

CIPA Higher Courts Qualification Regulations 2007

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CIPA Higher Courts Qualification Regulations 2007

Introduction

1. The Chartered Institute of Patent Attorneys (“CIPA”) makes these regulations as an authorised body under section 29 of the Courts and Legal Services Act 1990. These regulations replace the CIPA Higher Court Qualification Regulations 2000.

Definitions

2. A “Litigator Certificate” means a certificate granted by CIPA to a registered patent attorney who is a Fellow of CIPA conferring the rights set out in paragraph 5 below. A person holding such a certificate shall be known as a “Patent Attorney Litigator”.
3. “Intellectual Property Litigation” means litigation in respect of any matter relating to the protection of any invention, design, technical information or trade mark, or similar rights, or as to any matter involving passing-off, or any matter ancillary thereto.
4. The “Litigators Accrediting Board” or “LAB” means a committee of CIPA established under CIPA By-law 44.

Rights to Conduct Litigation and of Audience

5. Without prejudice to any existing rights of audience and to conduct litigation, registered patent attorneys who are Fellows of CIPA and who hold litigator certificates shall have the following rights:
 - (i) the right to conduct Intellectual Property Litigation in the Chancery Division of the High Court, including the Patents Court and in the County Court including any court designated as a Patents County Court;
 - (ii) to the right to conduct appeals in Intellectual Property Litigation from the Chancery Division of the High Court, including the Patents Court, and in the County Court including any court designated as a Patents County Court;
 - (iii) the right of audience in hearings in the County Court including any court designated as a Patents County Court in Intellectual Property Litigation;
 - (iv) the right of audience in hearings in private on interim matters ancillary to Intellectual Property Litigation.

Conditions for Grant of Litigator Certificates

6. Litigator Certificates will, unless refused for reasons given in writing, be granted to applicants who:
 - (a) are on the Register of Patent Agents and are Fellows of CIPA;
 - (b) have been so registered for a minimum period of three years;

and

 - (c) have agreed in writing to be bound by the Special Rules of Professional Conduct of CIPA and have agreed in writing to the Special Disciplinary Procedure of CIPA being applied;

and either:

- (d) have successfully undertaken a litigation course validated by CIPA and have had a minimum of six months experience under the supervision of a person who has the right to conduct litigation;

or

- (e) are or have been a solicitor or a barrister entitled to practice before the Courts of England and Wales, or an authorised litigator under the Courts and Legal Services Act 1990

Validation of Litigation Courses

7. Institutions wishing to teach a litigation course validated by CIPA shall submit, or be invited to submit, applications to CIPA.
8. CIPA shall evaluate whether the institution is fit to teach the 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 as litigators in the High Court and on appeal. CIPA shall have regard to the *Validation Guidelines* set out in Schedule II to these Regulations.
9. CIPA shall give a decision in writing whether or not the course has been validated.
10. CIPA 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. CIPA shall have power on reasonable notice to withdraw its validation in the event of any serious shortcomings which are not remedied to its satisfaction.
11. A specimen syllabus for a validated course is set out in Schedule III to these Regulations.

Admission to a Litigation Course

12. The admission requirements shall be as set out in Schedule IV to these Regulations.

Litigators Accrediting Board

13. The duties of the LAB will be to act on behalf of CIPA: in validating and monitoring litigation courses (including evaluating relevant institutions); in considering and, if deemed necessary, altering the syllabus for litigation courses; and in granting, refusing to grant and revoking litigator certificates. Its decisions shall be in writing and, where it decides not to validate a litigation course or to refuse or revoke a litigator certificate, it shall provide its reasons in writing.
14. The members of the LAB shall be appointed by CIPA and shall comprise at least two registered patent attorneys who are Fellows of CIPA and are or have recently been involved in litigation, at least one practising barrister, at least one practising solicitor and at least one lecturer in law at a university in England or Wales.
15. The LAB may appoint a sub-committee for liaison with the institution or institutions applying to teach or teaching validated litigation courses, and to report as to the suitability of the institution or institutions to teach the course.
16. The LAB shall make an annual report to CIPA concerning the applications received for accreditation and those approved, and the applications for litigator certificates received and granted. The report shall include such other matters as appear appropriate to the LAB.

