

LEGAL STATUS OF PATENT ATTORNEYS, TRADE MARK ATTORNEYS UNDER THE UNITED KINGDOM LAW

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Abstract.

Purpose: the author makes an attempt to research the legal status of patent attorneys, trade mark attorneys in the intellectual property right of the United Kingdom using the method of induction, systematic approach, formal legal methods. Analyzing the problem the author separates and gives legal description of different types of patent attorneys and trade mark attorneys as advisors in the field of intellectual property right of the United Kingdom. The main provisions of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (2015) (also well-known as Code of Conduct) are considered in detailed. **Results:** this research provides an opportunity to broaden the understanding of the institution of patent attorneys, trade mark attorneys in the intellectual property right of the United Kingdom and thus include this knowledge in the domestic research on intellectual property right. The obtained results will have a positive impact on the reform of the institute of representatives in the field of intellectual property in Ukraine in order to ensure its effectiveness and relevance to the challenges of the present. **Conclusions:** all types of patent attorneys and trade mark attorneys as advisors in the field of intellectual property right of the United Kingdom are well-educated professionals in all areas of intellectual property. They are able to advise on a wide range of technical and commercial issues in this field. Implementing a similar diversity of advisors in the field of intellectual property right of Ukraine will have a positive impact on the reform of the institute of representatives in the field of intellectual property in Ukraine in order to ensure its effectiveness and relevance to the challenges of the present.

Keywords: patent attorney; trademark attorney; Code of Conduct; intellectual property right, the United Kingdom.

1. Introduction

Intellectual property refers to the protection of creations of the mind, which have both a moral and a commercial value. Intellectual property right typically grants the author of intellectual creation exclusive rights for exploiting and benefiting from their creation. However, these rights, also called monopoly right of exploitation, are limited in scope, duration and geographical extent [1].

Intellectual property is divided into three institutions: industrial property includes patents for inventions, trademarks, industrial designs and geographical indications; copyright covers literary works, films, music, artistic works and architectural design; and rights related to copyright include those of performing artists in their performances, produc-

ers of phonograms in their recordings, and broadcasters in their radio and television programs [2; 3].

In any field the value and trustworthiness of advice depends on the ability of the advisor.

2. Analysis of the latest research and publications

It should be noted that international experience and national practice of the institute of patent attorneys was considered by such domestic scientists as Borivuk P.A., Kovalenko T.V., Tverezenko O.O. and others, but this issue needs to be researched in further.

3. Purpose of a research

In this article an author researches the legal status of patent attorneys and trade mark attorneys in the United Kingdom, considers the main provisions

of the Code of Conduct or the Rules of Professional Conduct for patent attorneys and trade mark attorneys as well-educated professionals in all areas of intellectual property.

4. Presenting main material

“Attorney” is the term which is used in the United Kingdom for those individuals who are specifically qualified to advice on intellectual property right and subject to external regulation. The protected terms “patent attorney” and “trade mark attorney” distinguish these lawyers from “patent consultants or patent advisors” and “trade mark consultants” etc., who are unlikely to have any form of professional qualification [4].

There are several types of patent attorneys and trade mark attorneys as advisors in the field of intellectual property right in the United Kingdom.

In the United Kingdom *the patent attorney* is an expert in the intellectual property right, specially trained, examined and experienced in the drafting patents and in knowledge of intellectual property right [5]. The title “Patent Attorney” is protected by the Copyright, Designs and Patents Act 1988 [6] and can only be used by a fully qualified patent attorney who is entered into the Register of Patent Attorneys and who is regulated by the Intellectual Property Regulation Board (hereafter – the IPReg) or by a fully qualified solicitor with specialist expertise in intellectual property law who is regulated by the Solicitors Regulation Authority. All those who are entered in the Register of Patent Attorneys must comply with the Code of Conduct – the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (hereafter – the Rules) [7] set out by the IPReg.

The IPReg was set up in 2010 by the Chartered Institute of Patent Attorneys (hereafter – the CIPA) and the Institute of Trade Mark Attorneys (hereafter – the ITMA) to be the independent regulatory body for the patent attorney and trade mark attorney professions. The CIPA and ITMA are approved regulators under the Legal Service Act 2007 [8], and in 2010 in order to separate their regulatory functions from their representational functions, as the Act requires them to do, they each set up a Regulation Board (the Patent Attorney Regulation Board and

the Trade Mark Attorney Regulation Board) which will act and take decisions together as the IPReg.

The IPReg has a Chairman and four Lay Members along with three Patent Attorneys and three Trade Mark Attorneys. The IPReg is responsible for: a) setting the education and training requirements for qualification as a Patent Attorney and a Trade Mark Attorney; b) setting the requirements for the Continuous Professional Development (hereafter – CPD) in order that the knowledge, skills and expertise of Patent Attorneys and Trade Mark Attorneys are maintained at a high level. All registered patent and trade mark attorneys in active practice are required to achieve the minimum of 16 hours CPD in order to remain registered and to self-certify that they have met this requirement when renewing their registration. Compliance may be monitored by requiring detailed support (such as individual CPD records) from a random sample of registrants each year to substantiate the 16 hours figure. Attorneys are required to undertake CPD relevant to their practice. The IPReg do not require specific numbers of hours to be devoted to particular subjects. Instead, attorneys should determine for themselves, bearing in mind their existing skills and the nature of their practice, the most appropriate subjects where they should undertake CPD, taking account of their responsibilities and the expectations placed upon them [9]; c) setting and maintaining the Rules for the professions; d) handling complaints of the professional misconduct against patent attorneys and trade mark attorneys and where appropriate taking disciplinary or other action [10].

The patent attorneys qualify by taking appropriate examinations in accordance with the regulations of the IPReg. The examinations for entry on the Register of Patent Attorneys are set by the Patent Examination Board.

The chartered patent attorneys are fellows of the CIPA who have attained the highest standards of professional practice in intellectual property law. The CIPA exists to provide its members with support in the early stages of professional training and to offer a comprehensive programme of the post-qualification Continuous Professional Development which guarantees that the chartered patent attorneys have the skills, knowledge and expertise to provide

an excellent level of service. The majority of the chartered patent attorneys are also the European patent attorneys and the registered trade mark attorneys.

The European patent attorneys are persons entered on a list of professional representatives at the European Patent Office (hereafter – EPO) as being qualified to prosecute patent applications. The EPO grants European patents for the Contracting States to the European Patent Convention and provides a single patent grant procedure, but not a single patent from the point of view of enforcement. Hence the patents granted are not European Union patents or even Europe-wide patents, but a bundle of national patents. Besides granting European patents, the EPO is also in charge of establishing search reports for national patent applications on behalf of the patent offices of France, Netherlands, Belgium, Luxembourg, Italy, Turkey, Greece, Cyprus, Malta, San Marino, Lithuania, Latvia and Monaco [11].

Under the United Kingdom law no one other than a person entered on the list of professional representatives may use the title “European Patent Attorney”.

Unlike the position for the patent attorneys, the terms “trade mark attorney” and “trade mark agent” are not protected by law and anyone may use them whether or not they have a qualification in trade marks. However, for the protection of the public, no one in the United Kingdom may use the title “*registered trade mark attorney*” unless he or she is in the Register of Trade Mark Attorneys. Entry to the Register of Trade Mark Attorneys is by examination and the Register is under the control of the IPReg.

All patent attorneys are examined in trade marks as part of the qualification to become a patent attorney and many of them practise as *trade mark attorneys*, although they may not have passed all the examinations for entry on the Register of Trade Mark Attorneys, or may have decided not to be on that Register. The Rules for patent attorneys requires them not to practise outside their competence and experience. Thus, when looking for advice on trade marks, it is advisable to check whether the advisor is a registered trade mark attorney or the patent attorney.

The European trade mark attorneys who are persons included in the list of professional representatives entitled to practise before the Office for Harmonisation in the Internal Market. There is no examination for entry on such list, but the local Patent Office must certify that the applicant has regularly practised in trade marks nationally.

All patent attorneys have the right both to conduct litigation (i.e. to run cases) and the right of audience in the Patents County Court and on appeal from the Patent Office in the Patents Court, which is part of the High Court. *The patent attorney litigators* can conduct the litigation and instruct a barrister to appear before the Court, without the need to use a solicitor for this work. The purpose of the government in granting this right was to give clients greater freedom of choice in selecting their advisers and to reduce the cost of litigation. The award of Certificates to the patent attorney litigators is governed by the CIPA Higher Court Qualification Regulations.

All members of the CIPA and ITMA have agreed to abide by the Rules written to ensure that clients consulting a firm of patent attorneys would receive accurate and impartial advice which puts their interests foremost. The Rules were drafted by the Patent Regulation Board of the CIPA and the Trade Mark Regulation Board of the ITMA working jointly together as the IPReg.

The Rules set out the standards of professional conduct and practice expected of the registered patent attorney, registered trade mark attorney or a body (corporate or unincorporated) registered in the Patent Attorney Register or the Trade Mark Attorney Register undertaking professional work (hereafter – the Regulated persons).

The Regulated persons are responsible under the Rules not only for their own acts and omissions, but also for those sanctioned, expressly or otherwise, by them.

Individuals, firms and companies registered in the Patent Attorney Register or Trade Mark Attorney Register, their managers and employees are subject to the Rules if they act in the course of a business which undertakes relevant professional work.

The Regulated persons shall carry out their professional work with due skill, care and diligence and with proper regard for the technical standards expected of them. They should only undertake work within his expertise or competence. The interests of the client would be served by the Regulated persons in fulfilment of the client's instructions.

The Regulated persons only undertake litigation and advocacy in matters where the primary issues at stake relate to intellectual property rights. Where a case raises issues which are not within the Regulated person's competence (e.g. complex issues of employment law in an intellectual property entitlement case), if the Regulated person is to continue to act they must supplement their team with other legal advisers who have relevant specialist knowledge of such matters.

Patent and trade mark attorneys do not have rights of audience in respect of criminal litigation.

The Regulated persons should in all professional activities: a) practise competently, promptly, conscientiously, courteously, honestly and objectively, avoiding unnecessary expense to the client; b) act so as to promote confidence in the intellectual property system; and c) put clients' interests foremost and keep clients' affairs confidential.

The Regulated person should not do anything that might compromise: a) his independence; b) the dignity and good standing of the Regulated person, or of the patent or trade mark professions; or c) the freedom of clients to instruct any person or firm to carry out their work or to change their representation.

The Regulated persons shall carry out their professional work in a timely manner and with proper regard for standards of professional service and client care.

Written terms of business should be given to clients at the outset of a relationship and as often as necessary thereafter. Any variations should be communicated to clients as soon as they apply to the client. The Regulated persons should ensure that clients receive as often as necessary an explanation, appropriate to the client's reasonably apparent or expected level of understanding, as to the issues in a matter, the progress of the matter and the likely timescale and an update periodically on ex-

penditure incurred or to be incurred. The level of reporting depends on the client relationship and the experience of the client or the person responsible within the client's organisation. For example, lay clients may require more care than in-house counsel. Extra care should be taken when dealing with potentially vulnerable clients such as private individuals and in particular where there may be risk factors related to a person's circumstances (e.g. bereavement, illness or disability, etc.) which increase the likelihood of the client being at a disadvantage or suffering detriment.

Every Regulated person should have a written file retention/destruction policy which should be made available to the client on request.

The 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, the 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, or possible conflict but only if all of the parties have given their informed consent in writing.

The 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.

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 reference to the specific subject matter of a case.

All Regulated persons should undertake a "conflict check" before taking on a new client. This may take whatever form is considered appropriate in all of the circumstances. 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.

The Regulated persons must keep the affairs of clients and former clients confidential except where disclosure is required and permitted by law or by the client or former client.

Subject to this duty of client confidentiality and any circumstance where disclosure of information is prohibited by law, unless a client expressly agrees that no duty to disclose arises or a different standard of disclosure applies, the Regulated person should disclose all relevant information of which he is aware to a client.

The Regulated persons' fees must be justifiable. Thus, fees charged should be based upon the information provided in any letter of engagement or on the basis of any amendment thereto.

Every Regulated person must ensure that they have in place appropriate controls, procedure and records and also sufficient and appropriately qualified staff and/or other resources to ensure that clients always receive a high standard of service in relation to the management of client money.

In the event that the Regulated person receives money from a client, other than by way of payment of fees or disbursements incurred but including money on account for fees or disbursements paid up front, they should ensure that such money is held on trust for the client in an account which is entirely separate from the Regulated person's or the firm's professional business accounts.

The Regulated persons in private practice must have an established procedure for dealing with complaints. The Regulated persons in private practice must keep records of all complaints received and the outcomes of their complaints procedures in respect of such complaints. In this context a complaint means an oral or written expression of dissatisfaction which alleges that the complainant has suffered (or may suffer) financial loss, distress, inconvenience or other detriment.

The Regulated persons may exercise a lien over client papers and other materials belonging to a client only when and to the extent that the lien is available in law or the lien is an express term of business to which the client has agreed.

The registered patent attorneys and registered trade mark attorneys shall undertake appropriate continuing professional development and, on re-

quest, provide details thereof to the appropriate Regulation Board.

Publicity and promotional activity of any kind by the Regulated persons is permitted if it is fair, honest, accurate and is not misleading and is not otherwise in breach of the Rules.

The letterhead, website and e-mails of the Regulated persons must show the words "regulated by the Intellectual Property Regulation Board" or "regulated by the IPReg".

