



## **Legal Services Board – Decision Notice issued under Part 3 of Schedule 4 to the Legal Services Act 2007**

### **The Intellectual Property Regulation Board (IPReg) rule change application to revise and consolidate the certification rules concerning litigation, rights of audience and other reserved legal activities.**

The Legal Services Board (LSB) has granted an application from IPReg to revise and consolidate its certification rules concerning litigation and reserved instrument activities by the 'Rights to conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules 2012' (**Annex A**).

In addition to the core rule changes, the LSB has approved consequential and clarificatory amendments to the 'Continuing Professional Development Regulations' (**Annex B**) and the 'Disciplinary Procedure Rules' (**Annex C**).

This Decision Notice sets out the basis for the LSB granting the application and the decision taken, including a brief description of the changes.

#### **Introduction**

1. The LSB is required by Part 3 of Schedule 4 to the Legal Services Act 2007 (the Act) to review and grant or refuse applications by approved regulators to make alterations to their regulatory arrangements. The Chartered Institute of Patent Attorneys (CIPA) and Institute of Trade Mark Attorneys (ITMA) as the joint approved regulator have delegated regulatory functions to IPReg.
2. Paragraph 25 of Schedule 4 to the Act explains that the LSB may only refuse an application setting out a proposed change to the regulatory arrangements if it is satisfied that by granting the application one or more of the criteria specified in sub paragraph 25(3) (and listed in the footnote below<sup>1</sup>) will be met. For example, the LSB's granting of the application to alter the regulatory arrangements must not be prejudicial to the regulatory objectives overall. Accordingly, if the LSB is not satisfied that one or more of the criteria for refusal are met, then it must approve the application in whole, or the parts of it that can be approved.

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<sup>1</sup> The Board may refuse the application only if it is satisfied that—(a) granting the application would be prejudicial to the regulatory objectives, (b) granting the application would be contrary to any provision made by or by virtue of the Act or any other enactment or would result in any of the designation requirements ceasing to be satisfied in relation to the approved regulator, (c) granting the application would be contrary to the public interest, (d) the alteration would enable the approved regulator to authorise persons to carry on activities which are reserved legal activities in relation to which it is not a relevant approved regulator, (e) the alteration would enable the approved regulator to license persons under Part 5 to carry on activities which are reserved legal activities in relation to which it is not a licensing authority, or (f) the alteration has been or is likely to be made otherwise than in accordance with the procedures (whether statutory or otherwise) which apply in relation to the making of the alteration.



3. As provided for by paragraphs 20(1) and 23(3) of Schedule 4 to the Act, the LSB has made rules<sup>2</sup> about how the application to alter the regulatory arrangements must be made including the contents of that application. The rules highlight the applicant's obligations under section 28 of the Act to have regard to the Better Regulation Principles. The rules also require that the applicant provides information about the nature and effect of each proposed change and of appropriate consultation undertaken. Sub paragraph 25(3)(f) of Schedule 4 to the Act requires that each proposed alteration has been made or is likely to be made in accordance with the procedures (whether statutory or otherwise) which apply in relation to the making of the alteration. This therefore includes the LSB's rules.
4. The chronology for the LSB's handling of this application can be found towards the end of this Decision Notice.

### Decision

5. This Decision Notice grants IPReg's application to revise and consolidate its certification rules concerning litigation and reserved instrument activities by the 'Rights to conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules 2012' (**Annex A**).
6. This Decision Notice also grants the consequential and clarificatory amendments to IPReg's 'Continuing Professional Development Regulations' (**Annex B**) and 'Disciplinary Regulations' (**Annex C**).
7. The LSB does not approve guidance where it is designed to explain how the rules apply. The guidance that is contained in these regulatory arrangements is considered to be explanatory and therefore does not require approval from the LSB.
8. The LSB acknowledges that in granting this application IPReg will update other documents to reflect changes in terminology and to replace references to the previous regulations with references to the new regulations.
9. The LSB provides comments on IPReg's clear rationale behind their changes in the following paragraphs.

