

IP Dispute Resolution in England and Wales: *why sending a US style “Cease and Desist Letter” or old style “Letter before Action” may not be a good idea.*



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Before the Civil Procedure Rules (“CPR”)¹ came into force, a plaintiff’s solicitor would send prospective defendants a *letter before action*. Those letters were meant to intimidate rather than to inform.² They would usually set a short deadline for compliance with their client’s demand with a warning that proceedings would be launched upon the expiry of the deadline without further ado unless the demand was met in full. They rarely went into any detail about the claim or the facts upon which it was based. Some defendants would capitulate upon receiving such a letter but others would ignore them or respond defiantly. As a result, considerable litigation was precipitated by those letters that could and should have been avoided.

Practice Direction – Pre-Action Conduct

The CPR were intended to cut the cost, delay, uncertainty and, indeed, volume of civil litigation. One of the means by which those aims were to be achieved was to require parties to a dispute to exchange information and documents before issuing proceedings. Ever since the CPR came into

force there has existed a free standing practice direction³ that regulates the conduct of parties to disputes before the issue of proceedings. The current practice direction is known as the *Practice Direction – Pre-Action Conduct* (“the **Practice Direction**”).⁴ That Practice Direction requires the exchange of information and evidence before the issue of proceedings.⁵ In many cases, compliance with the Practice Direction resolves the dispute altogether. Where the dispute is not resolved, the courts have power to enquire⁶ into the parties’ conduct and to punish non-compliance with a range of sanctions⁷. Sending an old style *letter before action* could well be regarded as non-compliance,⁸

Code of Practice for Pre-Action Conduct in Intellectual Property Disputes

Shortly after the CPR were introduced *Michael Skrein*⁹ was invited by the Law Society to convene a team of leading intellectual property practitioners¹⁰

³ A practice direction which is not related directly to any specific Part of the CPR.

⁴ http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/contents/practice_directions/pd_pre-action_conduct.htm.

⁵ Section III of the Protocol.

⁶ For instance, paragraph 63.20 (2) of the Part 63 practice direction requires a claimant who brings proceedings in the Patents County Court to state in his or her *particulars of claim* whether he or she has sent a letter before claim in accordance with the Practice Direction.

⁷ Para 4.6 provides the following sanctions:

“(1) staying (that is suspending) the proceedings until steps which ought to have been taken have been taken; (2) an order that the party at fault pays the costs, or part of the costs, of the other party or parties (this may include an order under rule 27.14(2)(g) in cases allocated to the small claims track); (3) an order that the party at fault pays those costs on an indemnity basis (rule 44.4(3) sets out the definition of the assessment of costs on an indemnity basis); (4) if the party at fault is the claimant in whose favour an order for the payment of a sum of money is subsequently made, an order that the claimant is deprived of interest on all or part of that sum, and/or that interest is awarded at a lower rate than would otherwise have been awarded; (5) if the party at fault is a defendant, and an order for the payment of a sum of money is subsequently made in favour of the claimant, an order that the defendant pay interest on all or part of that sum at a higher rate, not exceeding 10% above base rate, than would otherwise have been awarded.”

⁸ See para 4.4 of the Practice Direction for examples of non-compliance.

⁹ Mr. Skrein is a solicitor specializing in intellectual property law who was then with *Richards Butler*. He later moved to *Reed Smith*.

¹⁰ David Atfield, BBC, Geoff Bayliss, Boulton Wade Tennant, Liz Coleman, The Patent Office, Marcus Dalton, SmithKline Beecham, Susan Davey, BBC (who replaced Elizabeth Gibson of the BBC), Bridget Doherty, Department of Constitutional Affairs (who replaced Pat Reed), Sir Hugh Laddie, Tom Mitcheson, Three New Square, Jonathan Rayner James QC, Hogarth Chambers

¹ <http://www.justice.gov.uk/guidance/courts-and-tribunals/courts/procedure-rules/civil/>

² In the USA before action are called “cease and desist” letters. A database of cease and desist letters has been compiled by Harvard and a number of other US universities at <https://www.chillingeffects.org>.

with a view to drawing up a pre-action protocol¹¹ for intellectual property litigation. Some time after the team had begun its work, the government of the day decided to consider alternatives such as a single all-purpose pre-action protocol and the idea of one or more pre-action protocols for intellectual property was dropped. Rather than waste its work, the team published its proposals as a *Code of Practice for Pre-Action Conduct in Intellectual Property Disputes* (“**the Code**”). Although the Code has no official status it has been welcomed by many practitioners and is often used in conjunction with the Practice Direction.

