

UK AND EUROPEAN PATENT LITIGATION RIGHTS

1. Introduction

This guidance is intended for UK patent attorneys and trainees who wish to be able to represent clients before the Unified Patent Court. It is intended to deal with the most common circumstances, not to be exhaustive. The UPC rules are set out in the Unified Patent Court (UPC) Agreement and Rules of Procedure, and in the Draft Decision of the Administrative Committee.¹ This guidance may not be up to date, and so you should check for developments on the UPC website.² The UK rules are set out in The Rights to Conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules 2012.³

2. What rights are required where?

If you are qualified as a lawyer,⁴ generally you have litigation and/or advocacy rights in all fora. Otherwise:

- To act before the UK IPO, no special qualifications are required. Any patent attorney, or anyone else, may do so.
- To litigate or act as advocate before the Intellectual Property Enterprise Court or a County Court,⁵ or to appeal from the IPO to the High Court, you need an “**Intellectual Property Litigation Certificate**”⁶.
 - Prior to the commencement of the relevant part of the Legal Services Act 2007, all UK patent attorneys had these rights. All UK patent attorneys who entered the UK Register before 31st December 2012 therefore hold an Intellectual Property Litigation Certificate (though no paper certificates have to date been issued).
 - Patent attorneys who enter the UK Register on or after 1st January 2013 are expected to complete a Basic Litigation Skills Course by the end of the third year of going onto the Register as part of their Continuing Professional Development. Basic Litigation Skills courses⁷ enable patent attorneys to qualify in a short period of time.

¹ Draft Rules on the European Patent Litigation Certificate, *etc.* The Administrative Committee is not yet in existence but is expected to adopt the draft rules which have been agreed by the Preparatory Committee.

² At <http://www.unified-patent-court.org>

³ Available on IPReg's website, www.ipreg.org.uk

⁴ Which for these purposes means a solicitor or barrister, or a Scottish solicitor or advocate, or their equivalents elsewhere in the EU

⁵ In Part 63 matters

⁶ Or a Higher Courts Litigation Certificate. See paragraph 2.2 of the IPReg Litigator rules for a full list of the rights which go with each of these Certificates

⁷ Available through CIPA, Nottingham Law School, CPD Training (UK) and, potentially, others

- To litigate in intellectual property matters before other civil courts of England and Wales, you need a “**Higher Courts Litigation Certificate**”. Such certificates are issued by IPReg.⁸ Nottingham Law School provides a course for those wishing to have these rights.
- To act as advocate in intellectual property matters before other civil courts, you need a “**Higher Courts Advocacy Certificate**”.⁹
- If not a lawyer, to act before the European Patent Office, you must be a European Patent Attorney (“EPA”). This applies to all proceedings before the EPO, including those involving Unitary Patents in the future.
- To assist a lawyer before the UPC (including speaking under supervision), you can be either an EPA or a UK Registered Patent Attorney (or equivalent other national patent attorney practising in a contracting member state).¹⁰
- To litigate or act as an advocate before the UPC independently of a lawyer, you need to be an EPA on a list, entry to which requires an additional qualification – this will usually be a European Patent Litigation Certificate (“EPLC”).¹¹
- These requirements apply to all types of cases before the UPC, both at first instance and on appeal, whether before a Local Division, a Regional Division or the Central Division and whether for revocation of a patent or in an infringement or declaration of non-infringement action.

3. Routes for entry on the list of entitled representatives, authorised to represent before the UPC

During a one year transitional period (which has not yet started to run), an EPA can apply to go on the list if they:

- Possess an Intellectual Property Litigation Certificate or a Higher Courts Litigation Certificate or Higher Courts Advocacy Certificate.¹²
- Possess either the **Certificate or the MSc in Intellectual Property** from Queen Mary, University of London.¹³
- Possess the Nottingham Law School course “**Intellectual Property Litigation and Advocacy**”.¹⁴
- Have taken 3 patent infringement cases to court (without a lawyer) in the 5 years before applying.¹⁵

⁸ Their predecessors, issued by CIPA and ITMA, are passported into Higher Courts Litigation Certificates

⁹ These are available since 2013 through various course providers.