#### *A single regulatory regime*

10. Certain statutory litigation rights granted to patent attorneys under the Copyright, Designs and Patent Act 1988 have been repealed by the Act and are currently subject to transitional provision. New arrangements under the Act therefore need to be in place before the end of the transitional period. IPReg will replace their two separate litigation arrangements for patent attorneys and trade mark attorneys with a new single regime offering three levels of qualification common to both professions. This will essentially give 'rights of conduct' (which is the right to manage litigation for a client taking certain procedural steps and fulfilling certain roles in the handling of a case) and 'rights of

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<sup>2</sup> Rules for Rule Change Applications – Version 2 (November 2010)



audience' (which is the right to address a Court) in intellectual property, to patent and trade mark attorneys that hold litigation and advocacy certificates.

11. The LSB recognises that intellectual property litigation is a discreet and specific area of litigation and welcomes IPReg's approach to a single regime. The LSB notes that the arrangements in place prior to the approval of this application showed pronounced differences in the approaches taken by CIPA and ITMA to the establishment and regulation of their rights, and that the new single regime gives effect to a consistent approach to regulation across both professions.
12. LSB is also encouraged by IPReg's view that the changes will widen the pool of available litigators available for consumers whilst at the same time removing unnecessary and disproportionate qualification requirements. We are also assured that IPReg have adequate safeguards to ensure a regulated person can only undertake work within his/her expertise or competence, as enforced through rule 4 of IPReg's Code of Conduct.

*Independence between regulatory and representative bodies*

13. The arrangements in place before this application was submitted were established by CIPA and ITMA before the Patent Regulation Board and the Trade Mark Regulation Board – working together as IPReg – were established.
14. It is the LSB's view that the changes approved bring about a clear separation between the regulatory role of IPReg from CIPA and ITMA and is an approach which supports the LSB's work on independent regulation.
15. We are also encouraged by IPReg's decision to dispense with the requirement that qualification should be dependent on membership of a representative body, a move which was supported in the feedback received from consultees during the consultation period. It is our view that this will ensure that all persons qualified under IPReg's qualification regime are regulated regardless of whether they are a member of a representative body.

*Intellectual property consumers*

16. IPReg's application asserts that these changes will address consumer complaints about the need to instruct more than one legal adviser on intellectual property matters with the inherent increased costs. For example, the services of patent or trade mark attorneys would be required to obtain their rights, but to enforce them would have to instruct solicitors and barristers.
17. The LSB is encouraged by IPReg's consideration of consumer experiences and acknowledge that the new regime will undoubtedly help ease some of the complexities currently experienced by some consumers. We would also hope that through a consistent and streamlined qualification regime, that IPReg's desired outcome of these changes are achievable in that it improves the litigation skills of IPReg-regulated persons and encourages more attorneys to undertake litigation. We would expect the knock on



effect for consumer choice to be positive, perhaps even resulting in the availability of a wider pool of intellectual property providers.

18. The LSB acknowledges IPReg's point that there may be limited demand for these qualifications at present, and supports with their intention to monitor demand via training providers and the certification process.

***LSB's decision-making powers: applications to change regulatory arrangements***

19. The LSB has considered IPReg's application against the criteria in paragraph 25(3) of Schedule 4 to the Act, and considers that there is no reason to refuse this application; accordingly, the LSB grants this application.

20. The Annexes to this Decision Notice contains the rule changes approved by the LSB.

**Chronology**

- The LSB confirmed receipt of an application from IPReg on 16 August 2012. Further information was received on 26 September 2012 and 5 November 2012.
- The 28 day initial decision period for considering the application ended on 12 September 2012.
- The Decision Period was extended to 13 November 2012 on 11 September 2012. The extension of the initial decision period was required due to the complexity of the issues raised in the application and the additional time required by the LSB to assess the application.
- This Decision Notice is being published on our website on 6 November 2012.

