

Rules of Professional Conduct for Trade Mark Agents Holding and acting within the scope of Litigator Certificates

(Special Rules of Professional Conduct)

1. Definitions

“Certificate” shall mean a certificate issued by the Institute of Trade Mark Attorneys within the scope of the rights granted under the Courts and Legal Services Act 1990

“Trade Mark Litigator” shall mean a trade mark agent holding a current Certificate.

“Litigation Work” shall mean the provision of professional services within the scope of a Certificate by or under the supervision of a Trade Mark Litigator.

“Firm” shall mean a sole practitioner, a partnership or a body corporate carrying on business as a registered trade mark agent or solicitor, or whose primary purpose is to provide intellectual property advice to third parties for payment in respect of those services.

“Member of a Firm” shall mean an employee of the Firm and also the sole practitioner in the case of a sole practitioner, a partner of the Firm in the case of a partnership, and a director of the Firm in the case of a body corporate.

“ITMA” shall mean the Institute of Trade Mark Attorneys

“Employed Trade Mark Litigator” shall mean a Trade Mark Litigator who is an employee of an employer that is not a Firm.

2. Scope of Rules

2.1 These Rules shall apply to Trade Mark Litigators when performing Litigation Work.

2.2 A Trade Mark Litigator 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.

2.3 A Trade Mark Litigator shall, by applying for and holding a Certificate, agreed to subject to any appeal to be bound by all requirements and procedures and decisions of any person, body or committee set up to enforce these Rules and shall co-operate fully and promptly in establishing the facts in relation to any alleged breach of these Rules.

2.4 If any provision of these Rules imposes requirements additional to or different from those of other rules of conduct to which a Trade Mark Litigator is subject, these Rules shall prevail.

3. Basic Principles

A Trade Mark Litigator shall neither do anything nor permit any person to do anything on his or her behalf, which compromises or impairs or is likely to compromise or impair any of the following:

- (a) the independence or integrity of the Trade Mark Litigator
- (b) a person’s freedom to instruct a Trade Mark Litigator or other professional person of his or her choice;
- (c) The Trade Mark Litigator’s duty to act in the best interest of the client;

(d) The Trade Mark Litigator's [statutory] duty to the Court [under Section 27(2A) of the Courts and Legal Services Act 1990 (see Rule 11.1 below)], which shall prevail over his or her duty to any client or other person; or

(e) the Trade Mark Litigator's proper standard of work.

4. Competence

4.1 A Trade Mark Litigator shall decline to undertake Litigation Work outside his or her expertise or competence.

4.2 A Trade Mark Litigator shall consider whether, having regard to:

(a) the circumstances (including in particular the gravity, complexity and likely cost) of the case;

(b) the nature of the Trade Mark Litigator's practice;

(c) the Trade Mark Litigator's ability, experience and seniority; and

(d) the Trade Mark Litigator's relationship with the client; the best interests of the client would be served by the Trade Mark Litigator, another Trade Mark Litigator whether within the same Firm or not, a solicitor, or some other person providing litigation services.

4.3 The consideration referred to in Rule

4.2 shall be given as soon as practicable after receiving instructions and from time-to-time thereafter, particularly when circumstances change, and a file note shall be made on each occasion such consideration is given. If the Trade Mark Litigator considers that the best interests of the client would be served by some other person acting, he or she must advise his or her client accordingly.

5. Conflict of Interest

5.1 A Trade Mark Litigator 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.

5.1.1 If a Trade Mark Litigator 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 Trade Mark Litigator must not accept instructions to act against that client or shall henceforth cease to act against that client. The term "relevant knowledge " shall mean such 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.

5. 1.2 A Trade Mark Litigator must not continue to act for two or more clients where a conflict of interest arises between those clients.

5. 1.3 A Trade Mark & Design Litigator must not act where his or her interests, or where he knows or has reasonable grounds for suspecting that the interests of any Partner or member of staff of his or her firm, conflict with those of a client.

5.1.4 A Trade Mark Litigator must not allow any person to perform Litigation Work under his or her supervision when the Trade Mark Litigator knows or has reasonable grounds for suspecting that such person has a conflict of interest in respect of the Litigation Work.

5.1.5 Subject to Rule 6, an Employed Trade Mark Litigator 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.

6. Employed Trade Mark Litigators

6.1 An Employed Trade Mark Litigator shall not act in the course of his employment with his employer as a Trade Mark Litigator except in accordance with the following provisions of Rule 6.

