, a regulated person may still be bound by a duty of confidentiality, even if that prospective client does not subsequently instruct that person or their firm. There may be circumstances, however, where a regulated person receives information where there is no real or genuine interest in instructing that person or their firm and that information is unlikely to be confidential.

Rule 9 – Relationships with Other Professionals

Regulated persons should not communicate directly with any other party who to his knowledge has retained a registered person or other legally qualified person as a professional advisor to act in a matter except :

to request the name and address of the other party's professional advisor;

where it would be reasonable to conclude that the other party's professional advisor has refused or failed for no adequate reason either to pass on messages to their client or to reply to correspondence, and has been warned of your intention to contact their client direct;

with that professional advisor's consent; or

in exceptional circumstances.

A regulated person should co-operate with a client and any new representative of the client to ensure the client's interests are protected on any change of responsibility.

- 9.1 When a regulated person has been given explicit notice that another party has engaged a patent attorney, trade mark attorney or other legally qualified person in relation to a specific matter, the regulated person should normally direct all communications about that matter to the appointed advisor rather than directly to the party. The mere recordal of an address for service in relation to a relevant or potentially relevant right does not necessarily on its own constitute explicit notice that an advisor has been appointed in relation to a matter. Rather, it is only where a regulated person has been informed that a party has appointed a professional advisor, or the registered person receives a response from such an advisor, or it is otherwise objectively clear from the facts or circumstances that the recorded address for service is the appointed advisor in the specific matter in question, that the regulated person should avoid direct, or further direct, communication under this Rule.
- 9.2 General communications and publicity undertaken by regulated persons (i.e. communications not in relation to a specific matter where another party has retained a professional advisor in relation to that matter) are governed by Rule 18.
- 9.3 Nothing in this Rule shall be taken to prevent a regulated person from exercising a lien over client papers or other materials to the extent permitted by Rule 13.



Rule 10 - Fees

Regulated persons' fees must be justifiable.

Guidance

10.1 Fees charged should be based upon the information provided in any letter of engagement or on the basis of any amendment thereto.

Rule 11 - Financial Matters

Regulated persons shall ensure that their professional finances are managed appropriately.

Guidance

- 11.1 In the event that a regulated person receives money from a client, other than by way of payment of fees or disbursements or money on account for fees or disbursements paid up front, they should ensure that such money is held on trust for the client in an account which is entirely separate from the regulated person's or the firm's professional business accounts.
- 11.2 In the event that money may be held on trust for a client, a registered person's terms of business should deal with the issue of ownership of interest earned on money held on behalf of a client.
- 11.3 It is the responsibility of regulated persons to ensure that they are aware of legislation pertaining to "money laundering" and proceeds of crime".

Rule 12 - Complaints Handling

Regulated persons in private practice must have an established procedure for dealing with complaints. Written details of the procedure must be available whenever a client requests them and a client should be informed in writing, when first engaging the registered person, that such a procedure for the resolution of a complaint exists.

Regulated persons in private practice must notify all clients of the right to complain to the Legal Ombudsman at the conclusion of the complaint process, the timeframe for doing so and full details of how to contact the Legal Ombudsman. Such notification must be in writing and be provided at the time of engagement or in the case of existing clients at the next appropriate opportunity. A similar notification must be provided to all such clients at the conclusion of any complaint process.

Regulated persons in private practice must keep records of all complaints received and the outcomes of their complaints procedures in respect of such complaints. In this context a complaint means an oral or written expression of dissatisfaction which alleges that the complainant has suffered (or may suffer) financial loss, distress, inconvenience or other detriment.



- 12.1 The Rules of the Legal Ombudsman provide a right of complaint to all individuals who engage the services of authorised persons such as Patent Attorneys and Trade Mark Attorneys. The Legal Ombudsman has also applied to have the jurisdiction to review complaints made by micro enterprises as defined in European Recommendation 2003/361/EC (broadly enterprises with fewer than 10 staff and a turnover or balance sheet value not exceeding €2 million); charities, clubs, associations and societies with annual incomes of less than £1 million, trusts with net asset value less than £1 million and personal representatives or residual beneficiaries of an estate where a person with a complaint died before referring it to the ombudsman scheme.
- 12.2 Sufficient information must be given to all clients to enable them to identify whether they do have a right to take their complaint to the Legal Ombudsman and to contact the Legal Ombudsman to clarify whether they can.

Rule 13 - Liens

Regulated persons may exercise a lien over client papers and other materials belonging to a client only when and to the extent that the lien is available in law or the lien is an express term of business to which the client has agreed.

Guidance

- 13.1 The issue of lien comes up reasonably frequently in complaints. Regulated persons do not benefit from the statutory lien of solicitors and the extent of any lien if any at common law has never been clarified. It is best to ensure this is dealt with in written terms.
- 13.2 Any charges or contractual liens applicable to a transfer of files should be set out in the regulated person's terms of business or should be otherwise agreed, but the absence of agreement should not unreasonably delay effecting the transfer. Regulated persons should note that if they have not dealt with this issue adequately in their terms of business, they may be in no position contractually to recover costs associated with the transfer if no other agreement can be reached.
- 13.3 Save in exercise of any lien, it is not acceptable to obstruct or unreasonably delay a transfer of responsibility to a new representative when asked to do so by a client.

Rule 14 - Duty to Act in the Interests of Justice

Regulated persons exercising any right to appear before a court or tribunal or to conduct litigation must comply with their duties to the court or tribunal and act with independence in the interests of justice. Regulated persons exercising any right to appear before a court or to conduct litigation shall observe the Special Rules of Professional Conduct applicable to Litigation Practitioners.

Guidance

14.1 A regulated person must not submit orally or in any documents or pleading:



- a) statements of fact or contentions that are not supported by the evidence or instruction of the client;
- b) contentions that he cannot justify as prima facie arguable;
- c) allegations of fraud unless clearly instructed to make such an allegation and it is prima facie supported by credible material; note, however, that this does not preclude the making of claims of "bad faith" per se (for example, a lack of intention to use a trade mark), unless that claim is specifically directed to substantive fraud.

14.2 A regulated person must not:

- a) rehearse practice or coach a witness in relation to his evidence;
- b) encourage a witness to give evidence which is untruthful or which is not the whole truth;
- c) except with the consent of the representative for the opposing side or of the Court, communicate directly or indirectly about a case with any witness, whether or not the witness is his lay client, once that witness has begun to give evidence until the evidence of that witness has been concluded.

14.3 A regulated person when conducting proceedings in Court:

- a) is personally responsible for the conduct and presentation of his case and must exercise personal judgement upon the substance and purpose of statements made and questions asked;
- b) must not unless invited to do so by the Court or when appearing before a tribunal where it is his duty to do so assert a personal opinion of the facts or the law;
- c) must ensure that the Court is informed of all relevant decisions and legislative provisions of which he is aware whether the effect is favourable or unfavourable towards the contention for which he argues;
- d) must bring any procedural irregularity to the attention of the Court during the hearing and not reserve such matter to be raised on appeal;
- e) must not adduce evidence obtained otherwise than from or through the client or devise facts which will assist in advancing the lay client's case;
- f) must not make a submission which he does not consider to be properly arguable;
- must not make statements or ask questions which are merely scandalous or intended or calculated only to vilify, insult or annoy either a witness or some other person;
- must if possible avoid the naming in open Court of third parties whose character would thereby by impugned;



- i) must not by assertion in a speech impugn a witness whom he has had an opportunity to cross-examine unless in cross-examination he has given the witness an opportunity to answer the allegation;
- j) must not suggest that a witness or other person is guilty of crime, fraud or misconduct or make any defamatory aspersion on the conduct of any other person or attribute to another person the conduct of which his lay client is accused unless such allegations go to a matter in issue (including the credibility of the witness) which is material to the lay client's case and appear to him to be supported by reasonable grounds.
- 14.4 In addition to observing the Special Rules of Professional Conduct applicable to Litigation Practitioners, advocates should also be aware of and give consideration to the professional rules of the SRA and BSB as they impact on the conduct of the advocate.

Rule 15 - Anti-Discrimination

Regulated persons must not, in the conduct of their practice, unfairly or unlawfully discriminate against any person on grounds of race, religious belief, gender, sexual orientation, age or disability.

Rule 16 – Continuing Professional Development

Registered patent attorneys and registered trade mark attorneys shall undertake appropriate continuing professional development and, on request, provide details thereof to the appropriate Regulation Board.

Rule 17 - Professional Indemnity Insurance

Without prejudice to any obligation contained in the Special Rules of Professional Conduct applicable to Litigation Practitioners, each registered person or his firm in private practice must take out and maintain professional indemnity insurance cover, for each and every claim brought in the United Kingdom or elsewhere in the EU, commensurate with the risks at large arising from the extent and size of their practice, with due regard to Rule 4 (Competence). Any limitation of liability for negligence must be clearly drawn to the attention of a client and be understood and accepted by him.

Guidance

17.1 It would be expected that Professional Indemnity Insurance of at least £1 million would be required for all registered persons and their firms, unless demonstrably, their practice does not warrant a sum that high.



Rule 18 - Publicity

Publicity and promotional activity of any kind by regulated persons is permitted if it is fair, honest, accurate and is not misleading and is not otherwise in breach of these Rules.

The letterhead, website and e-mails of firms and sole practitioner registered persons in private practice must show the words "regulated by the Intellectual Property Regulation Board" or "regulated by IPReg".

- 18.1 What is acceptable promotional activity will inevitably change over time and will be a matter of subjective assessment in each case. For example, whilst creativity is an essential part of promotion, good taste in content and execution is important.
- 18.2 Cold calling (by any means) of private individuals or to domestic premises unless a business is being conducted from there would generally be unacceptable, and would certainly be so if directed repeatedly to specific individuals or groups.
- 18.3 Letterheads must comply with the Business Names Act 1985 concerning lists of partners and an address for service on stationery etc. and the Companies (Trading Disclosures) Regulations 2008 (SI 2008/495) regarding the appearance of the company name and other particulars on stationery, etc. If non-partners are named on a partnership's letterhead, their status should be made clear. A printed line is not sufficient in itself to distinguish partners from non-partners in a list. A similar standard applies to a company or an LLP's letterhead'.
- 18.4 The website and e-mails of any individual or firm providing services to the public in the EU must comply with the provisions of the E-Commerce Directive 2000/31/EC. This requires that the following information is included in electronic communications including e-mails and websites involved in cross-border e-commerce within the EU:
 - a) details of the professional body with which a firm is registered, which in the case of patent attorneys and trade mark attorneys would be IPReg;
 - the professional title and the member state where it was granted it is recommended to state that the partners/members/directors of the firm are UK registered patent and/or trade mark attorneys; and
 - c) a reference to the professional rules applicable to the firm in the member state where the firm is established and the means to access them. This could be achieved by providing a link to the Code of Conduct on the IPReq website.
- 18.5 Registered persons should only describe themselves or permit themselves to be described as "patent attorney litigators" or "trade mark attorney litigators" or the like if they hold a Higher Courts Litigation Certificate. Similarly, only registered persons who hold a Higher Courts Advocacy Certificate should describe themselves or permit themselves to be described as "patent attorney advocates" or "trade mark attorney advocates" or the like.



Rule 19 – Information to Regulation Boards

Regulated persons shall submit in a timely manner such information as the Regulation Boards may reasonably require.

Rule 20 - Co-operation

Regulated persons shall co-operate fully with the appropriate regulation Boards, and with any persons designated by them in connection with their regulatory responsibilities.

Rule 21 – Avoidance of Regulatory Conflict

To avoid regulatory conflict as defined in Sections 52 - 54 of the Legal Services Act 2007, the appropriate Regulation Boards may waive in writing the provisions of these Rules in any particular case or cases where the professional activities of a regulated person are fully regulated by another professional regulator.

Rule 22 – Commencement Date

These Rules shall apply from the date on which Sections 184 and 185 of the Legal Services Act 2007 come into force with the exception of Rule 18 second sentence which shall come into force 6 (six) months after that date.

First issued September 2009

Rule 12 amended October 2010

Guidance to Rule 6 (additional text to 6.1) amended September 2011

Guidance to Rule 8 (new 8.2) amended September 2011

Guidance to Rules 4, 14 and 18 amended December 2012



Special Rules of Professional Conduct applicable to Regulated Persons conducting litigation or exercising a right of audience before the Courts

The Patent Regulation Board of the Chartered Institute of Patent Attorneys and the Trade Mark Regulation Board of the Institute of Trade Mark Attorneys working jointly together as the IP Regulation Board (IPREG) now make the following provisions under section 275A of the Copyright Designs and Patents Act 1988 and under section 83A of the Trade Marks Act 1994, respectively, pursuant to Sections 185 and 184 of the Legal Services Act 2007.

Rule 1 – Interpretation

In these Rules, unless context otherwise requires:

"CIPA" means the Chartered Institute of Patent Attorneys;

"ITMA" means the Institute of Trade Mark Attorneys;

"IPREG" means the Patent Regulation Board of CIPA and the Trade Mark Regulation Board of ITMA working jointly together as the Intellectual Property Regulation Board;

"patent attorney register" means the register kept under section 275 of the Copyright Designs and Patents Act 1988 as amended;

"trade mark attorney register" means the register kept under section 83 of the Trade Marks Act 1994 as amended:

"registered person" means —

- a) a registered patent attorney;
- b) a registered trade mark attorney; or
- c) a body (corporate or unincorporate) registered in the patent attorney register or the trade mark attorney register;

"regulated person" means a registered person, an employee of a registered person, or a manager of a body which is a registered person;

"manager", in relation to a body, has the same meaning as in the Legal Services Act 2007;

"litigation certificate" means a certificate issued by CIPA or ITMA under their authority as authorised bodies under the Legal Services Act 2007 to grant rights of audience or conduct litigation;

"litigation work" shall mean conducting litigation or exercising a right of audience before the UK or community courts including any work undertaken within the scope of a litigation certificate:

"litigation practitioner" shall mean a regulated person undertaking litigation work;

"employed litigation practitioner" shall mean a litigation practitioner who is employed by an employer who is not regulated by IPREG or another legal services regulator under the Legal Services Act 2007.



Rule 2 - Scope of Rules

- 2.1 Subject to Rule 2.2, these Rules and the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other regulated persons shall apply to litigation practitioners and shall prevail over any other rules of conduct to which a litigation practitioner is subject.
- 2.2 Litigation practitioners undertaking litigation work in their capacity as:
 - (a) a recognised sole practitioner regulated by the Solicitors Regulation Authority;
 - (b) a self-employed barrister regulated by the Bar Standards Board; or
 - (c) a Manager or employee of an entity or person authorised by another approved regulator to carry on an activity which is a reserved legal activity

shall be subject to these Rules only to the extent that these Rules are compatible with the rules of the other legal regulator regulating that work.

2.3 A litigation practitioner shall be responsible for ensuring that all litigation work performed by a person under his or her supervision will be conducted in accordance with these Rules.

Rule 3 – Duties of a litigation practitioner

- 3.1 A litigation practitioner conducting litigation or exercising a right of audience has a statutory duty
 - (a) to the court to act in the interest of justice; and
 - (b) to comply with these Rules and the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other regulated persons

and those duties override any obligation which the litigation practitioner may have (otherwise than under the criminal law) it if is inconsistent with them.

- 3.2 A litigation practitioner whilst under a duty to do the best for a client must never deceive or mislead the Court.
- 3.3 A litigation practitioner must not make or instruct Counsel to make an allegation which is intended only to insult, degrade or annoy the other side, a witness or any other person.
- 3.4 A litigation practitioner is under a duty to attend or arrange for the attendance of a responsible representative throughout any Court hearing attended by Counsel.
- 3.5 A litigation practitioner must comply with any order of the Court which the Court can properly make requiring the litigation practitioner and his or her firm to take or refrain from taking some particular course of action.
- 3.6 A litigation practitioner must comply with the letter and spirit of any undertaking given to the Court or other party whether or not that undertaking is supported by consideration.

Rule 4 – Conflicts of Interests arising in the course of litigation work

4.1 A litigation practitioner must not accept instructions to act for two or more clients where there is a conflict or a significant risk of conflict between the interests of the clients.



- 4.2 A litigation practitioner must not continue to act for two or more clients where a conflict of interest arises between those clients.
- 4.3 Subject to Rule 5, an employed litigation practitioner may only undertake litigation work for a person other than his or her employer if;
 - (a) he or she declines to act for that person if any conflict arises between the employer and that person; and
 - (b) he or she informs that person in writing prior to commencing the or each piece of litigation work that he or she is an employee and that he or she must decline to act further for that person if any conflict arises between the employer and that person.

Rule 5 - Employed litigation practitioners

- 5.1 An employed litigation practitioner shall not act in the course of his employment with his employer as a litigation practitioner except in accordance with the following provisions of Rule 5.
- 5.2 In the course of his employment, an employed litigation practitioner may act for the employer and the following related bodies
 - (a) the employer's holding, associated or subsidiary company;
 - (b) a partnership, syndicate or company by way of joint venture in which the employer and others have an interest;
 - (c) a trade association of which the employer is a member;
 - (d) a club, association, pension fund or other scheme operating for the benefit of employees of the employer;
 - (e) where the employer is a public body, for another public body or statutory officer to which the employer is statutorily empowered to provide legal services; or
 - (f) a person with whom the employer has a joint interest in the outcome of any proceedings, including in particular any licensee or licensor of the employer, or any joint owner with the employer of any intellectual property rights the subject of the relevant litigation work, providing that such joint interest is bona fide for the employer's benefit and is not formed directly or indirectly for securing assistance in legal proceedings.
- 5.3 Subject to the following provisions, an employed litigation practitioner may also act for the following persons;
 - (a) a fellow employee;
 - (b) a director, company secretary or board member of the Employed litigation practitioner's employer; or
 - (c) an employee, director, company secretary, board member or trustee of the employer or of a related body of the employer within the meaning of Rule 5.2;

Provided that in each case

- (a) the matter related to or arises out of the work of such person for the employer;
- (b) the employed litigation practitioner is satisfied that such person does not wish to instruct some other representative; and
- (c) no charge is made to such person, in relation to the employed litigation practitioner's costs, unless such costs are recoverable from any other source.



- 5.4 The employed litigation practitioner shall, before accepting instructions to act for the bodies or persons other than the employer in accordance with these Rules, give written notice to the client that the employer is not able, by way of insurance or otherwise, to indemnify the client adequately in the event of a claim against the employed litigation practitioner for which the employer would be vicariously liable, if that be the case.
- 5.5 The employed litigation practitioner shall before accepting instructions to act for the bodies or persons other than the employer in accordance with these Rules, give written notice to the client that the employed litigation practitioner is not covered by insurance in relation to professional negligence, if that be the case.
- 5.6 Where an Employed litigation practitioner is acting for a body or person other than the employer in accordance with these Rules, any information disclosed by the Employed litigation practitioner by the client is confidential and cannot be disclosed to the employer except with the express consent of the client.