Duty to send a Letter before Claim

Both the Practice Direction and the Code require a claimant to set out his or her case in writing before issuing proceedings unless there is a very good reason for not doing so. Paragraph 7.1 (1) of the Practice Direction refers to such a letter as a *letter before claim* and paragraph 3.1 of the Code calls it a *letter of claim*. Both the Practice Direction and Code make clear that the purpose, style and content of such letters should be very different from an old style letter before action. Paragraph 7.1 (1) of the Practice Direction goes so far as to state that a letter of claim is *not* the start of proceedings.

Good Reasons for not sending a Letter

Both the Practice Direction and Code give examples of circumstances where a letter before claim need not be sent to a prospective defendant.

Paragraph 2.2 of the Practice Direction lists:

- (1) applications for an order where the parties have agreed between them the terms of the court order to be sought (“consent orders”);
- (2) applications for an order where there is no other party for the applicant to engage with;
- (3) most applications for directions by a trustee or other fiduciary;
- (4) applications where telling the other potential party in advance would defeat the purpose of the application (for example, an application for an order to freeze assets).

Paragraph 2.2 of the Code suggests a few more:

Judith Sullivan, the Patent Office, Clive Thorne, Denton Wilde Sapte, Jeff Watson, The Patent Office, Carolyn Jones, Richards Butler (Clerk) and Michael Skrein, Richards Butler (Chair).

¹¹ A pre-action protocol is a procedure for identifying the issues, exchanging information and attempting to resolve a dispute for specific types of litigation. There are pre-action protocols for personal injury, clinical disputes, construction and engineering, defamation, professional negligence, judicial review, disease and illness, housing disrepair, possession Claims based on rent arrears and possession claims based on mortgage arrears.

- where it is reasonable for the claimant to apply for an interim injunction within a time scale or in a manner which does not reasonably allow full compliance with this Code;
- where there is a reasonable and urgent need to issue proceedings to found jurisdiction;
- where the limitation period is about to expire;
- where a claim for unjustified threats might arise; and
- where it would clearly be unreasonable to expect a party to comply with the Code as a result of matters arising from the parties’ previous dealings.

Threats Actions

A unique hazard of intellectual property litigation in the United Kingdom is that threatening proceedings for infringement of a patent,¹² trade mark,¹³ registered design,¹⁴ unregistered design right,¹⁵ registered Community Design¹⁶ or Community trade mark¹⁷ can be actionable. A person aggrieved by such threats, (who need not be the person who was threatened) can claim a declaration that the threats were unjustifiable, an injunction against their continuance and damages for any loss sustained from them. The claim may lie not just against the party upon whose instructions the threats were made but also against the solicitor or other legal representative who made the threats.¹⁸ It follows that considerable care has to be taken in drafting the letter before claim and subsequent correspondence to avoid incurring liability for groundless threats. The paragraph of the Code mentioned in the last paragraph recognizes that there are circumstances when it is better not to send a letter before claim at all.

Contents of the Letter before Claim

Paragraph 2 of Annex A to the Practice Direction prescribes what should be in all letters before claim. That paragraph is supplemented by paragraph 2 of the Code and a number of Annexes for different types of intellectual property claim.

The Practice Direction¹⁹ requires a claimant to give concise details about the claim so that the defendant can understand and investigate the issues without needing to request further information. The letter should include:

- (1) the claimant’s full name and address;

¹² S.70 Patents Act 1977

¹³ S.21 of the Trade Marks Act 1994

¹⁴ S.26 of the Registered Designs Act 1949

¹⁵ S.253 of the Copyright, Designs and Patents Act 1988

¹⁶ Reg. 2 of the Community Design Regulations 2005

¹⁷ Reg. 6 of the Community Trade Mark Regulations 2005

¹⁸ *Brain v Ingledew, Brown, Bennison & Garrett* [1996] FSR 341

¹⁹ Para 2.1 of Annex A to the Practice Direction

- (2) the basis on which the claim is made (i.e. why the claimant says the defendant is liable);
- (3) a clear summary of the facts on which the claim is based;
- (4) what the claimant wants from the defendant;
- (5) if financial loss is claimed, an explanation of how the amount has been calculated; and
- (6) details of any funding arrangement such as a no win no fee agreement that may have been entered into by the claimant.