5. Conclusions

Like in Ukraine, in the United Kingdom the term "patent attorney" is a protected title, and only those who have passed tough qualifying examinations and who have then decided to place their name on the statutory Register of Patent Attorneys are entitled to use the term. All patent attorneys are trained broadly across the field of intellectual property and are expected to be able to advice on a wide range of technical and commercial problems throughout that field. But, unlike in Ukraine, in the United Kingdom there exist several types of advisors in the field of intellectual property right, namely: patent attorneys, chartered patent attorneys, European patent attorneys, registered trademark attorneys and trademark attorneys, European trademark attorneys, etc.). In our opinion, implementing a similar diversity of advisors in the field of intellectual property right of Ukraine will have a positive impact on the reform of the institute of representatives in the field of intellectual property in Ukraine in order to ensure its effectiveness and relevance to the challenges of the present.

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ПРАВОВИЙ СТАТУС ПАТЕНТНИХ ПОВІРЕНИХ, ПОВІРЕНИХ З ТОРГОВЕЛЬНИХ МАРОК ЗГІДНО ПРАВА ВЕЛИКОЇ БРИТАНІЇ

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Мета: автор намагається дослідити правовий статус патентних повірених, повірених з торговельних марок у праві інтелектуальної власності Великої Британії, використовуючи при цьому метод індукції, системний підхід, формально-юридичний метод. Аналізуючи питання, автор виокремлює та дає правову характеристику різних видів патентних повірених, повірених з торговельних марок як консультантів у сфері права інтелектуальної власності Великої Британії. Розглянуто основні положення Правил поведінки для патентних повірених, повірених з торговельних марок та інших осіб (цей документ також добре відомий як Кодекс Поведінки) (2015). **Результати:** дане дослідження дає можливість розширити уявлення про інститут патентних повірених та повірених з торговельних марок у Великій Британії і, таким чином, включити ці знання до вітчизняних наукових розробок з права інтелектуальної власності. Отримані результати матимуть позитивний вплив на реформування інституту представників у справах інтелектуальної власності в Україні для забезпечення його ефективності та відповідності викликам сьогодення. **Висновки:** всі види патентних повірених, повірених з торговельних марок як консультантів у сфері права інтелектуальної власності Великої Британії є добре освіченими спеціалістами у всіх сферах інтелектуальної власності. Вони здатні консультивати з широкого кола технічних та комерційних питань у даній галузі. Імплементация аналогічного різноманіття консультантів у сфері права інтелектуальної власності України матиме позитивний вплив на реформу інституту представників у сфері інтелектуальної власності в Україні, забезпечуючи її ефективність та актуальність перед викликами сьогодення.

Ключові слова: патентний повірений, повірений з торговельних марок, Кодекс Поведінки, право інтелектуальної власності, Велика Британія.

**ПРАВОВОЙ СТАТУС ПАТЕНТНЫХ ПОВЕРЕННЫХ, ПОВЕРЕННЫХ
ПО ТОРГОВЫМ МАРКАМ ПО ПРАВУ ВЕЛИКОБРИТАНИИ**

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Цель: автор пытается исследовать правовой статус патентных поверенных, поверенных по торговым маркам в праве интеллектуальной собственности Великобритании, используя при этом метод индукции, системный подход, формально-юридический метод. Анализируя вопрос, автор выделяет и дает правовую характеристику различных видов патентных поверенных, поверенных по торговым маркам в качестве консультантов в сфере права интеллектуальной собственности Великобритании. Рассмотрены основные положения Правил поведения для патентных поверенных, поверенных по торговым маркам и других лиц (этот документ также хорошо известен как Кодекс поведения) (2015). **Результаты:** данное исследование дает возможность расширить представление об институте патентных поверенных и поверенных торговым маркам в Великобритании и, таким образом, включить эти знания к отечественным научным разработкам по праву интеллектуальной собственности. Полученные результаты окажут положительное влияние на реформирование института представителей по делам интеллектуальной собственности в Украине для обеспечения его эффективности и соответствия вызовам современности. **Выводы:** все виды патентных поверенных, поверенных по торговым маркам в качестве консультантов в сфере права интеллектуальной собственности Великобритании хорошо образованными специалистами во всех сферах интеллектуальной собственности. Они способны консультировать по широкому кругу технических и коммерческих вопросов в данной области. Имплементация аналогичного многообразия консультантов в сфере интеллектуальной собственности Украины окажет положительное влияние на реформу института представителей в сфере интеллектуальной собственности в Украине, обеспечивая ее эффективность и актуальность перед вызовами современности.

Ключевые слова: патентный поверенный, поверенный по торговым маркам, Кодекс поведения, право интеллектуальной собственности, Великобритания.