Appeals

17. Any person who is aggrieved by a decision of the LAB on behalf of CIPA under these regulations may:
 - (i) 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
 - (ii) within one month of receiving notification of the outcome of a review, appeal to a person or body of persons appointed by CIPA, who shall not be a current member of the Council of CIPA or a current member of any Committee or body having disciplinary or regulatory powers over CIPA members, but shall have substantial experience in intellectual property litigation. The person or body may:
 - (a) affirm the decision of CIPA; or
 - (b) give directions as to how CIPA should exercise its functions under these regulations including making a direction that CIPA should validate a litigation course or grant the aggrieved person a litigator certificate or refrain from revoking a litigator certificate.

SCHEDULE I

Litigation Experience Guidelines for use during the Transitional Period *(the transitional period expired in November 2003)*

1. In assessing an applicant's experience, CIPA shall consider:
 - (a) whether the applicant has acquired sufficient experience of litigation since qualification as a patent agent; and
 - (b) whether sufficient litigation experience has been acquired in the recent past.
2. Suitable experience should normally include, in the preceding three years, at least one hundred hours involvement in any one year or one hundred and fifty hours spread over three years, such involvement to cover all aspects of litigation from commencement of an action through to trial, *i.e.* the preparation of pleadings, discovery, preparation of witness statements, preparation for trial and attendance at court during a trial. The experience should either involve at least one case which has proceeded to trial or be spread over several cases for which the applicant has had responsibility for the conduct of litigation.
3. An applicant may be accepted if his experience has not been wholly in the previous three years when he has, in total, substantially greater experience than set out in paragraph 2 above. Any applicant must, however, be or have recently been involved in litigation.
4. An applicant may not personally have had conduct of a case which proceeded to trial since many cases settle before trial. However, he should as a minimum requirement have spent time in Court during a trial making structured observation of that trial.
5. Experience that may be taken into account shall include conduct of litigation in the Patents County Court and involvement in litigation in the High Court where the applicant has had responsibility for instructing solicitors and substantial involvement in the conduct of the litigation. CIPA may also take into account experience of litigation before those tribunals before which patent agents habitually practice, including the Opposition Divisions and Appeal Boards of the European Patent Office, the Patent Office and the Patents Court on appeal from the Patent Office. Experience of litigation in other jurisdictions may also be taken into account, particularly where the system of litigation is similar to that in the English High Court. The relevant experience may have been confined to a limited number of cases where those cases were substantial and proceeded a substantial way towards trial, or may be spread over a greater number of cases of greater simplicity. A greater number of hours spread over a wider range of stages of the proceedings will carry more weight.
6. CIPA may also take into account the possession of:
 - (a) a degree in English law;
 - (b) a diploma from a college of law or from a university covering the core subjects for qualifying as a solicitor or barrister in England and Wales;
 - (c) the degree of LLM from Nottingham Trent University;
 - (d) a diploma in Intellectual Property Litigation from Birkbeck College, University of London;
 - (e) a certificate of attendance at one or more special courses for applicants under the transitional provisions.
7. If satisfied that the range and quality of the experience of an individual is substantial, CIPA may, in the case of applicants who have first applied within two years from the date on which CIPA became an authorised body for the purposes of Sections 27 and 28 of the Courts

and Legal Services Act 1990, give exemption from the test.

SCHEDULE II

Course Validation Guidelines

1. CIPA shall visit the institution and liaise with the staff concerned as often as necessary. In particular CIPA 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 course;
 - (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. CIPA shall liaise with the or 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 litigators;
 - (b) the examination and tests conducted by the institution are of an appropriate standard; and
 - (c) the administration and management of the course are effective.
3. The overall aim of a validated course is that by the end a participant should be able to perform competently as a litigator in the relevant courts.

SCHEDULE III

Specimen Syllabus for a Validated Litigation Course

1. The syllabus set out below is subject to alteration as experience and circumstances require and as changes in relevant law and practice may dictate. All alterations shall require the approval of CIPA in writing.

