

Intellectual Property Regulation Board

(on behalf of the Patent Regulation Board and the Trade Mark Regulation Board)

Consultation on Replacement of the CIPA Higher Courts Qualification Regulations and the ITMA Trade Mark Litigator and Trade Mark Advocate Certificate Regulations

Introduction

The Legal Services Act 2007 ('LSA') has at its heart a number of core "regulatory objectives" including:

- protecting and promoting the public interest;
- improving access to justice;
- protecting and promoting the interests of consumers;
- promoting competition in the provision of legal services (i.e. those services within subsection (2) of section 1 of the LSA; and
- encouraging, *inter alia*, a diverse and effective legal profession.

Consumers of intellectual property law services have long complained that intellectual property litigation is an area in which restrictions on professional representation lead to unnecessary increased cost and complexity. The problem is particularly acute for small and medium sized enterprises, and especially so for individual inventors, authors or traders.

In the past, IP consumers would use the services of patent or trade mark attorneys to obtain their rights, but to enforce them they would have to instruct solicitors and barristers. The IP attorneys would usually have a consulting role in the process. Consumers frequently complained that they could see no reason for having to instruct 3-4 different professional groups. Furthermore, the number of specialist IP solicitors was relatively low compared to the number of IP attorneys. The entire process potentially involved unnecessary duplication of professional services at commensurate cost; the pool of available professionals remained small and exclusive.

Matters improved a little with the introduction of the Patents County Court ('PCC') in 1990. At that time patent (but not trade mark) attorneys gained the right to represent clients and to advocate in relation to patent and design cases in the PCC¹. However, for a variety of reasons many patent attorneys were discouraged from utilising the rights. Consumers of trade mark services continued to complain that they had to re-instruct solicitors and barristers in the High Court.

Both patent and trade mark attorneys became eligible for more extensive litigation rights when their respective institutes became authorised bodies under the Courts and Legal

¹ The PCC's "special jurisdiction".

Services Act 1990, but because of cost and complexity, again the uptake has been low, and the incidence of the use of the rights is still lower. Thus despite more than a decade of change up to 2010, in practice access to IP litigation services has resisted liberalisation and greater competitiveness in practice, and it largely remains the preserve of a select group of solicitors and barristers.

Nevertheless, reforms have continued. In 2010 the PCC was substantially reformed to simplify procedures for lower value IP cases. To a much greater extent the regime in the PCC now resembles procedures used by the European Patent Office, which are in turn common to IP Office procedures across the world and in which patent and trade mark attorneys are trained and experienced. The new PCC Judge, His Honour Colin Birss QC, has regularly encouraged qualified IP attorneys to use such rights as they have to appear before him. In principle the stage is set for low value IP litigation to be significantly liberalised by allowing consumers to use a single professional chosen from a diverse range of providers for their litigation needs in the PCC, at a huge cost saving.

However, that outcome would be frustrated by the exclusion of most IP attorneys from appearing before the PCC. In particular:

- the existing statutory rights of patent attorneys to conduct litigation and to appear before the PCC and the High Court on appeal from the Patent Office have been repealed subject to transitional provisions.² Failure to reintroduce similar rights as part of the new LSA regime would exclude around 1800 previously qualified professionals from litigation practice;
- trade mark attorneys at large continue to be excluded from the PCC and from High Court appeals from the UKIPO;
- both patent and trade mark attorneys who wish to litigate have to undertake extensive additional training which is disproportionate compared to the equivalent regime for solicitors and which is statistically, and on professional evidence, a significant barrier to market entry.

Thus, at a time when repeated government reviews have stressed the importance of intellectual property to the UK economy, and in particular the availability of cost effective court procedures to facilitate enforcement, in practice the consumer faces – if anything – potentially less choice in service provision than at any time since 1989.

The Patent Regulation Board ('PRB') and the Trade Mark Regulation Board ('TRB') acting together as the Intellectual Property Regulation Board ('IPReg') believe this state of affairs is not in the public or consumer interest, and further is concerned that without change the reforms to the PCC will be substantially frustrated. IPReg is therefore proposing to issue a revised qualification regime for patent attorney and trade mark attorney litigators to

² Repealed (1.1.2010) by Legal Services Act 2007 (c. 29), ss. 208(1), 210, 211, Sch. 21 para. 80, Sch. 23 (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)(i)(vi) (with art. 9)

facilitate the grant of relevant, field-appropriate³, rights to registered patent & trade mark attorneys.