**Chris Kenny, Chief Executive  
Acting under delegated authority granted by the Board of the Legal Services Board**

**6 November 2012**





## 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:

**“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 Authorised Body 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;

**“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;

**“Authorised Body”** 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;

**“Patent Attorney Register”** means the register kept under section 275 of the Copyright Designs and Patents Act 1988 as amended;

**“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;

**“Trade Mark Attorney Register”** means the register kept under section 83 of the Trade Marks Act 1994 as amended;

**“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:
  - a) the Patents County Court; and
  - b) any 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 Patents County Court;
  - b) the High Court in appeals proceedings mentioned in paragraph (i) but not applications for judicial review; and
  - c) the appeal tribunal constituted by the Registered Designs Act 1949 (as amended from time to time);
- 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 any 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 Authorised Body 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 Authorised Body 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 Authorised Body 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**

- 11.1 These Rules shall come into effect on [commencement date] 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 Patents County 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.



## Amendments to the Continuing Professional Development Regulations

### Regulation 1 – Interpretation

**Replace current definition of “Authorised Litigator” with definition of Higher Court Advocate**

### Regulation 3 – Requirements

**Replace current Regulation 3.2 with below**

3.2 A Higher Court Advocate is required to complete a minimum of five hours Higher Court Advocacy CPD in each of the five years following qualification as a Higher Court Advocate or in the case of a Higher Court Advocate previously awarded Higher Court advocacy rights by another authorised body in each of the five years following the award of those rights by that body.

## Compliance with CPD Regulations - Guidance Notes 2012

### 6 Special CPD requirements: including part-time workers, extended leave, overseas-based registrants, dual-registrants and ~~authorised litigators~~ Higher Court advocates

Registered attorneys practising on a part-time basis are required to complete the same minimum number of CPD hours as those in full-time practice. However, registered attorneys who can substantiate that they have not been in active practice for a significant period during a year (for example as a result of illness, maternity, paternity, sabbatical leave or career break) may be entitled to a reduction in the required CPD minimum on application to the IPReg Education and Qualifications Committee. If the inactive period has been prolonged, then the Committee may require that a programme of CPD activities is started immediately on return to active practice.

Newly qualified individuals are not required to undertake CPD during the registration year in which they qualify but only from their next full year of registration.

Newly qualified individuals entering the Patent Attorney and Trade Mark Attorney registers on or after [date] must attend a certified basic litigation skills course either prior to qualification or within 3 years from the end of the calendar year when they are first entered onto the register.

In the case of trade mark attorneys qualifying under the new examination regime, this requirement will be fulfilled by their attending the litigation skills weekend included in the Nottingham Law School practise skills course required to qualify as a trade mark attorney.

Newly qualified patent attorneys and any trade mark attorneys qualifying under the old examination regime will have to attend either the litigation skills weekend included in the Nottingham Law School practise skills course or a basic litigation skills course run by CIPA or another accredited provider.

Course providers will provide details of attendees direct to IPReg to enable IPReg to monitor compliance with this provision and to enable IPReg to update the Patent Attorney and Trade Mark Attorney registers to indicate that such attorneys are eligible to undertake litigation and exercise rights in the Patents County Court and on Appeal from decisions of the IPO.

Any attorney who provides IPReg with evidence that they have already acquired a right to conduct civil litigation because for example they are qualified as a barrister or a solicitor or who provides evidence that they have completed the Bar Professional Training Course or the solicitors' Legal Practice Course will be exempted from the requirement to attend a basic litigation course.

If an attorney acquires an IPReg Higher Courts Litigation Certificate within 3 years of qualification they will also be exempted from the requirement to attend a basic litigation course. Practising attorneys registered on both the patent attorney and trade mark attorney Registers are normally only required to achieve the minimum of 16 hours CPD required for a single Register (and not for both Registers) provided the number of hours involved on patent and trade mark activities broadly reflects the split of patent and trade mark business carried out. However, IPReg may wish to examine CPD returns from such dual registered attorneys



to ensure that sufficient CPD activities are being carried out relevant to both trade mark and patent practice to support remaining on both Registers.