2. Knowledge Base

2.1 General

- 2.1.1. Candidates for the course are expected already to be aware of the creation, liability for infringement of, availability of threats actions in respect of, and defences to infringement of the following statutory intellectual property rights:

- a) Patents
- b) Trade Marks
- c) Copyrights
- d) Unregistered Design Rights
- e) Registered Designs
- f) Supplementary Protection Certificates

- 2.1.2. Candidates are also expected to be aware of the creation of liability for infringement of and defences to infringement of the following common law rights:

- g) Breach of Confidence
- h) Passing-off

- 2.1.3. The course will build on this existing knowledge base to ensure that those exercising litigation rights will be as well qualified as a solicitor to carry out litigation and advocacy work in the fields for which rights are sought. The knowledge base to be covered in the syllabus will deal with court procedure and law of evidence, and will also cover those legal topics which are not already covered by the basic qualifications for admission to the litigation course (see Schedule IV) and which a litigator ought to know in order to practise before the courts. In addition, the course will cover the practical skills needed to act as a litigator and to act as an advocate in chambers matters (which in patent cases do not normally cover orders for discovery or applications for interim injunctions).

2.2 Examination on Knowledge Base

- 2.2.1. The knowledge base shall be tested by a written examination covering the following subjects:

general law relevant to IP litigation (see 2.3.1 below);
civil evidence relating to intellectual property disputes (see 2.3.2 below); and
civil litigation procedure (see 2.5 below).

- 2.2.2. The level of the written examination will be the same as for a university degree in law or professional qualification in law.

2.3 General Law Topics

2.3.1 *General Law Relevant to IP Litigation*

Candidates will be expected to acquire a general awareness of the following topics, and a detailed knowledge of those aspects which concern Intellectual Property Litigation:

English Legal System; Sources of Law; UK and European Law; Functions of Parliament and of the Courts; Construction of UK Statutes, European Conventions and Delegated Legislation; the Doctrine of Precedent and its Application; The Supreme Court Act, County Courts Act, and Courts and Legal Services Act.

The effect of European law on intellectual property rights, in particular the impact of Articles 28, 30, 81, 82, 234 and 295 of the Community Treaty; the doctrine of exhaustion of rights; and the block exemptions for intellectual property.

The Jurisdiction and Judgements Regulation and the Brussels and Lugano Conventions on Civil Jurisdiction and Enforcement.

Criminal Liability under the Trade Descriptions Act 1968, the Copyright, Designs and Patents Act 1988 and the Trade Mark Act 1994.

Contract Law: the requirements for the formation of a valid contract, privity of contract, agency, deeds, implied terms, misrepresentation, mistake, illegality, frustration, exclusion clauses, discharge and breach.

General Defences to actions for tort or for breach of contract, including consent, estoppel and limitation of actions.

Remedies available for tort or for breach of contract including damages, injunctions, account of profits, declarations of non-infringement, and calculation of damages for breach of contract or tort in relation to intellectual property rights.

2.3.2 *Civil Evidence Relating to Intellectual Property Litigation*

Civil Evidence: Types of evidence, admissions, judicial notice, standard and burden of proof, presumptions, *res ipsa loquitur*, competence, compellability, examination, cross-examination and re-examination, character evidence, hearsay, the Civil Evidence Act 1995, opinion evidence, and privilege.

2.4 As well as covering these topics, those who have attended the course should be able to:

analyse material in a legal context, identify the relevant legal issues and present legal argument addressing the issues;

deal with any conflict of laws aspect;

deal with transfers and assignments and other aspects of the law of property; and

appreciate the applicability of the relevant aspects of insolvency and tax law, *e.g.* in licensing deals.

2.5 Civil Litigation Procedure

Candidates will be expected to acquire the knowledge needed to perform competently as a litigator in Intellectual Property Litigation. In particular, the following topics will be covered:

Commencing the action: Summons. How to issue. Service on defendants.

- a. How effected.
- b. Out of jurisdiction - how done
 - i. Jurisdiction and Judgements Regulation/Brussels and Lugano Convention countries
 - ii. Non-Convention countries
- c. Substituted service
- d. Inviting acceptance of service

Acknowledgement of service. Setting service aside.

Statements of Case:

- a. Claim Form and Particulars of Claim
 - i. Time for
 - ii. Purpose of
 - iii. Requirements of
 - iv. Relief to be sought
- b. Defence and Counterclaim
 - i. Time for, effect of failing to serve
 - ii. Purpose of
 - iii. Requirements of
 - iv. Relief to be sought
- c. Reply and Defence to Counterclaim
 - i. Time for, effect of failing to serve
 - ii. Purpose of
 - iii. Requirements of
- d. Amendment of Statements of Case
 - i. When possible
 - ii. Effect of
 - iii. Whether leave needed, *See v Scott Paine Orders*
 - iv. Terms upon which leave granted
- e. Part 20 Claims

Summary judgement, Striking out Claim/Defence/Counterclaim
Judgements by consent.

