

The Institute of Trade Mark Attorneys

Code of Practice

The following Code of Practice was brought into force in 1996 by the authority of Council under Article 59 of the Articles of Association as adopted on 22nd September, 1992 and will be used by Disciplinary Committee for its guidance in considering any issues or complaints referred to it.

1. **PUBLICITY**

1(i) **General**

A Member may, at his discretion, publicise his practice, or permit another person to do so, or publicise the business or activity of another person, subject to the provisions of this Code of Practice; but nothing herein contained shall be construed as authorizing any breach of The Institute's Rules of Professional Conduct as stated in Articles 58-64 of the Articles of Association and in any interpretation thereof that Council is empowered to make under the Articles of Association, or of any other professional obligation or requirement, or authorizing publicity which is not in good taste, or is unfair, undignified, misleading, not wholly accurate, or which does not comply with the law or any Rules or Codes of Practice applicable to the media used.

1(ii) *Repealed by Council on 28th January, 2003*

1(iii) **Unsolicited Correspondence**

Subject to the provisions of paragraph 2(ii)(b) hereof, Members shall not send unsolicited communications, advice to, or otherwise initiate any discussion relating to a specific professional matter with any person, company or firm whom the Member knows, or upon reasonable enquiry could have known, to be the client of another Member and not being his own client, save that where a Member has purchased a practice of another practitioner, he shall not be precluded from writing to each client of that other practitioner informing them of the change. Nothing in this paragraph shall be construed as precluding a Member from sending a general advertising circular to any person, company or firm subject to the Member concerned being responsible for ensuring compliance with the provisions of any other paragraph hereof.

1(iv) **Content of Publicity**

(a) **Success Rate**

No publicity may refer to a Member's success rate.

(b) **Comparison and Criticisms of Services**

No publicity may compare the quality of the service provided by a Member, his partners or his firm or company with that provided by any other identifiable Member, group of Members or their firm or company, and no publicity may criticize the quality of service provided by an identifiable Member, group of Members or their firm or company. Save that a Member may co-operate in the preparation of a survey of professional services, conducted by an independent third party, even if such survey results in the publication of direct comparisons between the quality of service or charges provided by different intellectual property practitioners.

(c) **Charging**

Any publicity as to charges or a basis of charging must be clearly and fairly expressed. If publicity contains a reference to a fixed charge for a particular item of work, then that charge must cover either all of the work which would normally be carried out by a practitioner in connection with that item, or specify precisely what further charges might be made for additional time spent on the case. The reference shall also state whether or not the charges are exclusive of VAT and disbursements.

No publicity may directly compare the charges of Member or group of Members or their firm with those of any other identifiable intellectual property practitioner or practitioners and no publicity may directly criticize the charges of any identifiable intellectual property practitioner or practitioners.

(d) **Practitioner to be identified**

Every advertisement by a Member must bear the Member's name or the names of his partners or firm name, together with the address of the principal place of business.

(e) **Credit Cards**

A credit card logo or other reference to a credit card may be included in a Member's publicity if applicable; but where, by agreement with the credit card company, the Member places a limitation on the use of the credit card facility, the logo or reference must be accompanied by a form of words indicating the existence and the nature and extent of the limitation.

1(v) **Directory Entries**

Entries in directories which comply with the foregoing paragraphs may be inserted in normal or other type under appropriate headings, providing that the heading does not require a specific qualification which the Member does not have.

1(vi) **Professional Stationery**

(a) **Application of the Code of Practice to Stationery**

The provisions of this Code of Practice apply to a Member's letterhead and any other matter forming part of his professional stationery.

(b) **Practising Address**

A Member's professional stationery must include a full practicing professional address and not merely a box number.

(c) **Use of Client's Stationery**

A Member may use for his professional work, the stationery of his client or employer provided it is clear from the overall effect that the stationery is being used by a Member in respect of his professional business for that client or employer and that the Member is responsible for the contents of the letter.

(d) **Use of Client's Name on Stationery**

A Member may not use the name or names or any of his clients on his professional stationery.

1(vii) **Sponsorship**

A Member or his firm may sponsor any event which will not bring the profession into disrepute provided that any advertisements promoting such events comply with this Code of Practice.

1(viii) **Stands at Exhibitions**

A Member may have a stand at an exhibition, conference or show, distribute literature and promotional gifts from such stand and give oral advice there, provided that the Member's firm name and practicing address are displayed on the stand and on any literature distributed therefrom and further provided that the messages conveyed by any literature or promotional gifts do not conflict with this Code of Practice.

1(xi) **Mobile Offices**

A Member may have a mobile office, provided that the Member's practice also has a permanent location. The firm name and the permanent practising address of the Member must be displayed prominently on the outside and inside of the mobile office and on any literature given out therefrom.

1(x) **Professional Announcements, Advertisements for Staff, etc**

Any professional announcement, advertisement for staff, advertisement offering agency services, or any other like advertisement by a Member must comply with the provisions of the Code of Practice.

No professional announcement shall be made which may be likely to induce or be taken to be attempting to induce the transfer from their existing representatives of clients who were formerly serviced by a named Member.

2. **RELATIONS BETWEEN MEMBERS OF THE INSTITUTE**

2(i) **General**

(a) Provided that he does not breach his overriding duty to his client, a Member must be candid and act in good faith in his dealing with other Members, and

(b) A Member is responsible for his own statements and, if a Partner or a Director in private practice, for statements made by his partners and by any other members of his firm or any directors or employee of his company, and

(c) A Member must behave courteously at all times, irrespective of the issues involved in the matter with which he is dealing; and

(d) A Member must not make statements offensive to another Member, whether or not such statements are in writing.

2(ii) **Direct Contact with Other Persons**

(a) A Member who has been instructed in a matter should not contact another Member's client or any other person in connection with that matter where he knows that another Member has already been instructed to act. Such contact should be made only with the consent of or following suitable notice to the other Member.

(b) A Member may be justified in writing direct to the client of another Member where that other Member has failed repeatedly to reply to letters. No such contact with the client of the other Member should be made until that other Member has been informed in writing that the Member intends to write to his client. If direct contact is then made with the client, the other Member must be informed.

(c) Nothing herein shall prevent a Member from suggesting to his client that that client makes direct contact with the client of another Member.

(d) When a Member or his firm being the appointed agent or the Address for Service in relation to a trade mark matter is contacted in respect of that matter or any matter arising therefrom, that Member ("The Contacted Member") shall inform his client promptly of any such communication received. Only when The Contacted Member has reported to his client, may The Contacted Member seek to require the person who has written to him (The Petitioner) to give an understanding that The Petitioner shall pay the reasonable charges of The Contacted Member for work involved in dealing further with the matter. If The Contacted Member no longer acts for, or for some other reason does not wish to, or cannot, report to his client or former client, he must promptly notify The Petitioner.

(e) In the event that the client instructs The Contacted Member that the client does not want to entertain the matter at all, then unless the client instructs otherwise. The Contacted Member shall inform The Petitioner accordingly irrespective of whether any undertaking has been obtained as to costs.

2(iii) **Payment of Costs**

Until such time as agreement to meet costs has been reached and a contract thereby established, The Petitioner is under no obligation to meet any charges which The Contacted Member wishes to make in respect of dealing with the matters raised by him or the request for assistance. However, The Petitioner should expect to be held responsible for the reasonable charges of The Contacted Member whether or not there has been a response to the matter raised or any assistance is given. Therefore, it is the responsibility of any Member in the role of The Petitioner to ensure that his client is made aware that such charges may be levied whether or not a response or the requested assistance is forthcoming and to agree with The Contacted Member what shall be the level or likely level of such charges. It is the responsibility of The Contacted Member to agree with his client or instructing principal whether to request payment of any charges and to ensure agreement that they will be met by The Petitioner.

3. **ASSISTANCE TO OTHER MEMBERS AND TRANSFER OF PAPERS UPON CHANGE OF AGENT**

3(i) In the event that a Member ("the Incoming Member") is instructed by or appointed to act for a client who has previously instructed or employed another Member ("the Outgoing Member") in respect of the same matter, it is expected that the Members shall cooperate reasonably to protect the interests of the client and to ensure that the client's rights are not prejudiced or harmed in any way. If agreement cannot be reached to achieve reasonable cooperation, including reasonable payment to the Outgoing Member for assistance rendered to the Incoming Member (as discussed below) the client is entitled to the return of all client papers in the possession of the Outgoing Member.

3(ii) Subject to any question of a lien, and subject to the general law of agency, client papers in the possession of a Member, acting as an Agent, belong to the client.

3(iii) **Papers Belonging to The Client**

(a) Documents in existence before a Member is appointed as Agent, and sent to the Member by or on behalf of the client during the currency of the appointment.

The Member holds those papers as Agent for and on behalf of the client, and on termination of his appointment must on request by or on behalf of the client return or dispose of them as the client may direct.

(b) Documents prepared by the Member as Agent for the benefit of the client and which may be said to have been paid for by the client. Such documents may include:

- ? all copy documents and letters other than those set out in paragraph 3(iv) below, and
- ? documents for which no specific charge has been made but which are part of services provided by the Member and for which a charge is made, and
- ? documents in respect of which a charge is specifically made such as Instructions and Briefs in contentious matters, and deeds and other documents in non-contentious matters.

(c) Documents prepared by a third party during the course of the appointment and sent to the Member (other than at the Member's expense). These include letters to the Member, and debit notes for disbursements incurred by the Member on behalf of his client.

3(iv) **Papers Belonging to The Agent**

(a) Documents prepared by the Member for his own benefit or protection, the preparation of which has not been charged either specifically or as part of a service to the client.

These include:

- ? copies of letters written to the client,
- ? entries of attendances,
- ? tape recordings of conversations and proofs of evidence, as an aide memoire but not charged specifically or as part of a service provided,
- ? internal office memoranda,
- ? entries in diaries,
- ? time sheets,
- ? computerized records, account.

(b) Documents sent by the client to the Member during the course of the appointment, the property in which was intended at the date of despatch to pass from the client to the Member.

These would include letters, authorities and "instructions written or given" by the client to the Member.

3(v) **Retention of Documents**

A Member seeking to retain documents must show that:

- ? he was under no duty to the client to prepare them;
- ? they were not in fact prepared for the benefit of the client; and
- ? the client cannot be regarded as being liable to pay for them specifically, or as part of a charge in respect of services to the client, or under any general item in the Member's bill.

A client seeking to obtain documents which the Member is resisting to return must show that:

- ? the documents were a necessary part of the business transacted, e.g. a draft agreement and,
- ? he has in fact paid (or is liable to pay) in one form or another for their preparation.

3(vi) On delivery of documents to the client or his nominee on the termination of an appointment as Agent, the Outgoing Member may charge for preparing a schedule of them if the schedule is requested or is agreed to by the client or on the client's behalf for example, by the Incoming Member to whom the papers are being transferred. If the client states that he does not require a schedule, the Outgoing Member cannot charge for preparing it.

3(vii) **Guidance on "Best Practice"**

(a) The Incoming Member should ensure that his new client fully understands that whatever arrangement that Incoming Member may have made as to fees for accepting the new client's instructions or assuming responsibility, there is no professional or other obligation on the Outgoing Member to provide free of charge such services as the Incoming Member has requested to facilitate a smooth transfer, and, unless agreed otherwise by the Outgoing Member and the client, these charges are the responsibility of the Incoming Member.

(b) The Incoming Member should contact the Outgoing Member with a view to making all arrangements to transfer of responsibility as well as the physical transfer of any papers.

(c) Although the Outgoing Member is not entitled to charge for preparing any schedules, for example of papers to be transferred, or photocopying such documents for his (or his insurer's) purposes, nevertheless, where the work is specifically requested by the client or by the Incoming Member, it is perfectly acceptable for the Outgoing Member to make a charge for preparing lists of schedules and to charge for work done in providing information, advice or assistance in effecting the transfer. When the Outgoing Member is first contacted, he should satisfy himself that the client or the Incoming Member will pay for work done by the Outgoing Member in preparing lists and schedules

and in providing assistance and/or making ready any papers to be transferred to the Incoming Member, including reasonable costs of photocopying. It is for the Incoming Member to ensure before accepting instructions to assume responsibility for the work to be transferred, that his new client is made aware that such charges might be incurred.

(d) The Outgoing Member should consider how to ensure that payment will be made for outstanding invoices and for fees and charges for work in progress, including disbursements incurred on behalf of the client, and should satisfy himself that payment will be forthcoming after he has relinquished the client's papers, for example, by requiring the Incoming Member to accept full responsibility for such payment, or by requiring an immediate full settlement of all outstanding invoices as a condition of releasing the client's papers. It is for the Incoming Member, firstly, to consider, before accepting instructions to assume responsibility for the work in question, whether he is prepared to give such assurances, and, secondly, to draw the attention of the client to the fact that such assurances or immediate payment of all outstanding invoices may be required by the Outgoing Member as a condition of releasing the client's papers.

4. **GENERAL**

A Member shall not act for parties on opposing sides of a matter unless he has the prior written consent of all parties having an interest in the matter that he should so act.

INTERPRETATION

1. "Advertisement" and "advertising", except where the context otherwise requires, refer to any form of advertisement and include, inter alia, brochures, directory entries, information circular, letters, stationery and press releases promoting a Member's practice; but exclude press releases prepared for a client.

2. "Practitioner" includes an individual, group of individuals, firm or company or corporation which conducts a professional practice offering services in intellectual property.

3. "The Institute" means The Institute of Trade Mark Agents.

4. "Articles of Association" means the Articles of Association of The Institute as adopted on 22 September 1992.

5. "Member" shall, except where the context requires it to include a group of Members or their firm, mean a person who is recorded in the records of The Institute as being an honorary member, or a subscribing Corporate, Affiliate, or Student Member.

6. "Agent" means a person, a group of persons or a firm, whether or not a Member or comprising a Member, acting as an agent for another.

7. "Register" means the Register of Trade Marks administered under the Trade Marks Act, 1994.

8. Words importing the masculine gender include the feminine, words in the singular include the plural, and words in the plural include the singular.