



Ministry
of Justice

Retained EU Case Law

Consultation on the departure from retained EU case law
by UK courts and tribunals

Consultation Questions

Please submit responses marked for the attention of Joanne Thambyrajah by email to Judicial_Policy_Correspondence@Justice.gov.uk

Q1: Do you consider that the power to depart from retained EU case law should be extended to other courts and tribunals beyond the UK Supreme Court and High Court of Justiciary. Please give reasons for your answer.

No. The powers should be confined to the Supreme Court and should be used sparingly.

The body of case law developed over the years is reasonably stable and well supported by industry. Departing from retained case law risks, and perhaps even invites, increased uncertainty. Moreover, the well-established mechanism for effecting significant change in the law is for the UK Parliament (as sovereign) to legislate and for the UK courts to interpret that legislation. If Parliament is of the view that domestic laws should depart from EU law, it can and should legislate.

In Intellectual Property (IP) law, EU case law has been particularly significant and well-developed in several areas, including in Trade Mark law, in Supplementary Protection Certificates (SPC) in patent law and, to a lesser extent, in Copyright and Design law. For example, UK trade mark law comprises a large body of CJEU decisions built up over 30 years. The decisions are interlinked and create a shared and reasonably stable understanding of how trade mark law is applied.

It is also often difficult in practice to distinguish between binding UK and binding EU case law in this area. To depart from the latter without having an unpredictable impact on the former would contribute to uncertainty. A line of case law may have been initially developed by a case before the High Court and then the Court of Appeal; in a subsequent case, it may have then been affirmed in somewhat different terms in a reference to the CJEU whereupon further domestic cases may have developed its application. What is the UK case law and what is the EU case law is hard to distinguish.

In cases where there is a real need to consider departing from EU case an application could be made to undertake a 'leap frog' appeal from the High Court to the Supreme Court.

Overall, certainty and predictability as to how intellectual property law functions are important to the operation of the system of registration and the enforcement of those rights. Permitting significant divergence by the lower courts from retained EU case law would make it much harder for clients to obtain clear advice from their advisors and would increase costs for SMEs, for which certainty is particularly important.



Q2: What do you consider would be the impacts of extending the power to depart from retained EU case law in each of the options below? Please give reasons for your answer.

- a. The Court of Appeal and equivalent level courts;**
- b. The High Court and equivalent level courts and tribunals;**
- c. All courts and tribunals.**

(a) The Court of Appeal and equivalent level courts;

It would increase the number of appeals in IP infringement cases. Due to EU case law underpinning the legal reasoning in most cases in several areas of IP law, unsuccessful parties would have a greater opportunity to appeal the basis of the underlying case law.

If the Court of Appeal were to have the powers but not the High Court, that would raise the question as to the standard for an appeal. Presently, a party must seek permission to appeal, either from the first instance court or from the Court of Appeal. The standard for permission is that there is a real prospect of success or there is some other compelling reason. This is a difficult test to apply where there might be a prospect of departure from EU case law. On one analysis, even if the court at first instance is right as a matter of law, there will always be a real prospect of success and/or a compelling reason where there can be a departure from EU case law, necessitating an appeal.

There is a risk that if the case law could be changed by different Courts, the current consistency of law would be undermined.

(b) The High Court and equivalent level courts and tribunals;

This would also increase the number of appeals, as cases both where the lower Court departed from retained EU case law and where it did not would be appealed by the losing party.

The impact would be piecemeal changes to law which would potentially lead to uncertainty and inconsistency.

(c) All courts and tribunals.

This would also increase the number of appeals, as cases both where the lower Court departed from retained EU case law and where it did not would be appealed by the losing party.

Decisions by all courts and tribunals would result in piecemeal changes to law which would potentially lead to uncertainty and inconsistency.

Q3: Which option do you consider achieves the best balance of enabling timely departure from retained EU case law whilst maintaining legal certainty across the UK. Please give reasons for your answer.

The option whereby the power is retained by the Supreme Court only.

As discussed in answer to Q1, this would allow a single tribunal to consider the policy behind any changes and to ensure that changes, in particular cases, do not have unintended consequences.

Q4: If the power to depart from retained EU case law is extended to the Court of Appeal and its equivalents, do you agree that the list below specifies the full range of courts in scope?

- i. Court of Appeal of England and Wales;
- ii. Court Martial Appeal Court;
- iii. Court of Appeal of Northern Ireland;
- iv. The High Court of Justiciary when sitting as a court of appeal in relation to a compatibility issue or a devolution issue; and
- v. The Inner House of the Court of Session in Scotland.

Please give reasons for your answer.

N/A See above.

Q5: If the power to depart from retained EU case law is to be extended to the High Court and its equivalents, do you agree that the list of courts below captures the full range of courts in scope?

- i. The High Court of England and Wales**
- ii. Outer House of the Court of Session in Scotland;**
- iii. The Sheriff Appeal Court of Scotland in Scotland;**
- iv. The High Court of Justiciary sitting at first instance; and**
- v. The High Court in Northern Ireland.**

Please give reasons for your answer.