Interlocutory Remedies:

- a. General Principles - *American Cyanamid*
- b. Cross-undertakings in damages - what are they and how are they given?
- c. Difference between *with notice and without notice applications*

- d. The importance of speed
- e. Interim injunctions
- f. Search Orders
- g. Freezing Orders

Security for costs:

- a. How applied for
- b. When applied for
- c. Repeated applications for
- d. Against whom can they be sought
- e. How security can be given

Payment into court and Part 36 Offers

Preliminary consideration

Allocation Hearings and Case Management Conferences

Applications and Hearings

- a. Application Notices
- b. Hearings on Applications
- c. Summary assessment of costs

Disclosure (CPR Part 31)

- a. How obtained
- b. How limited
 - i. By subject matter
 - ii. By date
 - iii. Who may see - confidentiality orders
- c. Limitations on use of
- d. Privilege
 - i. Legal
 - ii. Against self incrimination (absence of in intellectual property cases)
- e. Difference between disclosure and inspection
- f. Deemed authenticity of documents disclosed unless challenged

Inspection of processes and of equipment

- a. How obtained
- b. Who may see - confidentiality

Seeking discovery or inspection before commencement of the proceedings

Experiments

- a. When to seek
- b. Function
- c. How conducted

Admissions

Requests for further information

Witness Summons

Witness Statements

- a. Purpose
- b. How to put together
- c. Time for

Expert Reports

- a. Purpose
- b. How to put together
- c. Time for
- d. Duties of an expert to the court
- e. Part 35

Exchange of Witness Statements and Expert Reports

Civil Evidence Act Notices

Order of speeches and evidence in Trial

Skeleton arguments

Opening speech, speech for Defendant, closing speech

- a. Functions of each
- b. How to construct
 - i. Factual argument - visual aids
 - ii. Legal argument - authorities

Examination-in-Chief

- a. Function of
- b. What questions permissible - difference between leading and non-leading questions
- c. Declaring witness hostile

Cross-Examination

- a. Function of
- b. What questions permissible
- c. What questions mandatory

Re-examination

- a. Function of
- b. What questions permissible

Obligation to keep a note of the evidence given

The judgement

- a. Complete or partial invalidity

- b. Revocation
- c. Injunction
- d. Delivery up
- e. Destruction on oath
- f. Damages
- g. Account of profits
- h. Certificate of contested validity
- i. Declaration of non-infringement and generally
- j. Costs

Enforcement of orders. The Jurisdiction and Judgements Regulation. The Brussels Convention.

Contempt of Court

Appeals from interlocutory orders

- a. Leave - how obtained
- b. Time limits for
- c. Suspending interlocutory orders pending

Appeals from final orders

- a. Is leave needed?
- b. Time limits for
- c. Suspending injunctions, *etc.* pending
- d. Suspending inquiry as to damages pending

3. Skills Base

- 3.1. This shall comprise practical exercises which shall be assessed and recorded throughout the course rather than by an end-of-course examination. Assessment shall take into account the candidate's ability to:

analyse factual material, identify issues, and find and apply applicable law;

identify appropriate courses of action including advice on resolving disputes in alternative ways;

choose an appropriate forum for a dispute - where to go and why;

draft statements of case;

run disclosure, *etc.*; and

act as advocate in chambers matters (*e.g.* requests for time and applications for striking out, but not including applications for disclosure or applications for interlocutory injunctions which, in patent matters, are dealt with by a Judge in Court).

- 3.2. The skills assessment shall be based on how the students use the knowledge they have; "dummy runs" throughout the course shall be assessed and recorded. The emphasis throughout the skills based part of the course shall be on the management of the

process of litigation. This would include:

Case Management and Planning

Problem identification and goal setting

Project management

Case strategy

Litigation Skills

Fact investigation and analysis

Negotiation and settlement

- 3.3. The assessment methods shall be designed to ensure that all participants achieve the learning outcomes specified for each element of the course. The skills assessment shall comprise three components:

Extended Piece of Work. There are four options for the style of this project: a litigation management report, a conventional analytic dissertation, a reform proposal, or a peer-reviewed article.

