



IP REVIEW

July 2007

WELCOME...

Welcome to the latest IP Review, which has been put together by our Advanced Engineering Group (AEG) and focuses largely on engineering issues. We hope these articles will also be of general interest, but have included some hot-off-the-press developments in IP law too. The Group is unique amongst UK patent attorney firms, as it brings together an unparalleled depth of hands-on engineering knowledge. There are exciting developments in store for the Group, which we set out on the inside back page.

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Inventive Step is Put to the Test

The requirement that an invention involves an “inventive step” or is “non-obvious” is one of the primary hurdles for obtaining a patent. It is a hurdle unwary patent applicants can stumble over as potentially the test for non-obviousness is quite subjective.

Accordingly, various multi-step tests have been adopted over the years to make the task of determining whether an invention is obvious more objective. To this end the UK courts have been following a four-step *Windsurfing* test for more than 20 years. The test gives a central role to a notional “person skilled in the art” who is aware of everything in the state of the art and who has the skill to make routine workshop developments but not to exercise inventive ingenuity or think laterally – a “nerd” in the words of one judge.

In a recent UK Court of Appeal case, this bedrock of UK patent case law has been amended in a move that could have significant consequences for how inventions are scrutinised at both the application and litigation stage.

The case in question, *Pozzoli SPA v BDMO SA and others*, arose when Pozzoli accused BDMO of infringing its patent for a storage case capable of holding multiple CDs in a space efficient manner. As is usual, BDMO countered that it didn't infringe, and that the patent was obvious and therefore invalid and not capable of being enforced anyway. At the High Court last year the judge sided with BDMO, causing Pozzoli to appeal. So far, nothing new. However, the Court

of Appeal decided that the *Windsurfing* test needed something of a spring clean to make the process of determining “inventiveness” simpler. Specifically, the role of the person skilled in the art was reinforced by switching around the first two questions, so the identification of this person is the first thing the enquirer has to do, and the inventive concept is determined through the skilled person's eyes. Following the change, the test reads as follows:

1. (a) Identify the notional “person skilled in the art”;
(b) Identify the relevant common general knowledge of that person;
2. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
3. Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Cover story continued

The US approach to assessing inventive step is also rooted in a landmark case, the *Graham* decision from the 1960s. Whilst this has formed the basis of all US inventive step decisions since its inception, it has been coloured by the “teaching, suggestion, or motivation” (“TSM”) test which essentially requires that there must be a specific indication to the skilled person why separate documents should be combined to prove obviousness.

In *KSR* the Supreme Court stated that the TSM test should not be applied rigidly, a move which brings the task of assessing inventive step back to the “expansive and flexible approach” originally provided by *Graham*.

Perhaps the most groundbreaking aspect of *KSR* is the additional attributes that have been bestowed upon the skilled person, though. He/she is now not “an automaton” but “a person of ordinary creativity”. Contrast this with the UK skilled person’s utter lack of creativity.

What “ordinary creativity” is will inevitably be argued in the future, but *KSR* makes it clear that the person would at least have an awareness of design needs and market pressures, or whether it would be obvious to try a particular combination to arrive at an invention when a limited number of options are available to him/her.

Whilst the dust has yet to settle, it could mean that US courts will find it easier to invalidate patents on obviousness grounds. It may also bring the US closer to the European approach to assessing inventiveness of combination patents, which requires a surprising beneficial effect derived from the combination of previously known features.

The take-home message from both decisions is that inventors and patent attorneys will have to work closely together to draft clear and comprehensive patent applications that really sell their invention. This should give applicants the best chance of getting them patented, and increases the likelihood they will withstand any future litigation. We have always adopted this approach with our clients, as we take the view that getting an application right in the first place can avoid problems in years to come.

The changes, particularly in America, may also mean that our clients should consider looking again at problem third-party patents of borderline validity, to see if they are now less likely to present a barrier to their plans.

David Roberts and Paul Foot

But the Court did not stop there. It went on to reduce the importance of step 2 when it effectively stated that if the arguments

get bogged down when identifying the “inventive concept” of a patent claim, “the sensible way forward is to forget it!”.

This allows the courts to concentrate on the actual differences between the claimed features of the patent and the features of the known matter, which is ultimately what counts.

This does beg the question of why include this step in the test at all if you can junk it at will. But at least this approach, which focuses more on how the wording of the claim differs to what is already known, seems to bring the UK position closer to the more formal EPO problem-solution test.