5.7 Interpretation

- 1. "holding " and "subsidiary " Company have the meanings assigned to them by the Company's Act 1985 (as amended from time to time) and two companies are "associated " where they are subsidiaries of the same holding company or companies; and
- 2. any references to a litigation practitioner's employer include the employer's holding, associated or subsidiary company, and any references to an employee include references to an employee of such holding, association or subsidiary company.

Rule 6 - Non-discrimination

A litigation practitioner in any instance in which he is providing advocacy services In the course of litigation work must not withhold those services:

- (a) on the ground that the nature of the case is objectionable to him or to any section of the public;
- (b) on the ground that the conduct, opinions or beliefs of the prospective client are unacceptable to him or to any section of the public; or
- (c) on any ground relating to the source of any financial support which may properly be given to the prospective client for the proceedings in question (for example, on the ground that such support will be available under the Access to Justice Act 1999).

Rule 7 - Fees

- 7.1 A litigation practitioner must not charge unjustifiable fees having regard to fees generally charged by professions in the conduct of litigation of comparable complexity and difficulty to the litigation work in question.
- 7.2 A litigation practitioner who is retained in connection with litigation work shall not enter into any arrangement to receive a contingency fee in respect of that work except if permitted to do so by the Lord Chancellor in accordance with any statute or statutory instrument or otherwise in accordance with any rule of law.



7.3 In order to reduce misunderstandings concerning the levels of fees charged for litigation work, the client must also be informed in writing of the basis on which the work is to be charged.

Rule 8 – Community Legal Service Fund

A litigation practitioner is under a duty to consider and advise the client on the availability of funding for litigation services by the Community Legal Service Fund or any funding available from the wider Community Legal Service to which the client might be entitled under the Access to Justice Act 1999 and any Statutory Instruments thereunder or any succeeding Act.

Rule 9 - Professional Indemnity Insurance

- 9.1 Each litigation practitioner or his or her firm must take out and maintain professional indemnity insurance cover for litigation work. When commencing and renewing such insurance, each litigation practitioner or his firm shall ensure that the insurance provides cover in respect of each and every claim brought in the United Kingdom or elsewhere in the European Union of at least the Minimum Value (as defined in the next sentence) prevailing at the time of commencement or renewal. The Minimum Value shall be determined by IPREG from time to time but shall never be a value less than £1,000,000.
- 9.2 A litigation practitioner shall not limit liability for professional negligence below the Minimum Value.
- 9.4 The provisions of this Rule 9 shall not apply to an employed litigation practitioner when he is acting within the meaning of Rule 5.2 or 5.3.

Rule 10 - Client's Money

- 10.1 A litigation practitioner must ensure that any money held on behalf of the client in respect of such litigation work is held on trust for the client in an account which is entirely separate from the litigation practitioner's personal or professional business account.
- 10.2 Money which would have to be kept in the separate account includes that which is intended or which may be required to be:
 - (a) paid or received from a third party on settlement or as the Court might direct; or
 - (b) paid into or received from the Court (including without limitation by way of a Part 36 payment or a payment on account of costs following summary or detailed assessment).
- 10.3 Money in the separate client's account must be held to the order of the client or the Court and any interest accruing in the account must inure to the client.
- 10.4 Money which the litigation practitioner is not required to keep in such a separate clients' account includes:
 - (a) any money receiving on account of expected charges for the litigation practitioner's services;
 - (b) costs to be incurred on the client's behalf; and
 - (c) money paid in settlement of a debt owed by the client to the litigation practitioner.



Rule 11 - Commencement Date and Repeal

- 11.1 These Rules shall apply to all litigation work effective from 15th September 2011.
- 11.2 The ITMA Rules of Professional Conduct for Trade Mark Agents holding and acting within the scope of Litigator Certificates and the CIPA Rules of Professional Conduct for Patent Attorneys holding and acting within the scope of Litigator Certificates shall cease to be effective as of that date.

Patent Examination Board P6 – Infringement and Validity of UK Patents Final Examination Syllabus



Prerequisites	Have passed P1 or an approved course which grants eligibility to take the PEB final examinations.	
Aim	To test competencies expected of a patent attorney in advising on UK patent infringement and validity issues. Advice should be based on a knowledge of the legal framework and be appropriate to the facts provided and the client's needs.	
Competencies	Knowledge and understanding	
tested	Has a thorough knowledge and understanding of the key aspects of law	
	practice relating to validity and infringement of UK patents and can exploit	
	that knowledge in advising clients.	
	Personal effectiveness	
	Sees the overall picture.	
	 Is able to understand and interpret patents and other technical information. 	
	 Assimilates data and information provided to extract the issues. 	
	 Is able to reach an informed opinion on a finely balanced point. 	
	 Is able to use the information available to support the opinion reached. 	
	 Proposes actions solely on the basis of the information available in the question. 	
	 Identifies further information that may be required for a final opinion. 	
	Communicating and influencing	
	 Identifies key issues and where appropriate the alternative scenario or interpretation. 	
	Communication is clear, advisory, persuasive and informative.	
	Delivering results	
	 Advice reflects the client's needs and priorities. 	
	 Proposals are based on balanced analysis of information, risks and 	
	costs.	
	Proposals are practicable and achievable.	
Knowledge required	Patentable inventions.	
	2. Amendment of patents and patent applications.	
	Infringement including consequences of partial validity, right to continue use, effect of publication, burden of proof.	
	4. Revocation of Patents and putting validity in issue.	
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Patent Examination Board P6 – Infringement and Validity of UK Patents Final Examination Syllabus



Assessment method and success criteria	Examination lasting 5 hours. The examination paper will comprise a letter from a client or another document explaining the problem, a patent that is potentially infringed, and no more than four other documents that may be relevant to the infringement and/or validity of the patent being considered; documents may be relevant to more than one aspect of the problem. Candidates are expected to analyse and interpret the information and prepare a memorandum, setting out their opinion on one or more of the following (according the requirements of the situation):	
	 a. what is a tenable construction of the patent claims, supported by reasoning based on and referring to matter disclosed in the documentation where appropriate; b. whether the alleged infringement(s) do in fact infringe the patent concerned; c. the validity of the claims of the patent concerned in all relevant circumstances; d. the possibility of amending the patent concerned to improve the prospects of enforcement; 'design around' possibilities to avoid the protection offered by a patent under consideration; e. options available to the client; and f. an indication of further information that might be needed; and an indication only of any other practice points that might be raised by the situation. 	
	Candidates gaining 50 % or more of the marks available for the paper will be deemed to have passed the examination.	
Reading List	 The CIPA Guide to the Patents Acts and supplements (pub. Thompson - Sweet and Maxwell) including the cases discussed in the commentary on those parts of the Patents Act set out in the scope of themes on page 3 Terrell on the Law of Patents (Sweet and Maxwell) 	

Patent Examination Board P6 – Infringement and Validity of UK Patents Final Examination Syllabus



Scope of Themes

Theme	Legislative Background	Rules
1. Patentable	PA 1 - Patentable Inventions	
Inventions	PA 2 - Novelty	PR5
	PA 3 - Inventive Step	
	PA 4 - Industrial Application	
2. Amendment of	PA 19 and 27 - General powers to amend	
patents and patent	PA 75 - Amendment of patent in infringement	
applications	or revocation proceedings	
	PA 76 - Amendments of applications and	
	patents not to include	
	added matter	
	PA 117 - Correction of errors in patents and	
	applications	
3. Infringement	PA 60 - Meaning of Infringement	
	PA 61 - Proceedings for Infringement of patent	
	PA 125 - Extent of invention.	
4. Revocation of	PA 72 - Power to revoke patents on	PR 73, 75, 87
Patents and putting	application	PR 73, 75
validity in issue.	PA 73 - Comptroller's power to revoke	
	patents on his own initiative	
	PA 74 - Proceedings in which validity may	
	be put in issue	PR 92 to 100
	PA 74A and 74B Opinions by Patent Office	
	PA 125 - Extent of invention	

PA = The Patents Act 1977 (as amended) http://www.ipo.gov.uk/patentsact1977.pdf



Have passed P1 or an approved course which grants eligibility to take the PEB final examinations. To test competencies expected of a patent attorney in handling problems	
met in day to day practice with an emphasis on applied knowledge.	
Knowledge and understanding	
Has a thorough knowledge and understanding of the application of the key aspects of law and practice as will be required by a person advising clients on UK matters. In addition can also exploit that knowledge in advising clients, and in dealings with the patent office, foreign associates and persons from other professions.	
Personal effectiveness	
Sees the overall picture.	
 Assimilates data and information provided to extract the issues. 	
 Generates logical, considered and effective proposals for the way ahead. 	
 Evaluates risk and proposes mitigating actions. 	
Takes account of impact of proposals on others.	
Identifies further information or evidence needed, but where	
necessary proposes actions on the basis of limited information,	
including appropriate consideration of the alternatives available.	
Communicating and influencing	
 Writes to persuade, advise and inform. 	
 Can produce appropriate written material to suit requirement (e.g. 	
letter, brief, recommendation, statement of facts).	
Communication is clear and will be easily understood.	
Delivering results	
 Advice reflects client's needs and priorities. 	
 Proposals are based on balanced analysis of information, risks and costs. 	
 Proposals are practicable and achievable. 	
 Recognises and balances resources (e.g. costs/ time/ manpower) involved in options put forward. 	



Knowledge required

- 1. Forms of Intellectual Property protection available and their limitations.
- 2. Patentable inventions.
- 3. The right to apply for and obtain a patent, inventorship, ownership and employee relations.
- 4. Making patent applications, their search and examination, amendment and correction of applications.
- 5. Filing patent applications abroad, patentability and disclosure requirements in EPC, Japan and US.
- 6. Provisions as to patents after grant term, unity, amendment and restoration.
- 7. Patents and patent applications as a form of property, the patent register, securing information about patents, patent applications and inspection of documents.
- 8. Infringement including impact of partial validity, right to continue use, effect of publication, burden of proof and threats, marking, obtaining information about infringement (including from abroad).
- 9. Revocation of patents and putting validity in issue.
- 10. European patents (and applications therefore) effective in the UK.

 The European Patent Convention and Rules in so far as they interact with or inform UK law and practice and/or relate to the validity or revocation of patents effective in the UK.
- 11. International applications for patents (PCT) and entering the UK national phase from an international application.
- 12. Registered designs effective in the UK what is protectable, proprietorship, rights given by registration, duration an infringement.
- 13. Unregistered design rights effective in the UK; what is protectable, who qualifies for rights, duration and infringement, licences of right.
- 14. Convention applications (patents and designs).

Assessment method and success criteria

Examination lasting 4 hours. The examination paper will comprise a series of problems set out in two parts.

The first part (Part A) comprises about 6 problem each requiring analysis and advice involving law and practice taken from no more than two specific areas of knowledge (listed above). Candidates will be required to write letters, memoranda, and other appropriately responsive material. These problems will be particularly directed at testing the knowledge and communicating competencies.

The second part (Part B) comprises three problems. Responses to two of these problems will be required. The problems will be longer and wider ranging than those in the first part, will test the range of competencies, and probe a number of different aspects of law and practice.



	The weighting given to each of Parts A and B is equal. Marks are not given for mere recitation of statutes or regulations. Rather marks are given for applying these to the specific facts or situations of a question, giving options, recommendations or opinions and providing the underlying analysis, as appropriate. Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.
Reading list	 The CIPA Guide to the Patents Acts and supplements (pub Thompson - Sweet and Maxwell) including the cases discussed in the commentary on those parts of the Patents Act where thorough knowledge is sought Russell-Clarke and Howe on Industrial Designs (Thompson - Sweet and Maxwell) Terrell on the Law of Patents (Sweet and Maxwell) Community Design Law Principles and Practice – David Musker (Sweet and Maxwell) Copinger and Skone James on Copyright (Thompson - Sweet and Maxwell) PCT Applicant's Guide (WIPO) - Including the entries for US and JP Patent, Trademark and Copyright Law (US) - BNA Books Blackstone's Statutes on Intellectual Property (Oxford University Press) Manual for the Handling of Applications for Patents, Designs and Trade Marks throughout the World especially the entries for Patents in Japan and
	the US.

Scope of Themes

Theme	Legislative Background	Rules
1. Available forms of	Scope of Parts I and III of the Copyright,	
industrial protection	Designs and Patents Act 1988 (CDPA), the	
	Patents Act 1977 (PA), the Registered Designs	
	Act 1949 (RDA), and the Trade Marks Act 1994,	
	the kinds of protection available and terms,	
	derogation from	
	protection	
	CT Arts 28 to 30	
	CT Arts 81 and 82	
	CDPA 51 to 53	
2. Patentable	PA 1 - Patentable Inventions	
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	earlier and later applications	
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PA = The Patents Act 1977 (as amended)

http://www.ipo.gov.uk/patentsact1977.pdf

RDA = Registered Designs Act 1949 (as amended)

PR = Patents Rules 2007

F = Patent Form Number

CDPA = Copyright, Designs and Patents Act 1988

CT = Community Treaty (also known as the Treaty of Amsterdam)

USC = United States Code

EPC = European Patent Convention 2000

EPR = Implementing regulations to the European Patent Convention 2000

PCT = Patent Co-operation Treaty



nowledge and understanding andidates are expected to show a general knowledge of the English legal astem, including an appreciation of the differences between civil and riminal jurisdictions and remedies. 1. Candidates will need an outline knowledge of the structure of the courts in England (including Appeal Courts and the divisions of the High Court) and an understanding of the doctrine of precedent and the relevance of decided cases (their binding effect on future decision making). 2. In addition an outline knowledge is required of the manner in which the decisions of courts and tribunals may be challenged. This should include the routes and main grounds for appealing through the English Courts; the availability, procedure and main grounds for seeking judicial review; and the circumstances in which references to the Court of Justice of the European Union and the General Court may be made.
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the decisions of courts and tribunals may be challenged. This should include the routes and main grounds for appealing through the English Courts; the availability, procedure and main grounds for seeking judicial review; and the circumstances in which references to the Court of Justice of the European Union and the General Court
 Candidates will also be expected to have an outline knowledge of the sources of law in so far as they affect the field of intellectual property e.g. statute, secondary legislation, International Convention and custom and precedent.
 Candidates are expected to have an outline knowledge of how EU law applies to the UK, particularly with respect to Directives and Regulations.
 Candidates should have outline knowledge of how legislation is made by the UK Parliament in Westminster and by the Institutions of the European Union.
 Candidates will be expected to have an outline knowledge of the roles played by registered patent attorneys, registered trade mark attorneys, solicitors, barristers and judges.
 Candidates will be expected to have an outline knowledge of the law of court procedure, in so far as it affects the conduct of intellectual property law cases. The differences between the standard and the burden of proof in civil and criminal procedures must also be appreciated.



- 8. Candidates will also be expected to have an outline knowledge of the Civil Procedure Rules including the Patents County Court Rules, from pre-action procedure to the start of trial. In particular, candidates should be familiar with:
- the over-riding objective
- the 3 Woolf tracks and the allocation of IP disputes to those tracks
- the applicability of pre-action protocols to IP disputes
- where and how to issue proceedings
- an outline of how proceedings can be served
- a timetable for an action and a counterclaim
- an outline of disclosure obligations and procedure
- a good understanding of the reasons and applicability of privilege to
- communications, with particular reference as to how this applies to
- the candidates' individual professions
- · an outline of the obligations of an expert witness
- an outline of Part 36 CPR and a good understanding of the term 'without prejudice', the reasons for and rules relating to its use
- the purpose of the PCC, i.e. a quicker, less complex and less
- expensive alternative to the High Court
- possibility of transferring cases from High Court to PCC or vice versa
- based on complexity or monetary value
- an outline of procedure and comparison with the High Court, including:
 - pleadings are to set out the parties' case fully, i.e. they contain evidence;
 - any further evidence, arguments or discovery are only permitted at the judge's discretion and are discussed at the case management conference;
 - hearings last a maximum of 2 days;
 - recoverable costs are capped at £50,000.
- Candidates should be familiar with interim orders restraining infringement of IP rights until trial; search and seizure orders; and freezing orders.
- 10. Candidates should know the differences between these interim remedies, the circumstances when it might be appropriate to seek them and have an outline knowledge of the main issues that the Claimant will need to deal with in order to obtain such remedy.
- 11. Candidates will be expected to have an outline knowledge of the remedies available to a successful claimant in IP-related legal



proceedings, appreciating the differences between legal and equitable remedies.

- 12. Candidates should also know the general principles governing the award of costs made by the court at the end of trial and at interim hearings, including those governing the court's power to assess costs for immediate payment.
- 13. Candidates should be familiar with Alternative Dispute Resolution, including an outline knowledge of mediation and arbitration.
- 14. On the topic of evidence, candidates will be expected to know the varieties or types of evidence, including the differences between evidence of fact, evidence of opinion, hearsay evidence, etc., with particular reference to expert evidence and to the conduct and presentation of evidence obtained in market surveys.
- 15. Candidates should also know the rules of admissibility of written evidence and hearsay evidence in civil proceedings.
- 16. The rules governing the form of evidence in proceedings involving intellectual property law cases i.e. whether it should be in affidavit or statutory declaration or witness statement form, should be known thoroughly.

In addition candidates will be tested on the law of contract.

- 17. Candidates should know the basic elements necessary for the formation of a valid contract, for example, offer, acceptance, consideration, intention; having a thorough understanding of those terms.
- 18. Candidates should know the differences between an invitation to treat, an offer, and a counter offer; and their effects. Candidates should also have an outline knowledge of the rules for acceptance.
- 19. Candidates should be thoroughly familiar with the meaning of the following words: privity, condition, warranty, innominate term, misrepresentation, mistake.
- 20. Candidates should have an outline knowledge of the remedies available for enforcement of a contract.
- 21. Candidates should understand the difference between assignment



and novation of a contract.

