

D YOUNG & CO **INTELLECTUAL** **PROPERTY**

English Law – an introduction

25 April 2022 - CIPA Informals

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1

Presenter

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Overview

1. Legal system of England and Wales
2. Contract
3. Tort
4. Court procedure / litigation

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Legal System of England and Wales



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British constitution

- Unwritten
- No formal separation of powers, but three principal branches of state
 - Legislative: Parliament, including Crown, the House of Commons and the House of Lords
 - Executive: Crown and Government, including Ministers, civil service and members of the police and armed forces
 - Judiciary: Crown and judges, including legally-qualified judges and lay magistrates

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Sources of law - UK

Legislation

- Acts of Parliament
- Statutory instruments

Case law

- 'judge-made law'

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Sources of law - other

EU legislation

- Treaties
- Regulations
- Directives
- Decisions
- Recommendations/
opinions

Other international law and treaties

- Not law as such, unless adopted through legislation
- Can be persuasive

Brexit

- Now what?
 - “Retained law”
 - Withdrawal Agreement
 - Secondary legislation
 - Enforcement

Contract

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Formation

- Offer (cf invitation to treat)
 - *Carlill v Carbolic Smoke Ball Company* [1893] 2 QB 256
- Acceptance
- Consideration - "something of value" –
 - must be sufficient but need not be adequate
- Intention to create legal relations

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Formation

- Privity of contract
 - A contract cannot, as a general rule, confer rights or impose obligations arising under it on any person except the parties to it.
 - *Dunlop Tyre Co v Selfridge* [1915] AC 847
 - NB: Contracts (Rights of Third Parties) Act 1999

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Terms

- Terms of a contract (implied and express terms and why does it matter)
- Conditions
 - Terms which go to the root of the contract
 - Breach gives the right to repudiate the contract
- Warranties
 - Less imperative than a condition – contract will survive a breach
- Innominate Terms
 - Breach may/may not go to the root of the contract, depending on its nature
 - Whether breach repudiates the contract depends on whether the legal benefit of the contract has been removed from the innocent party
 - *Hong Kong Fir Shipping Co Ltd v Kawasaki Kaisha Ltd* [1962] EWCA Civ 7

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Remedies for breach

- Remedies
 - Damages
 - Repudiation
 - Rescission
 - Specific performance

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Contract principles we apply in IP

- Settlement agreements / Undertakings
- Assignments, licensing, collaboration, joint venture
- Ownership (partly a creature of statute, but also of contract)

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Tort

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What is a tort?

- Civil 'wrong', or more accurately the imposition of a civil liability for a breach of obligations which are imposed by law
- Most common is negligence but also:
 - Infringement of IP, passing off
 - Other 'economic torts' (conspiracy, malicious falsehood)

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Negligence

- Duty of care
 - *Donoghue v Stevenson* [1932] AC 562
- Breach of duty
 - *Bolam v Friern* [1957] 1 W.L.R. 583, 587
- Loss
- Causation
 - *Barnett v Chelsea & Kensington Hospital* [1969] 1 QB 428
- Remoteness
 - *The Wagon Mound No 1* [1961] AC 388
- Damages
- Defences

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Tort principles we apply in IP

- Tort law inherent in IP litigation
- Common design
- Breach of confidence
- Tortious damages v equitable remedies

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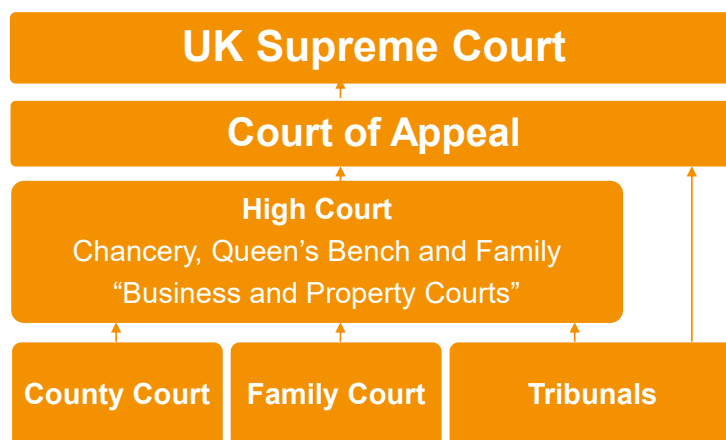
Courts and the judiciary

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Structure of the UK Civil Courts

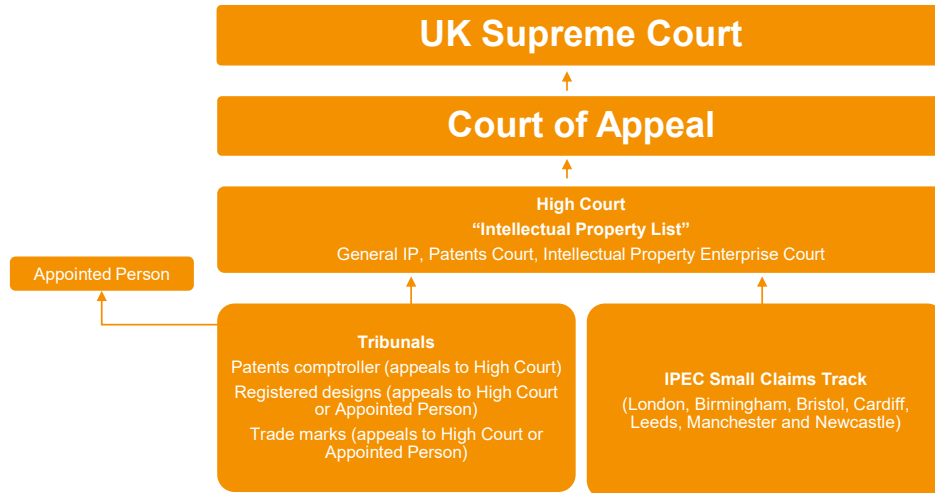


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The UK IP courts and tribunals



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EU courts / Brexit

- Now what? Supremacy of CJEU etc
- EU Courts
 - CJEU
 - Court of Justice
 - General Court
- Unified Patent Court??

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Court procedure / litigation

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Procedure

- Procedural rules and guidance
 - CPR, CPR Part 63
 - Chancery Guide
 - Court Guides (Patents Court, IPEC)
 - Judiciary Practice Statements
 - Acts of Parliament



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Key Stages

- Pre-action
 - Pre-action protocols
 - Settle early?
- Which court and why (IPEC v High Court)
 - Value, complexity, remedies sought, costs considerations

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Key Stages

- Initial Statements of Case
 - Claim Form, Particulars of Claim, Defence, Counter-claim etc...
 - IP Specific (e.g. Grounds of invalidity patents, registered designs)
- Ancillary - Notices to Admit / Requests for Further Information

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Key Stages

- Case management
- Interim applications
 - Interim injunctions, strike out applications, permission to amend pleadings, permission to amend patent
- Settlement
 - Part 36
 - Arbitration / mediation

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Key Stages

- Disclosure/PPD
 - Disclosure Pilot Scheme (infringement or validity)
 - PPD (in lieu of disclosure for infringement)
- Evidence
 - Witness/expert
 - Experiments

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Key stages

- Trial
 - Bifurcation of trials: liability, then quantum
- Remedies
 - Final injunction, delivery up, damages / account of profits, declaration of infringement/validity
- Costs-shifting principle

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Questions?

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