

## 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:

**“ABS”** means a licensable body as defined in section 72 of the Legal Services Act 2007;

**“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 or section 27A of the Registered Designs Act 1949;

**“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 whether or not an ABS;

**“Patent Attorney Register”** means (together) in respect of registered persons other than ABS, the Register kept under section 275 of the Copyright Designs and Patents Act 1988 as amended, and in respect of ABS, is part of IPReg’s Register of licensed bodies for the purpose of section 87 of the 2007 Act;

**“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 whether or not an ABS;

**“Trade Mark Attorney Register”** means (together) in respect of registered persons other than ABS, the Register kept under section 83 of the Trade Marks Act 1994 as amended, and in respect of ABS, is part of IPReg’s Register of licensed bodies for the purpose of section 87 of the 2007 Act;

**“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

2.1 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 a 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; and
  - b) the High Court in appeals proceedings mentioned in paragraph (i) but not applications for judicial review; and
- 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;
- ii) 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:
- a) 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 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 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 County Court;

- apply relevant rules of evidence across a range of contexts in High Court and 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 2****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.