Additionally, the decision also clarifies that the right of appeal to the Court of Appeal is not automatic, and gives some guidance on when overcoming a technical prejudice against a particular innovation can help to show that an inventive step is present.

Interestingly; this decision has come hot on the heels of a highly significant US Supreme Court Case, *KSR v Teleflex*, which also considered obviousness.

IP Threats and Opportunities in Automotive Fire Sale

The global automotive industry is under tremendous pressure at the moment due to overcapacity, higher raw material and oil prices and the increasing influence of the environmental lobby. The big automotive conglomerates have sought to restructure by cutting away underperforming units and by a fire sale of non-core assets. It is essential for suppliers, licensees, licensors and other partners of the sold corporations to review their IP position carefully. Withers & Rogers can help by searching portfolios, carrying out status checks, and flagging up matters for review in

No sale has been bigger than DaimlerChrysler's decision to offload Chrysler. The winning bidder, private equity group Cerberus, paid US\$7.4 billion, inheriting 83,000 employees and a loss making business with health care liabilities of US\$12 billion as the price of obtaining legendary automotive brands Dodge and Jeep.

This ownership churn causes uncertainty for suppliers, licensees and licensors. Licensees and licensors should review their agreements to ensure that they still bind the purchaser. Licence agreements often include a change of control clause which give one party the right to terminate when the other party is sold. Such a clause may present an opportunity to renegotiate or to seek alternative licensees. However, where there is a threat, there is normally an opportunity. Suppliers may find that there are fresh sales opportunities within companies freed from the apron strings of the large parent. The sale of Aston Martin by Ford may provide significant opportunities to first tier suppliers, especially in the Midlands region.

During these phases of reorganisation, companies often take the opportunity to rationalise their intellectual property portfolio. Brands, the goodwill associated with them and the registered trade marks that

protect them will often pass to the purchaser but not always. Patent portfolios are often retained by the parent with licence arrangements put in place for the sold company but companies may take the opportunity to abandon older patents or put groups of patents or trade marks up for sale or licensing. This can open up an area of technology for exploitation which had previously been closed off by IP.

If you have current agreements with firms that are restructuring that you would like us to review for issues, or if you would like to investigate any IP opportunities arising out of the current climate, for example checking the status of patents belonging to a firm up for sale, please contact a member of our automotive group.

STOP PRESS: Ford reveal "Project Swift" to sell Land Rover and Jaguar, causing further uncertainty.

David Croston



The Change

China is currently going through a second wave of change. IP holders need to be aware of the changes.

Market reforms in China began in the 1980s, an example being the collapse of collective farming. 20 years later the economic landscape of China has changed beyond recognition, with growing numbers of Chinese millionaires forming an elite. This elite need something to spend their money on and cars are an obvious choice. By way of example, a whopping 300,000 people visited the recent Shanghai autoshow.

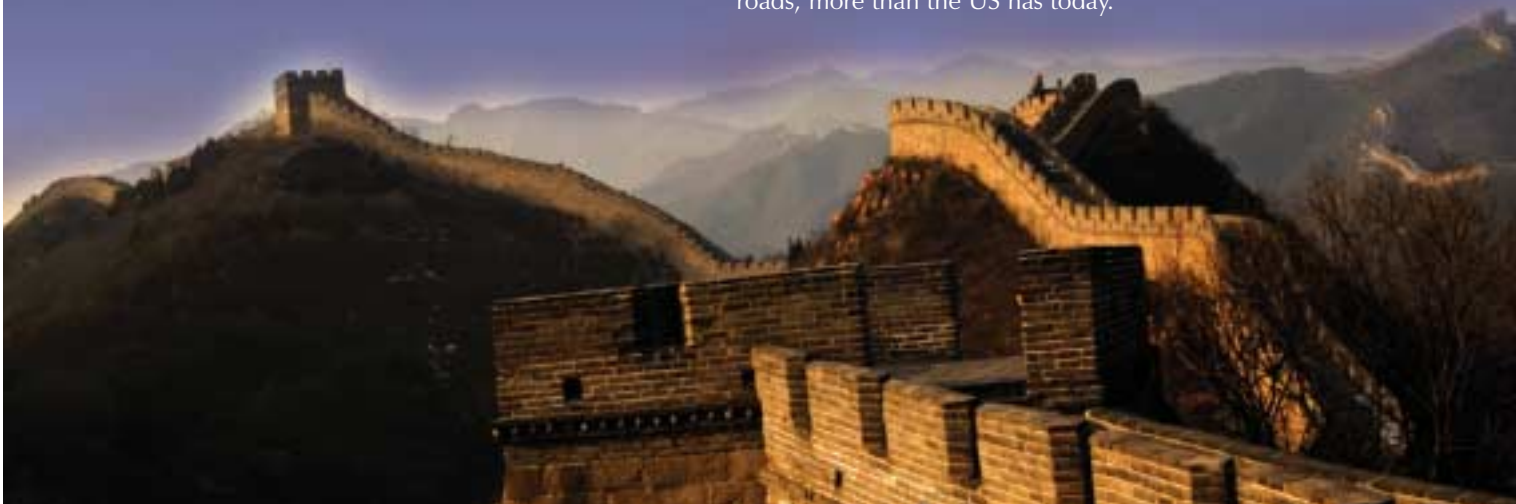
In China, "luxury" has traditionally meant that the owner rides in the back seat of a car. This favours manufacturers of large cars and Rolls Royce showed off its stretched Phantom model at the show. Unsurprisingly, the extra 250mm of stretch have been added to the rear passenger compartment. China accounts for 5% of Rolls Royce's global sales and this proportion is expected to grow. In a similar vein Mirko Bordiga, the General Manager of Ferrari Cars China is predicting a 50% rise in sales this year alone, with China expanding to be their 5th largest market within three years.

