

THE INSTITUTE OF TRADE MARK ATTORNEYS

TRADE MARK AND DESIGN LITIGATOR CERTIFICATES: RELEVANT EXPERIENCE GUIDELINES 16 July 2008

Applicants must demonstrate that they have acquired the basic skills necessary to enable them to handle contentious matters and to Exercise the rights of audience available to them on certification (“Relevant Experience”). These skills will require regular exposure to contentious matters over a period of at least 6 months, although whether the experience is in fact sufficient will be assessed on a case-by-case basis. Experience will primarily be proven by way of a Training Record. As a general rule and subject to the discretion of the LAB in particular cases, Relevant Experience must be gained after commencement of the training course in order for there to be an opportunity for the skills learnt to be put into practice.

Relevant Experience can be gained by directly handling the work, by assisting others in the work or by proper observation of experienced practitioners.

For the purpose of assessment, Relevant Experience is made up of 2 elements; experience of the court environment, and experience in professional practice.

Overall, the LAB must be satisfied that in any given case a candidate can demonstrate that he or she has had professional experience that enables him or her to be competent in the conduct of contentious matters and to recognise where the matter is outside their competency.

a) **Experience of the Court Environment**

The candidate must evidence Relevant Experience gained through involvement in or the structured observance of the conduct of contentious proceedings in a court forum covered by the rights granted under these Regulations. It will normally be expected that such experience would span, in total, at least 6 full court working days although more or less may be necessary depending on the quality of the experience. Note that for the purpose of this element, OHIM/UKIPO experience will *not* count, although experience in courts on appeals from these bodies will.

b) **Experience in Professional Practice**

The following non-exhaustive list gives examples of experience types which may be taken into account in assessing whether the Candidate has sufficient Relevant Experience:

- Taking client instructions and identifying the client's objectives
- Assessing and analysing all relevant legal and factual matters
- Preparing a case theory
- Preparing and revising as necessary case plans and schedules
- Instructing Counsel
- Preparing and handling pre-commencement correspondence/negotiations
- Preparing issuing and serving procedural documents in the normal course of a matter
- Evidence handling and management
- Preparing a case for hearing
- Attending hearings
- Handling settlement negotiations and drafting settlement agreements of a kind typical to contentious Trade Mark & Design matters
- Assessing costs and risks and advising accordingly
- Diarising and managing the matter on an ongoing basis
- Keeping proper records and attendance notes
- Proper file and case management
- Appropriate reporting and client care
- Post-determination formalities
- Advocacy, written or oral, before the UKIPO, OHIM or other tribunals, *inter partes* and *ex parte*
- Preparation of skeleton arguments in the UKIPO
- Pre – hearing preparation and planning
- Witness examination
- Generally presenting to peers, clients or other audiences
- Experience gained from training or other litigation courses validated or approved by ITMA or by other Regulators of persons having rights of representation.

For the avoidance of doubt, experience in the conduct of contentious matters and of advocacy, written or oral, before the UKIPO and OHIM is capable of being sufficient Relevant Experience for the purpose of this element, although whether it is sufficient in any particular case will depend on the facts. Experience of other kinds and before other tribunals, or of the handling of contentious matters in other fields, can also be taken into account to the extent it demonstrates the necessary competencies.

c) **The Training Record**

The candidate must keep and present to the Litigation Accrediting Board a Training Record, certified by the person supervising the candidate's training who must also confirm that proper training has been received and that the

necessary skills have been acquired. The LAB may raise enquiries or ask for further information to support the Candidate's application or may stipulate further experience that may be required.

Explanatory note

In formulating these guidelines, we have treated the regime for solicitors as being the most relevant comparative model. Thus, we have taken into account the fact that although Trade Mark and Design Litigator rights are, in effect, standard "lower" rights the LLM is in content closer to a "Higher Rights" course so that successful candidates have had significantly more training than a solicitor will typically have received before qualification. Indeed, it is considered that the LLM course, in context, more than covers the litigation content of the Law Society's compulsory requirements.

We have also taken into account the current experience requirements for trainee solicitors. We do not consider it is appropriate that we should insist upon markedly different standards for rights that are equivalent and, indeed, to do so might expose ITMA to regulatory challenge or to competition issues.

Discussions with the SRA confirm that actual exposure to "litigation", strictly so-called, is not required for trainee solicitors. Their requirements pertain to experience of contentious matters at large, including matters which do not involve formal proceedings. Furthermore, experience may be gained pervasively as well as by direct involvement.

In contrast, Trade Mark & Design Attorney work typically inherently involves a significant volume of both formal contentious work and advocacy and it is appropriate that this is taken into account. The SRA confirmed to us that experience of typical trade mark contentious matters –inter partes oppositions, invalidity and revocation proceedings before UKIPO, OHIM and the Designs Tribunal, would be adequate for their requirements. Thus we have similarly provided that experience of contentious trade mark and design matters in the relevant forums may suffice.

Conversely, we do not stipulate the experience must be of Trade Mark and Design Litigation. The legal subject matter of trade marks and designs will already be in the candidate's knowledge. There is thus no specific need to limit experience of litigation to Intellectual Property matters; litigation skills concern process rather than subject matter and so are transportable. This will assist those who seek to gain experience by secondment.

One marked difference from the SRA requirements is that although actual "court" experience is not required of trainee solicitors, we feel that it is important that our Litigators should be familiar with the court environment. Thus we have introduced an additional requirement for candidates to have experience of court either through personal involvement in matters or by attending as an observer. The minimum requirement is 6 days, equivalent to at least 1 day per month over the minimum experience period of 6 months.

Finally, in recognition of the fact that the SRA allows trainees to supplement or “top-up” their training through attendance at courses, we propose to be able to take such additional training into account as well.

As with the SRA model, proper training is certified by the supervising practitioner. The LAB will have the power to assess the experience gained, to call for more evidence and to stipulate that further experience is required.