A learning portfolio. This would document what is learnt from each stage by the individual and how it has affected his or her working practice. It should contain a summary of the work undertaken for the weekend schools and the reasons for the choice of the *Extended Piece of Work* as well as notes from meetings with tutors.

Post module assignments. A series of written tasks concerning various aspects of the litigation process will be assigned to be completed by participants on the course. Typical assignments will include the preparation of various documents relating to litigation e.g. statements of case, witness statements, instructions to expert, etc. and analytical essays considering aspects of the litigation process. Some of the assignments may involve and may be undertaken as part of a group exercise.

Reflective reports. At the end of each year participants prepare a report which helps them reflect on and evaluate their experience of the course and the implications for their practice. It allows for individual participants to comment on group performance and to offer explanations of where individuals and group performances could have been changed.

- 3.4. It is anticipated that the whole course would centre on six extended weekends over a two year period. These will include four to six hours of lectures concerning the knowledge base, to be supplemented by private study and if necessary by distance learning. However, the weekends will mainly focus on the skills base. The knowledge base shall primarily be acquired by distance learning methods. Participants shall prepare in advance of the weekends by independent study of course materials, reading lists, research and case study documentation. The weekends shall be structured around complex case studies and shall be mainly workshop-based, using group discussions and syndicate exercises. Participants should be expected to perform as litigators in these exercises where they shall face questions and debate, but where they shall also receive

sympathetic and constructive coaching from litigation professionals. Tutors and facilitators shall be chosen from leading practitioners and academics in litigation from the UK and overseas.

4. Outcome Statements for the Litigation Course

4.1. At the conclusion of the course the candidates will have the skills and knowledge to:

- (a) identify the issues that are likely to arise during litigation, make the necessary preliminary investigations, and advise whether it is in the client's interests that litigation should be started or defended;
- (b) decide when to instruct, prepare instructions for, and co-operate effectively with counsel;
- (c) draft and respond to pleadings;
- (d) deal with interim matters *e.g.* for security for costs, be aware of when it is appropriate to act as advocate and when counsel should be instructed, and act as advocate on those matters where it is appropriate to do so;
- (e) advise the client about its obligations under disclosure, and carry out disclosure;
- (f) deal with issues arising at the summons for directions;
- (g) prepare for trial, draft witness statements and deal with notices of experiments and other matters arising;
- (h) help in preparation of skeleton arguments to be filed before trial;
- (i) prepare bundles of papers for the court for use at trial;
- (j) act as a litigator during trial, and deal with issues arising after trial;
- (k) deal with ancillary matters;
- (l) keep the client informed and advised throughout the progress of the litigation;
- (m) keep appropriate records for the taxation of costs and make appropriate applications;
- (n) prepare papers for use by the Court of Appeal on appeal from the Patents Court or from the Patents County Court.

4.2. The candidates shall also be expected to:

- (a) have the skills and knowledge to deal effectively and courteously with the professional representative of the other party or parties;
- (b) know their obligations to the court and the relevant rules of professional conduct; and
- (c) know what they should do in the event of a complaint arising.

- 4.3. The existing range of professional activities of patent attorneys already require many of the skills and much of the knowledge identified above. For example, analytical and advocacy skills, and the preparation of written evidence are necessary in day to day practice before the UK Patent Office, Trade Marks Registry and Designs Registry and before the European Patent Office. At the conclusion of the proposed course, candidates will have extended their existing skills and knowledge so that they can practice as litigators and on appeal in intellectual property litigation before the High Court and the County Courts.

SCHEDULE IV

Basic Qualifications for Admission to the Litigation Course

Those admitted to the litigation course must have done at least one of the following:

- a) passed the examinations for entry on the Register of Patent Agents;
- b) passed the examinations for entry on the list of professional representatives at the European Patent Office;
- c) passed the foundation papers of the JEB;
- d) obtained the Queen Mary College Certificate in Intellectual Property Law by successful completion of the Certificate or of the MSc course with the CIPA special paper;
- e) successfully completed a course equivalent to (d) above.