The Historical Background

For clarification, litigation rights can be divided into two distinct types.

- i) a “right of audience” which is the right to address a Court; and
- ii) a “conduct right” which is the right to manage litigation for a client by taking certain procedural steps and fulfilling certain roles in the handling of a case.

Although the rights are often held together they are quite separate and distinct. By way of example, barristers are the most obvious practitioners with rights of audience in all courts but ordinarily do not have any rights to conduct litigation. In contrast solicitors have rights of audience only in some courts but have a universal right to conduct litigation.

Within the IP Professions, historically various rights have been granted:

- to registered patent attorneys automatically upon registration;
- to patent attorney litigators who have been qualified for three years and after completion of a training course and the acquisition of 6 months litigation experience;
- to trade mark & design litigators after completion of a training course and the acquisition of 6 months litigation experience.

Patent attorney rights

i) High Court rights

Prior to 1978, patent attorneys’ rights of audience were limited to the Patents Appeal Tribunal and the Registered Designs Appeal Tribunal. With the abolition of the Patents Appeal Tribunal in 1978, patent attorneys were given a limited statutory right to appear before the High Court and conduct appeals from decisions of the Patent Office.⁴ Patent attorneys could not appear in other matters, such as infringement or revocation cases, for which a traditional solicitor/barrister team had still to be separately instructed.

ii) Patents County Court rights

The PCC was established in the 1990s and patent attorneys were given the right to conduct litigation and appear in cases falling within the PCC’s “special jurisdiction”, in other words a set of rights limited to certain IP cases (to distinguish the rights from the PCC’s general jurisdiction as an ordinary County Court).⁵

³ i.e. rights commensurate with experience and qualification

⁴ Section 102 Patents Act 1977, now Section 102A of the Patents Act 1977 as amended

⁵ Sections 287 and 292 of the Patent, Copyright and Designs Act 1988

Patent attorney litigator rights

Following the appointment of the Chartered Institute of Patent Attorneys ('CIPA') as an authorised body under the Courts and Legal Services Act ("CLSA") 1990, appropriately qualified patent attorneys gained the right to *conduct* intellectual property litigation in the High Court and some ancillary rights.⁶

Trade mark attorney rights

For various largely historical reasons trade mark attorneys are not currently granted litigation rights upon qualification. It is believed that automatic PCC rights might have been given in common with Patent Attorneys under the Copyright Designs & Patents Act 1988, however when first instituted the PCC was only granted explicit jurisdiction over patent and design matters. Since its establishment its jurisdiction over trade mark matters has grown.⁷ Eventually, in 2005 the Institute of Trade Mark Attorneys ('ITMA') was designated an "Authorised Body" under the CLSA and attorneys may now qualify as Trade Mark & Design Litigators, with rights that mirror (appropriate to subject matter) those of Patent Attorney Litigators.

The need for reform

More recent developments now make it necessary to revise the existing litigation and rights of audience regulations issued by CIPA and ITMA. First, the current regulations were issued before the PRB and TRB were established as the independent regulators for patent attorneys and trade mark attorneys and therefore do not properly reflect the separation of the regulatory from the representative roles of CIPA and ITMA.

Second, there are pronounced differences in the approaches taken by CIPA/ITMA to the establishment and regulation of their rights and it is desirable that as far as possible these are made consistent.

Third, as noted above the existing statutory rights of patent attorneys to conduct litigation and to appear before the PCC and the High Court on appeal from the Patent Office have been repealed subject to transitional provisions.⁸ Rights will be lost unless a replacement regime is introduced before the end of the transitional period.

