

**ITMA TRADE MARK LITIGATOR AND TRADE MARK ADVOCATE
CERTIFICATE REGULATIONS 2009**

CONTENTS

1	Introduction
2	Trade Mark Litigator and Advocate Certificates
3	Rights of Trade Mark Litigators
4	Rights of Trade Mark Advocates
5	Existing Entitlement To Certification
6	Grant Of Trade Mark Litigator Certificates
7	Grant Of Trade Mark Advocate Certificates
8	Syllabuses And The Validation Of Litigation And Advocacy Courses
9	Admission To The Trade Mark Litigator And Trade Mark Advocate Courses
10	Litigation Accrediting Board
11	Appeals From LAB Decisions
Schedule 1	Trade Mark Litigator Certificates Relevant Experience Guidelines
Schedule 2	Trade Mark Advocate Certificates Relevant Experience Guidelines
Schedule 3	Litigation and Advocacy Course Validation Guidelines
Schedule 4	Rules of Professional Conduct and Disciplinary Procedure for ITMA Members holding and acting within the scope of Litigator and/or Advocate Certificates

1. INTRODUCTION

- 1.1 The Institute of Trade Mark Attorneys (ITMA) makes these regulations as an authorised body under Schedule 4 of the Courts and Legal Services Act 1990.

2. TRADE MARK LITIGATOR AND ADVOCATE CERTIFICATES

2.1 Trade Mark Litigator Certificate:

A Litigator Certificate means a certificate granted by ITMA in accordance with paragraph 4 below to Fellows or Ordinary Members of ITMA conferring the rights set out in paragraph 3.1 below.

2.2 Trade Mark Advocate Certificate:

A Trade Mark Advocate Certificate means a certificate granted by ITMA in accordance with paragraph 5 below to Fellows or Ordinary Members of ITMA conferring the rights set out in paragraphs 3.1 and 4.1 below.

3. RIGHTS OF TRADE MARK LITIGATORS

- 3.1 The following rights are granted by ITMA to holders of Trade Mark Litigator Certificates without prejudice to any existing rights of ITMA Members namely, subject to the jurisdiction of the courts concerned, including such courts as are designated Community Trade Mark and/or Community Design Courts, the right to conduct:

- (a) litigation in the Chancery Division of the High Court, including the Patents Court, and in the County Court, including the Patents County Court; and
- (b) appeals from the Comptroller General of Patents Designs and Trade Marks, the Patents County Court, the County Court, and the Chancery Division of the High Court,

in respect of any matter 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:

and any claim

- c) for infringement of literary or artistic copyright in the Trade Mark itself: and

- d) 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 (Trade Mark & Design Litigation)

3.2 All such litigation aforesaid is hereinafter referred to as Trade Mark & Design Litigation.

4. RIGHTS OF TRADE MARK ADVOCATES

4.1 The following rights are granted by ITMA acting as an Authorised Body to holders of Trade Mark Advocate Certificates without prejudice to any existing rights of ITMA Members, namely;

- (a) The rights granted by ITMA to persons entitled to hold Trade Mark Litigator Certificates;
- (b) subject to the jurisdiction of the courts and tribunal concerned, including such courts as are or may be designated Community Trade Mark and/or Community Design Courts, the right of audience:
 - (i) in hearings in the County Court, including the Patents County Court, in Trade Mark & Design Litigation;
 - (ii) in hearings before the Appeal Tribunal constituted by the Registered Designs Act 1949 (as amended from time to time); and
 - (iii) in hearings in private on interim matters in the course of Trade Mark & Design Litigation.

5. EXISTING ENTITLEMENT TO CERTIFICATION

5.1 Persons entitled under the Trade Mark & Design Litigator Regulations 2005 to hold Trade Mark and Design Litigator certificates at the date these Regulations come into force are deemed to be entitled to hold Trade Mark Advocate Certificates.

6. GRANT OF TRADE MARK LITIGATOR CERTIFICATES

6.1 Trade Mark & Design Litigator Certificates will, unless refused for reasons given in writing, be granted to applicants who are on the Register of Trade Mark Attorneys and are Fellows or Ordinary Members of ITMA and have agreed in writing to be bound by the Rules of Professional Conduct and Disciplinary Procedure for ITMA Members holding and acting within the scope of Litigator and/or Advocate Certificates contained in Schedule 4 and who either:

- (a) have successfully undertaken a Litigation Conduct Course validated by ITMA or an equivalent course offered by any other Authorised Body (a “Qualifying Litigation Course”) and have Relevant Experience as described in Schedule 1;

OR

- (c) are either a solicitor or barrister qualified to practice before the Courts of England and Wales; or
- (d) were a solicitor or a barrister qualified in England and Wales having been removed from the roll of solicitors or disbarred at their own request.