- 22. Candidates will be expected to have knowledge of the tort of negligence and the tort of malicious falsehood. With regard to negligence, candidates should be able to discuss the duty of care, breach, causation and remoteness. They should have an understanding of negligent mis-statement and an appreciation of economic loss. With regard to the tort of malicious falsehood, candidates should have the ability to discuss briefly each element which needs to be dealt with by the Claimant (or the Defendant) in such a claim.
- 23. Candidates should have an outline knowledge of the law of personal property and trusts as it applies to the ownership of intellectual property rights.
- 24. Candidates should have an appreciation of the difference between legal and equitable title. They should have a familiarity with the terms joint tenants and tenants in common. They should have an outline knowledge of the differences between oral and written agreements to transfer IP and how defects in legal title can be perfected.
- 25. Candidates should have an outline knowledge of the relevant law of companies, namely the nature of a limited liability company.
- 26. Candidates should understand the principal differences between limited companies and limited partnerships and unlimited businesses, such as partnerships or sole traders.
- 27. Candidates should understand the differences in liability for the proprietors of those businesses and should also have an outline understanding of the obligations and liabilities of directors of incorporated businesses.
- 28. Candidates should have an outline knowledge of how investment can be made in businesses and have an understanding of the terms debenture and of fixed and floating charges.
- 29. Candidates should have an outline knowledge of the right to object to a new company name and should also be aware of what rights may or may not exist to use a company name once it has been registered.
- 30. Candidates should have an outline knowledge of professional



	matters, for example the practitioner's ethical, legal and financial responsibilities to his clients and his knowledge of the Rules of professional conduct (including those on advertising, if any) governing the Patent and Trade Mark professions.
	31. Candidates are expected to understand the nature of their contractual, tortious and fiduciary duties to their clients.
	32. Candidates should also understand conflict of interest so as to be able to identify when a conflict arises and whether or not they can continue to act in such a circumstance.
Assessment method	Examination lasting 2 hours. The examination paper will comprise of a
and success criteria	series of questions set out in two parts.
	The first part (Part A) comprises five questions of which four must be answered. Each question will carry ten marks. These questions will be particularly directed at testing knowledge.
	The second part (Part B) comprises five questions of which four must be answered. Each question will carry fifteen marks. The questions will require knowledge and a demonstration of understanding of the law.
	Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.



Queen Mary College · University of London

James Charles Boff

having completed the course of study approved by the College and passed the prescribed examination has been awarded the Queen Mary College

Diploma in Intellectual Property Law

Head of Department

Registrar

James menter

Given at Queen Mary College

this

187 day of August in the year 1983

The University of Manchester School of Law

PROGRAMME HANDBOOK

FOR THE

POSTGRADUATE CERTIFICATE IN INTELLECTUAL PROPERTY LAW

2003/2004

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Appendix:

Details of course units

LAW SCHOOL GENERAL INFORMATION

Staff

The School of Law was established in 1872 and is housed entirely in the Williamson Building. The current School Officers referred to in this Handbook are:

Dean and Head of Department: Professor Andrew Sanders

Associate Dean (Postgraduate Studies) Professor Gerard McCormack

Programme Director Postgraduate Certificate Mr David Booton in Intellectual Property Law

A full staff list will be found in the School Handbook, a copy of which you will be given on registration.

Administrative and secretarial work relating to the Postgraduate Certificate in Intellectual Property Law is undertaken by Laura Short and Myra Knutton who are based in Room 3.09. Enquiries on any matters which are not covered in this Handbook should be directed in the first instance to Laura Short: Tel: 0161 275 3561; e-mail Laura.Short@man.ac.uk.

Staff Rooms

Staff offices are located on the 2^{nd} , 3^{rd} and 4^{th} floors of the Williamson Building. A directory of staff offices is in the 3^{rd} floor foyer.

Communications Notice boards, Letters and E-mail

All communications will come either (1) *via* the notice board on the fourth floor of the Williamson building, in the area at the top of the stairs or (2) *via* the student pigeon-holes, situated by the School Library. Any post addressed to you at the School will be placed in the pigeon-holes. Please check the notice board, pigeonholes and your e-mail regularly for internal and external mail.

The notice board referred to above is for School notices only and must not be used for other material such as personal communications between students and advertisements for products or services.

All students receive an e-mail address upon registration. It is often convenient to communicate with staff *via* email. You are positively encouraged to use the system, which is available from computer clusters in the Williamson Building or the University Library, free of charge.

LEARNING RESOURCES

Libraries

The principal law book collection is in the main John Rylands University Library, where there is a very substantial collection of books and periodicals. Mrs Sue Bate is the member of the library staff who has a specialised knowledge of the law collection.

A smaller selection of law materials, consisting of the main sets of Law Reports and Law Journals, can be found in the Law School Library on the third floor of the Williamson Building.

Please be considerate in the use of materials both in the John Rylands University Library and the School Library. Return books to their proper place on the shelves when you have finished working from them so that others may use the books. Any theft of books or damage done to books is, of course, regarded as a very serious matter both by the School and by the University. Disciplinary action will be taken against any student who misuses the library facilities.

Computers Access to Computers and Learning Computer Skills

All students should have a basic level of competence in computing and Information Technology Skills. *Manchester Computing* offers information skills instruction which will ensure students have a working knowledge of the Windows operating system, word-processing, e-mail and the internet. Students who are unfamiliar with the basics of information technology are strongly encouraged to take advantage of these courses.

Computers are available for student use in the Law school computer room (3rd Floor, Williamson Building), the Graduate School computer room (4th Floor Williamson Building) and in the University Library.

THE PROGRAMME OF STUDY

Structure of the Certificate Programme

The programme is structured so that students' academic and practical knowledge, understanding and skills are developed together. The focus of the programme is on law and practice. Students are initially required to study those areas of English law which have a particular bearing on the study of intellectual property so as to have a framework of understanding on which to base a more advanced knowledge and understanding. The remainder of the programme is devoted to knowledge of, understanding of, and skills in intellectual property law in practice.

To obtain the Certificate, students must undertake and pass a total of six compulsory course units. All course units have a value of 10 credits. Course units are principally taught through lectures, although some may involve small-group teaching such as seminars. Teaching is undertaken by members of the School of Law and legal practitioners who have been appointed as honorary lecturers. Details of the individual course units comprising the Certificate programme are given in the Appendix.

Aims and Learning Outcomes

Aims

The programme aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of intellectual property law and to provide a foundation of knowledge and understanding of intellectual property law;
- 2. to provide sufficient knowledge, skills and understanding such that they may practice in the area of intellectual property law;
- 3. to provide students with sufficient knowledge, skills and understanding such that they may progress to the more advanced stages of training associated with their particular profession; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based programme which provides exemption from the relevant foundation-level professional examinations.

Learning Outcomes

1. Knowledge & Understanding

By the end of the programme, students will:

have acquired and developed a foundation knowledge and understanding of the English legal system;

have acquired and developed a foundation knowledge and understanding of certain aspects of the substantive law relating to contracts, tort, European law, and company law;

have acquired and developed a foundation knowledge and understanding of the substantive law relating to intellectual property and associated rights in the United Kingdom;

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting intellectual property rights within the United Kingdom;

have acquired and developed a foundation knowledge and understanding of the laws and procedures concerned with securing and protecting intellectual property rights in certain foreign jurisdictions;

have acquired and developed a foundation knowledge and understanding of the international legal relations concerned with the protection of intellectual property; and

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting intellectual property under various international conventions.

2. Intellectual skills

By the end of the programme, students will:

be able to identify the relevant legal issues arising in respect of a novel set of facts or circumstances;

be able to identify how the law applies to a particular novel set of facts or circumstances; and

be able to appreciate the practical significance of new legislation, case law and international treaties in the application of intellectual property law.

3. Practical skills

By the end of the programme, students will:

be able to structure and present legal arguments relating to practical problems in intellectual property law:

be able to provide preliminary advice on securing and protecting a range of intellectual property rights;

be able to approach simple issues in the drafting and amendment of patent specifications;

be able to approach basic problems in application, opposition and infringement proceedings relating to a range of intellectual property rights; and

be able to undertake basic legal research using both paper and electronic sources.

4. Transferable skills

By the end of the programme, students will:

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

TEACHING ARRANGEMENTS

Registration and Induction

Registration takes place on Monday 29 September 2003 at 11am. Students will be informed at registration of basic induction procedures and syllabus and timetabling matters relating to the programme. The registration package also includes library and computer information and timetable/coursework details for the course units.

Teaching Quality Assurance

The Postgraduate Certificate in Intellectual Property Law is governed and regulated by a special *Board of Studies*, which meets twice a year. The Board receives input from all the lecturers on the programme, both from within the University and the representatives of the profession. It monitors all the arrangements for teaching and learning, examinations and assessment.

The programme is subject to the University of Manchester's teaching quality processes. Annual Reviews on the programme are produced by the Programme Director for report to the Law School Postgraduate Affairs Committee and the Committee of the Manchester Graduate School of Social Sciences.

STUDENT FEEDBACK AND REPRESENTATION

Board of Studies for the PG Certificate in Intellectual Property Law

Two students may be elected to serve on the Board of Studies for the PG Certificate in Intellectual Property Law. Students who have any matters which they wish the Board of Studies to discuss are asked to contact the student representatives or the Programme Director, in the first instance.

Postgraduate Affairs Committee

Postgraduate Affairs Committee is responsible for all postgraduate students in the Manchester Law School. The student representatives on that Committee will act for Certificate students, but because of the timing of elections, it is not always possible for Certificate students to be members of the Committee. You may contact the student representatives via their noticeboard in the School Library.

Use of Student Questionnaires

Questionnaires will be issued to students for comment on the teaching style and content of the course units. Student comment on these questionnaires is taken seriously. The outcome is considered by the Programme Director and reported to the Board of Studies.

CHANNEL FOR COMPLAINTS

Complaints by students

If a student wishes to make a complaint about any aspect of the Programme or the School, such complaint should in the first instance be made to the Programme Director. If this is for some reason inappropriate, the student should speak to the Director of Postgraduate Affairs or to some other member of staff.

If a student is dissatisfied with the response, then he/she should submit the complaint in writing to the Dean. The written complaint should set out the nature of the complaint, the steps already taken together with details of the response received, and a statement setting out why the complainant remains dissatisfied.

Complaints will be dealt with positively, constructively and in confidence (with the proviso that an individual against whom a complaint is made has the right to be supplied with a copy of the complaints. The School treats all complaints seriously and will deal with them without recrimination. Where, however, a complaint is shown to be frivolous, vexatious or motivated by malice, disciplinary action may be taken against the complainant.

Students who wish to speak to someone outside the Law School may like to go to the Head of Student Administration in the central administration, John Owens Building: Tel 0161 275 2071.

EXAMINATIONS AND ASSESSMENT

Assessment Procedures and Criteria

Assessment will be by way of 6 unseen written examinations, five of 3 hours duration and one of 3 hours 15 minutes duration. One examination will be set for each course unit. Examinations will be taken during the normal university examination period. The choice of examination as the only means of assessment is intended to facilitate comparison with the corresponding professional foundation-level examinations.

Guidelines for Award of the Certificate

Candidates for the Certificate are required to satisfy the examiners in each of the six written examinations. The pass mark for each examination is 50%.

The Certificate may also be awarded to a candidate who achieves an aggregate of 300 marks or higher, and who has failed no more than one examination, so long as the fail mark is not less than 45%.

Criteria for Distinction

A candidate who obtains a mark of 60% or higher in all of the examinations shall be awarded the Certificate with distinction.

Publication of Results

Pass lists will be published on School and University notice boards within about two working days of the examiners' meeting, at which they are discussed. Individual course unit marks may be obtained from the Programme Director, but are **not** available from the secretarial staff.

Consequences of failing one or more examinations

A candidate who fails to sit or fails to satisfy the examiners in one or more subjects shall normally be required to resit those subjects on one further occasion.

Candidates who pass the Certificate having been required to resit one or more examinations cannot be awarded the Certificate with distinction irrespective of the actual marks obtained by the Candidate.

A candidate who fails to sit or fails to satisfy the examiners in any subject at the resit examinations shall normally be recommended for exclusion. In extraordinary circumstances, the Board of Examiners may instead permit an additional resit.

Double Marking

In order to ensure that all examination papers and other assessments are accurately marked, the University has a double marking policy. This double marking process, together with the external scrutiny provided by a specially appointed external examiner, ensures that an even standard applies across all papers.

Adverse Circumstances affecting Examinations

Any illness or other personal circumstances which may affect your performance in any element of assessment should be reported in writing, with appropriate medical or other evidence, to your personal tutor, the Programme Director or to the Dean as soon as possible.

Marking Conventions for Examinations

0-9%

Answer irrelevant

10-19%

Answer largely irrelevant but displays some knowledge, though muddled understanding of general subject

20-29%

Answer largely irrelevant but displays some understanding of general subject

30-39%

Candidate identifies a number of relevant issues but fails to show a grasp of relevant concepts and displays (whether explicitly or implicitly) major gaps in knowledge and/or understanding.

40-44%

Candidate is able to identify some of the key issue but shows only a partial grasp of the relevant concepts and fails to develop or illustrate points. Weak presentation. Prone to inaccuracy and tendency to irrelevance.

45-49%

Candidate is able to identify some of the key issue but shows only a partial grasp of the relevant concepts and fails to develop or illustrate points. Weak presentation.

50-59%

Candidate shows ability to identify many of the key issues and some ability to argue logically and organise answer. Answer demonstrates a knowledge of the material provided in the basic texts and lecture notes but without much evidence of critical thought or wider reading in, or appreciation of, the subject.

60-69%

Candidate shows ability to identify the key issues, demonstrates a good grasp of the relevant concepts and is able to argue logically and organise the answer well. Answer demonstrates good powers of critical thought, provides good use of examples to illustrate points and justify arguments, and displays wide evidence of reading in, and appreciation of, the subject.

70-74%

Candidate shows ability to identify the key issues, demonstrates an excellent grasp of the relevant concepts and is able to argue logically and organise the answer well. Answer demonstrates excellent analytical ability and very good powers of critical thought. Superior understanding is shown by good use of examples to illustrate points and to justify arguments. Evidence of wide reading in, and appreciation of, the subject.

75-100%

Candidate shows ability to identify the key issues, demonstrates an excellent grasp of the relevant concepts and is able to argue logically and organise the answer well. Answer demonstrates excellent analytical ability and very good powers of critical thought. Superior understanding is shown by good use of examples to illustrate points and to justify arguments. Evidence of wide reading in, and appreciation of, the subject and with clear evidence of independent reading or thinking and/or excellent powers of critical thought.

Examinations and Assessment for Students who have Accredited Prior Learning

These rules apply solely to candidates who have accredited prior learning exempting them from one of the course units comprising the Postgraduate Certificate in Intellectual Property Law. In the case of these candidates, and unless indicated otherwise, these rules replace those on examinations and assessment contained above.

Assessment will be by way of 5 unseen written examinations, each of 3 hours duration, which will be taken during the normal university examination period. One examination will be set for each unit. There is no examination for the accredited course unit.

Candidates for the Certificate are required to satisfy the examiners in each of the examinations taken. The pass mark for each examination is 50%. A *notional* pass mark of 50% will be automatically awarded for the accredited course unit.

The Certificate may also be awarded to a candidate who achieves an aggregate of 300 marks or higher, and who has failed no more than one examination, so long as the fail mark is not less than 45%. For the purpose of calculating a candidate's aggregate mark, the *notional* pass mark of 50% for the accredited course unit will be used.

A candidate who obtains a mark of 60% or higher in all of the examinations *taken* shall be awarded the Certificate with distinction. Where a candidate has obtained a mark of 60% or higher in all of the examinations taken, a *notional* mark of 60% will be automatically awarded for the accredited course unit.

Academic Misconduct

It is important to underline the fact that problems of academic misconduct are taken very seriously by the University of Manchester. The sanctions applied in cases of misconduct are likely to be severe, and include the possibility of expulsion from the University.

Conduct during Examinations

The rules governing behaviour during examinations are strict, and are strictly enforced, and it is well to be aware of these at the outset.

- 1. You are not permitted to bring to your examination desk coats, books, briefcases, or pencil cases.
- 2. You are not permitted to bring to your examination desk or to have on your person (for example, in your pocket) any notes whatever relating to the exam. If you are found in possession of such unauthorised material, your examination paper will be automatically cancelled and you will receive a mark of zero. That is, proof of intention actually to use the notes does not have to be established.
- 3. All personal possessions must be left in designated areas during exams (usually in the front or the back of the examination room).
- 4. You must on no account tear or remove pages from answer books; this is regarded as a serious offence under examination regulations.
- 5. You will not normally be allowed to leave an examination room (for example, to go to the toilet) before the first half hour of the exam has elapsed. No students arriving late for an exam are admitted to the examination room after the first half hour of the exam.
- 6. No smoking is allowed in examination rooms. No eating is allowed either.

Plagiarism

All work submitted by a student, whether assessed or non-assessed, must be the work of that student. The University of Manchester regards plagiarism as a serious academic offence, and has issued the following guidelines to help clarify for you what will be considered as constituting plagiarism and to indicate the nature of the penalties that may be imposed where plagiarism occurs. The University's Statement on Plagiarism is reproduced in full below, although some references may not directly apply to PG Certificate in Intellectual Property Law students.

University Statement on Plagiarism

- 1. Coursework, dissertations and essays submitted for assessment must be your own work, unless in the case of group projects a joint effort is expected and is indicated as such.
- Unacknowledged direct copying from the work of another person, or the close paraphrasing of somebody
 else's work, is called plagiarism and is a serious offence, equated with cheating in examinations. This
 applies to copying both from other students' work and from published sources such as books, reports or
 journal articles.
- 3. Use of quotations or data from the work of others is entirely acceptable, and is often very valuable provided that the source of the quotation or data is given. Failure to provide a source or put quotation marks around material that is taken from elsewhere gives the appearance that the comments are ostensibly your own. When quoting word-for-word from the work of another person quotation marks or indenting (setting the quotation in from the margin) must be used and the source of the quoted material must be acknowledged.

- 4. Paraphrasing, when the original statement is still identifiable and has no acknowledgement, is plagiarism. A close paraphrase of another person's work must have an acknowledgement to the source. It is not acceptable for you to put together unacknowledged passages from the same or from different sources linking these together with a few words or sentences of your own and changing a few words from the original text: this is regarded as over-dependence on other sources, which is a form of plagiarism.
- 5. Direct quotations from an earlier piece of your own work, if unattributed, suggests that your work is original, when in fact it is not. The direct copying of one's own writings qualifies as plagiarism if the fact that the work has been or is to be presented elsewhere is not acknowledged.
- 6. Sources of quotations used should be listed in a full bibliography at the end of your piece of work and in a style required by your department.
- 7. Plagiarism is a serious offence and will always result in imposition of a penalty. In deciding upon the penalty the University will take into account factors such as the year of study, the extent and proportion of the work that has been plagiarised and the apparent intent of the student. The penalties that can be imposed range from a minimum of a zero mark for the work (without allowing resubmission) through the down grading of degree class, the award of a lesser qualification (e.g. a pass degree rather than honours, a certificate rather than diploma) to disciplinary measures such as suspension or expulsion.

STUDENT SUPPORT AND GUIDANCE

Personal Tutors

All School of Law students are allocated to a personal tutor. The personal tutor for all students on the Certificate programme is the Programme Director.

University Support Services

Check the University services which are available for you if you wish to use them – the full list is published on the Web (http://www.man.ac.uk/services/student/). A summary is shown below.