Along with the growing wealthy elite, there is also a growing middle class and this has been recognised by the indigenous car industry.

As a result, the first MG7 saloon rolled off Nanjing Automotive's new assembly line in late March 2007 to tempt the aspirational Chinese buyer. The MG7 is based on the Rover 75. Although not in the Rolls Royce league, it will still allow the owner to enjoy back-seat comfort whilst being driven around by a chauffeur should he/she choose to employ one. In 2005 Nanjing Automotive bought the physical assets of collapsed UK firm MG Rover. The MG brand is marketed in China as "Modern Gentleman". Whilst MG is well known in Europe and USA, this demonstrates how a powerful brand can transcend both political and cultural boundaries, albeit with a somewhat different slant!

Shanghai Automotive, which bought most of MG Rover's IP assets, also recently launched a similar car, again based on the Rover 75 design called the 750 and this is branded as a "Roewe". Significantly, the "Rover" brand was unavailable to both Shanghai Automotive and Nanjing Automotive since it is owned by Ford, who make Land Rover vehicles.

Ten years ago there were almost no privately owned cars in China, now there are 24 million. The Chinese new car market is growing by 10 million new cars per year and in 14 years time there will be 140 million cars on Chinese roads, more than the US has today.



ge in China

ond “cultural revolution” and IP rights ing situation and respond accordingly.

By picking over the bones of the last UK-owned volume car maker, Nanjing and Shanghai Automotive clearly think they can shortcut the move to having their own design (and IP generation) capability. No doubt they think they can win higher margins from the cars they sell in this burgeoning market, and will no longer be reliant on joint-ventures with established western car-makers.

From a European perspective, just as it is clear that the US is a major market and obtaining patents, registered designs and trade marks there is a key part of a global IP strategy for rights owners, so those owners should now consider an appropriate strategy for China. Without doing so, they are likely to lose out to both domestic Chinese and other foreign competition now and in years to come.

That doesn't mean that the same strategy should be used for China (or indeed India and Brazil) as for developed countries/regions such as USA, Japan and Europe.

Thus, whilst patent coverage for all inventions might be sought in USA, Japan and Europe, it may be appropriate to seek patent coverage for only the “key” inventions in China. This keeps down prosecution costs whilst still providing useful coverage. Although Chinese competitors may not yet be in a position to utilise your invention, they certainly will be within the twenty year life span of any patent applications that are applied for today.

Also, more European companies source their goods from Chinese manufacturers and strong Chinese IP can help police suppliers as well as preventing copies at source.

The ten year duration of registered designs in China means that this form of IP protection should also be considered, as should utility models (“petty patents”), which are also available.

As for trade marks, whilst their duration is potentially indefinite, they can be cancelled if not used for three years. Thus, trade marks should be considered only in the run up to launching a product (or a service) in China for the domestic Chinese market, or where a product is already on the market there.