6.2 In the course of his employment, an Employed Trade Mark Litigator 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;

(f) where the employer is an association whose members are limited to persons engaged or concerned in a particular trade, occupation or activity or otherwise having a community of interest and is formed bona fide for the benefit of its members and not formed directly or indirectly for the benefit of the Employed Trade Mark Litigator or primarily for securing assistance in legal proceedings, for a member of such an association; or

(g) 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.

6.3 Subject to the following provisions, an Employed Trade Mark Litigator may also act for the following persons;

(a) a fellow employee;

(b) a director, company secretary or board member of the Employed Trade Mark Litigator'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 6.2; 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 Trade Mark Litigator 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 Trade Mark Litigator's costs, unless such costs are recoverable from any other source.

6.4 The employed Trade Mark Litigator 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 Trade Mark Litigator for which the employer would be vicariously liable, if that be the case.

6.5 The Employed Trade Mark Litigator 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 Trade Mark Litigator is not covered by insurance in relation to professional negligence, if that be the case.

6.6 Where an Employed Trade Mark Litigator is acting for a body or person other than the employer in accordance with these Rules, any information disclosed by the Employed Trade Mark Litigator by the client is confidential and cannot be disclosed to the employer except with the express consent of the client.

6.7 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 Trade Mark Litigator'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.

7. Non-discrimination

7.1 A Trade Mark Litigator must not discriminate on the grounds of race, sex, disability, sexual orientation or religion in his or her professional dealings with clients, employees, solicitors, other patent agents, barristers or any other person.

7.2 Without prejudice to rule 7.1 a Trade Mark Litigator 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).

8. Confidentiality

8.1 Except properly for conduct of work on behalf of the client, a Trade Mark Litigator is under a duty to keep confidential to his or her own Firm the affairs of a client and to ensure that the staff of the Firm do the same.

8.2 The duty under Rule 8.1 applies irrespective of the source of that information.

8.3 The duty under Rule 8.1 continues until the client permits disclosure or waives the confidentiality.

9. Fees

9.1 A Trade Mark Litigator 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.

9.2 A Trade Mark Litigator 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.

10. Community Legal Service Fund

A Trade Mark Litigator 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.

11. Duties of a Trade Mark Litigator

11.1 A Trade Mark Litigator 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 those duties override any obligation which the Trade Mark Litigator may have (otherwise than under the criminal law) if it is inconsistent with them.

11.2 A Trade Mark Litigator whilst under a duty to do the best for a client must never deceive or mislead the Court.

11.3 A Trade Mark Litigator 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.

11.4 A Trade Mark Litigator is under a duty to attend or arrange for the attendance of a responsible representative throughout any Court hearing attended by Counsel.

11.5 A Trade Mark Litigator must comply with any order of the Court which the Court can properly make requiring the Trade Mark Litigator and his or her Firm to take or refrain from taking some particular course of action.

11.6 A Trade Mark Litigator 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.

12. Complaints

Each Trade Mark Litigator or Firm shall have an established procedure for dealing with complaints in regard to Litigation Work. Written details of the procedure must be available whenever a client requests them. In addition, a client shall be informed in writing, when first engaging a Trade Mark Litigator or Firm to do Litigation Work (whether or not the client is already a client of the Trade Mark Litigator or his Firm in respect of other work), that such a procedure exists and that, for resolution of a complaint, the client should first contact the Trade Mark Litigator or his Firm. 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.

13. Professional Indemnity Insurance

13.1 Each Trade Mark Litigator or his or her Firm must take out and maintain professional indemnity insurance cover for Litigation Work. When commencing and renewing such insurance, each Trade Mark Litigator or his or her 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 the relevant Council of ITMA from time to time but shall never be a value less than £1,000,000.

13.2 A Trade Mark Litigator shall not limit liability for professional negligence below the Minimum Value.

13.3 Any limitation of liability for negligence in respect of Litigation Work must be clearly drawn to the attention of a client and be understood and accepted by him or her.

13.4 The provisions of this Rule 13 shall not apply to an Employed Trade Mark Litigator when he or she is acting within the meaning of Rule 6.2 or 6.3.

14. Client's Money

14.1 A Trade Mark & Design Litigator in performing any Litigation Work 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 Trade Mark & Design Litigator's personal or professional business account.

14.2 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).

14.3 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.

14.4 Money which the Trade Mark & Design Litigator is not required to keep in such a separate clients' account includes:

- (a) any money receiving on account of expected charges for the Trade Mark & Design Litigator'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 Trade Mark & Design Litigator.