The letter should also:

- (1) list the essential documents on which the claimant intends to rely;
- (2) set out any alternative to litigation for the resolution of the dispute that the claimant considers suitable and invite the defendant to agree to this;
- (3) state the date by which the claimant considers it reasonable for a full response to be provided by the defendant; and
- (4) identify and ask for copies of any relevant documents not in the claimant's possession and which the claimant wishes to see.²⁰

Finally, unless the defendant is known to be legally represented the letter should –

- (1) refer the defendant to the Practice Direction and, in particular, draw attention to the court's powers to impose sanctions for failure to comply with the Practice Direction; and
- (2) inform the defendant that ignoring the letter before claim may lead to the claimant starting proceedings and may increase the defendant's liability for costs.²¹

Paragraph 3.2 of the Code is to similar effect.²²

Breach of Confidence Claims

Where a claimant alleges a breach of confidence, the letter before claim should identify the nature of the confidential information and state why it is confidential. Should the confidential nature of that information make it difficult for the claimant to disclose details in the absence of a formal confidentiality regime, the letter should attempt to establish such a regime.²³ The letter before claim

should state how the confidential information came into existence²⁴ and provide details of the claimant's ownership of the information,²⁵ and how the defendant came into possession of it.²⁶ It should state why the circumstances in which the information was communicated gives rise to a duty of confidence. If the claimant relies on a non-disclosure agreement or other contract the letter should contain details of the contract.²⁷ Finally, the letter should state how the defendant has breached, or is likely to breach, the duty of confidence including, if known, the name of the person to whom it is believed that the defendant has disclosed, or will disclose the information and the nature of the disclosure.²⁸

Copyright and Related Rights Claims

Where the claimant alleges infringement of copyright, database right, unregistered design right, unregistered Community design or other related intellectual property right, the letter before claim should provide sufficient information to identify the work, database, design, performance or other creation in which the right is said to subsist. Wherever possible, the letter should include a copy of the item.

In the case of a copyright work, the letter should indicate the type of work according to the descriptions set out in s.1 (1) and s.3 to s.8 of the Copyright, Designs and Patents Act 1988²⁹ and the date on which the work was created.³⁰

In the case of an unregistered design, the letter should state the year of first marketing if the claim is for infringement of an unregistered design right or the year the design was first made available to the public in the EU if it is for infringement of an unregistered Community design.³¹

In the case of a moral right, the letter of claim should identify the author or director and how the paternity right, where relevant, was asserted.³²

The letter should provide details of the claimant's ownership of the allegedly infringed matter.³³ If anyone other than the claimant has a relevant interest in such matter, the letter should give details of that interest and identify the person concerned.³⁴

²⁰ Para 2.2 *ibid*

²¹ Para 2.3 *ibid*

²² "The letter of claim should:-

- (a) state that the letter follows this Code and that the defendant should also do so;
- (b) unless the letter is being sent to the legal advisors of the defendant, enclose a copy of this Code;
- (c) identify the claimant;
- (d) list the remedies that the claimant seeks;
- (e) give details of any funding arrangements entered into."

²³ Para 3.2.A (f) of the Code.

²⁴ Para 3.2.A (g) *ibid*.

²⁵ Para 3.2.A (h) *ibid*.

²⁶ Para 3.2.A (i) *ibid*.

²⁷ Para 3.2.A (j) *ibid*.

²⁸ Para 3.2.A (k) *ibid*.

²⁹ Para 3.2.B (f) *ibid*.

³⁰ Para 3.2.B (g) *ibid*.

³¹ Para 3.2.B (g) *ibid*.

³² Para 3.2.B (h) *ibid*.

³³ Para 3.2.B (i) *ibid*.

³⁴ Para 3.2.B (j) *ibid*.