Attorneys are required to undertake CPD relevant to their practice. IPReg do not require specific numbers of hours to be devoted to particular subjects. Rather attorneys should determine for themselves, bearing in mind their existing skills and the nature of their practice, the most appropriate subjects where they should undertake CPD. It would be expected that any attorneys who wish to exercise rights of audience or rights to litigate will undertake CPD relevant to the conduct of litigation and/or advocacy on a sufficiently regular basis to ensure at a minimum that their skills in those areas are maintained.

Any attorney obtaining a Higher Courts Advocacy Certificate on the basis of passing an advocacy skills course or an advocacy assessment must undertake at least five hours of CPD relating to the provision of advocacy services in the higher courts in each of the first five CPD years following the grant of the qualification. Attorneys who obtain a Higher Courts Advocacy Certificate on the basis of a grant of a right of audience from another authorised body must undertake at least five hours of CPD relating to the provision of advocacy services in the higher courts in each of the first five CPD years following the date of first exercising that right.

Registered attorneys practising abroad are still subject to the IPReg CPD requirements but may include relevant activities carried out abroad or to satisfy overseas CPD requirements.

~~Authorised Litigators are required to carry out a minimum of 6 hours CPD relevant to litigation, 3 hours of which can be included in the 16 hours CPD required to remain on the Register as a practising attorney with the remaining 13 hours primarily devoted to other than litigation topics. Advice about CPD relevant to litigation may be obtained on request from the IPReg CPD Sub-Committee.~~



## Amendments to disciplinary procedure rules

### Rule 1 – Interpretation

“Code of Conduct” means 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 rights of audience before the courts adopted from time to time by the IPReg Board;

“Patent Attorney Litigator” means a registered patent attorney holding a certificate issued under the Rights to conduct litigation and rights of audience and other reserved legal activities certification rules;

“Rights to conduct litigation and rights of audience and other reserved legal activities certification rules” means the rules issued by IPReg from time to time relating to the authorisation of regulated persons to undertake reserved legal activities;

“Trade Mark and Design Litigator” means a registered trade mark attorney holding a certificate issued under the Rights to conduct litigation and rights of audience and other reserved legal activities certification rules;

### Rule 7 – Initial processing by the Complaints Review Committee

7.9 If a Complaint is admissible and the Complaint either:

- a) is the subject of pending litigation between the Complainant and the Respondent; or
- b) concerns the actions of a Respondent conducting litigation in their capacity as an authorised litigator,

the CRC may suspend investigation of a Complaint until the litigation is concluded.

A CRC shall only suspend investigation of a Complaint under Rule 7.9 (b) if the CRC is satisfied that neither the client of the Respondent, nor any opposing parties, nor the Court, will suffer any detriment if the client continues to be represented by the Respondent.

7.10 A Complaint suspended by virtue of Rule 7.7, 7.8 or 7.9 shall be resumed when the CRC is informed that the investigation by the other professional regulator or the litigation has been concluded.

The CRC shall take into account the determination of the case by any other regulator in a case suspended by virtue of Rule 7.7 or 7.8 or the conclusion of the Court in a case suspended by virtue of Rule 7.9 (a) when:

- (a) determining whether or not a Complaint discloses a prima facie case or whether or not processing a case further would be disproportionate or otherwise not in the public interest under rule 8.2; and
- (b) determining whether or not a case is suitable for determination by a summary procedure under rule 8.5.

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The result of the determination of the case by the other regulator or the conclusion of the Court shall also be included in the material submitted to a Disciplinary Board if the Complaint is referred to a Disciplinary Board.

## **Rule 8 - Review and assessment of a *prima facie* case and summary proceedings**

8.1 This Rule applies where a Complaint has been found to be admissible under Rule 7.2 and the investigation of the Complaint:

- a) has not been suspended by virtue of Rule 7.7, 7.8 or 7.9; or
- b) has been resumed under Rule 7.10.