7. GRANT OF TRADE MARK ADVOCATE CERTIFICATES

7.1 Trade Mark Advocate Certificates will, unless refused for reasons given in writing be granted to applicants who are on the Register of Trade Mark Attorneys and are Fellows or Ordinary Members of ITMA and have agreed in writing to be bound by the Rules of Professional Conduct and Disciplinary Procedure for ITMA Members holding and acting within the scope of Litigator and/or Advocate Certificates contained in Schedule 4;:

And:

- (a) Have successfully undertaken a Qualifying Litigation Course

and who either

- (b) Have successfully undertaken an Advocacy Course validated by ITMA or an equivalent course offered by any other Authorised Body and have Relevant Experience. If the candidate has not been certified as a Trade Mark Litigator the Relevant Experience shall be as described in Schedules 1 and 2 (which Experience can be gained concurrently). If the Candidate is a Trade Mark Litigator the Relevant Experience shall be as described in Schedule 2.

OR

- (c) are either a solicitor or barrister qualified to practice before the Courts of England and Wales; or
- (d) were a solicitor or a barrister qualified in England and Wales having been removed from the role of solicitors or disbarred at their own request.

8. SYLLABUSES AND THE VALIDATION OF LITIGATION AND ADVOCACY COURSES

- 8.1 ITMA shall require that the syllabii of Litigation and Advocacy courses shall cover at least the following areas of Trade Mark & Design Litigation:

Litigation Conduct Course

- *Procedure*
 - Civil Procedure Rules
 - Pleadings and amendments
 - Summary Judgment
 - Interim Remedies
 - Disclosure
 - Expert Evidence
 - Injunctive relief
 - Security for costs

- *Skills base*
 - Case planning
 - Client skills and client management
 - Case management and preparation
 - Costing/budgeting and estimation
 - letter and advice skills Advocacy (written and oral)
 - Negotiation skills
 - Interviewing skills
 - Skeleton Arguments
 - Statement of Issues
 - Settlement Agreements and drafting
 - Basic Tribunal Advocacy and litigation skills (appropriate to proceedings before UKIPO, OHIM and the Designs Tribunal)
 - Professional Conduct/Ethics
 - Project Management and Risk Assessment

Advocacy Course

- Case Preparation including Trial Strategy Plans
- Interim Applications
- Evidential and Legal Submissions
- Opening Speeches
- Examination in Chief
- Cross-examination
- Re-examination
- Closing Speeches
- Experts
- Professional Conduct/Ethics

ITMA may prescribe a syllabus for either course or may publish exemplary syllabuses.

- 8.2 Institutions or bodies wishing to teach any course validated by ITMA shall submit, or may be invited to submit applications to ITMA.
- 8.3 ITMA as appropriate 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 in the High court and on appeal within the scope of the Certificate for which teaching is given. ITMA shall have regard to the Validation Guidelines set out in Schedule 3 to these Regulations.
- 8.4 ITMA shall give a decision in writing whether or not the relevant course has been validated.
- 8.5 ITMA shall require an institution teaching a validated course to provide annual reports concerning the operation of the course in sufficient detail to show that the required standards are being met. ITMA shall have power on reasonable notice to withdraw its validation in the event of any serious shortcomings which are not remedied to their satisfaction.

9. ADMISSION TO THE TRADE MARK LITIGATOR AND TRADE MARK ADVOCATE COURSES

- 9.1 To be admitted to these courses candidates must:
- (a) be a Fellow or Ordinary Member of ITMA; or
 - (b) be a Student Member of ITMA and have passed or be deemed to have passed such qualifying examinations for admission as an Ordinary Member of ITMA as ITMA may prescribe.

10. LITIGATION ACCREDITING BOARD

- 10.1 ITMA shall establish a Litigation Accrediting Board (LAB) as a committee of ITMA under Article 63 of ITMA's Articles of Association.
- 10.2 The duties of the LAB will be to act on behalf of ITMA:
- (a) in the validation and monitoring of courses;
 - (b) in the consideration of and, if deemed necessary, alterations to the syllabii; and
 - (c) in granting, refusing to grant and revoking Certificates.