Academic Advice and Information

The Central Academic Advisory Service is a confidential service of information and consultation for students who wish to discuss any matters which may be affecting their academic progress. The office is on the second floor of the Williamson Building and is open from 9.30am to 5.00pm (except 1.00pm - 2.00pm) on weekdays during the semesters. (Tel 275 3033)

Accommodation Office

Advice and information is offered by the Accommodation Office staff on all types of accommodation, both the University's own residences and private sector flats. The office is in the Precinct Centre and is open on weekdays from 9.00am to 5.00pm. (Tel 275 2888)

Students in University residences will be informed about the pastoral care system within their own residence.

Careers Service

The Careers Service operates from offices in Crawford House, Precinct Centre, weekdays 9.00am to 5.00pm. Advice and information on careers is available from the excellent information room and from the University's Careers Advisers. (Tel 275 2828).

Students wishing to pursue careers in the legal profession will find the School's own advisers are well informed and can provide specialist assistance in finding placements and opportunities to meet with law firms.

Counselling Service

Students may make appointments for individual counselling or join group sessions for particular topics such as management of examination stress. The Counselling Service is based in Crawford House and is open 9.00am to 5.00pm on weekdays. (Tel 275 2864)

Disabled Students

A student who has a disability is asked to inform the Personal Tutor, so that any appropriate arrangements can be put in place. Students suffering form any disability may also contact the Law School's Disability Co-ordinator Ms Hazel Carty (tel 275 3587). There is also a Disability Support Officer in the University Administration based in the John Owens building. (Tel 275 7512; email disability@man.ac.uk)

English Language Teaching Unit

All students for whom English is a second language should take advantage of courses run by the English Language Teaching Unit (tel 275 3426/3533). It is a fundamental requirement that all LLM students are fluent in the English language.

Harassment Advisors

The University of Manchester is committed to creating a working and studying environment free of harassment. All staff and students are entitled to protection from sexual, racial, or personal harassment; similarly, all staff and students are required to observe University policy prohibiting such conduct. The policy describes harassment as "uninvited and unwanted actions which cause offence and/or embarrassment, fear, stress or tension. It can be an isolated act such as a comment or wilful gesture, or it can take the form of repeated behaviour against a person."

If you want more information about the policy, you may contact one of the University's Harassment Advisers for informal advice and support. These Advisers are specially trained students and staff members who have volunteered to assist individuals facing harassment. They may be contacted directly (see the list of advisers on posters throughout the School), or you may be referred through the office of the Head of Student Administration (Tel 275 2071).

International Students' Welfare

International Society: William Kay House, 327 Oxford Road, Manchester M13 9PG

Telephone: +44 (0) 161 275 4959/7697 Fax: +44 (0) 161 275 7696 e-mail: Int.Soc@man.ac.uk Web: http://www.man.ac.uk/IntSoc/

The Society, founded in 1966, is a social, cultural and welfare centre for the many international students in the University. A comprehensive programme of social activities and visits is organised each semester. Overseas students are advised to obtain a copy of the programme on arrival and are welcome to consult the Society for help and advice. British and Overseas students and staff are all equally welcome. Activities are also organised for spouses and families of overseas students.

Director: Susan Fernley BA

International Students Welfare Officer

Ms Gerry Bell, International Public Relations Office, Ground Floor, Beyer Building

Telephone: 0161 275 2110/2972

Please contact the Welfare Officer to discuss any individual problems such as finance and visas. You will find the 'Welcome Guide for International Students' at

Web: http://www.man.ac.uk/services/welcome/

Legal Advice

The Law School runs a free Legal Advice Centre in the University Precinct Centre. The Legal Advice Centre gives supervised undergraduate Law students, working with local solicitors, an opportunity to work on real cases, but any student may also be a client and may seek advice from the Centre. To book an appointment, please ring 0161 275 7977, or call in the Centre's Office, 12-2pm, Monday to Friday.

Medical Advice

All students must register with a GP in Manchester, but in addition an emergency and occupational health service operates from Crawford House on weekdays. (Tel 275 2864)

Nursery and Playscheme-information for students with children

The Dryden Street Nursery, established by the University in partnership with the Manchester Metropolitan University, has 25 subsidised places available for the children of students from this University. It is a purpose-built nursery with excellent facilities, but the waiting list is long and students should not rely on places being available. All enquiries should be addressed to the Manager.

Contact details: The Manager, Dryden Street Day Nursery, Dryden Street, Manchester M13 9AU Telephone: 0161 272 7121

Playscheme

The Students' Union runs a play scheme for children aged 5-11 during each school half term break and in the Easter holidays. The scheme, based in the Union Building, is supervised by trained play workers and costs around £3 per day. You can register your child in the Student Advice Centre on the first floor of the Students' Union Building, next to the Serpent Bar.

Postgraduate and Mature Students Society

Burlington Rooms, Burlington Street, Manchester M13 9PL

Tel: 0161-275 2392 e-mail: pgs@fs4.ph.man.ac.uk Website: http://burlington.man.ac.uk

The Society aims to provide not only a social focus for post-graduate and mature students studying at both the University of Manchester and UMIST, but also to offer information, advice and support, particularly to those students new to Manchester. Social events take place fortnightly on Thursdays and range from barge trips and curries to Mexican evenings and comedy nights! Associate membership is available to staff and to students of other institutions.

The Society has seats on several University and Union committees, including the Senate, giving members a direct voice in University affairs and the opportunity to promote the best interests of post-graduate and mature students within the University.

We have our own building - the Burlington Rooms, in the Schunck building next to John Rylands library - where you will find the Burlington Bar and the Society office on the ground floor, the post-graduate and mature student common room - the Schunck Room, upstairs and, a vegetarian restaurant - Herbivores, in the basement.

Students Union

The Student Union runs its own Advice Centre, offering a wide range of services, including up-to-date advice on state benefits. A part-time Legal Adviser may be consulted through an appointments system. (Tel 275 2946/2947)

Nightline, an all-night telephone advice and listening service offers a point of contact outside office hours. (Tel 275 2983/2984)

University Policies

University Policies on everything from Appeals against Decisions of Examiners Boards through Complaints Procedures and Equal Opportunities Policy to Work and Attendance regulations are set out on the University Policies web pages at http://www.man.ac.uk/policies/

Web-based sources of help – University of Manchester Student Intranet

The University of Manchester student intranet (http://www.intranet.man.ac.uk/student/) gives a wealth of information about all the matters which students need to know. EG Where to get a replacement swipe card; Access funds; how to get a transcript of your results.

APPENDIX: DETAILS OF COURSE UNITS

LW6201: INTRODUCTION TO THE GENERAL LEGAL FRAMEWORK OF INTELLECTUAL PROPERTY.

Credits:

10

Optional/Compulsory:

Compulsory

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course UnitCo-ordinator):

D. L. Booton

Teaching Staff:

Marie Fox Hazel Carty Angus MacCulloch Dora Kostalopolou David Milman Richard Moose (Barrister) David Booton

Teaching Methods:

Lectures and feedback on written assignment(s).

Assessment:

An unseen written examination, of three hours duration, comprises the total assessment

Aims and Learning Outcomes:

The course aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of law and to provide a foundation of knowledge and understanding of the English legal system;
- 2. to provide sufficient knowledge, skills and understanding of certain select areas of contract law, tort law and European law sufficient for students to understand and practice in the area of intellectual property law;
- 3. to provide students with sufficient general knowledge, skills and understanding of the English legal system such that they may progress to an understanding of the specific area of intellectual property law; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based course in general English law which provides exemption from the equivalent foundation-level professional examination.

By the end of the course, students will:

have acquired and developed a foundation knowledge and understanding of the English legal system;

have acquired and developed a foundation knowledge and understanding of certain aspects of the substantive law relating to contracts, tort, European law, and company law;

be able to identify the relevant legal issues arising in respect of a novel set of facts or circumstances;

be able to identify how the law applies to a particular novel set of facts or circumstances;

be able to appreciate the practical significance of new legislation and case law;

be able to structure and present complex legal arguments relating to practical problems in contract, tort and European law;

be able to undertake basic legal research using both paper and electronic sources;

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

Outline Syllabus:

An introduction to English legal method and legal system comprising: general knowledge of the English legal system; the sources of law, the rules on statutory interpretation; the structure of the courts and the appellate system; and the doctrine of precedent.

An introduction to contract law, comprising: the elements necessary for formation of a valid contract and in particular the notions of offer, acceptance and consideration; and remedies for breach of contract.

An introduction to certain aspects of Tort Law, comprising: an overview of tort principles; the tort of negligence; and the economic torts (including inducing breach; trade libel; passing off).

An introduction to certain aspects of European Community Law, comprising: the relationship between Directives, Regulations and Notices; the institutional structure of the European Union with particular reference to law-making powers; and an introduction to European Competition law.

An introduction to certain aspects of Company Law, comprising: the relevant law of companies; the nature of a limited liability company; the procedure for company formation and the right to object to new company names; the principal differences between limited companies and unincorporated businesses; and the transfer of property or assets.

LW6211: THE LAW OF COPYRIGHT AND DESIGNS

Credits:

10

Optional/Compulsory:

Compulsory

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course Unit co-ordinator):

D. L. Booton

Teaching Staff:

See outline syllabus below.

Teaching Methods:

Lectures only

Assessment:

An unseen written examination of three hours duration comprises the total assessment

Aims and Learning Outcomes:

The course aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of the law of copyright and designs and to provide a foundation of knowledge and understanding of copyright and designs law;
- 2. to provide sufficient knowledge, skills and understanding such that they may practice in the area of copyright and designs law;
- 3. to provide students with sufficient knowledge, skills and understanding such that they may progress to the more advanced stages of training in copyright and designs law; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based course on copyright and designs law which provides exemption from the equivalent foundation-level professional examination.

Learning Outcomes

By the end of the course, students will:

have acquired and developed a foundation knowledge and understanding of the copyright law and the e law relating to industrial designs;

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting rights in industrial designs and copyright works within the United Kingdom;

be able to identify the relevant copyright or design right issues arising in respect of a novel set of facts or circumstances;

be able to identify how the law applies to a particular novel set of facts or circumstances;

be able to appreciate the practical significance of new legislation and case law in the application of copyright and designs law;

be able to structure and present complex legal arguments relating to practical problems in copyright and designs law;

be able to advise on securing and protecting a rights in copyright works and industrial designs;

be able to approach application and infringement proceedings relating to Registered Designs, copyright and design right with confidence;

be able to undertake basic legal research using both paper and electronic sources;

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

Outline Syllabus:

Lecture Code	Title	Lecturer
C+D1 - C+D5	What is Copyright, In What Does Copyright Exist?	D. Booton
	Authorship	
	Duration	
	Rights of The Copyright Owner	
	Infringement	
	Exceptions to Infringement	
	Assignment and Licensing	
	Moral Rights.	
C+D6	Copyright in Designs (ss. 51 and 52 CDPA 1988)	D. Booton
C+D7	Design Right (s. 213 CDPA) – Subsistence and Infringement	D. Booton
C+D8 - 9	Registered Designs – registrability of designs	D. Booton
C+D10	Registered Designs – infringement	D. Booton
C+D11	Community Designs	D. Booton
C+D12	Copyright in Practice	K. Hodkinson
C+D13	Design Right in Practice	K. Hodkinson
C+D14	Registered Designs in Practice	K. Hodkinson

LW6221: UK PATENT LAW AND PRACTICE

Credits:

10

Optional/Compulsory:

Compulsory

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course Unit co-ordinator):

D. L. Booton

Teaching Staff:

See outline syllabus below

Teaching Methods:

Lectures only

Assessment:

An unseen written examination, of three hours duration, comprises the total assessment

Aims and Learning Outcomes:

The course aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of UK patent law and to provide a foundation of knowledge and understanding of UK patent law;
- 2. to provide sufficient knowledge, skills and understanding such that they may begin practice in the area of UK patent law;
- 3. to provide students with sufficient knowledge, skills and understanding such that they may progress to the more advanced stages of training in UK patent law; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based course in UK patent law and practice which provides exemption from the equivalent foundation-level professional examination.

Learning Outcomes

By the end of the programme, students will:

have acquired and developed a foundation knowledge and understanding of UK patent law;

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting patents within the United Kingdom;

be able to identify the relevant patent law issues arising in respect of a novel set of facts or circumstances;

be able to identify how the law applies to a particular novel set of facts or circumstances;

be able to appreciate the practical significance of new legislation, case law and international treaties in the application of UK patent law;

be able to structure and present complex legal arguments relating to practical problems in patent law;

be able to advise on securing and protecting rights arising under UK patent law;

be able to approach application, opposition and infringement proceedings relating to patents with confidence;

be able to undertake basic legal research using both paper and electronic sources;

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

Outline Syllabus:

Lecture Code	Title	Lecturer
PAT1	Introduction to Patents	D. Booton
PAT2	Novelty	D. Booton
PAT3	Inventive Step	D. Booton
PAT4	Industrial Applicability	D. Booton
PAT5	Biotechnological Inventions	A. Giles
PAT6	Computer-implemented Inventions	D. Booton
PAT7	Substantive application – specification, abstract. Priority	D. Booton
PAT8	Priority	Chris Revell
PAT9	Filing Procedures And Official Actions	J. Linn
PAT10	Infringement; Transactions and ownership	D. Booton
PAT11	Patent Grant, Amendment and Renewal	T. Halliwell
PAT12	Patent Infringement and Revocation	Gillian Dickson
PAT13	Mention/determination of inventor. Employee inventions	D. Booton
PAT14	Exploitation in UK, EU and International context	D. Booton
PAT15	Licences of Right and Compulsory Licenses.	P. Haward (Patent Office)
PAT16	Patent Exploitation	Richard Hill
PAT17 (see also TM18)	Intellectual Property Actions.	P. Colley
PAT18	Patents Recent Case Law	N. Cunningham

LW6231: PATENT DRAFTING SKILLS

Credits:

10

Optional/Compulsory:

Optional (alternative option is LW6261 Patent Examining Skills)

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course Unit co-ordinator):

D. L. Booton

Teaching Staff:

Peter Kolker Peter Low Peter Mole Mike Ajello

Teaching Methods:

Lectures and Tutorials

Assessment:

An unseen written examination, of three hours 15 minutes duration, comprises the total assessment

Aims and Objectives:

The course unit aims:

To introduce students to the fundamental skills necessary for drafting patent specifications.

Through the delivery of small-group progressive learning exercises focussing on simple mechanical devices, the course unit objectives are to give an students an introduction to the fundamentals of drafting patent specifications with the intention that by the end of the course, students should:

be able to draft a description of a simple mechanical invention; be able to identify the inventive concept underlying such an invention; and be able to draft a claim or claims defining the embodied invention.

Outline Syllabus:

This is an entirely skills-based course and, as such, has no syllabus. The course takes the form of a progressive series of learning exercises which are intended to develop the students drafting skills. Students are expected to know and understand the provisions of the Patents Act 1977 that are relevant to the drafting of patent specifications and in this sense, this course compliments LW6221: UK Patent Law and Practice.

LW6241: UK TRADE MARK LAW AND PRACTICE

Credits:

10

Optional/Compulsory:

Compulsory

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course Unit co-ordinator):

D. L. Booton

Teaching Staff:

See outline syllabus below

Teaching Methods:

Lectures only

Assessment:

An unseen written examination, of three hours duration, comprises the total assessment

Aims and Learning Outcomes:

The course aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of UK trade mark law and to provide a foundation of knowledge and understanding of UK trade mark law;
- 2. to provide sufficient knowledge, skills and understanding such that they may practice in the area of UK trade mark law;
- 3. to provide students with sufficient knowledge, skills and understanding such that they may progress to the more advanced stages of training in UK trade mark law; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based course in UK trade mark law and practice which provides exemption from the equivalent foundation-level professional examination.

Learning Outcomes

By the end of the course, students will:

have acquired and developed a foundation knowledge and understanding of UK trade mark law;

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting rights in trade marks within the United Kingdom;

be able to identify the relevant trade mark law issues arising in respect of a novel set of facts or circumstances;

be able to identify how trade mark law applies to a particular novel set of facts or circumstances;

be able to appreciate the practical significance of new legislation, case law and international treaties in the application of UK trade mark law;

be able to structure and present complex legal arguments relating to practical problems in trade mark law;

be able to advise on securing and protecting rights in trade marks;

be able to approach application, opposition and infringement proceedings relating to trade marks with confidence;

be able to undertake basic legal research using both paper and electronic sources;

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

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Outline Syllabus:

Lecture Code	Title	Lecturer
TM1 - TM2	What Is A Trade Mark - Registrable And Unregistrable Marks	A. Griffiths
TM3	Application procedure; Surrender and Revocation	A. Griffiths
TM4	Choosing A Trade Mark And Searching	P. Cooper
TM5	Trade Mark Application Procedure A Practioner Perspective	R. Grimshaw
TM6	Collective marks; Certification marks and Protection of well-known marks	A. Griffiths
TM7	Trade Mark Application Procedures A Trade Mark Registry Perspective	G. Hicks
TM8	Trade Mark Opposition Procedures A Trade Mark Registry Perspective	S. Long
TM9	A Practioners View Of The Trade Marks Registry- Applications and Oppositions	J. M. Maddox
TM10	Enforcement and Infringement	A. Griffiths
TM11	Enforcement And Infringement	A. J. Clay
TM12	Trade Marks as Property - Assignment And Licensing	A. Griffiths
TM13	Trade Marks as Property - Assignment And Licensing	M. Shaw
TM14	Passing Off	H.Carty
TM15	Passing Off	L. Wrenn
TM16 (see also PAT19)	Intellectual Property Actions.	P. Colley
TM17	Trade Marks Recent Case Law	A. Griffithts

LW6251: OVERSEAS INTELLECTUAL PROPERTY LAW

Credits:

10

Optional/Compulsory:

Compulsory

Availability:

Only available to students registered on the Postgraduate Certificate in Intellectual Property Law programme.

Staff Responsible (Course Unit co-ordinator):

D. L. Booton

Teaching Staff:

See outline syllabus below

Teaching Methods:

Lectures only

Assessment:

An unseen written examination, of three hours duration, comprises the total assessment

Aims and Learning Outcomes:

The course aims:

- 1. to introduce and develop general and specific skills appropriate to the practice of certain aspects of overseas and international intellectual property law and to provide a foundation of knowledge and understanding of the international aspects of intellectual property law;
- 2. to provide students with sufficient knowledge, skills and understanding such that they may progress to the more advanced stages of training in overseas and international intellectual property law; and
- 4. to make available to entrants to the patent agent and trade mark attorney professions a university-based course in overseas intellectual property law which provides exemption from the equivalent foundation-level professional examination.

