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The patent attorney's rights of representation – the English approach

Brian Cordery (Bristows) · Wednesday, February 9th, 2011

Certain patent attorneys (patent attorney litigators) have the right to conduct intellectual property litigation in England and Wales, being "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" (from the Higher Court Regulations of the Chartered Institute of Patent Attorneys; emphasis added). For certain patent matters they therefore offer an alternative to solicitors, who until recently have had exclusive rights to conduct such litigation before the Courts. A recent case (**Atrium v DSB**) has clarified the extent to which the patent attorney litigator's rights of representation apply.

The litigation concerned royalty payments allegedly due under a technology transfer agreement. Under the agreement, royalties were payable if a product sold by the assignee incorporated certain transferred technology and higher royalties were payable if that product that fell within the claims of the transferred patent rights. The parties disputed whether royalty payments were due on a certain product subsequently sold by the assignee, and the claim proceeded in the High Court (the main first instance court for intellectual property litigation). The assignee was represented by a patent attorney litigator, who sought declaratory relief that they were entitled to act on behalf of the assignee, not least because of the possibility for adverse consequences on costs recovery and privilege if they were not so entitled.

The judge held that despite the somewhat fuzzy wording of the Regulation that it was not limited to a narrow interpretation of "protecting inventions", such as cases involving prosecution and enforcement of patents and related intellectual property. Intellectual property rights could be protected and exploited in different ways – the rights might be exploited by the owner himself, licensed or sold. A royalty dispute would equally concern the "protection" of IP rights for the purposes of the Regulation. The right to act was therefore much broader, and included royalty payments under agreements relating to inventions, even where the payments were deferred. The judge also held that the scope of privilege for patent attorney litigators was co-terminous with the patent attorney litigator's authority to act under the CIPA Regulations.

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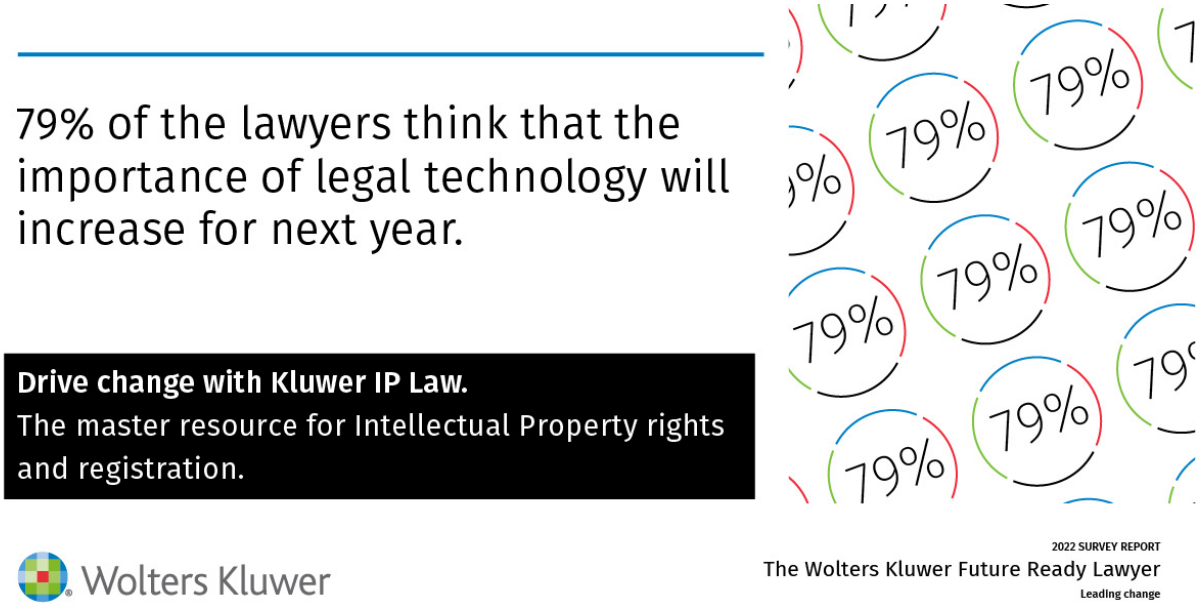

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