

**Intellectual Property Litigation Certificate – Module 1 Written Paper**

**17 November 2016**

**Time: 2pm – 4pm**

**Time allowed – Two hours**

**INSTRUCTIONS TO CANDIDATES**

1. You should attempt **all** questions in this paper.
2. Enter the question paper reference number (IPLC1), the question number, and your candidate number in the appropriate boxes at the top of each sheet of paper.
3. Start each question (but not each part of each question) on a new sheet of paper.
4. Use **black ink**.
5. Write on one side of the paper only.
6. Write within the printed margins.
7. Do not use highlighter pens on your answer script.
8. Do not state your name anywhere in the answers.
9. Write clearly, as examiners cannot award marks to answer scripts that cannot be read.

**INFORMATION FOR CANDIDATES**

1. The total number of marks for this paper is 60.
2. At the end of the examination the invigilator will instruct you to:
  - a) Count the number of pages you have used.
  - b) Use the boxes on each page of the answer script to number pages in the format '1 of 25, 2 of 25, etc.'
  - c) Place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3. Do not staple the pages or use adhesive tape or treasury tags.
4. You may take the examination paper out of the examination room.
5. This question paper consists of **seven** pages in total, including this page.

### **Question 1**

What is meant by a 'fact in issue' in legal proceedings?

**1 mark**

### **Question 2**

You act for the claimant in a registered design infringement case. You are preparing for a fully contested, expedited interim application in the Intellectual Property Enterprise Court (IPEC). In the application, your client is seeking an interim injunction to prohibit the defendant from marketing products which, according to your client, infringe its registered design.

**a) Which party is responsible for preparing the court bundle for the interim application?**

**1 mark**

**b) What is the deadline for lodging the trial bundle with the Court for interim applications?**

**1 mark**

**c) Which document is not part of the court bundle but, if used, must also be lodged with the Court and served on the other party?**

**1 mark**

**Total: 3 marks**

### **Question 3**

You are representing a client in a patent infringement action in the High Court. Shortly before trial, you discover a Court of Appeal judgment that is extremely relevant to the central issue in your case. The judgment opens up a line of argument which could be fatal to your case. You explain this to your client and she instructs you not to mention the judgment to the Court.

**Identify the relevant principles and actions you would take when dealing with this instruction.**

**4 marks**

### **Question 4**

Your sister is employed by a small engineering company which, despite its size, is extremely innovative and holds several valuable patents. You are aware that the company is involved in litigation and that your sister is involved in research and development. You or the other attorneys in your firm have not previously acted for the company or your sister in any capacity. Your sister has been asked to swear an affidavit in support of an application for an interim injunction and approaches you in your capacity as a Commissioner for Oaths.

**What course of action should you follow and why?**

**3 marks**

### Question 5

The Court of Appeal is bound by decisions of the Supreme Court and should also generally follow its own decisions. Explain the circumstance(s) under which the Court of Appeal can:

a) **diverge from a decision of the Supreme Court.**

**1 mark**

b) **diverge from its own previous decision.**

**4 marks**

**Total: 5 marks**

### Question 6

You act for a French corporate claimant seeking revocation of patent for a cork in a wine bottle that does not contaminate the wine. The proceedings are in IPEC and based on lack of inventive step over two prior art patent applications.

In its defence, the United Kingdom corporate defendant alleges that its product 'What a Corker!' which is an embodiment covered by the claims of the patent, has been an outstanding commercial success and satisfies a long-felt commercial want for non-contaminating corks. The defendant annexes to its defence a number of documents extolling the virtues of the product and showing substantial sales figures of the product. The documents also include a Queen's Award for Enterprise.

Aware of the impact that this evidence may have on a judge, at a Case Management Conference in IPEC you seek disclosure from the defendant of sales figures of comparable cork products, which are not covered by the claims of the patent. You also seek disclosure of adverse publicity for the 'What a Corker!' product since your client has heard a rumour that the product has received mixed reviews.

In the exercise of his discretion under Part 31, the judge refuses your application. In a short ex tempore judgment, he says that he considers the relevance of commercial success to the revocation action to be marginal. The judge also states that the issues in the case can be resolved by reviewing the disclosure of the two prior art patent applications. The judge says that he has allocated the trial to a fellow judge because his diary is too full. Whilst comforted to some extent by this, your French client states that it wishes to appeal the judge's decision. This is because it is concerned about the 'prejudicial' effect of such evidence on an English judge. The French client says that it is prepared to pay whatever it takes to overturn this decision.

**Please advise the client as to his options for appealing, including the route of appeal and the prospects of success.**

**4 marks**

### Question 7

Your client has been successful after a full trial on liability before the IPEC and has been awarded costs of the action. The client has asked about the principles as to how the costs award will be assessed.