Coincidentally, however, the PCC has been drastically reformed so that its procedures now reflect the opposition processes common to the EPO, UK IPO and OHIM, processes in which all patent and trade mark attorneys are fully trained. The whole point of these reforms was to expand access to justice, improve legal services competition and to reduce cost, yet the

⁶ CIPA Higher Courts Qualification Regulations 2007 – originally the CIPA Higher Courts Qualification Regulations 2000

⁷ The scope and extent of the PCC's jurisdiction has been considered in *ALK Abello v Meridian* [2010] EWPC 014, *National Guild of Removers & Storers Ltd v Christopher Silveria* [2010] EWPC 015, *Minsterstone Ltd v Be Modern Ltd* [2002] FSR 53 and *McDonald v Graham* [1994] RPC 407.

⁸ Note 1 *supra*.

effect of the LSA would be to exclude patent and trade mark attorneys from the Court unless IPReg takes steps to preserve these rights.

In addition, all patent and trade mark attorneys are fully capable of handling appeals within UKIPO, so it follows that the right to handle such cases in the High Court should be maintained/extended.

Furthermore, in the summer of 2010, Nottingham Law School at Nottingham Trent ('NLS') provided CIPA with some thoughts on how litigation might be provided in the future. In the process NLS reviewed and compared the existing qualification scheme for patent attorney litigators with those of other authorised bodies and concluded that the existing scheme is linked to a level that is higher than that required for other professions acquiring similar rights (ITMA had already revised its scheme to account for NLS's conclusions in a similar exercise, and in addition had divided the rights into separate "conduct" and "audience" qualifications which can be taken separately).

Finally, it is desired that both patent and trade mark & design litigators should, if they wish, be able to qualify for a right of audience in the Higher Courts (known as Higher Rights, currently not available to IP attorneys but available to solicitors).

Following the review by NLS and discussions between IPReg, CIPA and ITMA, IPReg (on behalf of the PRB and the TRB) is proposing to revise and replace the existing litigation regulations for both patent attorneys and trade mark attorneys in order to achieve the following aims:

- 1) to account for the delegation of regulatory powers by CIPA and ITMA to PRB and TRB;
- 2) to grant, on registration, rights of audience/ to conduct litigation to patent attorneys/trade mark attorneys broadly in line with the previous statutory rights of patent attorneys;
- 3) to align the qualification regimes for patent and trade mark attorney litigators with those of other authorised bodies, and to harmonise the regimes between themselves as much as is possible and desirable; and
- 4) to provide for the grant of Higher Rights to suitably qualified attorneys.

Proposed new qualification regime

The proposed new regime envisages three levels of rights:

(i) Patents County Court & UKIPO Appeals (Litigation & Advocacy) Rights - granted by virtue of registration as an IP Attorney

It is proposed that these rights (limited by reference to subject matter) will be granted to all patent and trade mark attorneys currently on the registers. This would then entitle all registered attorneys to undertake field appropriate intellectual property litigation and advocacy within the PCC and also to handle appeals from the Patent Office to the High Court. To avoid consumers having to change their legal team in the event of an appeal it is

also proposed that these rights will also include conduct rights in further appeals from the High Court and the PCC to the Court of Appeal and the Supreme Court.

Going forward, IPReg is proposing that the qualification arrangements for both patent and trade mark attorneys will include specific training in litigation.⁹

(ii) Intellectual Property Litigation Certificates

Intellectual Property Litigation Certificates are intended to replace the existing Litigation Certificates issued by CIPA and ITMA. These will entitle attorneys to conduct all forms of field-appropriate IP litigation in both the High Court and the County Courts as well as conferring the right to appear as advocates in all such matters before the County Courts and in private interim applications in the High Court.

(iii) Intellectual Property Higher Courts Advocacy Certificates

Intellectual Property Higher Courts Advocacy Certificates would be awarded to holders of Intellectual Property Litigation Certificates who complete an advocacy course to confirm their ability to undertake Higher Court advocacy. As such, Intellectual Property Higher Courts Advocacy Certificates will be directly analogous with the solicitors' higher rights qualification, which enables solicitors to extend their existing rights of audience in the High Court to full High Court trials and appeals, after successfully completing an advocacy assessment. Completion of a recognised course such as the SRA Higher Rights Course would be sufficient.

