

THE JOINT EXAMINATION BOARD

SYLLABUS – BASIC ENGLISH LAW PAPER

Syllabus for the examinations under the Examination Regulations pursuant to the Rules for the Registration of Patent Agents and Trade Mark Agents

NOTE:

Candidates will not be expected to display knowledge of amendments to any Statutes or Rules or new case law published subsequent to the three months immediately preceding the date of any particular examination. Knowledge of repealed states or Rules or transitional provisions is not required.

1. Candidates are expected to show a general knowledge of the English legal system, including an appreciation of the differences between civil and criminal jurisdictions and remedies.

They will also need an outline knowledge of the structure of the courts in England (including Appeal Courts and the divisions of the High Court) and an understanding of the doctrine of precedent and the relevance of decided cases (their binding effect on future decision making).

An outline knowledge is required of the manner in which the decisions of courts and tribunals may be challenged. This should include the routes and main grounds for appealing through the English Courts; the availability, procedure and main grounds for seeking judicial review; and the circumstances in which references to the European Court of Justice and the European Court of First Instance may be made.

Candidates will also be expected to have an outline knowledge of the sources of law in so far as they affect the field of intellectual property e.g. statute, secondary legislation, International Convention and custom and precedent.

Candidates are expected to have an outline knowledge of how EU law applies to the UK, particularly with respect to directives and regulations.

Candidates should have outline knowledge of how legislation is made by the UK Parliament in Westminster and by the Institutions of the European Union.

Candidates will be expected to have an outline knowledge of the roles played by registered patent agents, registered trade mark agents, solicitors, barristers and judges.

2. Candidates will be expected to have an outline knowledge of the law of court procedure, in so far as it affects the conduct of intellectual property law cases. The differences between the standard and the burden of proof in civil and criminal procedures must also be appreciated.

Candidates will also be expected to have an outline knowledge of the Civil Procedure Rules, from pre-action procedure to the start of trial. In particular, candidates should be familiar with:

- the over-riding objective
- the 3 Woolf tracks and the allocation of IP disputes to those tracks
- the applicability of pre-action protocols to IP disputes
- where and how to issue proceedings
- an outline of how proceedings can be served
- a timetable for an action and a counterclaim
- an outline of disclosure obligations and procedure
- a good understanding of the reasons and applicability of privilege to communications, with particular reference as to how this applies to the candidates' individual professions
- an outline of the obligations of an expert witness
- an outline of Part 36 CPR and a good understanding of the term "without prejudice", the reasons for and rules relating to its use

Candidates should be familiar with interim orders restraining infringement of IP rights until trial, search and seizure orders and freezing orders. Candidates should know the differences between these interim remedies, the circumstances when it might be appropriate to seek them and have an outline knowledge of the main issues that the Claimant will need to deal with in order to obtain such remedy.

Candidates will be expected to have an outline knowledge of the remedies available to a successful claimant in IP related legal proceedings, appreciating the differences between legal and equitable remedies.

Candidates should also know the general principles governing the award of costs made by the court at the end of trial and at interim hearings, including those governing the court's power to assess costs for immediate payment.

On the topic of evidence, candidates will be expected to know the varieties or types of evidence, including the difference between evidence of fact, evidence of opinion, hearsay evidence, etc, with particular reference to expert evidence and to the conduct and presentation of evidence obtained in market surveys. Candidates should also know the rules of admissibility of written evidence and hearsay evidence in civil proceedings.

The rules governing the form of evidence in proceedings involving intellectual property law cases i.e. whether it should be in affidavit or statutory declaration or witness statement form, should be known thoroughly.

3. In addition candidates will be tested on the law of contract.

Candidates should know the basic elements necessary for the formation of a valid contract, for example, offer, acceptance, consideration, intention, having a thorough understanding of those terms. Candidates should know the difference between an invitation to treat, an offer and a counter-offer, and their effects. Candidates should also have an outline knowledge of the rules for acceptance.

Candidates should be thoroughly familiar with the meaning of the following words, privity, condition, warranty, innominate term, misrepresentation, mistake. Candidates should have an outline knowledge of the remedies available for enforcement of a contract.

Candidates should understand the difference between assignment and novation of a contract.

4. Candidates will be expected to have knowledge of the tort of negligence and the tort of malicious falsehood.

With regard to negligence, candidates should be able to discuss the duty of care, breach, causation and remoteness. They should have an understanding of negligent mis-statement and an appreciation of economic loss.

With regard to the tort of malicious falsehood, candidates should have the ability to discuss briefly each element which needs to be dealt with by the Claimant (or the Defendant) in such a claim.

5. Candidates should have an outline knowledge of the law of personal property and trust as it applies to the ownership of intellectual property rights. Candidates should have an appreciation of the difference between legal and equitable title. They should have a familiarity with the terms joint tenants and tenants in common. They should have an outline knowledge of the differences between oral and written agreements to transfer IP and how defects in legal title can be perfected. Candidates will also be expected to identify any taxes which may arise on the transfer of IP right (detailed knowledge of the tax rates is not required).

6. Candidates will also be expected to have an outline knowledge of the relevant law of companies, namely the nature of a limited liability company. Candidates should understand the principal differences between limited companies and limited partnerships and unlimited businesses, such as partnerships or sole traders. Candidates should understand the differences in liability for the proprietors of those businesses and should also have an outline understanding of the obligations and liabilities of directors of incorporated businesses. Candidates should have an outline knowledge of how investment can be made in businesses and have an understanding of the terms debenture and of fixed and floating charges.

Candidates should also have an outline knowledge of the right to object to a new company name and should also be aware of what rights may or may not exist to use a company name once it has been registered.

7. Candidates will be expected to have an outline knowledge of professional matters, for example the practitioner's ethical, legal and financial responsibilities to his clients and his knowledge of the Rules of professional conduct (including those on advertising, if any) governing the Patent and Trade Mark professions.

Candidates are expected to understand the nature of their contractual, tortious and fiduciary duties to their clients. Candidates should also understand conflict of interest so as to be able to identify when a conflict arises and whether or not they can continue to act in such a circumstance.

March,2002