Learning Outcomes

By the end of the programme, students will:

have acquired and developed a foundation knowledge and understanding of the international legal relations concerned with the protection of intellectual property;

have acquired and developed a foundation knowledge and understanding of the procedures and practices involved in securing and protecting intellectual property under various international conventions;

have acquired and developed a foundation knowledge and understanding of certain aspects of substantive overseas and international intellectual property law;

have acquired and developed a foundation knowledge and understanding of the laws and procedures concerned with securing and protecting intellectual property rights in certain foreign jurisdictions;

have acquired and developed a foundation knowledge and understanding of the relations between the European Union competition rules and the exercise of national intellectual property rights;

be able to identify the relevant legal issues arising in respect of a novel set of facts or circumstances;

be able to appreciate the practical significance of new legislation, case law and international treaties in the application of intellectual property law;

be able to structure and present complex legal arguments relating to practical problems in intellectual property law;

be able to advise on securing and protecting a range of intellectual property rights;

be able to undertake basic legal research using both paper and electronic sources;

have developed their written and verbal communications skills;

be able to manage time and work to deadlines;

be able to find information and use information technology; and

have developed their abilities in problem solving and in logical thinking.

Outline Syllabus:

Lecture Code	Title	Lecturer
OSIP1	Introduction to the principles of International Law	D. Booton
OSIP2	Introduction to the Main International Intellectual Property Conventions	D. Booton
OSIP3	The EC Rules on Free Movement of Goods and Intellectual Property	D. Booton
OSIP4	The EC Competition Rules and Intellectual Property	D. Booton
OSIP5	The European Patent Office	K. Bill
OSIP6	Overseas Patent Law I	P. Mole
OSIP7	Overseas Patent Law II	P. Mole
OSIP8	The Patent Cooperation Treaty	C. Jones
OSIP9	Introduction to International and Foreign Trade Mark Law	A. Griffiths
OSIP10	International and Foreign Trade Mark Law Part 1	Julius Stobbs
OSIP11	International and Foreign Trade Mark Law Part 2	Julius Stobbs

DIPLOMA IN INTELLECTUAL PROPERTY LITIGATION

The Patent Litigators Association has been instrumental in a course being set up at Birkbeck College, University of London, leading to the grant of a diploma in intellectual property litigation.

The course is essentially practical and principally designed to assist UK Registered Patent Agents, and particularly members of the Patent Litigators Association, to conduct litigation personally before the Patents County Court.

The course will commence at Birkbeck College, Malet Street, London on 6th March 1995 and consists of twenty 3 hour sessions on Mondays and Fridays (excluding bank holidays) between 6.00 p.m. and 9.00 p.m. in the periods:

6th March 1995 to 7th April 1995 24th April 1995 to 2nd June 1995

An assessment, leading to the award of the diploma, will take place towards the end of June 1995.

The normal course fee is £2,750 plus VAT but is discounted to £2,500 plus VAT for PLA members.

Those who wish to enrol for the course should initially contact me in writing at the following address:

Alan Burrington
Secretary, Patent Litigators Association
c/o Beresford & Co.
2-5 Warwick Court
High Holborn
London WC1R 5DJ

The closing date for formal enrolment with Birkbeck College is expected to be early February 1995 but in view of the limited numbers that can be accommodated on the course it is recommended that early application be made.

December CIPA 1994

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NOTTINGHAM COURSE

Tab 17. LLM IN ADVANCED LITIGATION

DIPLOMA IN INTELLECTUAL PROPERTY LITIGATION BIRKBECK COLLEGE - UNIVERSITY OF LONDON COURSE STARTS 6 MARCH 1995

This course (to be held annually) is being arranged by the Faculty of Law of Birkbeck College and the Patent Litigators Association, with the assistance of members of the Patent Bar, to provide a formal qualification awarded by a leading academic institution.

Enrolment

Those wishing to enrol should please complete the accompanying form and return it to Alan Burrington at the address given by February 15, 1995.

Object

Those successfully completing this course will be equipped with the detailed knowledge necessary to conduct litigation competently. The Diploma will reflect this.

The course, which is particularly intended for Chartered Patent Agents, is suitable both for senior and younger members of the profession.

Content

The course will be practical and detailed. Those completing it will know what they can do, how to do it and how to support their position on the legal, factual and procedural issues in their case. The syllabus includes:

- General Law as relevant to IP litigation powers of courts etc Supreme Court Act
 County Court Act Legal Services Act
- Powers and jurisdictions of Patents Court and Patents County Court 1988 Act rights of patentee other IP rights as enforceable in these Courts
- Starting and running action particularly in Patents County Court including pleadings - directions - notices to admit - preliminary consideration - discovery etc
- Constructing a case argument construction determination and establishment of factual and legal propositions
- Rules of evidence evidence drafting
- Preparations for trial the trial
- Ancillary matters such as security for costs ex parte applications amendment of pleadings - amendment of patent - appeals etc.

Tutors

The part of the course dealing specifically with patent litigation will be taught mainly by members of the Patent Bar. The part of the course dealing with general law will be taught by the academic staff of Birkbeck College.

Administrative Details

The course will be held at Birkbeck College, Malet Street, London WC1E 7HX. It will consist of twenty 3 hour sessions on Mondays and Fridays between 6.00 and 9.00 pm in the periods 6 March 1995 to 7 April 1995 and 24 April 1995 to 2 June 1995. The normal course fee is £2750 plus VAT but is discounted to £2500 plus VAT for PLA members.

To: Alan Burrington Secretary Patent Litigators Association c/o Beresford & Co 2-5 Warwick Court High Holborn London WC1R 5DJ

I wish to enrol for the course leading to a Diploma in Intellectual Property Litigation beginning on 6 March 1995 at Birkbeck College, University of London.

I am/am not a Member of the Patent Litigators Association (delete as appropriate)

Name	:	
Address	:	
Telephone	:	
Facsimile	:	
		invoice for the course fee to be addressed as follows:
J		and the course lee to be addressed as follows:
Name	:	
Address	: ,	
	:	

CONDUCTING PATENT LITIGATION

GENERAL INTRODUCTION

Session 1 (6 March 1995)

1. Introduction to the English Legal system. The functions of Parliament. The functions of the courts. Statutory construction. Principles of legal authority. Legal sources. Pepper -v- Hart.

Session 2 (10 March 1995)

- 2. The Patents County Court: Jurisdiction (geographical and subject matter). Representation; what is possible and what is interests of client, change of representation, location. Choice of forum.
- 3. Overview of an action from beginning to end.

THE EARLY STAGES IN AN ACTION

Session 3 (13 March 1995)

- 4. Commencing the action: Summons. How to issue. Service on defendants.
 - a. How effected
 - b. Out of jurisdiction how done
 - i. Brussels convention countries
 - ii. Non-Brussels convention countries
 - c. Substituted service
 - d. Inviting acceptance of service
- 5. Acknowledgement of service. Setting service aside.

Session 4 (17 March 1995)

- 6. Pleadings:
 - a. Statement of Case
 - i. Time for
 - ii. Purpose of
 - iii. Requirements of
 - iv. Relief to be sought
 - b. Defence and Counterclaim
 - i. Time for, effect of failing to serve
 - ii. Purpose of
 - iii. Requirements of
 - iv. Relief to be sought
 - c. Reply and Defence to Counterclaim
 - i. Time for, effect of failing to serve

- ii. Purpose of
- iii. Requirements of
- d. Close of Pleadings.
- e. Amendment of Pleadings
 - i. When possible
 - ii. Effect of
 - iii. Whether leave needed
 - iv. Terms upon which leave granted, <u>See -v- Scott Paine Orders</u>
- f. Requests for further and better particulars of Pleadings.
- g. Third party proceedings

Sessions 5 and 6 (20 and 24 March 1995)

- 7. Summary judgement, Striking out Claim/Defence/Counterclaim
- 8. Judgements by consent. Tomlin Orders.
- 9. Interlocutory Relief:
 - a. General Principles American Cyanamid
 - B. Cross-undertakings in damages what are they and how are they given
 - c. Difference between inter partes and ex parte relief.
 - d. The importance of speed
 - e. Interlocutory injunctions
 - f. Anton Piller Orders
 - g. Mareva Orders
- 10. Security for costs:
 - a. How applied for
 - b. When applied for
 - c. Repeated applications for
 - d. Against whom can they be sought
 - e. How security can be given
- 11. Payment in to court and Calderbank letters.

STEPS LEADING TO THE TRIAL

Session 7, 8 and 9 (27, 31 March and 3 April 1995)

- 12. Preliminary consideration
- 13. Discovery:
 - a. How obtained
 - b. How limited
 - i. By subject matter
 - ii. By date

- iii. Who may see confidentiality orders
- C. Limitations on use of Alterskye
- d. Privilege
 - i. Legal
- e. Difference between lists and inspection
- f. Deemed authenticity of documents disclosed unless challenged.
- 14. Inspection of processes of equipment
 - a. How obtained
 - b. Who may see confidentiality
- 15. Seeking discovery or inspection <u>before</u> commencement of the proceedings.
- 16. Experiments
 - a. When to seek
 - b. Function
 - c. How conducted
- 17. Notices to Admit, effect of refusal to admit.
- 18. Interrogatories.
- 19. Subpoenas

Session 10 (7 April 1995)

- 20. Basic rules of evidence
 - a. Hearsay
 - b. Res Gestae
 - c. Issue estoppels
 - d. Similar fact evidence
 - e. Credit

Session 11 (24 April 1995)

- 21. Witness Statements
 - a. Purpose
 - b. How to put together
 - c. Time for
- 22. Expert Reports
 - a. Purpose
 - b. How to put together
 - c. Time for
 - d. <u>Ikarian Reefer</u>
- 23. Exchange of Witness Statements and Expert Reports.

24. Civil Evidence Act Notices.

THE TRIAL

Sessions 12 (28 April 1995)

- 25. Order of speeches and evidence.
- 26. Skeleton arguments.
- 27. Opening speech, Speech for Defendant, Closing speech.
 - a. Function of each
 - b. How to construct
 - i. Factual argument visual aids
 - ii. Legal argument authorities

Session 13 (1 May 1995)

- 28. Examination in chief
 - a. Function of
 - b. What questions permissible difference between leading and non-leading questions
 - c. Declaring witness hostile
- 29. Cross-examination
 - a. Function of
 - b. What questions permissible
 - c. What questions mandatory
- 30. Re-examination
 - a. Function of
 - b. What questions permissible
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THE JUDGEMENT

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 - a. Complete or partial invalidity
 - b. Revocation
 - c. Injunction
 - d. Delivery up
 - e. Destruction on oath
 - f. Damages
 - g. Account of profits
 - h. Certificate of contested validity
 - i. Declarations of non-infringement and generally
 - j. costs
 - i. <u>Elgindata</u>

ii. Wasted costs

- Enforcement of orders. The Brussels Convention. 33.
- 34. Contempt.

APPEALS

Session 16 (15 May 1995)

- 35. From interlocutory orders
 - a. Leave - how obtained
 - b. Time limits for
 - Suspending interlocutory orders pending c.
- 36. From final orders
 - a. Is leave needed?
 - b. Time limits for
 - c.
 - Suspending injunctions etc pending Suspending inquiry as to damages pending d.

Session 17 (19 May 1995)

37. Amendment of patent

Session 18 (22 May 1995)

38. Mock Trial

Session 19 (26 May 1995)

39. Spare session

Session 20 (2 June 1995)

40. Spare session

SESSION 1 GENERAL INTRODUCTION

SESSION 1. INTRODUCTION TO SOME BASIC LEGAL CONCEPTS

The purpose of this session is merely introductory. It will facilitate the study of other areas of this course if you are, at some level, familiar with the basic, and more commonly used methods, employed by lawyers in everyday practice. A brief description of the English common law system will be given, with reference to the sovereignty and legislative supremacy of parliament. it will also be useful to provide a summary of the types of materials which lawyers use to find and determine the law. In addition we will go through some of the fundamental library skills needed to find out the relevant law in a particular area. Finally a case report will be provided for analysis. By reading this case we will be able to elucidate some of the cardinal doctrines required for the study of any area of law. This session will thus be divided into three sections as follows:

Section One

The relationship between parliament and the courts
The differences between Statute and common law
The legislative function of Parliament
European Community law
The functions of the courts
The structure of the court system
other courts, tribunals and alternative dispute resolution.

Section Two

Sources of Law:
Statute
Common law cases
Library source books:
The Law reports (finding a case)
Halsbury's and other legal encyclopaedias
Journals

Section Three

Reading a case - exercise
The doctrine of precedent
The rules of Statutory Interpretation.

Background reading/Useful references:

The following books are fairly comprehensive guides to The English Legal System, and provide commentaries on the methods and languages used by lawyers. The Osbornes dictionary is a cheap and profitable investment.

'Learning Legal Rules' Holland & Webb (Blackstone 2nd Ed)

'Introduction to Legal Methods' Farrar & Dugdale (Sweet & Maxwell)

'Osbornes Dictionary of Law.

All England Law Reports

Mandla v Dr in Lee

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Mandla and another v Dowell Lee and another

LORD FRASER OF TULLYBELTON, LORD FUNUND-DAVIES, LORD ROSKILL, LORD BRANDON OF

28 FEBRUARY, 1, 2, 24 MARCH 1983 OAKBROOK AND LORD TEMPLEMAN

Ç and cut his hair -- Headmaster desiring to minimise religious distinctions in school which wearing of turbans would accentuate -- Whether unlawful discrimination -- Whether Sikhs a 'racial group' origins – Ethnic – Headmaster refusing to admit Sikh boy to school unless he removed his turban Whether Sikhs a group defined by reference to 'ethnic or national origins' - Whether defined by reference to colour, race, nationality or ethnic or national origins – Ethnic or national Race relations – Discrimination – Discrimination against racial group – Sikhs – Racial group liserimination justifiable - Race Relations Act 1976, ss 1(1)(b), 3(1).

Race Relations Act 1976 against a member of a 'racial group' as defined in s 3(1)^t of that 🏮 century in the Punjab area of India, and that the Sikhs were no longer a purely religious 🗜 removed the turban and cut his hair. The headmaster's reasons for his refusal were that The headmaster of a private school refused to admit as a pupil to the school a boy who was an orthodox Sikh, and who therefore wore long hair under a turban, unless he the wearing of a turban, being a manifestation of the boy's ethnic origins, would based on the Christian faith, the headmaster desired to minimise. The boy, suing by his Act. The boy contended that the headmaster's noturban rule amounted to discrimination within $s_{-1}(1)(\theta(i)$ and (ii) because the boy was not a member of a 'racial group , , , who origins. The boy appealed, contending that the term 'ethnic' embraced more than accentuate religious and social distinctions in the school which, being a multiracial school father, sought a declaration in the county court that the refusal to admit him unless he removed his turban and cut his hair was unlawful discrimination under s 1(1)(b) of the can comply with the rule and the headmaster could not show the rule to be justifiable irrespective of [the boys] ethnic . . . origins. The evidence before the court was that the group but were a separate community with distinctive customs such as the wearing of of the 1076 Act only if the group could be distinguished from other groups by definable Sikhs were originally a religious community founded at about the end of the fifteenth long hair and a turban although racially they were indistinguishable from other Punjabis, with whom they shared a common language. The judge dismissed the boy's claim on the ground that Sikhs were not a racial group' within the definition of that term in s 3(1) of the 1976. Act since Sikhs could not be defined by reference to . . . ethnic or national merely a racial concept and meant a cultural, linguistic or religious community. It was common ground that Sikhism was primarily a religion, that the adherents of a religion were not as such a racial group within the 1976 Act and that discrimination in regard to religious practices was not unlawful. The Court of Appeal dismissed the boy's appeal on racial characteristics with which members of the group were born and that Sikhs had no the grounds that a group could be defined by reference to its ethnic origins within s 3(t) such characteristics peculiar to Sikhs. The boy appealed to the House of Lords.

Held . The appeal would be allowed for the following reasons-

broad cultural and historic sense. For a group to constitute an 'ethnic group' for the community by virtue of certain characteristics, two of which were essential. First it had (1) The term 'ethnic' in 8.3 of the 1976 Act was to be construed relatively widely in a purposes of the 1976. Act it had to regard itself, and be regarded by others, as a distinct

Sortion, 80% so far as material, is set out at priving gypost Section 1(1) is second at paroes a ly post

could also be relevant, namely (a) either a common geographical origin or descent from community surrounding it, and (e) the characteristic of being a minority or being an the Sikhs were a group defined by reference to 'ethnic origins' for the purpose of the the Punjab (see p. 1066 b.c and g to p. 1067 g, p. 1068 f, p. 1069 a to e, p. 1071 b to e and p. 1072 d to f, post); King Ansell v Police [1970] 2 NZLR 531 adopted. necessarily associated with religious observance. In addition, the following characteristics have to be peculiar to the group, (c) a common literature peculiar to the group, (d) a common religion different from that of neighbouring groups or from the general 1976 Act even though they were not racially distinguishable from other people living in tradition of its own, including family and social customs and manners, often but not a small number of common ancestors, (b) a common language, which did not necessarily oppressed or a dominant group within a larger community. Applying those characteristics, to have a long shared history, of which the group was conscious as distinguishing it from other groups, and the memory of which it kept alive, and second it had to have a cultural

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(2) The words can comply in s 1(1)(b)(i) of the 1976 Act were not to be read literally. construed as meaning can in practice or can, consistently with the cultural conditions of the racial group' to which the person belonged. The 'no turban' rule was not a requirement with which the applicant boy could, consistently with the customs of being ie as meaning 'can physically' so as to indicate a theoretical possibility, but were to be d a Sikh, comply and therefore the application of that rule to him by the headmaster was unlawful discrimination (see p. 1069 f to h. p. 1071 b 10 c and p. 1072 h j, post); Price v Civil Service Commission [1978] 1 All ER 1228 applied.

(3) The 'no turban' rule was not 'justifiable' within the meaning of s(1)(b)(ii) of the 1976 Act merely because the headmaster had a genuine belief that the school would provide a better system of education if it were allowed to discriminate against those who wore turbans (see p. 1069 h j, p. 1070 a to d and f, p. 1071 b to e and p. 1072 h j, post). Decision of the Court of Appeal [1982] 3 All ER 1108 reversed.

For the general meaning of unlawful discrimination on ground of ethnic or national For the Race Relations Act 1976, 88 1, 3, see 46 Halsbury's Statutes (3rd edn) 305, 307. origins, see 4 Halsbury's Laws (4th edn) para 1035.

Cases referred to in opinions

Ealing London Beveugh v Race Relations Board [1972] 1 All ER 105, [1972] AC 342, [1972] 2 WLR 71, HL, 2 Digest (Reissue) 316, 1783.

9 King-Ansell v Police [1979] 2 NZLR 531, NZ CA. Panesar v Nestlé Co Ltd [1980] ICR 144, CA.

Price v Civil Service Commission [1978] 1 All ER (228, [1977] 1 WLR (417, EAT, Digest (Cont Vol E) 407, 72.4b.

