

PAMIA

REDVERS CUNNINGHAM

Chief Executive, Thomas Miller Professional Indemnity

*Professional Negligence Claims
Against UK IP Professionals*

A Cross Border Focus

www.pamia.co.uk

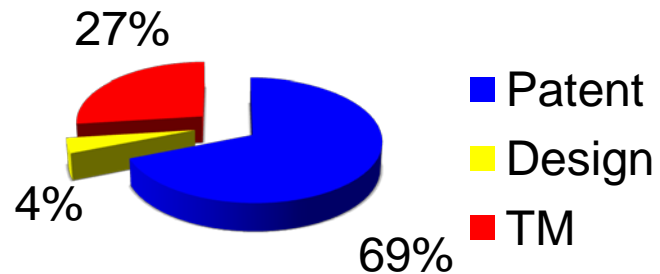
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PAMIA'S UNIQUE PERSPECTIVE

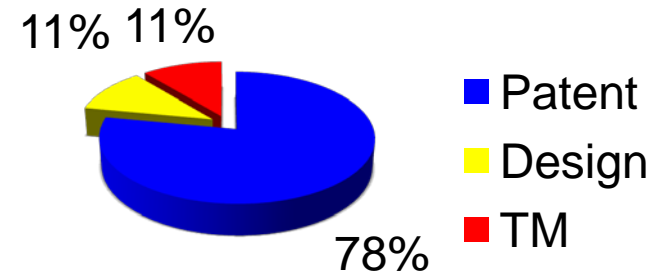
- **A Mutual Insurance Company**
 - Professional Indemnity for UK and Irish Patent and Trade Mark Attorneys
 - Not-for-profit
 - Owned and controlled by its members
 - Outsourced management
- **Established for 25 Years**
 - Response to “hard” insurance market
 - 95% market share
 - High quality cover and service for low premiums
- **Unrivalled Knowledge**
 - 7500 notifications
 - 250 claims
 - £20m paid in damages and legal costs