- 10.3 The LAB's decisions shall be in writing and, where it decides not to validate a litigation course or advocacy course or to refuse or revoke a litigator certificate, it shall provide its reasons in writing.
- 10.4 The members of the LAB shall number no more than 7 and no less than 5, shall be appointed by ITMA. The Committee shall include at least 2 Members of ITMA holding Litigator or Advocacy Certificates.
- 10.4 The LAB shall make an annual report to ITMA concerning the applications received for accreditation and those approved, and the applications for Trade Mark Litigator/Advocate Certificates received and granted. The report shall include such other matters as appear appropriate to the LAB.

11. APPEALS FROM LAB DECISIONS

Any person who is aggrieved by a decision of the LAB on behalf of ITMA under these regulations may:

- (a) within one month of receiving notification of the decision ask for the decision to be reviewed; the LAB 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, appeal to an independent person or body of persons appointed by ITMA, agreeable to the parties, in the absence of agreement determined in accordance with the Arbitration Act 1996 as may be amended or replaced from time to time, which person or body may:
 - (i) affirm the decision of ITMA: or
 - (ii) give directions as to how ITMA should exercise its functions under these regulations including making a direction that ITMA should validate a litigation course or grant the aggrieved person a Certificate or refrain from revoking a Certificate.

SCHEDULE 1

TRADE MARK LITIGATOR CERTIFICATES RELEVANT EXPERIENCE GUIDELINES

Applicants must demonstrate that they have acquired the basic skills necessary to enable them to handle contentious matters (“Relevant Experience”). These skills will require regular exposure to contentious matters over a period of at least 6 months, although whether the experience is in fact sufficient will be assessed on a case-by-case basis. Candidates who have attended qualifying courses validated by other Authorised Bodies may have to demonstrate greater experience showing an awareness of issues specific to Trade Mark & Design Litigation.

This experience can be gained by directly handling the work, by assisting others in the work or by proper observation of experienced practitioners.

Candidates should have experience that enables them to be competent in the conduct of contentious matters and to recognise where the matter is outside their competency.

The following activities are examples of experience types which may be taken into account:

- Taking client instructions and identifying the client’s objectives
- Assessing and analyzing all relevant legal and factual matters
- Preparing a case theory
- Preparing and revising as necessary case plans and schedules
- Instructing Counsel
- Preparing and handling pre-commencement correspondence/negotiations
- Preparing issuing and serving procedural documents in the normal course of a matter
- Evidence handling and management
- Preparing a case for hearing
- Attending hearings
- Handling settlement negotiations and drafting settlement agreements of a kind typical to contentious Trade Mark & Design matters
- Assessing costs and risks and advising accordingly
- Diarising and managing the matter on an ongoing basis
- Keeping proper records and attendance notes
- Proper file and case management
- Appropriate reporting and client care
- Post-determination formalities

The experience must be gained under the supervision of a person having the right to conduct litigation in a forum covered by these Regulations.

For the avoidance of doubt, experience in the conduct of contentious matters before the UKIPO and OHIM may be sufficient Relevant

Experience for the purpose of these Regulations. Experience before other tribunals, or of the handling of contentious matters in other fields, can also be taken into account.

The LAB may also take into account experience gained from training or other litigation courses validated or approved by ITMA or by other Regulators of persons having rights of representation.

In addition, the candidate **must** evidence Relevant Experience gained through involvement in or the structured observance of the conduct of contentious proceedings in a court forum covered by the rights of representation granted under these Regulations. It is likely that experience over, in total, at least 6 court working days would be expected.

The candidate must keep and present to the Litigation Accrediting Board a Training Record, certified by the person supervising the candidate's training who must also confirm that proper training has been received and that the necessary skills have been acquired. The LAB may ask for further information to support the Candidate's application or may stipulate further experience that may be required.

SCHEDULE 2

TRADE MARK ADVOCATE CERTIFICATES RELEVANT EXPERIENCE GUIDELINES

Applicants must demonstrate that they have acquired the basic skills necessary to enable them to exercise the rights of audience available to them on certification. These skills will require regular exposure to advocacy experience over a period of at least 6 months, although whether the experience is in fact sufficient will be assessed on a case-by-case basis. Candidates who have attended qualifying courses validated by other Authorised bodies may have to demonstrate greater experience showing an awareness of issues specific to Trade Mark & Design Litigation.