Whilst the automotive sector provides a good example of the changing landscape for IP protection brought about by China's increasing importance to the world economy, there can be no doubt that most other industries will need to adapt their approach to make the most of the opportunities in China too.

We have been advising clients on appropriate IP strategies that take into account the changes in emerging economies for many years. If you are feeling the effects on your business and would like some guidance, please contact one of our team.

John Jones





Client Profile: Euro Packaging Ltd

You have probably come across those surveys which talk about the amount of time we spend on some activities across an average lifetime - you know the ones - "The average person spends 24 years sleeping, 10 years commuting etc". One category that I have never seen, although it must, I am sure, be measured in years, is trying to open plastic carrier bags at the supermarket checkout. One company dedicated to reducing that time is Euro Packaging Limited. The Birmingham based plastic carrier bag manufacturer continually innovates to create more user friendly products which dispense and open easily. It is probably not something which you have dwelt on amidst the bustle of the checkout but hundreds of design hours go into the design of each bag system.

Adam Dickinson at Euro Packaging Limited is the man responsible for developing the bag systems which you will use in the years to come.

"We try to develop systems which make life easy for the store and for the customer. The goal is a bag which dispenses one at a time, open, every time. That way the customers' experience is improved and checkout waiting time is reduced".

"Also, checkout appearance is improved because the dispensers are designed to look good and there are no waste bags scattered around".

"We are also committed to addressing the environmental concerns around carrier consumption. We strive to improve the degradability of our bags and to reduce material wastage. We have been in the lead of developing innovative bag structures which the customer can reuse".

"We have sought to protect our bags and dispense systems as thoroughly as possible. Working with Withers & Rogers, we have filed patent applications and obtained granted patents across our product range which has helped us to develop our market share. We can also enter new market territories with the benefit of protected products".

So remember the next time you are at the checkout, that the bag you are loading is probably one of the seven billion bags that Euro Packaging Limited produce for the UK every year. And remember too that it took hundreds of hours to design so you do not take that long to open it.

David Croston

Germany: The Case for National Protection

Given the popularity of the European Patent Office (EPO) it is easy to forget that protection at national patent offices of mainland Europe can still have its place.

The German Patent and Trade Mark Office (GPTO) holds a particular appeal, since it combines the possibility of obtaining coverage for the EU's most populous nation and largest economy with some unusual and useful quirks. It is no wonder that, despite having the EPO on their doorsteps, German firms continue to file at the GPTO in large numbers. Some useful features of the German national system are as follows:

- The application process is by default slow, slower even than the EPO! No request for examination needs to be made until **seven years** after filing and the office suffers large backlogs in many areas, so applications can be pending for ten+ years. Great if you want your competitors to remain unsure of the ultimate breadth of your patent for as long as possible, or want to delay the cost of divisionals.
- The application process can be fast. If you want an enforceable right quickly, a local attorney can get an interview with an examiner arranged. This means that an application can be granted in a matter of months.
- The application process can be really fast. Germany offers utility model "Gebrauchsmuster" protection in addition to patents. These have a maximum 10 year lifespan and some other limitations, but can co-exist with patents for the same invention and offer a similar form of protection. Utility models can be filed in their own right or derived from German patent applications, EP applications designating Germany and even International (PCT) applications. Since they are only examined for formal matters, they can be granted, and potentially enforced, in a matter of weeks.

Take an example of a UK firm with their next big product launched to much acclaim a couple of months ago.



They have a pending International application to get protection for the product. The application looks promising but is several years from grant. The firm learns that their German competitor may be launching a potentially infringing product at a trade fair in Germany in two months' time.

It is entirely possible for the firm to file a German utility model divided from the PCT, get it registered and obtain an injunction to get the competitor product removed from the trade fair before the public are let in! This prevents the competitor getting a foothold in the market, and means customers have only one source for the product.

Of course, for most inventions, the EPO is still likely to be the best route for protection and we can, of course, handle EPO applications ourselves. But sometimes this "one size fits all" approach may not be the best. At Withers & Rogers we enjoy close relations with German and other national European attorneys and can advise on alternative strategies for protecting innovations in Europe.

Paul Foot



Client Profile: Ricardo plc

Few companies in the UK automotive sector can boast as proud a history of innovation as Ricardo. The company was founded by Sir Harry Ricardo in 1915, a man responsible for numerous innovations in engine design - in particular high-speed diesels and two-stroke petrol engines. Today, as Ricardo plc, the company continues to flourish as an innovator, creating IP both for its clients, and with a view to generating revenue from its technology in the open market.