Proposed new administration for the new regime

Under the proposed new regime, the granting of certificates will be a matter for the PRB or the TRB, with the removal of any certificate to be dealt with under IPReg codes of conduct. The existing CIPA Litigators Accrediting Board and the ITMA Litigation Accrediting Board would no longer be required. However, in order to accredit courses and ensure that the PRB and TRB have suitable expertise to assess the abilities of course providers, the PRB and TRB will have the ability to establish a Litigation Course Accreditation Panel including members external to IPReg to assess courses, as and when required.

Consultation

Prior to preparing a draft regulation, IPReg on behalf of the PRB and the TRB would like to canvas views on a number of issues as set out below. A draft regulation will then be prepared and further consultation will then be undertaken so that interested parties can comment on the wording of the draft regulation before it is finalised.

(i) Rights to conduct litigation in the PCC

IPReg is proposing to permit registered patent attorneys and registered trade mark attorneys to conduct litigation and appear in any field-appropriate matter before the PCC

⁹ This would be a new course. The content of such a course and whether such a course should be introduced is the subject of questions (2) - (4) in this consultation document

both within and without the special jurisdiction. Such rights could potentially cover any field-appropriate matter¹⁰ within the jurisdiction of the PCC.

(1) Do you agree with the proposal to permit all IP attorneys to conduct IP litigation and appear before the PCC in any field-appropriate matter within their competency? If not, why not?

(ii) Basic skills course for acquisition of litigation rights by new attorneys

At present, although IP rights and IP litigation form the background to much of the training and qualification of patent and trade mark attorneys, there is currently no formal requirement to undertake a specific litigation skills course in order to acquire the statutory rights which are awarded on qualification. It is proposed to make the future acquisition of such rights dependent upon completion of a basic litigation skills course. It is proposed that the outcomes of the course should be similar to those required of trainee solicitors undertaking the Legal Practice Course.¹¹

No decision has yet been taken as to whether such a mandatory course should be introduced and IPReg would welcome views on the following:

(2) For new entrants to the professions, should the award of litigation rights/a right of audience in the PCC and a right to conduct appeals from Patent Office decisions to the High Court require attendance at a basic litigation skills course? If not, why not?

(3) If such a course is introduced should it be obligatory to complete the course as part of the route to qualification as a patent/trade mark attorney? Alternatively should it be obligatory to undertake the course as part of an attorney's CPD within a certain number of years of qualifying?

(4) Are there any further factors regarding a basic litigation skills course that IPReg should consider?

¹⁰ See also section ix Definition of "intellectual property litigation" *infra*.

¹¹ At present a short 2-3 day course supplementing the current experience and training of patent and trade mark attorneys is under consideration. Outcomes would be that 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 *basic skills* in the presentation of cases before courts and tribunals;
- 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.

(iii) Rights to conduct appeals to the Court of Appeal and the Supreme Court

Currently, where a client has instructed an IP attorney¹² to undertake an appeal from a patent office decision to the High Court, to take an appeal from the Designs Registry to the Registered Designs Tribunal or to bring litigation within the special jurisdiction of the PCC, and that case is then appealed further, unless the attorney in question holds a litigator's certificate that client is forced to change legal representation. This may involve changing the firm instructed, if the existing firm does not have a patent attorney litigator or other authorised litigator.

However, appeals are generally more straightforward to conduct than first instance proceedings and furthermore both patent and trade mark attorneys regularly handle appeals in IP Offices. In effect, the only substantive differences are in procedure. In order for an appeal to proceed, a barrister or other Higher Courts advocate needs to be instructed, if not already involved with the case at first instance. However, if a litigant is forced to change the main representative at this stage, then there is a risk of further significant costs being incurred. The new representative is unlikely, within the short time available, to acquire the knowledge wholly to replace the original representative. Furthermore, especially on an IPO appeal the IP Attorney will have the greatest grasp of the case. So the original IP attorney is likely to remain engaged, being the person with the best knowledge of the case. Given the change in the procedure in the PCC to make it a less costly forum, more accessible to small and medium size enterprises, there is a question as to whether that potential increase of cost on appeal can be justified.