The letter should list the actions the defendant has taken (or is threatening to take) that have infringed (or will infringe) stating why the activity in question amounts to infringement.³⁵ Where the infringing activity involves making a copy of the claimant's work, the letter should provide sufficient details to enable the defendant to identify the infringing matter.³⁶ The letter should identify as clearly as possible the relevant part or parts of the infringing work that are said to reproduce the claimant's work,³⁷ the relevant part or parts of the claimant's work that have been or will be copied³⁸ and how the defendant has had access to the claimant's work.³⁹ If the claimant intends to claim additional damages the letter should make that clear and identify the acts relied upon.⁴⁰

Passing-off Claims

Where the claimant alleges passing off, the letter before claim should provide sufficient details to identify:

- the mark or get-up relied upon (enclosing a copy of the mark or get-up wherever practicable);⁴¹ and
- the goods or services associated with such mark or get-up and how the mark or get-up has been used in respect of those goods or services.⁴²

The letter should state when the claimant started to use that mark or get-up in respect of those goods or services.⁴³ It should provide sufficient details to identify the size and geographical extent of the reputation or goodwill associated with the mark or get-up relied upon and how long that reputation or goodwill has existed.⁴⁴ It should identify the sign complained of and the goods or services in respect of which the sign has been or will be used,⁴⁵ the activities of the defendant complained of⁴⁶ and the confusion that those activities have caused or are likely to cause⁴⁷ with examples.⁴⁸

Patent and Registered Design Claims

Where the claim relates to a patent or registered design, the letter before claim should identify the patent or registered design in suit and enclose a

copy of the specification.⁴⁹ It should indicate the proprietor⁵⁰ and anyone else with a relevant interest in the patent or design registration⁵¹ and the nature of his or her interest.⁵²

If it is alleged that the patent or registered design has been infringed, the letter before claim should identify the activities of the defendant complained of and state why those actions have infringed or will infringe.⁵³ In the case of a patent, the letter should identify the claims of the patent which have been or will be infringed.⁵⁴

Where the claimant wishes to revoke a patent or registered design, the letter should identify the grounds for invalidity and/or revocation and, wherever possible, cite any relevant prior art of which the claimant is aware.⁵⁵

Where the claimant is seeking the defendant's agreement that certain activities do not infringe the patent or registered design, the letter should set out those activities in sufficient detail for the defendant to understand the activities.⁵⁶

Where the claimant says that he or she is entitled to the patent or registered design, the letter should explain his or her reasons for making such claim.⁵⁷

Registered Trade Marks Claims

Where the claim relates to a registered trade mark, the letter before claim should identify the mark, its number, class and date of registration and the relevant part of the specification relied upon. It should also enclose a copy of the specification.⁵⁸ It should identify the registered proprietor⁵⁹ and if anyone other than the claimant has a relevant interest in the registered mark, the letter should give details of that interest and identify the person concerned.⁶⁰

In an infringement claim, the letter should provide sufficient details to identify the goods or services in respect of which the registered mark has been used if more than 5 years have elapsed since the mark was registered.⁶¹ Where the claimant intends to rely on goodwill and reputation in relation to the goods or services in respect of which the registered mark