The plaintiffs, Sewa Singh Mandla and his son, Gurinder Singh Mandla, an infant suing Committee of the House of Lords granted on 18 November 1982 against the decision of 1983] QB 1) on 29 July 1982 dismissing their appeal against the judgment of his Honour ludge Gosling sitting in the Birmingham County Court on 10 December 1980 whereby he dismissed the plaintiffs' claim against the defendants, Mr A G Dowell Lee and Park Birmingham, for, inter alia, a declaration that the defendants had committed an act of unlawful discrimination against the plaintiffs within the Race Relations Act 1976 by refusing to admit the second plaintiff to the school as a pupil unless he removed his by his father and next friend, who were both Sikhs, appealed by leave of the Appeal the Court of Appeal (Lord Denning MR, Oliver and Kerr L.J.) ([1982] 3.All ER 1108, Grove Private School Ltd, the headmaster and owner respectively of Park Grove School,

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Mandia v Dowe : e (Lord Fraser)

turban and cut his hair to conform with the school rules. The facts are set out in the opinion of Lord Fraser.

Alexander tryine QC and Harjit Singh for the appellants.

The second respondent was not represented. The first respondent appeared in person.

Their Lordships took time for consideration.

24 March. The following opinions were delivered.

ပ is whether Sikhs are a racial group' for the purposes of the Race Relations Act 1976, For LORD FRASER OF TULLYBELTON. My Lords, the main question in this appeal reasons that will appear, the answer to this question depends on whether they are a group defined by reference to 'ethnic origins',

of the rules which he had to observe was to wear a turhan. That is because the turban is $\ensuremath{ heta}$ independent school in Birmingham called Park Grove School. The second respondent is The appellants (plaintiffs) are Sikhs. The first appellant is a solicitor in Birmingham and he is the father of the second appellant. The second appellant was, at the material date, a boy of school age. The first respondent (first defendant) is the headmaster of an a company which owns the school, and in which the first respondent and his wife are accept the boy if he insisted on wearing a turban. The second appellant was then sent to principal shareholders. In what follows I shall refer to the first respondent as the respondent. In July 1978 the first appellant wished to enter his son as a pupil at Park Grove School, and he brought the boy to an interview with the respondent. The first appellant explained that he wished his son to grow up as an orthodox Sikh, and that one regarded by Sikhs as a sign of their communal identity. At the interview, the respondent said that wearing a turban would be against the school rules which required all pupils to the matter over. A few days later he wrote to the first appellant saying that he had another school, where he was allowed to wear a turban, and, so far as the appellants as wear school uniform, and he did not think he could allow it, but he promised to think decided he could not relax the school rules and thus, in effect, saying that he would not individuals are concerned, that is the end of the story.

clearly raises an important question of construction of the 1976 Act, on which the But the first appellant complained to the Commission for Racial Equality that the respondent had discriminated against him and his son on racial grounds. The commission took up the case and they are the real appellants before your Lordships House. The case commission wishes to have a decision, and they have undertaken, very properly, to pay the costs of the respondent in this House, whichever party succeeds in the appeal. In the county court Judge Gosling held that Sikhs were not a racial group, and therefore that there had been no discrimination contrary to the 1976 Act. The Court of Appeal (Lord Denning MR, Oliver and Kerr LJD ([1982] 3 All ER 1108, [1983] QB 1) agreed with that

including employment, provision of goods, services and other things, and by s 17 in the racial grounds, and more generally, to make provision with respect to relations between The main purpose of the 1976 Act is to prohibit discrimination against people on people of different racial groups. So much appears from the long title. The scheme of the discrimination and then in later parts to prohibit such discrimination in various fields field of education. There can be no doubt that, if there has been racial discrimination discriminate against a person in the terms on which the school offers to admir him as a Act, so far as is relevant to this appeal, is to define in Part I what is meant by racial against the appellants in the present case, it was in the field of education, and was contrary to sitted which makes it unlawful for the proprietor of an independent school to view. The commission, using the name of the appellants, now appeals to this House. pupil. The only question is whether any racial discrimination has occurred.

Racial discrimination is defined in s 1(1), which provides as follows:

other a requirement or condution which he applies or would apply equally to persons less favourably than he treats or would treat other persons; or (b) he applies to that not of the same racial group as that other but-(i) which is such that the proportion of persons of the same racial group as that other who can comply with it is considerably smaller than the proportion of persons not of that racial group who the colour, race, nationality or ethnic or national origins of the person to whom it is 'A person discriminates against another in any circumstances relevant for the can comply with it; and (ii) which he cannot show to be justifiable irrespective of applied; and (iii) which is to the detriment of that other because he cannot comply purposes of any provision of this Act if—(a) on racial grounds he treats that other

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direct discrimination. When the present proceedings began in the county court, direct discrimination was alleged, but the judge beld that there had been no direct entirely on 'indirect' discrimination, that is discrimination contrary to $s_1(1)(b)$. When the proceedings began the appellants claimed damages, but that claim was not pursued The type of discrimination referred to in para (a) of that subsection is generally called discrimination, and his judgment on that point was not challenged in the Court of Appeal or before your Lordships' House. The appellants' case in this House was based before this House. Having regard to \$ 57(3) of the 1976 Act, it would have been unlikely to succeed. They now seek only a declaration that there has been unlawful discrimination against them contrary to the Act.

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The case against the respondent under s 1(1)(h) is that he discriminated against the second appellant because he applied to him a requirement or condition (namely the 'no Sikhs who can comply with it is considerably smaller than the proportion of non-Sikhs who can comply with it and (ii) which the respondent cannot show to be justifiable irrespective of the colour, etc of the second appellant, and (iii) which is to the detriment of the second appellant because he cannot comply with it. As I have already said, the first main question is whether the Sikhs are a racial group. If they are, then two further questions arise. Question two is what is the meaning of 'can' in s 1(1)(b)(i), and question turban' rule) which he applied equally to pupils not of the same racial group as the second respondent (i.e. to pupils who were not Sikhs) but (i) which is such that the proportion of three is, what is the meaning of justifiable in para (b)(ii) of that subsection?

Ethnic origins'

Racial group is defined in 8 3(1) of that Act, which provides:

nationality or ethnic or national origins, and references to a person's racial group "..."racial group" means a group of persons defined by reference to colour, race, refer to any racial group into which he falls.

groups, especially those living, like most Sikhs, in the Punjab. The argument turns referred to various dictionary definitions. The Oxford English Dictionary (1807 edn) gives two meanings of 'ethnic'. The first is 'pertaining to nations not Christian or lewish; gentile, hearhen, pagan'. That clearly cannot be its meaning in the 1976 Act, because it is inconceivable that Parliament would have legislated against racial discrimination Neither party contended that that was the relevant meaning for the present purpose. The second meaning given in the Oxford English Dictionary (1897 edn) was 'pertaining to race; It is suggested that Sikhs are a group defined by reference to colour, race, nationality or national origins. In none of these respects are they distinguishable from many other entirely on whether they are a group defined by 'ethnic origins'. It is therefore necessary to ascertain the sense in which the words ethnic is used in the 1076 Act. We were peculiar to a race or nation; ethnological. A slightly shorter form of that meaning intending that the protection should not apply either to Christians or (above all) to Jews. formitting becaliar to a race or nation) was given by the Concise Oxford Dictional vin 1043

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because they were essentially a religious group, and they shared their racial characteristics **b** purpose. Oliver and Kerr LJI also accepted that meaning as being substantially correct, a and Oliver 1.] said that the word 'ethnic' in its popular meaning involved 'essentially a racial concept: the concept of something with which the members of the group are born; and was expressly accepted by Lord Denning MR as the correct meaning for the present some fixed or inherited characteristic (see [1982] 3 All ER 1108 at 1116-1117, [1983] QB 1 at 15). The respondent, who appeared on his own behalf, submitted that that was the relevant meaning of ethnic in the 1976 Act, and that it did not apply to Sikhs

1. All ER 105 at 115, [1972] AC 342 at 362, referring to the long title of the Race Relations relevant distinctive biological characteristics (assuming that such characteristics exist). My Lords, I recognise that 'ethnic' conveys a flavour of race but it cannot, in my opinion, have been used in the 1976 Act in a strict racial or biological sense. For one things it would be absurd to suppose that Parliament can have intended that membership of a particular racial group should depend on scientific proof that a person possessed the The practical difficulties of such proof would be prohibitive, and it is clear that Parliament must have used the word in some more popular sense. For another thing, the briefest glance at the evidence in this case is enough to show that, within the human race, there are very few, if any, distinctions which are scientifically recognised as racial. Trespectfully Act 1968 (which was in terms identical with part of the long title of the 1976 Act), when agree with the view of Lord Simon in Eding Landon Berengh v Race Relations Board [1972] with other religious groups, including Hindus and Muslims, living in the Punjab.

Moreover, "racial" is not a term of art, either legal or, I surmise, scientific, I apprehend that anthropologists would dispute how far the word "race" is biologically at all relevant to the species annusingly called homo sapiens."

A few lines lower down, after quoting part of s 1(1) of the 1968 Act, Lord Simon said:

This is rubbery and clusive language-understandably when the draftsman is dealing with so unprecise a concept as "race" in its popular sense and endeavouring to leave no loophole for evasion."

have been used to mean simply any 'racial or other group'. If that were the meaning of h with the ordinary experience of those who read newspapers at the present day. In my $\,j\,$ this extent, that it introduces a reference to cultural and other characteristics, and is not I turn, therefore, to the third and wider meaning which is given in the Supplement to limited to racial characteristics. The 1972 meaning is, in my opinion, too loose and vague the Oxford English Dictionary vol 1 (A-G) (1972). It is as follows: pertaining to or having or other group within a larger system . . . Counsel for the appellants, while not accepting the third (10-2) meaning as directly applicable for the present purpose, relied on it to to be accepted as it stands. It is capable of being read as implying that any one of the common racial, cultural, religious, or linguistic characteristics, esp. designating a racial adjectives, racial, cultural; religious or linguistic; would be enough to constitute an ethnic, it would add nothing to the word group, and would lead to a result which would be unacceptably wide. But in seeking for the true meaning of ethnic in the statute, we extended sense to include other characteristics which may be commonly thought of as ethnic group. That cannot be the sense in which ethnic is used in the 1976 Act, as that Act is not concerned at all with discrimination on religious grounds. Similarly, it cannot are not tied to the precise definition in any dictionary. The value of the 1972 definition is in my view, that it shows that ethnic has come to be commonly used in a sense appreciably wider than the strictly racial or biological. That appears to me to be consistent opinion, the word ethnic still retains a racial flavour but it is used nowadays in an being associated with common racial origin.

For a group to constitute an ethnic group in the sense of the 1976 Act, it must, in my opinion, regard itself, and be regarded by others, as a distinct community by virtue of

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are these: (1) a long shared history, of which the group is conscious as distinguishing it from other groups, and the memory of which it keeps alive; (2) a cultural tradition of its certain characteristics. Some of these characteristics are essential; others are not essential but one or more of them will commonly be found and will help to distinguish the group from the surrounding community. The conditions which appear to me to be essential own, including family and social customs and manners, often but not necessarily following characteristics are, in my opinion, relevant: (3) either a common geographical not necessarily peculiar to the group; (5) a common literature peculiar to the group; (6) a common religion different from that of neighbouring groups or from the general community surrounding it; (7) being a minority or being an oppressed or a dominant group within a larger community, for example a conquered people (say, the inhabitants associated with religious observance. In addition to those two essential characteristics the origin, or descent from a small number of common ancestors; (4) a common language, of England shortly after the Norman conquest) and their conquerors might both be ethnic groups.

apostates. Provided a person who joins the group feels himself or herself to be a member of it, and is accepted by other members, then he is, for the purpose of the 1976 Act, a member. That appears to be consistent with the words at the end of sub-s (1) of 8.3: A group defined by reference to enough of these characteristics would be equable of including converts, for example, persons who marry into the group, and of excluding references to a person's racial group refer to any racial group into which he falls. In my opinion, it is possible for a person to fall into a particular racial group either by birth or by adherence, and it makes no difference, so far as the 1976 Act is concerned, by which route he finds his way into the group. This view does not involve creating any inconsistency between direct discrimination under para (a) and indirect discrimination under para (b). A person may treat another relatively unfavourably 'on racial grounds' because he regards that other as being of a particular race, or belonging to a particular racial group, even if his belief is, from a scientific point of view, completely erroneous.

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Finally, on this part of the argument, I think it is proper to mention that the word ethnic is of Greek origin, being derived from the Greek word ethnos the basic meaning of which appears to have been simply 'a group' not limited by reference to racial or any other distinguishing characteristics: see Liddell and Scott's Greek-Finglish Lexicon (8th edn (Oxford), 1807). I do not suggest that the meaning of the English word in a modern statute ought to be governed by the meaning of the Greek word from which it is derived. but the fact that the meaning of the latter was wide avoids one possible limitation on the meaning of the English word.

counsel for the appellants as a broad, cultural/historic sense. The conclusion at which I Richardson JJ) in King-Ansell v Police [1979] 2 NZLR 531. That case was discovered by the industry of the appellants' counsel, but unfortunately not until after the Court of Appeal My Lords, I have attempted so far to explain the reasons why, in my opinion, the word ethnic in the 1976 Act should be construed relatively widely, in what was referred to by have arrived by construction of the 1976 Act itself is greatly strengthened by consideration of the decision of the Court of Appeal in New Zealand (Richmond P, Woodhouse and in England had decided the case now under appeal. If it had been before the Court of Appeal it might well have affected their decision. In that case the appellant had been convicted by a magistrate of an offence under the New Zealand Race Relations Act 1071, the offence consisting of publishing a pamphtet with intent to incite ill-will against Jews. on the ground of their ethnic origins. The question of law arising on the appeal concerned the meaning to be given to the words 'ethnic ... origins of that group of persons in \$ 25(1) of the Act. The decision of the Court of Appeal was that Jews in New Zealand did form a group with common ethnic origins within the meaning of the Act. The structure of the New Zealand Act differs considerably from that of the 1976 Act, but the offence created by \$ 25 of the New Zealand Act (viz inciting ill-will against any group of persons on the ground of their 'colour, race, or ethnic or national origins') raises the same question of construction as the present appeal, in a context which is identical,

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The reasoning of all members of the New Zealand court was substantially similar, and it a can, I think, be sufficiently indicated by quoting the following short passages. The first is from the judgment of Woodhouse J where, after referring to the meaning given by the Supplement to the Oxford English Dictionary vol 1 (A-G) (1972), which I have already except that the New Zealand Act does not mention 'nationality', and the 1976 Act does.

would usually depend upon a combination, present together, of characteristics of the kind indicated in the Supplement. In any case it would be a mistake to regard The distinguishing features of an ethnic group or of the ethnic origins of a group this or any other dictionary meaning as though it had to be imported word for word into a statutory definition and construed accordingly. However, subject to those qualifications, I think that for the purposes of construing the expression "ethnic origins" the 1972 Supplement is a helpful guide and Laccept it."

Richardson J said (at \$42):

The real test is whether the individuals or the group regard themselves and are regarded by others in the community as having a particular historical identity in terms of their colour or their racial, national or ethnic origins. That must be based on a belief shared by members of the group."

And the same judge said (at 543):

their own eyes and in the eyes of those outside the group, they have a distinct social identity based not simply on group cohesion and solidarity but also on their belief ... a group is identifiable in terms of its ethnic origins if it is a segment of the beliefs, traditions and characteristics derived from a common or presumed common that combination which gives them an bistorically determined social identity in population distinguished from others by a sufficient combination of shared customs, past, even if not drawn from what in biological terms is a common racial stock. It is as to their historical antecedents."

English-speaking countries should, if possible, construe the words which we are fMy Lords, that last passage sums up in a way on which I could not hope to improve the views which I have been endeavouring to express. It is important that courts in considering in the same way where they occur in the same context, and I am happy to say that Hind no difficulty at all in agreeing with the construction favoured by the New

There is only one respect in which that decision rests on a basis that is not fully Zealand Court of Appeal.

applicable to the instant appeal. That appears from the long title of the New Zealand Act An Act to affirm and promote racial equality in New Zealand and to implement which is as follows:

the International Convention on the Elimination of All Forms of Racial Discrimination,

without distinction as to race, colour, or national or ethnic origin' of equality before the 1 Acts 1965 and 1968, refer to the International Convention on the Elimination of All Neither the 1976 Act nor its predecessors in the United Kingdom, the Race Relations Forms of Racial Discrimination. The convention was adopted on 7 March 1966, and was not now material. It was not ratified by the United Kingdom until 7 March 1969 (see to prohibit racial discrimination in all its forms, and to guarantee the rights of everyone law, notably in certain rights which were specified including education (art 5(e)(v)). The words which I have quoted are very close to the words found in the 1976. Act and in its Kingdom Acts having been passed in implementation of the obligation imposed by the signed by the United Kingdom on 11 October 1966, subject to reservations which are Canad 4108, August 1960). Under the convention the states parties undertook, inter alia, predecessors in this country, and they are certainly quite consistent with these United convention. But it is unnecessary to rely in this case on any special rules of construction applicable to legislation which gives effect to international conventions because, for the

reasons already explained, a strict or legalistic construction of the words would not, in

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The respondent admitted, rightly in my opinion, that, if the proper construction of the Sikhs would qualify as a group defined by ethnic orgins for the purposes of the Act. summarised sufficiently for present purposes in the opinion of the county court judge in It is, therefore, unnecessary to consider in any detail the relevant characteristics of the Sikhs. They were originally a religious community founded about the end of the iffteenth century in the Punjab by Guru Nanak, who was born in 1469. But the community is no longer purely religious in character. Their present position is the word 'ethnic' in 8.3 of the 1976 Act is a wide one, on lines such as I have suggested, the following passage:

The evidence in my judgment shows that Sikhs are a distinctive and self-conscious community. They have a history going back to the fifteenth century. They have a written language which a small proportion of Sikhs can read but which can be read by a much higher proportion of Sikhs than of Hindus. They were at one time politically supreme in the Punjab."

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The result is, in my opinion, that Sikhs are a group defined by a reference to ethnic origins for the purpose of the 1976 Act, although they are not biologically distinguishable from the other peoples living in the Punjab. That is true whether one is considering the position before the partition of 1947, when the Sikhs lived mainly in that part of the Punjab which is now Pakistan, or after 1947, since when most of them have moved into India. It is, therefore, necessary to consider whether the respondent has indirectly discriminated against the appellants in the sense of s 1(1)(b) of the 1976 Act. That raises the two subsidiary questions I have already mentioned.

