

PAPER: IPLCI

Question 1

- a) A witness statement contains a statement of truth but is not sworn.
Lying in a written statement is punishable by contempt of court.
An affidavit is signed by the deponent and is sworn (i.e. under oath).
Lying in an affidavit is punishable as perjury.
- b) An affidavit.

Question 2

- a) A judicial review can be applied for within 3 months from when the grounds for judicial review arose. It has been 14 weeks (i.e. more than 3 months) since the decision. Therefore the deadline has passed.
In order for judicial review to be accepted, the first stage requires obtaining permission for judicial review. Only when this permission is granted can the hearing take place. For there to be sufficient grounds for judicial review the claimant must show that the comptroller made a decision that no reasonable comptroller would have made (unreasonable and irrational); the Comptroller did not apply the law correctly or there has been a procedural violation on the Human Rights Act has been violated. It appears there are good grounds for judicial review in light of the fact that there are good arguments for requirements of Art. 11 of PCT being fulfilled. Judicial review is however, limited more to the procedural acts, not the facts on which decision was refused. The content of the case is not relevant; but the conduct of the Comptroller.
- b) Since we needed to file permission for judicial review within 3 months of the Comptroller's decision, which was not done, we will need to request an extension for the time period for applying for judicial review. Given that claimant is in hospital, this may be sufficient grounds for an extension.

Question 3

- a) Client can request reconsideration of the permission to appeal from the IPEC Judge in an oral hearing, within 7 days of the decision. If this is refused, can request permission to appeal from the court of appeal, then to the supreme court if permission to appeal to court of appeal is refused.
- b) To appeal you must show that the decision was wrong in fact or law or there was a serious procedural violation.
Must provide statement of case providing the reasons and arguments as to why the decision was incorrect, state the remedy sought and directions which the claimant wishes the court to make.

Question 4

With regards to Waterpel Ltd, if they are making an infringing product, this would fall under primary infringement of Section 60(1) of the UK Patents Act 1977. Try to obtain an example of the infringing product to determine whether the product does in fact infringe the patent held by the client.

Get information of where Waterpel is carrying out the manufacturing to determine the jurisdiction under which proceedings should be issued.

Given that Waterpel may not have any money, the likely remedy sought here is an injunction from Waterpel to stop manufacture of the infringed product.

With regards to Rhoads PLC, it will be necessary to carry out a company search to determine the relationship between Rhoads and Waterpel and determine if Waterpel is a subsidiary of Rhoads.

If we can establish that Rhoads was “acting in common design” with Waterpel, to the extent that Rhoads was making the acts of infringement carried out by Waterpel his own, then Rhoads could be liable as a joint tortfeasor with Waterpel (Sabaf and Menegheffi) and client could issue proceedings against Rhoads as the second defendant.

Given that Rhoads is a large company, likely to be able to recover damages from them.

Question 5

- a) The limitation period for bringing infringement proceedings against a patent case is 6 years from the time the infringement was carried out. However, the limitation period is renewed with every recurrent act of infringement. Therefore, given that the last known infringing act was 6 months ago, Gemma can issue proceedings within the next five and a half (5.5) years. Gemma cannot issue proceedings against Anthony for acts of infringement that occurred over 6 years ago.
- b) The disadvantage is that Gemma may not be able to recover damages in respect of any infringement that occurred over 6 years ago. Therefore the damages for infringement that occurred over 6 years ago by Anthony cannot be recovered.

It is advisable to issue proceedings as soon as possible and not wait until the end of the renewed limitation period (i.e. not wait 5.5 years). In this way Gemma will be able to recover damages going back 6 years from date of issuing proceedings, meaning damages from prior infringement before the act 6 months ago by Anthony can still be recovered.

This allows maximum amount of damage to be recovered. Also the courts may not look too favourably on Gemma if she knew that she could issue proceedings earlier but did not.

Question 6

- a) A letter before claim may not be appropriate in patent infringement actions because the defendant could issue a threat action against the claimant if they can show that a threat was made (ie. threat that infringement proceedings will be issued) and they can show that they (or another party) was aggrieved by the threat.
- b) In order to avoid a threat action, the letter should be limited to providing details about the patent in suit, so as not to provide any indication of a threat. Also the primary infringer (i.e. if defendant is an importer or manufacturer), then the defendant cannot issue threat proceedings so this needs to be borne in mind.
Is the patent valid and in force? If the patentee knew that the patent was invalid when making a threat, any threat defence may fail.
- c) Whilst there is some conflicting caselaw, there is a serious risk that a letter contains a threat, even if the letter is written without prejudice, the judge may open the letter as evidence to show that a threat has been made.
So the answer is no, writing 'without prejudice' does not alleviate the risk of threat action. Also just putting 'without prejudice' without any real negotiation proposals is unlikely to be sufficient for the court not to allow the letter to be used as evidence. There is also caselaw to state that even if the letter was replete with such negotiation terms, there is still a risk that the Judge will allow it in.
- d) A letter before claim should include as much detail about the patent and the proprietor as possible and invite the potential defendant to provide a response, by requesting any information they may have regarding the content of the patent. Whilst claimant could also issue proceedings first and send a letter before claim as a letter before service, this can have negative cost implications for the claimant and is unlikely to comply with the pre-action PD, so this route is not advisable.