³⁵ Para 3.2.B (k) *ibid.*

³⁶ Para 3.2.B (l) *ibid.*

³⁷ Para 3.2.B (m) *ibid.*

³⁸ Para 3.2.B (n) *ibid.*

³⁹ Para 3.2.B (o) *ibid.*

⁴⁰ Para 3.2.B (p) *ibid.*

⁴¹ Para 3.2.C (f) *ibid.*

⁴² Para 3.2.C (g) *ibid.*

⁴³ Para 3.2.C (h) *ibid.*

⁴⁴ Para 3.2.C (i) *ibid.*

⁴⁵ Para 3.2.C (j) *ibid.*

⁴⁶ Para 3.2.C (k) *ibid.*

⁴⁷ Para 3.2.C (l) *ibid.*

⁴⁸ Para 3.2.C (m) *ibid.*

⁴⁹ Para 3.2.D (f) *ibid.*

⁵⁰ Para 3.2.D (g) *ibid.*

⁵¹ Para 3.2.D (h) *ibid.*

⁵² Para 3.2.D (h) *ibid.*

⁵³ Para 3.2.D (i) *ibid.*

⁵⁴ Para 3.2.D (j) *ibid.*

⁵⁵ Para 3.2.D (k) *ibid.*

⁵⁶ Para 3.2.D (l) *ibid.*

⁵⁷ Para 3.2.D (m) *ibid.*

⁵⁸ Para 3.2.E (f) *ibid.*

⁵⁹ Para 3.2.E (g) *ibid.*

⁶⁰ Para 3.2.E (h) *ibid.*

⁶¹ Para 3.2.E (i) *ibid.*

has been used, the letter should state the size and geographical extent of the reputation or goodwill associated with the mark and how long that reputation or goodwill has been in existence.⁶² The letter should also identify

- the sign complained of, the goods or services to which the sign is or will be applied and the subsection(s) of s.10 of the Trade Marks Act 1994 that the claimant relies upon;⁶³
- the activities of the defendant complained of;⁶⁴
- any confusion that these activities have caused or are likely to cause;⁶⁵ and
- any instances of confusion currently relied upon.⁶⁶

Where the claimant wishes to revoke a trade mark, the letter should specify the grounds for invalidity and/or revocation relied upon.⁶⁷

Where the claimant is seeking the defendant's agreement that certain activities do not infringe the registered mark, the letter should set out those activities in sufficient detail for the defendant to understand the allegation.⁶⁸

Where the claimant says that he or she is entitled to the registered trade mark, the letter should explain the claimant's reasons for making such a claim.⁶⁹

Claims for Groundless Threats

Where groundless threats are alleged, the letter before claim should identify the correspondence or other activities complained of (enclosing wherever possible copies of any correspondence upon which the claimant relies)⁷⁰ and the statutory basis for the claim.⁷¹

Duty to Respond

Both the Practice Direction⁷² and Code⁷³ require a defendant to respond in full to the letter before claim within "a reasonable period of time." Paragraph 7.2 of the Practice Direction recognizes that a *reasonable period of time* will vary depending on the matter. The Code states that In almost all cases a defendant will be expected to have provided a substantive response within 28 days of receiving

the letter before claim.⁷⁴ If the defendant cannot respond in full within 14 days or, if the letter before claim specifies a shorter period of time, the defendant should contact the claimant and explain why he or she cannot meet the deadline and offer a date by which he or she will be in a position to respond.⁷⁵ If the reason for the delay is that the defendant intends to seek advice, then the defendant should say so⁷⁶ and indicate from whom he or she is seeking such advice.⁷⁷ Also, the defendant should state whether an insurer is or may be involved.⁷⁸ If so, the defendant should state the date by which the defendant or insurer will provide a full written response⁷⁹ and request any further information that may be required to provide a full response.⁸⁰

Substantive Response

The defendant should accept the claim in whole or in part or state that the claim is not accepted.⁸¹

Unless the defendant accepts the claim in full, his or her letter of response should:

- (1) give reasons why the claim is not accepted, identifying which facts and which parts of the claim (if any) are accepted and which are disputed, and the basis of that dispute;
- (2) state whether the defendant intends to make a counterclaim against the claimant (and, if so, provide information equivalent to a claimant's letter before claim);
- (3) state whether the defendant alleges that the claimant was wholly or partly to blame for the problem that led to the dispute and, if so, summarize the facts relied on;
- (4) state whether the defendant agrees to the claimant's proposals for alternative dispute resolution and if not, state why not and either suggest an alternative form of ADR or state why none is considered appropriate;
- (5) list the essential documents on which the defendant intends to rely;
- (6) enclose copies of documents requested by the claimant, or explain why they will not be provided; and
- (7) identify and ask for copies of any further relevant documents, not in the defendant's possession that the defendant wishes to see.⁸²

The Code further provides that if the claim is accepted in whole or in part, the letter of response

⁶² Para 3.2.E (j) *ibid.*

⁶³ Para 3.2.E (k) *ibid.*

⁶⁴ Para 3.2.E (l) *ibid.*

⁶⁵ Para 3.2.E (m) *ibid.*

⁶⁶ Para 3.2.E (n) *ibid.*

⁶⁷ Para 3.2.E (o) *ibid.*

⁶⁸ Para 3.2.E (p) *ibid.*

⁶⁹ Para 3.2.E (q) *ibid.*

⁷⁰ Para 3.2.F (f) *ibid.*

⁷¹ Para 3.2.F (g) *ibid.*

⁷² Para 7.1 (2) of the Practice Direction.

