

TMPDF

Trade Marks Patents and Designs Federation

3 June 2004

Mrs Susan Samuel
Review of the Regulatory Framework for Legal Services
2nd Floor Selbourne House
54-60 Victoria Street
LONDON SW1E 6QW

Dear Mrs Samuel,

Re: Response to the “Clementi Review” of Legal Services, March 2004

1. TMPDF represents most of the major users and generators of intellectual property in the United Kingdom. Its members include numerous UK “blue chips”, smaller companies that are IP-intensive, and the UK subsidiaries of large multinationals. Its members therefore have an interest in the quality and cost of legal services relating to intellectual property, whether these are provided by private practice or “in-house”.
2. This response is written following the discussion of the TMPDF Council on 14 May 2004.
3. TMPDF would welcome increased flexibility of provision of legal services relating to intellectual property. In particular, it would welcome mixed practices of solicitors (or solicitors and barristers), patent attorneys, and trade mark attorneys.¹
4. However, we believe that mixed practices will deliver full advantage only if the protection of privilege² enjoyed by the clients of patent and trade mark attorneys is broadened. Moreover, we regard such a broadening of protection of privilege as desirable in itself, even if such mixed practices do not come into existence.
5. While solicitors’ clients enjoy relatively generous protection, patent attorneys’ clients enjoy the narrower protection set out in Section 280 of the Copyright, Designs, and Patents Act 1988. Trade mark attorneys’ clients enjoy the still narrower protection set out in Section 87 of the Trade Marks Act 1994.
6. Patent and trade mark attorneys are trained in, and are expected by their clients to advise on, various aspects of the law not covered or not clearly covered by Sections 280 and 87 referred to above, in particular -

¹ Registered patent agents and registered trade mark agents are permitted to describe themselves as “patent attorneys” and “trade mark attorneys” respectively, and these shorter descriptions are used here.

² The discussion of privilege that follows refers to the UK Courts and competition authorities. The position with respect to EU Courts and competition authorities is different, in particular with respect to in-house legal advisers.

- (a) copyright law and the law of the rarer intellectual property rights such as database extraction rights,
- (b) the law relating to ownership of intellectual property rights,
- (c) the criminal law relating to intellectual property infringement,
- (d) the law of confidence, and
- (e) contract law and competition law (though advice would normally be sought on these only in relation to a transaction having an intellectual property component).

7. When a private practice or in-house patent or trade mark attorney receives a request for advice in such areas, it does happen that he involves a solicitor purely so as to ensure that the advice given is privileged, *i.e.* without any improvement in the quality of the advice. This increases cost for the client (or employer, in the in-house case) because the solicitor involved will feel professionally obliged to check the work that has been done by the patent or trade mark attorney. This increase in cost would still occur in mixed practices, if these were allowed to exist but the law on privilege were not changed.

8. In conclusion, we believe it would be in the interests of consumers of legal services (such as our members) -

(a) if the clients of patent and trade mark attorneys enjoyed the same protection of privilege as those of solicitors, without prejudice of course to the professional obligation of patent and trade mark attorneys only to advise on matters where they are adequately trained and experienced, and

(b) if mixed professional practices in the IP area were permitted.

(a) would be worth implementing even if (b) were not, and the value of implementing (b) would be increased by implementing (a).

9. I hope this is helpful.

Yours sincerely,

Sheila Draper
Secretary