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meaning of the word in the 1976 Act, then a literal reading of the word can' would deprive Sikhs and members of other groups defined by reference to their ethnic origins to them. They can comply with almost any requirement or condition if they are willing It is obvious that Sikhs, like anyone else, 'can' refrain from wearing a turban, if 'can' is construed literally. But if the broad cultural/historic meaning of ethnic is the appropriate of much of the protection which Parliament evidently intended the 1976 Act to afford to give up their distinctive customs and cultural rules. On the other hand, if ethnic means inherited or unalterable, as the Court of Appeal thought it did, then 'can' ought logically to be read literally. The word can is used with many shades of meaning, in the context of s t(t)(b)(t) of the 1976 Act it must, in my opinion, have been intended by Parliament to be read not as meaning 'can physically', so as to indicate a theoretical cultural conditions of the racial group. The latter meaning was attributed to the word by the Employment Appeal Tribunal in Price v Civil Service Commission [1978] 1. All ER 1228. [1977] 1 WLR 1417, on a construction of the parallel provision in the Sex Discrimination Act 1975. Lagree with their construction of the word in that context. possibility, but as meaning 'can in practice' or 'can consistently with the customs and Accordingly I am of opinion that the 'no turban' rule was not one with which the second appellant could, in the relevant sense, comply.

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respondent, it was no doubt perfectly justifiable. He explained that he had no intention of discriminating against Sikhs. In 1978 the school had about 300 pupils (about 75% boys six negroes, seven Chinese and 15 from European countries. The reasons for having a The word justifiable occurs in sa(1)(b)(ii). It raises a problem which is, in my opinion, more difficult than the problem of the word 'can'. But in the end I have reached a firm opinion that the respondent has not been able to show that the 'no turban' rule was justifiable in the relevant sense. Regarded purely from the point of view of the and 25% girls) of whom over 200 were English, five were Sikhs, 34 Hindus, 16 Persians, schoof uniform were largely reasons of practical convenience, to minimise external differences between races and social classes, to discourage the 'competitive fashions' which 大田 李 田田

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school to outsiders, including prospective parents. The respondent explained the difficulty he said tend to exist in a teenage community, and to present a Christian image of the for a headmaster of explaining to a non-Sikh pupil why the rules about wearing correct school uniform were enforced against him if they were relaxed in favour of a Sikh. In my view these reasons could not, either individually or collectively, provide a sufficient justification for the respondent to apply a condition that is prima facie discriminatory under the 1076 Act.

An attempted justification of the 'no turban' rule, which requires more serious consideration, was that the respondent sought to run a Christian school, accepting pupils of the statute, if I could have done so. But in my opinion that is impossible. The onus of all religions and races, and that he objected to the turban on the ground that it was an questions of fact for the tribunal of fact, and if there was evidence on which it could find outward manifestation of a non-Christian faith. Indeed, he regarded it as amounting to a challenge to that faith. I have much sympathy with the respondent on this part of the case and I would have been glad to find that the rule was justifiable within the meaning under para $(b \langle ii \rangle$ is on the respondent to show that the condition which he seeks to apply is not indeed a necessary condition, but that it is in all circumstances justifiable irrespective of the colour, race, nationality or ethnic or national origins of the person to is that the turban is objectionable just because it is a manifestation of the second notwithstanding that the proportion of Sikhs who could [se conscientiously] comply whom it is applied, that is to say that it is justifiable without regard to the ethnic origins Court of Appeal held that a rule forbidding the wearing of beards in the respondent's of that person. But in this case the principal justification on which the respondent relies appellant's ethnic origins. That is not, in my view, a justification which is admissible under para (b(ii). The kind of justification that might fall within that provision would be one based on public health, as in Panesar v Nestlé Co Ltd [1980] ICR 144, where the with it. Again, it might be possible for the school to show that a rule insisting on a fixed meals for the particular group would be prohibitive. Questions of that sort would be chocolate factory was justifiable within the meaning of s 1(1)(b)(ii) on hygienic grounds, with it was considerably smaller than the proportion of non-Sikhs who could comply diet, w high included some dish (for example, pork) which some racial groups could not conscientiously cat was justifiable if the school proved that the cost of providing special the condition to be justifiable its finding would not be liable to be disturbed on appeal.

But in the present case I am of opinion that the respondent has not been able to show

that the 'no turban' rule was justifiable.

Final considerations

Before parting with the case I must refer to some observations by the Court of Appeal which suggest that the conduct of the Commission for Racial Equality in this case has the respondent as an engine of oppression. Kerr I.J ([1082] 3 All ER 1108 at 1123, been in some way unreasonable or oppressive. Lord Denning MR ([1982] 3 All ER 1108 at 1114. [1983] QB 1 at 13) merely expressed regret that the commission had taken up language and suggested that the machinery of the 1076 Act had been operated against $1033 \mid \mathrm{QR}(1)$ at 23) referred to notes of an interview between the respondent and an official of the commission which he said read in part 'more like an inquisition than an the case. But Oliver I.J (11082.] 3 All ER 1108 at 1118, [1983] QB 1 at 18) used stronger interview and which he regarded as harassment of the respondent.

will be resented by some and are liable to be regarded as objectionable and inquisitive. My Lords, I must say that I regard these strictures on the commission and its officials as entirely unjustified. The commission has a difficult task, and no doubt its inquiries But the respondent in this case, who conducted his appeal with restraint and skill, made no complaint of his treatment at the hands of the commission. He was specifically asked by some of my noble and learned friends to point out any part of the notes of his interview with the commission's official to which he objected, and he said there were none and that an objection of that sort formed no part of his case. The haly who conducted the interview on behalf of the commission gave evidence in the county court,

and no suggestion was put to her in cross-examination that she had not conducted it activities, but its functions have been laid down by Parliament and, in my view, the actions of the commission itself in this case and of its official who interviewed the respondent on 3 November 1978 were perfectly proper and in accordance with its properly. Opinions may legitimately differ as to the usefulness of the commission's

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in this House and they do not seek to disturb the order for costs in the lower courts in I would allow this appeal. The appellants have agreed to pay the costs of the respondent favour of the present respondent made by the Court of Appeal. LORD EDMUND-DAVIES. My Lords, I have found this case unfortunate in several ways and by no means free from difficulty. But I have had the advantage of reading in draft form the speeches prepared by my noble and learned friends Lord Fraser and Lord Templeman. They are in conformity with the conclusion at which I had ultimately arrived, and I do not find it necessary or desirable to add any observations of my own. I therefore restrict myself to concurring that the appeal should be allowed. LORD ROSKILL. My Lords, I have had the advantage of reading in draft the speeches prepared by my noble and learned friends Lord Fraser and Lord Templeman. For the reasons given in those speeches I too would allow this appeal. σ LORD BRANDON OF OAKBROOK. My Lords, I have lad the advantage of reading in draft the speeches prepared by my noble and learned friends Lord Fraser and Lord Templeman. Lagree with both speeches, and for the reasons which they give I would allow the appeal.

discrimination is made a criminal offence are employment, education and the provision by reference to colour, race, nationality or ethnic or national origins. Presumably Parliament considered that the protection of these groups against discrimination was the LORD TEMPLEMAN. My Lords, the Race Relations Act 1976 outlaws discrimination in specified fields of activities against defined racial groups. The fields of activity in which discrimination in these fields was most widespread and harmful. By s 3 of the 1976 Act the racial groups against which discrimination may not be practised are groups defined most necessary. The 1976 Act does not outlaw discrimination against a group of persons defined by reference to religion. Presumably Parliament considered that the amount of discrimination on religious grounds does not constitute a severe burden on members of religious groups. The 1976 Act does not apply and has no reference to the situation in Northern Ireland. The Court of Appeal thought that the Sikhs were only members of a that the Sikhs are more than a religion and a culture. And in view of the history of this country since the 1939-45 war I find it impossible to believe that Parliament intended to of goods, facilities, services and premises. Presumably Parliament considered that religion or at best members of a religion and culture. But the evidence of the origins and history of the Sikhs which was adduced by the parties to the present litigation disclosed exclude the Sikhs from the benefit of the Race Relations Act 1976 and to allow discrimination to be practised against the Sikhs in those fields of activity where, as the present case illustrates, discrimination is likely to occur, 6 4

Section 17 of the 1976 Act makes it unlawful for the proprietor of a school to discriminate against a person in the terms on which the school offers to admit him to the school as a pupil. By s 1(1): A person discriminates against another ... if ... (b) he applies to that other a the same racial group as that other but-(i) which is such that the proportion of persons of the same racial group as that other who can comply with it is considerably smaller than the proportion of persons not of that racial group who can comply requirement or condition which he applies or would apply equally to persons not of with it; and (ii) which he cannot show to be justifiable irrespective of the colour, race, nationality or ethnic or national origins of the person to whom it is applied 🚎



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School if he complies with the school rules. Rule 22 stipulates that Boys' hair must be adopted by orthodox Sikhs for containing unshorn hair is the wearing of a turban; a group, being a group of persons defined within the 1976 Act and cannot comply with rr 22 or 20, whereas all non-Sikhs can comply with those rules, then the school is guilty of discrimination against the Sikh Gurinder Singh unless the respondents can show that rr cut so as not to touch the collar . . . As an orthodox Sikh Gurinder Singh must allow his school cap is useless for that purpose. Gurinder Singh says he cannot comply with rr 22 The respondents are only willing to admit the appellant Gurinder Singh to Park Grove hair to grow unshorn. Rule 20 requires boys to wear the school uniform. The method or 20 because he is a Sikh and on his behalf it is argued that Sikhs constitute a racial 22 and 20 are justifiable irrespective of the ethnic origin of Gurinder Singh.

the adjective 'ethnic'. But it is common ground that some definitions constitute the Sikhs a relevant group of ethnic origin whereas other definitions would exclude them. The racial group envisages that a group defined by reference to ethnic origin may be different tests. They are more than a religious sect, they are almost a race and almost a nation. As and second Sikh wars; they fail to qualify as a separate nation or as a separate nationality In the course of the argument attention was directed to the dictionary definitions of true construction of the expression ethnic origins' must be deducted from the 1070 Act. from a group defined by reference to race, just as a group defined by reference to national origins may be different from a group defined by reference to nationality. In my opinion, for the purposes of the 1976. Act a group of persons defined by reference to ethnic origins a race, the Sikhs share a common colour, and a common physique based on common persons who have the same othnic origins as the Sikhs have ceased to be members of the A racial group means a group of persons defined by reference to colour, race, nationality or ethnic or national origins. Lagree with the Court of Appeal that in this context ethnic origins have a good deal in common with the concept of race just as national origins have a good deal in common with the concept of nationality. But the statutory definition of a must possess some of the characteristics of a race, namely group descent, a group of geographical origin and a group history. The evidence shows that the Sikhs satisfy these as a separate race because in racial origin prior to the inception of Sikhism they cannot be distinguished from other inhabitants of the Punjab. As a nation the Sikhs defeated the The Sikhs qualify as a group defined by ethnic origins because they consitute a separate Sikh community. But the Sikhs remain a group of persons forming a community recognisable by ethnic origins within the meaning of the 1976 Act, Gurinder Singh is a ancestors from that part of the Punjab which is centred on Amritsar. They fail to qualify Moghuls, and established a kingdom in the Punjab which they tost as a result of the first because their kingdom never achieved a sufficient degree of recognition or permanence. and distinct community derived from the racial characteristics I have mentioned. They also justify the conditions enumerated by my noble and learned friend Lord Fraser. The Sikb community has accepted converts who do not comply with those conditions. Some member of the Sikh community which qualifies as a racial group for the purposes of the

school rules without becoming a victim of discrimination. The discrimination cannot be justified by a genuine belief that the school would provide a better system of education Lagree with my noble and learned friend that Curinder Singh cannot comply with the if it were allowed to discriminate. Lalso agree that the Commission for Racial Equality were under a duty properly to investigate the present complaint of discrimination and that their conduct was not oppressive.

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Lagree that the appeal should be allowed.

tpred allowed.

Solicitors: *Budman & Partners* (for the appellants).

Alary Rose Phinniner | Barrister,

Avon County Council v Howlett

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Avon / Howlett

CUMMING-BRUCE, EVELEIGH AND SLADE LJJ 20, 21, 22 JULY, 21 DECEMBER 1982 COURT OF APPEAL, CIVIL DIVISION

Estoppel – Representation – Alistake – Payment of moncy – Employer overpaying employee by mistake – Employer representing that employee entitled to treat money as his own – Employee spending part of money in reliance on representation - Whether employer estopped from recovering whole of money or only the part spent. 9

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Recovery of money paid. Nature of mistake. Alistake of law or of fact. Burden of Overpayment recoverable enty if paid under mistake of fact. Burden of proof that money paid proof. Overpayment of solary by mistake. Action by employer to resover money overpand under mistake of fact Iving on employer. Alistoke ن

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was not due to any fault on his part. The judge held that the mistake which had led to had overpaid him to the extent of $f_{
m I}$, 507. They brought an action against him claiming repayment of that sum on the ground that it had been paid by mistake. In his defence the defendant claimed (i) that the money was irrecoverable because it had been paid under a mistake of law and not of fact, and (ii) that in any event the plaintiffs were estopped from pursuing any part of their claim because (a) they had represented to him that he was entitled to treat the money as his own, (b) in reliance on that representation he had spent money which he would not otherwise have done and (c) the overpayment the overpayment was one of fact since the plaintiffs' employees had not fed the correct information into the computer, that the plaintiffs were estopped from reclaiming that part of the money which the defendant claimed he had spent in reliance on their representation, but that they were not estopped from reclaiming the balance because it would not be inequitable for them to require the defendant to repay it. He accordingly The defendant was injured in the course of his employment with the plaintiffs and as a result was absent from work for nearly two years. The plaintiffs subsequently discovered that during that period, under their computerised system for the payment of wages, they gave judgment for the plaintiffs for the balance. The defendant appealed. σ

had occurred due to a mistake of fact and not of law they were prima facie entitled to recover the full amount of the overpayment (see p. 1076 h.j. p. 1077 a b and p. 1084 c.to. Held - (1) Since the plaintiffs had discharged the onus of proving that the overpayment p 1085 b, post). 6

Rep. 134, R. F. Jones Ltd v. Waring & Gillow Ltd [1926] All F.R. Rep. 36, Greenwood v. Martins Bank Ltd [1932] All ER Rep 318 and Amalgamated Investment and Property Co Ltd (in lig) v (2) However, estopped by representation, being a rule of evidence which precluded a representor from averring facts which were contrary to his own representations, could not operate pro tanto and therefore since, on the facts, all the conditions for the application of that estopped had been satisfied it followed that the plaintiffs were prevented from recovering any part of the overpayment. Accordingly, the appeal would be allowed and the judgment of the trial judge set aside (see p 1076 h j, p 1078 a b, p 1087 a b, p 1088 g to Jand p. 1080 c.f., post); Skyring v Greenwead [1824-34] All FR Rep. 104, Oglivic v West Australian Mortgage and Agency Corp Ltd [1800] AC 257, Hoft v Markham [1022] All FR Texas Commerce International Bank Ltd [1981] 3 All ER 577 considered.

Per Cumming-Bruce L.J. A plaintiff who is faced with a defence of estoppel and wishes under a mistake of fact should plead, by way of reply, the facts on which he relies (see to argue that it would be inequitable for the defendant to retain money paid to him a roge fand a post). BIRKBECK COLLEGE (University of London)

EXAMINATION FOR DIPLOMA IN INTELLECTUAL PROPERTY LITIGATION

Wednesday, 14 JUNE 1995 - Afternoon 2.00 - 6.00

Answer ALL Questions

Unless stated otherwise all questions relate to litigation in the Patents County Court

50 marks are awarded for each of Sections A and B, 2 marks for each question in Section A and the 50 marks for Section B being as indicated

SECTION A

- Explain how an action may be commenced in the Patents County Court and list the documents required.
- What is the initial action taken by the Patents County Court?
- 3 On whom should the documents then be served?
- 4 How is service proved?
- Explain briefly how a defendant served with such proceedings may respond listing any documents involved (assume that the plaintiff's claims are to be resisted).
- When are pleadings deemed to be closed? What document should a plaintiff prepare next and for what purpose?
- 7. Briefly explain the term 'further and better particulars' and its relevance to proceedings in the Patents County Court.
- What is the period allowed for lodging an appeal from a decision of the Patents County Court, and to whom is the appeal directed?
- 9 State briefly what is governed by the "Brussels Convention" in the context of (i) starting an action (ii) the steps to be taken after the trial?
- 10 From where do patent agents derive their right to conduct litigation before the Patents County Court?
- 11 What do you understand by the phrase "third party proceedings"?

- What do you understand by the terms "interrogatories" and "sub poenas"?
- Outline the purpose of "witness statements" in litigation.
- 14 What do you understand by the term "discovery"?
- To what extent is "discovery" available in proceedings before the Patents County Court?
- 16 What is a "Civil Evidence Act Notice"?
- 17 List four the types of relief available to a successful plaintiff in the Patents County Court.
- Outline the provisions of Order 48A of the County Court rules in relation to the requirements for the "Statement of Case" in respect of patent infringement.
- 19 Briefly explain the terms (i) "ratio decidendi" (ii) "res judicata".
- Outline the provisions of Order 104 of the Rules of the Supreme Court only in relation to particulars of objections concerning want of novelty or want of inventive step.
- 21 Briefly explain the term "legal professional privilege". Is this available to clients of patent agents?
- 22 Explain briefly the term "security for costs" and give examples of two situations in which it may arise.
- 23 Briefly explain the term "summary judgement" and what relevance it has to actions before the Patents County Court?
- 24 Briefly explain the term "payment into court" and "Calderbank Letter".
- 25 List in order the main steps normally involved in the trial.

SECTION B

Instructions

You are a partner in the patent agents practice of White & Co and act for Mrs Hulbert, a London housewife living in a semi-detached suburban house with her husband (employed by the local Bronto supermarket as a shelf-stacker), two teen-age children, three dogs and four goldfish.

Back in 1990 you acted for her in obtaining a United Kingdom Patent No. 3,000,000 and United Kingdom Registered Design No. 2,000,000 in respect of a new tea bag holder. Essentially, this consisted of an open-mouthed plastic pocket with perforated square-shaped side walls and a long relatively rigid handle extending upwardly from one of the pocket walls. In use, the tea bag would be inserted into the pocket parallel to the pocket walls, the holder placed in the tea-cup, the boiling water and milk poured in and the whole stirred until the desired strength of tea has obtained, whereupon the holder with used tea bag is pulled out using the long handle. The great advantage over using just a conventional tea bag with string lay in the ease of removal of the tea bag from the cup without fear of scalding the drinker's fingers.

No substantive objections had been raised during prosecution of either the Patent or the Registered Design. The statement of novelty filed with the Registered Design referred to the square shape of the pocket walls as being the distinctive feature. Claim 1 of the Patent, however, did not contain any such limitation but recited broadly the combination of a handle and openmouthed pocket.

A few days ago Mrs Hulbert came to see you again. Your assistant took an attendance note (Document A).

Examination of the Bronto holder indicates that it was being made in Scotland at Glenethyl (Fife) Industrial Estate by Plastics for People. You make enquiries and ascertain that Plastics for People is a workers' co-operative set up by the local council in an attempt to mop up some of the local unemployment.