⁷³ Para 4.1 of the Code.

⁷⁴ *Ibid*

⁷⁵ *Ibid*

⁷⁶ Para 3.5 (1) of Annex A to the Practice Direction

⁷⁷ Para 3.5 (2) *ibid.*

⁷⁸ Para 3.2 (1) *ibid*

⁷⁹ Para 3.2 (2) *ibid*

⁸⁰ Para 3.2 (3) *ibid*

⁸¹ Para 4.1 of Annex A to the Practice Direction

⁸² Para 4.2 *ibid*

should state which parts of the claim are accepted and which are rejected. It should also indicate which remedies the defendant is willing to offer. If the defendant is prepared to cease all or any of the activities complained of, the response should identify those activities and state whether he or she is prepared to give undertakings not to repeat them.⁸³ If the defendant is willing to offer a financial remedy, the letter should provide sufficient information to enable the claimant to determine the basis upon which the sum has been calculated. In such circumstances it may be reasonable for the defendant to require such information to be kept confidential by the claimant or his or her advisors.⁸⁴

If the defendant requires more information, he or she should specify precisely what information is needed to enable the claim to be dealt with and why.⁸⁵

In addition to the information specified by the Practice Direction, the Code requires a defendant to give details of any funding arrangements entered into where he or she rejects the whole claim.⁸⁶

In a breach of confidence claim, the defendant should state his or her defence, specifying, if such be the case, why he or she disputes that:

- (1) the information is confidential,
- (2) it is owned by the claimant, or that
- (3) any obligation of confidence has been or will be breached.⁸⁷

If the defendant disputes the subsistence of copyright or related right, originality, title or infringement, the letter of response should explain why.⁸⁸ The letter should also state whether the defendant is prepared to enter into a licence with the claimant.⁸⁹ If the defendant intends to counterclaim for groundless threats, the letter of response should set out the same particulars as would be set out in a letter before claim.⁹⁰

If the defendant to a passing off claim disputes the subsistence of goodwill or reputation in a mark or get-up the letter of response should explain why.⁹¹ If he or she wants to enter a licence the letter should state that too.⁹²

If the defendant disputes the validity of a patent or registered design, the letter of response should identify the grounds for invalidity relied upon and,

where possible, specify any relevant prior art of which the defendant is aware.⁹³ The letter should also state whether the defendant is prepared to enter into a licence.⁹⁴ If he or she intends to counterclaim for groundless threats, the letter should set out the same particulars as would be set out in a letter before claim.⁹⁵

Where the defendant to a trade mark claim challenges the claimant's description of any reputation or goodwill in his or her mark, the letter of response should state the reasons for the challenge.⁹⁶ Similarly, where the defendant disputes the claimant's description of the defendant's sign, goods or services, the letter should identify the defendant's mark, get-up, goods or services.⁹⁷ Where the defendant relies upon any of the defences set out in s.10, s.11 or s.12 of the Trade Marks Act 1994, the letter of response should state the defence or defences relied upon.⁹⁸ In particular, where the defendant relies upon another registered trade mark pursuant to s.11 (1) of the Trade Marks Act 1994, the letter should provide sufficient details to identify that registered trade mark, including the number, class and date of registration. It should also enclose a copy of the registration.⁹⁹ Where the defendant disputes the validity of the registered mark, the letter should state the grounds for invalidity and/or revocation.¹⁰⁰ The letter should also state whether the defendant is prepared to enter into a licence.¹⁰¹ If the defendant intends to counterclaim for groundless threats, the letter of response should set out the same particulars as would appear in a letter before claim.¹⁰²

Should a defendant to a groundless threats claim disagree with the claimant's characterization of the meaning of any words complained of, the letter of response must state the reasons for disagreeing.¹⁰³

Claimant's Reply

A reply should be confined to a response to a counterclaim or to any positive defence that the defendant may have raised such as the invalidity of a patent, trade mark or registered design.¹⁰⁴ If the defendant has requested documents or information

⁸³ Para 4.2 (b) of the Code

⁸⁴ Para 4.2 (c) *ibid*

⁸⁵ Para 4.2 (d) *ibid*

⁸⁶ Para 4.2 (g) *ibid*

⁸⁷ Para 4.2.A (h) *ibid*

⁸⁸ Para 4.2.B (h) *ibid*

⁸⁹ Para 4.2.B (i) *ibid*

⁹⁰ Para 4.2.B (j) *ibid*

⁹¹ Para 4.2.C *ibid*

⁹² Para 4.2.C (k) *ibid*

⁹³ Para 4.2.D (h) *ibid*

⁹⁴ Para 4.2.D (i) *ibid*

⁹⁵ Para 4.2.D (j) *ibid*

⁹⁶ Para 4.2.E (h) *ibid*

⁹⁷ Para 4.2.E (i) *ibid*

⁹⁸ Para 4.2.E (j) *ibid*

⁹⁹ Para 4.2.E (k) *ibid*

¹⁰⁰ Para 4.2.E (l) *ibid*

¹⁰¹ Para 4.2.E (m) *ibid*

¹⁰² Para 4.2.E (n) *ibid*

¹⁰³ Para 4.2.F (h) *ibid*

¹⁰⁴ Para 5.2 of Annex A to the Practice Direction.



the claimant should provide them or explain why he or she cannot do so.¹⁰⁵

What Happens Next

If the parties have complied with the Practice Direction and Code they should have all the information they need to understand the issues in dispute, to assess the strength of their own and their opponent's case and to decide what steps to take next. Issuing proceedings is, of course, an option but others include a meeting of the parties, experts or legal advisers to agree or narrow issues, mediation, arbitration or some other forms of alternative dispute resolution. These options are explored in "Intellectual Property Dispute Resolution in the UK."¹⁰⁶

Mediation

Mediation can best be described as chaired negotiation. A skilled mediator helps the parties to find common ground and facilitates settlement. This process requires the consent and active co-operation of all parties. Although the courts can encourage parties to consider mediation and even impose sanctions if they fail to co-operate they cannot oblige them to do so.

NIPC Ltd. offers a specialist mediation service for intellectual property claims. Mediators include *Jane Lambert*, a barrister and member of the WIPO arbitration, mediation and domain name dispute resolution panels, *Michael Swift*, an experienced forensic accountant, and *Peter Back*, a former hearing officer and mediator with the Intellectual Property Office. Further information about this service can be obtained from the NIPC Mediation website at <http://www.nipc-mediation.co.uk> or by calling **0800 862 0055**.

The Intellectual Property Office, World Intellectual Property Office and a number of other bodies also provide IP mediation services, all of which are listed in a booklet which is updated regularly by the IPO.¹⁰⁷

Arbitration

Arbitration is the determination of a dispute by a third party ("an arbitrator") appointed by or on behalf of the parties pursuant to an agreement to refer a current or future dispute to arbitration ("arbitration agreement"). The arbitration agreement usually specifies the law and procedure that the arbitrator shall follow. Often that follows the procedure of the

court with disclosure, examination and cross-examination of witnesses and submissions of law but the parties can agree to a simpler procedure that dispenses with any of those formalities. The World Intellectual Property Office offers specialist arbitration for intellectual property claims as does NIPC Ltd. Further information can be obtained from the NIPC Arbitration website at <http://www.nipcarb.co.uk> or by calling **0800 862 0055**.

Further Information

If you want to discuss any point in this article or any IP dispute in which you are involved, do not hesitate to call me on **0800 862 0055** or email me on jane.lambert@nipclaw.com. □

¹⁰⁵ Para 5.1 *ibid*.

¹⁰⁶ Jane Lambert "Intellectual Property Dispute Resolution in the UK" 2 Nov 2011
<http://www.jdsupra.com/post/documentViewer.aspx?fid=d24ef1d9-2f19-411f-a524-ee3849ffa87a>

¹⁰⁷ <http://www.ipo.gov.uk/mediationproviders.pdf>