**Explain the basis of the cost award assessment in the IPEC.**

**3 marks**

### Question 8

When interviewing a person who may be an important witness in support of your client's case:

**a) State three things you should tell the interviewee at the start of the interview meeting.**

**3 marks**

**b) What are the three stages used to question the interviewee?**

**3 marks**

**c) In drafting a witness statement, how should the substantive content of the evidence of the intended witness be set out?**

**1 mark**

**Total: 7 marks**

### Question 9

Set out **four** important differences between litigation procedure in the Patents Court and IPEC.

**4 marks**

### Question 10

As a patent attorney, you are a Commissioner of Oaths. A former colleague of yours (now working for another firm of patent attorneys) has a client who wants to swear a lengthy factually complex affidavit in the English language with 15 exhibits for a Search and Seize Order. The colleague and client attend your offices. During introductory pleasantries with your colleague, the client, who is a jovial Italian man, interrupts when you ask your colleague which holy book the client wishes to swear on and says in very broken, halting, hesitant and ungrammatical English that he is happy to swear on the Bible as he was raised a Catholic but, really, he considers himself an agnostic and not sure if he believes in what the Bible says.

**In relation to the above scenario, name four of the steps that you as Commissioner of Oaths should take before administering the oath and signing the jurat.**

**4 marks**

## Question 11

A client comes to you concerned about his newly granted patent for an innovative lever arch file being infringed by a competitor manufacturer who is supplying lever arch files in substantial volumes to two well-known supermarket chains. The competitor's products appear to fall within the claims of the patent although you can see possible arguments against infringement. Having the benefit of patent litigation insurance, the client wishes to act aggressively and speedily against both the manufacturer and supermarket chains. He asks you to draft and send a letter to the manufacturer and supermarket chains requiring them to undertake to cease selling and stocking their lever arch files within 14 days or proceedings will be issued in IPEC. Prior to the meeting, you have done some research and found an obscure patent application that is close prior art and, in your view, will raise strong arguments that the patent is invalid if the intended defendants ever found out about it.

**When drafting the three letters to the manufacturer and supermarket chains:**

- a) **What concerns should you have about their content or whether they should be sent at all?**  
2 marks
- b) **How would you address those concerns in the drafting of the letters?**  
3 marks
- Total: 5 marks**

**See page 6 for questions 12 onwards**

## Question 12

A client comes to you concerned about a competitor marketing a garden hose coupling device LOKRITE that he considers not only infringes his patent but also his registered trade mark, LOKBITE. Your client is the leading manufacturer of garden hose coupling devices. You are an experienced patent attorney but in these days of specialisation, you have not kept up with the law of trade marks, although you did ten years ago study trade mark law as part of your training. You review the papers and come to the conclusion that the case for infringement of the registered trade mark is open, but ultimately believe the patent infringement action will fail.

However, you form the view that the competitor probably intentionally adopted LOKRITE to trade unfairly off the reputation of LOKBITE or, at the very least, took an informed decision to 'sail close to the wind'. The client also says that the competitor has been wrongly telling the market that the LOKBITE hose coupling device has defects, causing water to pour out of the device, and that the competitor has also said that the client's advertisements extolling the watertight virtues of LOKBITE have been investigated by the Trading Standards Office. You discuss the case with your supervising partner, who also knows little about trade marks. He says that it looks like a big case with potentially large billings and says to you there is no reason why you should not do the case. He says, after all, there is no topic under the sun which cannot be learnt if one has books and advice could be sought from the Bar of England and Wales.

**a) What principles should you have in mind in deciding whether to accept the instructions?**

**2 marks**

**b) With those principles in mind, what action would you take, and state your reasons for taking that action?**

**3 marks**

**Total: 5 marks**

## Question 13

You are instructed by Christine Jenkins, who is being sued for infringement of a UK patent by Martyn Howlett. Your firm has recently merged with another firm and some years ago Howlett was a client of this firm. In conversation with a colleague who previously worked for your merger partner it becomes clear that Howlett has previously failed on more than one occasion to enforce this patent and it is clear that he will back down when faced with a determined opponent.

**What ethical considerations does this scenario raise and what action should you take?**

**4 marks**

**Question 14**

- a) Under what circumstances is a decision of the Comptroller General of Patents capable of being the subject of judicial review?

**2 marks**

- b) Can an adverse decision of the Comptroller General which you consider perverse be subject to judicial review proceedings if you are advised that you have the opportunity for a review of the decision before a Hearing Officer? Give a reason for your answer.

**1 mark**

- c) In judicial review proceedings, what will be the main focus of enquiry by the court when it comes to deciding whether such should be granted?

**1 mark**

- d) If the judicial review proceedings are successful, what will the court commonly order should happen to the application which is the subject matter of the judicial review proceedings?

**1 mark**

**Total: 5 marks**

**Question 15**

- a) Why would the court order a 'without prejudice' meeting of experts?

**1 mark**

- b) What are the experts required to produce as a result of such a meeting?

**2 marks**

**Total: 3 marks**

**Total marks [60]**