One strand of Ricardo's global activities involves the invention and development of powertrain solutions. The Leamington-based driveline and transmission division, with links to the area from 1950, has been responsible for the mechanical design, manufacture and supply of the Dual Clutch Transmission fitted in the Bugatti Veyron (above), along with the control unit and production software.

These types of innovations in actuation technology, clutch design and control algorithms have allowed related developments to be applied to mainstream cars, and come as a result of strategically investing many man-years in R&D, support of PhD students and demonstrator vehicles.

Commercial exploitation of "good ideas" requires good intellectual property protection and strong management as a basis for licence fees and royalties, or leveraging contract work. Ricardo also supports the IP protection of its clients' project work - from sketched concept through to subtle manufacturing techniques.

John Wheals, Chief Engineer for Innovation at the firm, says, "We have worked closely with Adrian Chettle and David McWilliams of Withers & Rogers' Advanced Engineering Group and found their approach compliments our rapid-fire innovation culture bringing both technological expertise and procedural rigour...even on Christmas Eve. We look forward to continued support in maintaining our patent portfolio with exciting prospects for Torque Vectoring™ driveline and many other world-beating technologies".

Ricardo's continued commitment to innovation is extremely encouraging, not only for the UK's automotive industry but also for the UK's reputation as a leader in engineering technology. There is a good chance that your next car may have benefited directly from this commitment.

David McWilliams



Exciting Developments for the Advanced Engineering Group

Many firms of patent attorneys take the view that engineering inventions can be handled by pretty much any of their patent attorneys, even if their training is in electronics or biotechnology. Withers & Rogers takes a different view.

Several years ago we set up the Advanced Engineering Group (AEG) within the firm to ensure that the 140 years' collective experience shared amongst the firm's ten engineering attorneys and technical assistants, is put to best use for the benefit of our clients. We have specialist groups to serve clients in the automotive, aerospace, packaging and advanced materials sectors.

The Group believes that it is important to stay in close touch with the industries we serve. For this reason we are active members of the Motorsport Industry Association (MIA) and Midlands Aerospace Alliance (MAA), and are regular attendees at events and trade fairs of interest to our clients such as the Commercial Vehicle Show and Total Process & Packaging.

For historical reasons, our engineering attorneys are presently based in two offices in the UK's engineering

heartland, but exciting changes are afoot. Later this year purpose-built offices will open in Leamington Spa to house the whole AE Group under one roof.

Leamington is on the doorstep of the UK's "Motorsport Valley" and also the engineering firms of Birmingham, Coventry and the Midlands as a whole. This will be the greatest number of engineering attorneys to be found in one office anywhere in the centre of the UK. What's more the office will also have electronics, computing and life-sciences attorneys on site should a client's needs span more than one area of technology and a trade mark team to look after branding issues.

We believe this move will only improve the excellent service we offer our clients and we look forward to embracing the new opportunities the move will bring.

Paul Foot

A Huge Sigh of Relief: the EPO Sees Sense on Divisional Applications

A central tenet of European patent law is that a patent should not be granted to cover more than one invention. To do otherwise would enable applicants to get coverage for a multitude of inventions without paying any additional fees. There is however, nothing to stop applicants filing patent applications that include multiple inventions.

This is where divisional applications come in. By paying further fees, a “divisional” including a different invention may be divided from a “parent” (the original application), but still benefit from the original priority date. Divisionals are also used tactically in order to keep an applicant’s options open for as long as possible, and to possibly obtain granted claims tailored to catch infringing products or processes that appear a number of years after a patent application has been filed, possibly long after the parent has been granted.

Often in these circumstances applicants sail close to the wind by trying to eke out every last drop of protection from their applications, at the risk of extending the protection that they are seeking beyond what was originally contemplated by the parent application as filed. This is not something the European Patent Office (EPO) takes kindly to, because a further tenet of the law is that applications cannot have new information added to them after they have been filed. This includes divisionals when compared to their parent.

Where it perceives new information has been added, the EPO has traditionally accepted that amendments to overcome these so-called “added matter” objections can be done any time before they grant a divisional. So if a divisional is filed including claims which do not have basis in the parent the divisional can still proceed to grant so long as any of the additional subject matter is deleted from the claims before grant.

More recently certain Technical Boards of Appeal - the first tier of appeal within the EPO - suggested that this practice might be wrong. According to the Technical Boards, any divisionals filed with additional subject matter not contained

in the parent were irredeemably invalid, meaning no amendments could overcome the problem. They then referred related questions to the Enlarged Board of Appeal. The Enlarged Board provides the highest level of appeal within the EPO.

The EPO decided to suspend any cases where this point arises pending the Enlarged Board decision. This has led to considerable difficulties for EP applicants and led to complex filing strategies to avoid the possibility of a divisional being irredeemably invalid, as well as a log-jam for thousands of pending divisionals. We reported on this in more depth back in the last issue of the IP Review.

If the Enlarged Board had sided with the Technical Boards, then this would have been catastrophic for thousands of both granted and pending divisionals where there was originally added matter that was removed during prosecution. They would simply have been invalid and unenforceable. What’s more this would have been hugely detrimental to the credibility of the EPO.

Thankfully, The Enlarged Board has now, finally, provided two decisions that clarify the situation. These give the right answers, much to the relief of European patent applicants and European patent attorneys. Specifically, the Enlarged Board considered the Technical Boards’ questions and answered each as follows:

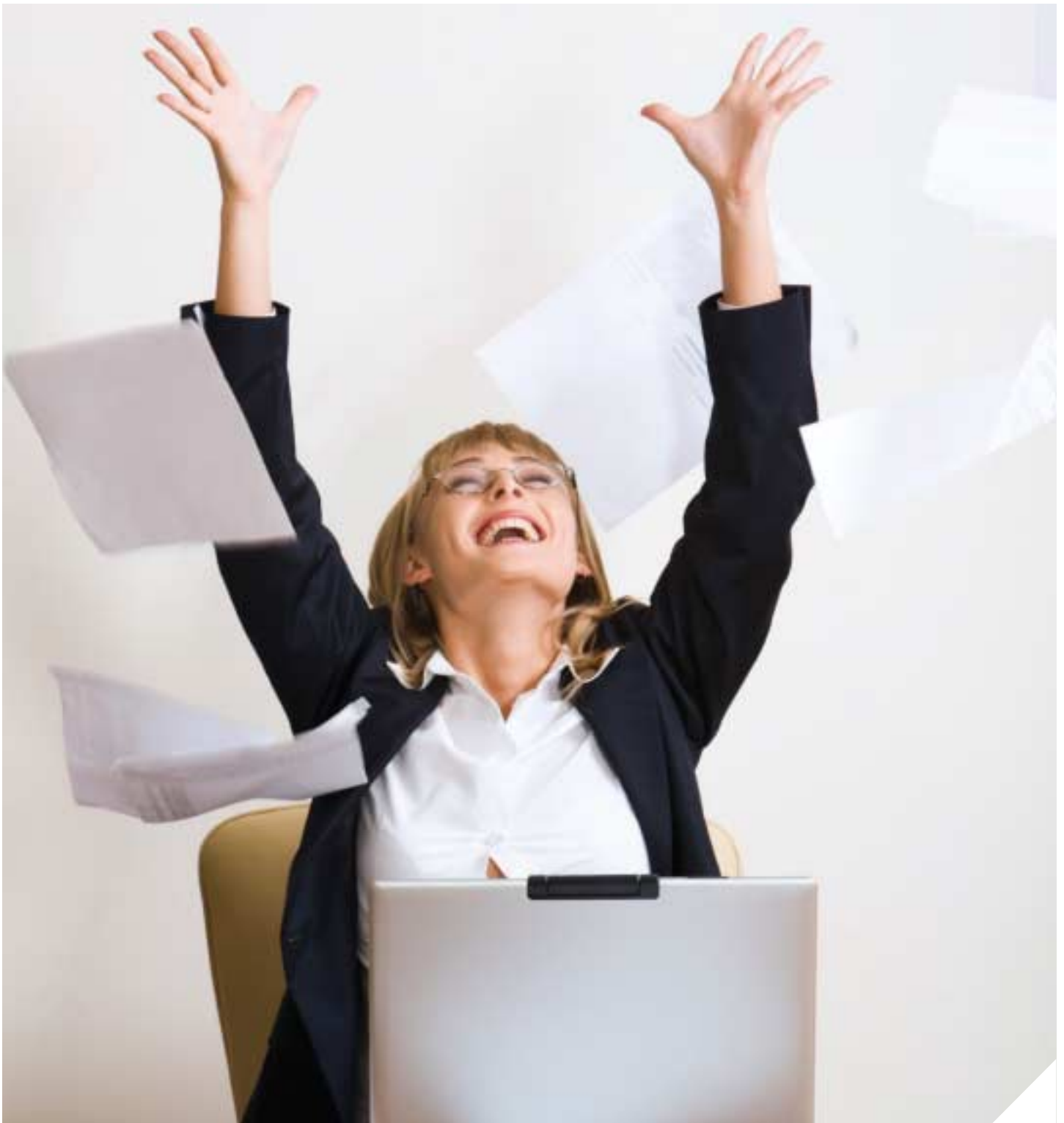
- A divisional which when filed contains matter extending beyond the content of the parent application can be amended later in order to make it valid.

- It is still possible to make these amendments even if the parent is already granted or refused.
- There are no further limitations which apply to amendments to divisionals beyond those related to added subject matter.
- Where a second divisional is filed from a first divisional, it is necessary that the claims in the second divisional have basis from both the first divisional and the earlier parent. In addition the fates of the parent and first divisional do not have any impact on the second divisional.

As a result, it is now straightforward to file divisional applications with the most desirable claims again. However, Withers & Rogers continue to recommend that any divisionals also include all of the content of the original parent application thus allowing maximum flexibility for amendments and for filing any future divisional applications.

Why did we have to go through all this? Well, your guess is as good as ours!

Russell Barton and Paul Foot



Recent Developments in UK Intellectual Property

An Intellectual Addition

Following a specific recommendation in the Gowers Review of the UK's IP system, the UK Patent Office has now become the UK Intellectual Property Office, or UK-IPO. This reflects the fact that the Office also handles registered designs and trade marks in addition to patents. Their new website URL is www.ipo.gov.uk.

For more information see:
<http://www.ipo.gov.uk/namefactsheet.pdf>
(pdf viewer required).

Late Declarations of Priority For Patents

Since 2005 it has been possible, in certain circumstances, to claim priority in the UK from an earlier UK national application up to two months beyond the usual 12 month priority period.

From 1 April 2007, it also became possible for an international ("PCT") application to claim late priority too. Late claims, however, can only be made in very specific circumstances. For further information please contact us.

Highways Across the World For Patents

The Commissioner of the Japan Patent Office (JPO) and the Chief Executive of the UK-IPO signed the Patent Prosecution Highway Pilot Agreement in March 2007. This pilot scheme will run for a year from July 2007 and will allow applicants to request accelerated examination in either one of the UK or Japan if they have received an examination report in respect of a corresponding application in the other.

For more information see:
<http://www.ipo.gov.uk/press-release-20070326.htm>

The European Patent Office (EPO) also recently launched a pilot project to fast-track applications which have been searched and/or examined and claim priority from an earlier application in the UK and some other EU states by providing its Extended European Search Report within 3 to 6 months of filing.

For more information see:
<http://upp.european-patent-office.org/index.html>

The End Of Examination on Relative Grounds in the UK For Trade Marks

Following consultation, the UK-IPO has decided to cease examining trade mark applications on relative grounds in the UK, placing the responsibility of policing registered marks into the hands of the proprietor. This comes into effect in October 2007. It is therefore even more important for trade mark proprietors to have watching services in place, a service which we can provide.

For more information see:
<http://www.ipo.gov.uk/consult-relativegrounds.pdf>

Designs Update

A cluster of legislative changes in the UK Designs system in 2006 took effect as of 1 October 2006, having effects including:

- No relative examination;
- Multiple design applications;

both of which bring the UK system closer to the Community Design (CD) system. Despite this, the relatively small extra cost of EU wide protection via CD registrations means that savvy applicants are still likely to shun the UK national route.

For more information see:
<http://www.ipo.gov.uk/desguidance.pdf>

Watch out for Scam Registries!

An increasingly common phenomenon is the creation of scam IP registries. If you receive any correspondence purporting to be from an IP registry or intellectual property office that hasn't been forwarded by us, then always contact us before taking action.

For more information see:
<http://www.ipo.gov.uk/patent/p-notice-unsolicited.htm>

Erratum: EPC 2000

In the November 2006 issue of the IP Review we stated that a translation into English, French or German of a European patent application filed in a non-EPO official language will need to be supplied within one month of the filing date. Applicants will in fact have two months to do this when the EPC 2000 changes come into force this December.

Phil Sanger

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