Question 7

- a) This could be sham litigation. Usually when proceedings are settled this quickly, it can be a sign that there is money-laundering involved.
- b) Firm will conduct client due diligence by checking the identity of the client and the other company providing the settlement. Also conduct credit checks/controls to determine where the money is coming from. Is it legal? Should probably flag this with the appointed attorney responsible for checking money-laundering issues. If the money is illegally obtained, firm must inform the National Crime Agency with details of the suspicions. This is usually done without consent of the client since the duty to report such criminal activities overrides the firm's duty to the client.

Question 8

- a) A commissioner for oaths should be impartial. The fact that the deponent is one of his work colleagues means that there is likely to be a personal connection there. Therefore the impartiality as a commissioner for oaths is jeopardised.
In addition the commissioner for oaths should not have any personal interest in the matter. Given that the outcome of the decision is likely to be one where Benedict has a personal interest, there is a clearly a bias here.

Question 9

- a) No. The commissioner for oaths has a duty to ensure that the deponent understands that what is written in the declaration is true. The Argentinean boyfriend does not speak English, and if this is the case, Lucy cannot be sure that the deponent knows that what is in the Declaration is true.
- b) Commissioner for Oaths has to know that the Exhibits referred to in the declaration are those presented. These are missing. Without them Lucy cannot verify the nature of the exhibits and whether these are the ones being referred to.
Also Lucy has a personal relationship with Helen so this may put into question Lucy's impartiality as a commissioner for oaths.

Question 10

- a) A threat has been made against Jeff – provide details of the letter detailing the threat.

That Jeff has been aggrieved by the threat – provide details regarding the fact that his reputation has been put into question, and the fact he is not a primary infringer and therefore the threat is unjustified.

Damages suffered as a result of the threat – goodwill of his suppliers has been damaged, and Jeff is likely to suffer loss of sales if his suppliers stop supplying Jeff.
- b) May want to include malicious falsehood on a cause of action, if it can be verified that the statement made by Speed Bikes is not true and was done in malice. In order to do this must provide:-
- documents/details of the fact that these facts are false;
 - details were written out of malice;
 - Jeff has suffered damages as a result; and
 - relief should be awarded.

- c) The matter will not be concluded, but the two may be heard as one case. Whoever files the claim form first is likely to be the claimant and the other will be a defendant and then their claim will become the counterclaim or defence.

Question 11

The expert needs to have the right qualifications, i.e. knowledge and expertise in the field of influenza virus. The more respected the expert, the more weight the report is likely to have. The expert must not have a conflict of interest. The duty of the expert is to the court foremost and therefore, the expert should be impartial to the parties. The expert must be able to provide his opinion in a way which could be understood by a lay person.

Question 12

- a) A patent attorney's duty to the court overrides the duty to act in the best interests of the client.

In particular, a patent attorney must not mislead the court. Your duty to the court also means disclosing any documents that may adversely affect your case.

Clearly *Moody vs. Davis* is one such document that should be disclosed.

- b) You do not have a duty to inform the opposing side.
- ci) Explain to the client that you have a duty to disclose the *Moody vs. Davis* document and request client's permission to disclose it to the court. If the client refuses, then you cannot disclose the document as this would be contrary to client's instructions but you must withdraw representation if you are likely to mislead the court by not disclosing the document.
- ii) Explain the complaints procedure the firm operates so that the client can lodge a complaint if they wish.

Should try and reason with the client since your duty to the court requires you to disclose *Moody vs. Davis* in order not to mislead the court. If client cannot be reasoned with, withdraw representation.

Question 13

- a) Once all witnesses have provided their account and their statements so that none of the other witnesses can be swayed or influenced by what you have said.

- b) Cannot communicate with a witness until the witness has given his/her statement in trial. It is forbidden to try and coach or influence a witness before they have given their account of events. Although it may be permissible to communicate with a witness if the other side and court agrees.

Question 14

In the Patents Court, documents relating to commercial success should be excluded. For infringement cases, where the patentee has already been served with the particulars relating to the infringed products or process, these do not need to be disclosed.

Where validity of a patent is in issue, do not disclose documents that have a publication date outside 2 years either side of the earliest priority date.

Question 15

Costs on a standard basis – costs reasonable incurred, reasonable in amount and proportionate to the claim. If there is any doubt, costs awarded in favour of the paying party.

Costs on indemnity - costs reasonably incurred, reasonable in amount and proportionate to the claim. If there is any doubt, costs awarded in favour of the party being awarded costs.

Costs can only be rewarded less than or equal to amount actually incurred by the party.

Question 16

The witness's statement is evidence in chief and must be signed and include a statement of truth.

If it is found that a witness has lied in a statement, the witness could be found to be in contempt of court.

You have a duty to your client to keep all confidential information between you and the client until the privilege is lost. Giving vital strategy or tactics is likely to break confidentiality and privilege that exists between you and your client.

The witness is not bound by the same confidentiality, and therefore, if the other side finds out the information you have disclosed, you could be providing vital information regarding the proceedings you do not want the opponent knowing about. You should not reveal anything to the witness that you do not want the other side finding out about.

The written statement should be an account of their statement in their own words of what happened. Revealing details of the case may influence the witness to say what you want them to say to appease you. The statement could be a lie then. Furthermore you have an ethical duty not to mislead/coach/influence a witness. Providing such details could be seen as unethical.