



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



CIPA

The Chartered Institute of Patent Attorneys

Patents • Trade Marks • Designs • Copyright

Recognising Potential Conflicts in IP Law

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Professional Rules in the UK and the EPI

UK Patent & Trade Mark Attorneys are regulated by the
IP Regulation Board – “IPReg”

The Patent Regulation Board of the Chartered Institute of Patent Attorneys and
the Trade Mark Regulation Board of the Chartered Institute of Trade Mark Attorneys
– work jointly together as IPReg.

IPReg looks after the official Registers of Patent Attorneys and Trade Mark Attorneys,
and deals with Professional Conduct and Discipline.



IPReg Rules of Conduct

2015 – last amended July 2019

Rule 7 – Conflicts

A regulated person must not act where his interests conflict with those of a client or of a **former** client, or where he knows or has reasonable grounds for suspecting that the interests of any partner or regulated person or staff of his firm, conflict with those of a client or of a former client.

Provided in all the circumstances it is reasonable to do so, a regulated person may act for two or more clients, or for a client as against a former client, in relation to the same or a related matter in a situation of conflict, ... but only if all of the parties have given their informed **consent** in writing. Regardless of consent a regulated person must, however, refuse to act on behalf of conflicting or potentially conflicting parties in contentious matters, in circumstances where the regulated person's actions would not be **seen** to be neutral ...



IPReg Rules of Conduct

Guidance

7.1 If a regulated person acquires ... relevant knowledge concerning a current or a former client in the course of acting for that client in any capacity, the regulated person should not accept instructions to act against that client ... The term “relevant knowledge” should mean knowledge of the client or the client’s affairs that is not widely disseminated to the public and that is ... relevant to the action concerned against the client.

7.2 A regulated person must not allow any person to perform work under his supervision when the regulated person knows or has reasonable grounds for suspecting that such a person has a conflict of interest in respect of the work.



IPReg Rules of Conduct

Guidance (continued)

7.3 *A conflict may not arise simply because the regulated person acts for two or more parties in the same general field of business or technology although on the facts it may do so. More typically a conflict arises by references to the specific subject matter of a case. ...*

7.4 *Confidentiality safeguards within firms or between branches may be sufficient to “cure” conflict, provided informed written **consent** is obtained from all parties and suitable arrangements to ensure the confidentiality of information applying to each client are in place. ...*

7.5 *All regulated persons should undertake a “**conflict check**” before taking on a new client. ... The minimum expected is a check with all other relevant persons that acceptance of a named client is not likely to compromise the interests of a client already on the books.*



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Institute of Professional Representatives before the European Patent Office

Disciplinary Regulation and Code of Conduct

- neither say much about conflict

Article 3 of the Disciplinary Regulation

(2) A professional representative shall refuse ... his services if acceptance ... would necessitate his dealing with a particular matter on which he has represented or advised another client with opposing interests



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Paragraph 4 of the Code of Conduct – Relations with Clients

— — —

(d) In addition to the requirements of Article 3(2) of the Disciplinary Regulation, a member shall decline an order which is in conflict with his own interests. In all such cases, if the order cannot be postponed without possible damage to the client, a member shall accept and perform the order so far as immediately necessary to avoid such possible damage; thereafter he shall resign from the case.

(e) A member must not acquire a financial interest in any industrial right in such circumstances as to give rise to a conflict between professional duty and interest. He must not charge a fee directly related to the outcome of the services he provides.



Legal conflict vs. Political conflict

Distinguish between legal conflict and political conflict

Political conflict may or may not involve legal conflict, and often does not
e.g. business competitors where there is no actual conflict relating to IP rights

- can be quite common in relation to trade marks

But nevertheless your senior client may not be able to countenance your acting for a major business competitor – so if you want to keep your senior client you may be faced with having to decline instructions from your prospective junior client



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Conflict and Consent

Obtaining consent is often the key

Situations that would otherwise present a conflict may well be resolved by obtaining consent from one client or the other, or both

Possibility of separating patents and trade marks

(attorney firm X acts for large pharmaceutical company A in relation to patent work, but files trade mark oppositions against them for large pharmaceutical company B)



Conflict: Europe vs. USA

It is said that Conflict is generally matter-based in Europe, as compared to being generally client-based in the USA.

- but this is a generality, and as we have seen, there is an aspect of client-basis in Europe

Would *Altova GMBH v. Syncro Soft SRL* have been decided differently in Europe?

Can you solve a conflict by sacking a client then commencing proceedings against them?

I think not; seeking consent was the way to go, and of course Syncro Soft SRL would have very probably refused consent – that's life ...



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Thank you for your attention!

For more information please contact:

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