This experience can be gained by directly handling the work, by assisting others in the work or by proper observation of experienced practitioners.

Candidates should have experience that enables them to be competent in the conduct of contentious matters and to recognise where the matter is outside their competency. For example, experience of the following activities may be taken into account:

Advocacy, written or oral, before the UKIPO, OHIM or other tribunals, *inter partes* and *ex parte*.

Preparation of skeleton arguments in the UKIPO

Pre – hearing preparation and planning

Witness examination

Generally presenting to peers, clients or other audiences.

The LAB may also take into account experience gained from training or other advocacy courses validated or approved by ITMA or by other Regulators of persons having rights of audience.

In addition, the candidate *must* evidence Relevant Experience gained through involvement in or the structured observance of the conduct of oral advocacy in contentious proceedings in UKIPO or in a court forum covered by the rights of representation granted under these Regulations. It is likely that experience over, in total, attendance at UKIPO/Court on least 6 working days would be expected.

The candidate must keep and present to the Litigation Accrediting Board a Training Record, certified by the person supervising the candidate's training who must also confirm that proper training has been received and that the necessary skills have been acquired. The LAB may ask for further information to support the Candidate's application or may stipulate further experience that may be required.

SCHEDULE 3

Litigation and Advocacy Course Validation Guidelines

1. ITMA may visit the institution and liaise with the staff concerned as often as necessary. In particular ITMA 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. ITMA shall liaise with each institution teaching a validated course to ensure that:
 - (a) the syllabus and practical exercises are up to date and continue to meet the training requirements of Trade Mark & Design 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 a validated course is that by the end a participant should be able to perform competently as a Trade Mark & Design Litigator or Advocate in the relevant courts.

SCHEDULE 4

Rules of Professional Conduct and Disciplinary Procedure for ITMA Members holding and acting within the scope of Litigator and/or Advocate Certificates

1. Definitions

"Certificate" shall mean a Litigator or Advocate certificate issued by the Institute of Trade Mark Attorneys within the scope of the rights granted under the Courts and Legal Services Act 1990.

"Certified Person" shall mean a person holding a Certificate granted under these Regulations and acting under that Certificate

"Litigation Work" shall mean the provision of professional services within the scope of either a Litigator or Advocate Certificate by or under the supervision of a Certified Person.

"Firm" shall mean a sole practitioner, a partnership or a body corporate carrying on business as a registered trade mark attorney or solicitor, or whose primary purpose is to provide intellectual property advice to third parties for payment in respect of those services.

"Member of a Firm" shall mean an employee of the Firm and also the sole practitioner, a partner of the Firm in the case of a partnership, and a director of the Firm in the case of a body corporate.

"ITMA" shall mean the Institute of Trade Mark Attorneys.

"Employed Certified Person" shall mean a Certified Person who is an employee of an employer that is not a Firm.

"Holding" and "subsidiary" company have the meanings assigned to them by the Company's Act 1985 (as amended from time to time) and two companies are "associated" where they are subsidiaries of the same holding company or companies;

2. Scope of Rules

- 2.1 These Rules shall apply to Certified Persons when performing Litigation Work.
- 2.2 A Certified Person shall be responsible for ensuring that all Litigation Work performed by a person under his or her supervision will be conducted in accordance with these Rules.
- 2.3 A Certified Person shall, by applying for and holding a Certificate, agree to subject to any appeal to be bound by all requirements and procedures and decisions of any person, body or committee set up to enforce these Rules and shall co-operate full and promptly in establishing the facts in relation to any alleged breach of these Rules.
- 2.4 If any provision of these Rules imposes requirements additional to or different from those of other rules of conduct to which a Certified Person is subject, those Rules shall prevail.

3. Basic Principles

- 3.1 A Certified Person shall neither do anything nor permit any persons to do anything on his or her behalf, which compromises or impairs or is likely to compromise or impair any of the following:
 - (a) the independence or integrity of the Certified Person;
 - (b) a person's freedom to instruct a Certified Person or other professional person of his or her choice;
 - (c) the Certified Person's duty to act in the best interest of the client;
 - (d) the Certified Person's statutory duty to the Court [under Section 27(2A) of the Courts and Legal Services Act 1990 (see Rule 11.1 below) which shall prevail over his or her duty to any client or other person, or
 - (e) the Certified Person's proper standard of work.