You also ascertain that Bronto, although a relatively small operator compared with the trade giants, has supermarkets scattered throughout the United Kingdom. The formal corporate entity is Bronto (UK) Ltd, a private company registered in England but owned wholly by Bronto S.A. of Cavellville, Belgium. They have a number of subsidiaries in other EEC countries, and are proud of being a close-knit family business in spite of their international spread.

ADVISE MRS HULBERT AS TO:

(a) who could be sued and why, and who would you select? (6 marks)
(b) where could a suit be brought and what would you advise? (6 marks)
(c) what other steps, if any, would you take in advance of suit? (6 marks)

Assume now that you have satisfied yourself concerning any pre-action questions and that you have commenced an action in the Patents County Court for patent and registered design infringement.

Immediately following the initiation of legal proceedings, you receive a fax from the Legal Department of Bronto (UK) (Document B).

Next day, Mrs Hulbert brings you a copy of a memorandum (Document C) placed anonymously into Mr. Hulbert's locker at work.

ADVISE MRS HULBERT AS TO:

(d) how best to proceed further in this matter.

(10 marks)

The legal proceedings continue (either following or in spite of your advice) in the Patent County Court, up to the close of pleadings stage. Bronto both deny infringement (of the Patent and the Registered Design) and attack the validity of each. Various prior forms of tea bag holder are cited, mostly pre-1914 documents but also one alleged to have been used since around 1950 at their tea plantation in Assam. They indicate that they want to dispose of the matter quickly and will press for early trial. At this point you receive a further letter from Mrs Hulbert (Document D) describing her most recent plans.

ADVISE MRS HULBERT AS TO:

- (e) how you will deal with her absence. (6 marks) (f) how, if at all, Document C can be used to advantage. (6 marks)
- (g) explain briefly what other procedural issues may arise in this case in preparation for trial. (10 marks)

DOCUMENT A (ATTENDANCE NOTE)

I heard about the Patents County Court from my friend down the road, who works in their posh new place near Regent's Park. She says it is just for ordinary people like me. So I have come to you for help again.

It's all about my patent and design which you took out for me a few years ago. I was never able to interest anyone in it (although I did keep the fees up to date).

My husband tells me that Bronto (where he works in the store) are about to launch a new item on the tea side. They have always been very big in beverages. One of their suppliers in Kenya has developed a genetically engineered tea plant, which you may have read about in the papers. It produces tea with an absolutely consistent flavour, irrespective of growing conditions, so that tea-tasters will no longer be required. Bronto are going to start selling it next month, to coincide with Wimbledon and Henley. They will describe the tea as ideal for making iced tea. The tea will come in a tea bag together with a holder very much like mine but with a longer handle and pockets which are rounded at the corners rather than completely square as in my design.

One of my husband's friends in the warehouse slipped him a sample. Here it is. I know that I am in only very modest financial circumstances but I do not see why Bronto should be entitled to rip me off. I work occasionally as a part-time care assistant at the local nursing home to supplement my husband's income, but we always have difficulty in paying off the mortgages at the end of each month. We have two, one on the house and another on our boat. We are both mad-keen sailors.

DOCUMENT B (Fax to White & Co.)

Legal Department Bronto UK Tusk Drive Dino Industrial Park Juratown

WITHOUT PREJUDICE

Dear Sirs,

re: Mrs Hulbert

We act for Bronto UK in connection with the legal proceedings for infringement of United Kingdom Patent No. 3,000,000 and Registered Design No. 2,000, 000.

It seems to us almost inconceivable that these proceedings could be successful. Our tea bag holder is of a very different shape since it is intended to be used in glasses (for iced tea) rather than in mugs or cups (for ordinary hot tea). It has a much longer handle and the pocket is rounded-off to assist stirring in the relatively smaller cross-sectional area at the bottom of the standard tall iced tea glass. The basic idea of a handle and pocket holder is also very old and goes back at least to Victorian times.

Nevertheless we prefer to deal with your client's complaint (however unjustified it may be) immediately in order to avoid any problems with our new GT product.

We therefore offer £1000 in settlement of all your client's claims. This offer is open for 7 (seven) days only, from 6pm today.

Yours faithfully,

For Bronto (UK) Ltd

DOCUMENT C

To: A.Bronto (Managing Director)
From: B.Diplodoc (Legal Department)

re: Mrs Hulbert

This is in reply to your memo of last week.

This case is potentially a real can of worms for us. The GT launch is our biggest promotion of the year and we seem to fall right within her Patent and Design.

In order to try and wrap it all up very quickly before she really gets under way, I have offered her £1000. Knowing that her husband earns here, I would imagine that there is a very good change they will accept this and blow it all on a fortnight in Majorca.

DOCUMENT D (Letter to White & Co.)

White & Co. Chartered Patent Agents

Dear Mr.....

Thank you for keeping me in the picture.

Just to let you know that I have just been offered a place on the Mighty Minnows all-girls round the world windjammer trip. It's a once in a lifetime opportunity which I wouldn't miss for anything. Next time round I will be over 40 and too old. My girls can keep the house going while I am away.

The trip should take best part of a year - maybe even longer if we have to into port for repairs. Cape Horn will probably give us quite a battering.

I am sure that you can keep the case going properly in my absence. There is no radio onboard, but we expect to make a few stops in ports for stock up water and provisions.

I will try and get in touch with you at these, although the dates are obviously uncertain.

The President stressed in closing that the views expressed in the documents were not necessarily those of Council, and indeed some were quite contrary to views held by some council members. They were prepared for the purpose of drawing comments and he was pleased that they were doing just that, and thanked the contributors accordingly.

The President announced that, as a result of the ballot which had been conducted during the course of the meeting, the following candidates had been elected:

As Fellows:

Ruth Anita Barcock, Angela Mary Brown, Nicholas Justin Ertl, Alison Elizabeth Fraser Simpson, Laura Marie Hughes, Cyrus James Grahame Legg, David Leslie Roberts and Graham Wood;

As Associates:

John Norman Adams, Manender Grewal, James Irvine, Sheila Agnes Fife Kerr, Audrey Hammett and Ross Thomson Walker;

As Foreign Members:

Marc-Roger Hirsch, Alain Michelet and Ken R. Moon.

In the evening there was an excellent dinner for members and friends as is becoming customary after out-of-town meetings. As is also becoming customary at such dinners the Editor met more members of the profession and found out as the meal progressed what they really thought, which was entertaining although not suitable for reproduction in these pages.

G.F.A.

Birkbeck College Litigation Course

A dinner was held on the 22nd November 1995 at the Langham Hilton Hotel, Portland Place, by the Patent Litigators Association to mark the completion of the inaugural running of the part-time course at Birkbeck College, University of London, leading to a Diploma in Intellectual Property Litigation.

Diplomas were presented by The Honourable Mr. Justice Laddie to those who had completed the course and passed the associated examination. There was also a presentation by His Honour Judge Ford to Mr. Matthew Hitching, the candidate gaining the highest marks in the examination.

The Chartered Institute was represented by the Vice-President, Mr. Andrew Serjeant, and his wife Joan, and the Lord Chancellor's department by Mr. Rael Zackon. All others attending the dinner were either directly or indirectly involved in the setting up, running or attending the course and included academic and administrative members of the staff of Birkbeck College, practising barristers and solicitors who had acted as lecturers and examiners.



Matthew Hitching receiving his award from His Honour Judge Ford



The Honourable Mr. Justice Laddie and His Honour Judge Ford with those awarded the Litigation Diploma

Those members of the Chartered Institute who may be interested in wishing to enrol for the course in 1996 should apply to Miss Valerie Hoare, Department of Law, Birkbeck College, University of London, Malet Street, London, WC1E 7HX, for further details.

Alan Burrington, Secretary PLA

Birkbeck College Diploma in Intellectual Property Litigation

This course was run for the first time in 1995 and it is planned to run it again in 1996.

The course is essentially practical and principally designed to assist UK registered patent agents in connection with their involvement in intellectual property litigation generally and their conduct of litigation before the Patents County Court in particular. The lectures are given in the main by members of the Patent Bar and also by solicitors expert in intellectual property litigation.

The course will commence at Birkbeck College, Malet Street, London on 12th February 1996 and consists of twenty 3 hour sessions on two evenings a week (excluding bank holidays) between 6.00 and 9.00 p.m. in the periods:

12th February 1996 to 25th March 1996 1st April 1996 to 22nd April 1996.

An examination leading to the award of the diploma will take place around the middle of May 1996.

The course fee is £1,900 plus VAT.

For those who wish to enrol for the course further details are obtainable from:

Valerie Hoare, Department of Law, Birkbeck College, University of London, Malet Street, London, WC1E 7HX, (Tel: 0171-631 6507, Fax: 0171-631 6506)

Alan Burrington Secretary, Patent Litigators Association

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DRAFT PROPOSAL FOR QUALIFYING COURSE FOR FELLOWS OF THE CHARTERED INSTITUTE OF PATENT AGENTS SEEKING CERTIFICATION AS A LITIGATOR

I. Aim

The aim of the course will be to provide patent agents with the skills and knowledge necessary to act as fully effective litigators in those areas in which litigators rights are sought by the Chartered Institute.

It is not considered appropriate that the course should only aim for some minimum standard. It should be designed to achieve and require a high standard such that those who achieve the qualification can function as high level professionals in the field of litigation for which rights are sought using both their knowledge of substantive law in their specialist area (patents, trade marks etc) and their skills and knowledge of litigation gained on the qualifying course.

II. Need for New Course

None of the courses which are at present available will meet the above requirements. There is, therefore, the need for a new course which will lead to a qualification recognised to be of a sufficiently high standard. Although there is no existing course which meets these requirements in full, there are two courses which individually go some way towards meeting the requirements for the new course. The proposal, therefore, is that the new course should be developed from these two existing courses, which are:

1. the Diploma in Intellectual Property litigation course at Birkbeck College, London University; and

2. the LLM course in Advanced Litigation run by Nottingham Trent University.

The details of these courses as at present constituted will be understood from consideration of the documents in the accompanying lever arch file.

III. The Birkbeck Course

The Birkbeck Course was established in 1995 as a result of the perceived need by the members of the committee of the Patent Litigators Association for an effective and practical course for patent agents intending to act as litigators and/or advocates in the Patents County Court.

The course content was designed with the assistance of Mr Hugh Laddie QC (now Mr Justice Laddie) who, at the time, was Chairman of the Patent Bar. Those parts of the course dealing with general law were taught by members of the academic staff at Birkbeck College. The remainder, dealing specifically with patent litigation, was taught mostly by members of the Patent Bar, but with some subjects being taught by experienced solicitors. A short description of the course, setting out its objects and in outline its content, is included at Tab 1 in the accompanying lever arch file. This description was circulated to members of the Chartered Institute when the course was set The fully detailed syllabus is at Tab 2. distributed and used at each of the sessions are included at Tabs 3 to 15 and the examination paper at Tab 16.

In 1995, the course ran from March to June. A further course will begin in November 1996.

As can be seen, in addition to the teaching of law and practice, the course involved practical skills based training by way of a mock patent infringement trial.

IV. The Nottingham LLM In Advanced Litigation

The brochure issued by Nottingham describing this course is included at Tab 17 in the accompanying lever arch file.

It is understood that this course meets the requirements of the Law Society's Legal Practice Course and indeed that Nottingham are regarded as a leader in the teaching of this course.

As is set out in the Nottingham brochure, the course concentrates on the development of practical skills and uses a structured program of participative learning in order to achieve this. As is explained on page 5 of the brochure, there are no examinations on the course but assessment is by way of the following, which have to be submitted by participants in the course:

- 1. A Learning Portfolio;
- Reflective reports;
- 3. A research based "Extended Piece of Work" in the form of a report, a dissertation or a reform proposal.

V. The Seat for the New Course

Nottingham have been approached and have indicated a willingness and keen interest to establish the new course. However, they require time to do this so that they can ensure that it is established to the required standards and to meet the needs of those seeking qualification by way of the course. They have pointed out that the LLM in Advanced Litigation took two years of planning in order to create it.

It is proposed that Nottingham should be formally asked to establish the new course leading to an LLM in Advanced

Litigation and Fellowship of the Centre of Advanced Litigation just as the present LLM course does. The new course should take into account the following points:

- 1. Whereas the present LLM in Advanced Litigation assumes that the candidates will have had two years of experience of litigation, such assumption should not be made in relation to the new course. It will need to start from a more basic position.
- 2. The new course will need to deal explicitly and thoroughly with patent and other intellectual property litigation cases within the scope of the litigators rights being sought by the Chartered Institute. So far as patent cases are concerned, this will be based upon the present Birkbeck Course. A syllabus to bring in the other types of intellectual property case which are relevant has still to be designed.

Keith Beresford 17 July 1996

CIPA Basic Litigation Skills Course Description

Course summary

This short, intensive course is designed to allow qualified attorneys to develop and practise the skills required to formulate and present a coherent submission. The underpinning knowledge will be presented via reading or lectures, with the main emphasis of the course being practical as there will be opportunities for supervised small group and team work in which participants can practise and prepare required skills, and plenary sessions in which advocacy skills can be practised and where reflection on and learning from the course will take place.

Content

Each session below contains a session title, session summary and set of learning outcomes. Each session has been mapped to the IPReg learning outcomes in Schedule 1 IPReg Rights to Conduct Litigation and Rights of Audience and Other Reserved Legal Activities, Schedule 1 – Basic Litigation Skills Course Outcomes of document. This is also attached.

Remote Learning

The remote learning is provided as bespoke online learning resources, supported with selected reading including articles and material from a recommended text book. The remote learning will comprise three days of study. Participants will complete the remote learning on a flexible basis before they attend the tutor-delivered components of the course.

The remote learning will provide full preparation for the tutor-delivered components. The online resources will include guidance on how to use the learning materials. Participants will familiarise themselves with the aims, objectives and structure of the course, the assessment requirements, and the case study. They will also acquire the knowledge required for key areas including court structures, civil litigation procedures, administering oaths and declarations, ethics and evidence. Short on-line tests will enable participants to be aware of their progress and identify any areas of weakness.

At the end of the remote learning, participants will be able to:

- understand the course structure
- understand the rights acquired on successful completion of the course
- understand the course assessment requirements
- explain the importance of preparation
- describe relevant court structures
- locate the civil litigation rules and identify which parts apply to IP
- explain IP litigation procedures
- explain procedures for administering oaths or declarations
- explain how advocates use evidence in IP litigation
- identify potential ethical issues.

LO1, LO2, LO4, LO5, LO6

Day 4

Session 4.1 Review of learning

This session provides a brief review of the remote learning with an overview of the tutor-delivered sessions and how the components link.

At the end of this session, participants will be able to:

- understand the course structure
- know the rights acquired on successful completion of the course
- understand the course assessment requirements.

Session 4.2 Preparation and case management

This session is a lecture that introduces the skills required to present a case in any tribunal.

At the end of this session, participants will be able to:

- explain the importance of preparation
- plan the internal process of litigation file management.

LO1, LO3, LO5

Session 4.3 Case preparation

In this session, participants will be mentored and work in groups to analyse the case and plan how to approach it. A plenary session will provide an opportunity for review and reflection.

At the end of this session, participants will be able to:

- 1 analyse the case
- 2 apply the relevant law to the facts of a patent dispute
- 3 recognise the appropriate cause(s) of action for a claim and the elements which must be proved for each
- 4 develop a case theory for a claimant in infringement proceedings
- 5 demonstrate the importance of thorough preparation.

LO1, LO3

Session 4.4 Evidence

This session is a lecture that builds on the pre-course learning to enable participants to apply their understanding of ethical principles to the case study.

At the end of this session participants will be able to:

• assess the usefulness and relevance of evidence.

LO1, LO2, LO3

Session 4.5 Ethics

This session is a lecture that builds on the pre-course learning to enable participants to apply their understanding of ethical principles to the case study.

At the end of this session participants will be able to:

- explain duties to the court
- analyse ethical issues when dealing with clients and witnesses
- explain duties to the other side
- apply ethical principles in relation to collecting and presenting evidence
- distinguish between evidence, argument and submission.

LO2

Session 4.6 Ethics 2

Preparing to interview clients and witnesses

In this session, participants will be mentored and work in groups using the case study to prepare and plan for interviewing a witness.

At the end of this session participants will be able to:

- identify potential witnesses
- prepare for interviewing
- prepare a schedule of questions for interviewing a witness
- identify appropriate techniques for extracting information from a witness
- (prepare to) draft a witness statement.

LO1, LO2, LO3

Session 4.7 Ethics 2

In this session, participants work in small groups to apply their understanding of ethics to a task based around the case study.

Session 4.8 Evidence gathering and interviewing

In this session, participants will work in small groups to apply interviewing techniques in a role play task in the context of the case study. There will be opportunities to receive informal feedback and to discuss the usefulness of the evidence obtained.

At the end of this session, participants will be able to:

- assess different evidence gathering techniques
- select appropriate techniques for interviewing
- evaluate the relevance and admissibility of witness evidence
- apply techniques identified in Session 4.7.

LO1, LO2, LO3

Session 4.9: Preparing the case 1

Session summary

This session takes the form of a lecture. The case study will be used as a basis for exploring the processes of preparing the case.

At the end of this session, participants will be able to:

- prepare the Statement of Case
- prepare witness statements

- state the contents of Pleadings
- explain the relationship between effective initial drafting of patents and successful litigation
- identify jurisdiction issues
- explain ethics issues in relation to privilege.

LO1, LO2, LO3, LO4, LO5, LO6

Session 4.10: Preparing the case 2

In this session, participants will work in small groups on a task based around the case study that involves establishing what case preparation is needed.

At the end of this session, participants will be able to:

• describe the required elements to prove the case.

LO1, LO2, LO3

Session 4.11: Oral advocacy skills

This session is a lecture that explores the skills and techniques required for effective oral advocacy.

At the end of this session, participants will be able to:

• formulate and present a coherent submission based upon facts, general principles and legal authority.

LO1, LO2, LO3, LO7

Session 4.12 Practising oral advocacy

In this session participants will practising making a short presentation of a case within a small group. Tutors will provide support and individual feedback.

At the end of this session participants will be able to:

• deliver a submission in a structured, concise and persuasive manner.

LO7

Session 4.13: Plenary session

This is the final plenary session, during which participants will have the opportunity to broaden their understanding of advocacy skills and litigation procedures through discussion of, and feedback on, queries arising during the course. The importance of being prepared for challenges to the case they plan to present will also be explored.

At the end of this session, participants will be able to:

• understand the importance of identifying possible challenges and ways to respond. LO1, LO3, LO6

Day 5

Individual preparation

Participants will have the opportunity to carry out self-directed study in preparation for the assessments. Tutors will be available for consultation.

Assessment

Assessment will be means of:

Written examination lasting 2 hours which assesses learning outcomes LO2, LO4, LO5 and LO6; and **Advocacy task**: individual 10 minute presentation of submission and argument, based around the case study, which assesses learning outcomes LO1, LO3 and LO7.

The assessment sessions will be scheduled to run in parallel for effective time management.