CLAIMS ANALYSIS

**Number of
Notifications**

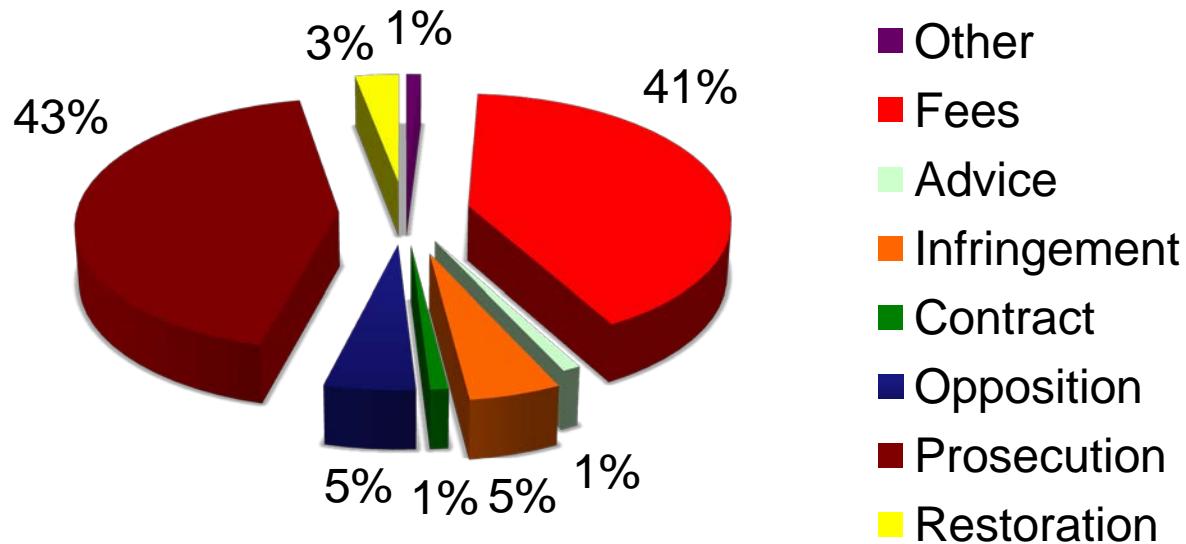


**Value of
Notifications**



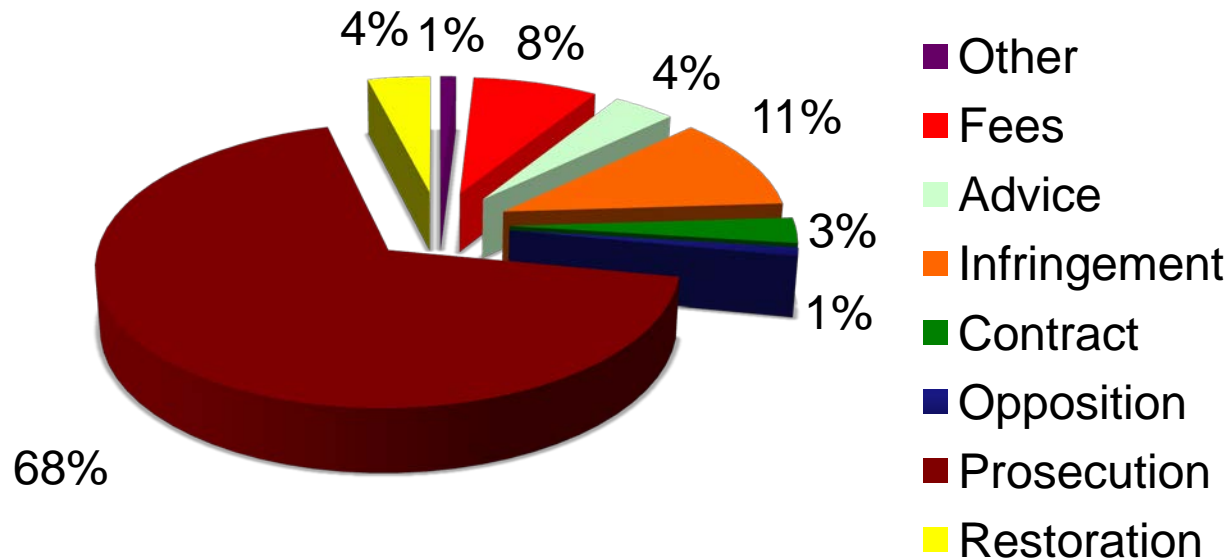
CLAIMS ANALYSIS

Notifications by Type of Work



CLAIMS ANALYSIS

Value of Claims by Type of Work



CASE STUDY 1

- UK attorney paid the renewal fee on a French patent
- French PO recorded the payment against the wrong patent
- French PO issued lapse notices to the attorney of record in France
- French attorney claimed to have forwarded notices to UK attorney
- UK attorney had no record of receiving notices
- Patent lapsed
- French PO would not reinstate patent
- Client was sued for €12m by a licensee for loss of monopoly
- Client sought an indemnity from the UK attorney
- UK attorney sought an indemnity from the French attorney
- Licensee's claim against client failed
- A costly cross-border dispute between attorneys avoided

CASE STUDY 2

- UK client asked UK attorney if a patent remained in force in the USA
- UK attorney asked a US agent who replied that it was still in force
- UK attorney passed on US agent's advice to UK client
- UK client did not launch product on US market as a result
- Later UK client learned that the US patent had in fact lapsed
- UK client unable to sue US agent as US agent bankrupt
- UK client sued UK attorney in New York
- New York courts refused jurisdiction
- UK client sued UK attorney in England for US\$14m
- High Court and Court of Appeal dismissed the claim
- Held UK attorney entitled to rely on the advice of US agent

CASE STUDIES 3 & 4

Case Study 3

- UK attorney instructed Japanese attorney to file patent application
- Japanese attorney acknowledged instructions
- Japanese attorney confirmed action would be taken by due date
- Japanese attorney missed the deadline
- Client lost opportunity to secure patent rights in Japan
- Client sought £35m compensation from UK attorney
- UK attorney not at fault and not liable to compensate the client

Case Study 4

- UK attorney instructed Indian attorney to file patent application
- Instructions sent by email to an out-of-date email address
- Instructions not acknowledged
- UK attorney did not seek acknowledgement
- Filing deadline missed
- Client lost opportunity to secure patent rights in India
- UK attorney at fault and liable to compensate the client

SUMMARY & GUIDANCE

- Claims against IP professionals are rare
- When claims do happen they can be for very large sums of money
- Claims often have an international dimension
- Reliable and secure communication is the key to reducing errors
 - Select reputable agents
 - Issue timely and clear instructions
 - Ensure instructions are acknowledged and understood
 - Agree who is responsible for what
 - Seek regular progress reports