4. Competence

- 4.1 A Certified Person shall decline to undertake Litigation work outside his or her expertise or competence.
- 4.2 A Certified Person shall consider whether, having regard to:
 - (a) the circumstances (including in particular the gravity, complexity and likely cost) of the case;

- (b) the nature of the Certified Person's practice;
 - (c) the Certified Person's ability, experience and seniority; and
 - (d) the Certified Person's relationship with the client. The best interests of the client would be served by the Certified Person, another Certified Person whether within the same Firm or not, a solicitor, or some other person providing litigation services.
- 4.3 The consideration referred to in Rule 4.2 shall be given as soon as practicable after receiving instructions and from time-to-time thereafter, particularly when circumstances change, and a file note shall be made on each occasion such consideration is given. If the Certified Person considers that the best interests of the client would be served by some other person acting, he or she must advise his or her client accordingly.

5. Conflicts of Interests

- 5.1 A Certified Person must not accept instructions to act for two or more clients where there is a conflict of a significant risk of conflict between the interests of the clients.
- 5.2 If a Certified Person acquires or has acquired relevant knowledge concerning a current or a former client in the course of acting for that client in any capacity, the Certified Person must not accept instructions to act against that client or shall henceforth cease to act against that client.. The term "relevant knowledge" shall mean such knowledge of the client of the client's affairs that is not widely disseminated to the public and that is, or is likely to become, relevant to the action concerned against the client.
- 5.3 A Certified Person must not continue to act for two or more clients where conflict of interests arises between those clients.
- 5.4 A Certified Person must not act where his or her interests, or where he knows or has reasonable grounds for suspecting that the interests of any Partner or member of staff of his or her firm, conflict with those of a client.
- 5.5 A Certified Person must not allow any person to perform Litigation Work under his or her supervision when the Certified Person knows or has reasonable grounds for suspecting that such person has a conflict of interest in respect of the Litigation work.
- 5.6 Subject to Rule 6, an Employed Certified Person may only undertake Litigation Work for a person other than his or her employer if:
- (a) he or she declines to act for that person if any conflict arises between the employer and that person; and

- (b) he or she informs that person in writing prior to commencing each piece of Litigation work that he or she is an employee and that he or she must decline to act further for that person if any conflict arises between the employer and that person.

6. Employed Certified Persons

6.1 An employed Certified Person shall not act in the course of his employment with his employer as a Certified Person except in accordance with the following provisions of Rule 6.

6.2 In the course of his employment, an Employed Certified Person may act for the employer and the following related bodies

- (a) the employer's holding, associated or subsidiary company;
- (b) a partnership, syndicate or company by way of joint venture in which the employer and others have an interest
- (c) a trade association of which the employer is a member;
- (d) a club, association, pension fund or other scheme operating for the benefit of employees of the employer;
- (e) where the employer is a public body, for another public body or statutory officer to which the employer is statutorily empowered to provide legal services;
- (f) where the employer is an association whose members are limited to persons engaged or concerned in a particular trade, occupation or activity of otherwise having a community of interest, and is formed bona fide for the benefit of its members and not formed directly or indirectly for the benefit of the Employed Certified Person or primarily for securing assistance in legal proceedings, for a member of such an association; or
- (g) a person with whom the employer has a joint interest in the outcome of any proceedings, including in particular any licensee or licensor of the employer, or any joint owner with the employer of any intellectual property rights the subject of the relevant Litigation Work, providing that such joint interest is bona fide for the employer's benefit and is not formed directly or indirectly for securing assistance in legal proceedings.

6.3 Subject to the following provisions, an Employed Certified Person may also act for the following persons:

- (a) a fellow employee;
- (b) a director, company secretary or board member of the Employed Certified Person's employer; or
- (c) an employee, director, company secretary, board member or trustee of the employer or of a related body of the employer within the meaning of Rule 6.2;

