

IPReg Consultation on Litigation Rights for Patent and Trade Mark Attorneys

Introduction

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions, here and elsewhere.

The consultation

At a time when repeated government reviews have stressed the importance of intellectual property to the UK economy and the availability of cost effective court procedures to facilitate enforcement, the consumer faces 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 to the current regulations, the 2010 reforms to the Patent County Court will be substantially frustrated.

IPReg is, therefore, proposing to issue a revised qualification regime for patent attorney and trade mark attorney litigators to facilitate the grant of relevant rights to registered patent and trade mark attorneys.

Prior to preparing a draft regulation, IPReg on behalf of the PRB and the TRB is canvassing views on a number of issues. 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.

The [consultation](#) is open until 17 October 2011.

IP Federation response

The IP Federation agrees with all the proposals made in the consultation paper and has no further comments to make on these. Thus, our response to the specific questions is as follows.

- (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?

Yes, we agree with the proposal.

- (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?

Yes, the award of litigation rights, a right of audience in the PCC and a right to conduct appeals from decisions to the High Court should require attendance at a basic litigation skills course.

- (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?

It should 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?

We do not wish to raise any further factors.

- (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?

Yes, we agree with the proposal.

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

We do not wish to raise any other rights which should be included.

- (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?

Yes, we agree that the qualification regime for patent attorneys should be harmonised with that of trade mark attorneys.

- (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?

Yes, we agree that IPReg should move to an outcomes-based assessment scheme.

- (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?

Yes, we 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.

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

We do not wish to raise any other issues.

- (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?

Yes, we agree IPReg should establish a qualification scheme.

- (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?

Yes, we agree that the scheme should be set at the standard of the SRA scheme enabling solicitors to extend their rights in the Higher Courts.

- (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?

We do not wish to raise any other issues.

- (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.

Yes, we agree that the grant and maintenance of Litigator or Advocacy Certificates should be independent from membership of CIPA or ITMA.

- (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?

Yes, we agree with the approach proposed in the paper.

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

Yes, we agree with this graduated approach.

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

We do not have any suggestions at this time.

Conclusion

The members of the IP Federation support IPReg in its proposals to issue a revised qualification regime for patent attorney and trade mark attorney litigators to facilitate the grant of relevant rights to registered patent and trade mark attorneys.

IP Federation
17 October 2011

IP Federation members 2011

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Delphi Corp.
Dyson Technology Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Nucletron Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
QinetiQ Ltd
Rolls-Royce plc
Shell International Ltd
Smith & Nephew
Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc