

## **PRE-REGISTRATION AND REGULATION OF PATENT ATTORNEY AND TRADE MARK ATTORNEY FIRMS BY IPReg**

CIPA and ITMA have put in place arrangements which enable solicitors employed by firms of Patent and Trade Mark Attorneys to provide legal services to the public.

Firms of Patent and Trade Mark Attorneys are invited to seek “pre registration” under the terms of this notice, and to pay the fee (£500); the firm, and all the Trade Mark Attorneys, Patent Attorneys and Solicitors will then be regulated by IPReg on behalf of the two Institutes.

### **Background**

The SRA changed the Solicitors’ Code of Conduct to permit solicitors to practice via “an authorised non-SRA regulated firm”. “Non-SRA regulated firm” is defined by the Solicitors’ Code of Conduct as meaning; “a sole practitioner, partnership, LLP or company authorised to practise by another approved regulator and not by the SRA”. Since ITMA and CIPA are both listed in Schedule 4 to the Legal Services Act 2007, this means that following the change to the Solicitor’s Code of Conduct, solicitors are permitted to provide legal services to the public via firms of patent attorneys and trade mark attorneys if such firms are regulated by CIPA or ITMA. Such practice is permitted notwithstanding the fact that the statutory appointment of CIPA and ITMA as authorised regulators has not yet come into effect.

At present the ITMA and CIPA codes of conduct only apply to individual members of the Institutes rather than to firms run by such members. However, ITMA and CIPA have decided that their respective regulatory arms, the Trade Mark Regulation Board (TRB) and the Patent Regulation Board (PRB), acting jointly as IPReg, may regulate the conduct of firms on an interim basis before the appointment of CIPA and ITMA as statutory regulators; this has the effect of bringing forward the date when solicitors employed or managing firms of patent and trade mark attorneys can provide legal services via such firms.

In particular, such approval permits solicitors within firms of patent and trade mark attorneys to:

- (i) practise as solicitors and hence not be obliged in the course of practice via a patent or trade mark attorney firm to refer to themselves as “non-practising”; and
- (ii) Exercise their rights to litigate and rights of audience on behalf of clients of the firm.

In the case of the latter, one particular, right which may well be of significant interest will be the right to undertake and prosecute appeals from the Community Trade Mark Office to the Court of First Instance and the ECJ where at present patent attorneys’ and trade mark attorneys’ rights of audience are unclear.

The approval of IPReg to regulate such firms on an interim basis also relieves solicitors practising through such firms of the obligation to comply with much of the Solicitors Code of Conduct<sup>1</sup> and in particular the Solicitor’s Accounts rules<sup>2</sup> provided their practice remained within

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<sup>1</sup> SRA Rule 23(2)(a); “Only this rule and rules 1 (Core Duties), 12 (Framework of Practice) , 20 (rights and Obligations of practice , 21 (Separate Business) and 24 (interpretation) apply to you if you are a solicitor,

the scope of that regulated by IPReg.

IPReg's ability to regulate such firms on an interim basis will increase the opportunities for firms of patent attorneys and trade mark attorneys who currently employ or who are managed by individuals qualified as solicitors to compete with solicitors for certain type of IP-related work. It is also believed that such interim regulation will be of benefit the public because it will relieve solicitors working via patent and trade mark attorney firms from being obliged to use the misleading "non-practising" term or forgoing mentioning their solicitor qualifications when in fact many such individuals are dual qualified both as solicitors and patent/trade mark attorneys and practising as such.

Firms will, of course need to inform or consult their insurers before applying for registration. Also, any Solicitor covered by this arrangement will need to continue to maintain their Practice Certificates.

### **What is required?**

Firms who wish to register should apply in writing to IPREG setting out the following:

- 1) The partnership, LLP or company agrees that it will abide by the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other regulated persons<sup>3</sup>.
- 2) That either:
  - (A) i) the partnership, LLP or company is entitled under section 276 of the Copyright Designs and Patents Act 1988 to carry on a business under any name or other description which contains the words "patent agent" or "patent attorney" ; and that
  - ii) it undertakes the business of acting as agent for others for the purpose of applying for or obtaining patents, in the United Kingdom or elsewhere, or conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents;

AND/OR

- (B) i) the partnership, LLP or company is entitled under section 84 of the Trade Marks Act 1994 to carry on a business under any name or other description which contains the words "registered trade mark agent" ; and that
- ii) it undertakes the business of acting as agent for others for the purpose of applying for or obtaining the registration of trade marks, in the United Kingdom or elsewhere, or conducting proceedings before the comptroller relating to applications for, or otherwise in connection with the registration of trade marks.

In addition, the request should provide the following information:

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*REL or RFL practising through or employed by an authorised non-SRA firm when doing work of a sort authorised by the firm's approved regulator."*

<sup>2</sup> Solicitor's Accounts Rules Rule 5(d) "*These rules do not apply to: ... a solicitor when practising as a manager or employee of an authorised non-SRA firm and acting within the scope of that firm's authorisation to practise.*"

<sup>3</sup> Available from [http://www.ipreg.org.uk/document\\_file/file/Code%20of%20Conduct.pdf](http://www.ipreg.org.uk/document_file/file/Code%20of%20Conduct.pdf)

- (a) the name, and trading name if different, and any number under which the body is registered;
- (b) the registered body's registered office, if it is an LLP or company;
- (c) the registered body's principal practising address;
- (d) all the registered body's other practising addresses;
- (e) whether the registered body is a partnership, an LLP or a company; and
- (f) if the registered body is a company, its registered number and whether it is:
  - (i) a company limited by shares;
  - (ii) a company limited by guarantee;
  - (iii) an unlimited company;
  - (iv) an overseas company registered in England and Wales;
  - (v) an overseas company registered in Scotland; or
  - (vi) a *societas Europaea*;
- (g) a list of the body's managers (i.e. partners in the case of a partnership, members in the case of an LLP and directors in the case of a company), and in respect of each manager, whether that manager is:
  - (i) a registered patent attorney;
  - (ii) a registered trade mark attorney ;
  - (iii) a lawyer of England and Wales, and if so the nature of his or her qualification;
  - (iv) a registered European lawyer, and if so his or her professional title and jurisdiction of qualification; or
  - (v) a registered foreign lawyer, and if so his or her professional title and jurisdiction of qualification.

A fee of **£500** (cheques to be payable to IPReg) will be payable for this pre-registration.

A form for applying for pre-registration is attached.

Upon registering a firm, IPReg will issue a letter to the firm in question confirming that IPReg undertake to regulate the firm in respect of the provision of legal services relating to or ancillary to the acquisition or enforcement of intellectual property; any other services such are ordinarily undertaken by firms of patent and trade mark attorneys; and any further services IPReg might approve from time to time. In the event of doubt a firm may apply to IPReg for confirmation that the services provided or proposed to be provided by the firm fall within the scope of regulation by IPReg.

Applications can be made with immediate effect to:

Intellectual Property Regulation Board, 95 Chancery Lane, London, WC2A 1DT

Enquiries to [info@ipreg.org.uk](mailto:info@ipreg.org.uk)