Provided that in each case

- (a) the matter related to or arises out of the work of such person for the employer;
 - (b) the Employed Certified Person is satisfied that such person does not wish to instruct some other representative; and
 - (c) no charge is made to such person, in relation to the Employed Certified Person's costs, unless such costs are recoverable from any other source.
- 6.4 The employed Certified Person shall, before accepting instructions to act for the bodies or persons other than the employer in accordance with these Rules, give written notice to the client that the employer is not able, by way of insurance or otherwise, to indemnify the client adequately in the event of a claim against the Employed Certified Person for which the employer would be vicariously liable, if that be the case.
- 6.5 The Employed Certified Person shall, before accepting instructions to act for the bodies or persons other than the employer in accordance with these Rules, give written notice to the client that the Employed Certified Person is not covered by insurance in relation to professional negligence, if that be the case.
- 6.6 Where an Employed Certified Person is action for a body or person other than the employer in accordance with these Rules, any information disclosed by the Employed Certified Person by the client is confidential and cannot be disclosed to the employer except with the express consent of the client.
- 6.7 any references to a Certified Person's employer include the employer's holding, associated or subsidiary company, and any references to an employee include references to an employee of such holding, associated or subsidiary company.

7. Non-discrimination

- 7.1 A Certified Person must not discriminate on the grounds of race, sex, disability, sexual orientation or religion in his or her professional dealings with clients, employees, solicitors, other patent agents, barristers or any other person.

- 7.2 Without prejudice to Rule 7.1 a Certified Person in any instance in which he is providing advocacy services in the course of Litigation Work must not withhold those services;
- (a) on the ground that the nature of the case is objectionable to him or to any section of the public:
 - (b) on the ground that the conduct, opinions or beliefs of the prospective client are unacceptable to him or to any section of the public; or
 - (c) on any ground relating to the source of any financial support which may properly be given to the prospective client for the proceedings in question (for example, on the ground that such support will be available under the Access to Justice Act 199).

8. Confidentiality

- 8.1 Except properly for conduct of work on behalf of the client, a Trade Mark Litigator is under duty to keep confidential to his or her own Firm the affairs of a client and to ensure that the staff of the Firm do the same.
- 8.2 The duty under Rule 8.1 applies irrespective of the source of that information.
- 8.3 The duty under Rule 8.1 continues until the client permits disclosure or waives the confidentiality.

9. Fees

- 9.1 A Certified Person must not charge unjustifiable fees having regard to fees generally charged by professionals in the conduct of litigation of comparable complexity and difficulty to the Litigation Work in question.
- 9.2 A Certified Person who is retained in connection with Litigation Work shall not enter into any arrangement to receive a contingency fee in respect of that work except if permitted to do so by the Lord Chancellor in accordance with any statute or statutory instrument or otherwise in accordance with any rule of law.

10. Community Legal Service Fund

- 10.1 A Certified Person is under a duty to consider and advise the client on the availability of funding for litigation services by the Community Legal Service Fund or any funding available from the wider Community Legal Service to which the client might be entitled under the Access to Justice Act 199[] and any Statutory Instruments thereunder or any succeeding Act.

11. Duties of a Certified Person

11.1 A Certified Person conducting litigation or exercising a right of audience has a statutory duty

(a) to the court to act in the interests of justice; and

(b) to comply with these rules

And those duties override any obligation which the Certified Person may have (otherwise than under the criminal law) if it is inconsistent with them.

11.2 A Certified Person whilst under a duty to do the best for a client must never deceive or mislead the Court.

11.3 A Certified Person must not make or instruct counsel to make an allegation which is intended only to insult, degrade or annoy the other side, a witness or any other person.

11.4 A Certified Person is under a duty to attend or arrange for the attendance of a responsible representative throughout any Court hearing attended by Counsel.

11.5 A Certified Person must comply with any order of the Court which the Court can properly make requiring the Certified Person and his or her Firm to take or refrain from taking some particular course of action.

11.6 A Certified Person must comply with the letter and spirit of any undertaking given to the Court or other party whether or not that undertaking is supported by consideration.

12. Complaints

12.1 Each Certified Person or Firm shall have an established procedure for dealing with complaints in regard to Litigation Work. Written details of the procedure must be available whenever a client requests them. In addition, a client shall be informed in writing, when first engaging a Certified Person or a Firm to do Litigation Work (whether or not the client is already a client of the Certified Person or his Firm in respect of other work), that such a procedure exists and that, for resolution of a complaint, the client should first contact the Trade Mark Litigator or his Firm. In order to reduce misunderstandings concerning the levels of fees charged for Litigation Work, the client must also be informed in writing of the basis on which the work is to be charged.