It therefore appears to IPReg that there could be real benefit to a litigant in retaining its existing representative and not needing to instruct afresh just for an appeal. So, IPReg is proposing that the rights to conduct appeals from these types of proceedings should be included in the basic litigation rights granted to IP Attorneys on qualification. This would then enable all IP attorneys to conduct appeals to the Court of Appeal and the Supreme Court. Such appeals would be conducted with the assistance of counsel in courts where an attorney lacked a right of audience.¹³

(5) Do you agree with the proposal to extend the rights awarded to IP attorneys on qualification to include the right to conduct appeals at all levels?

(6) Are there any other rights which should be included?

(iv) Amendment of requirements for Litigation Certificates

In their report NLS noted the existence of barriers to qualification which are currently limiting the numbers of qualified patent attorney and trade mark attorney litigators, in particular, the requirement that practitioners complete six months "flying hours" before

¹² i.e. a registered patent or trade mark attorney

¹³ Rights of audience for patent and trade mark attorneys in the Higher Courts are discussed in section (v) *Introduction of Intellectual Property Higher Courts Advocacy Certificates* *infra*.

qualification as a litigator¹⁴. NLS note that the “flying hours” requirement appears to have been derived from the rather restrictive 1994 regulations for Higher Court advocates¹⁵ that were relaxed in 2000 and appears out of step given that other regulators such as the SRA have an outcomes-based assessment for HCAs.

In addition to the above, the existing patent attorney litigator regulations (but not the existing trade mark attorney litigator regulations) limit the grant of litigator’s certificates to patent attorneys who have been on the patent attorney register for at least 3 years.

IPReg considers that these restrictions unduly limit the numbers of patent attorney and trade mark attorney litigators and believe that an outcomes-based assessment would be a more appropriate way to determine whether or not a litigator’s certificate should be issued. Further, IPReg considers that the appropriate standard for such an assessment should be closer to the standard required of a newly qualified solicitor acquiring similar rights, but tailored to intellectual property issues, in the interests of maintaining consistency across the legal professions.

IPReg is therefore proposing to remove the current requirement for attorneys to undertake a specified period of litigation experience or “flying hours” in addition to the simulated experience obtained on the academic course before being awarded a certificate and move to an outcomes based system.

Before making a final decision, IPReg would welcome views on the following:

(7) Do you agree that the qualification regime for patent attorneys should be harmonised with that of trade mark attorneys, so that qualification as a patent attorney litigator should be open to all registered patent attorneys and not just attorneys who have been on the patent attorney register for at least 3 years? If not, why not?

(8) Do you agree that IPReg should move to an outcomes-based assessment scheme similar to that adopted by the SRA where qualification is based on completion of an assessment and not dependent upon completion of “flying hours”? If not, why not?

(9) If IPReg moves to an outcomes-based assessment scheme, do you agree that the level required to pass an assessment should be of a similar standard to that of a newly qualified solicitor acquiring similar rights? If not, what would be an appropriate level of assessment? And why?

(10) Are there any other issues which arise from IPReg’s proposal to amend the qualification regime for Litigation Certificates?

¹⁴ Although the NLS paper only made reference to the “flying hours” requirements for patent attorney litigators, the trade mark attorney litigator regulations include an identical provision and therefore the reasoning applies equally to both patent attorneys and trade mark attorneys.

¹⁵ This may be an error. The “flying hours” were probably derived from the then current requirement for a trainee solicitor to spend 6 months of the training contract in a “contentious seat”. In any event, that requirement has also been relaxed.

(v) Introduction of Intellectual Property Higher Courts Advocacy Certificates

IPReg is proposing to introduce a scheme to enable appropriately qualified patent and trade mark attorneys to acquire rights of audience in the Higher Courts. Such a scheme would be similar to that established for solicitors acquiring rights of audience in that the acquisition of rights is linked to an advocacy assessment which will be set at the level required of solicitor advocates.

In order to be eligible for an Intellectual Property Higher Courts Advocacy Certificate, patent and trade mark attorneys would first have to obtain an Intellectual Property Litigation Certificate. Higher rights could then be obtained by completing an accredited advocacy course and passing an advocacy assessment. Outcomes required of higher court advocates under the scheme would mirror those under the existing SRA scheme for solicitor advocates.