We note the important role of the **Intellectual Property Enterprise Court (IPEC)**, which formally sits within the Chancery Division of the High Court. We expect that if the High Court has the power, it would extend to the IPEC. If the High Court has the power, all tribunals of more or less co-ordinate jurisdiction should have the power.

Q6: In respect of either option, are there other courts or tribunals to which the power to depart from retained EU case law should be extended? If yes, in what circumstances should this occur? Please give reasons for your answer.

We also note the important role of **the Appointed Person**, as a an alternative route of appeal to the High Court from the decisions of the UKIPO in relation to the registration and validity of registered trade marks and registered designs . If the Appointed Person did not have the powers but the High Court did, this could drive appeals away from it (where over 90% of such appeals occur) to the High Court. This would significantly increase time and cost and would particularly affect SMEs.

Q7: Do you consider that the courts and tribunals to which the power to depart from retained EU case law is extended should be permitted to depart from retained domestic case law relating to retained EU case law? If yes, in what circumstances should this occur? Please give reasons for your answer.

It would be consistent for the Courts that have the power to depart from retained EU case law to also have the power to depart from retained domestic law.

Q8: Do you agree that the relevant courts and tribunals to which the power is extended should be bound by decisions of the UK Supreme Court, High Court of Justiciary and Court of Appeal and its equivalents across the UK where it has already considered the question of whether to depart from retained EU case law after the end of the Transition Period, in the normal operation of precedent? Please give reasons for your answer.

Yes. This would be consistent.

Q9: Do you agree:

- a. that the test that should be applied by additional courts or tribunals should be the test used by the UK Supreme Court in deciding whether to depart from its own case law?**
- b. that this test is capable of being easily understood and applied across the jurisdictions by reference to the relevant case law?**

Please give reasons for your answers. If you do not agree, what alternative test do you consider should be applied? Please give reasons for your answer.

We agree that there should be a test. We agree that the UK Supreme Court should apply its existing test.

We have reservations about whether the test is sufficiently clear to be applied consistently by Courts other than the UK Supreme Court.

If the Court of Appeal or equivalents were to have the power our preference would be the narrower test that is currently applied when departing from their own decisions.

Q10: Are there any factors which you consider should be included in a list of considerations for the UK Supreme Court, High Court of Justiciary and other courts and tribunals to whom the power is extended to take into account when deciding whether to depart from retained EU case law? Please give reasons for your answer.

The powers should be used sparingly, to help maintain confidence in the stability of the law.

Q11: As part of this consultation process, we would also like to know your views on how these proposals are likely to impact the administration of justice and in particular the operation of our courts and tribunals.

- a. Do you consider that the changes proposed would be likely to impact on the volume of litigation started in UK courts and tribunals? Please specify where, in your view, this would occur and why?**
- b. Do you consider that the changes proposed would be likely to impact on the type of litigation started in UK courts and tribunals? Please specify where, in your view, this would occur and why?**
- c. Do you consider that the changes proposed would be likely to have more of an impact on particular parts of the justice system, or its users? Please specify where this might occur and why.**
- d. Do you consider that the changes proposed would have more of an impact on individuals with particular protected characteristics under the Equalities Act 2010? Please specify where this might occur and why.**

a. If the power is extended to Courts and Tribunals other than the UK Supreme Court, it is likely to increase the number of appeals.

In addition, with regard to IP cases the uncertainty of outcome is likely to give rise to fewer cases being commenced in the UK Courts. As many IP owners are non-UK businesses with equivalent rights in other jurisdictions they may prefer to fight the dispute in a jurisdiction where the law is more certain.

Q12: Do you have any other comments that you wish us to consider in respect of this consultation.

No comments

Thank you for participating in this consultation.

About you

Please use this section to tell us about yourself

Full name	Matthew Critten
Job title or capacity in which you are responding to this consultation exercise (e.g. member of the public etc.)	Chair, CIPA Litigation Committee
Date	13 August 2020
Company name/organisation (if applicable):	The Chartered Institute of Patent Attorneys
Address	The Chartered Institute of Patent Attorneys 2nd Floor Halton House 20 – 23 Holborn London
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If you would like us to acknowledge receipt of your response, please tick this box	<input checked="" type="checkbox"/> (please tick box)
Address to which the acknowledgement should be sent, if different from above	

If you are a representative of a group, please tell us the name of the group and give a summary of the people or organisations that you represent.

This submission is made on behalf of:

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- **The Chartered Institute of Trade Mark Attorneys**, the professional body for Trade Mark Attorneys in the UK,
 - **The Chartered Institute of Patent Attorneys**, the professional body for Patent Attorneys in the UK,
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and has the support of the leadership of the **Intellectual Property Bar Association**, the specialist bar association for barristers practising intellectual property law in England and Wales