13. Professional Indemnity Insurance

- 13.1 Each Certified Person or his or her Firm must take out and maintain professional indemnity insurance cover for Litigation Work. When commencing and renewing such insurance, each Trade Mark Litigator or his or her Firm shall ensure that the insurance provides cover in respect of each and every claim brought in the United Kingdom or elsewhere in the European Union of a least the Minimum Value (as defined in the next sentence) prevailing at the time of commencement or renewal. The Minimum Value shall be determined by the relevant Council of ITMA from time to time but shall never be a value less than £1,000,000.
- 13.2 A Certified Person shall not limit liability for professional negligence below the Minimum Value.
- 13.3 Any limitation of liability for negligence in respect of Litigation Work must be clearly drawn to the attention of a client and be understood and accepted by him or her.
- 13.4 The provisions of this Rule 13 shall not apply to an Employed Trade Mark Litigator when he or she is acting within the meaning of Rule 5.2 or 6.3

14. Client's Money

- 14.1 A Certified Person in performing any Litigation Work must ensure that any money held on behalf of the client in respect of such Litigation Work is held on trust for the client in an account which is entirely separate from the Trade Mark & Design Litigator's personal or professional business account.
- 14.2 Money which would have to be kept in the separate account includes that which is intended or which may be require to be:
- (a) paid or received from a third party on settlement or as the court might direct; or
 - (b) paid into or received from the Court (including without limitation by way of a Part 36 payments or a payment on account of costs following summary or detailed assessment).
- 14.3 Money in the separate client's account must be held to the order of the client or the Court and any interest accruing in the account must inure to the client.
- 14.4 Money which the Certified Person is not required to keep in such a separate clients' account includes:
- (a) any money received on account of expected charges for the Certified Person's services;

- (b) costs to be incurred on the client's behalf; and
- (c) money paid in settlement of a debt owed by the client to the Certified Person.

ITMA - Disciplinary Procedure in respect of Litigation Work

1. Definitions

- 1.1 The definitions at 1 of the Rules of Professional Conduct for Trade Mark Attorneys holding and acting within the scope of Litigation Rights Certificates (the "Special Rules of Professional Conduct") shall also apply to the conduct of the present Disciplinary Procedure.
- 1.2 The Disciplinary Procedure set out in the following paragraphs shall apply to the conduct of any complaint concerning a possible breach of the Special Rules of Professional Conduct by a Certified Person.

2. Object

Many complaints of a minor nature can be dealt with internally by discussion. Such an internal procedure may not resolve serious complaints and this disciplinary procedure provides a route by which a client or other interested party may take further any point of dissatisfaction.

3. First Stages

- 3.1 For the disciplinary procedure to be initiated, the complainant must have an interest in the Litigation Work complained of. The Secretary of ITMA is deemed to have an interest and shall be entitled to initiate the disciplinary procedure if the Secretary deems in his or her absolute discretion that it is appropriate to do so, and the term "complainant" includes the Secretary of ITMA when the Secretary has initiated the disciplinary procedure. Provided the complainant has an interest, the complainant can be a client or a person other than client, for instance, a Court, a third party such as another party of their representative in legal proceedings or a member of the Bar.
- 3.2 If a complaint is made to ITMA or if the Secretary of ITMA initiates the disciplinary procedure, the Certified Person in relation to whom the complaint is made or his or her Firm shall be informed. If the complainant is a client and if the matter has not been discussed between the client and the Certified Person or his or her Firm, the Certified Person or his or her Firm should make reasonable endeavours to discuss the complaint with the client. If the complaint is not resolved between the client and the Certified Person (or his or her Firm), then the client may require that the matter be

referred to the appointed person or body (see paragraph 3.3). If the complainant is not a client, the matter shall be referred directly to the appointed person or body; however, if the disciplinary procedure is initiated by the Secretary of ITMA, the matter shall be referred directly to the Litigator Conduct committee appointed under paragraph 4.