(11) Do you agree that IPReg should establish a qualification scheme to enable appropriately qualified patent attorneys and trade mark attorneys to acquire rights of audience in the High Court?

(12) Do you agree that the qualification scheme for acquiring higher rights of audience should be set at the standard of the SRA scheme enabling solicitors to extend their rights in the Higher Courts? If not, what alternative scheme should be established?

(13) Are there any other issues which arise from IPReg's proposal to establish a scheme to enable appropriately qualified patent and trade mark attorneys to acquire higher rights of audience?

(vi) Membership of CIPA and ITMA

Prior to the coming into force of the Legal Services Act, all registered patent attorneys enjoyed the rights granted by section 102A of the Patents Act 1977 and section 292 of the Copyright, Designs and Patents Act 1988. However, any rights to be a litigator under the CIPA Higher Courts Qualifications Regulations 2007 or the ITMA Trade Mark Litigator and Trade Mark Advocate Certificate Regulations 2009 requires membership of the respective body.

IPReg wishes to consult on whether membership of either CIPA or ITMA should be a prerequisite to the grant of rights to carry out reserved legal activities and/or to the retention of those rights once granted.

At present IPReg is minded to make the future acquisition of any litigator or advocacy right available to all registered patent and trade mark attorneys independent of their membership of CIPA or ITMA. This will also mean that a person who ceases to be a member of CIPA or ITMA will not lose any litigation right already acquired.

(14) Do you agree that the grant and maintenance of Litigator or Advocacy Certificates should independent from membership of CIPA or ITMA? If not, please explain why.

(vii) Transitional Provisions*Existing Registered Attorneys*

It is proposed that patent and trade mark attorneys on the register when any new regulation comes into force will be granted field-appropriate rights to conduct and advocate in IP Litigation in the PCC and to conduct and appear in High Court appeals from decisions of the Patent Office.

Certified Patent Litigators and Trade Mark & Design Advocates

It is proposed that Intellectual Property Litigation Certificates will be issued to patent attorneys who already hold CIPA Patent Attorney Litigation Certificates and to trade mark attorneys who hold ITMA Trade Mark and Design Advocate Certificates thereby enabling them to maintain their current rights.

Part qualified patent litigators and trade mark and design litigators

For those attorneys who have begun or completed the existing litigation courses, IPReg is liaising with NLS to put in place a scheme which would enable IPReg, under guidance from NLS, to equate completion of all or part of the existing courses with completion of corresponding portions of a course approved under this regulation. Such an approach would enable those attorneys who have attended the existing NLS courses but who have not yet applied for a litigator's certificate because, for example, they have not completed the academic thesis required as part of the existing patent attorney litigator's course or have not yet completed the currently required number of "flying hours" to apply for certificates under the new regime.

Similarly trade mark attorney litigators who have not acquired Trade Mark and Design Advocate certificates, would be eligible to acquire an Intellectual Property Litigation Certificate which extended their litigation rights to include rights to undertake chambers advocacy upon completion of an advocacy course and assessment. Such an advocacy course would be identical to the current qualification for trade mark attorney advocates.

(15) Do you agree that the approach proposed in this paper is the right approach to enable qualified and partially qualified patent and trade mark attorney litigators to apply for certificates under the new regulation? If not, what alternative approach should IPReg consider?

(viii) Continuing Professional Development

All registered patent attorneys and all registered trade mark attorneys are required each year to undertake 16 hours of CPD relevant to their practice.¹⁶ For certified patent and trade mark attorney litigators the level of required CPD rises to 19 hours, at least 6 hours of which must be relevant to litigation. In contrast at present although patent attorneys and trade

¹⁶ IPREG Continuing Professional Development Regulations 2009 available for download from http://www.ipreg.org.uk/document_file/file/20090930_CPD_Regulations.pdf

mark attorneys are required to undertake CPD, there is no requirement for the CPD to be related to litigation matters. Rather attorneys are given discretion to undertake CPD most relevant to their practice. At present, IPReg is minded to maintain the current approaches to CPD.