¹⁰ UPC Agreement, Article 48(4); Rules of Procedure 292 together with 287(6) & (7)

¹¹ UPC Agreement, Article 48(2)

¹² EPLC Rules, 12(a)(vi), (vii), (viii)

¹³ EPLC Rules, 12(a)(v)

¹⁴ EPLC Rules, 12(a)(iv)

¹⁵ EPLC Rules, 12(b)

At any time, any EPA can apply to go on the list if they:

- **Possess a law degree** (a Bachelor's or Master's degree, i.e. LLB or LLM recognised in an EU State).¹⁶ The degree does not have to relate specifically to IP, or to litigation.
- Pass **an accredited EPLC course**. This will involve students in a minimum of 120 study hours, and written and oral examinations.¹⁷ No such courses currently exist. It is likely that CEIPI in Strasbourg, and at least one UK institution, will provide such a course after the end of the transitional period.

4. What should you do?

Unless you possess a law degree, you will prefer to qualify under the transitional arrangements. Thus, if you are already an EPA (or will become one by the end of the transitional period), you will additionally need one of the following qualifications, and must apply to go on the list within the transitional period:

- If you are a UK Registered Patent Attorney or UK Registered Trade Mark Attorney on the Register before 31st December 2012, you already have the necessary qualifications to apply to go on the list. IPReg together with CIPA will provide you with any necessary supporting documents. We are aware that most patent attorneys do not possess a paper certificate demonstrating their litigation qualifications, but we will ensure that acceptable evidence is available in the necessary form.
- If you are a UK Registered Trade Mark Attorney, who qualified via the Nottingham course in 2013 or afterwards, then again you already have the necessary transitional qualifications.
- If you passed the Queen Mary Certificate or MSc in Intellectual Property, or the Nottingham Law School Intellectual Property Litigation and Advocacy course, then again you already have the necessary transitional qualifications.
- If you are a UK Registered Patent Attorney who went on the Register after 1st January 2013 and have already completed a Basic Litigation Skills course (or obtained a Higher Courts Litigation Certificate, or a Higher Courts Advocacy Certificate), then again you already have the necessary transitional qualifications.
- If you are a UK Registered Patent Attorney who qualified in or after 2013 and you do **not** yet hold an Intellectual Property Litigation Certificate, if you obtain it before the end of the transitional period, you can use it within that period to apply to go on the list. You will need one within three years of qualifying in any event, in order to stay on the UK Register. You may wish to consider enrolling on the next available Basic Litigation Skills course.

¹⁶ Or an equivalent qualification - perhaps a solicitor or barrister qualifying examination for example: EPLC Rules, 11

¹⁷ EPLC Rules, 4

- If you are a UK Registered Patent Attorney and cannot otherwise qualify, then you may qualify during the transitional period by experience¹⁸ if you have represented (without the assistance of a lawyer) in three patent infringement actions, initiated before a national court within the five years preceding your application to go on the list.

If you are not yet an EPA, you should aim to become one before the end of the transitional period if possible.

- If you are a trainee who is likely to become an EPA before the end of the transitional period, you can qualify to go on the list within the transitional period if, within that period, you either
 - take the Queen Mary Certificate Course, or
 - take the one year Nottingham Law School course “Intellectual Property Litigation and Advocacy” (or any of other specified courses¹⁹), or
 - qualify as a UK patent attorney and complete a Basic Skills Course, or as a UK trade mark attorney.

If you wish to go on to the list and these transitional arrangements do not apply to you, then you may qualify at any time by becoming an EPA, and either

- obtaining a law degree or equivalent; or
- (in future) passing an EPLC Course and obtaining a Certificate.

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¹⁸ EPLC Rules, 12(b)

¹⁹ Listed in EPLC Rules, 12(a)