- 3.3 The appointed person or body shall be secretariat of ITMA, or a person or body appointed by the secretariat.
- 3.4 The appointed person or body shall act as a third party mediator or a third party conciliator as it deems appropriate. The appointed person or body shall review any complaint, other than where the disciplinary procedure is initiated by the Secretary of ITMA, and shall explore with the parties whether there is any basis of settling the complain without taking the matter further.
- 3.5 The appointed person or body shall also review the complaint and give a preliminary opinion on whether on the face of it the complaint has any substance, and shall inform the complainant and the Trade Mark Litigator (or his or her Firm) of that opinion.
- 3.6 The appointed person or body shall also determine whether the complaint concerns a possible breach of the Special Rules of Professional Conduct by a Certified Person, in which case the complaint shall be handled under the Special Rules of Professional Conduct, otherwise, the complaint shall be handled under Articles 58 to 64 of ITMA' Articles of Association and the ITMA Code of Practice rather than by the Litigator Conduct Committee.
- 3.7 If it is determined under paragraph 3.6 that the complaint concerns a possible breach of the Special rules of Professional Conduct, and if the complain cannot be resolved on the basis of mediation or conciliation, or if the appointed person or body so directs, the complaint shall be referred to the Litigator Conduct Committee appointed under paragraph 4. after consultation with the complainant.

4. The Litigator Conduct Committee

- 4.1 The Litigator Conduct Committee shall be a committee of ITMA, shall be appointed under an appointment procedure set up by ITMA, shall be appointed for each complaint or series of associated complaints. The Committee shall consist of:
 - (a) three Fellows of ITMA; and
 - (b) at least two members experienced in litigation appointed by the Bar Council and/or the Law Society or failing such appointment by the Secretary of State for Trade and Industry.
- 4.2 The Litigator Conduct Committee shall remain validly constituted and competent to decide any matter under the Disciplinary Procedure notwithstanding one member of

the originally appointed Litigator conduct committee at any time resigning or otherwise failing to participate in the Litigator Conduct committee. If at any time a second member resigns or fails to participate in the Litigator Conduct Committee, the Litigator Conduct Committee shall be reappointed and the procedure before the Litigator Conduct Committee shall be reinitiated unless otherwise agreed with the complainant and the Trade Mark Litigator.

5. Procedure before the Litigator Conduct Committee

- 5.1 The Litigator Conduct Committee shall ascertain the facts from the complainant and from the Certified Person and can seek facts and views from others as the Litigator Conduct Committee deems appropriate. The Litigator Conduct Committee can adjudicate on any breach of Articles 59 to 62 of ITMA's Articles of Association or the ITMA Code of Practice as well as any breach of the Special Rules of Professional Conduct. The Litigator Conduct Committee shall allow profession or other representation for the complainant and for the Certified Person.
- 5.2 The Litigator Conduct Committee shall give the parties the opportunity of a hearing before reaching a decision. The Litigator Conduct committee shall have the right to determine that both parties be not present at the same hearing.

6. The Powers of the Litigator Conduct Committee

- 6.1 The Litigator Conduct Committee shall give a reasoned decision. The Litigator Conduct Committee shall have the power to impose one or more of the following sanctions, as it deems appropriate:
- (a) an unpublished warning;
 - (b) a public reprimand;
 - (c) an order to pay a fine to ITMA up to level 5 of the standard scale of fines for summary offences as set out in S.37 Criminal Justice Act 1982 as amended from time to time;
 - (d) an order to take remedial action;
 - (e) an order to forego or, if appropriate, to repay some or all of the charges rendered in connection with the Litigation work complained of;
 - (f) an order to pay compensation to the complainant up to level 5 as in (c) above;
 - (g) an order to pay a proportion of or the full costs of the disciplinary procedure;
 - (h) an order suspending the trade mark attorney from acting as a Trade Mark Litigator or imposing conditions on his or her continued practice as a Certified Person, either for a limited period or indefinitely;

- (i) an order to refer the matter to the Council of ITMA or other empowered ITMA body with a recommendation to cancel the Trade Mark Litigator's membership of ITMA either for a limited period or indefinitely;
- (j) if the Litigator Conduct Committee has been empowered to impose such an order, an order cancelling the Trade Mark Litigator's membership of ITMA either for a limited period or indefinitely;
- (k) an order referring the Certified Person to the Secretary of State for Trade and Industry under Rule 10 and rules 14 to 17 of The Register of Trade Mark Agents Rules 1990 and sending the Secretary of State a copy of the Decision.
- (l) an order that the whole decision or a summary or part of the decision, with or without the names of the parties, be published.

7. Appeals Procedure

- 7.1 There shall be an appeal to an independent person or body of persons appointed by ITMA agreeable to the parties, or in the absence of agreement determined in accordance with the Arbitration Act 1996 as may be amended or replaced from time to time.