(16) Do you agree with this graduated approach to CPD? If not, how should the CPD levels be amended and why?

(ix) Definition of “intellectual property litigation”

In the existing Patent Attorney Litigator Regulations, the rights of patent attorney litigators are expressly limited to “intellectual property litigation” which is defined as “any matter relating to the protection of any invention, design, technical information, or trade mark, or similar rights, or as to any matter involving passing-off or any matter ancillary thereto”.¹⁷

Similarly the Trade Mark and Design Attorney litigator regulations¹⁸ limit the rights of a trade mark and design attorney litigators to matters “relating to the protection of any trade mark or design or as to any matter involving passing off, or to the Olympic Symbol etc. (Protection) Act, 1995, or to the Olympic Association Right (Infringement Proceedings) Regulations 1995, or to the right to an injunction to restrain the unauthorised use of Royal Arms etc. conferred by Section 99(4) of the Trade Marks Act 1994” as well as “any claim for infringement of literary or artistic copyright in the Trade Mark itself” or “for breach of contract insofar as it relates to the sale of trade mark goods or the provision of trade mark services, the subject of a licence”.

The definition in the Patent Attorney Litigator Regulations has proved problematic. In *Atrium Medical v. DSB Holding SA*¹⁹ Lewison J. was asked to rule on whether a patent attorney litigator could represent a claimant in a dispute relating to contract concerning the disposal of patents and know how. As noted by Lewison J. a challenge to the scope of a right to undertake litigation has many knock-on effects including whether or not communications are privileged, the recoverability of costs and also potential issues with professional indemnity insurance.²⁰ Doubts about the scope of rights therefore have a significant chilling effect on whether attorneys choose to exercise their rights.

In view of the above, IPReg would welcome views on the drafting of an appropriate definition of intellectual property litigation which ensures that attorneys’ activities are restricted to fields appropriate to their qualification but which minimises the chances of satellite litigation on the scope of such rights .

¹⁷ CIPA Higher Courts Qualification Regulations 2007 sections 3 & 5. This definition of “intellectual property litigation” mirrors the wording of section 280(2) of the Copyright, Designs and Patents Act 1988 which defines the scope of patent attorney privilege.

¹⁸ ITMA Trade Mark Litigator and Trade Mark Advocate Certificate Regulations 2009 Section 3

¹⁹ 2011 EWHC 74 (Pat)

²⁰ *Ibid.* Paragraph 7

(17) Do you have any suggestions as to how IPReg should define the scope of “intellectual property litigation” to achieve these aims?

Responding to the consultation

Any person wishing to make any comment on questions set out in this consultation document or on the proposed scheme in general is invited to do so by e-mail to the Chief Executive at:

ann.wright@ipreg.org.uk

This consultation will close on **17 October 2011** after which the PRB and the TRB will consider the responses and prepare a draft regulation and then issue a further consultation so that interested parties can comment on the wording of the draft regulation before it is finalised and submitted to the Legal Services Board for approval.

Individuals & organisations consulted:

Approved regulators & regulatory bodies:

Association of Costs Lawyers
Bar Council
BSB
Cost Lawyer Standards Board
Councils for Licensed Conveyancers
ILEX
ILEX Professional Board
Master of the Faculties
Law Society
Legal Ombudsman
Ministry of Justice
Office of Fair Trading
SRA

Educational institutions:

Bournemouth University
Brunel University
Nottingham Law School
Queen Mary, University of London
University of Manchester

IP Barristers Chambers:

3 New Square
8 New Square
11 South Square
Hogarth Chambers

IP Judges:

HH Colin Birss QC
Arnold J
Floyd J
Mann J
Patten J
Warren J

Registered & regulated persons:

All registered patent attorneys
All registered trade mark attorneys
All entities entered onto the patent or trade mark attorney registers

Representative organisations:

AIPPI

Anti-Counterfeiting Group

British Brands Group

CBI

CIPA

Design Council

FICPI UK

ITMA

LES

Ideas 21

Intellectual Property Awareness Network

IP Bar Association

IP Federation

Intellectual Property Lawyers Association

Institute of Patentees and Inventors

UNION