

Patent Attorney and Trade Mark Attorney Qualification and Registration Regulations 2009

The Patent Regulation Board of the Chartered Institute of Patent Attorneys and the Trade Mark Regulation Board of the Institute of Trade Mark Attorneys working jointly together as the IP Regulation Board (IPReg) now make the following provisions under section 275A of the Copyright Designs and Patents Act 1988 and under section 83A of the Trade Marks Act 1994, respectively, pursuant to Sections 185 and 184 of the Legal Services Act 2007.

Explanatory note: these Regulations make provision as to:

- *the appointment of Registrars for maintaining the patent attorney and trade mark attorney registers;*
- *the procedures for, and the circumstances in which, individuals may be entered into the patent attorney register and/or the trade mark attorney register, the duration and renewal of registration and the circumstances in which registration will expire or may be revoked; and*
- *appeals relating to registration of individuals in the patent attorney and trade mark attorney registers.*

Regulation 1 – Interpretation

In these Regulations, unless the context otherwise requires:-

“CIPA” means the Chartered Institute of Patent Attorneys;

“ITMA” means the Institute of Trade Mark Attorneys;

“Legal Services Board” means the board established under Section 2 and Schedule 1 of the Legal Services Act 2007

“PRB” means the Patent Regulation Board of CIPA

“TRB” means the Trade Mark Regulation Board of ITMA

“IPReg” means PRB and TRB working jointly together as the IP Regulation Board;

“patent attorney register” means the register kept under section 275 of the Copyright Designs and Patents Act 1988 as amended;

“trade mark attorney register” means the register kept under section 83 of the Trade Marks Act 1994 as amended;

“the Registers” means the “patent attorney register” and the “trade mark attorney register”;

“registered patent attorney” means an individual whose name is entered in the patent attorney register;

“registered trade mark attorney” means an individual whose name is entered in the trade mark attorney register;

“Authorised Litigator” means a registered patent attorney or registered trade mark attorney granted a right of audience or a right to conduct litigation under the Rights to Conduct Litigation and Rights of Audience and Other Reserved Legal Activities Certification Rules 2012;

“patent attorney work” means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining patents in the United Kingdom or elsewhere or of conducting proceedings before the Comptroller relating to applications for or otherwise in connection with patents;

“trade mark attorney work” means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining trade marks in the United Kingdom or elsewhere or of conducting proceedings before the Comptroller relating to applications for or otherwise in connection with trade marks;

“the commencement date” means the date on which sections 184 and 185 of the Legal Services Act 2007 come into force; and

“Registrar” means a person appointed in accordance with these Regulations to maintain the patent attorney register or the trade mark attorney register.

Regulation 2 – The Registrars

- 2.1 IPReg shall appoint a Registrar for each of the Registers to be responsible for maintaining the relevant register in accordance with these Regulations and under such terms and conditions as IPReg may determine.
- 2.2 A Registrar will normally hold office for a period of one year but shall be eligible for reappointment.
- 2.3 By agreement with PRB and TRB, the same person may be appointed as the Registrar for both of the Registers.

Regulation 3 – The Registers

- 3.1 When these Regulations come into force, any individual whose name was, immediately prior to the coming into force of these Regulations, entered in the Register of Patent Agents kept under the Register of Patent Agents Rules 1990 shall be entered in the Register of Patent Attorneys and any individual whose name was, immediately prior to the coming into force of these Regulations, entered in the Register of Trade Mark Agents kept under the Register of Trade Mark Agents Rules 1990 shall be entered in the Register of Trade Mark Attorneys.
- 3.2 The first renewal date of registrations of individuals entered into the Registers in accordance with Regulation 3.1 will be 31 December 2010.

- 3.3 The patent attorney register shall include for each registered patent attorney, the registered attorney's full name, business address, date of registration, qualification for registration, and such other particulars as PRB and the relevant Registrar may think fit to include.
- 3.4 The trade mark attorney register shall include for each registered trade mark attorney, the registered attorney's full name, business address, date of registration, qualification for registration, and such other particulars as TRB and the relevant Registrar may think fit to include.
- 3.5 The Registers shall be available for public inspection at such times and in such form and manner as IPReg may direct in consultation with CIPA and ITMA.
- 3.6 Not later than 1st April in each year IPReg shall make available to the public a copy of the entries in the Registers as at the end of the preceding calendar year by means of electronic and/or printed publication.

Regulation 4 – Requirements for Registration of Individuals

- 4.1 PRB and TRB either separately or together as IPReg and after consultation with CIPA and ITMA shall periodically issue Rules relating to the academic qualifications for admission of a person to the patent attorney register or the trade mark attorney register respectively and to the administration and conduct of periodic qualifying examinations.
- 4.2 An individual shall qualify for admission to the Patent Attorney Register, if he is able to demonstrate to the satisfaction of the Registrar of the Patent Attorney Register that he:
- (a) possesses the necessary academic qualifications required by PRB;
 - (b) has passed the qualifying examinations required by PRB; and
 - (c) either has satisfactorily completed not less than two years' full-time practice in the field of intellectual property, including substantial experience of patent attorney work, under the supervision of:
 - i) a registered patent attorney, or
 - ii) a barrister, solicitor or advocate who is engaged in or has substantial experience of patent attorney work in the United Kingdom,or else has satisfactorily completed not less than four years' full-time practice in the field of intellectual property, including substantial experience of patent attorney work in the United Kingdom; and
 - (d) is able to comply with such other rules or regulations made by PRB relating to the education and training required of registered persons and by IPReg, including character and suitability requirements of registered persons.
- 4.3 An individual shall qualify for admission to the Trade Mark Attorney Register, if he is able to demonstrate to the satisfaction of the Registrar of the Trade Mark Attorney Register that he:

- (a) possesses the necessary academic qualifications required by TRB;
 - (b) has passed the qualifying examinations required by TRB; and
 - (c) either has satisfactorily completed not less than two years' full-time practice in the field of intellectual property, including substantial experience of trade mark attorney work, under the supervision of:
 - i) a registered trade mark attorney, or
 - ii) a barrister, solicitor or advocate who is engaged in or has substantial experience of trade mark attorney work in the United Kingdom,or else has satisfactorily completed not less than four years' full-time practice in the field of intellectual property, including substantial experience of trade mark attorney work in the United Kingdom; and
 - (d) is able to comply with such other rules or regulations made by TRB relating to the education and training required of registered persons and by IPReg, including character and suitability requirements of registered persons.
- 4.4 An individual who has successfully applied to either PRB or TRB under the European Communities (Recognition of Professional Qualifications) Regulations 2015 (SI 2015 No. 2059) as amended from time to time shall be deemed to have passed such examinations as may be required under Regulation 4.2(b) or 4.3(b) hereof for admission to one of the Registers as relevant.
- 4.5 The relevant Registrar may for the purpose of establishing that a person has completed the requirements of Regulation 4.2 or 4.3, require that the person submit a statutory declaration attesting to the facts and may require such further particulars as considered necessary.
- 4.6 A Registrar may in cases of doubt regarding whether a person has completed the requirements of Regulations 4.2 or 4.3 refer the matter for decision by PRB or TRB, respectively.
- 4.7 A person who qualifies for registration under this Regulation shall unless subject to a direction under Regulation 9.1 be entitled to be admitted to one or both of the Patent and Trade Mark Attorney Registers on production to the relevant Registrar of the evidence of qualification for registration and payment of the fees prescribed under Regulation 12.
- 4.8 On request a Registrar shall provide a person entered onto the relevant Register with a certificate of registration and this shall constitute evidence of eligibility to practice as a registered patent attorney or registered trade mark attorney.
- 4.9 PRB and TRB either separately or together as IPReg may after consultation with CIPA and ITMA and with the approval of the Legal Services Board issue Regulations concerning additional qualifications and any other requirements necessary for authorisation of a registered patent attorney or registered trade mark attorney as an Authorised Litigator and for entry of the name of such an Authorised Litigator in that capacity in one or both of the Registers as appropriate.

Regulation 5 – Qualifying Examinations

- 5.1 PRB and TRB, separately or together as IPReg, may after consultation with CIPA and ITMA empower and accredit one or more Examination Agencies to be responsible to them for the management and control of the qualifying examinations pertaining to admission to one or both of the Registers as relevant or in connection with authorisation according to Regulation 4.9 and may make such additional regulations as may be necessary for this purpose.
- 5.2 PRB and TRB, separately or together as IPReg, shall be responsible for determining the entry requirements, the overall standard to be attained in, and the general content of, the qualifying examinations and the authorisation carried out under Regulation 5.1 and the appropriate level of fees associated with any such examinations and shall consult with CIPA and ITMA in determining such standard, content and level of fees.
- 5.3 Any regulations made according to Regulation 5.1 shall include transitional provisions to enable an individual who, before the coming into force of such regulations, has started the authorisation according to Regulation 4.9 or has entered for any qualifying examinations held, or to be held by or on behalf of, CIPA or ITMA to complete the necessary qualifying examinations to comply with these Regulations.

Regulation 6 – Continuing Professional Development

- 6.1 PRB and TRB, separately or together as IPReg, shall after consultation with CIPA and ITMA make regulations governing such appropriate education and training as may be required as part of the continuing professional development of a person applying to remain on the Patent Attorney Register or the Trade Mark Attorney Register, respectively.
- 6.2 PRB and TRB, separately or together as IPReg, shall have the power for due cause to waive any or all of the requirements of Regulation 6.1 in whole or in part or to extend the time within which a registered patent or trade mark attorney must complete any of such requirements.
- 6.3 Instances of non-compliance with regulations made under Regulation 3.4, 6.1 and/or 7.2 which are not exempted by Regulation 6.2 hereof shall be considered by the Registrar who may suspend the registrant from the register for a period of up to three months.
- 6.4 If a registrant's name is suspended from the register under Regulation 6.3, the suspension will be lifted upon completion of the required CPD, the grant of an exemption under Regulation 6.2 and/or receipt of requested evidence.
- 6.5 If a registrant's name is suspended from the register under Regulation 6.3, and the required CPD is not completed and/or the requested evidence is not received within three months of the first day of the Registrant's suspension from the register, the Registrar shall refer the registrant to the Joint Disciplinary Panel established under the CIPA and ITMA Rules of Disciplinary Procedure.

- 6.6 If a registrant is referred to the Joint Disciplinary Panel under Regulation 6.5, the registrant's name shall remain suspended from the register until any disciplinary proceedings are concluded.

Regulation 7 – Renewal of Registration

- 7.1 A person shall be entitled to remain on the relevant register on payment of the fee for renewal of registration prescribed in accordance with Regulation 12:
- (a) Upon payment of the fee for renewal of registration prescribed in accordance with Regulation 12;
 - (b) If he can provide to the satisfaction of the Registrar, evidence that he has complied with Rule 17 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons concerning Professional Indemnity Insurance; and
 - (c) If he satisfies the continuing professional development requirements of any rules made under Regulation 6.
- 7.2 The relevant Registrar may, for the purpose of establishing that a person fulfils the requirements of Regulation 6, 4.2(d) or 4.3(d), require that the person submit evidence to that effect and may require such further particulars as are considered necessary.
- 7.3 A Registrar may in cases of doubt regarding whether a person has completed the requirements of Regulation 6, 4.2(d) or 4.3(d) refer the matter for decision by PRB or TRB, respectively.
- 7.4 If a registered patent attorney or registered trade mark attorney fails to:
- (a) pay the fee prescribed for renewal of registration in accordance with Regulation 12 within one month from the day on which it becomes payable (the Renewal Date);
 - (b) provide the relevant Registrar with the evidence requested in accordance with Regulation 7.2 within one month of being asked to do so; or
 - (c) provide evidence to the satisfaction of the Registrar that he has appropriate Professional Indemnity Insurance in place in accordance with Rule 17 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated Persons,
- the Registrar concerned shall notify the attorney in accordance with Rule 3 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated Persons that his name will be suspended for a period of three months or removed from the relevant register within one month, unless the required fee is paid and/or the requested evidence is supplied.
- 7.5 If a registrant's name is suspended from the register under Regulation 7.4, the suspension will be lifted upon payment of the unpaid fees and/or provision of satisfactory requested

evidence, together with such further late payment fee as may be prescribed in accordance with Regulation 12.

(a) If the payment required and/or information requested is not provided within three months of the first day of the Registrant's suspension from the register, the Registrar shall remove the Registrant's name from the register if they are satisfied that removal of the attorney's name from the register would not present a risk or potential risk to clients, to the protection of client money, or to any investigative process.

(b) If the Registrar concerned considers the attorney may present a risk of the type set out in Regulation 7.5(a), they shall notify the attorney that they remain suspended from the register until such time as the Registrar considers appropriate.

7.6 Restoration of the name of a person removed from one or both of the Registers under Regulation 7.4, 7.5 or 7.5(a) after a period of six months from the Renewal Date shall be at the discretion of IPReg which may impose such further requirements as it considers appropriate which may include providing evidence of compliance with some or all of the initial registration requirements of Regulation 4.2 or 4.3.

Regulation 8 – Amendment and Correction of the Registers

8.1 A registered patent attorney or registered trade mark attorney shall notify the relevant Registrar promptly of any change in the particulars relating to him entered in either of the Registers and the Registrar shall, on payment of any fee prescribed in accordance with Regulation 12, amend the relevant register accordingly.

8.2 Any person may apply for correction of an entry in the Patent or Trade Mark Registers to the Registrar concerned who may, upon being satisfied that such entry has been made in error or that any entry is incorrect, correct the entry in whatever manner seems most appropriate.

8.3 No correction of any entry under Regulation 8.2 shall be made unless the Registrar concerned has first notified the proposed correction to the person appearing to him to be affected, has given that person the opportunity to make written representations regarding the same and has taken into account any such representations.

Regulation 9 – Removal of Entries from the Registers

- 9.1 Where IPReg has reached a decision in accordance with its Rules of Disciplinary Procedure that a registered patent attorney or a registered trade mark attorney has been guilty of misconduct or other material breach of any of its rules and regulations, it may direct that the entry for that person be removed from the relevant register, and may further direct that the entry for that person shall not be restored during such period as may be specified; and upon such a direction the Registrar concerned shall accordingly remove the whole entry for that person from the relevant register and the relevant Registrar shall not, except with the prior consent of IPReg, register the name of that person whilst the direction remains in effect.
- 9.2 IPReg shall maintain a Special Record containing the name and particulars of any person whose name has been removed from either of the Registers together with the reason for the removal and such other particulars as are considered appropriate.
- 9.3 The Special Record shall be freely available for public inspection at such times and in such manner as IPReg may direct.
- 9.4 A registered patent attorney or a registered trade mark attorney may apply to the Registrar at any time, to have their name removed from the relevant register.
- 9.5 If an application is made in accordance with Regulation 9.4, the Registrar concerned may take whatever steps are considered appropriate to satisfy themselves that removal of the attorney's name from the register would not present a risk or potential risk to clients, to the protection of client money, or to any investigative process.
- 9.6 If the Registrar concerned is satisfied that granting the application may present a risk of the type set out in Regulation 9.5, they may refuse the application or defer the making of a decision until such time as they consider appropriate.

Regulation 10 – Appeals from Decisions under these Regulations

- 10.1 IPReg shall establish an administrative appeals procedure for reviewing decisions made under these Regulations.
- 10.2 Any person aggrieved by any decision under these Regulations may invoke the appeal procedure.
- 10.3 Any appeals under IPReg's own appeal procedure must be made with 28 days of notification of the decision.
- 10.4 In the event of a successful appeal against a direction under Regulation 9.1, the Registrar shall restore to the relevant register an entry removed in accordance with the previous direction.

Regulation 11 – Duration of Registration and Renewal

- 11.1 Unless provided for otherwise by regulations, the registration of an individual shall be renewed annually and the Renewal Date shall be 31 December in each successive year.
- 11.2 Renewal of registration shall commence on the day following the Renewal Date, subject to compliance with Regulation 7.1.

Regulation 12 – Fees

- 12.1 IPReg shall determine in consultation with CIPA and ITMA and with the approval of the Legal Services Board such fees as may be payable in connection with initial and continued registration of individuals and shall publish a list of these at regular intervals.
- 12.2 The fees referred to in Regulation 12.1 shall include those payable by:
- (a) Every person for entry into one of the Registers;
 - (b) Every registered person to remain on one of the Registers as eligible to practice;
 - (c) A registered patent attorney or registered trade mark attorney requesting an amendment of either of the Registers under Regulation 8.1; and
 - (d) A person applying to have his name restored to either of the Registers under Regulation 7.5.
- 12.3 IPReg may provide for the remission or refund of any fees in such circumstances as may be prescribed.
- 12.4 Any renewal of registration fee payable under Regulation 12.2(b) may be paid up to three months before the Renewal Date.
- 12.5 The fees payable by a candidate for any qualifying examinations (or part or parts thereof) required under Regulation 4.2(b) or 4.3(b) shall be determined by the Examination Agency concerned but the level of such fees shall be subject to review in accordance with Regulation 5.2.

Regulation 13 – Commencement Date

- 13.1 These Regulations shall apply from the commencement date.

Sept 09: First publication

Mar 10: Minor corrections

Feb 14: Definition of “Authorised Litigator” revised

Feb 16: Updated Statutory Instrument reference

Feb 18: Power to suspend registrants for non-compliance with CPD or PII requirements, and non-payment of fees

Dec 18: Time period to suspend registrants for non-compliance, removal of entries from the registers